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

OCT - 5 2000

Michael G. Gilman (For Patent Owner)
Lowe Hauptman Gopstein Gilman & Berner
1700 Diagonal Road
Suite 310
Alexandria, VA 22314

Enclosures: Petition filed May 19, 2000
Petition filed September 15, 2000

David J. Cushing (For Requester)
Sughrue Mion Zinn MacPeak & Seas
2100 Pennsylvania Ave., N.W.
Washington, D.C. 20037-3202

Enclosure: Paper filed September 5, 2000

In re Gnecco et al.
Reexamination Proceeding
Control No. 90/005,608
Filed: January 7, 2000
For: U.S. Patent No. 5,640,457

DECISION DISMISSING PETITIONS AND RETURNING IMPROPER SUBMISSIONS

This is a decision on the May 19, 2000, patent owner petition filed under 37 C.F.R. § 1.181(a)(3), to invoke the supervisory authority of the Commissioner to strike three (3) documents from the reexamination request as not being within the scope of the statutory grounds available for reexamination. This is also a decision on the September 5, 2000, third party requester paper taken as a petition, requesting denial and return of the patent owner petition of May 19, 2000, and on the September 15, 2000, patent owner petition filed under 37 C.F.R. § 1.181(a)(3), to invoke the supervisory authority of the Commissioner to strike the September 5, 2000, third party requester paper from the reexamination proceeding.

The patent owner petitions and third party requester petition are before the Director of Technology Center 2700 for decision.

For the reasons set forth below, all of the petitions are **dismissed**, and the petitions are being returned to the respective senders as improper submissions.

REVIEW OF FACTS

1. On March 23, 2000, the examiner ordered reexamination in the present 90/005,608 proceeding.

2. On May 19, 2000, patent owner filed a petition under 37 C.F.R. § 1.181(a)(3), to invoke the supervisory authority of the Commissioner to strike three (3) documents from the reexamination request as not being within the scope of the statutory grounds available for reexamination.

3. On September 5, 2000, the third party requester (hereinafter "requester") filed a paper requesting denial and return of the patent owner petition of May 19, 2000.

4. On September 15, 2000, patent owner filed a petition under 37 C.F.R. § 1.181(a)(3), to invoke the supervisory authority of the Commissioner to strike the September 5, 2000, third party requester paper from the reexamination.

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 May 19, 2000, patent owner petition to strike was filed prior to the start of the examination on the merits and was not accompanied by a statement under § 1.530. Accordingly, the May 19, 2000, patent owner petition is dismissed as being an improper submission under § 1.540. Patent owner, electing **not** to submit

the papers along with a timely filed statement under § 1.530(b), thereby **not** giving the reexamination requester a right to file a

reply under § 1.535, cannot expect to be afforded the right to submit papers prior to the time provided for under 37 C.F.R. § 1.540. Accordingly, the May 19, 2000, patent owner petition is being returned as an improper submission under § 1.540.

The present issue is a procedural issue. It is the intent of the Statute to provide certain rights under 35 U.S.C. § 304 to both patent owners and third party requesters in the preliminary phase (stage) of the reexamination proceeding. The rules (including 37 C.F.R. § 1.540) were drafted in accordance with that intent. If a patent owner responds to the order for reexamination, the third party requester should have the right to then respond to the patent owner. In the present instance, the patent owner cannot take away that third party right by electing **not** to file a statement, and then expect to be afforded the right to submit papers prior to the time provided for under § 1.540 to permit entry of patent owner's paper (the petition).

Should patent owner elect to raise the question of whether the three (3) documents from the reexamination request are within the scope of the statutory grounds available for reexamination after a first Office action on the merits is issued, patent owner may do so at that point (in owner's responsive arguments) as provided for in 35 U.S.C. § 305 directed to conduct of reexamination proceedings.

The September 5, 2000, requester paper is taken as a petition in opposition to patent owner's petition of May 19, 2000. This petition is also an improper submission under § 1.540 and, accordingly, is being returned herewith. Even if it were proper, entry of this paper would be moot in view of the return of the petition submitted by patent owner. Likewise, the September 15, 2000, patent owner petition is also an improper submission under § 1.540 and, accordingly, is being returned herewith. Again, even if the patent owner petition of September 15, 2000, were proper, entry of this paper would be moot in view of the return of the papers submitted by requester.

CONCLUSION

1. The patent owner petition under 37 C.F.R. § 1.181(a)(3), filed May 19, 2000, to strike three (3) documents from the reexamination request as not being within the scope of the statutory grounds available for reexamination is dismissed.

2. The third party requester paper filed September 5, 2000, taken as a petition in opposition of, and requesting denial and return of the patent owner petition of May 19, 2000, is dismissed.

3. The patent owner petition under 37 C.F.R. § 1.181(a)(3), filed September 15, 2000, to strike requester's paper of September 5, 2000 from the reexamination is dismissed.

4. All of the petitions are being returned as improper submissions.

5. The reexamination file is being forwarded to the examiner assigned to the proceeding for issuance of a first Office action in due course not inconsistent with this decision.

Telephone inquiries related to this decision should be directed to James Groody, Special Program Examiner, at (703) 308-5461.

James L. Dwyer
Director
Technology Center 2600
Communications

Mailed copies To:

Michael G. Gilman
Lowe Hauptman Gopstein Gilman + Berner
1700 Diagonal Road
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Alexandria, VA 22314

Document Produced on Request

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

mailed To:

DO NOT USE IN PALM PRINTER

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

David J. Cushing
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2100 Pennsylvania Ave., N.W.
Washington, D.C. 20037-3202

REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/005608

PATENT NO. 5,640,457

ART UNIT 2743

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
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,613	01/19/00	RE35575	003705.P046R

MM41/0103

MICHAEL J. MALLIE
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES CA 90025-1026

EXAMINER
ULLAH, A

ART UNIT	PAPER NUMBER
2874	7

DATE MAILED: 01/03/01

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. 7

Michael J. Mallie (For Patent Owner)
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George A. Quadrino (For Third Party Requester)
FARKAS & MANELLI PLLC
2000 M Street, N.W., 7th Floor
Washington, D.C. 20036-3307

In re Jing-Jong Pan :
Reexamination Proceeding :
Control No. 90/005,613 :
Filed: January 19, 2000 :
For U.S. Patent No. RE35,575 : DECISION MERGING
: REEXAMINATION
: PROCEEDINGS

In re Jing-Jong Pan :
Reexamination Proceeding :
Control No. 90/005,614 :
Filed: January 19, 2000 :
For U.S. Patent No. RE35,575 :

In re Jing-Jong Pan :
Reexamination Proceeding :
Control No. 90/005,758 :
Filed: June 23, 2000 :
For U.S. Patent No. RE35,575 :

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. RE35,575 was issued on July 29, 1997. RE35,575 is a reissue patent of Patent No. 5,208,876

2. Reexamination Control No. 90/005,613 and Reexamination Control No. 90/005,614 were requested by the patent owner on January 19, 2000.

3. Reexamination was ordered in both the '5613 reexamination proceeding and the '5614 reexamination proceeding on April 5, 2000.

4. Reexamination Control No. 90/005,758 was requested by a third party requester on June 23, 2000.

5. Reexamination was ordered in the '5758 reexamination proceeding on September 5, 2000.

6. No statement by the patent owner was received in the '5613 reexamination proceeding, in the '5614 reexamination proceeding, or in the '5758 reexamination proceeding.

7. A Power of Attorney by Assignee and Revocation of Previous Powers for the '5614 reexamination proceeding, submitted by E-TEK Dynamics, Inc., was received on July 6, 2000[1].

8. A Change of Address of the third party requester was received, via facsimile transmission, on September 29, 2000.[2]

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[1]Since all three reexamination proceedings are for the same U.S. Patent RE35,575, the correspondence address of the patent owner for all three proceedings will be the address of Michael J. Mallie.

[2]Since the address of the third party requester has been changed, the patent owner is reminded that all future correspondence relating these reexamination proceedings must be served

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 '5613 and '5614 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.

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on the third party requester at the address indicated on the first page of this decision.

CONCLUSION

Reexamination Control Nos. '5613, '5614 and '5758 are merged. The reexamination files are being forwarded to the examiner for preparing a first Office action.

Henry Thau for

Janice A. Falcone, Group Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
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Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,614	01/19/00	RE35575	003705.P046R

MM41/0103

MICHAEL J. MALLIE
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN
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SEVENTH FLOOR
LOS ANGELES CA 90025-1026

EXAMINER
ULLAH, A

ART UNIT	PAPER NUMBER
2874	7

DATE MAILED: 01/03/01

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Commissioner of Patents and Trademarks

90005614 - 20010103

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Paper No. 7

Michael J. Mallie (For Patent Owner)
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George A. Quadrino (For Third Party Requester)
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Washington, D.C. 20036-3307

In re Jing-Jong Pan :
Reexamination Proceeding :
Control No. 90/005,613 :
Filed: January 19, 2000 :
For U.S. Patent No. RE35,575 : DECISION MERGING
: REEXAMINATION
: PROCEEDINGS

In re Jing-Jong Pan :
Reexamination Proceeding :
Control No. 90/005,614 :
Filed: January 19, 2000 :
For U.S. Patent No. RE35,575 :

In re Jing-Jong Pan :
Reexamination Proceeding :
Control No. 90/005,758 :
Filed: June 23, 2000 :
For U.S. Patent No. RE35,575 :

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. RE35,575 was issued on July 29, 1997. RE35,575 is a reissue patent of Patent No. 5,208,876

2. Reexamination Control No. 90/005,613 and Reexamination Control No. 90/005,614 were requested by the patent owner on January 19, 2000.

3. Reexamination was ordered in both the '5613 reexamination proceeding and the '5614 reexamination proceeding on April 5, 2000.

4. Reexamination Control No. 90/005,758 was requested by a third party requester on June 23, 2000.

5. Reexamination was ordered in the '5758 reexamination proceeding on September 5, 2000.

6. No statement by the patent owner was received in the '5613 reexamination proceeding, in the '5614 reexamination proceeding, or in the '5758 reexamination proceeding.

7. A Power of Attorney by Assignee and Revocation of Previous Powers for the '5614 reexamination proceeding, submitted by E-TEK Dynamics, Inc., was received on July 6, 2000[1].

8. A Change of Address of the third party requester was received, via facsimile transmission, on September 29, 2000.[2]

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[1]Since all three reexamination proceedings are for the same U.S. Patent RE35,575, the correspondence address of the patent owner for all three proceedings will be the address of Michael J. Mallie.

[2]Since the address of the third party requester has been changed, the patent owner is reminded that all future correspondence relating these reexamination proceedings must be served

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 '5613 and '5614 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.

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on the third party requester at the address indicated on the first page of this decision.

CONCLUSION

Reexamination Control Nos. '5613, '5614 and '5758 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

Page 4 of 4 - 90/005,758

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
WASHINGTON, D.C. 20231
www.uspto.go

Paper No. 21

MAILED
JAN 17 2003

Jonathan O. Owens
Haverstock & Owens
162 North Wolfe Road
Sunnyvale, California 94086

FOR OWNER

In re Reexamination of:
U.S. Patent No. 5,978,807
Reexamination Control No. 90/005,622
Filed: March 3, 2000
For: APPARATUS FOR AND METHOD OF AUTOMATICALLY DOWNLOADING AND STORING INTERNET PAGES

DECISION GRANTING REQUEST FOR REISSUANCE OF OFFICE ACTION

This communication is in response to the Request for Reissuance of Office action filed January 15, 2003.

The petition is **GRANTED**.

An Office action setting a 2 month period for response was mailed on September 23, 2002. As of January 13, 2003 no response had been matched to the file. The undersigned then called Jonathan Owens to ascertain whether any response had been filed. As a result of that conversation it was determined that Patent Owner did not receive the correspondence because it was mailed to an outdated address.

Patent Owner filed the instant petition with proof that a change of correspondence address, to customer no. 28960, was filed for Patent No. 5,978,807 on January 17, ***2002***. Office records indicate that this change of address was duly recorded. However, no separate change of address was filed or entered for the reexamination proceeding.

37 C.F.R. § 1.33(c) states in relevant part:

> All notices, official letters, and other communications for the patent owner or owners in a reexamination proceeding will be directed to the attorney or agent ***of record*** (see § 1.34(b)) ***in the patent file*** at the address listed on the register of patent attorneys and agents maintained pursuant to § § 10.5 and 10.11 ...

The record establishes that the Office communication of September 23, 2002 was mailed to an improper address of record *after* the filing of the Change of Address. Accordingly, the petition is **GRANTED**.

The newly submitted correspondence address has now been recorded in the PALM system and on the file wrapper. It is strongly recommended that future address changes be specifically filed in the reexamination file as there is no administrative procedure in place to link the change of address in a patent file with an ongoing reexamination proceeding.

The Office action of September 23, 2002 will be remailed to the appropriate address with the two month Period for response restarted to run from the date of the remailing. **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

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
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,626	02/01/00	4476168	914.1145

IM52/0213

THOMAS J. DURLING AT SEIDEL
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EXAMINER	
BAHTA, A	
ART UNIT	PAPER NUMBER
1775	11

DATE MAILED: 02/13/01

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

Commissioner of Patents and Trademarks

PTO-90C (Rev. 2/95)
1- File Copy
U S G P O 2000 ; 465-188/25266

UNITED STATES PATENT and TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND
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WASHINGTON, D.C. 20231
WWW.USPTO.GOV

Mailed:

Paper No. 11
WAK

In reexamination of:
Ryuji Aoyama : DECISION
Serial No. 90/005,626 : ON
Filed: February 1, 2000 : PETITION
For: ARTIFICIAL FLOWER-FORMING RIBBON

This decision involves the applicants' Petition Requesting the Restarting of the Reply Period Pursuant to MPEP 710.06, filed January 16, 2001. An Office Action bearing a mail date of November 11, 2000 was received by patentee's counsel on January 13, 2001. The postmark on the corresponding envelop shows a mail date of January 10,2001. The applicants have requested that the time for response be reset.

The Petition is **GRANTED.**

Pursuant to MPEP § 710.06, the period for reply is reset to run from the date of receipt for the Office Action. The period for reply in this case would be reset to January 13, 2001.

Richard V. Fisher

Richard V. Fisher, Director
Technology Center 1700
Chemical and Materials Engineering

Mr. Thomas J. Durling
SEIDEL, GONDA, LAVORGNA & MONACO, P.C.
1800 Two Penn Center Plaza
Philadelphia, PA 19102

UNITED STATES PATENT AND TRADEMARK OFFICE
UNDER SECRETARY OF COMMERCE FOR
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AND TRADEMARK OFFICE
Washington, D.C. 20231

#9
Cmas 11/

William C. Cray (For Patent Owner)
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Laguna Beach, CA 92651

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

DO NOT ENTER

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

MAILED
NOV 0 6 2000
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.

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.

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

c:\kiva\kenpet3\5592merg.y2k
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

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.

90005592,90005628,90006541

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 one month 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

DOCKET ALARM

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
Dickens-Soeder 2000 LLC
3892 Cedron Street
Irvine, CA 92606

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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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

UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFI
WASHINGTON, D.C. 2023
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Paper No. 39

Bruce Dickens
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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
Technology Center 2100
Computer Architecture, Software, and Information Security
(703) 306-4160

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DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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#19/9 EAW 4/6/6

SEP - 9 2001

Paper No. 19/9

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DECISION MAILED

In re Robert Bigler et al.
Reexamination Proceeding
Control No. 90/005,639
Filed: February 17, 2000
For U.S. Patent No. 5,912,541

In re Robert Bigler et al.
Reexamination Proceeding
Control No. 90/005,936
Filed: February 21, 2001
For U.S. Patent No. 5,912,541

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above-identified reexamination files are before the Director of Examining Group 2830, Technology Center 2800, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 5,912,541 issued on November 10, 1992.

2. Reexamination Control No. 90/005,639 was filed by a third party requester on February 17, 2000.

3. Reexamination was ordered in the '639 reexamination proceeding on April 25, 2000.

4. An amendment was filed on June 21, 2000 which amended claim 26 and canceled claim 29.

5. A non-final Office Action was mailed on September 27, 2000.

6. A second amendment was filed on January 26, 2001 which amended column 2 of the specification and added new claims 36-100.

7. Reexamination Control No. 90/005,936 was filed by the same third party requester on February 21, 2001.

8. Reexamination was ordered in the '936 reexamination proceeding on April 24, 2001.

Do Not Enter

DISCUSSION

Under 37 C.F.R. § 1.565(c):

> If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* reexamination has not been terminated, the *ex parte* reexamination proceedings will be consolidated and result in the issuance of a single certificate 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

In accordance with 37 C.F.R. § 1.565(c), the '639 and '936 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

I. Requirements for Same Amendments in Both Proceedings

As noted above, the claims and specification have been amended in the '639 reexamination proceeding. A patent owner is required to maintain the same claims and specification in both files. A 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 ~~less than~~ under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

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

Reexamination Control Nos. '639 and '936 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.

Stewart J. Levy, Group Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

DO NOT ENTER

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.
90/005,913	01/22/01	4849267	REEX-101

027682 IM22/0824
J. MICHAEL MARTINEZ DE ANDINO ESQ.
HUNTON & WILLIAMS
RIVERFRONT PLAZA, EAST TOWER
951 EAST BYRD ST.
RICHMOND VA 23219-4074

EXAMINER	
SINGH, A	
ART UNIT	PAPER NUMBER
1771	17

DATE MAILED: 08/24/01

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

Commissioner of Patents and Trademarks

Reexamination Merger Letter
90/005,640
90/005,913

REEXAM
MPEP 2283

J. Michael Martinez de Andino Hunton & Williams Riverfront Plaza, East Tower 951 East Byrd Street Richmond, VA 23219-4074	:	(for Patent Owner)
Barry I. Hollander Hollander Law Firm, P.L.C. Suite 305 10300 Eaton Place Fairfax, VA 22030	:	(for Third Party)
In re Ward et al Reexamination Proceeding Control No. 90/005,640 Filed: February 18, 2000 For: U.S. Patent No. 4,849,267	:	**DECISION MERGING REEXAMINATION PROCEEDINGS**
In re Ward et al Reexamination Proceeding Control No. 90/005,913 Filed: January 22, 2001 For: U.S. Patent No. 4,849,267	:	

The above noted reexamination files are before the Director of Technology Center 1700 for consideration of the merger of the proceedings under 37 C.F.R. 1.565(c).

BACKGROUND

1. United States Patent 4,849,267, issued July 18, 1989, is the subject of Reexamination Control Nos. 90/005,640 and 90/005,913.

2. A first request for reexamination, assigned Reexamination Control No. 90/005,640 ('640), was filed February 18, 2000 by Barry Hollander of Hollander Law Firm, P.L.C., Suite 305, 10300 Eaton Place, Fairfax, VA 22030. The request urged that a substantial new question of patentability was raised by the teachings

of (a) U.S. patent 4,617,210; (b) U.S. patent 4,617,210, in combination with U.S. patent 3,704,197 and/or U.S. patent 3,922,464; (c) U.S. patent 4,617,210 in combination with the June 1983 Henry® 630 adhesive article and/or Henry® Flooring Adhesives Specification Guide and (d) U.S. patent 4,617,210, in combination with U.S. patent 3,014,829.

3. Reexamination was ordered for '640 on May 25, 2000.

4. A first Office action for '640 was mailed on September 22, 2000 and contained (a) the rejection of claims 1-4, 7, 10 and 11 under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 4,617,210 in view of U.S. patent Re. 24,906; (b) the rejection of claims 1-4 and 7-11 under 35 U.S.C. as being unpatentable over U.S. patent 3,704,197; and (c) the rejection of claims 1-4 and 7-11 under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 3,704,197, in view of U.S. patent 3,922,464. The patentability of claims 5, 6 and 12-19 was confirmed.

5. Patent owner responded to the first Office action on December 8, 2000. A one month extension of time to respond to the first Office action was approved on November 17, 2000.

6. A "Notice of Intent to Issue Reexamination Certificate" was mailed December 28, 2000 confirming the patentability of claims 1-19. A "Statement of Reasons for Patentability and/or Confirmation" was attached thereto, which set forth the examiner's reasons for patentability of the claims over the prior art of record.

7. Patent owner responded to the "Notice of Intent to Issue Reexamination Certificate" by submitting a "Request for Clarification of Discrepancy in the Record" on January 3, 2001.

8. A "Reexamination Interview Summary Form" was mailed on January 31, 2001 in which the record was clarified.

9. A second request for reexamination, assigned Reexamination Control No. 90/005,913 ('913), was filed January 22, 2001 by Barry Hollander of Hollander Law Firm, P.L.C., Suite 305, 10300 Eaton Place, Fairfax, VA 22030. The request urged that a substantial new question of patentability was raised by the teachings of (a) U.S. patent 4,617,210, in combination with U.S. patent 4,284,681; (b) U.S. patent 4,617,210, in combination with U.S. patent 4,284,681 and U.S. patent 3,704,197 and/or U.S. patent 3,922,464; (c) U.S. patent 4,617,210, in combination with U.S. patent 4,284,681 and the1983 Henry® 630 adhesive article and/or the Henry® Flooring Adhesives Specification Guide; (d) U.S. patent 4,617,210, in combination with U.S. patent 4,284,681 and U.S. patent 3,014,829.

10. Reexamination was ordered for '913 on March 28, 2001.

DISCUSSION

Under 37 C.F.R. 1.565(c):

> If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* proceeding has not been terminated, the *ex parte* 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 each of the above reexamination proceedings. Accordingly, merger of the proceedings under 37 C.F.R. 1.565(c) is appropriate. MPEP 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 90/005,640 and 90/005,913 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. REQUIREMENTS FOR THE 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 2283, "Merger of Reexaminations".

III. CONDUCT OF MERGED PROCEEDING

The "Notice of Intent to Issue Reexamination Certificate" mailed December 28, 2000 is hereby withdrawn and the files shall be forwarded to the examiner for consideration of the prior art, statements and evidence presented in the second Request for Reexamination.

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 Reexamination Control No. 90/005,640 and No. 90/005,913 as:

J. Michael Martinez de Andino, Esq.
HUNTON & WILLIAMS
Riverfront Plaza, East Tower
951 East Byrd Street
Richmond, VA 23219-4074

CONCLUSION

Reexamination Control Nos. 90/005,640 and 90/005,913 are merged. An Office action will be issued in due course.

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.
907[illegible]	[illegible]	5761648	[illegible]

TM11/1206

THOMAS G SCAVONE ESQ & MICHAEL P MAZZA E
NIRO SCAVONE HALLER AND NIRO
181 WEST MADISON STREET SUITE 4600
CHICAGO IL 60602

EXAMINER
POINVIL[illegible]

ART UNIT	PAPER NUMBER
2184	8

DATE MAILED: 12/06/00

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. 2000; 465-188/25266
1- File Copy

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 8

Thomas G. Scavone Esq. and Michael P. Mazza Esq. Niro Scavone Haller and Niro 181 West Madison Street Chicago, Illinois 60602	)	FOR OWNER
Harold N. Wells Esq. Jenkens & Gilchrist PC 1455 Ross Avenue, Suite 3200 Dallas, Texas 75202-2799	)	FOR FIRST THIRD PARTY REQUESTER
Catalina Marketing International, Inc. c/o Harold N. Wells Esq. Jenkens & Gilchrist PC 321 North Clark Street, Suite 800 Chicago, Illinois 60610-4714	)	FOR SECOND THIRD PARTY REQUESTER
In re Golden et al. Reexamination Proceeding Control No. 90/005,641 Filed: February 18, 2000 For: U.S. Patent No. 5,761,648	)	DECISION SUA SPONTE, MERGING REEXAMINATION PROCEEDINGS
In re Golden et al. Reexamination Proceeding Control No. 90/005,773 Filed: July 17, 2000 For: U.S. Patent No. 5,761,648	)	

Undelivered Mail

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. 5,761,648 issued on June 2, 1998.

2. A first request for reexamination, Control No. 90/005,641 ('641) was filed by the Third Party Requester on February 18, 2000.

3. Reexamination was ordered in the '641 reexamination proceeding on May 2, 2000.

4. A second request for reexamination, Control No. 90/005,773 ('773) was filed by the Third Party Requester on July 17, 2000.

5. Reexamination was ordered in the '773 reexamination proceeding on September 20, 2000.

6. An Interview was held on November 28, 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 '641 and '773 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 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.

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.

John J. Love, Director
Technology Center 2100
Computer Architecture, Software, and Electronic Commerce

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

AUG 18 2000

William F. Kolakowski III
Dykema Gossett PLLC
Suite 300
39577 North Woodward Avenue
Bloomfield Hills, MI 48304-2820

Neill P. Young et al.
Reexamination Control No. 90/005,646
Filed: February 25, 2000
For: MODEL TRAIN CONTROLLER FOR REVERSING UNIT

DECISION ON PETITION FOR THE ACCEPTANCE OF LATE PAPERS

This is in reply to petitioner's communication filed August 10, 2000 which 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 the Patent Owner's Statement submitted by the patent owner in response to the Order granting reexamination of May 5, 2000, was apparently never received by the Office. The patent owner has submitted a copy of the Patent Owner's Statement along with a copy of the post card receipt having a date stamp of June 30, 2000. This is acceptable evidence of a timely filing of the Patent Owner's Statement.

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 communication from the patent owner filed June 30, 2000.

Gerald Goldberg Director
Patent Technology Center 3600
(703) 308-1134
Facsimile No.: (703) 308-2177

SM/SM: 8/13/00
SM

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	02/28/00	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, D.C. 20005-0944

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

90005647.050300

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
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Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,652	02/29/00	5575925	

IM62/1013

WILLIAM F. WESTERMAN
ARMTRONG, WESTERMAN, HATTORI, MCLELAND &
1725 K STREET, N.W.
SUITE 1000
WASHINGTON DC 20006

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
WWW.USPTO.GOV

CST

Mailed: Paper Number ___

William F. Westerman
Armstrong, Westerman, Hattori, McLeland & Naughton
1725 K Street, NW
Suite 1000
Washington, DC 20006 : (for Patent Owner)

Scott A. Schaffer
Marger Johnson & McCollom
1030 SW Morrison Street
Portland, OR 97205 : (for Third Party)

John D. Gugliotta
Law Offices of John D. Gugliotta
202 Delaware Building
137 South Main Street
Akron, OH 44308 : (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 : **DECISION MERGING REEXAMINATION PROCEEDINGS**

In re Logue, Jr.
Reexamination Proceeding
Control No. 90/005,652
Filed: February 29, 2000
For: U.S. Patent No. 5,575,925

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

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

#9

HAMILTON BROOK SMITH AND
REYNOLDS, P.C.
TWO MILITIA DR
LEXINGTON , MA 02421-4799

DECISION ON PETITION

28 JUN 2000

In re Kuo et al
Reexamination Proceeding
Control No.: 90/005,655
Filed: February 29, 2000
For: U.S.Patent No. 6,013,679

This decision is in response to Patent Owner's petition under 37 CFR 1.515(c), filed June 2, 2000, seeking review of the examiner's Order Denying the Reexamination Request, mailed May 12, 2000.

Requester argues in the petition that the examiner should not have denied the Request for Reexamination based on the teachings of Example 19 of Burns et al, US 5,527,893.

A review of the request for reexamination shows that Patent Owner identified the Burns et al '893 reference as not having been considered during the prosecution of the patent and that it might raise a substantial new question of patentability under 35 U.S.C. 102 with respect to claim 1. Patent Owner's explanation of the reference as it relates to the claims of the patent is one short paragraph in length and fails to identify any specific portion of the reference being relied upon. It is also noted that the parent of Burns et al, '893, was of record in the prosecution of the application. This reference, US 5,017,229, is generally duplicative of the '893 patent through Example 18. The examiner's denial of the request for reexamination clearly states that Example 18 is the closest example to claim 1 of the patent for which reexamination is being requested. Because of the similarity of the two references through Example 18, it is possible that the examiner inadvertently reviewed the wrong reference in making a decision denying reexamination. It is only with Patent Owner's petition and identification of Example 19, added in the '893 reference, that the examiner is directed to the portion of the reference which is closest to claim 1 of the patent for which reexamination is requested. Based on the now identified portions of the '893 reference it is agreed that a substantial new question of patentability which has not previously been decided is raised by the Burns et al '893 reference.

Third Party Requester's petition for reconsideration of the examiner's denial of reexamination has been considered. The petition is **GRANTED**. In accordance with this order for reexamination Patent Owner is given TWO MONTHS from the mailing date of this decision within which to provide a statement, 37 CFR 1.530(b). (Extensions of time are governed by 37 CFR 1.550(c).)

John Kittle
Director, Technology Center 1600/2900

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.
90/005,659	03/02/00	5945214	

IM22/1103

Howard N Flaxman Esq
Aquilino Welsh and Flaxman
2341 Jefferson Davis Highway Suite 112
Arlington VA 22202

EXAMINER
TURNER,A

ART UNIT	PAPER NUMBER
1775	9

DATE MAILED: 11/03/00

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

Commissioner of Patents and Trademarks

PTO-90C (Rev. 2/95)
1- File Copy
U S G P O 2000, 465-188/25266

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Mailed: Paper Number 9

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(for Patent Owner)

In re Ma et al
Reexamination Proceeding
Control No. 90/005,659
Filed: March 2, 2000
For: U.S. Patent No. 5,945,659

DECISION ON REQUEST TO RESTART PERIOD

This is a decision on the RESPONSE, filed October 24, 2000, requesting restart of the period for response to the first Office action of September 13, 2000 since the Office action was not received at the correspondence address until October 16, 2000.

DECISION

Pursuant to MPEP 710.06, the patent owners request is accepted as a petition under 37 C.F.R. 1.181 (no fee) to restart the period for response. A review of the petitioner's request reveals that the criteria for restarting the period for response have been met. Additionally, the time period of ONE month to respond set in the Office action of September 13, 2000 does not comply with the requirements set forth in MPEP 2263. A review of the application record reveal no litigation search or other evidence indicating that the instant reexamination was filed at the direction of a court or that there is litigation that has been stayed pending the results of this reexamination. Accordingly, the period for response should have been set at **TWO** months from the date of the Office action of September 13, 2000.

The petition is **GRANTED**. The period for response to the Office action of September 13, 2000 is reset to expire **TWO** months from the date of receipt at the correspondence address, i.e., period expires December 16, 2000.

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.
90/005,660	03/02/00	5968596	

IM22/1030

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EXAMINER	
TURNER, A	
ART UNIT	PAPER NUMBER
1775	9

DATE MAILED: 10/30/00

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

Commissioner of Patents and Trademarks

90005660 20001030

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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Mailed: Paper Number 9

In re application of	:	
Muyuan M. Ma et al.	:	DECISION ON PETITION
Reexam No. 90/005,660	:	TO RESTART PERIOD FOR
Filed: October 19, 1999	:	RESPONSE TO OFFICE
For: DIBORIDE COATED PRESSING SURFACES FOR ABRASION RESISTANT LAMINATE AND MAKING PRESSING SURFACES	:	ACTION
U.S. Patent No. 5,968,596	:	

The Patent Owner filed a response on October 24, 2000 requesting that the period for response to the Office Action of September 13, 2000 be restarted. This response is being treated as a Petition to Restart Period for Response to Office Action. In particular, the Patent Owner requests that the period for response to the Office Action be reset to run from October 16, 2000. The Office Action has a mail date of September 13, 2000 but was not received by the Patent Owner until October 16, 2000.

The Petition is **GRANTED**.

The Petition meets the requirement for resetting the response time set forth in MPEP 710.06 and 1160 O.G. 14 (March 1, 1994). The Petition was filed on October 24, 2000, within two weeks of the actual date of receipt of the Office Action on October 16, 2000. A substantial portion of the response time had elapsed since the Patent Owner did not receive the Office Action until after it was due. Specifically, the Patent Owner's response was due one month after the original mail date of September 13, 2000, i.e., October 13, 2000. The Petition includes evidence showing the date of receipt of the PTO action at the correspondence address, as well as a statement setting forth the date of receipt of the PTO action at the correspondence address and explaining how the evidence being presented establishes the date of receipt of the PTO action at the correspondence address.

It is additionally noted that the Office Action of September 13, 2000 erroneously set the shortened statutory period for response to expire 1 month from the mailing date. As set forth in MPEP 2263, a shortened statutory period of 2 MONTHS will be set for response to reexamination Office Actions, except where the reexamination results from a court order or litigation is stayed for purposes of reexamination, in which case the shortened statutory period will be set at 1 month. Currently, there is no evidence in the reexamination file that this reexamination resulted from a court order or litigation which was stayed for purposes of reexamination. Thus, the Office Action should have set the shortened statutory period for response to expire 2 MONTHS from the mailing date of the September 13, 2000 Office Action.

Accordingly, the Petition is granted and the shortened statutory period for response is being set at 2 MONTHS from receipt of the September 13, 2000 Office Action. Accordingly, the Patent Owner has two months from October 16, 2000 to respond to the Office Action. The Patent Owner's response therefore is due on **December 16, 2000**.

Jerome W. Massie, Director (Acting)
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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

AUG 18 2000

Paper No. 11

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: For Patent Owner

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: For Requester

In re Reexamination
Control No. 90/005,667
U.S. Patent No. 6,010,156
Issued: January 4, 2000
Patent Owner: CoStar Corporation
Request Filed: March 3, 2000
Requester: Seiko Instruments USA, Inc.

: DECISION ON PETITION

DO NOT ENTER

Summary

This is a decision on the Petition for Review of Denial of Reexamination Request filed on June 23, 2000. The petition is denied.

Background

As originally filed on March 3, 2000, this reexamination request contained an allegation by Requester that a substantial new question of patentability existed with respect to United States Patent No. 6,010,156 ("the '156 patent") based in whole or in part on United States Patent No. 5,801,944 ("the '944 patent"), as well as either the "CoStar User Manual for LabelWriter XL Printer" ("CoStar") or United States Patent No. 5,501,393 ("the '393 patent"). Requester pointed out that the '944 patent did not appear on the list of "References Cited" on the cover sheet of the '156 patent and so was not cited or of record during the prosecution of the '156 patent. Requester took the position that even if the '944 patent was of record during the prosecution of the '156 patent, the relevance of the '944 patent to the patentability of the claims of the '156 patent was not discussed in accordance with the "Guidelines for Reexamination of Cases in View of *In re Portola Packaging, Inc.*, 110 F.3d 786, 42 USPQ2d 1954 (Fed. Cir. 1997)" (hereinafter "the Portola Guidelines"). Requester also took the position that CoStar, although cited during the

prosecution of the application which matured into the '156 patent, was not discussed in accordance with the Portola Guidelines. Requester stated that the '393 patent was both cited and applied during prosecution of the '156 patent.

The question of whether or not the reexamination request raised a substantial new question of patentability with respect to the patentability of the claims of the '156 patent was brought to the attention of the Group Director, as required by the Portola Guidelines. See the Portola Guidelines, endnote 9 (64 Fed. Reg. at 15349; 1223 OG at 127). In turn, the undersigned delegated the responsibility for issuing an Order either granting or denying the request for reexamination to the Special Program Examiner for Patent Examining Groups 3710 and 3720.

In an Order dated May 25, 2000, the Special Program Examiner denied the request for reexamination. Reexamination was denied because the Special Program Examiner found that the '944 patent and CoStar were each in fact cited and of record during the prosecution of the '156 patent. The Special Program Examiner further found that the relevance of both the '944 patent and CoStar to the patentability of the claims of the '156 patent was discussed in a manner which precluded the use of these references in order to establish a substantial new question of patentability under 35 U.S.C. 303(a) in accordance with the decision of the Court in the *Portola* case, as construed in the Portola Guidelines, unless these references were considered together with a prior art reference not barred by the Portola Guidelines. The Special Program Examiner further found that the only other prior art reference relied upon by Requester, the '393 patent, was admitted by Requester to have been cited of record and discussed as to its relevance because it had in fact been applied during the prosecution of the '156 patent. The Special Program Examiner therefore concluded that as CoStar and both of the patents relied upon by Requester had been cited of record and discussed with respect to their relevance to the patentability of the claims of the '156 patent, the request for reexamination did not present a substantial new question of patentability pursuant to 35 U.S.C. 303(a).

Standard of Review

37 C.F.R § 1.515 provides for a review of an Order denying a request for reexamination by petition under 37 C.F.R. § 1.181. As discussed in MPEP 2248, consideration of the petition has been delegated to the Group Director. The review of a decision refusing to order reexamination is to be made *de novo*. In accordance with the requirement for a *de novo* review, prior to formulating this decision, the entire record as contained in the reexamination file and the file of the '156 patent have been considered, together with the specific points presented in the petition.

Overview of Requester's Position

The following general arguments have been presented by Requester to establish that the Special Program Examiner erred in reaching the conclusion that the reexamination request did not raise a substantial new question of patentability:

1. At pages 2-4 of the petition, Requester argues that the Special Program Examiner acted improperly in determining that the '944 patent was cited of record during the prosecution of the '156 patent because this conclusion was not reached on the basis of

the '156 patent file but upon papers submitted by the patent owner and upon an interview between the Special Program Examiner and counsel for Patent Owner during the period following filing of the reexamination request. Requester states that consideration of the papers was improper because:

a. the papers included a forty-seven page non-final ruling issued by a U.S. District Court and did not constitute bare notice of litigation under 37 C.F.R. § 1.565(a) and MPEP 2282;

b. 35 U.S.C. 303(a) , 37 C.F.R. § 1.515(a) and MPEP 2240 prohibit consideration of any input from the Patent Owner prior to issuing an Order to grant or deny reexamination; and

c. 37 C.F.R. § 1.560 and MPEP 2281 preclude interviews prior to the time that reexamination has been ordered.

2. Even presuming that the '944 patent had been cited of record during the prosecution of the '156 patent, the '944 patent was not discussed with sufficient specificity so that the discussion thereof would qualify under the Portola Guidelines because the patent is not mentioned in the examiner's statement of reasons for allowance. Requester argues that the '944 patent was not actually discussed, and so is not precluded as raising a substantial new question of patentability under the Portola Guidelines.

Requester's Statement of the Facts Relied On

In support of these points, Requester has alleged the following facts at pages 4-7 of the petition:

a. In the file of the '156 patent, Paper No. 6, (and its replacement, Paper No. 7 which repeated the rejection of certain claims advanced in Paper No. 6 but modified a restriction requirement advanced in Paper No. 6) were both actions on the merits of the patentability of the claims, and each action included a rejection based upon any of four United States patents.

b. The '944 patent was not one of the four United States patents forming the basis for the rejections set forth in Paper Nos. 6 and 7.

c. Attached to Paper No. 6 was a single page of Notice of References Cited Form PTO-892 marked "Page 1 of 2 ", which listed two of the four patents applied in the rejection, but not listing the other two patents, and not listing the '944 patent.

d. There is no page 2 of the Form PTO-892 in the file.

e. The response to the rejection advanced in Paper No. 6 and repeated in Paper No. 7 did not mention the '944 patent.

f. A new examiner assumed responsibility for the application and in Paper No. 9 summarized an interview concerning cancellation of certain claims as being directed to a non-elected invention.

g. Paper No. 10, the Notice of Allowability includes the following statement of the examiner's reasons for allowance:

> "None of the cited patents used separately or together teach for the design of a computer generated mailing label comprising a perforated strip of segmented self-adhesive labels, said perforations defining a plurality of fields wherein each field comprises a separate address label and a separate postage label to be affixed to an item to be mailed."

h. The '156 patent issued on January 4, 2000 and did not include two of the four patents applied in the rejection of the claims, or the '944 patent, in the listing of the references cited on the cover page of the patent.

Requester's Arguments

From the foregoing facts, Requester makes numerous arguments at pages 7-14 of the petition, which may fairly be summarized as follows:

I. The Special Program Examiner erred in admitting Owner's notice of litigation into the record because it was more than "bare notice" since it contained a Ruling of the Court. Requester argues that the Ruling influenced the Special Program Examiner's position.

II. The decision in the case of *Patlex Corp. v. Mossinghoff*, 771 F.2d 480, 226 USPQ 985 (Fed. Cir. 1985), cited in MPEP 2240, precludes any input from the Patent Owner prior to determination of a request for reexamination unless Patent Owner filed the reexamination request.

III. It was error for the Special Program Examiner to have contacted counsel for Patent Owner during the initial reexamination request review period, citing various sections of the Manual of Patent Examining Procedure.

IV. The '944 patent was not actually discussed within the meaning of the Portola Guidelines, and it was error on the part of the Special Program Examiner to have equated the standard set forth in the Portola Guidelines with the standards established in MPEP 1302.14 for suitable statement by an examiner of reasons for the allowance of a patent application.

Analysis- Form PTO-892 and The Missing "Page 2 of 2"

The appropriate starting point for an analysis of the position asserted by Requester is to again emphasize that the methodology for review required by MPEP 2248 is to undertake a *de novo* review of the entire record. Thus, the question of whether the Special Program Examiner committed error by denying the request for reexamination does not entirely address the question

which must be addressed on a review of this matter *de novo*. The real question to be answered is whether the request for reexamination filed by Requester in fact established that a substantial new question of patentability under 35 U.S.C. 303(a) existed with respect to one or more of the claims of the '156 patent, insofar as "substantial new question of patentability" has been construed in the decision in the *Portola case*, as implemented by the Portola Guidelines.

With this starting point in mind, it makes little difference whether one can argue that reexamination Paper No. 8, filed on May 11, 2000 was or was not "bare notice" of the status of litigation, or whether the Special Program Examiner "erred" in denying the reexamination request because he was "influenced" by the Ruling that formed a part of that paper. The real issue is whether or not the Patent and Trademark Office carried out its statutory obligation pursuant to 35 U.S.C. 303(a), as the statute has been construed by the Court of Appeals for the Federal Circuit in the *Portola* decision, in accordance with the Portola Guidelines. To answer that question, one must consider whether the statute, the Court decisions construing it, and the guidelines promulgated with respect to one of those decisions, would be satisfied if the Office were to undertake to address the question with respect to a facially incomplete or inaccurate patented file. It is the position of the undersigned that nothing in the statute, the Court decisions, or the Guidelines promulgated by the Director of the United States Patent and Trademark Office impose upon the Office a requirement to discharge its duty pursuant to 35 U.S.C. 303(a) based upon a facially incomplete or inaccurate patented file.

Therefore, it is appropriate to first consider facts b-d above as presented by Requester. The record copy of the '156 patent, namely the patented file, shows that a rejection was made on any of four patent references. Yet the Form PTO-892 lists only two of the four references. And that same Form PTO-892 states that it is "Page 1 of 2". "Page 2 of 2" of the form PTO-892 is not in the patented file. However, inspection of the patented file shows that it contains copies of all four of the patent references applied in the rejections set forth in Paper Nos. 6 and 7, and also contains a copy of the '944 patent. What conclusions are most likely? Did the examiner make a mistake by applying two patent references to reject claims without listing them on the reference citation form? Did applicant for patent, faced with receiving a rejection based upon these references without receiving copies of the references or a copy of a listing of the references on a Form PTO-892 take no steps to inquire after the matter, and/or make the record complete? And to compound the situation, did the examiner also just happen to make another mistake by creating a Form PTO-892 comprising "Page 1 of 2" when in reality there was but a single page of the form? Finally, why is there a copy of the '944 patent in the patented file if it was not cited by the applicant or by the examiner? Why does the file of the '156 patent contain copies of all four references applied in the rejections advanced in Paper Nos. 6 and 7, and a copy of the '944 patent?

The answers to these questions appear to be self-evident. The most highly probable answers to these questions, and therefore the answers that are most likely true, are that:

A. The examiner created a Form PTO-892 designated "Page 1 of 2" because there was also created a second page of that form designated "Page 2 of 2".

B. The examiner in fact did not reject claims utilizing two prior art references without listing them on the reference citation form; the references were actually listed on the

"missing" "Page 2 of 2 Pages".

C. The copies of all four patent references actually appear in the patented file of the '156 patent, notwithstanding that only two of them are listed on "Page 1 of 2" of the Form PTO-892, because they were in fact listed on that "missing" "Page 2 of 2".

D. The applicant for patent, now Patent Owner, took no steps to inform the examiner that the applicant was not in receipt of two pages of the Form PTO-892, and/or had received only a single sheet of Form PTO-892 that did not list two of the four references used to reject applicant's claims, and/or did not receive copies of these four references because applicant, now Patent Owner, had in fact received a two page Form PTO-892 which listed all of the applied references on those two pages, and had in fact received copies of all of the references so listed.

E. A copy of the '944 patent appears in the patented file of the '156 patent because it was cited of record during the prosecution of the '156 patent.

In view A-D, the only reasonable conclusion that one can reach **merely from a consideration of the '156 patented file** is that although there is no "Page 2 of 2" of the Form PTO-892 in the file of the '156 patent, one almost certainly existed as part of the attachment to Paper No. 6, and that it listed thereon the two references actually applied to the claims in Paper No. 6 and that it may well have also listed the '944 patent, as copies of the two references and the '944 patent appear in the file. This conclusion rationally explains why the Form PTO-892 that is in the file is styled as "Page 1 of 2", why there are copies of two references in the file not appearing thereon which were applied in the rejection appearing in Paper No. 6, with no question about these references having been raised by Patent Owner. A missing "Page 2 of 2" would explain the failure of these references to have been listed on the face of the printed '156 patent.

In addition, if in fact the examiner had cited the '944 patent during the prosecution of the application resulting in the '156 patent, as seems highly likely from E above, it may well have been listed on that missing "Page 2 of 2" of the Form PTO-892.

Given A-E above and the conclusions drawn therefrom **merely from a consideration of the '156 patented file**, the question then arises whether it was in any way incumbent upon the Office to carry out its statutory mandate under 35 U.S.C. 303(a) and 304 by deciding if the reexamination request presented a substantial new question of patentability based upon a record contained in a patented file that was almost certainly incomplete in the sense that a paper was missing from the file. It is submitted that the answer to this question is "no", and to the extent that the Office could determine that the file of the '156 patent was almost certainly incomplete merely from inspecting the file, it seems that it was incumbent open the Office to determine whether or not the file was actually incomplete or not, and if incomplete, to then determine what the contents of the complete file which was examined and issued as the '156 patent actually were.

Against this, it almost seems to be beside the point to discuss whether or not the Special Program Examiner committed a "clear error" by proceeding as he did. Nevertheless, inspection of Paper No. 8, the "Notice of Litigation" filed by Patent Owner on May 11, 2000, shows that it contains absolutely no discussion by the Patent Owner. It consists only of court papers

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comprising two Rulings on motions and a Submission of a Bond for Preliminary Injunction. Contrary to the conclusion and argument presented by Requester, Paper No. 8 is the epitome of "bare notice" as discussed in MPEP 2282. It includes no argument or information other than the status of certain motions, and the status of these motions must be ascertained by reading the motions themselves. Moreover, the fact that Requester had informed the Office when filing the reexamination request that litigation existed did not relieve Patent Owner of the duty created by 37 C.F.R § 1.565(a) to file Paper No. 8 since MPEP 2282 clearly states that both the existence of, *and results of*, the litigation should be furnished to the Office. (emphasis added.) Admitting Paper No. 8 into the record was entirely proper pursuant to both 37 C.F.R.§ 1.565(a) and MPEP 2282.

In addition, it is clear from a reading of the Order Denying Request for Reexamination, Paper No. 9, that the Special Program Examiner did not rely on the Ruling in Paper No. 8 as the basis of any conclusion reached in the Order. See page 5, last paragraph of Paper No. 9. The Ruling, which was "required reading" insofar as it could inform someone of the status of the litigation only if it were read, merely informed the Special Program Examiner of the existence of a document in possession of the Patent Owner. That document would surely address the issue of whether a "Page 2 of 2" of Form PTO-892 actually existed, and the Office could then know with absolute certainty what the record of the '156 patented file truly was, without regard for how the Court had ruled on the motions before it. In addition, the question of whether the '944 patent was cited of record during prosecution of the application which matured into the '156 patent, a question fundamental to the discharge of the Office's duty under 35 U.S.C. 303(a), could be answered definitively. Again this answer would be supplied regardless of how the Court had ruled in the papers submitted as by Patent Owner as Paper No. 8.

It is not surprising that the Special Program Examiner therefore requested that counsel for Patent Owner furnish a copy of "Page 2 of 2" of Form PTO-892 as attached to Paper No. 6, if in fact such a thing existed as seemed to be implied from a reading of Paper No. 8. Contrary to the arguments of Requester, this was not an improper interview; MPEP 2281 clearly states that interviews "will *ordinarily*" not be had prior to the first office action..." (emphasis supplied) except to discuss amendments that will make the claims allowable. Here, although Paper No. 9 characterizes the contact as an "interview", no discussion of any kind on the merits of the request took place. See Paper No. 9, page 1, fourth paragraph. Even assuming, *arguendo*, that the contact between Patent Owner and the Special Program Examiner could be characterized as "improper" under MPEP 2282, 37 C.F.R. § 1.565(a) itself merely precludes interviews prior to the first official action to discuss the patentability of patent claims. The record does not show that any discussion on the merits of the patentability of any claims was had, or that there was any discussion of the merits of the request for reexamination. The sole discussion appears to have been whether Patent Owner could submit a copy of "Page 2 of 2" of the Form PTO-892. To the extent that the Special Program Examiner's action in contacting Patent Owner was permissible pursuant to 37 C.F.R. § 1.565(a), it is regarded as being *de minimis* that it may have technically violated MPEP 2281. It is a hornbook principle, requiring no citation of authority, to point out that the regulations control over the Manual insofar as they may be inconsistent.

As the primary consideration of arriving at a correct conclusion under 35 U.S.C. 303(a) requires, of necessity, that the Office have a complete and accurate copy of the patented file of the patent for which reexamination is being requested, as a consideration of the file of the '156 patent

shows hat the file of the '156 patent was in fact incomplete, and as the Office became informed of the availability of the existence of a paper which could show whether the file was in fact complete, and could supply the missing material if it were not, it appears to the undersigned that it was entirely proper to ask for, receive and consider the missing material. Given that a copy of the missing "Page 2 of 2" of the Form PTO-892 that was attached to Paper No. 7 of the '156 patent file is now located within the file of the reexamination proceeding, upon *de novo* review of that material, it is clear that the '944 patent was in fact cited of record during the prosecution of the '156 patent. The absence of the '944 patent from the list of references considered that appears on the printed version of the '156 patent does not indicate that the '944 was not considered, because it appears that the reason that the '944 patent was not so listed is that a paper was lost from the application file prior to the printing of the '156 patent. Consideration of the complete file of the '156 patent shows that the '944 patent was in fact cited of record therein.

Analysis - "Discussion of the Relevance" of the '944 Patent and CoStar Under the Portola Guidelines

Even though it is clear, as discussed above, that the '944 was cited of record during the prosecution of the '156 patent, and that the CoStar patent which appears on the face of the printed '156 patent was also cited during the prosecution of the '156 patent, it is still necessary to consider whether the examiner did more than merely "cite" these references. This follows from the fact that the Portola Guidelines state:

> "If prior art was not relied upon to reject a claim, but was cited in the record of a prior related PTO proceeding, and its relevance to the patentability of any claim was actually discussed on the record,[7] the PTO will not order or conduct reexamination based only on such prior art." (64 Fed. Reg. at 15348; 1223 OG at 126.)

The Portola Guidelines direct PTO personnel to:

> "Deny the reexamination request if the decision to order reexamination would be based only on prior art that was, in a prior related PTO proceeding, (a) relied upon to reject any claim, **and/or** (b) cited and its relevance to patentability of any claim discussed.[9]" (64 Fed. Reg. at 15348; 1223 OG at 126.) (emphasis supplied.)

Endnotes 7 and 9, appearing at page 15349 of 64 Federal Register and at page 127 of Volume 1223 of the Official Gazette, read:

> "7. The relevance of the prior art to patentability may be discussed by either the applicant, patentee, examiner, or any third party. However, 37 C.F.R. 1.2 requires that all PTO business be transacted in writing. Thus, the PTO cannot presume that a prior art reference was previously relied upon to reject or discussed in a prior PTO proceeding if there is no basis in the written record to so conclude other than the examiner's initials or a check mark on a PTO 1449 form, or equivalent, submitted with an information disclosure statement. Thus, any discussion of prior art must appear on the record of a prior related PTO proceeding. Examples of generalized statements in a prior related PTO proceeding that would not preclude reexamination include statements that prior art is 'cited to show the state of the art,' 'cited to show the background of the invention,' or 'cited of interest.'"

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

Neither the '944 patent nor CoStar were used in the rejection of any claim in a prior proceeding in the Office. However, Paper No. 10 of the '156 patented file is a Notice of Allowance dated August 2, 1999. Attached thereto is a Notice of Allowability, which in turn has attached thereto an examiner's statement of reasons for allowance of the application. That statement reads as follows:

"The following is an examiner's statement of reasons for allowance:

None of the cited patents used separately or together teach for the design of a computer generated mailing label comprising a perforated strip of segmented self-adhesive labels, said perforations defining a plurality of fields wherein each field comprises a separate address label and a separate postage label to be affixed to an item to be mailed."

The Portola Guidelines themselves do not further define any test for determining whether, with respect to any reference, "its relevance to patentability of any claim" was "discussed".

The Special Program Examiner drew an analogy between the "discussion" referred to in the Portola Guidelines, and an examiner's statement of reasons for allowance which appeared as part of Paper No. 10 in the file of the '156 patent. The Special Program Examiner held that the statement in Paper No. 10 was a proper statement under MPEP 1302.14, which discusses such statements in the context of the examination of pending patent application because when compared to the examples of proper statements in MPEP 1302.14 the statement was clearly proper. The Special Program Examiner then held that the statement was not a "generalized statement" as discussed in endnote 7, and was therefore a statement which was sufficient to constitute a discussion of the relevance of the references to the patentability of a claim for purposes of endnote 7. (See Order Granting/ Denying Request for Reexamination dated May 25, 2000, Paper No. 9, page 5, last two paragraphs).

As previously noted, Requester argues that the Special Program Examiner erred in his analysis of this issue. Specifically, Requester argues that there is no support for using the guidelines of an examiner's statement of reasons for allowance as a test of the sufficiency of a "discussion" of a reference for purposes of the Portola Guidelines. At pages 11-13 of the petition, Requester emphasizes the wording of the Portola Guidelines which includes the phrase "*its* relevance", which Requester construes to mean "the relevance of '*a*' prior art reference". (emphasis in the petition). Requester also notes that MPEP 2242 adds the adjective "specific" to modify the language of the Portola Guidelines so as to mandate that "...any *specific* discussion of the prior art must appear on the record of a related PTO proceeding".

The problem with the arguments presented by Requester on this issue is that there is no support for Requester's premise that the examiner's statement of reasons for allowance is a "generalized statement" because it is all inclusive in the sense of not calling out each cited reference by name.

Only if that premise is granted does it follow that the Portola Guidelines would exclude the above quoted examiner's statement of reasons for allowance as being a "generalized statement" of the sort mentioned in endnote 7 because it does not discuss the relevance of "a" prior art reference. In other words, Requester would require that for purposes of "barring" a reference from raising a substantial new question of patentability under the Portola Guidelines, a prior Office proceeding must include a discussion of the relevance of a plurality of prior art documents that names each individual prior art document by name, even if the reason why the examiner the examiner held the claims to be patentability over all of the prior art documents is identical for each prior art document. There is simply no support for holding that the Portola Guidelines and MPEP 2242 include such a requirement expressly, or mandate it implicitly.

A review of MPEP 1302.14 shows the high importance which the Office places on an examiner's statement of reasons for allowance during the prosecution of an application for patent which has resulted in the allowance of the application. Almost three full pages are devoted thereto, complete with examples of acceptable and unacceptable statements. The acceptable statements in no way require the calling out by name of each prior art reference of record in the application file at the time of allowance. Indeed many examples of acceptable statements do not "name" any prior art reference of record, while one example that is deemed to be unacceptable does specifically name a prior art reference. The conclusion that one reaches from reading MPEP 1302.14 is that the key to an acceptable statement of reasons for allowance is the specificity with which it states the manner in which the claimed invention defines over the prior art of record. Where the terminology "prior art" obviously includes all prior art of record without each piece of prior art of record being individually named, a reasons for allowance statement can simply use that terminology. Acceptable statements of reasons for allowance also do not have to include multiple reasons for allowing the claims, each with respect to an individual cited reference of record.

There is simply no reason known to the undersigned for supposing that an examiner's statement of reasons for allowance which expressly states that none of the prior art teaches a particular specifically identified claimed limitation is somehow not a "specific" discussion of why the claims are patentable for purposes of the Portola Guidelines merely because the statement lumps a plurality of prior art references together under the phrase "none of the prior art" rather than naming each of the prior art references separately. In this regard, attention is invited to MPEP 2287 which instructs that a statement of "reasons for patentability" must be provided in every reexamination proceeding that results in a reexamination certificate confirming the patentability of a patent claim and/or holding that an amended patent claim or newly added claim is patentable. MPEP 2287 then refers to MPEP 1302.14 for purposes of understanding what such a statement is to include. It does not seem logical to suppose that one would instruct an examiner to prepare a reasons for allowance statement in a reexamination proceeding that would be acceptable pursuant to MPEP 1302.14, yet would intend that a statement of reasons for allowance prepared in accordance with the instructions and examples in MPEP 1302.14 would be unsatisfactory or deficient under the Portola Guidelines.

It is clear from a *de novo* review of the examiner's statement of reasons for allowance in Paper No. 10 of the '156 patented file that the examiner's statement of reasons for allowance expressly reflects the examiner's consideration of each and every prior patent cited of record during the prosecution of the application which matured into the '156 patent. Further, the examiner's

statement states specific reasons why the allowed claims were deemed patentable over these prior patents. It is therefore precisely the type of discussion of the relevance of the patents cited of record which is contemplated by the Portola Guidelines as meaning that those patents cannot, by themselves, raise a substantial new question of patentability within the meaning of the holding in the *Portola* decision. It is also apparent upon *de novo* review that while the statement of reasons for allowance in Paper No. 10 of the '156 patented file reads "[N]one of the cited patents...", that the examiner intended to include the non-patent publications cited of record as well as the cited patents within the above quoted phrase from the examiner's statement of reasons for allowance. Given the specificity of the examiner's statement with respect to those limitations held to be lacking in the patents of record, it would be absurd to hold that if the specifically discussed limitations of the allowable claims of the '156 patent were in fact taught in the non-patent publications but not in the prior art patents, that the examiner would have allowed the application without also discussing why the allowable claims contained a limitation or limitations not taught by the non-patent publications.

Decision

If the Office is to carry out its statutory obligation pursuant to 35 USC 301 *et seq*, it is apparent that it is necessary to have before the personnel charged with reviewing a request for reexamination a complete and accurate file of the patent that is the subject of the reexamination request. Viewed from the perspective of whether the Special Program Examiner committed clear error in his treatment of the reexamination proceeding leading to his Order denying the request for reexamination, it is apparent to the undersigned that no meaningful or prejudicial error was committed. The Special Program Examiner became aware of the possibility that the patented file was incomplete, and that this in turn implied that the printed copy of the '156 did not accurately reflect the prior art cited of record during the prosecution of the '156 patent. Given the decision in the *Portola* case, and the procedures dictated in the Portola Guidelines, the Special Program Examiner took certain steps to resolve the issue of the completeness of the file of the '156 patent. Having determined that the file was not complete, and having further determined that it was missing a particular paper, and having further determined the contents of that paper, the Special Program Examiner was then in a position to discharge the duties imposed upon the Office under the Reexamination Statutes, the case law and the practice related thereto. This is not error, and is not seen as prejudicial to either party to the reexamination proceedings.

Viewed from the perspective that the review of the present petition is required to be *de novo*, it is clear that the record now definitively shows that both the '944 patent and CoStar were in fact among the prior art documents cited of record during the prosecution of the application which matured into the '156 patent. To hold otherwise would be against the interests of justice with respect to both parties to the reexamination proceeding, since it cannot be in the interest of justice for a reexamination proceeding to be ordered based upon an incomplete or inaccurate patented file.

It is further clear that the '944 patent and CoStar were in fact discussed on the record as to their relevance to the patentability of the claims of the '156 patent during the examination thereof in such a way as to become prior art documents that are incapable, by themselves, of raising a substantial new question of patentability in accordance with the decision in the *Portola* case and the Portola Guidelines.

As the reexamination request relies upon but a single additional prior art document, the '393 patent, and as that document was also clearly cited of record and discussed as to its relevance to the patentability of the claims in the '156 patent during the examination thereof, the reexamination request presented no patent or printed publication which raised a substantial new question of patentability, *In re Portola Packaging, Inc.*, 110 F.3rd 786, 42 USPQ2d 1295 (Fed. Cir.), *reh'g in banc denied*, 122 F.3rd1473, 44 USPQ2d 1060 (1997).

This decision is final and is not appealable. 37 CFR § 1.515(c). No further communication on this matter will be acknowledged or considered.

PETITION DENIED.

E. Rollins-Cross, Director, Patent
Examining Groups 3710 and 3720

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CENTRAL REEXAMINATION UNIT

RANDALL B. BATEMAN
P.O. BOX 1319
SALT LAKE CITY, UT 84110-1319

In re Application of
Brant Monson
Control No. 90/005,673 (U.S. Patent 5,826,463)
Filed: March 9, 2000
Attorney Docket No. 0162.BMON.RE

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 August 11, 2008.

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 Randall Bateman on behalf of all attorneys of record. All attorneys/agents have been withdrawn.

Applicant is reminded that there is no attorney of record at this time.

All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

There is no outstanding Office action that requires a reply from the applicant.

Telephone inquiries concerning this decision should be directed to Denise Boyd at 571-272-0992.

Denise L. Boyd

cc: **Brant Monson**
3875 North Cove Drive
Provo, UT 84604

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/005,675	03/13/2000	5826394		2137

7590 09/17/2004

FULWIDER PATTON LEE & UTECHT, LLP
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LOS ANGELES, CA 90045

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/17/2004

430

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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Paper No.

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Los Angeles, CA 90045

(For Patent Owner)

Edward W. Callan
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San Diego, CA 92130

(For Requester)

In re Barton, et al.
Reexamination Proceeding
Control No. 90/005,675
Filed: March 13, 2000
For: U.S. Patent No. 5,826,394

DECISION DISMISSING PETITION

This is a decision on the September 26, 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 $650.00 pursuant to 37 C.F.R. § 1.17(m) for the petition under 37 C.F.R. § 1.137(b) was paid by check.

The petition for revival under 37 C.F.R. § 1.137(b) based upon unintentional delay 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)(II)(C) and (D).

The instant petition is accompanied by the petition fee, as well as a proposed response to the non-final Office action of July 14, 2003.

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 instant petition lacks item (3) above.

The petition includes a detailed explanation for the delay in filing the response to the non-final Office action of July 14, 2003, and expresses the intent to file the response by September 23, 2003. This statement contained in the present petition varies from the language required by 37 C.F.R. § 1.137(b)(3), and is insufficient to meet the requirements of 37 C.F.R. § 1.137(b)(3).

With regard to item (1), although a response to the outstanding non-final Office action was filed on September 26, 2003, note

that this paper is not in compliance with 37 C.F.R. § 1.530. Specifically, the amendment is **not** in compliance with 37 C.F.R. § 1.530, because the amendment does not show **all deletions being made with bracketing with regard to the original patent text** of the specification and claims. **Any and all text being deleted from the original patent must be shown in brackets. Any and all text being added to the original patent must be completely underlined, i.e., any new claims should be completely underlined. Note that there should be no strike-outs in a reexamination amendment, and there should be no deletions shown in newly added claims since they are completely new to the original patent.** Note that the manner of making amendments in applications set forth in 37 C.F.R. § 1.121 does not apply to reexamination proceedings, as stated in 37 CFR § 1.121(i). Therefore, this amendment should be re-submitted in the format required by 37 C.F.R. § 1.530.

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, and should include 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.

3. An appropriate amendment in compliance with 37 C.F.R. § 1.530 should be submitted along with any renewed petition.

4. The reexamination file will be stored in the Central Reexam Unit (CRU) for one month to await any such renewed petition. If no such renewed petition is timely received, the reexamination file will be forwarded to Technology Center 3600 for termination of the proceeding, and issuance of the Notice of Intent to Issue Reexamination Certificate (NIRC).

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

By mail: Assistant Commissioner for Patents
Box DAC
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (703) 305-1013 (until 9/27/04)
(571) 273-0100 (after 9/29/04)
Attn: Office of Patent Legal Administration

6. Telephone inquiries with regard to this decision should be directed to the undersigned at (703) 308-0255.

Lynn M. Kryza
Senior Patent Special Projects Advisor
Office of Patent Legal Administration

September 15, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/005,675	03/13/2000	5826394		2137

7590 04/14/2005

EXAMINER	

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ART UNIT	PAPER NUMBER

DATE MAILED: 04/14/2005

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 32

Ellsworth R. Roston, Esq. (For Patent Owner)
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Howard Hughes Center
6060 Center Drive, 10th Floor
Los Angeles, CA 90045

Edward W. Callan (For Requester)
3830 Valley Centre Drive
No. 705 PMB 452
San Diego, CA 92130

In re Barton, et al.
Reexamination Proceeding
Control No. 90/005,675
Filed: March 13, 2000
For: U.S. Patent No. 5,826,394

DECISION GRANTING PETITION

This is a decision on the October 8, 2004, patent owner renewed 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 pursuant to 37 C.F.R. § 1.17(m) for the petition under 37 C.F.R. § 1.137(b) was paid with the previous 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)(II)(C) and (D).

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 instant petition includes a statement that the "entire delay in filing the amendment, between the date of September 15, 2003 (the last date set for filing the amendment in the USPTO), and the date of filing the amendment on or before October 8, 2004 and (b) the renewed petition to revive under 37 CFR 1.137(b) in the USPTO was unintentional." The statement contained in the petition varies from the language required by 37 C.F.R. § 1.137(b)(3); however, the statement contained in the 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 petition fee was paid with the previous petition. The renewed petition is accompanied by a response to the outstanding non-final rejection, which meets the criteria of 37 C.F.R. § 1.137(b)(1).

In view of the above, the renewed 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 3600 for consideration of the response to the outstanding non-final rejection, and preparation of the next Office action.

3. Any inquiries with regard to the merits of this proceeding should be directed to Primary Examiner Robert Canfield, of Group Art Unit 3635.

4. Any telephone inquiries with regard 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 14, 2005

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.
90/005,677	03/15/00	4733665	3006-946

QM31/1003

J P Milnamow Esq
Dressler Rockey Milnamow and Katz Ltd
Two Prudential Plaza
180 N Stetson Avenue Ste 4700
Chicago IL 60601

EXAMINER	
THALER, M	

ART UNIT	PAPER NUMBER
3731	

DATE MAILED: 10/03/00

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Commissioner of Patents and Trademarks

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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

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	:	

DO NOT ENTER

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
Two Prudential Plaza
180 Stetson Avenue, Suite 4700
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(For Patent Owner)

Spiro Bereveskos, Esq.
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Moriarty, & McNett
Bank One Center/Tower,
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Indianopolis, IN 46204

(For Requestor)

#7 (mail)

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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WASHINGTON, D.C. 20231
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Paper No. 7

LARSON & TAYLOR (For Patent Owner)
1199 N. Fairfax Street
Suite 900
Alexandria, VA 22314

Enclosure: Third party requester petition papers of 8/22/01

Dillis V. Allen (For Requester)
1080 Nerge Road
Suite 205
Elk Grove Village, IL 60007

MAILED
AUG 24 2001
REEXAM UNIT

In re Garofalo
Reexamination Proceeding
Control No. 90/005,678
Filed: March 15, 2000
For: U.S. Patent No. 5,465,517

DECISION DISMISSING PETITION & RETURNING IMPROPER PAPER

This is a decision on the August 22, 2001, (originally filed March 5, 2001) third party requester PETITION UNDER 37 C.F.R. § 1.181(a)(3) and § 1.182, to invoke the supervisory authority of the Commissioner, requesting review of the Notice of Intent to Issue Reexamination Certificate (NIRC) of January 16, 2001, which confirmed all of the claims of U.S. Patent No. 5,465,517, to Garofalo. The petition is before the Office of Patent Legal Administration for decision.

The petition is **dismissed** and is being forwarded to the patent owner for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 5,465,517 issued to Garofalo on November 14, 1995.

2. A third party request for reexamination of the '517 patent was filed on March 15, 2000, and was assigned control No. 90/005,678.

3. Reexamination was ordered on June 6, 2000.

4. No patent owner's statement under 37 C.F.R. § 1.530 was filed.

5. On January 16, 2001, a Notice of Intent to Issue Reexamination Certificate (NIRC) was mailed for the reexamination proceeding.

6. The reexamination certificate issued on April 24, 2001, confirming the patentability of all claims of the '517 patent.

7. A courtesy copy of the present third party requester petition, that was originally filed March 5, 2001, but not yet matched with the file, was received on August 22, 2001. The petition under 37 C.F.R. § 1.181(a)(3) and § 1.182, to invoke the supervisory authority of the Commissioner requests a review of the NIRC of January 16, 2001.

Application/Control Number: 90/005,678

DECISION

With regard to the third party requester's petition of August 22, 2001, 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 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 third party requester petition is not a request for reexamination in compliance with the requirements of 37 C.F.R. § 1.510, and it is not a reply pursuant to 37 C.F.R. § 1.535. Nor does the petition qualify as a prior art statement under 37 C.F.R. § 1.501. Therefore, the third party requester petition of August 22, 2001, is an improper submission under 37 C.F.R. § 1.550(e). As such, the petition is **dismissed** and is being forwarded to the patent owner.

It should additionally be noted that neither the rules nor any provisions of the statute provide 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). In the present instance, at pages 1-3, petitioner raises concerns that the examiner issued the NIRC in error in the '5678 proceeding. These assertions are clearly directed to the merits of the reexamination proceeding, and addressing same 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 patent owner was not included with the instant 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."

Any future communications filed by the third party requester in the present proceeding must include proof of service on the patent owner.

Accordingly, the petition is **dismissed** and it will not be made of record in the reexamination file. While ordinarily the petition would be returned to the third party requester, in this instance

it is being forwarded to the patent owner, since there is no indication that the patent owner 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**, and is being forwarded to the patent owner.

2. A copy of the present decision is being made of record in the present reexamination file.

3. 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

August 24, 2001

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

BRC
Paper no. 16

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SEP 21 2001
GROUP 1100

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(for Patent Owner)

Michael G. Gilman
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Alexandria, VA 22314

(for Requester)

In re Reexamination of
William M. Brander
Reexam Control No. 90/005,684
Filed: March 27, 2000
For: U.S. Pat. No. 5,820,955

DECISION ON MERGING REEXAMINATION PROCEEDINGS

In re Reexamination of
William M. Brander
Reexam Control No. 90/005,920
Filed: February 1, 2001
For: U.S. Pat. No. 5,820,955

Undelivered Mail

BACKGROUND

1. United States Patent No. 5,820,955 issued on October 13, 1998.

2. A first request for reexamination, Control No. 90/005,684 was filed on March 27, 2000 on behalf of the Patent Owner by George M. Thomas, Esq., Thomas, Kayden, Horstemeyer & Risley, LLP, Suite 1500 100 Galleria Parkway N W, Atlanta, GA 30339.

3. Reexamination was ordered for 90/005,684 on June 21, 2000.

4. The Patent Owner filed a Statement in 90/005,684 on August 17, 2000.

5. A first Office Action was mailed November 6, 2000 and contained the following rejections:

(a) a rejection over claims 8, 9 and 14-21 under 35 U.S.C. 102(b) as being anticipated by Caggiano;

(b) a rejection over claims 7 and 10-13 under 35 U.S.C. 103 as being obvious over Caggiano;

(c) a rejection over claims 1-4 under 35 U.S.C. 103 as being obvious over Caggiano in view of Genske et al;

(d) a rejection over claims 7, 23 and 24 under 35 U.S.C. 103 as being obvious over Caggiano in view of Richman et al;

(e) a rejection over claims 1, 8, 9, 14-19 and 22 under 35 U.S.C. 102(b) as being anticipated by Kannankeril;

(f) a rejection over claims 7, 20 and 21 under 35 U.S.C. 103 as being obvious over Kannankeril;

(g) a rejection over claims 1, 3, 4, 8, 9 and 14-22 under 35 U.S.C. 102(b) as being anticipated by Beaver, Jr. et al;

(h) a rejection over claims 6 and 7 under 35 U.S.C. 103 as being obvious over Beaver, Jr. et al; and

(i) a rejection over claims 23 and 24 under 35 U.S.C. 103 as being obvious over Beaver, Jr. et al in view of Richman et al.

The patentability of claim 5 was confirmed.

6. The Patent Owner filed a timely Response on December 6, 2000.

7. A second Office Action was mailed on February 6, 2001 and contained the following rejections:

(a) a rejection over claims 9 and 59-64 under 35 U.S.C 305(a) as enlarging the scope of the claims of the patent being reexamined;

(b) a rejection over claims 9 and 59-64 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification;

(c) a rejection over claims 14-21, 74 and 76 under 35 U.S.C. 102(b) as being anticipated by Caggiano;

(d) a rejection over claims 6, 7, 41, 43, 44, 50, 52 and 53 under 35 U.S.C. 103 as being obvious over Caggiano;

(e) a rejection over claims 1, 3, 4, 25 and 27 under 35 U.S.C. 103 as being obvious over Caggiano in view of Genske et al;

(f) a rejection over claims 10-13, 65 and 67 under 35 U.S.C. 103 as being obvious over Caggiano in view of Gujer;

(g) a rejection over claim 2 under 35 U.S.C. 103 as being obvious over Caggiano in view of Genske et al and in further view of Gujer;

(h) a rejection over claims 7, 23, 24, 50, 52 and 53 under 35 U.S.C. 103 as being obvious over Caggiano in view of Richman et al;

(i) a rejection over claims 1, 14-19, 22, 25, 27, 74 and 76 under 35 U.S.C. 102(b) as being anticipated by Kannankeril;

(j) a rejection over claims 6, 7, 20, 21, 41, 43, 44, 50, 52 and 53 under 35 U.S.C. 103 as being obvious over Kannankeril;

(k) a rejection over claims 7, 23, 24, 50, 52 and 53 under 35 U.S.C. 103 as being obvious over Kannankeril in view of Richman;

(l) a rejection over claims 2, 7, 10, 23, 24, 50, 52, 53, 65 and 67 under 35 U.S.C. 103 as being obvious over Kannankeril in view of Richman and Gujer;

(m) a rejection over claims 1, 4, 14-22, 25, 27, 74 and 76 under 35 U.S.C. 102(b) as being anticipated by Beaver, Jr. et al;

(n) a rejection over claims 6, 7, 41, 43, 44, 50, 52 and 53 under 35 U.S.C. 103 as being obvious over Beaver, Jr. et al;

(o) a rejection over claims 7, 23, 24, 50, 52 and 53 under 35 U.S.C. 103 as being obvious over Beaver, Jr. et al in view of Richman et al;

(p) a rejection over claims 1, 9, 14-19, 21, 22, 25-27, 59-62, 64 and 74-76 under 35 U.S.C. 102(e) as being anticipated by Yeager;

(q) a rejection over claims 3, 4, 6, 7, 28-31, 42-58, 63 and 77-82 under 35 U.S.C. 103 as being obvious over Yeager; and

(r) a rejection over claims 2, 7, 10, 23, 24, 50-58 and 65-73 under 35 U.S.C. 103 as being obvious over Yeager in view of Richman and Gujer.

The patentability of claim 5 was confirmed and added claims 32-40 were allowed.

8. The Patent Owner filed a timely Reponse on March 9, 2001, with a Mailing Certificate of March 6, 2001. Additionally, the Patent Owner filed a Supplemental Respone on April 24, 2001 to reflect a summary of the Interview conducted with the Examiner on April 24, 2001.

9. A second request for reexamination, Control No. 90/005,920, was filed on February 1, 2001 on behalf of a third party requester by Michael G. Gilman, Lowe, Hauptman, Gilman & Berner, LLP, 1700 Diagonal Road Suite 310, Alexandria, VA 22314.

10. Reexamination was ordered for 90/005,920 on April 11, 2001. No Patent Owner's Statement was filed under 37 CFR 1.530. See MPEP 2249.

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 both of the above noted reexamination proceedings. Accordingly, merger of the proceedings under 37 C.F.R 1.565(c) is appropriate. The MPEP 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 90/005,684 and 90/005,920 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. The Patent Owner is given one (1) month from the date of this decision to provide a "housekeeping amendment" to make the claims the same in each file. See MPEP 2283, under "Merger of Reexaminations".

III. CONDUCT OF MERGED PROCEEDING

An Office Action will be issued in due course (after entry of the "housekeeping amendment") which applies to both Reexamination nos. 90/005,684 and 90/005,920. The Order Granting the Reexamination Request in 90/005,920 includes a finding of a substantial new question of patentability with Kannankeril (US '010), Caggiano (US '632), Gujer (US '401), Beaver (US '429), Greminger, Jr. et al (US '578), Power (US '907), Haigh et al (US '654) and Sisson (US '876) taken either alone or in combination.

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 single response, filed in triplicate, each bearing an original signature, for each 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.

Further, since MPEP 2240 states:

> "...If the requester includes in the second or subsequent request prior art which raised a substantial new question in the pending reexamination, reexamination would 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, upon petition by the patent owner under 37 CFR 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..."

Because the earlier reexamination proceeding has already considered the prior art (Kannankeril, Caggiano, Gujer, Beaver and Greminger, Jr. et al) upon which the 90/005,684 reexamination proceeding was granted, the requester is reminded that care should be taken in any subsequently filed reexamination to ensure that a substantial new question is raised by prior art not already of record in order to avoid denial of the reexamination pursuant to MPEP 2240.

Undocketed

CONCLUSION

Reexamination Control Nos. 90/005,684 and 90/005,920 are merged. The Patent Owner is given one (1) month from the date of this decision to provide a "housekeeping amendment" to make the claims the same in each file.

Richard V. Fisher

Richard V. Fisher, Director
Technology Center 1700
Chemical and Materials Engineering

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Paper No. 25

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(For Patent Owner)

Michael G. Gilman
LOWE HAUPTMAN GILMAN & BERNER, LLP
1700 Diagonal Road
Suite 310
Alexandria, VA 22314

(For Requester)

MAILED

NOV 2 6 2002

REEXAM UNIT

In re Brander
Reexamination Proceeding
Control No. 90/005,684
Filed: March 27, 2000
For: U.S. Patent No. 5,820,955

In re Brander
Reexamination Proceeding
Control No. 90/005,920
Filed: February 1, 2001
For: U.S. Patent No. 5,820,955

DECISION DISMISSING PETITION

This is a decision on the October 29, 2002, patent owner petition for entry of belated papers filed under 37 C.F.R. § 1.137(b), based upon unintentional delay in this merged reexamination proceeding. The petition is before the Office of Patent Legal Administration for decision.

The petition fee of $640.00 pursuant to 37 C.F.R. § 1.17(m) for the petition under 37 C.F.R. § 1.137(b) in the merged proceeding

has been charged to deposit account no. 20-0778, as per petitioner's instructions in the supplement to the petition filed November 19, 2002, correcting page 2 of the present petition to authorize that such fee be charged to the above deposit account.

The petition for revival under 37 C.F.R. § 1.137(b) based upon unintentional delay 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 petition fee, as well as a statement, as set forth in items (2) and (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.

The instant petition lack(s) item (1) above. Although a response to the outstanding non-final Office action was filed on April 5, 2002, and another response was filed on September 24, 2002, and a third response was filed with the present petition on October 29, 2002, none of these papers constitute "the required reply" pursuant to 37 C.F.R. § 1.137(b)(1). Specifically, the amendment of April 5, 2002, is improper for reasons of record in the Office communication mailed August 15,2002. Similarly, the amendments of September 24, 2002, and October 29, 2002, are **not** in compliance with 37 CFR § 1.530, as there is no explanation of the support in the original disclosure of the patent for the changes to the claims made by the amendments, as required by 37 CFR § 1.530(e). Also, in the amendment paper of September 24, 2002, the amendment is **not** in compliance with 37 C.F.R. § 1.530(d)(2), as some of the changes are not correctly presented with changes in bracketing and underlining with regard to the original patent text. Specifically, in claim 1, line 9 apparently "and" has been deleted and therefore it should be presented after the semicolon in brackets as -[and]-. Similarly, in claim 6, line 8 the comma should be underlined and in line 9 the semicolon should not be underlined. In claim 7, line 4 "impervious" should be presented as -[imperious] <u>impervious</u>-, as the "v" was missing from the original patent text. Claim 8 is presented as amended, whereas instructions were provided in the amendment of December 6, 2000, that claim 8 is cancelled. Note that in claim 8, line 6 after "liquid", if it is patent owner's intent to cancel "impervious and said second ply is liquid", then such text should appear in brackets. Similarly, in claim 9, line 9 "structural" should be presented as -[structure] <u>structural</u>-. Further, the amendment of October 29, 2002, is also **not** in compliance with 37 C.F.R. § 1.530(d)(2), as some of the changes are not correctly presented with changes in bracketing and underlining with regard to the original patent text. Specifically, in claim 7, line 4 "impervious" should be presented as -[imperious] <u>impervious</u>-, as the "v" was missing from the original patent text. Similarly, in claim 9, line 9 "structural" should be presented as -[structure] <u>structural</u>-.

In view of the above, the petition for the entry of late papers is **<u>not</u>** sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

The petition is **<u>dismissed</u>**.

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. The reexamination file will be stored in the Central Reexam Unit (CRU) for one month to await any such renewed petition. If no such renewed petition is timely received, the reexamination file will be forwarded to Technology Center 1700 for termination of the proceeding, and issuance of the Notice of Intent to Issue Reexamination Certificate (NIRC).

4. 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

5. 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 25, 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

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WASHINGTON, D.C. 20231
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Paper No. 28

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(For Patent Owner)

Michael G. Gilman
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Suite 310
Alexandria, VA 22314

(For Requester)

MAILED

JAN 3 1 2003

REEXAM UNIT

In re Brander
Reexamination Proceeding
Control No. 90/005,684
Filed: March 27, 2000
For: U.S. Patent No. 5,820,955

In re Brander
Reexamination Proceeding
Control No. 90/005,920
Filed: February 1, 2001
For: U.S. Patent No. 5,820,955

DECISION GRANTING PETITION

This is a decision on the December 19, 2002, patent owner renewed 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 $640.00 pursuant to 37 C.F.R. § 1.17(m) for the petition under 37 C.F.R. § 1.137(b) in the merged proceeding was paid with the previous petition of October 29, 2002.

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 previous petition was accompanied by the petition fee, as well as a statement, as set forth in items (2) and (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 previous petition varies from the language required by 37 C.F.R. § 1.137(b)(3); however, the statement contained in the previous 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 outstanding nonfinal Office action of February 28, 2002, has been received. However, the amendment of December 19, 2002, is still **not** in compliance with 37 C.F.R. § 1.530(d)(2), as some of the changes are not correctly presented with changes in bracketing and underlining with regard to the original patent text. Specifically, in claim 1, line 10, the comma should be a semi-colon. In claim 7, line 4 "[imperious] impervious" should be presented as -[imperious] <u>impervious</u>-, note in the instant amendment, impervious is <u>not</u> underlined. In claim 10, line 18 the semi-colon should be underlined. Also, in claim 14, line 12 the semi-colon should be underlined.

However, as a courtesy to patent owner, given the numerous attempts to provide a proper amendment in response to the Office action of February 29, 2002, these changes will be made in red ink (initialed and dated) on the amendment papers of December 19, 2002, so that this petition can be granted and prosecution of this merged reexamination proceeding resumed.

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 3600 for consideration of the response to the final Office action of December 19, 2002.

3. Further inquiries with regard to this reexamination proceeding should be directed to the examiner, Rena Dye, of Group Art Unit 3627.

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

January 31, 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

#37

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OK
SM

Reexamination Control No's. 90/005,684 and 90/005,920

FOR PATENT OWNER:

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FOR REQUESTER:

Michael G. Gilman
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1700 Diagonal Road, Suite 310
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DECISION ON PETITION FOR THE ACCEPTANCE OF LATE PAPERS

MAILED

MAY 25 2004

REEXAM UNIT

This is in reply to petitioner's communication filed December 18, 2003 and supplemented on February 10, 2004 that will be treated as a Petition To Accept Late Filed Papers. There is no fee required for this petition. A Petition for Extension of Time Under 37 CFR 1.550 filed January 8, 2004 will also be treated in this decision.

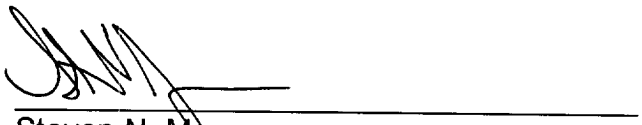
The petition to accept late paper is **GRANTED**.
The petition for extension of time is **DISMISSED as Moot**.

A review of the above reexamination file indicates that a Final Rejection was mailed May 13, 2003. The after-final amendment and the Notice of Appeal with a Certificate of Mailing date of November 10, 2003 submitted by the patent owner in response to the final rejection was apparently never received by the Office. The patent owner has submitted a copy of the after-final amendment and the Notice of Appeal bearing the above-noted Certificate of Mailing dates. In addition, the patent owner has submitted, by facsimile transmission, on February 4, 2004 a statement by Mary N. Kilgore 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 and Notice of Appeal.

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. The Appeal Brief is due 2 months from the date of this decision.

As to the petition for extension of time filed January 8, 2004, in view of the 2 month time period to file the Appeal Brief from the date of this decision, the one month extension requested by the Patent Owner is seen as being moot and the petition is dismissed on that basis.



Steven N. Meyers
Special Programs Examiner,
Technology Center 3600
(703) 308-1020

snm: 2/8/04

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO.
90/005,686	03/28/2000	5856689	0756-2123	6444

7590 12/12/2003

Nixon Peabody LLP
8180 Greensboro Drive Suite 800
McLean, VA 22102

EXAMINER
Ngo

ART UNIT	PAPER NUMBER
2814	19

DATE MAILED: 12/12/2003

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

90005686.121003

PTO-90C (Rev 10/03)

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Paper No. 19

NIXON PEABODY, LLP
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In re Hideomi Suzawa :
Reexamination Proceeding :
Control No. 90/005,686 : DECISION ACCEPTING PAPERS
Filed: May 28, 2000 :
For U.S. Patent No. 5,856,689 :

This is a decision accepting the supplemental amendment, filed December 10, 2003, via facsimile transmission, as being timely filed.

A Notice of Defective Paper in *Ex Parte* Reexamination (Notice) was mailed on June 26, 2003, setting a one month time period or the remaining time period for reply to the last Office action, which ever is longer, to submit an amendment in proper reexamination format.

A telephone call with the patent owner revealed that a response was filed but not associated with the reexamination file. A copy supplemental amendment was filed, via facsimile transmission, as evidence that a response was indeed timely filed. The transmission also includes a copy of a postcard receipt acknowledging that a response to the Notice was received in the US Patent and Trademark Office on July 30, 2003. The response was bears a Certificate of Mailing under 37 C.F.R. § 1.8(a) with a date of deposit of July 28, 2003 (July 26, 2003 was a Saturday).

In view of the evidence of timely submission and receipt of the response and pursuant to the M.P.E.P. § 503 and 37 C.F.R. § 1.8(b), it is hereby determined that a response to the Notice was timely filed and the copy of the response is accepted since the originally submitted response was apparently lost.

The reexamination file is being forwarded to the examiner for further examination.

Henry Thran for

Richard K. Seidel, Group Director
Technology Center 2800
Semiconductors, Optical and Electrical
Systems and Components

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Paper No. 22

Jerome Massie
Nixon Peabody LLP
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Washington, DC 20004-2128

(For Patent Owner)

MAILED

MAY 25 2004

REEXAM UNIT

In re Suzawa
Reexamination Proceeding
Control No. 90/005,686
Filed: March 28, 2000
For: U.S. Patent No. 5,856,689

: DECISION
: GRANTING
: PETITION

This is a decision on the May 17, 2004, patent owner PETITION UNDER 37 C.F.R. 1.181 REQUESTING ENTRY AND CONSIDERATION OF TIMELY FILED PRIOR ART STATEMENT, UNDER 37 C.F.R. 1.501. In view of the relief requested, the petition is taken as a petition under 37 CFR 1.182 which applies to "situations not specifically provided for in the regulations."

The petition is before the Office of Patent Legal Administration for decision.

Pursuant to 37 CFR 1.17(h), the petition fee for a petition under 37 CFR 1.182 is $130.00. This fee has been charged to petitioner's deposit account no. 19-2380, as per the petitioner's instructions in the last paragraph of the present petition.

The petition is granted, and the Notice of Intent to Issue Reexamination Certificate of April 21, 2004 is vacated for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 5,856,689 issued to Hideomi Suzawa, on January 5, 1999.

2. On March 28, 2000, a request for reexamination of the '689 patent was filed by patent owner, and it was assigned Control No. 90/005,686.

3. On June 22, 2000, reexamination was ordered in the '5686 proceeding.

4. Prosecution then advanced to the point where a Notice of Intent to Issue Reexamination Certificate (NIRC) has been issued for the proceeding.

5. On May 17, 2004, the patent owner filed the present petition requesting entry and consideration of the prior art statement (under 37 CFR 1.501) that is attached to the petition.

Application/Control Number: 90/005,686

DECISION

The petition is accompanied by a copy the Patent Owner's date stamped postcard receipt which acknowledges receipt in the U.S. Patent and Trademark Office (the Office) of a "Prior Art Statement Under 37 C.F.R. 1.501" and a "PTO 1449 Form w/8 References" on February 13, 2004. Petitioner also attaches a copy of the prior art statement under 37 CFR 1.501 to which the date stamped postcard receipt is directed.

In view of the date stamped postcard receipt, the prior art statement attached to the present petition is deemed to have been originally filed on February 13, 2004, though it was inadvertently never matched with the file for the instant reexamination proceeding. The reexamination file shows that a Notice of Intent to Issue Reexamination Certificate was mailed on April 21, 2004. Thus, the filing of the prior art statement pre-dated the issuance of the Notice of Intent to Issue Reexamination Certificate. Accordingly, the prior art statement was timely and has a right of entry in the reexamination proceeding.

In view of the above, the Notice of Intent to Issue Reexamination Certificate mailed April 21, 2004 is hereby vacated. The file will be forwarded to the Technology Center, and the prior art statement that accompanied the present petition will be considered.

CONCLUSION

1. The petition is granted.

2. The Notice of Intent to Issue Reexamination Certificate mailed April 21, 2004 is vacated for the purpose of consideration of the prior art statement under 37 CFR 1.501 that accompanied the May 17, 2004, filing of the present petition.

3. The reexamination file is being forwarded to Technology Center 2800 for consideration of the prior art statement.

4. Telephone inquiries related to the present decision should be directed to the undersigned, at 703-308-6710.

PTOL-90A (Rev. 04/03)

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

April 24, 2004
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UNITED STAT PATENT and TRADEMARK OFFICE
UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D C. 20231
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MAILED

Mailed: JUN 29 2000

GROUP 1100

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
(Dma)

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

#26 (mas)

Paper No. 26

Gerard F. Diebner, Esq. (For Patent Owner)
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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
APR 0 5 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
: GRANTING
: 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 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**.

Application/Control Number: 90/005,314
Art Unit: 1724

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

UNITED STAT PATENT 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

MAILED

Mailed: JUN 29 2000

GROUP 1100

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
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#24
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Paper No. 24

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New York, NY 10022

Douglas C. Hochstetler (For Requester)
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233 South Wacker Drive
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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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

#26 (mas)

Paper No. 26

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
APR 0 5 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
: GRANTING
: 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 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**.

Application/Control Number: 90/005,314
Art Unit: 1724

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

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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Jeffrey L. Costellia
Nixon Peabody LLP
401 9th Street, N.W.
Suite 900
Washington, DC 20004-2128

MAILED

MAR 21 2007

CENTRAL REEXAMINATION UNIT

Enclosure: Copy of reexamination certificate that issued for 90/005,691.

In re Yamazaki et al.	:	DECISION
Reexam Control No. 90/005,691	:	PETITION UNDER
Filed: March 31, 2000	:	37 CFR §1.182
Attorney Docket No. 740756-002124	:	

This is a decision on the patent owner's February 6, 2007 "PETITON REQUESTING DUPLICATE LETTERS PATENT PURSUANT TO 37 CFR § 1.182," which requests a duplicate official Reexamination Certificate.

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office.

The petition is **granted to the extent as set forth below.**

BACKGROUND

US Patent No. 5,963,287 to Yamazaki et al. (the '287 patent) issued on October 5, 1999.

On March 31, 2000, petitioner patent owner filed a request for *ex parte* reexamination (assigned reexamination control number 90/005,691).

Reexamination was ordered, and it concluded with the issuance of a Reexamination Certificate on May 20, 2003.

DECISION

A letters patent is not issued at the conclusion of a reexamination proceeding. Rather a reexamination certificate issues. Thus, patent owner's request for a "duplicate letters patent" cannot be granted, as it is stated. However, as an enclosure to this decision, a copy of the reexamination certificate that issued for the 90/005,691 reexamination proceeding is hereby provided to patent owner. The enclosed copy **shall serve as patent owner's official Reexamination Certificate,** with the present decision serving as evidence to that effect.

Therefore, the petition is granted to the extent possible.

CONCLUSION

1. The petition under 37 CFR 1.182 to issue a duplicate letters patent, is **granted to the extent set forth above**.

2. Telephone inquiries with regard to this decision should be directed to Joseph F. Weiss, Jr., Office of Patent Legal Administration, at (571) 272-7759.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

March 16, 2007
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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, DC 20231
www.uspto.gov

#11

John C. Altmiller
Kenyon and Kenyon
1500 K Street NW, Suite 700
Washington DC 20005-1247

(For Patent Owner)

Robert J. Frank, Esq.
Venable
1201 New York Avenue NW, Suite 1000
Washington DC 2005-3917

(For Requester)

Reexam Control No.: 90/005,696
Filed: April 5, 2000
For: U.S. Patent No. 5,275,595

Reexam Control No.: 90/005,900
Filed: January 3, 2001
For: U.S. Patent No. 5,275,595

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. 90/005,696 was ordered in a decision mailed June 29, 2000. Amendments to the specification, abstract, and claims were filed August 29, 2000, December 11, 2000, and December 15, 2000.

Reexamination in application Control No. 90/005,900 was ordered in a decision mailed February 21, 2001.

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

As noted above, the abstract, specification, and claims have been amended in the Reexam Control No. 90/005,696. The patent owner is required to maintain identical specifications, abstract, 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 specification, abstract, and 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 requester and requester will be sent copies of all papers mailed by the Office.

Conclusion

Reexamination Control Nos. 90/005,696 and 90/005,900 are hereby merged. Upon receipt of the required paper placing the same specification, abstract and 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: (703) 308-0873

ak/6/11/01

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.
90/005,697	04/05/00	5758505	11499/2

EXAMINER

QM61/1221

John C Altmiller
Kenyon and Kenyon
1500 K Street N W Suite 700
Washington DC 20005-1247

ART UNIT	PAPER
3744	10

DOERRLER, W

DATE MAILED 12/21/00

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. 10

In re Application of Dobak et al
Appl. No.: 90/005,697
Filed: April 5, 2000
For: PRECOOLING SYSTEM FOR JOULE-THOMSON PROBE

DECISION ON PETITION UNDER 37 CFR 1.59

This is a response to the petition under 37 CFR 1.59(b), filed May 23, 2000, 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 "pages 57-147, 148-233,246-275 and 275-325 of the deposition of Gerald W. Spinks, Esq. Of December 14, 1999, Cite No.152 ("Information")", filed April 5, 2000, 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.

William C. Doerrler
Primary Examiner
TC 3744
December 19, 2000

Office Action in Reexamination	Control No. 90/005,697	Patent Under Reexamination 5758505 ET AL	
	Examiner William C Doerrler	Art Unit 3744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

a☐ Responsive to the communication(s) filed on _____. b☐ This action is made FINAL

c☒ No Statement has been received from the patent owner under 37 CFR 1 530

A shortened statutory period for response to this action is set to expire 1 month(s) from the mailing date of this letter 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 37 CFR 1 550(d). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).** If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION.

1 ☐ Notice of References cited by Examiner, PTO-892

2 ☒ Information Disclosure Statement, PTO-1449

3 ☐ Notice of Patent Drawing Review, PTO-948

4. ☐ _____.

Part II SUMMARY OF ACTION

1a ☒ Claims 1-36 are subject to reexamination.

1b ☐ Claims _____ are not subject to reexamination.

☐ Claims _____ have been canceled.

☒ Claims 2,4,7,11,13,14,17-19,23-29 and 32-36 are patentable and/or confirmed

☒ Claims 1,3,5,6,8-10,12,15,16,20-22,30 and 31 are rejected

☐ Claims _____ are objected to.

☐ The formal drawings, filed on _____ are acceptable

☐ The proposed drawing correction, filed on _____ has been (7a)☐ approved (7b)☐ disapproved

☐ Acknowledgment is made of the priority claim under 35 U.S C. § 119

a)☐ All b)☐ Some c)☐ None of the certified copies have

1☐ been received

2☐ not been received.

3☐ been filed in Application No. _____ .

4☐ been filed in reexamination Control No _____.

5☐ been received by the International Bureau in PCT application No. _____

9 ☐ Since the proceeding appears to be in condition for issuance of a reexamination certificate except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C D 11, 453 O G 213

10 ☐ Other

cc Requester (if third party requester)

DETAILED ACTION

Reexamination

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1,3,5,6,8-10,12,15,16,20-22,30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bard et al in view of the French 1,468,862 patent (reference 60 from the IDS) and the Grokholskii et al article (reference 109) from the IDS.

Bard et al discloses applicants' basic inventive concept, a method and apparatus for cooling a distal cold tip (74) which is part of a primary closed loop (a loop with no

mass exchange from an external component including from the secondary loop) having a compressor (14, 14') a primary heat exchanger (62, 66,70) and a primary expansion element (74); a secondary closed loop having a compressor (12,12') and expansion element (52). The expansion devices isenthalpically expand the flowing fluid in each loop. Bard further discloses heat exchange between the primary and secondary closed loop to cool the primary refrigerant prior to expansion. Bard however does not clearly disclose using a primary/secondary heat exchanger which transfers heat from the primary and secondary refrigerant prior to expansion to the expanded secondary refrigerant (the bypassing of the expanded primary refrigerant around the primary/secondary heat exchanger is not seen as necessary to meet claim unless it is specifically claimed i.e. claim 9), or using a mixed refrigerant in the primary closed loop. Figure 5 of the French patent shows a heat exchanger which exchanges heat from the primary and secondary refrigerants in closed loops prior to expansion to the secondary refrigerant after expansion. This is seen as a combination of Bard et al's heat exchangers 48 and 50. The Grokholskii et al article shows a mixed refrigerant with a compression pressure below 420 psia. Bard at the top of column 10 states that the "invention can be implemented with fluids other than those specified". It would have been obvious to one of ordinary skill in the art at the time of applicants' invention from the teaching of the French '862 patent and the Grokholskii et al article to modify the refrigeration system of Bard et al by consolidating the heat exchangers which exchange heat from the primary and secondary refrigerants prior to expansion with the secondary

refrigerant after expansion to produce a smaller device to improve portability and ease of use and to use a mixed refrigerant with a low working pressure to provide safe and effective refrigeration.

The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a), to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 5,758,505 throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

90005697.111600

Allowable Subject Matter

Claims 2,4,7,11,13,14,17-19,23-29 and 32-36 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C Doerrler whose telephone number is (703) 308-0696. The examiner can normally be reached on Monday-Friday 6:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (703) 308-2111. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7764 for regular communications and (703) 308-7764 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.

WCD
December 12, 2000

William C Doerrler

WILLIAM DOERRLER
PRIMARY EXAMINER

90005697 . 111600

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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MAY - 7 2001

Paper No. 15

John C. Altmiller
Kenyon and Kenyon
1500 K Street NW Suite 700
Washington, DC 20005-1247

(For Patent Owner)

Robert J. Frank, Esq
Venable
1201 New York Avenue, NW
Suite 1000
Washington, D.C. 20005-3917

(For Requester)

In re John D. Dobak, III et al.
Reexamination Proceeding
Control No. 90/005,697
Filed: April 5, 2000
For: U.S. Patent No. 5,758,505

In re John D. Dobak, III et al.
Reexamination Proceeding
Control No. 90/005,901
Filed: January 3, 2001
For: U.S. Patent No. 5,758,505

DECISION, *SUA SPONTE*,
MERGING REEXAMINATION
PROCEEDINGS

The above noted reexamination files are now before the Director of Patent Examining Groups 3740 and 3750 for consideration of merger of the proceedings under 37 CFR § 1.565(c), in accordance with the practice set forth at MPEP § 2283.

I. Merger of Proceedings

As required by the practice pursuant to MPEP § 2283, and under the authority of 37 CFR § 1.565(c), the '697 and '901 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

All future submissions by Owner must be served on Requester of Control No. 90/005,901. The contents of each file will thereafter 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. 15 in both files. There will be no Paper Nos. 7-14 in Control No. 90/005,901.

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. Requester will receive the body of the action, with the appropriate cover sheet, while Owner will receive the body of the action and a copy of each cover sheet. All papers filed by Owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by Owner must consist of a single response, filed in duplicate, each bearing an original signature, for entry in each file. Owner is reminded that every paper filed in the merged proceedings subsequent to this Decision must be served on Requester, even papers filed *via* facsimile transmission.

Since there are no amendments to the specification or claims in Control No. 90/005,697, the reexam files will be forwarded to the examiner for an office action to be mailed in due course. The Primary Examiner should note that each reexamination file must reflect consideration of the identical prior art, and should, therefore, insure that each file reflects identical reference citations.

DECISION

Reexamination Control Nos. 90/005,697 and 90/005,901 are MERGED. Extensions of time are governed by 37 CFR § 1.550(c). The files are being forwarded to the Primary Examiner. Owner must keep the examiner advised as to the status of any presently existing or future litigation involving the patent under reexamination.

Richard Bertsch
Director, Technology Center 3700
Phone: (703) 308-0975
Fax: (703) 305-7764

Electronic Acknowledgement Receipt

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,697	04/05/00	5758505	11499/2

90/005,901 and

QM01/0906

John C Altmiller
Kenyon and Kenyon
1500 K Street N W Suite 700
Washington DC 20005-1247

EXAMINER
DOERRLER, W

ART UNIT	PAPER NUMBER
3744	20

DATE MAILED: 09/06/01

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

Commissioner of Patents and Trademarks

PTO-90C (Rev. 2/95)
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1- File Copy

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Paper No. 20

In re Application of 5758505
Appl. No.: 90/005,697
Filed: April 05, 2000
For: PRECOOLING SYSTEM FOR JOULE-THOMSON PROBE

DECISION ON PETITION UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b), filed May 23, 2000 to expunge information from the above identified application.

The petition is granted.

Petitioner requests that a document entitled pages 57-147, 148-233, 246-275 and 275-375 of the Deposition of Gerald W. Spinks, Esq. of December 14, 1999, Cite No. 152 ("Information") filed April 5, 2000, be expunged from the record. Petitioner states that either: (A) 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.

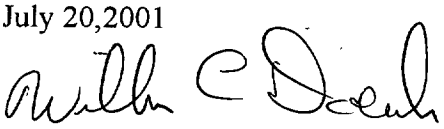
The information in question has been determined by the undersigned to not be material to the examination of the instant application.

Applicant is required to retain the expunged material(s) for the life of any patent which issues on the above-identified application.

The expunged material is returned herewith.

Enclosure: Above listed pages of the Spinks deposition

William C. Doerrler
Primary Examiner
TC 3744
July 20,2001



William C Doerrler

90005697.090501

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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
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#14

SEP 24 2001

John C. Altmiller
Kenyon and Kenyon
1500 K Street NW, Suite 700
Washington DC 20005-1247

(For Patent Owner)

Laurence J. Marhoefer
Venable, Baetjer, Howard & Civiletti, LLP
1201 New York Avenue NW, Suite 1000
Washington DC 2005-3917

(For Requester)

Reexam Control No.: 90/005,698
Filed: April 5, 2000
For: U.S. Patent No. 5,910,104

Reexam Control No.: 90/005,945
Filed: March 2, 2001
For: U.S. Patent No. 5,910,104

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. 90/005,698 was ordered in a decision mailed June 29, 2000. Prosecution progressed through to the filing of an amendment on February 20, 2001.

Reexamination in application Control No. 90/005,945 was ordered in a decision mailed April 23, 2001.

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 requester and requester will be sent copies of all papers mailed by the Office.

Conclusion

Reexamination Control Nos. 90/005,698 and 90/0005,945 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

ak/9/22/01

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
90/005,698 & 90/005,945	4/5/00 & 3/2/01	5,910,104	11499/1

JOHN C. ALTMILLER
KENYON & KENYON
1500 K STREET NW, SUITE 700
WASHINGTON, DC 20005-1247

EXAMINER	
PEFFLEY, M.	
ART UNIT	**PAPER**
3739	15

DATE MAILED: SEP 12 2003

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

Commissioner of Patents and Trademarks

cc: Laurence J. Marhoefer, 3rd party attorney

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O Box1450
Alexandria, VA 22313-1450
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SEP 12 2000

Paper No. 15

In re Application of U.S. Patent No.: 5,910,104
Appl. No.: 90/005,698 & 90/005,945
Filed: April 05, 2000
For: Cryosurgical Probe With Disposable Sheath

DECISION ON PETITION UNDER 37 CFR 1.59

DO NOT ENTER

This is a decision on the petition under 37 CFR 1.59(b), filed May 23, 2000, to expunge information from the above identified application.

The petition is granted.

Petitioner requests that a document consisting of pages 57-147, 148-233, 246-275, and 275-325 of the deposition of Gerald W. Spinks, Esq. Of December 14, 1999, referred to as Cite 181, filed April 5, 2000, be expunged from the record. Petitioner states that 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(h) has been paid.

The information in question has been determined by the undersigned to not be material to the examination of the instant application.

Applicant is required to retain the expunged material(s) for the life of the patent identified above.

The expunged material has been removed from the official file.

Enclosure: Pages 57-147, 148-233, 246-275, and 275-325 of the Deposition of Gerald W. Spinks, Esq. Of December 14, 1999, referred to as Cite 181.

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

ak/9/11/03

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#11 ma

Paper No. 11

Robert R. Sachs (For Patent Owner)
FENWICK & WEST, LLP
Two Palo Alto Square
Palo Alto, CA 94306

Leslie Gladstone Restaino (For Requester)
RIKER DANZIG SCHERER
HYLAND & PERRETTI, LLP
Headquarters Plaza
One Speedwell Avenue
Morristown, NJ 07962-1981

enclosure: Certificate of Correction of 9/7/99

MAILED
AUG 23 2001
REEXAM UNIT

In re Fink, et al.
Reexamination Proceeding
Control No. 90/005,699
Filed: April 5, 2000
For: U.S. Patent No. 5,657,255

DECISION GRANTING PETITION

This is a decision on the June 25, 2000, patent owner PETITION UNDER 37 C.F.R. § 1.182, requesting that a dual power of attorney be recognized in the present reexamination proceeding. The petition is before the Office of Patent Legal Administration for decision.

The petition is **granted.**

DECISION

Petitioner requests in the June 25, 2000, PETITION UNDER 37 C.F.R. § 1.182, that a dual power of attorney be recognized in the present reexamination proceeding. Petitioner explains that two of the four inventors, Fink and Kornman, have assigned their entire right, title and interest in U.S. Patent No. 5,657,255 to Medical Science Systems, Inc., which subsequently changed their name to Interleukin Genetics, Inc. Petitioner indicates that a Power of Attorney relating to the ownership interests of Interleukin Genetics, Inc. was previously filed granting power of attorney to FENWICK & WEST, LLP. Petitioner also explains that the other two of the four inventors, Holtzman and Paterson, have assigned their entire right, title and interest in U.S. Patent No. 5,657,255 to Entelos, Inc. Petitioner indicates that a Power of Attorney relating to the ownership interests of Entelos, Inc. was previously filed granting power of attorney to COOLEY GODWARD, LLP. Petitioner also clarifies that patent owners have requested that the correspondence address be maintained at:

Robert R. Sachs, Esq.
FENWICK & WEST, LLP
Two Palo Alto Square
Palo Alto, CA 94306

Petitioner notes that when the Power of Attorney from Entelos, Inc. to COOLEY GODWARD, LLP was filed on December 6, 2000, in processing such paper, the U.S. Patent & Trademark Office (USPTO) revoked the previous power of attorney to Robert R. Sachs, Esq. of FENWICK & WEST, LLP. Petitioner explains that the original intent in filing the Power of Attorney paper of December 6, 2000, was to add Christopher R. Hutter, Esq. of COOLEY GODWARD, LLP, without removing Robert R. Sachs, Esq. of FENWICK & WEST, LLP. Petitioner indicates that the present petition was filed to resolve any ambiguity arising from the initial filing and to create a dual power of attorney as was originally intended.

The petition is granted. It is noted that a certificate of correction for U.S. Patent No. 5,657,255 had issued on September 7, 1999, which corrected the inventive entity of the patent to add two more inventors, Holtzman and Paterson. A review of the present reexamination file revealed that such certificate of

correction was not included with the copy of the patent filed with the original reexamination request papers. Accordingly, a copy of the certificate of correction has been placed in the reexamination file, as it constitutes a part of the original patent undergoing reexamination, and a copy is being sent to the third party requester along with a copy of this decision. The USPTO records have been corrected to include Robert R. Sachs, Esq. of FENWICK & WEST, LLP, along with Christopher R. Hutter, Esq. of COOLEY GODWARD, LLP, as having power of attorney in the present reexamination proceeding. Any error and/or confusion created in revoking the previous power of attorney to Robert R. Sachs is regretted.

CONCLUSION

1. The petition is **granted**.

2. The reexamination file is being returned to Technology Center 2100 for examiner action.

3. Any further communications as to the merits of the reexamination proceeding should be directed to the examiner, Kyle J. Choi, in Technology Center 2100.

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

August 22, 2001

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MAILED

JAN 10 2002

REEXAM UNIT

Paper No. 17

Robert R. Sachs, Esq.
FENWICK & WEST, LLP
Two Palo Alto Square
Palo Alto, CA 94306

(For Patent Owner)

Peter Tu, Esq.
Director of Intellectual Property
307 College Road East
Physiome Sciences, Inc.
Princeton, NJ 08540

(For Requester)

In re Fink, et al.
Reexamination Proceeding
Control No. 90/005,700
Filed: April 5, 2000
For: U.S. Patent No. 5,808,918

DECISION GRANTING PETITION

This is a decision on the July 19, 2001, patent owner PETITION UNDER 37 C.F.R. § 1.182, requesting that a dual power of attorney be recognized in the present reexamination proceeding. The petition is before the Office of Patent Legal Administration for decision.

The petition is **granted.**

DECISION

Petitioner requests in the July 19, 2001, PETITION UNDER 37 C.F.R. § 1.182, that a dual power of attorney be recognized in the present reexamination proceeding. Petitioner explains that two of the four inventors, Fink and Kornman, have assigned their entire right, title and interest in U.S. Patent No. 5,808,918 to Medical Science Systems, Inc., which subsequently changed their name to Interleukin Genetics, Inc. Petitioner indicates that a Power of Attorney relating to the ownership interests of Interleukin Genetics, Inc. was previously filed granting power of attorney to FENWICK & WEST, LLP. Petitioner also explains that the other two of the four inventors, Holtzman and Paterson, have assigned their entire right, title and interest in U.S. Patent No. 5,808,918 to Entelos, Inc. Petitioner indicates that a Power of Attorney relating to the ownership interests of Entelos, Inc. was previously filed granting power of attorney to COOLEY GODWARD, LLP. Petitioner also clarifies that patent owners have requested that the correspondence address be maintained at:

Robert R. Sachs, Esq.
FENWICK & WEST, LLP
Two Palo Alto Square
Palo Alto, CA 94306

Petitioner notes that when the Power of Attorney from Entelos, Inc. to COOLEY GODWARD, LLP was filed on December 6, 2000, in processing such paper, the U.S. Patent & Trademark Office (USPTO) revoked the previous power of attorney to Robert R. Sachs, Esq. of FENWICK & WEST, LLP. Petitioner explains that the original intent in filing the Power of Attorney paper of December 6, 2000, was to add Christopher R. Hutter, Esq. of COOLEY GODWARD, LLP, without removing Robert R. Sachs, Esq. of FENWICK & WEST, LLP. Petitioner indicates that the present petition was filed to resolve any ambiguity arising from the initial filing and to create a dual power of attorney as was originally intended.

The petition is <u>granted</u>. The USPTO records have been corrected to include Robert R. Sachs, Esq. of FENWICK & WEST, LLP, along with Christopher R. Hutter, Esq. of COOLEY GODWARD, LLP, as having power of attorney in the present reexamination proceeding. Any error and/or confusion created in revoking the previous power of attorney to Robert R. Sachs is regretted.

CONCLUSION

1. The petition is **granted**.

2. The reexamination file is being returned to Technology Center 2100 for examiner action.

3. Any further communications as to the merits of the reexamination proceeding should be directed to the examiner, Kyle J. Choi, in Technology Center 2100.

4. 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

January 10, 2002

90005700.061901

UNITED STATES PATENT AND TRADEMARK OFFICE

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WASHINGTON, D.C. 20231
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#16 (mai)

Paper No. 16

David M. Mundt
COOK ALEX MACFARRON MANZO
CUMMINGS & MEHLER LTD.
200 West Adams suite 2850
Chicago, IL 60606

(For Patent Owner)

MAILED

SEP 14 2001

REEXAM UNIT

In re Bond
Reexamination Proceeding
Control No. 90/005,705
Filed: April 18, 2000
For: U.S. Patent No. 5,341,707

DECISION GRANTING PETITION

This is a decision on the July 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 is **granted**.

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 proposed amendment after final, and the petition fee under 37 C.F.R. § 1.17(m). The examiner has indicated that the proposed amendment after final would be entered upon revival of this reexamination proceeding. In view of the above, the petition is sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

CONCLUSION

1. The petition is **granted**.

2. The reexamination file is being returned to Technology Center 3700 for entry of the proposed amendment after final.

3. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Debra S. Meislin, 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 11, 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.
90/005,706	04/14/00	4903695	2860-0032-25

QM12/0713

James R Boler
Oblon Spivak McClelland Maier and Neusta
Crystal Square Five Fourth Floor
1755 Jefferson Davis Highway
Arlington VA 22202

EXAMINER	
SHAY,D	
ART UNIT	**PAPER NUMBER**
3739	7

DATE MAILED: 07/13/00

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

Commissioner of Patents and Trademarks

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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

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

James R. Boler
Oblon, Spivak, McClelland
Maier, and Neustadt PC (For Patent Owner)
Crystal Square Five
Fourth Floor
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Mark E. Ungerman
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801 Pennsylvania Avenue (For Requestor)
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7
Cmas 11/2

Thomas E. Sisson (For Patent Owner)
MILLER, SISSON, CHAPMAN & NASH PC
300 Convent Suite 1650
San Antonio, TX 78205

Cynthia G. Seal (For Requester)
2925 Briarpark
Suite 930
Houston, TX 77042

DO NOT ENTER

MAILED
NOV 28 2000
REEXAM UNIT

In re reissue application of :
Gipson :
Application No. 09/484,260 :
Filed: January 18, 2000 :
For: U.S. Patent No. 5,839,514 :
:
: **DECISION, SUA SPONTE, TO MERGE REEXAMINATION AND REISSUE PROCEEDINGS**
In re Gipson :
Reexamination Proceeding :
Control No. 90/005,708 :
Filed: April 24, 2000 :
For: U.S. Patent No. 5,839,514 :

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. 5,839,514 issued to Gipson on November 24, 1998.

2. On January 18, 2000, a reissue application was filed and assigned application no. 09/484,260, which cancelled claims 1-3 & 10, amended claims 4-9, and amended the specification on page 8.

3. A notice of the reissue was published in the *Official Gazette* on April 4, 2000.

4. No Office action has been mailed in the reissue application.

5. On April 24, 2000, a request for reexamination of the '514 patent was filed by a third party requester, and was assigned Control No. 90/005,708.

6. On June 16, 2000, reexamination was ordered.

7. No patent owner's statement was filed in response to the order.

DOCKET ALARM

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 cancelled claims 1-3 & 10, amended claims 4-9, and amended the specification on page 8. A review of the reexamination file shows that reexamination was ordered on June 16, 2000, and is awaiting a first Office action. Original patent claims 1-11 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 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 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 above noted reissue application and reexamination proceeding ARE MERGED.

2. The reissue and reexaminations file are being forwarded to the examiner via the Director of Technology Center 3600. 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.

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)308-0255.

Lynn M. Kryza
Special Projects Examiner
Office of Patent Legal Administration

November 28, 2000

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,703	04/28/00	5663484	11378.120USR1

HM11/0920

Pennie and Edmonds LLP
1155 Avenue of the Americas
New York NY 10036-2711

EXAMINER	
NELSON, A	

ART UNIT	PAPER NUMBER
1638	#9

DATE MAILED: 09/20/00

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

Commissioner of Patents and Trademarks

90005703 20000928

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
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Washington, D.C. 20231

#5

PENNIE AND EDMONDS LLP
1155 AVENUE OF THE AMERICAS
NEW YORK , NY 10036-2711

:FOR PATENT OWNER

MERCHANT & GOULD
P. O. BOX 2903
MINNEAPOLIS, MN 55402-0903

:FOR REQUESTER

In re Reexamination Proceeding of
Eugenio S. Sarreal et al
Control No.: 90/005,709
Filed: April 28, 2000
Patent No.: 5,663,484

: PETITION DECISION

This is a decision on the Petition under 35 U.S.C. 133 which is being treated as a petition under 37 CFR 1.181, filed September 11, 2000, to accept a late filed patent owner's statement based on non-receipt of the reexamination order.

A review of the file history shows that the Request for Reexamination was filed on April 28, 2000, by third party Requester represented by Merchant & Gould. The request was processed and an order granting reexamination was mailed to Patent Owner and third party Requester on May 22, 2000. It is noted that the order, by statute, was required to be mailed no later than July 27, 2000, but was mailed more than two months in advance of that date. The order set a two month period for Patent Owner to file a reply to the Order granting reexamination. On August 24, 2000, the examiner in charge of this proceeding contacted Patent Owner's representative to confirm that no statement had been filed. In response, Patent Owner stated they had not received the Order and requested a copy be forwarded to them by facsimile transmission. On September 11, 2000, Patent Owner's representatives filed a statement with confirmation of service on third party Requester on September 8, 2000, and this petition. Accompanying the petition is a statement of examination of the files and of the person responsible for receipt and docketing of incoming mail attesting to the fact that the Order was not received.

The petition is **GRANTED** Patent Owner's statement will be accepted as timely filed.

Third Party Requester's period for filing a reply is set at TWO MONTHS from the date of service of Patent Owner's statement (September 8, 2000). No extension of time is permitted.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Group 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-5408.

Jasemine C. Chambers
Director, Group 1600

00428 0 . 60750005

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

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(mas)

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David R. Crichton (For Requester)
Ciba Specialty Chemicals Corporation
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Tarrytown, NY 10591-9005

MAILED

MAR 21 2001

REEXAM UNIT

In re reissue application of :
Haase :
Serial No. 09/733,392 :
Filed: December 7, 2000 :
For: U.S. Patent No. 5,846,435 :
:
:
In re Haase : **DECISION, SUA SPONTE,**
Reexamination Proceeding : **TO MERGE REEXAMINATION**
Control No. 90/005,710 : **AND REISSUE PROCEEDINGS**
Filed: April 24, 2000 :
For: U.S. Patent No. 5,846,435 :
:

DECISION ON PETITION

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. 5,846,435 issued to Richard A. Haase on December 8, 1998.

2. A request for reexamination of the `435 patent was filed on April 24, 2000, and the resulting reexamination proceeding was assigned Control No. 90/005,710.

3. On June 20, 2000, reexamination was ordered in the `5710 proceeding.

4. A non-final Office action was mailed in the `5710 proceeding on December 4, 2000.

5. On December 7, 2000, patent owner filed a reissue application which was assigned Application No. 09/733,392.

6. A response to the Office action in the `5710 proceeding was filed on February 5, 2001.

7. Notice of the filing of the reissue application was published in the *Official Gazette* on February 13, 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 `5710 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 `5710 reexamination file shows that a response including an amendment to the first Office action was filed on February 5, 2001, by the patent owner. Claims 1 and 15 have been amended in the `5710 reexamination file.

A review of the reissue (Application No. 09/733,392) prosecution history shows that the reissue application was published in the *Official Gazette* on February 13, 2001. Two months from the publication of the present reissue have not yet passed, but once it has, the application will be awaiting a first Office action on the merits by the examiner. In addition to amending patent claims 1-3 and 15, in the reissue application, applicant has submitted new claims 17-19 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 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. 09/733,392, and Control Number 90/005,710. 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. 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).

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. Any such responses must be served on the requester, who will also be sent copies of 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 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 1700. 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** 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 (b) the expiration of the ONE (1) month period from the mailing of this decision for filing the amendment.

   II. The time period for filing a protest in accordance with 37 C.F.R. § 1.176 in the reissue application has expired, i.e., after April 13, 2001, plus time for matching any protest.

5. Telephone inquiries related to this decision should be directed to Lynn M. Kryza at (703) 308-0255.

FILED VIA EFS-WEB

Lynn M. Kryza
Special Projects Examiner
Office of Patent Legal Administration

March 20, 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.
09/733,392	12/07/00	Richard Alan Haase	

PATENT NUMBER	DATE OF THIS NOTICE	PAPER NUMBER
5,846,435	03/21/01	11

NOTICE OF MERGED REEXAM - REISSUE PROCEEDING

This reissue application has been merged with the reexamination proceeding listed below:

Control No. 90/ 005,710 Filing Date: 04/24/00

Requester (name, address) David R. Crichton
Ciba Specialty Chemicals Corporation
540 White Plains Road
PO Box 2005
Tarrytown, NY 10591-5005

The front face of the reissue patent will include the following paragraph:

REEXAMINATION RESULTS

The questions raised in reexamination request No. 90/ 005,710, filed 04/24/00, 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).

JMacaluso
3/7/02

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.
90/005,715	04/28/2000	5335160	0175-26	4644

90/005,719
90/006,130

7590 03/07/2002

Thomas W Cole Esq
Nixon Peabody LLP
8180 Greensboro Drive Suite 800
McLean, VA 22102

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/07/2002

MAR 0 7 2002

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

15/Dec. Merg
Reexam
Proceedings

90005715.083001

90005715.083001

PTO-90C (Rev 07-01)

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)

Lawrence D. Maxwell
NEEDLE & ROSENBERG, P.C.
Suite 1200, The Candler Building
127 Peachtree Street, NE
Atlanta, Georgia 30303-1811

REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/005,719; 90/005,715; 90/006,130

PATENT NO. 5,335,160

ART UNIT 2875

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
United States Patent and Trademark Office
Washington D C 20231
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Paper No. 15/15/6

(For Patent Owner)

Thomas W. Cole
NIXON PEABODY LLP
8180 Greensboro Drive, Suite 800
McClean, Virginia 22102

(For Third Party Requester)

Lawrence D. Maxwell
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In re Paul F. Savoca
Reexamination Proceeding
Control No. 90/005,715
Filed: April 28, 2000
For U.S. Patent No. 5,335,160

In re Paul F. Savoca
Reexamination Proceeding
Control No. 90/005.719
Filed: May 4, 2000
For U.S. Patent No. 5,335,160

In re Paul F. Savoca
Reexamination Proceeding
Control No. 90/006.130
Filed: October 16, 2001
For U.S. Patent No. 5,335,160

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. 5,335,160 issued on August 2, 1994.

2. A first request for reexamination, Control No. 90/005,715, was filed by the patent owner on April 28, 2000.

3. A Preliminary amendment was filed on May 19, 2000, deleting claims 1 and 4, amending claims 2, 3, 5-7 and adding new claim 24.

4. A second request for reexamination, Control No. 90/005,719, was filed by the patent owner on May 4, 2000.

5. A Preliminary amendment was filed on May 19, 2000, deleting claims 1 and 4, amending claims 2, 3, 5-7 and adding new claim 24.

6. Reexamination was ordered in both the '5715 reexamination proceeding and the '5719 reexamination proceeding on July 18, 2000.

7. No statement by the patent owner was received in either of the reexamination proceedings.

8. A decision merging the '5715 and '5719 reexamination proceedings was mailed on October 12, 2000.

9. A non-final Office action was mailed on June 21, 2001, setting a three (3) month time period for response.

10. A personal interview was held on August 30, 2001.

11. An amendment was filed on September 7, 2001, along with a declaration by inventor Paul F. Savoca. Claims 8, 16 and claim 24 were amended and claims 25-49 were added.

12. A third request for reexamination, Control No. 90/006,130, was filed by a third party on

October 16, 2001.

13. Reexamination was ordered in the '6130 reexamination proceeding on December 12, 2001.

14. No Patent owner's statement under 37 C.F.R. § 1.530(b) was received in the '6130 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 all three (3) 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 '5715, '5719 and '6130 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 '5715 and '5719 reexamination proceedings which were previously merged and the claims of the '6130 reexamination proceeding has not been amended. The claims in the '6130 reexamination proceeding are not the

same as the claims in the other two reexamination proceedings. The 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 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 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.'5715, '5719 and '6130 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. Thau

Janice A. Falcone, Group Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/005,715	04/28/2000	5335160	0175-26	4644

90/005,719
90/006,130 7590 10/21/2002

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McLean, VA 22102

EXAMINER
LEE, YQ.

ART UNIT	PAPER NUMBER
2875	#25

DATE MAILED: 10/21/2002

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
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WASHINGTON, D.C 20231
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Paper No. 25

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Atlanta, Georgia 30303-1811

(for requester)

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TECHNOLOGY CENTER 2800
SPECIAL PROGRAM CENTER

In re Paul F. Savoca
Reexamination Proceeding
Control Number 90/005,715
Filed: April 28, 2000
For: U.S. Patent No. 5,335,160

In re Paul F. Savoca
Reexamination Proceeding
Control Number 90/005,719
Filed: May 4, 2000
For: U.S. Patent No. 5,335,160

In re Paul F. Savoca
Reexamination Proceeding
Control Number 90/006,130
Filed: October 16, 2001
For: U.S. Patent No. 5,335,160

DECISION ON REQUEST FOR EXTENSION OF TIME

This is a decision on the petition under 37 C.F.R. § 1.550(a) filed September 20, 2002, for immediate action by the examiner in the above-identified reexamination proceedings.

Patent owner requests that the reexamination proceedings be taken up for action immediately by the examiner pursuant to the "special dispatch" provision of 37 C.F.R. § 1.550(a) and guidelines of MPEP §§ 708.01 and 2261, and that the patent owner be granted an interview during the first week of October for the purpose of resolving the remaining 112 (second paragraph) issue.

The petition is **granted-in-part** and **dismissed-in-part**.

Patent owner contends that U.S. Patent No. 5,335,160 is the subject of ongoing litigation in the Northern District of Florida, Case No. 4:99cv311-SPM, in which the court has now set a trial date of December 16, 2002, with a pre-trial conference scheduled for November 18, 2002. Therefore, patent owner seeks to conclude this merged reexamination proceeding with a decision from the USPTO as soon as possible so as to avoid further delays in the litigation to await the conclusion of the present merged reexamination proceeding.

Pursuant to the "special dispatch" provision of 37 C.F.R. § 1.550(a) and in accordance with MPEP § 2261, the above-identified merged reexamination proceeding will be forwarded to the examiner for prompt issuance of an Office action. Accordingly, the patent owner's request for immediate action is **granted.**

A review of the merged reexamination proceeding reveals that an interview between the examiner of record and the patent owner's representative was conducted on Thursday, October 10, 2002. Accordingly, the patent owner's request for a interview during the first week of October is **dismissed** as being moot.

Patent owner's representative is reminded that all correspondence submitted in this merged reexamination proceeding must be served on the third party requester (37 C.F.R. § 1.550(f)) and must be filed in triplicate in accordance with the decision merging proceedings mailed March 7, 2002. Failure to serve correspondence on the third party requester and/or to submit correspondence in triplicate may result in processing delays.

The reexamination files are being forwarded to the examiner for prompt issuance of an Office action.

Any inquiry concerning this decision should be directed to Edward J. Glick, Special Programs Examiner, at telephone No. (703) 308-4858.

Janice A. Falcone, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/005,715; 90/005,719; 90/005,130

PATENT NO. 5,335,160

ART UNIT 2875

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).

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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Paper No. 36

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Lawrence D. Maxwell (For Third Party Requester)
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Suite 1200, The Candler Building
127 Peachtree Street, NE
Atlanta, Georgia 30303-1811

Enclosure: Copy of patent owner papers filed February 12, 2003, and March 31, 2003.

In re reissue application of :
Paul F. Savoca :
Application No. 10/364,510 :
Filed: February 12, 2003 :
For: U.S. Patent No. 5,335,160 :

In re Paul F. Savoca :
Reexamination Proceeding :
Control No. 90/005,715 :
Filed: April 28, 2000 :
For: U.S. Patent No. 5,335,160 :

In re Paul F. Savoca :
Reexamination Proceeding :
Control No. 90/005,719 :
Filed: May 4, 2000 :
For: U.S. Patent No. 5,335,160 :

In re Paul F. Savoca :
Reexamination Proceeding :
Control No. 90/006,130 :
Filed: October 16, 2001 :
For: U.S. Patent No. 5,335,160 :

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JUN 26 2003
REEXAM UNIT

DECISION GRANTING MERGER OF PROCEEDINGS

This is a decision on the patent owner's request for merger of reissue application serial No. 10/364,510 with the already merged proceeding of reexamination control Nos. 90/005,715, 90/005,719, and 90/006,130. Patent owner's request for merger was filed together with reissue application No. 10/364510 on February 12, 2003, and was supplemented on March 31, 2003.

Patent owner's request papers are taken as a composite **petition** under 37 CFR 1.182 for merger of the reissue application with the already merged reexamination proceeding.[1]

The petition is before the Office of the Patent Legal Administration of the United States Patent and Trademark Office.

The petition under 37 CFR 1.182 for merger is granted.

REVIEW OF FACTS

1. U.S. patent No. 5,335,160 issued on August 2, 1994, with 23 claims.

2. A first request for reexamination, assigned control No. 90/005,715, was filed by the patent owner on April 28, 2000.

3. A second request for reexamination, assigned control No. 90/005,719, was filed by the patent owner on May 4, 2000.

4. A preliminary amendment was filed in the '5715 and '5719 proceedings on May 19, 2000, deleting claims 1 and 4, amending claims 2, 3 and 5-7, and adding new claim 24.

5. Reexamination was ordered for both of the '5715 and '5719 reexamination proceedings on July 18, 2000.

6. A patent owner's statement under 37 CFR 1.530 was not received in either of the '5715 and '5719 proceedings, and a decision merging the '5715 and '5719 proceedings was mailed on October 12, 2000.

7. A non-final Office action was mailed for the merged proceeding on June 21, 2001, and a personal interview was held on August 30, 2001.

8. An amendment was filed on September 7, 2001, along with a declaration by the inventor. Claims 8, 16 and claim 24 were amended, and claims 25-49 were added.

---

[1] It was apparently recognized by patent owner that the papers titled as a "request" for merger were actually directed to a petition, as the supplemental paper of March 31, 2003 makes reference to "the petition fee... for filing the instant petition" as attached in the last paragraph of the supplemental paper.

9. A third request for reexamination, assigned control No. 90/006,130, was filed by a third party requester on October 16, 2001.

10. Reexamination was ordered for the '6130 reexamination proceeding on December 12, 2001.

11. A patent owner's statement under 37 CFR 1.530 was not received in the '6130 reexamination proceeding, and a decision merging the '5715, '5719, and '6130 proceedings was mailed on March 7, 2002.

12. Prosecution in the merged proceeding (for the three reexaminations) progressed to the point where a Notice of Intent to Issue Reexamination Certificate (NIRC) was mailed on February 6, 2003, indicating the status of the claims as:

    Claims 11-15 & 17-23 confirmed.
    Claims 2, 5-10 & 16 amended.
    Claims 1, 3 & 4 canceled.
    New claims 24-49 patentable.

13. On February 12, 2003 (after the NIRC was issued), the patent owner filed reissue application 10/364,510 for reissue of the 5,335,160 patent.

14. Included with the reissue application was a preliminary amendment adding new claims 50-60. In the "Remarks" section of the amendment, it is pointed out that new claims 50-60 are "narrower than the originally issued claims, but broader in some respects than the claims allowed in the merged re-examination proceedings...."

15. Also included with the reissue application was a request for merger of reissue application No. 10/364510 with the already merged proceeding of reexamination control Nos. 90/005,715, 90/005,719, and 90/006,130.

16. On March 31, 2003, patent owner supplemented the initial request for merger and included, pursuant to 37 CFR 1.17(h), the petition fee of $130.00 required for a petition under 37 CFR 1.182. As pointed out above, patent owner's request is being taken as a petition for merger of the reissue application with the merged reexamination proceeding.

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. 10/364,510 and reexamination control Nos. 90/005,715, 90/005,719, and 90/006,130 are currently pending. Since the order to reexamine has been mailed in all three reexamination proceedings, 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 three reexamination proceedings be merged and a joint examination be conducted. Accordingly, Notice of Intent to Issue Reexamination Certificate mailed February 6, 2003, for the merged proceeding of reexamination control Nos. 90/005,715, 90/005,719, and 90/006,130 is being withdrawn, and the examination of the reissue application and the 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 grant of merger is not an assurance that, in a future similar situation, merger would be granted.*

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 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).

2. A review of the reexamination files for the merged proceeding of reexamination control Nos. 90/005,715, 90/005,719, and 90/006,130 shows that original patent claims 11-15 and 17-23 are present, patent claims 1, 3 and 4 are canceled, and patent claims 2, 5-10 and 16 are amended. In addition, new claims 24-49 have been added. A review of reissue application No. 10/364,510 shows that original patent claims 1-23 are present. In addition, new claims 50-60 have been added. **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 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 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.

2. In the event that a 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 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 the reissue application and the reexamination proceedings. Each action will contain identifying data *for all of the cases*, i.e, the reissue application and the three reexamination proceedings, and each action will be physically entered into all four files (which will be maintained as separate files).

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 responses must be served on the requester*, who will also be sent copies of Office actions.

6. 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 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 three reexamination proceedings that will remain merged as one proceeding, 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 as a result of the difference in rules relating to reexamination and reissue proceedings. Thus, 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).

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 three reexamination proceedings that will remain merged as one proceeding. Such examination would be conducted as set forth in the immediately preceding paragraph.

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

three reexamination proceedings that will remain merged as one proceeding.

LACK OF SERVICE

It should be noted that the requisite proof of service [2] of the February 12, 2003, request (for merger) upon Lawrence D. Maxwell, the third party requester in the merged reexamination proceeding, was not included with that request. The March 31, 2003, supplemental request included a Certificate of Service of an "Amendment After Final" on the requester, but not the request for merger.

Since the requisite proof of service on third party requester Maxwell has not been included, a copy of the two patent owner requests is being provided to requester with this decision.

Any future communications filed by the patent owner in the merged reexamination proceeding must include proof of service of the paper **to which the proof is attached** upon the third party requester.

CONCLUSION

1. The petition to merge the reissue and reexamination proceedings is **granted**.

2. The Notice of Intent to Issue Reexamination Certificate mailed February 6, 2003, for the merged proceeding of reexamination control Nos. 90/005,715, 90/005,719, and 90/006,130 is hereby **withdrawn**.

3. Reissue application No. 10/364,510 **is merged** with the already merged proceeding of reexamination control Nos. 90/005,715, 90/005,719, and 90/006,130.

---

[2] Pursuant to 37 CFR 1.550(f) "[a]fter 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."

4. Pursuant to Part II of this decision, a housekeeping amendment is required **within ONE MONTH of this decision,** placing the same amendments in all cases of the present merged proceeding.

5. The reissue and three reexaminations files are being forwarded to the examiner via the Director of Technology Center 2800. Upon receipt of same, the 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 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. All further examination in the merged proceeding should be conducted in accordance with Part III of this decision.

7. 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
Office of Patent Legal Administration

June 23, 2003
C:\KIVA\KENPET4\6130grnt.mrg

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.
10/364,510	02/12/2003	Paul F. Savoca	

PATENT NUMBER	DATE OF THIS NOTICE	PAPER NUMBER
5,335,160	06/26/2003	37

NOTICE OF MERGED REEXAM - REISSUE PROCEEDING

This reissue application has been merged with the reexamination proceeding listed below:

Control No. 90/005,715 Filing Date: 04/28/2000
Control No. 90/005,719 Filing Date: 05/04/2000
Control No. 90/006,130 Filing Date: 10/16/2001

Requester (name, address) Lawrence E. Maxwell
NEEDLE & ROSENBERG, P. C.
Suite 1200, The Candler Building
127 Peachtree Street, NE
Atlanta, GA 30303-1811

The front face of the reissue patent will include the following paragraph:

REEXAMINATION RESULTS

The questions raised in reexamination request No. 90/005,715 90/005,719** 90/006,130**, filed **04/28/2000, 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).

**and filed 05/04/2000 and 10/16/2001, respectively

FORM PTO-1527
(3-84)

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
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Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,719	05/04/00	5335160	0175-26

MM71/1012

THOMAS W COLE
NIXON PEABODY LLP
8180 GREENSBORO DRIVE SUITE 800
MCLEAN VA 22102

EXAMINER	
CARIASO,A	
ART UNIT	**PAPER NUMBER**
2875	

DATE MAILED: 10/12/00

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

Commissioner of Patents and Trademarks

90005719 20001012

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D C 20231
www uspto gov

Paper No. 10

Thomas W. Cole
NIXON PEABODY LLP
8180 Greensboro Drive, Suite 800
McClean, Virginia 22102

In re Paul F. Savoca	:	
Reexamination Proceeding	:	
Control No. 90/005,715	:	
Filed: April 28, 2000	:	
For U.S. Patent No. 5,335,160	:	DECISION MERGING
	:	REEXAMINATION
	:	PROCEEDINGS
In re Paul F. Savoca	:	
Reexamination Proceeding	:	
Control No. 90/005,719	:	
Filed: May 4, 2000	:	
For U.S. Patent No. 5,335,160	:	

DOCKET SEARCH

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. 5,335,160 issued on August 2, 1994.

2. A first request for reexamination, Control No. 90/005,715, was filed by the patent owner on April 28, 2000.

3. A second request for reexamination, Control No. 90/005,719, was filed by the patent owner on May 4, 2000.

4. Reexamination was ordered in both the '5715 reexamination proceeding and the '5719 reexamination proceeding on July 18, 2000.

7. No statement by the patent owner was received in either of the reexamination proceedings.

DOCKET ALARM

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 '5715 and '5719 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

Reexamination Control Nos. '5715 and '5719 are merged. The reexamination files are being forwarded to the examiner for preparing a first Office action.

Henry S. Phan for

Janice A. Falcone, Group Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

JMacaluso
3/7/02

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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.
90/005,715	04/28/2000	5335160	0175-26	4644

90/005,719
90/006,130

7590 03/07/2002

Thomas W Cole Esq
Nixon Peabody LLP
8180 Greensboro Drive Suite 800
McLean, VA 22102

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/07/2002

MAR 0 7 2002

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

15/Dec. Merg
Reexam
Proceedings

90005715.083001

90005715.083001

PTO-90C (Rev 07-01)

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Lawrence D. Maxwell
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Atlanta, Georgia 30303-1811

REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/005,719; 90/005,715; 90/006,130

PATENT NO. 5,335,160

ART UNIT 2875

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
United States Patent and Trademark Office
Washington D C 20231
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Paper No. 15/15/6

(For Patent Owner)

Thomas W. Cole
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(For Third Party Requester)

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In re Paul F. Savoca
Reexamination Proceeding
Control No. 90/005,715
Filed: April 28, 2000
For U.S. Patent No. 5,335,160

In re Paul F. Savoca
Reexamination Proceeding
Control No. 90/005.719
Filed: May 4, 2000
For U.S. Patent No. 5,335,160

In re Paul F. Savoca
Reexamination Proceeding
Control No. 90/006.130
Filed: October 16, 2001
For U.S. Patent No. 5,335,160

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. 5,335,160 issued on August 2, 1994.

2. A first request for reexamination, Control No. 90/005,715, was filed by the patent owner on April 28, 2000.

3. A Preliminary amendment was filed on May 19, 2000, deleting claims 1 and 4, amending claims 2, 3, 5-7 and adding new claim 24.

4. A second request for reexamination, Control No. 90/005,719, was filed by the patent owner on May 4, 2000.

5. A Preliminary amendment was filed on May 19, 2000, deleting claims 1 and 4, amending claims 2, 3, 5-7 and adding new claim 24.

6. Reexamination was ordered in both the '5715 reexamination proceeding and the '5719 reexamination proceeding on July 18, 2000.

7. No statement by the patent owner was received in either of the reexamination proceedings.

8. A decision merging the '5715 and '5719 reexamination proceedings was mailed on October 12, 2000.

9. A non-final Office action was mailed on June 21, 2001, setting a three (3) month time period for response.

10. A personal interview was held on August 30, 2001.

11. An amendment was filed on September 7, 2001, along with a declaration by inventor Paul F. Savoca. Claims 8, 16 and claim 24 were amended and claims 25-49 were added.

12. A third request for reexamination, Control No. 90/006,130, was filed by a third party on

October 16, 2001.

13. Reexamination was ordered in the '6130 reexamination proceeding on December 12, 2001.

14. No Patent owner's statement under 37 C.F.R. § 1.530(b) was received in the '6130 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 all three (3) 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 '5715, '5719 and '6130 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 '5715 and '5719 reexamination proceedings which were previously merged and the claims of the '6130 reexamination proceeding has not been amended. The claims in the '6130 reexamination proceeding are not the

same as the claims in the other two reexamination proceedings. The 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 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 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.'5715, '5719 and '6130 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. Thau

Janice A. Falcone, Group Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/005,715	04/28/2000	5335160	0175-26	4644

90/005,719
90/006,130 7590 10/21/2002

Thomas W Cole Esq
Nixon Peabody LLP
8180 Greensboro Drive Suite 800
McLean, VA 22102

EXAMINER
LEE, YQ.

ART UNIT	PAPER NUMBER
2875	#25

DATE MAILED: 10/21/2002

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. 25

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(for patent owner)

Lawrence D. Maxwell
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Suite 1200, The Candler Building
127 Peachtree Street, NE
Atlanta, Georgia 30303-1811

(for requester)

MAILED

OCT 2 1 2002

TECHNOLOGY CENTER 2800
SPECIAL PROGRAM CENTER

In re Paul F. Savoca
Reexamination Proceeding
Control Number 90/005,715
Filed: April 28, 2000
For: U.S. Patent No. 5,335,160

In re Paul F. Savoca
Reexamination Proceeding
Control Number 90/005,719
Filed: May 4, 2000
For: U.S. Patent No. 5,335,160

In re Paul F. Savoca
Reexamination Proceeding
Control Number 90/006,130
Filed: October 16, 2001
For: U.S. Patent No. 5,335,160

DECISION ON REQUEST FOR EXTENSION OF TIME

This is a decision on the petition under 37 C.F.R. § 1.550(a) filed September 20, 2002, for immediate action by the examiner in the above-identified reexamination proceedings.

Patent owner requests that the reexamination proceedings be taken up for action immediately by the examiner pursuant to the "special dispatch" provision of 37 C.F.R. § 1.550(a) and guidelines of MPEP §§ 708.01 and 2261, and that the patent owner be granted an interview during the first week of October for the purpose of resolving the remaining 112 (second paragraph) issue.

The petition is **granted-in-part** and **dismissed-in-part**.

Patent owner contends that U.S. Patent No. 5,335,160 is the subject of ongoing litigation in the Northern District of Florida, Case No. 4:99cv311-SPM, in which the court has now set a trial date of December 16, 2002, with a pre-trial conference scheduled for November 18, 2002. Therefore, patent owner seeks to conclude this merged reexamination proceeding with a decision from the USPTO as soon as possible so as to avoid further delays in the litigation to await the conclusion of the present merged reexamination proceeding.

Pursuant to the "special dispatch" provision of 37 C.F.R. § 1.550(a) and in accordance with MPEP § 2261, the above-identified merged reexamination proceeding will be forwarded to the examiner for prompt issuance of an Office action. Accordingly, the patent owner's request for immediate action is **granted.**

A review of the merged reexamination proceeding reveals that an interview between the examiner of record and the patent owner's representative was conducted on Thursday, October 10, 2002. Accordingly, the patent owner's request for a interview during the first week of October is **dismissed** as being moot.

Patent owner's representative is reminded that all correspondence submitted in this merged reexamination proceeding must be served on the third party requester (37 C.F.R. § 1.550(f)) and must be filed in triplicate in accordance with the decision merging proceedings mailed March 7, 2002. Failure to serve correspondence on the third party requester and/or to submit correspondence in triplicate may result in processing delays.

The reexamination files are being forwarded to the examiner for prompt issuance of an Office action.

Any inquiry concerning this decision should be directed to Edward J. Glick, Special Programs Examiner, at telephone No. (703) 308-4858.

Janice A. Falcone, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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Patent and Trademark Office
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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/005,715; 90/005,719; 90/005,130

PATENT NO. 5,335,160

ART UNIT 2875

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).

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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Paper No. 36

Thomas W. Cole (For Patent Owner)
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Lawrence D. Maxwell (For Third Party Requester)
NEEDLE & ROSENBERG, P.C.
Suite 1200, The Candler Building
127 Peachtree Street, NE
Atlanta, Georgia 30303-1811

Enclosure: Copy of patent owner papers filed February 12, 2003, and March 31, 2003.

In re reissue application of :
Paul F. Savoca :
Application No. 10/364,510 :
Filed: February 12, 2003 :
For: U.S. Patent No. 5,335,160 :
:
In re Paul F. Savoca :
Reexamination Proceeding :
Control No. 90/005,715 :
Filed: April 28, 2000 :
For: U.S. Patent No. 5,335,160 :
:
In re Paul F. Savoca :
Reexamination Proceeding :
Control No. 90/005,719 :
Filed: May 4, 2000 :
For: U.S. Patent No. 5,335,160 :
:
In re Paul F. Savoca :
Reexamination Proceeding :
Control No. 90/006,130 :
Filed: October 16, 2001 :
For: U.S. Patent No. 5,335,160 :

MAILED

JUN 26 2003

REEXAM UNIT

DECISION GRANTING
MERGER OF
PROCEEDINGS

This is a decision on the patent owner's request for merger of reissue application serial No. 10/364,510 with the already merged proceeding of reexamination control Nos. 90/005,715, 90/005,719, and 90/006,130. Patent owner's request for merger was filed together with reissue application No. 10/364510 on February 12, 2003, and was supplemented on March 31, 2003.

Patent owner's request papers are taken as a composite **petition** under 37 CFR 1.182 for merger of the reissue application with the already merged reexamination proceeding.[1]

The petition is before the Office of the Patent Legal Administration of the United States Patent and Trademark Office.

The petition under 37 CFR 1.182 for merger is granted.

REVIEW OF FACTS

1. U.S. patent No. 5,335,160 issued on August 2, 1994, with 23 claims.

2. A first request for reexamination, assigned control No. 90/005,715, was filed by the patent owner on April 28, 2000.

3. A second request for reexamination, assigned control No. 90/005,719, was filed by the patent owner on May 4, 2000.

4. A preliminary amendment was filed in the '5715 and '5719 proceedings on May 19, 2000, deleting claims 1 and 4, amending claims 2, 3 and 5-7, and adding new claim 24.

5. Reexamination was ordered for both of the '5715 and '5719 reexamination proceedings on July 18, 2000.

6. A patent owner's statement under 37 CFR 1.530 was not received in either of the '5715 and '5719 proceedings, and a decision merging the '5715 and '5719 proceedings was mailed on October 12, 2000.

7. A non-final Office action was mailed for the merged proceeding on June 21, 2001, and a personal interview was held on August 30, 2001.

8. An amendment was filed on September 7, 2001, along with a declaration by the inventor. Claims 8, 16 and claim 24 were amended, and claims 25-49 were added.

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[1] It was apparently recognized by patent owner that the papers titled as a "request" for merger were actually directed to a petition, as the supplemental paper of March 31, 2003 makes reference to "the petition fee... for filing the instant petition" as attached in the last paragraph of the supplemental paper.

9. A third request for reexamination, assigned control No. 90/006,130, was filed by a third party requester on October 16, 2001.

10. Reexamination was ordered for the '6130 reexamination proceeding on December 12, 2001.

11. A patent owner's statement under 37 CFR 1.530 was not received in the '6130 reexamination proceeding, and a decision merging the '5715, '5719, and '6130 proceedings was mailed on March 7, 2002.

12. Prosecution in the merged proceeding (for the three reexaminations) progressed to the point where a Notice of Intent to Issue Reexamination Certificate (NIRC) was mailed on February 6, 2003, indicating the status of the claims as:

    Claims 11-15 & 17-23 confirmed.
    Claims 2, 5-10 & 16 amended.
    Claims 1, 3 & 4 canceled.
    New claims 24-49 patentable.

13. On February 12, 2003 (after the NIRC was issued), the patent owner filed reissue application 10/364,510 for reissue of the 5,335,160 patent.

14. Included with the reissue application was a preliminary amendment adding new claims 50-60. In the "Remarks" section of the amendment, it is pointed out that new claims 50-60 are "narrower than the originally issued claims, but broader in some respects than the claims allowed in the merged re-examination proceedings...."

15. Also included with the reissue application was a request for merger of reissue application No. 10/364510 with the already merged proceeding of reexamination control Nos. 90/005,715, 90/005,719, and 90/006,130.

16. On March 31, 2003, patent owner supplemented the initial request for merger and included, pursuant to 37 CFR 1.17(h), the petition fee of $130.00 required for a petition under 37 CFR 1.182. As pointed out above, patent owner's request is being taken as a petition for merger of the reissue application with the merged reexamination proceeding.

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. 10/364,510 and reexamination control Nos. 90/005,715, 90/005,719, and 90/006,130 are currently pending. Since the order to reexamine has been mailed in all three reexamination proceedings, 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 three reexamination proceedings be merged and a joint examination be conducted. Accordingly, Notice of Intent to Issue Reexamination Certificate mailed February 6, 2003, for the merged proceeding of reexamination control Nos. 90/005,715, 90/005,719, and 90/006,130 is being withdrawn, and the examination of the reissue application and the 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 grant of merger is not an assurance that, in a future similar situation, merger would be granted.*

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 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).

2. A review of the reexamination files for the merged proceeding of reexamination control Nos. 90/005,715, 90/005,719, and 90/006,130 shows that original patent claims 11-15 and 17-23 are present, patent claims 1, 3 and 4 are canceled, and patent claims 2, 5-10 and 16 are amended. In addition; new claims 24-49 have been added. A review of reissue application No. 10/364,510 shows that original patent claims 1-23 are present. In addition, new claims 50-60 have been added. **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 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 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.

2. In the event that a 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 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 the reissue application and the reexamination proceedings. Each action will contain identifying data *for all of the cases*, i.e, the reissue application and the three reexamination proceedings, and each action will be physically entered into all four files (which will be maintained as separate files).

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 responses must be served on the requester*, who will also be sent copies of Office actions.

6. 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 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 three reexamination proceedings that will remain merged as one proceeding, 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 as a result of the difference in rules relating to reexamination and reissue proceedings. Thus, 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).

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 three reexamination proceedings that will remain merged as one proceeding. Such examination would be conducted as set forth in the immediately preceding paragraph.

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

three reexamination proceedings that will remain merged as one proceeding.

LACK OF SERVICE

It should be noted that the requisite proof of service [2] of the February 12, 2003, request (for merger) upon Lawrence D. Maxwell, the third party requester in the merged reexamination proceeding, was not included with that request. The March 31, 2003, supplemental request included a Certificate of Service of an "Amendment After Final" on the requester, but not the request for merger.

Since the requisite proof of service on third party requester Maxwell has not been included, a copy of the two patent owner requests is being provided to requester with this decision.

Any future communications filed by the patent owner in the merged reexamination proceeding must include proof of service of the paper **to which the proof is attached** upon the third party requester.

CONCLUSION

1. The petition to merge the reissue and reexamination proceedings is **granted**.

2. The Notice of Intent to Issue Reexamination Certificate mailed February 6, 2003, for the merged proceeding of reexamination control Nos. 90/005,715, 90/005,719, and 90/006,130 is hereby **withdrawn**.

3. Reissue application No. 10/364,510 **is merged** with the already merged proceeding of reexamination control Nos. 90/005,715, 90/005,719, and 90/006,130.

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[2] Pursuant to 37 CFR 1.550(f) "[a]fter 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."

4. Pursuant to Part II of this decision, a housekeeping amendment is required **within ONE MONTH of this decision,** placing the same amendments in all cases of the present merged proceeding.

5. The reissue and three reexaminations files are being forwarded to the examiner via the Director of Technology Center 2800. Upon receipt of same, the 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 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. All further examination in the merged proceeding should be conducted in accordance with Part III of this decision.

7. 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
Office of Patent Legal Administration

June 23, 2003
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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.
10/364,510	02/12/2003	Paul F. Savoca	

PATENT NUMBER	DATE OF THIS NOTICE	PAPER NUMBER
5,335,160	06/26/2003	37

NOTICE OF MERGED REEXAM - REISSUE PROCEEDING

This reissue application has been merged with the reexamination proceeding listed below:

Control No. 90/005,715 Filing Date: 04/28/2000
Control No. 90/005,719 Filing Date: 05/04/2000
Control No. 90/006,130 Filing Date: 10/16/2001

Requester (name, address) Lawrence E. Maxwell
NEEDLE & ROSENBERG, P. C.
Suite 1200, The Candler Building
127 Peachtree Street, NE
Atlanta, GA 30303-1811

The front face of the reissue patent will include the following paragraph:

REEXAMINATION RESULTS

The questions raised in reexamination request No. 90/ 90/005,715 90/005,719** 006,130** , filed **04/28/2000 , 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).

**and filed 05/04/2000 and 10/16/2001, respectively

FORM PTO-1527
(3-84)

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#15 MS

Dennis H. Rainear
Patent & Trademark Division
Ethyl Corporation
P.O. Box 2189
330 South Fourth Street
Richmond, VA 23219

(For Patent Owner)

MAILED

SEP 19 2000

REEXAM UNIT

Bruce S. Londa
Londa and Gluck LLP
20 Exchange Place, 37th Floor
New York, NY 10005

(For Requester)

DO NOT DOCKET

In re reissue application of
Gatto et al.
Application No. 09/359,770
Filed: July 22, 1999
For: U.S. Patent No. 5,650,381

In re Gatto et al.
Reexamination Proceeding
Control No. 90/005,720
Filed: May 10, 2000
For: U.S. Patent No. 5,650,381

DECISION TO MERGE
REEXAMINATION AND
REISSUE PROCEEDINGS

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. 5,650,381 issued July 22, 1997.

2. Certificates of Correction issued on November 18, 1997, and on April 21, 1998, in the '381 patent.

3. On July 22, 1999, an application for reissue of the '381 patent was filed, and it was assigned Application No. 09/359,770.

4. The filing of the reissue application was published in the *Official Gazette* on November 16, 1999.

5. A first Office action was mailed in the reissue application on March 31, 2000.

6. On May 10, 2000, a request for reexamination was filed by a third party requester, and the proceeding was assigned Control No. 90/005,720.

7. An amendment was filed in the reissue application on June 26, 2000.

8. On July 20, 2000, reexamination was ordered.

9. A waiver of Patent Owner's statement under 37 C.F.R. § 1.530 was filed in the reexamination proceeding by patent owner on August 10, 2000. A first Office action has not yet been issued in the reexamination.

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 an Office action was mailed on March 31, 2000, and new claims have been added. A review of the reexamination file shows that reexamination was ordered on July 20, 2000. A waiver of a 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.

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, 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.

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. Conclusion

1. The above noted reissue application and reexamination proceeding ARE MERGED.

2. The reissue and reexaminations file are being forwarded to the examiner via the Director of Technology Center 1700. 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 date of this decision to await the housekeeping amendment requested in Part II above.

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

September 19, 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.
09/359,770	07/22/99	Vincent J. Gatto	

PATENT NUMBER	DATE OF THIS NOTICE	PAPER NUMBER
5,650,381	09/19/00	16

NOTICE OF MERGED REEXAM - REISSUE PROCEEDING

This reissue application has been merged with the reexamination proceeding listed below:

Control No. 90/ 005,720 Filing Date: May 10, 2000

Requester (name, address) Bruce S. Londa
Londa and Gluck LLP
20 Exchange Place, 37th Floor
New York, NY 10005

The front face of the reissue patent will include the following paragraph:

REEXAMINATION RESULTS

The questions raised in reexamination request No. 90/005,720, filed May 10, 2000, 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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
[illegible]	05/15/00	4706275	45456-025

WM41/0308

JEFFREY H. INGERMAN
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1251 AVENUE OF THE AMERICAS
NEW YORK NY 10020-1104

EXAMINER
BARNIE, R

ART UNIT	PAPER NUMBER
2643	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

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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	

DECISION MERGING REEXAMINATION PROCEEDINGS

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

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
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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

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

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

90005725.032102

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.
90/005,726	05/15/00	6016543	ENSEMBL.002F

EXAMINER	

WM41/0730

MARK C. CONTOIS
CARTER, LEDYARD & MILBURN
1401 I STREET, N.W.
SUITE 300
WASHINGTON DC 20005

ART UNIT	PAPER NUMBER
2664	14

DATE MAILED: 07/30/01

REEXAMINATION COMMUNICATION

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE ONE MONTH(S) FROM THE DATE OF THIS LETTER. EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).

RECEIVED
AUG 06 2001
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cc: Requester

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COMMISSIONER FOR PATENTS
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WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 14

Mark Comtois CARTER, LEDYARD, MILBURN 1401 I Street, NW Suite 300 Washington, D.C. 20005	)))))	FOR OWNER
Richard E. Campbell KNOBBE, MARTENS, OLSON & BEAR, LLP 550 W. C Street, Suite 1200 San Diego, CA 92101	)))))	FOR THIRD PARTY REQUESTER
In re Foster, Jr. et al. Reexamination Proceeding. Control No. 90/005726 Filed: May 15, 2000 For: U.S. Patent No. 6,016,313	)))))	DECISION SUA SPONTE, MERGING REEXAMINATION PROCEEDINGS
In re Foster, Jr. et al. Reexamination Proceeding Control No. 90/005974 Filed: April 5, 2001 For: U.S. Patent No. 6,016,313	)))))	

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. 6,016,313 issued on January 18, 2000.

2. A first request for reexamination, Control No. 90/005726 ('726) was filed by the Third Party Requester on May 15, 2000.

3. Reexamination was ordered in the '726 reexamination proceeding on August 1, 2000.

4. A first Office action was mailed on December 4, 2000 in the '726 reexamination proceeding rejecting claims 1-86 (all pending claims).

5. Interviews in the'726 reexamination proceeding were held on February 13, 2001 and February 28, 2001.

6. A response to the first Office Action in the '726 reexamination proceeding was filed on March 5, 2001.

7. A second request for reexamination, Control No. 90/005974 ('974) was filed by the Third Party Requester on April 5, 2001.

8. Reexamination was ordered in the '974 reexamination proceeding on June 4, 2001.

9. A Change of Correspondence Address for the Patent Owner was filed in both reexamination proceedings on June 20, 2001.

10. A Change of Correspondence Address for the Third Party Requester was filed in the '726 reexamination proceeding on July 19, 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 '726, and '974 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 Proceedings

The Patent Owner is required to maintain the same claims and specification in both files. Since the files do not maitain the same claims and/or specification, a "housekeeping" amendment is required to be submitted within **ONE MONTH** of this decision. Any discussion of the merits or issues of the proceedings within the housekeeping amendment 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.

Both files will be maintained as separate complete files and 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 addressed to both files and 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.

Jin F. Ng, Director
Technology Center 2600
Communications

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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9
(mailed)

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Ross F. Hunt, Jr. (For Requester #2)
Larson & Taylor
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Alexandria, VA 22314

DO NOT REMOVE

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.

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.

Control: 90/005,592

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.

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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UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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1990 M Street, NW
Suite 800
Washington, D.C. 20036

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

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.

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 not 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.

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

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. Requirement for Same Amendments in All Proceedings

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 ONE (1)**

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

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
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.
90/006,541	02/07/2003	5806063	22058-00003-US	8322

7590 05/13/2004

Bruce Dickens
Dickens-Soeder 2000 LLC
3892 Cedron Street
Irvine, CA 92606

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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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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATEN
UNITED STATES PATENT AND TRADEMARK OFFI
WASHINGTON, D.C. 2023
www.uspto g

Paper No. 39

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FOR PATENT OWNER

MAY 13 2004

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FOR THIRD PARTY REQUESTOR ['6541]

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Larson & Taylor
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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].

---

[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
Technology Center 2100
Computer Architecture, Software, and Information Security
(703) 306-4160

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.
90/005,728	05/16/00	5555402	LUC 42075

TM21/0226

RUSSELL L JOHNSON
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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.

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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.

UNITED STATES PATENT AND TRADEMARK OFFICE

Allen R. MacDonald, Director
Technology Center 2100
Computer Architecture, Software, and Electronic Commerce

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APR 1 3 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

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Paper No. 32

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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 PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Paper No. 15

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(For Patent Owner)

MAILED
OCT 12 2000
GROUP 2500

Paul Devinsky
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600 13th Street, N.W.
Washington, D.C. 20005-3096

(For Requester)

DO NOT ENTER

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.

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

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.

DO NOT ENTER

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.

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
www.uspto.gov

Stephan J. Schultz
Watts, Hoffman, Fisher & Heinke
1100 Superior Ave., Suite 1750
Cleveland, Ohio 44114

(For Patent Owner)

#21

Paul Devinsky
McDermott, Will & Emery
600 13th Street, N.W.
Washington, D.C. 20005-3096

(For Requester)

MAILED

JAN 30 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
C:\KIVA\KENPET3\5731REAS.ONS

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.
90/005,733	05/18/00	5848259	C72370US

TM11/1206

FROHWITTER
RONALD L CHICHESTER
THREE RIVERWAY SUITE 500
HOUSTON TX 77056

EXAMINER
SEAL, J

ART UNIT	PAPER NUMBER
2131	#8

DATE MAILED: 12/06/00

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

Leah Sherry
OPPENHEIMER WOLFF &
DONNELLY LLP
3373 Hillview Avenue, Suite 200
Palo Alto, CA 94304

FOR OWNER

Patent Administrator
TESTA, HURWITZ & THIBEAULT, LLP
High Street Tower
125 High Street
Boston, MA 02110

FOR THIRD PARTY REQUESTOR

In re Collins et al.
Reexamination Proceeding
Control No. 90/005,733
Filed: May 18, 2000
For: U.S. Patent No. 5,848,159

DECISION SUE SPONTE
MERGING REEXAMINATION
PROCEEDINGS

In re Collins et al.
Reexamination Proceeding
Control No. 90/005,776
Filed: July 28, 2000
For: U.S. Patent No. 5,848,159

DO NOT ENTER

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. 5,848,159 issued on December 08, 1998.

2. A first request for reexamination, Control No. 90/005,733 ('733) was filed by the Patent Owner on May 18, 2000.

3. Reexamination was ordered on the '733 reexamination proceeding on July 19, 2000.

4. A second request for rexamination, Control No. 90/005,776 ('776) was filed by the Third Party Requestor on July 28, 2000.

5. Reexamination was ordered on the '776 reexamination proceeding on August 31, 2000.

6. A Power of Attorney was filed by the Patent Owner on September 18, 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 '733 and '776 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 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 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.

John J. Love, Director
Technology Center 2100
Computer Architecture, Software,
and Electronic Commerce

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.
90/005,733			

Leah Sherry
OPPENHEIMER WOLFF & DONNELLY LLP
1400 Page Mill Ave.
Palo Alto, CA 94304

EXAMINER	
ART UNIT	PAPER NUMBER
	9

DATE MAILED: 23 FEB 2001
remailed

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

Commissioner of Patents and Trademarks

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Leah Sherry OPPENHEIMER WOLFF & DONNELLY LLP 3373 Hillview Avenue, Suite 200 Palo Alto, CA 94304	FOR OWNER
Patent Administrator TESTA, HURWITZ & THIBEAULT, LLP High Street Tower 125 High Street Boston, MA 02110	FOR THIRD PARTY REQUESTOR
In re Collins et al. Reexamination Proceeding Control No. 90/005,733 Filed: May 18, 2000 For: U.S. Patent No. 5,848,159	DECISION SUE SPONTE MERGING REEXAMINATION PROCEEDINGS
In re Collins et al. Reexamination Proceeding Control No. 90/005,776 Filed: July 28, 2000 For: U.S. Patent No. 5,848,159	

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. 5,848,159 issued on December 08, 1998.

2. A first request for reexamination, Control No. 90/005,733 ('733) was filed by the Patent Owner on May 18, 2000.

3. Reexamination was ordered on the '733 reexamination proceeding on July 19, 2000.

4. A second request for rexamination, Control No. 90/005,776 ('776) was filed by the Third Party Requestor on July 28, 2000.

5. Reexamination was ordered on the '776 reexamination proceeding on August 31, 2000.

6. A Power of Attorney was filed by the Patent Owner on September 18, 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 '733 and '776 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 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 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.

John J. Love, Director
Technology Center 2100
Computer Architecture, Software,
and Electronic Commerce

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

12 (mail)

Leah Sherry
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(For Patent Owner)

Patent Administrator
TESTA, HURWITZ & THIBEAULT, LLP
125 High Street
Boston, MA 02110

(For Requester)

MAILED

MAR 14 2001

REEXAM UNIT

In re Collins et al.
Reexamination Proceeding
Control No. 90/005,733
Filed: May 18, 2000
For: U.S. Patent No. 5,848,159

In re Collins et al.
Reexamination Proceeding
Control No. 90/005,776
Filed: July 28, 2000
For: U.S. Patent No. 5,848,159

In re reissue application of
Collins et al.
Serial No. 09/694,416
Filed: October 20, 2000
For: U.S. Patent No. 5,848,159

DECISION TO SUA SPONTE 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. 5,848,159 issued to Collins et al. on December 8, 1998.

2. A request for reexamination of the `159 patent was filed by patent owner on May 18, 2000, and the resulting reexamination proceeding was assigned Control No. 90/005,733.

3. On July 19, 2000, reexamination was ordered in the `5733 proceeding.

4. A request for reexamination of the `159 patent was filed by a third party requester on July 28, 2000, and the resulting reexamination proceeding was assigned Control No. 90/005,776.

5. On August 31, 2000, reexamination was ordered in the `5776 proceeding.

6. In the `5733 proceeding, a patent owner's statement under 37 C.F.R. § 1.530 in response to the order was received on September 22, 2000.

7. On October 20, 2000, patent owner filed a reissue application which was assigned Application No. 09/694,416.

8. Notice of the filing of the reissue application was published in the *Official Gazette* on December 5, 2000.

9. On December 6, 2000, a decision merging the `5733 and `5776 reexamination proceedings was mailed.

10. On February 23, 2001, the decision merging the `5733 and `5776 reexamination proceedings was re-mailed.

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 `5733 and `5776 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 history of the `5733 reexamination file and the `5776 reexamination file shows that the original specification, drawings and patent claims are presently in the `5733 and `5776 reexamination files. On December 6, 2000, a decision merging these two reexamination proceedings was mailed. On February 23, 2001, the decision merging these two reexamination proceedings was re-mailed. These merged reexamination proceedings are awaiting a first Office action on the merits by the examiner.

A review of the reissue (Application No. 09/694,416) prosecution history shows that the reissue application was published in the *Official Gazette* on December 5, 2000. The application is awaiting

a first Office action on the merits by the examiner. In addition to amending the specification and patent claims 1-13, in the reissue application, applicant has submitted new claims 14-61 for consideration. Thus, the claims are not 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 reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application 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 *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 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). **An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in all three cases**, specifically, Application No. 09/694,416, and Control Numbers 90/005,733 and 90/005,776. The response to the requirement must be limited to placing the same amendments in all three 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 two (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 reexamination proceedings. Each action will contain identifying data *for all three of the cases*, i.e, the reissue application and the 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 the three files, with each of the three 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 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 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 two 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 C.F.R. § 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 two 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 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 *as to the reissue application*, a stay of the CPA reissue application, and separate, continued prosecution as to the two reexamination proceedings that will remain merged as one proceeding.

U.S. Patent and Trademark Office

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 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 ONE (1) MONTH of this decision**, placing the same amendments in all three 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 proceedings **after** the earlier of:

(a) the submission of the housekeeping amendment to place the same amendments in all three 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
Special Projects Examiner
Office of Patent Legal Administration

March 13, 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.
09/694,416	10/20/00	Thomas Collins	20206-014 (PT

PATENT NUMBER	DATE OF THIS NOTICE	PAPER NUMBER
5,848,159	03/14/01	13

NOTICE OF MERGED REEXAM - REISSUE PROCEEDING

This reissue application has been merged with the reexamination proceeding listed below:

90/ 005,733 Filing Date: 05/18/00
Control No. 90/ 005,776 Filing Date: 07/28/00

Requester (name, address) Patent Administrator
Testa, Hurwitz & Thibeault, LLP
125 High Street
Boston, MA 02110

The front face of the reissue patent will include the following paragraph:

REEXAMINATION RESULTS

The questions raised in reexamination request No. 90/ 005733** , filed 05/18/00** , 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).

**AND REEXAMINATION REQUEST NO. 90/005,776, FILED ON 07/28/00

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.
90/005,733	05/18/00	5848259	C72370US

TM11/1206

FROHWITTER
RONALD L CHICHESTER
THREE RIVERWAY SUITE 500
HOUSTON TX 77056

EXAMINER
SEAL, J

ART UNIT	PAPER NUMBER
2131	#8

DATE MAILED: 12/06/00

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

Leah Sherry
OPPENHEIMER WOLFF &
DONNELLY LLP
3373 Hillview Avenue, Suite 200
Palo Alto, CA 94304

FOR OWNER

Patent Administrator
TESTA, HURWITZ & THIBEAULT, LLP
High Street Tower
125 High Street
Boston, MA 02110

FOR THIRD PARTY REQUESTOR

In re Collins et al.
Reexamination Proceeding
Control No. 90/005,733
Filed: May 18, 2000
For: U.S. Patent No. 5,848,159

DECISION SUE SPONTE
MERGING REEXAMINATION
PROCEEDINGS

In re Collins et al.
Reexamination Proceeding
Control No. 90/005,776
Filed: July 28, 2000
For: U.S. Patent No. 5,848,159

DO NOT ENTER

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. 5,848,159 issued on December 08, 1998.

2. A first request for reexamination, Control No. 90/005,733 ('733) was filed by the Patent Owner on May 18, 2000.

3. Reexamination was ordered on the '733 reexamination proceeding on July 19, 2000.

4. A second request for rexamination, Control No. 90/005,776 ('776) was filed by the Third Party Requestor on July 28, 2000.

5. Reexamination was ordered on the '776 reexamination proceeding on August 31, 2000.

6. A Power of Attorney was filed by the Patent Owner on September 18, 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 '733 and '776 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 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 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.

John J. Love, Director
Technology Center 2100
Computer Architecture, Software,
and Electronic Commerce

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.
90/005,733			

Leah Sherry
OPPENHEIMER WOLFF & DONNELLY LLP
1400 Page Mill Ave.
Palo Alto, CA 94304

EXAMINER	
ART UNIT	PAPER NUMBER
	9

DATE MAILED: 23 FEB 2001
remailed

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

Commissioner of Patents and Trademarks

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Leah Sherry OPPENHEIMER WOLFF & DONNELLY LLP 3373 Hillview Avenue, Suite 200 Palo Alto, CA 94304	FOR OWNER
Patent Administrator TESTA, HURWITZ & THIBEAULT, LLP High Street Tower 125 High Street Boston, MA 02110	FOR THIRD PARTY REQUESTOR
In re Collins et al. Reexamination Proceeding Control No. 90/005,733 Filed: May 18, 2000 For: U.S. Patent No. 5,848,159	DECISION SUE SPONTE MERGING REEXAMINATION PROCEEDINGS
In re Collins et al. Reexamination Proceeding Control No. 90/005,776 Filed: July 28, 2000 For: U.S. Patent No. 5,848,159	

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. 5,848,159 issued on December 08, 1998.

2. A first request for reexamination, Control No. 90/005,733 ('733) was filed by the Patent Owner on May 18, 2000.

3. Reexamination was ordered on the '733 reexamination proceeding on July 19, 2000.

4. A second request for rexamination, Control No. 90/005,776 ('776) was filed by the Third Party Requestor on July 28, 2000.

5. Reexamination was ordered on the '776 reexamination proceeding on August 31, 2000.

6. A Power of Attorney was filed by the Patent Owner on September 18, 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 '733 and '776 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 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 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.

John J. Love, Director
Technology Center 2100
Computer Architecture, Software,
and Electronic Commerce

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

12 (mail)

Leah Sherry
OPPENHEIMER, WOLFF & DONNELLY, LLP
1400 Page Mill Avenue
Palo Alto, CA 94304

(For Patent Owner)

Patent Administrator
TESTA, HURWITZ & THIBEAULT, LLP
125 High Street
Boston, MA 02110

(For Requester)

MAILED

MAR 14 2001

REEXAM UNIT

In re Collins et al.
Reexamination Proceeding
Control No. 90/005,733
Filed: May 18, 2000
For: U.S. Patent No. 5,848,159

In re Collins et al.
Reexamination Proceeding
Control No. 90/005,776
Filed: July 28, 2000
For: U.S. Patent No. 5,848,159

In re reissue application of
Collins et al.
Serial No. 09/694,416
Filed: October 20, 2000
For: U.S. Patent No. 5,848,159

DECISION TO SUA SPONTE 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. 5,848,159 issued to Collins et al. on December 8, 1998.

2. A request for reexamination of the `159 patent was filed by patent owner on May 18, 2000, and the resulting reexamination proceeding was assigned Control No. 90/005,733.

3. On July 19, 2000, reexamination was ordered in the `5733 proceeding.

4. A request for reexamination of the `159 patent was filed by a third party requester on July 28, 2000, and the resulting reexamination proceeding was assigned Control No. 90/005,776.

5. On August 31, 2000, reexamination was ordered in the `5776 proceeding.

6. In the `5733 proceeding, a patent owner's statement under 37 C.F.R. § 1.530 in response to the order was received on September 22, 2000.

7. On October 20, 2000, patent owner filed a reissue application which was assigned Application No. 09/694,416.

8. Notice of the filing of the reissue application was published in the *Official Gazette* on December 5, 2000.

9. On December 6, 2000, a decision merging the `5733 and `5776 reexamination proceedings was mailed.

10. On February 23, 2001, the decision merging the `5733 and `5776 reexamination proceedings was re-mailed.

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 `5733 and `5776 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 history of the `5733 reexamination file and the `5776 reexamination file shows that the original specification, drawings and patent claims are presently in the `5733 and `5776 reexamination files. On December 6, 2000, a decision merging these two reexamination proceedings was mailed. On February 23, 2001, the decision merging these two reexamination proceedings was re-mailed. These merged reexamination proceedings are awaiting a first Office action on the merits by the examiner.

A review of the reissue (Application No. 09/694,416) prosecution history shows that the reissue application was published in the *Official Gazette* on December 5, 2000. The application is awaiting

a first Office action on the merits by the examiner. In addition to amending the specification and patent claims 1-13, in the reissue application, applicant has submitted new claims 14-61 for consideration. Thus, the claims are not 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 reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application 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 *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 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). **An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in all three cases**, specifically, Application No. 09/694,416, and Control Numbers 90/005,733 and 90/005,776. The response to the requirement must be limited to placing the same amendments in all three 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 two (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 reexamination proceedings. Each action will contain identifying data *for all three of the cases*, i.e, the reissue application and the 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 the three files, with each of the three 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 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 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 two 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 C.F.R. § 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 two 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 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 *as to the reissue application*, a stay of the CPA reissue application, and separate, continued prosecution as to the two reexamination proceedings that will remain merged as one proceeding.

U.S. Patent and Trademark Office

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 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 ONE (1) MONTH of this decision**, placing the same amendments in all three 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 proceedings **after** the earlier of:

(a) the submission of the housekeeping amendment to place the same amendments in all three 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
Special Projects Examiner
Office of Patent Legal Administration

March 13, 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.
09/694,416	10/20/00	Thomas Collins	20206-014 (PT

PATENT NUMBER	DATE OF THIS NOTICE	PAPER NUMBER
5,848,159	03/14/01	13

NOTICE OF MERGED REEXAM - REISSUE PROCEEDING

This reissue application has been merged with the reexamination proceeding listed below:

90/ 005,733 Filing Date: 05/18/00
Control No. 90/ 005,776 Filing Date: 07/28/00

Requester (name, address) Patent Administrator
Testa, Hurwitz & Thibeault, LLP
125 High Street
Boston, MA 02110

The front face of the reissue patent will include the following paragraph:

REEXAMINATION RESULTS

The questions raised in reexamination request No. 90/ 005733** , filed 05/18/00** , 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).

**AND REEXAMINATION REQUEST NO. 90/005,776, FILED ON 07/28/00

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

Paper No. 10
AR

Kilpatrick Stockton, LLP (For Patent Owner)
Attn: Roger T. Frost
1100 Peachtree Street
Suite 2800
Atlanta, GA 30309-4530

MAILED
JUL 0 8 2003
REEXAM UNIT

Alton D. Rollins, Esquire (For Third Party Requester)
Oblon Spivak McClelland Maier
& Neustadt, PC
1940 Duke Street
Alexandria, VA 22314

Neshide et al :
Reexamination Proceeding : DECISION
Control No. 90/005,734 : DISMISSING
Filed: May 22, 2000 : PETITION
For: U.S. Patent No. 5,851,505 :

This is a decision on the December 16, 2002, patent owner petition, requesting withdrawal of the Reexamination Certificate issued May 15, 2001. The petition is taken as a petition under 37 CFR 1.181.

The petition is before the Office of the Patent Legal Administration of the United States Patent and Trademark Office.

For reasons set forth below, the petition is dismissed.

REVIEW OF FACTS

1. U.S. Patent No. 5,851,505 issued on December 22, 1998.

2. On May 22, 2002, a request for reexamination of the '505 patent was filed by a third party requester, and it was assigned Control No. 90/005,734.

3. An Order Granting the Request for Reexamination was mailed on July 26, 2000.

4. On November 13, 2000, a first Office action was mailed; all of the claims, i.e., claims 1-5, were rejected.

5. On February 27, 2001, a Notice of Intent to Issue Reexamination Certificate (NIRC) was mailed. The NIRC held the examination of the proceeding to be terminated and set forth the status of claims 1-5 as canceled, as a result of patent owner's failure to timely respond to the November 13, 2000, Office action.

6. Reexamination Certificate U.S. 5,851,505 C1 (4357th) issued May 15, 2001, and was published in the *Official Gazette* of that date. In the Certificate, claims 1-5 were identified as canceled

7. On December 18, 2002, the patent owner filed the present petition, requesting that (1) the Reexamination Certificate be withdrawn, and (2) the November 13, 2000, Office action be remailed.

DECISION DISMISSING PETITION

Section 711.03(c), part II, of the Manual of Patent Examining Procedure sets forth that a grantable petition establishing nonreceipt of an Office communication requires two items:

(1) A statement from the practitioner averring that the Office communication was not received and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received; and

(2) A copy of the docket record(s) where the non-received Office communication would have been entered, had it been received and docketed.

The present petition does not contain any statement (from the practitioner) to the effect that a search of the file jacket and docket records was made, and that such a search indicated that the November 13, 2000, first Office action was not received.

It is further noted that petitioner has supplied a copy of the docket report for January 13, 2001, showing a lack of entry for that date as to the present proceeding. Petitioner has not, however, supplied a copy of the file jacket showing the absence of an entry for the November 13, 2000, first Office action. If entries for receipt of Office actions are made on the file jacket, a copy of same should be submitted. If such entries are not made on the file jacket, a statement to that effect should be submitted.

CHANGE OF ADDRESS

Pursuant to the notification of change of correspondence address set forth in the petition, the address of the patent owner is to be changed in the records for the present proceeding to:

Kilpatrick Stockton, LLP
Attn: Roger T. Frost
1100 Peachtree Street
Suite 2800
Atlanta, GA 30309-4530

CONCLUSION

1. The petition is dismissed.

2. **The submission of the above-described information** is required in order to complete the present petition. If petitioner desires to make the required submission, the submission should be provided via a **"Renewed Petition to Withdraw Reexamination Certificate."**

3. Any renewed petition must be filed within **ONE (1) MONTH** of the mailing date of this decision.

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

By mail: Central Reexamination Unit
Office of Patent Legal Administration
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (703) 305-1013
Central Reexamination Unit
Attn: Kenneth Schor

By HAND: Central Reexamination Unit
Crystal Plaza Three-Four, 3D68
2201 South Clark Place
Arlington, VA

5. The reexamination file is being stored in the CRU, pending the filing of a renewed petition by patent owner, or the expiration of time for such.

6. 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
Office of Patent Legal Administration

July 7, 2003
C:\KIVA\KENPET4\5734wd.dis

Page 4 of 5

#11
MCW

PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Control No. **90/005,734**

Patent Under Reexamination: **5,851,505**

Filed: **MAY 22, 2000**

For: **METHOD OF PRODUCING PURIFIED AQUEOUS SOLUTION OF HYDROGEN PEROXIDE**

Control Reexamination Unit

Attention: **KENNETH M. SCHOR**

RECEIVED
JUL 17 2003
OPLA

RESPONSE TO DECISION

Attention. Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

VIA FACSIMILE (703) 305-1013
Central Reexamination Unit

Sir:

Responsive to the Decision dated July 8, 2003 in the proceeding identified above, the undersigned respectfully requests reconsideration of the Petition filed December 16, 2002.

The Decision states that the Petition did not contain a statement from the undersigned practitioner to the effect that a search of the file jacket and the docket records was made, and that such a search indicated that the November 13, 2000 Office action was not received. The Decision further states that Petitioner has not supplied a copy of the file jacket showing the absence of an entry for the November 13, 2000 Office action.

I hereby certify that this correspondence is being sent via facsimile addressed to: Attention Kenneth Schor, Senior Legal Advisor, Office of Patent Legal Administration, Central Reexamination Unit at (703) 305-1013, on July 15, 2003.

Roger T. Frost - Reg. No. 22,176

Patent Under Reexamination: 5,851,505
Response to Decision

Responding to that Decision, the undersigned practitioner states that he has searched the file jacket of the aforementioned application and has not located the Office communication (Paper No. 6) mailed November 13, 2000. The undersigned thereby avers that the aforementioned Office communication was not received.

The undersigned, before submitting the Petition of December 16, 2002, initiated a search of the patent docket records maintained by the law firm of which the undersigned is a partner. That search produced no indication that the November 13, 2000 Office action was received. The docket record copy submitted by the undersigned with the December 16, 2002 Petition was prepared from the aforementioned search of docket records.

A copy of the file jacket cover, showing certain docket entries for Application No. 08/935,204, the application corresponding to the patent under reexamination in the present proceeding, is attached to the present paper. Papers in the present reexamination proceeding are maintained in that file jacket. The last docket entry on that file jacket cover is "Oct 13, 1998, Issue Fee" in the "Responses Filed" column. However, the aforementioned law firm, sometime after issuance of the patent here in reexamination but before the present reexamination was initiated, discontinued the practice of entering docket information on file jackets. For that reason, the absence of a file jacket entry for the November 13, 2000 Office action, or any previous document in the reexamination proceeding, is meaningless.

Patent Under Reexamination: 5,851,505
Response to Decision

The foregoing is submitted as a complete response to the Decision mailed July 8, 2003 in the present proceeding. The undersigned thus requests the Office to reconsider the aforementioned Petition and to grant the relief requested therein.

Respectfully submitted,

Roger T. Frost
Reg. No. 22,176

KILPATRICK STOCKTON LLP
1100 Peachtree Street, Suite 2800
Atlanta, Georgia 30309-4530
Direct Phone: (404) 745-2402
Direct Fax: (404) 541-3208
Docket: 20111-0011 (45455/239331)

Document Page 3 of 4

Patent Under Reexamination: 5,851,505
Response to Decision

CERTIFICATE OF SERVICE

This is to certify that a copy of the foregoing is being sent by first class mail on July 15, 2003 addressed to:

Alton D. Rollins, Esq.
Oblon, Spivak, McClelland,
Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, Virginia 22314

Roger T. Frost

U.S. PATENT APPLICATION

24

entor(s) YOSHIYUKI NISHIDE, et al.

rial No. 08/935,204 Filed September 22, 1997

le METHOD OF PRODUCING PURIFIED AQUEOUS SOLUTION OF HYDROGEN PEROXIDE

roup Art Unit Examiner

ssignee MITSUBISHI GAS CHEMICAL COMPANY, INC.

ssignment Recorded Sept. 22, 1997 Reel 8814 Frame 0492

Citation of Art Filed

Office Action Dated	Response Due	Response Filed
19	19	March 30 1998 IDS
April 2 1998 Office Action July 2 1998 Response July 22 1998 Amd. Filed		
August 18 1998 Not. of Allow. Nov. 18 1998 Issue Fee Oct 13 1998 Issue Fee		
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Maintenance: DUE PAID

3½ June 22, 2002

7½ June 22, 2006

11½ June 22, 2010

Allowed Base Fee Paid Bal. Fee Paid

Patent No. 5,851,505 Patent Date December 22, 1998

Expiration Date

LAW OFFICES OF
JONES & ASKEW
ATLANTA, GEORGIA

20111-0011

Continuation of
Division of
Continuation in part of

YOSHIYUKI ... TITLE Method of Producing Purified Aqueous Solution of Hydrogen Peroxide PATENT NO.

****
*** RX REPORT ***
****

RECEPTION OK

TX/RX NO	6102
CONNECTION TEL	
CONNECTION ID	KS ATLANTA
ST. TIME	07/15 16:18
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RESULT	OK

KILPATRICK STOCKTON LLP
Attorneys at Law

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RFrost@KilpatrickStockton.com

July 15, 2003

FAX

RECIPIENT/ PHONE NO.	FAX NO.	COMPANY/ CITY, STATE, COUNTRY
Attention: Kenneth M. Schor Control Reexamination Unit	(703) 305-1013	U.S. Patent and Trademark Office Alexandria, VA

Roger T. Frost
FROM

6
PAGES (WITH COVER)

8514
REFERENCE NO

45455/239331
CLIENT/MATTER NO

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COMMENTS

The facsimile confirmation of the Patent Office imprinted hereon will acknowledge receipt of:

Control No: **90/005,734**
Patent Under Reexamination: **5,851,505**
Filed: **May 22, 2000**
For: **Method of Producing Purified Aqueous Solution of Hydrogen Peroxide**
Papers Submitted: **Response to Decision; and a copy of the file jacket cover.**
Docket No.: **45455/239331 (20111-0011)**
Date Mailed **July 15, 2003**
Atty/Sec: **RTF:mcm**

TO BE COMPLETED BY KS OPERATIONS CENTER

TRANSMISSION RECEIPT DATE/TIME: _____

COMPLETED BY: _____ JOB CODE 02585

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
P O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.go

Paper No. 12

Kilpatrick Stockton, LLP
Attn: Roger T. Frost
1100 Peachtree Street
Suite 2800
Atlanta, GA 30309-4530

(For Patent Owner)

Alton D. Rollins, Esquire
Oblon Spivak McClelland Maier
& Neustadt, PC
1940 Duke Street
Alexandria, VA 22314

(For Third Party Requester)

MAILED

JUL 2 2 2003

REEXAM UNIT

Neshide et al :
Reexamination Proceeding : DECISION
Control No. 90/005,734 : GRANTING
Filed: May 22, 2000 : PETITION
For: U.S. Patent No. 5,851,505 :

This is a decision on the July 17, 2003, patent owner renewed petition under 37 CFR 1.181, requesting withdrawal of the Reexamination Certificate issued May 15, 2001.

The petition is before the Office of the Patent Legal Administration of the United States Patent and Trademark Office.

For reasons set forth below, the petition is granted.

REVIEW OF FACTS

1. U.S. Patent No. 5,851,505 issued on December 22, 1998.

2. On May 22, 2002, a request for reexamination of the '505 patent was filed by a third party requester, and it was assigned Control No. 90/005,734.

3. An Order Granting the Request for Reexamination was mailed on July 26, 2000.

4. On November 13, 2000, a first Office action was mailed. All of the claims, i.e., claims 1-5, were rejected in that Office action.

5. On February 27, 2001, a Notice of Intent to Issue Reexamination Certificate (NIRC) was mailed. The NIRC held the examination of the proceeding to be terminated, and set forth the status of claims 1-5 as canceled, as a result of patent owner's failure to timely respond to the November 13, 2000, Office action.

6. Reexamination Certificate U.S. 5,851,505 C1 (4357th) issued May 15, 2001, and was published in the *Official Gazette* of that date.

7. On December 18, 2002, the third party requester filed a petition, requesting that the Reexamination Certificate be withdrawn, and (2) that the Office action be remailed.

8. The petition was dismissed as incomplete in a decision issued July 8, 2003, by the Senior Legal Advisor of the Office of the Patent Legal Administration.

9. The present renewed petition was filed on July 8, 2003, to complete the petition.

DECISION GRANTING PETITION

Section 711.03(c), part II, of the Manual of Patent Examining Procedure sets forth that a grantable petition establishing nonreceipt of an Office communication requires two items:

(1) a statement from the practitioner averring that the Office communication was not received and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received; and

(2) a copy of the docket record(s) where the non-received Office communication would have been entered had it been received and docketed.

As petitioner responded to July 8, 2003, decision by completing the petition, the above requirements are considered to be satisfied.

Accordingly, the following relief is being provided to the patent owner:

The NIRC, and the holding therein that the examination was terminated, are withdrawn by the present decision.

The Reexamination Certificate appearing in the *Official Gazette* of May 15, 2001, is vacated by the present decision.

The reexamination file will be returned to the Technology Center for remailing of the November 13, 2000, Office action.

ERRATUM

In order to correct the Office's records, the following erratum will be duly published in the Official Gazette:

> --All reference to Reexamination Certificate U.S. 5,851,505 C1 (4357th) appearing in the *Official Gazette* of May 15, 2001, should be deleted since no Reexamination Certificate was properly issued.--

CONCLUSION

1. The petition is granted.

2. The February 27, 2001, Notice of Intent to Issue Reexamination Certificate, and the holding therein that the examination was terminated, are hereby withdrawn.

3. Reexamination Certificate U.S. 5,851,505 C1 (4357th) appearing in the Official Gazette of May 15, 2001, is hereby vacated.

4. The reexamination file is being returned to Technology Center 1700 for remailing of the Office action of November 13, 2000.

5. Telephone inquiries related to this decision should be directed to Kenneth M. Schor, Senior Legal Advisor, at (703) 308-6710.

Robert J. Spar, Director,
Office of Patent Legal Administration
Office of Assistant Commissioner
for Patent Examining Policy

July 21, 2003
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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

Paper No. 8

John C. Janka (for Patent Owner)
NIRO SCAVONE HALLER & NIRO
181 W. Madison, Suite 4600
Chicago, IL 60602

Joseph A. Twarowski (for Requester)
BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 Wilshire Blvd., 7th Floor
Los Angeles, CA 90025

Gabriel P. Katona, L.L.P. (For a Third Party)
708 Third Ave., 14th Floor
New York, NY 10017

MAILED
NOV 13 2000
REEXAM UNIT

Attachments: Improper papers of 8/29/00

Reexamination of U.S. Patent No. :
5,253,341 to Rozmanith et al. :
Control No. 90/005,742 : **DECISION DISMISSING PETITION**
Filed: June 9, 2000 : **AND RETURNING IMPROPER PAPERS**

This is a decision on the paper entitled "Request for Reexamination" of July 3, 2000, requesting reexamination of the above patent, filed by a third party, Gabriel P. Katona, who is **not** the third party requester in Reexamination Control No. 90/005,742. This is also a decision on the papers entitled "Request for Reexamination at the Initiative of the Director" and "Request for Reexamination" submitted by facsimile transmission on August 29, 2000, by the same third party, Gabriel P. Katona. The "Request for Reexamination" of August 29, 2000, is a duplicate of the request filed July 3, 2000. The "Request for Reexamination at the Initiative of the Director" is being treated as a petition under 37 CFR 1.182.

This petition and papers are before the Office of Patent Legal Administration for decision.

The petition is **DISMISSED** for the reasons set forth below.

REVIEW OF FACTS

1. On October 12, 1993, U.S. Patent No. 5,253,341 was issued to Rozmanith et al. (the '341 patent).

2. On June 9, 2000, a third party requester, Joseph A. Twarowski, filed a first request for reexamination of the '341 patent, which request was assigned Control No. 90/005,742.

3. A second "Request for Reexamination " was filed on July 3, 2000, by a different third party, Gabriel Katona, but was not accompanied by the reexamination filing fee of $2520.00.

4. Reexamination was ordered in the first `5742 proceeding on August 4, 2000.

5. On August 29, 2000, a "Request for Reexamination at the Initiative of the Director"; and a copy of the second "Request for Reexamination" were submitted by facsimile transmission by the third party, Gabriel Katona.

DO NOT ENTER

DECISION

Under 37 C.F.R. § 1.501:

> (a) At any time during the period of enforceability of a patent, any person may cite to the Patent and Trademark Office in writing prior art consisting of patents or printed publications which that person states to be pertinent and applicable to the patent and believes to have a bearing on the patentability of any claim of a particular patent. If the citation is made

> by the patent owner, the explanation of pertinency and applicability may include an explanation of how the claims differ from the prior art. Citations by the patent owner under § 1.555 and by a reexamination requester under either § 1.510 or § 1.535 will be entered in the patent file during a reexamination proceeding. The entry in the patent file of citations submitted after the date of an order to reexamine pursuant to § 1.525 by persons other than the patent owner, or a reexamination requester under either § 1.510 or § 1.535, will be delayed until the reexamination proceedings have been terminated.
>
> (c) . . . If the fee for requesting reexamination has not been paid, no determination will be made and the request will be placed in the patent file as a citation if it complies with the requirements of § 1.501(a).

DECISION MAILED

The July 3, 2000, "Request for Reexamination" was not accompanied by the reexamination filing fee of $2520.00, but the request was filed prior to the order of reexamination proceeding `5742. Note that the paper entitled "Request for Reexamination" filed on August 29, 2000, is a duplicate of the request filed July 3, 2000. Since the request for reexamination of July 3, 2000, complies with the requirements of § 1.501(a), it qualifies as a timely filed prior art citation. Therefore, it will be placed in the patent file as a prior art citation, and will be considered by the examiner in the examination of the `5742 proceeding. The duplicate copy is being returned with this decision.

The August 29, 2000, third party petition under 37 CFR § 1.182 to initiate a Commissioner ordered reexamination was not accompanied by the petition fee required under § 1.17(h), and therefore is **dismissed**. It is noted that had the petition fee been paid, it does not appear that the criteria for a Commissioner ordered reexamination would be present. Accordingly, the August 29, 2000, third party petition under 37 CFR § 1.182 to initiate a Commissioner ordered reexamination is dismissed for lacking the required petition fee required under § 1.17(h). The submission does not qualify as a prior art citation under § 1.501(a) and is being returned herewith.

CONCLUSION

1. The third party request for reexamination, filed July 3, 2000, is incomplete as the reexamination request filing fee was not paid, but the submission is being accepted as a prior art citation under § 1.501.

2. The July 5, 2000, paper has been entered in the patent file as a prior art statement under § 1.501, and will be considered by the examiner in the examination of the '5742 proceeding.

3. The third party paper filed August 29, 2000, taken as a petition under 37 C.F.R. § 1.182, requesting reexamination is **dismissed**.

4. All of the papers of August 29, 2000, are being returned as improper submissions.

5. The reexamination file is being forwarded to the examiner assigned to the proceeding for issuance of a first Office action in due course not inconsistent with this decision.

6. Telephone inquires related to this decision should be directed to Lynn M. Kryza of the Office of Patent Legal Administration, at (703) 308-0255.

Copy provided by USPTO

Lynn M. Kryza
Special Projects Examiner
Office of Patent Legal Administration

November 9, 2000

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Paper No. 38

John C. Janka **(For Patent Owner)**
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Enclosures: August 28, 2003, patent owner appeal brief.
August 11, 2003, patent owner appeal brief filed with petition.

Joseph A. Twarowski **(For Third Party Requester)**
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MAILED

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REEXAM UNIT

Rozmanith et al :
Reexamination Proceeding : DECISION
Control No. 90/005,742 : DENYING
Filed: June 9, 2000 : PETITION
For: U.S. Patent No. 5,253,341 :

The above-identified application has been forwarded to the undersigned for consideration on the "PETITION TO THE COMMISSIONER PURSUANT TO 37 C.F.R. § 1.182 "; TO REQUIRE ACCEPTANCE OF APPELLANTS'S APPEAL BRIEF AS ORIGINALLY SUBMITTED, which was filed on August 11, 2003. The petition is taken as a petition under 37 CFR 1.181(a)(3), to invoke the supervisory authority of the Director of the United States Patent and Trademark Office to reconsider the July 28, 2003, decision of the Group Director of Technology Center 2100.

The present petition under 37 CFR 1.181(a)(3) is **granted** to the extent that the Technology Center Group Director's July 28, 2003, and August 19, 2003, decisions have been reviewed.

The present petition under 37 CFR 1.181(a)(3) is **denied** as to making a change in the ultimate decision by the Group Director.

REVIEW OF FACTS

1. U.S. patent No. 5,253,341 issued on October 12, 1993.

2. A request for reexamination, assigned control No. 90/005,742, was filed by a third party requester on June 9, 2000.

3. Reexamination was ordered for the '5742 reexamination proceeding on August 4, 2000, and the proceeding underwent examination and prosecution.

4. During the prosecution of the '5742 proceeding, the patent owner filed, on June 5, 2001, a petition under 37 CFR 1.182 requesting disqualification of the examiner of record (the examiner assigned the proceeding) from further examination of the proceeding. This petition was treated as a petition under 37 CFR 1.181 to invoke supervisory authority, and it was granted by the Technology Center Group Director on June 5, 2001, based on the statement that:

   > "The currently assigned Examiner's operation of a web site with search capabilities that could conceivably be covered by claims presented during the reexamination proceeding raises the appearance of a possible conflict of interest. Therefore, irrespective of the merits of Petitioners' contentions of actual infringement, it is deemed appropriate to reassign the case so as to avoid any appearance of bias."

5. The '5742 reexamination proceeding was reassigned to another examiner, and progressed to the point where a final rejection Office action was issued on April 15, 2003.

6. After the final rejection action, the patent owner filed a notice of appeal on May 6, 2003, and then, an appeal brief on June 26, 2003.

7. In a decision mailed July 28, 2003, the Technology Center Group Director returned the appeal brief filed June 26, 2003, based upon a determination that the brief contained remarks which were in violation of the courtesy and decorum requirement of 37 CFR 1.3. The patent Owner was afforded a 30 day time limit to resubmit the appeal brief without the inappropriate statements.

8. In response to the July 28, 2003, decision, the patent owner resubmitted the appeal brief, and it was received in the Office on August 13, 2003. This will be identified hereinafter as the "first" resubmission.

9. In a decision mailed August 19, 2003, the Technology Center Group Director returned the first resubmitted appeal brief, stating that the resubmitted appeal brief:

> "does not remove the identified objected to passage. In addition, it refers to the Brief as 'CENSORED BY EXAMINER DONAGHUE'S 7/28/03 ORDER' in multiple locations.
>
> "This submission is not in compliance with the decision of July 28. Accordingly, it is held **NON-RESPONSIVE.**"

The 30 day time limit that commenced on July 28, 2003, was stated to continues to run, and patent owner was advised that failure to timely file a compliant appeal brief would result in the termination of the proceeding.

10. The appeal brief was then resubmitted *twice* by the patent owner. These resubmissions will be identified hereinafter as the "second" and "third" resubmissions. The second resubmission bears an August 28, 2003, date of Office receipt. The third resubmission bears an August 27, 2003, date. The third resubmission is stated therein to have been submitted on the same date as the second resubmission in order to correct an inadvertent error in the Certificate of Mailing provided with the "second" resubmission.

11. On August 11, 2003, the patent owner filed the instant petition under 37 CFR 1.182 requesting that the Technology Center Group Director "be ordered to accept for filing Applicant's appeal brief as originally presented...and that the original appeal brief (which was returned to Appellants) be substituted for the censored brief Applicants were forced by the Group Director's 7/28/03 Order to submit on August 11, 2003." The petition is accompanied by what patent owner characterizes as the originally presented appeal brief. [1]

Control: 90/005,742

DECISION

1. The "first" resubmission of the appeal brief has now been replaced by the "third" resubmission of the appeal brief received on August 27, 2003. Thus, the instant petition is taken as a request to accept the originally presented appeal brief (attached to the petition) in place of *the "third" resubmission.* In addition, the present petition seeks to undo what the Technology Center Group Director decided in the July 28, 2003, and August 19, 2003, decisions. Thus, the petition is taken as a petition under 37 CFR 1.181(a)(3), to invoke the supervisory authority of the Director to reconsider the decisions of the Group Director of Technology Center 2100.

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[1] Since the originally filed appeal brief is not present, it cannot be compared with the copy submitted with the present petition to verify whether it is the same as the originally submitted brief.

The instant petition and the record of the present proceeding have been given a plenary review, and it is found that there is no basis for disturbing the Group Director's decisions of July 28, 2003, and August 19, 2003.

2. 37 CFR 1.3 (Business to be conducted with decorum and courtesy) states as follows:

> "Applicants and their attorneys or agents are required to conduct their business with the Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Commissioner and will be returned by the Commissioner's direct order. Complaints against examiners and other employees must be made in correspondence separate from other papers."

The August 11, 2003, patent owner appeal brief filed with petition contains negative remarks directed to the statements and actions of an examiner who was, but is no longer, the examiner in charge of the present reexamination proceeding. It also contains derogatory remarks as to other parties, assertions of improper third party participation, and a second-hand derogatory remark as to the Office. These remarks have no place in an appeal brief. Pursuant to 37 CFR 1.3 any complaint as to the examiner in charge of the proceeding, or other Office personnel, should have been "made in correspondence separate from" the appeal brief. Further, any complaint as to improper third party participation is addressed by way of petition, and not by way of appeal brief. Likewise, a request for assignment of a different examiner to the proceeding is addressed by way of petition, which patent owner did, and not by way of appeal brief. [2]

In addition, it is to be noted that the appealed claims are either unpatentable over the applied art as a matter of fact and law, or they are not. The statements and actions of a prior examiner or other parties identified in the remarks do not change the determination on appeal as to whether the art teaches/meets the claims. As such, the presence of the negative and derogatory remarks in the appeal brief is not relevant to the decision that the Board of Patent Appeals and Interference's will render as to the patentability issue. That decision will be one of fact and law, based on the merits of the art, the arguments as to that art, and technological evidence proffered. Since the remarks are not relevant as to whether the art teaches/meets the claimed invention, yet they are negative and derogatory, the identified remarks in the appeal brief are deemed to **not** be in good taste. Accordingly, the remarks are found to violate the "decorum" requirement of 37 CFR 1.3. At page 4 of the petition, it is

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[2] As stated in MPEP 1201, "[t]he line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Commissioner of Patents and Trademarks should be carefully observed. The Board will not ordinarily hear a question which it believes should be decided by the Commissioner, and the Commissioner will not ordinarily entertain a petition where the question presented is an appealable matter."

Control No: 90005742 Date Filed: 08/11/2003

suggested by petitioner that "accusations of discourtesy" have been made. The point made here is not, however, that a party was discourteous, but rather that the *remarks* made in the appeal brief are not in good taste and not appropriate.

3. At page 4 of the petition, it is argued that "[t]he Board of Appeals [sic] is entitled to know the full basis of the rulings made during this reexamination, notwithstanding the Group Director's attempt to suppress these important facts."

In this instance, the examiner to which the bulk of the patent owner's remarks are directed is no longer assigned to the proceeding. The final rejection Office action of April 15, 2003, was issued by a different examiner and was initialed by two conferees who are not the original examiner, and to whom none of patent owner's remarks have been directed. Thus, the decision to reject the claims at issue was rendered after a review of the matter by three examiners other than the initial examiner, to whom the complaints directed to the original examiner are not relevant. The "full basis of the rulings made during this reexamination" that are relevant to the rejection of the claims is set forth in the *265 page final rejection issued by the new examiner and initialed by two conferees*, and the patent owner has had the opportunity to address that basis in the appeal brief.

4. The TC Group Director's Ultimate Holding in the Proceeding:

In the present instance, the Technology Center Group Director found that the appeal briefs filed on behalf of patent owner on June 26, 2003, and August 13, 2003, contained remarks which were in violation of the decorum requirement of 37 CFR 1.3, and accordingly, the Group Director returned the June 26, 2003 and August 13, 2003, appeal briefs to the patent owner. The Group Director's ultimate decision is entitled to an administrative presumption of correctness in the absence of a convincing showing of error. In the present decision, based upon a plenary review of the record, as discussed above, it has been determined that the June 26, 2003, and August 13, 2003, appeal briefs contained remarks that were not appropriate to the appeal briefs, for the reasons set forth above. Accordingly, there is no reversible error and no basis for disturbing the Group Director's decisions of July 28, 2003, and August 19, 2003, to return the appeal briefs. Thus, the petition is **denied** as to making a change in the ultimate holding of the Group Director.

RETURN OF PAPERS

In view of the above-noted inappropriate content of the August 11, 2003, appeal brief filed with petition, that appeal brief is being returned to the patent owner.

In addition, the "second" resubmission of the patent owner appeal brief is being returned, because the third resubmission is a replacement for the second, to correct an inadvertent error in the Certificate of Mailing provided with the second resubmission.

CONCLUSION

1. The petition is granted to the extent that the July 28, 2003, and August 19, 2003, decisions of the Group Director have been reviewed, but is **denied** to making any changes therein.

2. The patent owner appeal briefs received August 11, 2003 (with the petition) and August 28, 2003 (the second resubmission) are being **returned** to the patent owner, while the appeal brief of August 27, 2003 (the third resubmission) is being retained.

3. No further reconsideration or review of this matter will be undertaken by way of petition.

4. This decision may be viewed as a **final agency action** within the meaning of 5 U.S.C. 704 for purposes of seeking judicial review. See MPEP 1002.02

5. The reexamination file is being forwarded to the examiner via the Group Director of Technology Center 2100, for action on the retained appeal brief.

6. Telephone inquiries related to this decision should be directed to Kenneth M. Schor, Senior Legal Advisor, at (703) 308-6710.

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

October 1, 2003
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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
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Office of the Director
Group 3600

Reexamination Control No. 90/005,743 – Paper No. 16
Reexamination Control No. 90/005,947 – Paper No.'s 9 15

FOR PATENT OWNER:

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DECISION ON REEXAMINATION MERGER
37 CFR 1.565(c)

Reexam Control Nos. 90/005,743 and 90/005,947

FOR FIRST REQUESTER;

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FOR SECOND REQUESTER;

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NOTICE OF CONSOLIDATION OF REEXAMINATION PROCEEDINGS

Background

1. U.S. Letters Patent No. 5,865,251 issued on February 2, 1999.

2. A first request for reexamination was filed by a third party requester, Richard T. Redano, on June 9, 2000, and was assigned Reexamination Control No. 90/005,743.

3. Reexamination was ordered in Reexamination Control No. 90/005,743 on August 14, 2000.

4. In Reexamination Control No. 90/005,743 the examiner issued a first Office action on January 23, 2001, rejecting claims 4-11 and indicating claims 1-3 and 12 patentable (sic, confirmed).

5. On March 6, 2001, a second request for reexamination of U.S. Letters Patent No. 5,865,251 was filed by a third party requester, J. Dean Lechtenberger and was assigned Reexamination Control No. 90/005,947.

6. In Reexamination Control No. 90/005,743 the patent owner submitted, on March 23, 2001, an amendment that amended claim 7 and added new claims 13 and 14. On that same date the patent owner also submitted an affidavit under 37 CFR 1.132.

7. Reexamination was ordered in Reexamination Control No. 90/005,974 on June 6, 2001.

8. In Reexamination Control No. 90/005,743 the examiner issued a final Office action on July 31, 2001, rejecting claims 4-11 and indicating claims 1-3 and 12 confirmed.

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. 90/005,743 and 90/005,947 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

As noted above, claim 7 was amended and new claims 13 and 14 added in Reexamination Control No. 90/005,743 in the amendment of March 23, 2001. Patent owner must maintain the same claims and the same description/specification in both files. Therefore, patent owner is required to submit an appropriate "housekeeping" amendment within **ONE MONTH** from the mailing date of this decision, placing the same amendment proffered during the first reexamination proceeding in the second reexamination proceeding, i.e. Reexamination Controol No. 90/005,947. Since the time period for submission of a patent owner's statement has expired, 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 subsequent to the required "housekeeping" amendment 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 a separate complete file. 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. 90/005,743 and 90/005,947 are hereby merged and an Office action will be issued by the examiner for *ex parte* prosecution of the merged proceeding. Appropriate submissions by the patent owner, as set forth above, are required within **ONE MONTH** from the mailing date of this decision.

Steven N. Meyers
Special Programs Examiner
Technology Center 3600
(703) 308-3868

Concur:

Al Lawrence Smith
Director
Technology Center 3600

Page 4 of 5

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July 2, 2004

Paper No. 28

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(For Patent Owner)

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(For Requester)

In re Rebardi, et al.
Reexamination Proceeding
Control No. 90/005,743
Filed: June 9, 2000
For: U.S. Patent No. 5,865,251

DECISION GRANTING PETITION

In re Rebardi, et al.
Reexamination Proceeding
Control No. 90/005,947
Filed: March 6, 2001
For: U.S. Patent No. 5,865,251

This is a decision on the patent owner petition filed November 26, 2003, for entry of late papers based upon unintentional delay under 37 CFR 1.137(b). Patent owner requests entry of a late-filed reply brief under 37 CFR 1.193(b)(1); and entry of a late-filed request for oral hearing under

37 CFR 1.194(b). The petition is before the Office of Patent Legal Administration for consideration.

The petition fee of $1,330 pursuant to 37 CFR 1.17(m) for the petition under 37 CFR 1.137(b), and the fee for the request for oral hearing of $290 pursuant to 37 CFR 1.17(d), have been charged to the deposit account 23-2053 as authorized in the respective papers.

The petition for entry of late papers based upon unintentional delay is **granted** for the reasons indicated below.

REVIEW OF FACTS

1. On January 31, 2002, patent owner filed a notice of appeal.

2. On March 29, 2002 patent owner filed the appeal brief.

3. On September 10, 2003, the examiner's answer was mailed.

4. Any reply brief and/or request for oral hearing was due no later than November 10, 2003.

5. On November 26, 2003, the following papers were filed by the patent owner:

   a. a reply brief under 37 CFR 1.193(b)(1);

   b. a request for oral hearing under 37 CFR 1.194(b); and,

   c. a petition for entry of late papers based upon unintentional delay under 37 CFR 1.137(b).

DECISION

Under 37 CFR 1.193(b)(1), patent owner may file a reply brief as a matter of right within two months from the mailing date of the examiner's answer. Extensions of time to file the reply brief may be granted pursuant to 37 CFR 1.550(c). MPEP 1208.03. Further, 37 CFR 1.194(b) provides that a patent owner who desires an oral hearing before the Board of Patent Appeals and Interferences (Board) must request the oral hearing within two months after the date of the examiner's answer. This time period may only be extended by filing a request for extension under 37 CFR 1.550(c). MPEP 1209.

Under 37 CFR 1.550(c):

> "The time for taking any action by a patent owner in an ex parte 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)."

Under the rules, the time for filing a reply brief and the time for filing a request for oral hearing may be extended. Under 37 CFR 1.550(c), however, a request for an extension of time for filing either or both papers must be filed before the expiration of the two-month period. As noted in the above review of facts, the reply brief and the request for oral hearing which were due no later than November 10, 2003, were filed on November 26, 2003, sixteen days after the due date. No request for extension of time was filed. On the same date (sixteen days from the due date), patent owner requested, by petition, acceptance and entry of the late papers under the unintentional delay standards of 37 CFR 1.137(b).

Under 37 CFR 1.550(e)(2):

> "(e) If a response by the patent owner is not timely filed in the Office, . . .
>
> (2) The response may nevertheless be accepted if the delay was unintentional; a petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b)."

As noted, 37 CFR 1.550(e)(2) provides an avenue of relief for the patent owner when a paper is not timely filed. The paper may be accepted under the guidelines of an unintentionally delayed response set forth in 37 CFR 1.137(b).

A grantable petition under 37 CFR 1.137(b) must be accompanied by:

(1) the paper for which the delay is to be excused, 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 paper from the due date for the paper until the filing of a grantable petition pursuant to 37 CFR 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 CFR 1.137(b) was unintentional, the Director may require additional information. See MPEP 711.03(c)(III)(C) and (D). In view of the fact that the petition was promptly filed sixteen days after the due date, no exceptional circumstances are seen which would indicate the need for any additional information.

In the present instance:

1. The reply brief to the Examiner's Answer of September 10, 2003, and the request for oral hearing have been received.

2. The petition is accompanied by the petition fee.

3. A statement is contained in the present petition which is being construed as the statement required by 37 CFR 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 the late papers is sufficient to meet the criteria set forth under 37 CFR 1.137(b). Accordingly, the papers will be accepted under the provisions of 37 CFR 1.550(e)(2).

CONCLUSION

1. The petition is **granted**.

2. The reply brief will be entered as timely filed. The reexamination file will be forwarded to Technology Center 3600 for consideration of the reply brief.

3. The request for oral hearing will be entered as timely filed. It is to be noted that this decision only excuses the delay (pursuant to 37 CFR 1.550(e)(2)) as to the filing of the request for oral hearing under 37 CFR 1.194(b). This decision does not address nor decide whether an oral hearing is necessary. That determination remains at the Board's discretion under 37 CFR 1.194(c) (last sentence).

4. Further inquiries with regard to this reexamination proceeding should be directed to the examiner, Hoang Dang, of Group Art Unit 3672.

5. Telephone inquiries with regard to this decision should be directed to the undersigned at (703) 308-5107.

Robert J. Spar
Director
Office of Patent Legal Administration

C:\zJerry\90_5743-5947 reply brief accepted via unintentional copy A wpd

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NOV 20 2000

REEXAM UNIT

Thomas P. Pavelko
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(For Requester)

DECISION MAILED

In re reissue application of :
Pervan :
Application No. 09/343,696 :
Filed: June 30, 1999 :
For: U.S. Patent No. 5,706,621 :
:
: **DECISION, SUA SPONTE,**
: **TO MERGE REEXAMINATION**
In re Pervan : **AND REISSUE PROCEEDINGS**
Reexamination Proceeding :
Control No. 90/005,744 :
Filed: June 13, 2000 :
For: U.S. Patent No. 5,706,621 :

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. 5,706,621 issued to Pervan on January 13, 1998.

2. On June 30, 1999, a reissue application was filed and assigned application no. 09/343,696, which amended claims 3 and 6, and added claims 24-40, and a notice of the reissue was published in the *Official Gazette* on August 31, 1999.

3. A nonfinal Office action was mailed in the reissue application on April 13, 2000.

4. On June 13, 2000, a request for reexamination of the '621 patent was filed by a third party requester, and was assigned Control No. 90/005,744.

5. On September 7, 2000, reexamination was ordered.

6. No patent owner's statement was filed in response to the order.

09/343,696 - 12/5/2005

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 claims 3 and 6, and added new claims 24-40. A review of the reexamination file shows that reexamination was ordered on September 7, 2000, and is awaiting a first Office action. Original patent claims 1-23 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.

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 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 above noted reissue application and reexamination proceeding ARE MERGED.

2. The reissue and reexaminations file are being forwarded to the examiner via the Director of Technology Center 3600. 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.

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)308-0255.

Lynn M. Kryza
Special Projects Examiner
Office of Patent Legal Administration

November 17, 2000

#15 DW

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

APR 24 2002

Thomas E. Anderson (For Requester)
Gifford Krass Groh Sprinkle
Anderson & Citkowski PC
280 North Old Woodward Ste 400
Birmingham, MI 48009

MAILED

APR 24 2002

OFFICE OF THE DIRECTOR
TC 3600

Remy J Vanophem (For Patent Owner)
Vanophem Meehan and Vanophem PC
755 West Big Beaver Road Ste. 1313
Troy, MI 48084-4903

In re Reexamination Control No. 90/005,749 : DECISION ON PETITION
Filed June 15, 2000 : TO MAKE APPLICATION
For: U.S. Patent No. 5,771,752 : SPECIAL
:

This is a decision on the petition submitted on March 29, 2002 to make the above-identified reexamination proceeding special on the basis that applicant is over 65 years of age or, in the alternative, on the basis of infringement.

The petition is **DENIED**.

Petitioner is advised that although patent applications made be made special under the provisions of 37 CFR 1.102, reexamination proceedings are not covered under this rule inasmuch as they are not patent applications. Furthermore, reexamination proceedings are examined with special dispatch. See MPEP 708, 2261 and 35 U.S.C. 305.

The application is being forwarded to the examiner for consideration of the Appeal Brief filed March 29, 2002.

Kenneth J. Dorner

Kenneth J. Dorner
Special Programs Examiner
Technology Center 3600
dw/kd: 4/17/02

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

JUL 14 2005

FOR PATENT OWNER:

Remy J. VanOphem
VanOphem, Meehan and VanOphem PC
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Troy, MI 48084-4903

FOR REQUESTER:

Thomas E. Anderson
Gifford, Krass, Groh, Sprinkle, Anderson & Citkowski PC
280 North Old Woodward, Suite 400
Biringham, MI 48009

DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY

Reexamination Control No. 90/005,749

This is a decision on the request filed on June 30, 2005 under 37 CFR 1.36 and MPEP 402.06, requesting permission to withdraw as the attorney of record for the patent owner in the above-identified reexamination proceeding.

The request is **NOT APPROVED**.

Under 37 CFR 1.36 an attorney may withdraw only upon application to and approval by the Director. It should be noted that a withdrawal is effective when approved, not when filed. Besides giving due notice to his or her client and delivering to the client all papers and property to which the client is entitled as specified under 37 CFR 10.40, approval of such a request requires that the following conditions be met:

A) Each attorney of record must sign the notice of withdrawal, or the notice must contain a clear indication of one attorney signing on behalf of another, because the Office does not recognize law firms;

B) A proper reason for the withdrawal as enumerated in 37 CFR 10.40(b) or subsection (1)-(6) of 37 CFR 10.40(c) must be provided; and

C) There must be at least 30 days between approval of the withdrawal and the expiration date of a time period for reply.

The request to withdraw as attorney in the above-identified application is not approved because the request does not comply with items B) and C) above.

With respect to item B) no reason has been provided for the withdrawal request. Reasons for withdrawal should conform to those set forth in 37 CFR 10.40(b) or subsection (1)-(6) of 37 CFR 10.40(c).

As for item C) an Office action was mailed to the correspondence address of record on May 26, 2005. This Office action set a two month shortened statutory period for response, making the date on which the response is due July 26, 2005. Since the request was not submitted until June 30, 2005, it is impossible for there to be at least a 30-day time period between approval of the withdrawal request and the expiration date of the current response period.

Randolph A. Reese
Special Programs Examiner
Patent Technology Center 3600
(571) 272-6619

RAR: 7/13/05

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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JUN 17 2002

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(For Requester)

Reexam Control No.: 90/005,747
Filed: June 21, 2000
For: U.S. Patent No. 5,207,675

Reexam Control No.: 90/006,115
Filed: September 24, 2001
For: U.S. Patent No. 5,207,675

Reexam Control No.: 90/006,128
Filed: October 12, 2001
For: U.S. Patent No. 5,207,675

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. 90/005,757 was ordered in a decision mailed September 7, 2000. A non-final office action was mailed June 24, 2001. A response to the Office action of June 24, 2001 was filed August 3, 2001.

Reexamination in application Control No. 90/006,115 was ordered in a decision mailed November 29, 2001. Patent Owner did not file a statement under 37 CFR 1.530.

Reexamination in application Control No. 90/006,128 was ordered in a decision mailed November 29, 2001. Patent Owner did not file a 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 All Proceedings

The Patent Owner is required to maintain identical specifications, drawings, claims, and claim numbering in all files. In view of the fact that all applications contain identical specifications, drawings, and claims, no amendment is required.

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 all proceedings. All papers issued by the Office or as 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 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. See 37 CFR 1.565 (d).

Conclusion

At this time there is no further action required by the Patent Owner. These proceedings will be forwarded to the examiner for an action on the merits.

John E. Kittle, Director
Groups 3730 & 3760
Phone: (703) 308-0873

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.
90/005,758	06/23/00	RE35575	

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MM41/0103

EXAMINER
ULLAH, A

ART UNIT	PAPER NUMBER
2874	7

DATE MAILED: 01/03/01

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

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 7

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George A. Quadrino (For Third Party Requester)
FARKAS & MANELLI PLLC
2000 M Street, N.W., 7th Floor
Washington, D.C. 20036-3307

In re Jing-Jong Pan :
Reexamination Proceeding :
Control No. 90/005,613 :
Filed: January 19, 2000 :
For U.S. Patent No: RE35,575 : DECISION MERGING
: REEXAMINATION
: PROCEEDINGS

In re Jing-Jong Pan :
Reexamination Proceeding :
Control No. 90/005,614 :
Filed: January 19, 2000 :
For U.S. Patent No. RE35,575 :
:
:

In re Jing-Jong Pan :
Reexamination Proceeding :
Control No. 90/005,758 :
Filed: June 23, 2000 :
For U.S. Patent No. RE35,575 :

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. RE35,575 was issued on July 29, 1997. RE35,575 is a reissue patent of Patent No. 5,208,876

2. Reexamination Control No. 90/005,613 and Reexamination Control No. 90/005,614 were requested by the patent owner on January 19, 2000.

3. Reexamination was ordered in both the '5613 reexamination proceeding and the '5614 reexamination proceeding on April 5, 2000.

4. Reexamination Control No. 90/005,758 was requested by a third party requester on June 23, 2000.

5. Reexamination was ordered in the '5758 reexamination proceeding on September 5, 2000.

6. No statement by the patent owner was received in the '5613 reexamination proceeding, in the '5614 reexamination proceeding, or in the '5758 reexamination proceeding.

7. A Power of Attorney by Assignee and Revocation of Previous Powers for the '5614 reexamination proceeding, submitted by E-TEK Dynamics, Inc., was received on July 6, 2000[1].

8. A Change of Address of the third party requester was received, via facsimile transmission, on September 29, 2000.[2]

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[1]Since all three reexamination proceedings are for the same U.S. Patent RE35,575, the correspondence address of the patent owner for all three proceedings will be the address of Michael J. Mallie.

[2]Since the address of the third party requester has been changed, the patent owner is reminded that all future correspondence relating these reexamination proceedings must be served

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 '5613 and '5614 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.

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on the third party requester at the address indicated on the first page of this decision.

CONCLUSION

Reexamination Control Nos. '5613, '5614 and '5758 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

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UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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#6
(mailed 11/28)

James G. O'Neill (For Patent Owner)
3151 Airway Ave.
Suite K-105
Costa Mesa, CA 92626

Enclosure: Petition papers of November 8, 2000

John S. Egbert (For Requester)
HARRISON & EGBERT
1018 Preston
Suite 100
Houston, TX 77002

MAILED
NOV 28 2000
REEXAM UNIT

In re Voo :
Reexamination Proceeding : DECISION
Control No. 90/005,764 : DISMISSING
Filed: July 3, 2000 : PETITION
For: U.S. Patent No. Des. 400,970 :

This is a decision on the November 8, 2000, third party requester PETITION UNDER 37 CFR 1.183 requesting waiver of the rules to permit entry and consideration of the November 8, 2000, third party requester PETITION UNDER 37 CFR 1.515(c) requesting reconsideration of the decision denying the request for reexamination mailed September 13, 2000. Petitioner urges that the one month deadline to respond to the decision denying the request for reexamination mailed September 13, 2000, be suspended. The petition is before the Office of Patent Legal Administration for decision.

The petition is dismissed for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Design Patent No. 400,970 issued to Voo on November 10, 1998.

2. On July 3, 2000, a request for reexamination of U.S. Design Patent No. 400,970 was filed by a third party requester.

3. On September 13, 2000, the examiner denied the request for reexamination on the grounds that the patents did not raise a substantial new question of patentability.

4. On November 8, 2000, the third party requester filed the present PETITION PURSUANT TO 37 CFR 1.183 to waive the rules and suspend the ONE MONTH deadline to permit entry and consideration of the November 8, 2000, PETITION PURSUANT TO 37 CFR 1.515(c), requesting reconsideration of the examiner's decision denying the request for reexamination.

DECISION

This reexamination proceeding terminated after October 13, 2000, for failure to timely file a petition requesting reconsideration of the decision denying the request for reexamination mailed September 13, 2000, which set a period for seeking review by petition to the Commissioner of ONE (1) MONTH, and noted that extensions of time were governed by 37 CFR 1.183.

It should be noted that 37 CFR 1.183 Suspension of rules states:

> 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 Commissioner or the Commissioner'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(h).

The petition is dismissed. Section 303(c) of Title 35 provides that once the United States Patent and Trademark Office (Office) issues its final determination to deny a request for reexamination, that determination is final and nonappealable. 37 CFR 1.515(c) of the rules permits the requester to seek review of the examiner's decision denying the reexamination within one month of the mailing date thereof. If such a review is not sought by petition (pursuant to 37 CFR 1.515(c)), the Office's denial becomes its final determination on the matter and the reexamination proceeding terminates. The one month time period for seeking review of the examiner's decision denying the reexamination can be extended by obtaining a waiver of the rule under 37 CFR 1.183, but only if the petition requesting waiver of the rule is filed **prior** to the end of the one-month time period, because the reexamination proceeding has not yet terminated. However, once the time for seeking review has passed, the Office's denial is final and nonappealable, and the reexamination proceeding has terminated by statute. Once the reexamination has terminated, the time for seeking review cannot be extended (as requested in the instant petition) by a waiver of the rule because such a waiver would be tantamount to a waiver of the statute. The Office does not have the authority to waive the statute.

However, even if the petition pursuant to 37 CFR 1.183, had been filed **prior** to the end of the one-month time period for seeking review of the examiner's decision denying the reexamination, it would have been dismissed for the following reasons.

Petitioner contends that the suspension of the one month deadline is proper because the requester never intended to "abandon" the reexamination request, and because the requester's attention had been focused on other matters. However, the statute requires that reexamination be conducted with **special dispatch**, and establishes the one month time period for seeking review of the examiner's decision denying the reexamination. Note that Petitioner has provided no evidence showing that the delay in responding was unavoidable and/or that the response could not have been timely presented. In the absence of such evidence, petitioner's contentions are insufficient, as no extreme circumstances have been described and no fact pattern has been presented to establish that an extraordinary situation has occurred during the '5764 reexamination proceeding, for which justice requires that the Commissioner waive the rules.

Accordingly, the petition is **dismissed** and it will not be made of record in the reexamination file.

Lack of Service:

It should also be noted that the requisite proof of service on the patent owner was not included with the instant petition papers. Pursuant to 37 CFR 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."

Any future communications filed by the third party requester in the present proceeding must include proof of service on the patent owner.

Accordingly, the petition is **dismissed** and it will not be made of record in the reexamination file. While ordinarily the petition would be returned to the third party requester, in this instance it is being forwarded to the patent owner, since there is no indication that the patent owner 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 petition of requester is being forwarded to the patent owner, to provide patent owner with a copy of the papers.

3. The reexamination file is being returned to Technology Center 2900 for termination of the proceedings.

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

November 28, 2000

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.
907005,770	07/14/00	5346306	7641 2015

MM21/1218

ASLAN BAGHDADI
SHAW PITTMAN
2300 N STREET NW
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EXAMINER	
BENNETT,G	
ART UNIT	**PAPER NUMBER**
2859	6

DATE MAILED: 12/18/00

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DOCKET ALERT

UNITED STATES DEPARTMENT OF COMMERCE
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Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
90/005,770	07/14/00	5346306	7641-2015

MM21/1218

LAWRENCE B. GOODWIN
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EXAMINER
BENNETT, G

ART UNIT	PAPER NUMBER
2859	

DATE MAILED: 12/18/00

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 6/9

Alsan Bagdadi (For Patent Owner)
SHAW PITTMAN
2300 N Street, N.W.
Washington, D.C. 20037

Lawrence B. Goodwin (For Third Party Requester)
ORRICK, HERRINGTON & SUTCLIFFE
666 Fifth Avenue
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.

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.

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.
9[illegible]	[illegible]	5761648	[illegible]

TM11/1206

THOMAS G SCAVONE ESQ & MICHAEL P MAZZA E
NIRO SCAVONE HALLER AND NIRO
181 WEST MADISON STREET SUITE 4600
CHICAGO IL 60602

EXAMINER
POINVIL[illegible]

ART UNIT	PAPER NUMBER
2[illegible]	8

DATE MAILED: 12/06/00

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WASHINGTON, D.C. 20231
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Paper No. 8

Thomas G. Scavone Esq. and Michael P. Mazza Esq. Niro Scavone Haller and Niro 181 West Madison Street Chicago, Illinois 60602	)	FOR OWNER
Harold N. Wells Esq. Jenkens & Gilchrist PC 1455 Ross Avenue, Suite 3200 Dallas, Texas 75202-2799	)	FOR FIRST THIRD PARTY REQUESTER
Catalina Marketing International, Inc. c/o Harold N. Wells Esq. Jenkens & Gilchrist PC 321 North Clark Street, Suite 800 Chicago, Illinois 60610-4714	)	FOR SECOND THIRD PARTY REQUESTER
In re Golden et al. Reexamination Proceeding Control No. 90/005,641 Filed: February 18, 2000 For: U.S. Patent No. 5,761,648	)	DECISION SUA SPONTE, MERGING REEXAMINATION PROCEEDINGS
In re Golden et al. Reexamination Proceeding Control No. 90/005,773 Filed: July 17, 2000 For: U.S. Patent No. 5,761,648	)	

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. 5,761,648 issued on June 2, 1998.

2. A first request for reexamination, Control No. 90/005,641 ('641) was filed by the Third Party Requester on February 18, 2000.

3. Reexamination was ordered in the '641 reexamination proceeding on May 2, 2000.

4. A second request for reexamination, Control No. 90/005,773 ('773) was filed by the Third Party Requester on July 17, 2000.

5. Reexamination was ordered in the '773 reexamination proceeding on September 20, 2000.

6. An Interview was held on November 28, 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 '641 and '773 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 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.

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.

John J. Love, Director
Technology Center 2100
Computer Architecture, Software, and Electronic Commerce

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.
90/005,776	07/28/00	5848159	

TM11/1206
TOWNSEND AND TOWNSEND AND CREW
TWO EMBARCADERO CENTER 8TH FLOOR
SAN FRANCISCO CA 94111-3834

EXAMINER	
SEAL, J	
ART UNIT	**PAPER NUMBER**
2131	#6

DATE MAILED: 12/06/00

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

Commissioner of Patents and Trademarks

DO NOT ENTER

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Washington, D.C. 20231
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Leah Sherry OPPENHEIMER WOLFF & DONNELLY LLP 3373 Hillview Avenue, Suite 200 Palo Alto, CA 94304	FOR OWNER
Patent Administrator TESTA, HURWITZ & THIBEAULT, LLP High Street Tower 125 High Street Boston, MA 02110	FOR THIRD PARTY REQUESTOR
In re Collins et al. Reexamination Proceeding Control No. 90/005,733 Filed: May 18, 2000 For: U.S. Patent No. 5,848,159	DECISION SUE SPONTE MERGING REEXAMINATION PROCEEDINGS
In re Collins et al. Reexamination Proceeding Control No. 90/005,776 Filed: July 28, 2000 For: U.S. Patent No. 5,848,159	

Do not detach

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. 5,848,159 issued on December 08, 1998.

2. A first request for reexamination, Control No. 90/005,733 ('733) was filed by the Patent Owner on May 18, 2000.

3. Reexamination was ordered on the '733 reexamination proceeding on July 19, 2000.

4. A second request for rexamination, Control No. 90/005,776 ('776) was filed by the Third Party Requestor on July 28, 2000.

5. Reexamination was ordered on the '776 reexamination proceeding on August 31, 2000.

6. A Power of Attorney was filed by the Patent Owner on September 18, 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 '733 and '776 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 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 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.

John J. Love, Director
Technology Center 2100
Computer Architecture, Software,
and Electronic Commerce

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.
90/005,776			

EXAMINER

Leah Sherry
OPPENHEIMER WOLFF & DONNELLY LLP
1400 Page Mill Ave.
Palo Alto, CA 94304

ART UNIT	PAPER NUMBER
	7

DATE MAILED: 23 FEB 2001
remailed

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Leah Sherry OPPENHEIMER WOLFF & DONNELLY LLP 3373 Hillview Avenue, Suite 200 Palo Alto, CA 94304	FOR OWNER
Patent Administrator TESTA, HURWITZ & THIBEAULT, LLP High Street Tower 125 High Street Boston, MA 02110	FOR THIRD PARTY REQUESTOR
In re Collins et al. Reexamination Proceeding Control No. 90/005,733 Filed: May 18, 2000 For: U.S. Patent No. 5,848,159	DECISION SUE SPONTE MERGING REEXAMINATION PROCEEDINGS
In re Collins et al. Reexamination Proceeding Control No. 90/005,776 Filed: July 28, 2000 For: U.S. Patent No. 5,848,159	

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. 5,848,159 issued on December 08, 1998.

2. A first request for reexamination, Control No. 90/005,733 ('733) was filed by the Patent Owner on May 18, 2000.

3. Reexamination was ordered on the '733 reexamination proceeding on July 19, 2000.

4. A second request for rexamination, Control No. 90/005,776 ('776) was filed by the Third Party Requestor on July 28, 2000.

5. Reexamination was ordered on the '776 reexamination proceeding on August 31, 2000.

6. A Power of Attorney was filed by the Patent Owner on September 18, 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 '733 and '776 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 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 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.

John J. Love, Director
Technology Center 2100
Computer Architecture, Software,
and Electronic Commerce

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

#12 (mail)

Leah Sherry
OPPENHEIMER, WOLFF & DONNELLY, LLP
1400 Page Mill Avenue
Palo Alto, CA 94304

(For Patent Owner)

Patent Administrator
TESTA, HURWITZ & THIBEAULT, LLP
125 High Street
Boston, MA 02110

(For Requester)

MAILED

MAR 14 2001

REEXAM UNIT

In re Collins et al.
Reexamination Proceeding
Control No. 90/005,733
Filed: May 18, 2000
For: U.S. Patent No. 5,848,159

In re Collins et al.
Reexamination Proceeding
Control No. 90/005,776
Filed: July 28, 2000
For: U.S. Patent No. 5,848,159

In re reissue application of
Collins et al.
Serial No. 09/694,416
Filed: October 20, 2000
For: U.S. Patent No. 5,848,159

DECISION TO SUA SPONTE 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. 5,848,159 issued to Collins et al. on December 8, 1998.

2. A request for reexamination of the `159 patent was filed by patent owner on May 18, 2000, and the resulting reexamination proceeding was assigned Control No. 90/005,733.

3. On July 19, 2000, reexamination was ordered in the `5733 proceeding.

4. A request for reexamination of the `159 patent was filed by a third party requester on July 28, 2000, and the resulting reexamination proceeding was assigned Control No. 90/005,776.

5. On August 31, 2000, reexamination was ordered in the `5776 proceeding.

6. In the `5733 proceeding, a patent owner's statement under 37 C.F.R. § 1.530 in response to the order was received on September 22, 2000.

7. On October 20, 2000, patent owner filed a reissue application which was assigned Application No. 09/694,416.

8. Notice of the filing of the reissue application was published in the *Official Gazette* on December 5, 2000.

9. On December 6, 2000, a decision merging the `5733 and `5776 reexamination proceedings was mailed.

10. On February 23, 2001, the decision merging the `5733 and `5776 reexamination proceedings was re-mailed.

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 `5733 and `5776 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 history of the `5733 reexamination file and the `5776 reexamination file shows that the original specification, drawings and patent claims are presently in the `5733 and `5776 reexamination files. On December 6, 2000, a decision merging these two reexamination proceedings was mailed. On February 23, 2001, the decision merging these two reexamination proceedings was re-mailed. These merged reexamination proceedings are awaiting a first Office action on the merits by the examiner.

A review of the reissue (Application No. 09/694,416) prosecution history shows that the reissue application was published in the *Official Gazette* on December 5, 2000. The application is awaiting

a first Office action on the merits by the examiner. In addition to amending the specification and patent claims 1-13, in the reissue application, applicant has submitted new claims 14-61 for consideration. Thus, the claims are not 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 reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application 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 *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 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). **An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in all three cases**, specifically, Application No. 09/694,416, and Control Numbers 90/005,733 and 90/005,776. The response to the requirement must be limited to placing the same amendments in all three 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 two (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 reexamination proceedings. Each action will contain identifying data *for all three of the cases*, i.e, the reissue application and the 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 the three files, with each of the three 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 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 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 two 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 C.F.R. § 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 two 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 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 *as to the reissue application*, a stay of the CPA reissue application, and separate, continued prosecution as to the two reexamination proceedings that will remain merged as one proceeding.

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 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 ONE (1) MONTH of this decision**, placing the same amendments in all three 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 proceedings **after** the earlier of:

(a) the submission of the housekeeping amendment to place the same amendments in all three 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
Special Projects Examiner
Office of Patent Legal Administration

March 13, 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.
09/694,416	10/20/00	Thomas Collins	20206-014 (PT

PATENT NUMBER	DATE OF THIS NOTICE
5,848,159	03/14/01

PAPER NUMBER
13

NOTICE OF MERGED REEXAM - REISSUE PROCEEDING

This reissue application has been merged with the reexamination proceeding listed below:

Control No. 90/ 005,733 Filing Date: 05/18/00
90/ 005,776 Filing Date: 07/28/00

Requester (name, address) Patent Administrator
Testa, Hurwitz & Thibeault, LLP
125 High Street
Boston, MA 02110

The front face of the reissue patent will include the following paragraph:

REEXAMINATION RESULTS

The questions raised in reexamination request No. 90/ 005733** , filed 05/18/00** , 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).

**AND REEXAMINATION REQUEST NO. 90/005,776, FILED ON 07/28/00

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. 24

LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza
Suite 4900
Chicago, IL 60601-6780

(For Patent Owner)

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JUL 19 2002

REEXAM UNIT

In re Callant et al.
Reexamination Proceeding
Control No. 90/005,782
Filed: August 4, 2000
For: U.S. Patent No. 5,116,722

DECISION DISMISSING PETITION

This is a decision on the May 6, 2002, patent owner "conditional" petition for an extension of time or petition for entry of belated papers filed under 37 C.F.R. § 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.

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 "conditional" petition requests relief under two different rules, which technically is improper and should have been presented in two 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 two-part petition decision, as follows below.

The petition fee of $1280.00 pursuant to 37 C.F.R. § 1.17(m) for the petition under 37 C.F.R. § 1.137(b) has been charged to deposit account no. 12-1216, as per petitioner's instructions on page 3 of the present petition.

The petition requesting an extension of time is **dismissed**.

The petition for revival under 37 C.F.R. § 1.137(b) based upon unintentional delay 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

Part I. Petition under 37 C.F.R. §1.550(c)

With regard to third party requester's petition under 37 C.F.R. § 1.550(c), requesting an extension of time in the instant reexamination proceeding, it should be noted that 37 C.F.R. § 1.550(c) states:

> The time for taking any action by a patent owner in an *ex parte* 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.

Since the due date for filing the required reply, in this case the appeal brief, was April 15, 2002, the request for an extension of time is not timely and is therefore **dismissed**.

Part II. Petition under 37 C.F.R. § 1.137(b)

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 petition fee. The instant petition lack(s) items (1) and (3) above. Since this case is a reexamination proceeding, the required reply set forth in 37 C.F.R. § 1.137(b)(1) can only be an appeal brief in compliance with 37 C.F.R. § 1.192(c) and appeal brief fee, as neither RCE practice, nor continuing application practice are applicable to reexamination proceedings. However, an appeal brief has **not** been received. Instead, patent owner filed a second request for reexamination of U.S. Patent No. 5,116,722 on the same date as the instant petition, which reexamination request was assigned Control No. 90/006,293, and was ordered on July 15, 2002[1]. It should also 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 delay in submitting these papers from the due date for filing the

[1] Note that the filing of and granting of this second reexamination request does **not** obviate the need to file a grantable petition pursuant to 37 C.F.R. § 1.137(b) based upon unintentional delay, including the required reply, i.e., appeal brief, in the instant reexamination proceeding. A failure to file a grantable petition based upon unintentional delay in the present reexamination proceeding will result in dismissal of the appeal and termination of the instant proceeding via issuance of a Notice of Intent to Issue Reexamination Certificate (NIRC) cancelling all patent claims. This would necessitate that the USPTO vacate the second reexamination proceeding, Control No. 90/006,293, as no claims would remain in the patent to be reexamined.

Appeal Brief (April 15, 2002) until the filing of this petition 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. The reexamination file will be stored in the Central Reexam Unit (CRU) for one month to await any such renewed petition. If no such renewed petition is timely received, the reexamination file will be forwarded to Technology Center 1700 for dismissal of the appeal, termination of the proceeding, and issuance of the Notice of Intent to Issue Reexamination Certificate (NIRC).

4. 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

July 19, 2002

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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. 27

LEYDIG, VOIT & MAYER, LTD.
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Chicago, IL 60601-6780

(For Patent Owner)

MAILED

AUG 1 4 2002

REEXAM UNIT

In re Callant et al.
Reexamination Proceeding
Control No. 90/005,782
Filed: August 4, 2000
For: U.S. Patent No. 5,116,722

DECISION GRANTING PETITION

This is a decision on the patent owner renewed PETITION UNDER 37 C.F.R. § 1.137(b) of August 8, 2002, for the entry of late papers on the grounds of unintentional delay, requesting the entry of the late filed Appeal Brief accompanying the petition. The Appeal Brief is filed in triplicate, and the appeal brief fee under 37 C.F.R. § 1.17(c) of $320.00 has been charged to petitioner's deposit account 12-1216, as authorized on page 2 of the instant petition. The petition fee under 37 C.F.R. § 1.17(m) of $1280.00, for the reexamination proceeding was paid with the previous petition of May 6, 2002. The renewed petition is before the Office of Patent Legal Administration for decision.

The renewed petition under 37 C.F.R. § 1.137(b) is **granted** for the reasons indicated below.

DECISION

The renewed petition of August 8, 2002, was accompanied by the reply required by 37 C.F.R. § 1.137(b)(1), specifically the appeal brief in triplicate and the appeal brief fee, as well as 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 under 37 C.F.R. § 1.137(b) was unintentional.

The petition fee, in compliance with 37 C.F.R. § 1.137(b)(2), was paid with the previous petition of May 6, 2002.

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 patent examiner, Thorl Chea, in Group Art Unit 1752.
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

August 13, 2002

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
www uspto gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/005,782 / 90/006,293	08/04/2000	5116722	A32890	5596

7590 11/05/2002

Leydig, Voit & Mayer, Ltd.
Two Prudential Plaza,
Suite 4900
Chicago, IL 60601-6780

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/05/2002

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

90005782 . 110502

PTO-90C (Rev 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, D.C. 20231
WWW.USPTO.GOV

Mailed: CST

Paper No. 28

Leydig, Voit & Mayer, Ltd.
Two Prudential Plaza, Suite 4900
180 North Stetson Avenue
Chicago, IL 60601-6780

(for Patent Owner)

In re Callant et al
Reexamination Proceeding
Control No. 90/005,782
Filed: August 4, 2000
For: U.S. Patent 5,116,722

In re Callant et al
Reexamination Proceeding
Control No. 90/006,293
Filed: May 6, 2002
For: U.S. Patent 5,116,722

DECISION MERGING REEXAMINATION PROCEEDINGS

The above noted reexamination files are before the Director of Technology Center 1700 for consideration of the proceedings under 37 C.F.R. 1.565(c).

BACKGROUND

1. United States Patent 5,116,722, issued May 26, 1992, is the subject of Reexamination Control Nos. 90/005,782 and 90/006,293.

2. A first request for reexamination, assigned Reexamination Control No. 90/005,782 ('5782), was filed August 4, 2000 by Baker Botts, LLP. The request urged that a substantial new question of patentability was raised by the teachings of (a) "Ein führung in die Technologie Photographischer Silberhalogenidschicten" by Zwicky; (b) Japanese patent 63-286,243 to Ikeda; and (c) U.S. patent 4,897,343 to Ikeda et al.

3. Reexamination was ordered for '5782 on October 12, 2000.

4. A Patent Owner's Statement, which included amendments to the claims, was submitted on December 12, 2000.

5. A first Office action for '5782 was mailed on February 8, 2001.

6. Patent owner responded to the first Office action on May 30, 2001. This response included an amendment to the claims.

7. A final Office action for '5782 was mailed on August 15, 2001.

8. Patent owner responded to the final Office action on February 14, 2002.

9. Patent owner filed a Notice of Appeal on February 15, 2002.

10. An Advisory action for '5782 was mailed on March 15, 2002. The examiner indicated that the amendments proposed after final rejection would not be entered.

11. Patent owner filed a "conditional" petition for an extension of time or petition under 37 C.F.R. 1.137(b) for entry of belated papers on May 6, 2002.

12. A decision was issued by a Patent Special Projects Advisor of the Office of Patent Legal Administration on July 19, 2002 dismissing the "conditional" petition for an extension of time or petition for entry of belated papers filed under 37 C.F.R. 1.137(b) on May 6, 2002.

13. Patent owner responded to the dismissal of the "conditional" petition with the submission of a Renewed Petition Under 37 C.F.R. § 1.137(b) on August 8, 2002.

14. A decision was issued by a Patent Special Projects Advisor of the Office of Patent Legal Administration on August 14, 2002 granting the Renewed Petition Under 37 C.F.R. § 1.137(b) on August 8, 2002.

15. A second request for reexamination, assigned Reexamination Control No. 90/006,293 ('6293), was filed May 6, 2002 by Christopher T. Griffith of Leydig, Voit & Mayer, Ltd. The request urged that a substantial new question of patentability was raised by the teachings of (a) "Ein führung in die Technologie Photographischer Silberhalogenidschicten" by Zwicky; (b) Japanese patent 63-286,243 to Ikeda; and (c) U.S. patent 4,897,343 to Ikeda et al. This second request for reexamination included proposed amendments to the claims.

16. Reexamination was ordered for '6293 on July 15, 2002.

DISCUSSION

Under 37 C.F.R. 1.565(c):

> If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* proceeding has not been terminated, the *ex parte* 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 each of the above reexamination proceedings. Accordingly, merger of the proceedings under 37 C.F.R. 1.565(c) is appropriate. MPEP 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 90/005,782 and 90/006,293 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. Patent Owner is given one (1) month from the date of this decision to provide a "housekeeping amendment" to make the claims the same in each file. See MPEP 2283, "Merger of Reexaminations."

III. CONDUCT OF MERGED PROCEEDING

An Office action will be issued in due course (after entry of the "housekeeping amendment") which applies to both Reexamination Nos. 90/005,782 and 90/006,293.

All papers mailed by the Office throughout the merged proceeding 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 a signature and identifying data for both files, for entry into each file. All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control Nos. 90/005,782 and 90/006,293 as:

Christopher T. Griffith
Leydig, Voit & Mayer, Ltd.
Two Prudential Plaza, Suite 4900
180 North Stetson
Chicago, IL 60601-6780

CONCLUSION

Reexamination Control Nos. 90/005,782 and 90/006,293 are merged. The Patent Owner is given one (1) month from the date of this decision to provide a "housekeeping amendment" to make the claims the same in each file.

Richard V. Fisher, Director
Technology Center 1700
Chemical and Materials Engineering

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.
90/005,782 ; 90/006,293 ; 90/007,150	08/04/2000	5116722	A32890	5596

7590 01/27/2005

EXAMINER	

ART UNIT	PAPER NUMBER

Leydig, Voit & Mayer, Ltd.
Two Prudential Plaza,
Suite 4900
Chicago, IL 60601-6780

DATE MAILED: 01/27/2005

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

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

CST

Leydig, Voit & Mayer, Ltd.
Two Prudential Plaza, Suite 4900
180 North Stetson Avenue
Chicago, IL 60601-6780

(for Patent Owner)

In re Callant et al
Reexamination Proceeding
Control No. 90/005,782
Filed: August 4, 2000
For: U.S. Patent 5,116,722

In re Callant et al
Reexamination Proceeding
Control No. 90/006,293
Filed: May 6, 2002
For: U.S. Patent 5,116,722

In re Callant et al
Reexamination Proceeding
Control No. 90/007,150
Filed : August 2, 2004
For: U.S. Patent 5,116,722

DECISION MERGING REEXAMINATION PROCEEDINGS

The above noted reexamination files are before the Director of Technology Center 1700 for consideration of the proceedings under 37 C.F.R. 1.565(c).

BACKGROUND

1. United States Patent 5,116,722, issued May 26, 1992, is the subject of Reexamination Control Nos. 90/005,782, 90/006,293 and 90/007,150.

2. A first request for reexamination, assigned Reexamination Control No. 90/005,782 ('5782), was filed August 4, 2000 by Baker Botts, LLP. The request urged that a substantial new question of patentability was raised by the teachings of (a) "Ein

führung in die Technologie Photographischer Silberhalogenidschicten" by Zwicky; (b) Japanese patent 63-286,243 to Ikeda; and (c) U.S. patent 4,897,343 to Ikeda et al.

3. Reexamination was ordered for '5782 on October 12, 2000.

4. A Patent Owner's Statement, which included amendments to the claims, was submitted on December 12, 2000.

5. A first Office action for '5782 was mailed on February 8, 2001.

6. Patent owner responded to the first Office action on May 30, 2001. This response included an amendment to the claims.

7. A final Office action for '5782 was mailed on August 15, 2001.

8. Patent owner responded to the final Office action on February 14, 2002.

9. Patent owner filed a Notice of Appeal on February 15, 2002.

10. An Advisory action for '5782 was mailed on March 15, 2002. The examiner indicated that the amendments proposed after final rejection would not be entered.

11. Patent owner filed a "conditional" petition for an extension of time or petition under 37 C.F.R. 1.137(b) for entry of belated papers on May 6, 2002.

12. A decision was issued by a Patent Special Projects Advisor of the Office of Patent Legal Administration on July 19, 2002 dismissing the "conditional" petition for an extension of time or petition for entry of belated papers filed under 37 C.F.R. 1.137(b) on May 6, 2002.

13. Patent owner responded to the dismissal of the "conditional" petition with the submission of a Renewed Petition Under 37 C.F.R. § 1.137(b) on August 8, 2002.

14. A decision was issued by a Patent Special Projects Advisor of the Office of Patent Legal Administration on August 14, 2002 granting the Renewed Petition Under 37 C.F.R. § 1.137(b) on August 8, 2002.

15. A second request for reexamination, assigned Reexamination Control No. 90/006,293 ('6293), was filed May 6, 2002 by Christopher T. Griffith of Leydig, Voit & Mayer, Ltd. The request urged that a substantial new question of patentability was raised by the teachings of (a) "Ein führung in die Technologie Photographischer Silberhalogenidschicten" by Zwicky; (b) Japanese patent 63-286,243 to Ikeda; and (c) U.S. patent 4,897,343 to Ikeda et al. This second request for reexamination included proposed amendments to the claims.

16. Reexamination was ordered for '6293 on July 15, 2002.

17. A Decision Merging Reexamination Control Nos. 90/005,782 and 90/006,293 was mailed on November 5, 2002.

18. Patent owner filed a proper "housekeeping amendment" in each reexamination file to make the claims the same in each file on March 26, 2003.

19. A non-final Office action for the merged proceeding was mailed on August 1, 2003.

20. Patent owner responded to the non-final Office action on October 1, 2003.

21. A final Office action for the merged proceeding was mailed on March 31, 2004.

22. Patent owner responded to the final Office action on June 1, 2004.

23. A Notice of Appeal was filed on June 1, 2004.

24. An advisory action was mailed on July 15, 2004.

25. Patent owner responded to the advisory action with an amendment and an Appeal Brief on August 2, 2004.

26. An advisory action was mailed on October 7, 2004.

27. A third request for reexamination, assigned Reexamination Control No. 90/007,150 ('7150) was filed August 2, 2004 by Christopher T. Griffith of Leydig, Voit & Mayer, Ltd. The request urged that a substantial new question of patentability was raised by the teachings of (a) U.S. Patent 4,897,343 to Ikeda et al; (b) The Theory of Photographic Process, Ch. II – Sensitizing and Desensitizing Dyes, T.H. James (Ed), 1966; (c) U.S. Patent 4,814,264 to Kishida et al; and (d) Affirmation of Hans Zwicky of October 28, 1996. This third request for reexamination included proposed amendments to the claims.

28. Reexamination was ordered for '7150 on October 7, 2004.

29. Patent owner filed a timely patent owner's statement on December 7, 2004.

DISCUSSION

Under 37 C.F.R. 1.565(c):

> If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* proceeding has not been terminated, the *ex parte* 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 each of the above reexamination proceedings. Accordingly, merger of the proceedings under 37 C.F.R. 1.565(c) is appropriate. MPEP 2283 further sets forth:

> After the patent owner and second requester have been given an opportunity to file a statement and reply, respectively, the second reexamination proceeding will be merged with the first reexamination proceeding, and prosecution will then continue at the most advanced point possible for the first proceeding. It should be noted that if a final rejection has been issued in the first proceeding, prosecution will be ordinarily be reopened where any of the new patents or printed publications presented in the second request are applied to the merged proceeding in a new ground of rejection.

DECISION

I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. 1.565(c), the 90/005,782, 90/006,293 and 90/007,150 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. Patent Owner is given one (1) month from the date of this decision to provide a "housekeeping amendment" to make the claims the same in each file. See MPEP 2283, "Merger of Reexaminations." Specifically, the amendment filed June 1, 2004 in the merged reexamination proceedings of 90/005,782 and 90/006,293 is not in compliance with 37 CFR 1.530 (all amendments to the claims must be relative to the patent claims). It is noted that in the preliminary amendment filed August 2, 2004 in reexamination proceeding 90/007,150, patent owner indicated that the claims of reexamination proceedings 90/005,782 and 90/006,293 were also being amended, however this amendment must be submitted in the files of 90/005,782 and 90/006, 293.

III. CONDUCT OF MERGED PROCEEDING

An Office action will be issued in due course (after entry of the "housekeeping amendment") which applies to Reexamination Nos. 90/005,782, 90/006,293 and 90/007,150. All papers mailed by the Office throughout the merged proceeding 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 a signature and identifying data for all files, for entry into each file. All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control Nos. 90/005,782, 90/006,293 and 90/007,150 as:

Christopher T. Griffith
Leydig, Voit & Mayer, Ltd.
Two Prudential Plaza, Suite 4900
180 North Stetson
Chicago, IL 60601-6780

CONCLUSION

Reexamination Control Nos. 90/005,782, 90/006,293 and 90/007,150 are merged. The Patent Owner is given one (1) month from the date of this decision to provide a "housekeeping amendment" to make the claims the same in each file.

Jacqueline M. Stone
Director, Technology Center 1700
High Polymer Chemistry, Plastics,
Stock Materials and Compositions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www uspto gov

MAIL

Paper No. 18

SEP 17 2001

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

Michael A. Cantor Esq.
CANTOR COLBURN LLP
55 Griffin Road South
Bloomfield, CT 06002

(For Patent Owner)

In re Reexamination of
U.S. Patent No.
5,696,496
Reexamination Control No.
90/005,787
For: PORTABLE MESSAGING AND SCHEDULING DEVICE WITH HOMEBASE STATION

DECISION ON REQUEST FOR EXTENSION OF TIME

RECEIVED

This is a decision on a request for an extension of time under 37 C.F.R. § 1.550(c) filed September 12, 2001. The request is for an extension of time of one month. This petition requests extension until October 16, 2001 to respond to the Office action of August 16, 2001.

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 and indicates a situation beyond the ordinary in which the owner would have difficulty in responding within the two month period set forth in the last Office action.

Accordingly, the request is **GRANTED**.

The Owners response to the Office action of August 16, 2001 is due on or before October 16, 2001. The Owner is reminded of the requirement under 35 U.S.C. § 305 to conduct reexamination proceedings with special dispatch.

Jin F. Ng, 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.
90/005,789	08/09/00	5848005	[illegible]

026059 MM21/0306
TOWNSEND AND TOWNSEND AND CREW LLP/ 0151
TWO EMBARCADERO CENTER
8TH FLOOR
SAN FRANCISCO CA 94111-3834

EXAMINER
LE, V

ART UNIT	PAPER NUMBER
2824	6

DATE MAILED: 03/06/01

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. 6

TOWNSEND AND TOWNSEND AND CREW (For Patent Owner)
Two Embarcadero Center, 8th Floor
San Francisco, CA 9411-3834

Norman R. Klivans
SKJIERVEN MORRILL MACPHERSON (For Third Party Requester)
25 Metro Drive, Suite 700
San Jose, CA 95110

MAILED

MAR 06 2001

TECHNOLOGY CENTER 2800
SPECIAL PROGRAM CENTER

In re Richard G. Cliff et al. :
Reexamination Proceeding :
Control No. 90/005,789 :
Filed: August 9, 2000 :
For U.S. Patent No. 5,848,005 : DECISION MERGING
: REEXAMINATION
: PROCEEDINGS

In re Richard G. Cliff et al. :
Reexamination Proceeding :
Control No. 90/005,800 :
Filed: August 28, 2000 :
For U.S. Patent No.5,848,005 :

The above-identified reexamination files are before the Director of Examining Group 2820, Technology Center 2800, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No.5,848,005 issued on December 8, 1998.

2. A first request for reexamination, Control No. 90/005,789, was filed by the third party requester on August 9, 2000.

3. A second request for reexamination, Control No. 90/005,800, was filed by the same third party requester on August 28, 2000.

4. Reexamination was ordered in both the '5789 reexamination proceeding and the '5800 reexamination proceeding on November 20, 2000.

7. No statement by the patent owner was received in either of the reexamination proceedings.

Document not considered

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 '5789 and '5800 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

Reexamination Control Nos. '5789 and '5800 are merged. The reexamination files are being forwarded to the examiner for preparing a first Office action.

Henry Thau for

Rolf G. Hille, 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.
90/005,790	08/09/00	6018490	M-9230-RX1 U

026059 MM21/0306
TOWNSEND AND TOWNSEND AND CREW LLP/ 0151
TWO EMBARCADERO CENTER
8TH FLOOR
SAN FRANCISCO CA 94111-3834

EXAMINER
LE,V

ART UNIT	PAPER NUMBER
2824	7

DATE MAILED: 03/06/01

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. 7

TOWNSEND AND TOWNSEND AND CREW (For Patent Owner)
Two Embarcadero Center, 8th Floor
San Francisco, CA 9411-3834

Norman R. Klivans (For Third Party Requester)
SKJIERVEN MORRILL MACPHERSON
25 Metro Drive, Suite 700
San Jose, CA 95110

MAILED

MAR 06 2001

TECHNOLOGY CENTER 2800
SPECIAL PROGRAM CENTER

In re Richard G. Cliff et al.
Reexamination Proceeding
Control No. 90/005,790
Filed: August 9, 2000
For U.S. Patent No. 6,018,490

In re Richard G. Cliff et al.
Reexamination Proceeding
Control No. 90/005,801
Filed: August 28, 2000
For U.S. Patent No. 6,018,490

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above-identified reexamination files are before the Director of Examining Group 2820, Technology Center 2800, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 6,018,490 issued on January 25, 2000.

2. A first request for reexamination, Control No. 90/005,790, was filed by the third party requester on August 9, 2000.

3. A second request for reexamination, Control No. 90/005,801, was filed by the same third party requester on August 28, 2000.

4. Reexamination was ordered in both the '5790 reexamination proceeding and the '5801 reexamination proceeding on November 20, 2000.

7. No statement by the patent owner was received in either of the reexamination proceedings.

Control: 90/005,790

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 '5790 and '5801 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

Reexamination Control Nos. '5790 and '5801 are merged. The reexamination files are being forwarded to the examiner for preparing a first Office action.

Henry S. Thau for

Rolf G. Hille, 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.
90/005,791	08/09/00	6064599	[illegible]

026059 MM21/0306
TOWNSEND AND TOWNSEND AND CREW LLP/ 0151
TWO EMBARCADERO CENTER
8TH FLOOR
SAN FRANCISCO CA 94111-3834

EXAMINER
LE, V

ART UNIT	PAPER NUMBER
2824	6

DATE MAILED: 03/06/01

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 2000 ; 465-188/25266

1- File Copy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Paper No. 6

TOWNSEND AND TOWNSEND AND CREW (For Patent Owner)
Two Embarcadero Center, 8th Floor
San Francisco, CA 9411-3834

Norman R. Klivans
SKJIERVEN MORRILL MACPHERSON (For Third Party Requester)
25 Metro Drive, Suite 700
San Jose, CA 95110

MAILED

MAR 0 6 2001

TECHNOLOGY CENTER 2800
SPECIAL PROGRAM CENTER

In re Richard G. Cliff et al.
Reexamination Proceeding
Control No. 90/005,791
Filed: August 9, 2000
For U.S. Patent No. 6,064,599

DECISION MERGING
REEXAMINATION
PROCEEDINGS

In re Richard G. Cliff et al.
Reexamination Proceeding
Control No. 90/005,802
Filed: August 28, 2000
For U.S. Patent No.6,064,599

The above-identified reexamination files are before the Director of Examining Group 2820, Technology Center 2800, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No.6,064,599 issued on May 16, 2000.

2. A first request for reexamination, Control No. 90/005,791, was filed by the third party requester on August 9, 2000.

3. A second request for reexamination, Control No. 90/005,802, was filed by the same third party requester on August 28, 2000.

4. Reexamination was ordered in both the '5791 reexamination proceeding and the '5802 reexamination proceeding on November 20, 2000.

7. No statement by the patent owner was received in either of the 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. <u>Merger proceedings</u>.

In accordance with 37 C.F.R. § 1.565(c), the '5791 and '5802 reexamination proceedings are <u>merged</u>. 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

Reexamination Control Nos. '5791 and '5802 are merged. The reexamination files are being forwarded to the examiner for preparing a first Office action.

Rolf G. Hille, 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.
90/005,800	08/28/00	5848005	M 9229 RX2 U

MM21/0306

ROBERT C COLWELL
TOWNSEND AND TOWNSEND AND CREW.
TWO EMBARCADERO CENTER EIGHTH FLOOR
SAN FRANCISCO CA 94111-3834

EXAMINER
LE,V

ART UNIT	PAPER NUMBER
2824	6

DATE MAILED: 03/06/01

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
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Paper No. 6

TOWNSEND AND TOWNSEND AND CREW (For Patent Owner)
Two Embarcadero Center, 8th Floor
San Francisco, CA 9411-3834

Norman R. Klivans
SKJIERVEN MORRILL MACPHERSON (For Third Party Requester)
25 Metro Drive, Suite 700
San Jose, CA 95110

DO NOT ENTER

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MAR 0 6 2001

TECHNOLOGY CENTER 2800
SPECIAL PROGRAM CENTER

In re Richard G. Cliff et al. :
Reexamination Proceeding :
Control No. 90/005,789 :
Filed: August 9, 2000 :
For U.S. Patent No. 5,848,005 : DECISION MERGING
: REEXAMINATION
: PROCEEDINGS

In re Richard G. Cliff et al. :
Reexamination Proceeding :
Control No. 90/005,800 :
Filed: August 28, 2000 :
For U.S. Patent No.5,848,005 :

The above-identified reexamination files are before the Director of Examining Group 2820, Technology Center 2800, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No.5,848,005 issued on December 8, 1998.

2. A first request for reexamination, Control No. 90/005,789, was filed by the third party requester on August 9, 2000.

3. A second request for reexamination, Control No. 90/005,800, was filed by the same third party requester on August 28, 2000.

4. Reexamination was ordered in both the '5789 reexamination proceeding and the '5800 reexamination proceeding on November 20, 2000.

7. No statement by the patent owner was received in either of the reexamination proceedings.

Unscanned Documents

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 '5789 and '5800 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

Reexamination Control Nos. '5789 and '5800 are merged. The reexamination files are being forwarded to the examiner for preparing a first Office action.

Rolf G. Hille, 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.
90/005,801	08/28/00	6018490	M-9230-RX2 U

026059 MM21/0306
TOWNSEND AND TOWNSEND AND CREW LLP/ 0151
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EXAMINER
LE,V

ART UNIT	PAPER NUMBER
2824	7

DATE MAILED: 03/06/01

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Paper No. 7

TOWNSEND AND TOWNSEND AND CREW (For Patent Owner)
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Norman R. Klivans (For Third Party Requester)
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San Jose, CA 95110

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MAR 06 2001

TECHNOLOGY CENTER 2800
SPECIAL PROGRAM CENTER

In re Richard G. Cliff et al.
Reexamination Proceeding
Control No. 90/005,790
Filed: August 9, 2000
For U.S. Patent No. 6,018,490

In re Richard G. Cliff et al.
Reexamination Proceeding
Control No. 90/005,801
Filed: August 28, 2000
For U.S. Patent No. 6,018,490

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above-identified reexamination files are before the Director of Examining Group 2820, Technology Center 2800, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 6,018,490 issued on January 25, 2000.

2. A first request for reexamination, Control No. 90/005,790, was filed by the third party requester on August 9, 2000.

3. A second request for reexamination, Control No. 90/005,801, was filed by the same third party requester on August 28, 2000.

4. Reexamination was ordered in both the '5790 reexamination proceeding and the '5801 reexamination proceeding on November 20, 2000.

7. No statement by the patent owner was received in either of the 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 '5790 and '5801 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

Reexamination Control Nos. '5790 and '5801 are merged. The reexamination files are being forwarded to the examiner for preparing a first Office action.

Henry Thaw for

Rolf G. Hille, 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.
90/005,802	08/28/00	6064599	M-9231-RX2 U

026059 MM21/0306
TOWNSEND AND TOWNSEND AND CREW LLP/ 0151
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SAN FRANCISCO CA 94111-3834

EXAMINER	
LE, V	

ART UNIT	PAPER NUMBER
2824	6

DATE MAILED: 03/06/01

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Paper No. 6

TOWNSEND AND TOWNSEND AND CREW (For Patent Owner)
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Norman R. Klivans
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MAR 06 2001

TECHNOLOGY CENTER 2800
SPECIAL PROGRAM CENTER

In re Richard G. Cliff et al.
Reexamination Proceeding
Control No. 90/005,791
Filed: August 9, 2000
For U.S. Patent No. 6,064,599

In re Richard G. Cliff et al.
Reexamination Proceeding
Control No. 90/005,802
Filed: August 28, 2000
For U.S. Patent No.6,064,599

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above-identified reexamination files are before the Director of Examining Group 2820, Technology Center 2800, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No.6,064,599 issued on May 16, 2000.

2. A first request for reexamination, Control No. 90/005,791, was filed by the third party requester on August 9, 2000.

3. A second request for reexamination, Control No. 90/005,802, was filed by the same third party requester on August 28, 2000.

4. Reexamination was ordered in both the '5791 reexamination proceeding and the '5802 reexamination proceeding on November 20, 2000.

7. No statement by the patent owner was received in either of the reexamination proceedings.

Electronic Acknowledgement Receipt

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 '5791 and '5802 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

Reexamination Control Nos. '5791 and '5802 are merged. The reexamination files are being forwarded to the examiner for preparing a first Office action.

Rolf G. Hille, Group Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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Paper No. 8

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FOR OWNER

MAIL

MAR 29 2001

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

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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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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WASHINGTON, D.C. 20231
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February 5, 2001

#7

Edwin D. Schindler
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(For Patent Owner)

M. Robert Kestenbaum
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(For Third Party Requester)

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

DECISION ON PETITION

In re Thomas Heinl
Reexamination Proceeding
Control No. 90/005,809
Filed: September 5, 2000
For: U.S. Patent No. 4,903,691

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.

DO NOT ENTER

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.

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.

Decision Mailed

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
Senior Legal Advisor
Office of Patent Legal Administration

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Paper No. 13

JUN 4 2001

Edwin D. Schindler (For Patent Owner)
Five Hirsch Avenue
P. O. Box 966
Coram, NY 11727

M. Robert Kestenbaum (For Third Party Requester)
11011 Bermuda Dunes NE
Albuqueque, NM 87111

In re Thomas Heinl	:
Reexamination Proceeding	:
Control No. 90/005,275	:
Filed: February 25, 1999	:
For: U.S. Patent No. 4,903,691	: DECISION MERGING
	: REEXAMINATION
In re Thomas Heinl	: PROCEEDINGS
Reexamination Proceeding	:
Control No. 90/005,809	:
Filed: September 5, 2000	:
For: U.S. Patent No. 4,903,691	:

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
Technology Center 3700
Phone No. (703) 308-0873

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

#9 Dw

JUN 25 2001

MAILED

JUN 25 2001

Office of the Director
Group 3600

Rick Martin
Law Offices of Rick Martin, P.C.
416 Coffman St.
Longmont, CO 80501

In re Reexamination Proceeding
90/005,811
Filed: September 5, 2000
For: SHEAR TAB METHOD AND APPARATUS

DECISION ON PETITION FOR THE ACCEPTANCE OF LATE PAPERS

This is in reply to petitioner's communication filed June 8, 2001 which 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 the amendment and attached exhibits submitted by the patent owner in response to the Office action of March 6, 2001, was apparently never received by the Office. The patent owner has submitted a copy of these documents along with a copy of the post card receipt having a date stamp of April 6, 2001. This is acceptable evidence of a timely filing of the response to the Office action.

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 to enter the communication from the patent owner filed April 6, 2001.

Al Lawrence Smith, Director
Patent Technology Center 3600
(703) 308-1020
Facsimile No.: (703) 306-4597

ALS:rar:6/25/01

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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NOV 26 2001

Reexamination Control No. 90/005,811 – Paper No. 13
Reexamination Control No. 90/005,970 – Paper No. 13

MAILED

NOV 26 2001

Office of the Director
Group 3600

FOR PATENT OWNER:

Rick Martin
Law Offices of Rick Martin, P.C.
416 Coffman Street
Longmont, CO 80501

DECISION ON REEXAMINATION MERGER
37 CFR 1.565(c)

Reexam Control Nos. 90/005,811 and 90/005,970

FOR REQUESTER;

Thomas J. Edgington, Esq..
Kirkpatrick & Lockhart LLP
Henry W. Oliver Building
535 Smithfield Street
Pittsburgh, PA 15222-2312

DO NOT ENTER

NOTICE OF CONSOLIDATION OF REEXAMINATION PROCEEDINGS

Background

1. U.S. Letters Patent No. 5,956,916 issued on September 28, 1999.

2. A first request for reexamination was filed by the patent owner on September 5, 2000, and was assigned Reexamination Control No. 90/005,811.

3. Reexamination was ordered in Reexamination Control No. 90/005,811 on October 31, 2000. The order set a shortened statutory period of two months for the submission of patent owner's statement under 37 CFR 1.530(b).

4. On December 26, 2000 patent owner filed an owner's statement in Reexamination Control No. 90/005,811.

5. On March 6, 2001 the examiner issued a first Office action in Reexamination Control No. 90/005,811 in which claims 1-27 were rejected.

6. On March 6, 2001, patent owner filed a response in Reexamination Control No. 90/005,811 to the Office action of March 6, 2001. This response included amendments to patented claims 1, 4, 6, 7, 11, 14, 18, 21, 22, and 27 and added new claims 28-47. For some reason this response was not matched with the reexamination file. On June 8, 2001 patent owner submitted a copy of the response by facsimile transmission including evidence in the form of a date stamped post card showing that the response had, in fact, been received in the Office on March 6, 2001. In a letter dated June 25, 2001, the proceeding was reinstated based upon the evidence submitted.

7. On April, 2, 2001, a second request for reexamination of U.S. Letters Patent No. 5,956,916 was filed by a third party requester, Dietrich Industries, Inc., and was assigned Reexamination Control No. 90/005,970.

8. On May 16, 2001, reexamination was ordered in Reexamination Control No. 90/005,970. The Order set a shortened statutory period of two months for the submission of a patent owner's statement under 37 CFR 1.530(b).

9. On June 11, 2001 the patent owner submitted an owner's statement and an amendment which included amendments to patented claims 1, 4, 6, 7, 11, 14, 18, 21, 22, and 27 and added new claims 28-47 in Reexamination Control No. 90/005,970.

10. On July 9, 2001 the Office received verification in the form of a Certificate of Service in Reexamination Control No. 90/005,970 which indicated that requester had been served with a copy of the owner's statement (the June 11, 2001 paper) on July 5, 2001.

11. On July 11, 2001 a Notice of Defective Paper was mailed to patent owner indicating that the amendments included with the owner's statement in Reexamination Control No. 90/005,970 did not comply with 37 CFR 1.530(d) and giving patent owner one month to correct the deficiency by filing a proper amendment.

12. On July 27, 2001 a Notice of Defective Paper was mailed to patent owner indicating that the amendments submitted in Reexamination Control No. 90/005,811 did not comply with 37 CFR 1.530(d) and giving patent owner one month to correct the deficiency by filing a proper amendment.

13. On July 30, 2001 patent owner submitted an amendment in Reexamination Control No. 90/005,970 that corrected the deficiencies noted in the Notice of Defective Paper. The remarks included with this amendment are the same as the remarks made in the original owner's statement of July 11,2001.

14. On August 11, 2001 patent owner submitted an amendment in Reexamination Control No. 90/005,811 that corrected the deficiencies noted in the Notice of Defective Paper. Several minor errors in the July 30, 2001 amendment filed in

Reexamination Control No. 90/005,970 were noted in the remarks of this amendment. These errors were the failure to underline "floor" in lines 3 and 4 of claim 27. Three additional errors were noted by the examiner—"floor" in line 1 of claim 6 in both reexamination proceedings and "floor" in line 4 of claim 27 in Reexamination Control No. 90/005,811 were also not underlined. See "Requirements for Same Amendments in All Files" under Decision below for the manner in which these errors are to be corrected.

15. On August 30, 2001 requester submitted a reply to patent owner's statement in Reexamination Control No. 90/005,970.

Discussion

Under 37 CFR 1.565(c):

> If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* reexamination proceeding has not been terminated, the *ex parte* 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 the second reexamination proceeding while the first reexamination proceeding was pending. Accordingly, consolidation of the second reexamination proceeding with the first reexamination proceeding 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. 90/005,811 and 90/005,970 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

As noted above, patented claims 1, 4, 6, 7, 11, 14, 18, 21, 22, and 27 were amended in both reexamination proceedings and new claims 28-47 were added in both reexamination proceedings. The identical claims being in both files, there is no need for a housekeeping amendment. However, patent owner is reminded that the same claims and the same description/specification must be maintained in both files. As for the errors noted in Item 14 of the "Background", the three instances where "floor" was not underlined in Reexamination Control No. 90/005,970 and the two instances where "floor" was not underlined in Reexamination Control No. 90/005,811 are considered to be so minor in nature that it has been deemed unnecessary for patent owner to file a housekeeping amendment to correct them. Instead, underlining has been provided by the examiner in

the five instances noted. In each case, the examiner has initialed and dated the changes in the margin next to the actual amendment. From this point, prosecution will proceed *ex parte*. No submission by the requester will be considered in the merged reexamination proceeding .

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 a separate complete file. 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. 90/005,811 and 90/005,970 are hereby merged and in due course an Office action will be issued by the examiner for *ex parte* prosecution of the merged proceeding.

Randolph A. Reese
Special Programs Examiner
Technology Center 3600
(703)308-2121

Concur:

Al Lawrence Smith,
Director
Technology Center 3600

Page: 4 of 5

#19
(mas)

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 Nos. 90/005,811 & 90/005,970

FOR PATENT OWNER:

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DECISION ON PETITION FOR THE ACCEPTANCE OF LATE PAPERS

FOR REQUESTER:

Thomas J. Edgington Esq.
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Henry W. Oliver Building
535 Smithfield Street
Pittsburgh, PA 15222-2312

MAILED
SEP 29 2003
REEXAM UNIT

This is in reply to petitioner's Petition for the Acceptance of Late Papers filed February 24, 2003 and supplemented on April 22, 2003. There is no fee required for this petition.

The petition is **GRANTED**.

A review of the above reexamination file indicates that the Amendment and affidavits under 37 CFR 1.132 submitted on September 17, 2002 were never received by the Office. The patent owner has submitted a copy of the amendment and affidavits along with a copy of the post card receipt having a receipt date stamp date of September 17, 2002. This is acceptable evidence of a timely filing of the amendment and affidavits.

The reexamination file is being forwarded to the Supervisory Legal Instruments Examiner for entry of the amendment and affidavits filed September 17, 2002, and then to the examiner for prompt consideration of the amendment and affidavits. The papers which accompanied the petition (i.e., the Power of Attorney, statement under 37 CFR 3.73(b), Change of Address, and Certificate of Service for all these papers) will also be entered.

Kenneth J. Dorner

Kenneth J. Dorner, Special Programs Examiner
Patent Technology Center 3600
(703) 308-0866
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Kjd: 5/20/03

cc: Requester

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#10

Cooper & Dunham LLP
1185 Avenue of the Americas
New York, NY 10036

SEP - 3 2004

In re: Per Karlsson et al
Reexamination Proceeding
Control No.: 90/005,822
Filed : September 19, 2000
For : U.S. Patent No. 5,520,191

: DECISION ON PETITION
: TO REDATE AND REMAIL
: OFFICE ACTION DUE TO
: NON-RECEIPT BY THE
: PATENT OWNER

This is a decision on patent owner's request filed on August 27, 2004 styled as a Petition for Revival of a Reexamination Pursuant to 37 CFR 1.137(a), which is being treated as a petition to remail and redate the latest Office action, under 37 CFR 1.181(a). There is no fee required for this petition.

The petition is **GRANTED**.

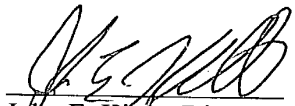
A review of the file history reveals that an Order granting reexamination was mailed on December 1, 2000. Subsequently, on June 8, 2001, a first Office action was mailed to the Patent Owner. As of the writing of this decision, no response to the Office action has been filed. However, no formal steps have been taken to terminate the reexamination proceedings as a result of the non-receipt of a response to the last Office action. The Patent Owner alleges that he never received the June 8, 2001 Office action and therefore, the proceedings cannot be considered terminated for failure to timely file a response.

Failure to reply to an Office action in a reexamination proceeding results in the termination of the proceedings (37 CFR 1.550(d))[1]. Non-receipt of an Office action can be considered as grounds for reinstating a reexamination proceeding if a specific type of evidence of non-receipt of an action is submitted. There is a strong presumption that mail properly addressed and delivered to the United States Postal Service is in fact delivered to the addressee. An allegation that the Office letter was not received may be overcome by a showing that the letter was not received. The showing required to establish non-receipt of the Office action must include: (1) a statement from the practitioner stating that the Office action was not received by practitioner; (2) a statement attesting to the fact that a search of the file jacket and docket record indicates that the Office action was not received; and (3) a copy of the docket record where the non-received Office action would have been entered had it been received and docketed. See notice entitled "Withdrawing the Holding of Abandonment when Office Actions Are Not Received", 1156 OG 53.

[1] Abandonment does not apply to reexamination proceedings, as reexamination proceedings are not applications.

The request filed August 27, 2004 includes all the above-noted elements. The request is therefore granted. Upon the mailing of this decision, the file will be forwarded to the Legal Instruments Examiner for the remailing of the Office action of June 8, 2001; the remailing of this Office action will establish a new shortened statutory period for response.

Summary: Request to redate and remail the Office action is granted.



John E. Kittle, Director
Groups 3730 and 3760
Phone: (703) 308-0873

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Paper No. 26/7

Mark L. Becker
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(For Patent Owner)

Alan R. Loudermilk
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(For Third Party Requester)

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

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.

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.

Henry Thau

Janice A. Falcone, Group Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

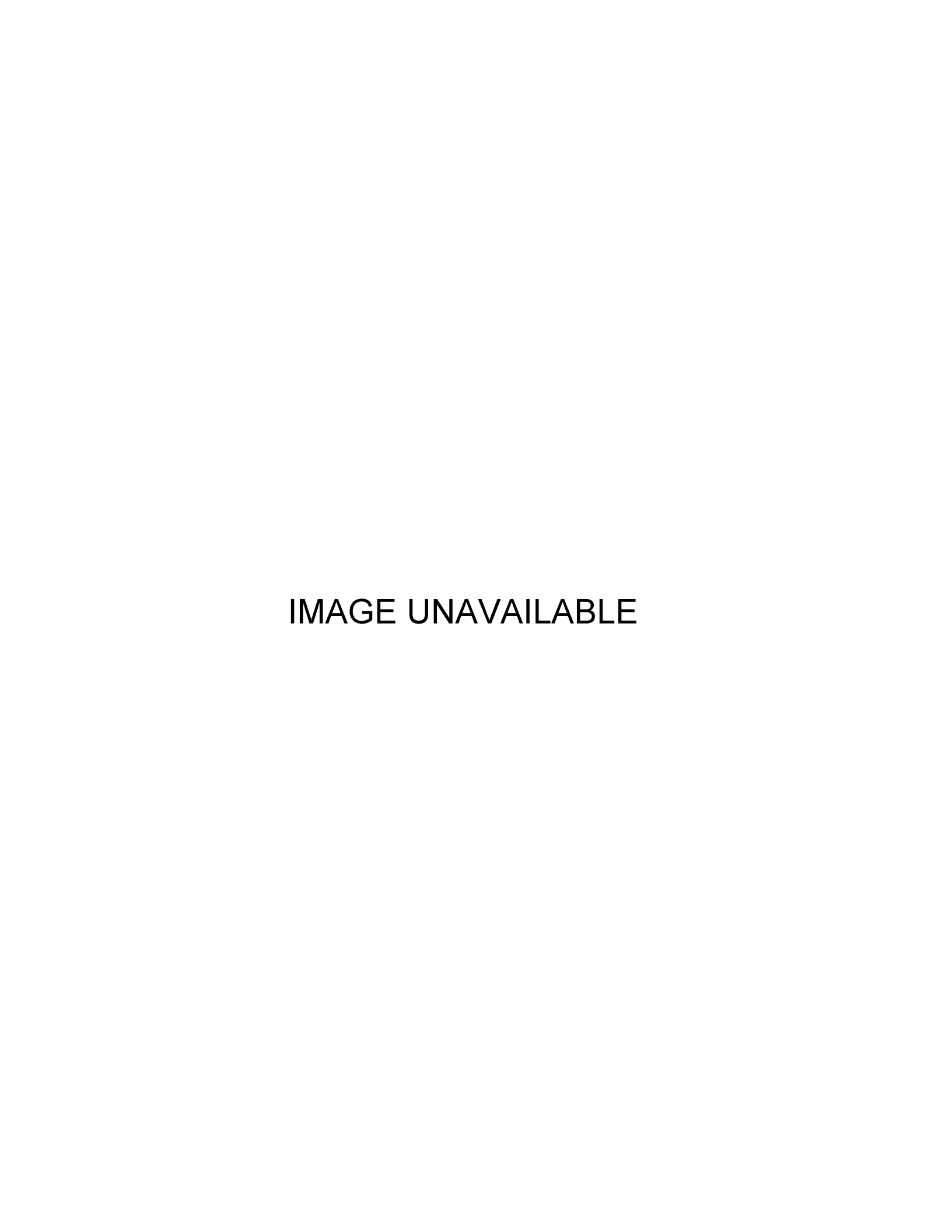
IMAGE UNAVAILABLE

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.
90/005,384			

EXAMINER	
ART UNIT	PAPER NUMBER
	26

DATE MAILED:

REEXAMINATION INTERVIEW SUMMARY FORM

All participants (patent owner, patent owner's representative, PTO personnel):

(1) Mark Becker (3) _____

(2) Ken Wells (4) _____

Date of interview: 8/29/00

Type: [X] Telephonic, [ ] Personal: (copy given to [ ] patent owner, [ ] patent owner's representative).

Exhibit shown or demonstration conducted: [ ] Yes, [X] No. If yes, brief description: _____

Agreement: [ ] was reached with respect to some of the claims in question, [X] was not reached.

Claims discussed: all, generally

Identification of prior art discussed: none

Description of what was agreed to if an agreement was reached, and/or any other comments:
applicant's representative discussed alternative reasons for patentability of the claims over the prior art of record. However, because the case file was not available, the examiner was not able to agree or disagree with applicant's representative on these alternative reasons for allowan

(A fuller description, if necessary, and a copy of the amendments, if available, which the examiner agreed would render the claims patentable must be attached. Also, where no copy of the amendments which would render the claims patentable is available, a summary thereof must be attached.)

A FORMAL WRITTEN RESPONSE TO THE LAST OFFICE ACTION IS NOT WAIVED AND MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. IF A RESPONSE TO THE LAST OFFICE ACTION HAS ALREADY BEEN FILED, THEN PATENT OWNER IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO PROVIDE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. 37 C.F.R. 1.560(b).

EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).

cc: Requester

Kenneth Wells
(Examiner's Signature)

PTOL-474 (2-90)

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. 8/35

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(For Third Party Requester)

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JAN 08 2001
GROUP 2100

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

DO NOT ENTER

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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DEC 1 7 2001

Paper No. 10/49

TECHNOLOGY CENTER 2800
SPECIAL PROGRAM CENTER

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(For Patent Owner)

Alan R. Loudermilk
LOUDERMILK & ASSOCIATES
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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).

Page 2 of 5

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.

Henry S. Phan for

Janice A. Falcone, Group Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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90/005,881
90/006,051
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

ARTER & HADDEN, LLP
1100 HUNTINGTON BUILDING
925 EUCLID AVENUE
CLEVELAND, OH 44115-1475

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

John X. Garred
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(For Patent Owner)

Alan R. Loudermilk
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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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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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

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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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. : 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)).

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)).

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
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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

KLARQUIST SPARKMAN, LLP
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/24/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

ALAN R. LOUDERMILK
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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

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)).

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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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

KLARQUIST SPARKMAN, LLP
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SUITE 1600
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/24/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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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

KLARQUIST SPARKMAN, LLP
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SUITE 1600
PORTLAND, OR 97204

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/24/2009

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UNITED STATES PATENT AND TRADEMARK OFFICE

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

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)).

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.
90/005,384	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

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UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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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)).

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

Klarquist Sparkman LLP
121 SW Salmon Street
Suite 1600
Portland, Oregon 97204

(For Patent Owner)

MAILED

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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#11
(mas)

Fax No. 703 308-6916

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

US Patent Under Reexamination: 5,240,139
Filed: 9/25/00
Inventor: CHIRNOMAS, Munroe
For: PACKAGE VENDING MACHINE
Today's Date: October 18, 2001

Atty Docket No.: 92PA0IUSRE
Control Number: 90/005,824
Group Art Unit: 3651
Examiner: MACKEY, Patrick

United States Patent and Trademark Office
Commissioner for Patents
Washington, DC 20231
ATTN: Office of Petitions
Cc: Tech Center 3600

FAX RECEIVED
OCT 18 2001
PETITIONS OFFICE

PETITION FOR ENTRY OF UNINTENTIONALLY LATE PAPERS, PURSUANT TO 37 CFR § 1.137(b)

Sir:

Applicant hereby petitions for entry of late papers (i.e., the Response) in the above captioned Reexamination, so as to avoid or revive a termination of the above captioned reexamination under 37 CFR § 1.550(d).

On June 25, 2001 applicant's undersigned "in-house" attorney received an "Office Action in Reexamination" mailed June 18, 2001 for which a three month period was set for filing a response by Patent Owner, expiring September 18, 2001.

Due to a clerical error in docketing and handling of this Office Action, the "reply due date" was erroneously thought to be extendable using the extension of time procedures of 37 CFR § 1.136. On or about October 10, 2001, applicant's undersigned attorney realized the above clerical error, but by this time it was already too late to comply with the extension of time procedures of 37 CFR § 1.550(c). Accordingly, the response is being filed as soon as practically possible, and in fact simultaneously herewith.

11/06/2001 MTWITTY 00000001 501960 90005824
01 FC:241 640.00 CH

US Patent Under Reexamination: 5,240,139
Filed: 9/25/00

Atty Docket No.: 92PA0IUSRE
Control Number: 90/005,824

In accordance with the above, it is submitted that the entire delay from the due date for the reply, until the filing of the attached response in this Reexamination, was unintentional.

The proposed response is the filing of a Reply to the outstanding Office Action, a copy of which is attached hereto.

In accordance with 37 CFR § 1.17(m), the small entity fee for this Petition is believed to be $640.00. The Commissioner is hereby authorized to charge the requisite fee to Deposit Account No. 501960.

DEPOSIT ACCOUNT

Respectfully submitted,

Lawrence C. Edelman
Reg. No. 29,299

FASTCORP
One Cory Road
Morris Township, NJ 07960
(973) 455-0400

CERTIFICATE OF TRANSMISSION
PURSUANT TO 37 CFR §1.8

I hereby certify that this correspondence is being fax transmitted on **October 18, 2001** to:
(703) 308-6916
USPTO Office of Petitions
Washington, DC 20231

Date: October 18, 2001

Lawrence C. Edelman
Reg. No. 29,299

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

JUL 24 2001

#8

MCDERMOTT, WILL, & EMERY
600 13TH STREET, N. W., SUITE 1200
WASHINGTON, DC 20005-3096

In re Reexamination Proceeding	:	
Control No. 90/005,837	:	
Patent No. 5,501,005	:	DECISION ON
Patentee: Yasuto Onitsuka	:	REQUEST FOR
Filed: October 2, 2000	:	EXTENSION OF TIME
Attorney Docket No.: 43890-456	:	

Receipt is acknowledged of a request for extension of time under 37 CFR 1.550(c), filed on June 20, 2001 and entered in the file as paper No. 7.

An office action, which set a two month shortened statutory response period, was mailed on May 24, 2001, and was entered in the file as paper No. 6.

The request indicates that the reason for the extension of time is to allow for the routing and translation of the draft documents with the Japanese assignee, Matsushita. The request is for an one month extension of the two month shortened statutory period for response which ends on July 24, 2001.

The request for an extension of time is for sufficient cause and is granted.

The time to file a response to paper No. 6 is extended to expire on August 24, 2001.

Further extensions of time in this regard should not be expected.

E. Rollins-Cross, Director, Patent
Examining Groups 3710 and 3720

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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MAY 24 2001

Paper No. 12

Donald J. Perreault *et al*
Hayes, Soloway, Hennessey, Grossman and Hag
175 Canal Street
Manchester, NH 03101

(For Patent Owner)

Peter C. Knops
Lathrop & Gage, LC
2345 Grand Boulevard
Suite 2800
Kansas City, MO 64108

(For Requester)

In re Howard J. Dananberg, D.P.M.
Reexamination Proceeding
Control No. 90/005,839
Filed: October 5, 2000
For: U.S. Patent No. 4,597,195

DECISION, *SUA SPONTE*,
MERGING REEXAMINATION
PROCEEDINGS

In re Howard J. Dananberg, D.P.M.
Reexamination Proceeding
Control No. 90/005,955
Filed: March 19, 2001
For: U.S. Patent No. 4,597,195

The above noted reexamination files are before the Director of Patent Examining Group 3720 for consideration of merger of the proceedings under 37 CFR 1.565(c), in accordance with the practice set forth at MPEP § 2283.

I. Merger of Proceedings

As required by the practice pursuant to MPEP § 2283, and under the authority of 37 CFR 1.565(c), the '736 and '751 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

Patent 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. 12 in both files. There will be no Paper Nos. 7-11 in Control No. 90/005,955. Any

reply to the examiner's action dated May 3, 2001 as promulgated in reexamination control number 90/005,839 must be filed in duplicate, each copy bearing an original signature, with one copy directed to each reexamination proceeding. That reply will be Paper No. 13 in both files. The reply must also serve to place the same claims and specification in both files, including any amendments made in response to the May 3, 2001 action as well as any changes which have previously been made in the earlier filed proceeding which have not yet been made in the later filed proceeding.

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. Requester will receive the body of the action, with the appropriate cover sheet(s), while Owner will receive the body of the action and a copy of each cover sheet. All papers filed by Owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by Owner must consist of a single response, filed in duplicate, each bearing an original signature, for entry in each file. Owner is reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on Requester, even papers filed *via* facsimile transmission.

Ex parte prosecution pursuant to 37 CFR 1.550 and 1.552 commenced in reexamination proceeding 90/005,839, and will resume in the event that a reply to the above mentioned examiner's action is timely filed, in accordance with Section II, *supra*. Failure to file a reply will result in termination of the merged proceedings and issuance of an appropriate Notice of Intent to Issue Reexamination Certificate, which will in turn result in the publication of a single Reexamination Certificate for this merged proceeding. The Primary Examiner should note that each reexamination file must reflect consideration of the identical prior art, and must, therefore, insure that each file reflects identical reference citations.

Owner is reminded of the continuing duty to inform the Office of changes in the status of any litigation involving the patent undergoing reexamination.

E. Rollins-Cross, Director, Patent
Examining Groups 3210 & 3720

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PEARNE & GORDON LLP
1801 EAST 9TH STREET
SUITE 1200
CLEVELAND OH 44114-3108

(For Patent Owner)

MAILED

OCT 06 2006

CENTRAL REEXAMINATION UNIT

In re Bruce BOXUM
Reexamination Proceeding
Control No.: 90/005,843
Filed: October 11, 2000
For: U.S. Patent No.: 5,911,748
Certificate Issued: May 14, 2002

: DECISION ON PETITION
: UNDER 37 CFR 1.182

This is a decision on the May 13, 2004, patent owner petition titled PETITION UNDER 37 CFR 1.182 TO CORRECT REEXAMINATION CERTIFICATE.

The petition is before the Office of Patent Legal Administration.

The petition fee of $130 set forth in 37 CFR 1.17(h) for the present petition under 37 CFR 1.182, has been paid by check.[1]

The petition is dismissed for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 5,911,748 (the '748 patent) issued on June 15, 1999.

2. A request for reexamination of the '748 patent was filed on October 11, 2000. The request was assigned control No. 90/005,843 (the '5843 proceeding).

3. An assignment of United States Patent No. 5,911,748 ('748 patent) from White Consolidated Industries, Inc. to Dometic Corporation was recorded in the Office on October 9, 2001.

4. An *Ex Parte* Reexamination Certificate issued in the '5843 proceeding on May 18, 2002.

DECISION

The present petition was filed in response to a communication dated June 6, 2003, from the Office denying patentee's petition under 37 CFR 1.182 to accept a request for a Certificate of

[1] At the time of filing the present petition, § 1.182 required the $130 petition fee set forth in § 1.17(h).

Correction pursuant to 37 CFR 1.322 dated January 31, 2003.[2] The Office error alleged by petitioner involves listing "White Consolidated Industries, Inc." as the assignee of record on the reexamination certificate although an assignment of United States Patent No. 5,911,748 ('748 patent) from White Consolidated Industries, Inc. to Dometic Corporation was recorded on October 9, 2001, a date after the '748 patent had issued and before the mailing of the reexamination certificate.[3] Petitioner requests issuance of a certificate of correction for the reexamination certificate changing the assignee name on the reexamination certificate from "White Consolidated Industries, Inc." to "Dometic Corporation."

No Error in Reexamination Certificate

Petitioner's attention is directed to 35 U.S.C. § 152, which states:

> Patents may be granted to the assignee of the inventor of record in the Patent and Trademark Office, upon the application made and the specification sworn to by the inventor, except as otherwise provided in this title.

Thus, the Office may issue a patent to the assignee of record of a pending application, or an assignee whose assignment was submitted for recordation against an application pending at the Office. The statute, however, makes no provision for issuance of a patent to the assignee by way of an assignment recorded, or submitted for recordation, **after** issuance of the patent, as the application is then no longer pending but is an issued patent. Likewise, § 152 makes no provision for the Office to issue a reexamination certificate reflecting that the previously issued patent, which issued to the assignee of record, is subject to an assignment submitted for recordation after the patent issued, including any assignment recorded after a request for reexamination has been filed. In other words, the Office is not required to identify any change in the recorded assignee on the reexamination certificate. The Office will, however, identify a change in the assignee of record on the reexamination certificate if (a) a title report generated at the time the request for reexamination is filed identifies an assignee of record that is different from that listed on the face of the patent, or (b) the patent owner submits, during the reexamination proceeding, a proper statement under 37 CFR 3.73(b) indicating that title is in an assignee different from that listed in the patent (see MPEP § 320). In this instance, the assignment to Dometic Corporation[4] was submitted for recordation and recorded after the '748 patent had issued; thus, the title report that was generated at the time the request for reexamination was filed **properly identified** White Consolidated Industries, Inc." as the assignee of record. In addition, there is no record of patent owner having filed a proper statement under 37 CFR 3.73(b) indicating that the title was in Dometic Corporation by way of an assignment subsequent to the filing of the reexamination proceeding. Accordingly, the reexamination certificate properly listed "White Consolidated Industries, Inc." as the assignee of record. The Office committed no error in not reflecting the post-issuance conveyance from White

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[2] Petitioner suggests that the Petitions Examiner misunderstood the petition of January 31, 2003, as a petition for a certificate of correction to the patent when petitioner was actually requesting a correction of the assignee name on the reexamination certificate.

[3] The Office mailed the Notice of Recordation on December 11, 2001.

[4] The conveyance to Dometic Corporation sought to be included on the reexamination certificate.

Consolidated Industries, Inc. to Dometic Corporation on the reexamination certificate and the requested Certificate of Correction will not be issued.

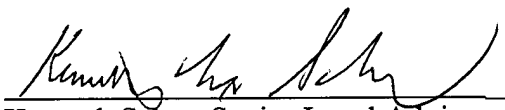
Petitioner is reminded that **an application** may issue in the name of an assignee consistent with the application's filed or recorded assignment where the assignee is identified by applicant on Part B-Fee Transmittal of the PTOL-85 form that is returned by applicant with the issue fee. Unlike an application, however, **reexamination proceedings do not have such a procedure** that provides for assignment information that was recorded after the filing of a request for reexamination (not appearing on the title report). Instead, a proper statement under 37 CFR 3.73(b) must be submitted during the reexamination proceeding to have a new assignee listed on the reexamination certificate.

CONCLUSION

1) The petition is dismissed.

2) A copy of this decision is being placed in the file for the present reexamination, and is also being placed in the file of U.S. Patent No. 5,911,748, which is the patent subjected to Reexamination Proceeding 90/005,843.

3) Telephone inquiries related to this decision should be directed to Brian E. Hanlon, Legal Advisor, at (571) 272-5047, or in his absence, the undersigned at (571) 272-7710.



Kenneth Schor, Senior Legal Advisor
Office of Patent Legal Administration
Office of Patent Examination Policy

September 28, 2006
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UNITED STATES
PATENT AND
TRADEMARK OFFICE

JAN - 8 2003

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
WWW.USPTO.GOV

In re Reexamination Proceeding:
Control No.: 90/005,845 : DECISION ON PETITION
Filed: October 13, 2000 :
Patent No.: D-431,211 :
For: Pair of Motorcycle Fairing Guards :

Decision by the U.S. Patent and Trademark Office to suspend action until conclusion of Civil Action No. C-1-00-869 pending in United States District Court for Southern District of Ohio. In particular the court action includes an interfering patents count under 35 USC 291.

The claim in the instant case was rejected in an office action mailed June 20, 2002 (paper no. 14). Patent owner field a response August 16, 2002 (paper no.15)

Per this response a trial date has been set for March 3, 2003 in U.S. District Court for the Southern District of Ohio. In accordance with 37 CFR 1.565 and 37CFR1.987 prosecution in this Reexamination application is suspended pending the outcome of the above referenced civil action.

When a decision is reached in the civil action a copy of the decision should be sent to the Office. At that time the Office will decide upon its position in this reexamination application.

John E. Kittle
Director, TC 3700 & 2900
Mechanical Engineering & Designs

Requestor: Frank C. Eisenschenk, Ph.D., Esq.,
Saliwanchik, Lloyd & Saliwanchik
2421 N.W. 41st Street
Suite A-1
Gainesville, FL 32606-6064

Patent Owner: Alfred J. Mangels
4729 Cornell Road
Cincinnati, OH 45211

#16

UNITED STATES PATENT AND TRADEMARK OFFICE

JAN - 8 2003

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
WWW.USPTO.GOV

In re Reexamination Proceeding:
Control No.: 90/005,845 : DECISION ON PETITION
Filed: October 13, 2000 :
Patent No.: D-431,211 :
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John E. Kittle
Director, TC 3700 & 2900
Mechanical Engineering & Designs

Requestor: Frank C. Eisenschenk, Ph.D., Esq.,
Saliwanchik, Lloyd & Saliwanchik
2421 N.W. 41st Street
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Gainesville, FL 32606-6064

Patent Owner: Alfred J. Mangels
4729 Cornell Road
Cincinnati, OH 45211

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.
90/005,845	10/13/2000	D431211	JFH-PL1	5702

7590 05/18/2009

JEFF HOOP
P.O. BOX 6509
OCALA, FL 34478-6509

EXAMINER	
LEE, ANGELA J	
ART UNIT	PAPER NUMBER
2911	
MAIL DATE	DELIVERY MODE
05/18/2009	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.

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 18 2009

IN RE REEXAMINATION PROCEEDINGS

In re Application of
Control No.: 90005845
Filed: 10/13/2000 :
Patent No.: D431,311 : DECISION ON PETITION
For: Pair of Motorcycle Fairing Guards :

On January 8, 2003 the U.S. Patent and Trademark Office suspended the Reexamination proceedings in the application identified above in accordance with 37 CFR 1.565, pending the conclusion of the Civil Case No: 100cv869 in the United States District Court for the Southern District of Ohio.

Prior the suspension, the claim in the instant Reexamination was rejected in the Office action mailed on June 20, 2002. Patent owner's response was filed on August 16, 2002.

Per jury verdict, the final judgment was issued on February 11, 2004 in the Civil Case, No:100cv869 by the United States District Court for the Southern District of Ohio.

In view of the conclusion of the above Civil Case No:100cv869, the suspension of the reexamination proceedings in this Reexamination application is lifted.

The case has been forwarded to the examiner for further action.

/Jasemine C. Chambers/
Jasemine C. Chambers, Ph.D., J.D.
Director, Technology Center 2900
Designs

a.a.

Requestor: Jeff Hoop
P.O. Box 6509
Ocala FL 34478-6509

Patent Owner: Alfred J. Mangels
4729 Cornell Road
Cincinnati, OH 45211

#21

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UNITED STATES PATENT AND TRADEMARK OFFICE

DEC 15 2003

Office of the Director
Group 3600

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

Reexamination Control No. 90/005,850 - Paper No. 21

FOR PATENT OWNER:

Mueller and Smith
7700 Rivers Edge Drive
Columbus, OH 43235

FOR REQUESTER:

Charles Alworth, Esq.
505 Cumberland Road
Tyler, TX 75703

DECISION ON PETITION TO INVOKE SUPERVISORY AUTHORITY OF THE COMMISSIONER
37 CFR 1.181

90005850 - 05/29/2003

This is in response to the petition filed May 30, 2003 under 37 CFR 1.182 invoking supervisory review of the Examiner's decision mailed March 25, 2003, which is properly being treated as a petition under 37 CFR 1.181 Invoking the Supervisory Authority of the Commissioner. The Patent Owner also requests that the Commissioner direct the Examiner to conduct the reexamination with special dispatch.

The petition is **GRANTED-IN-PART**.

The Patent Owner asserts that the statement filed by Robert Bender is not a sufficient declaration or affidavit as required by MPEP § 2258(I)(E) and should not have been relied upon by the Examiner to establish the "Well Master 200 Production Management System-Operation-Basic Manual" as a printed publication prior to the date of filing of the application of the present patent under reexamination.

The issue of the propriety of the 35 U.S.C 102(a) rejection of the claims using the Well Master document as supported by the statement of Robert Bender is an appealable matter for the Board of Patent Appeals and Interferences rather than a petitionable matter for the Commissioner for Patents to decide. The sufficiency of the Bender statement and the weight it will be accorded, as required by MPEP § 2258(I)(E), will be taken up by the Examiner in due course. Therefore, this part of the petition is dismissed.

With regard to the issue of the Examiner not conducting the reexamination proceedings with special dispatch, the Office apologizes for any undue delays in the prosecution of this

reexamination. In the future, the Examiner will be directed to conduct prosecution of this reexamination application with special dispatch.

The application is being returned to the Examiner for consideration of the Response to Notice of Defective Paper in Ex Parte Reexamination filed July 31, 2003.

Inquires related to this decision may be directed to Supervisory Patent Examiner David Bagnell at (703) 308-2151.

Donald T. Hajec, Director
Technology Center 3600
(703) 306-4180

DJB:11/17/03

90005850 20031117

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
WASHINGTON, D C. 20231
www.uspto.go

Paper No. 14

Tim A. Cheatham
Polaroid Corporation
Law and Patent Dept.
784 Memorial Drive
Cambridge, MA 02139

(For Patent Owner)

MAILED

JUL 0 2 2002

REEXAM UNIT

In re Reexamination Proceeding :
Control No. 90/005,851 :
Filed: November 3, 2000 : **DECISION**
For: U.S. Patent No. 6,110,638 : **DISMISSING**
Patentee: Boggs, et al. : **PETITION**
:
:

This is a decision on the patent owner PETITION UNDER 37 C.F.R. § 1.137(a) for the entry of late papers on the grounds of unavoidable delay of January 9, 2002, requesting the entry of the late filed response to the final rejection of August 16, 2001. The petition fee under 37 C.F.R. § 1.17(l) of $110.00, 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 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 either "Renewed Petition under 37 C.F.R. § 1.137(a)" or "Petition under 37 C.F.R. § 1.137(b)."

DECISION

A grantable petition for entry of belated papers under 37 C.F.R. § 1.137(a) must be accompanied by (1) the proposed response to the outstanding Office action, (2) the petition fee required by law, and (3) an adequate showing of the cause of unavoidable delay. This petition lacks item (3) above.

This reexamination proceeding terminated after October 16, 2001, for failure to timely file a response to the outstanding Office action within two months of the final rejection mailed on August 16, 2001. The proposed response to the outstanding Office action, required for the present petition for entry of late papers, was previously filed with a certificate of mailing date of November 15, 2001, and was accompanied by a request for a one month extension of time. This response was received on January 16, 2002, apparently due to mail delays (irradiation), and a courtesy copy of such response was also filed with the instant petition. The proposed response has been reviewed and provisionally approved for entry by the examiner assigned to this proceeding, upon revival of the instant reexamination proceeding.

With regard to an adequate showing of the cause of unavoidable delay, the present petition indicates that one of the inventors, Roger Boggs, resides in Ulm, Germany, and on October 2, 2001, a copy of the declaration under 37 C.F.R. § 1.131 was sent to him by UPS Next Day Air for his signature. It is stated that Mr. Boggs received and signed the declaration on the morning of October 4, 2001, and deposited such signed declaration with UPS in Germany at 3:00 PM that afternoon for delivery to Polaroid Cambridge on the following day. It is indicated that as of October 16, 2001, Polaroid Cambridge had not received the signed declaration and had contacted UPS, which could provide no information, but suggested that they contact UPS in Germany. It is further stated that Roger Boggs was so informed and agreed to contact UPS in Germany, which he did on October 17, 2001 and through October 19, 2001, but UPS in Germany could provide no record of the signed declaration leaving Ulm, Germany. It is described that having failed to track down the original signed declaration, a second declaration was prepared by Polaroid Cambridge and forwarded to Mr. Boggs via UPS on October 29, 2001. It is indicated that Mr. Boggs received and signed the second declaration on October 31, and subsequently airmailed it back to Polaroid Cambridge on the same date. It is stated that as a result of the loss by UPS of the original signed declaration, Patent Owner's failure to file a timely response to the Office action dated August 16, 2001, was unavoidable. Such statements are signed by Edward S. Roman, attorney for patent owner.

In order for a showing of unavoidable delay to be adequate under 37 C.F.R. § 1.137(a), it must set forth the entirety of the facts surrounding the delay in filing the response to the outstanding

Office action. Such showing must basically explain who did what/when/where/why and how in the above described scenario, in order to address this matter in detail. Although the above statements provide a description of some of what transpired with regard to the declaration under 37 C.F.R. § 1.131, the showing is incomplete, as the statements do not encompass the entire time period from the due date for the response to the filing of a grantable petition for entry of belated papers under 37 C.F.R. § 1.137(a). It is also inadequate, as the statements were not accompanied by any supporting evidence (e.g., UPS Next Day Air receipts, FAX records and/or telephone records/bills showing communication between Polaroid Cambridge and Roger Boggs and UPS, as well as between Roger Boggs and UPS in Germany and Polaroid Cambridge, any documentation from UPS as to their receipt of papers and evidence of subsequent loss of papers, such as may be indicated in their advertised tracking system) to establish that the delay was "unavoidable" within the meaning of the statute. Further, the above statements do raise some questions as to whether the delay was "unavoidable" within the meaning of the statute, such as why apparently no action was taken between October 5, 2001 and October 16, 2001, to locate the signed declaration deposited by Mr. Boggs with UPS Germany on October 4, 2001, for next day delivery? Why did it take from October 31, until November 15, 2001, to submit such declarations to the Office? Why did petitioners wait until January 9, 2002, to file the instant petition? Note that the entire time period between the due date for the response to the outstanding Office action to the filing of a grantable petition for entry of belated papers under 37 C.F.R. § 1.137(a) needs to be addressed by petitioners in their showing.

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 for depositing the declarations with UPS, those responsible for contacting UPS, both in the United States and Germany, as well as Mr. Boggs, when the declaration was not received, those responsible for docketing the reexamination proceeding, those responsible for monitoring and following up on the status of any papers needed for responding to the outstanding Office action, and those responsible for filing a timely reply to the outstanding Office action.

The showing should include copies of any records (FAX and telephone) and receipts (UPS, airmail), including docket reports and any monitoring reports, relevant to the time period in question, with supporting statements. Specifically, copies of the docket records should be provided showing when the last Office communication of August 16, 2001, in the reexamination proceeding was entered into the Polaroid Corporation docketing system, and how the proceeding was handled in their docketing system and monitoring system from that time until the filing of a grantable petition for entry of belated papers under

37 C.F.R. § 1.137(a). Therefore, with regard to petitioner's assertion that a loss of mail by UPS was the cause of delay in filing the response, the showing provided is incomplete as to substantiating that this error was indeed the cause of the delay at issue, and the present petition is inadequate to establish a case of "unavoidable" delay within the meaning of the statute. Note that a petition under 37 C.F.R. § 1.137(a) must establish that the delay was unavoidable, and not that it was just unintentional.

As noted in MPEP 711.03(c)§(III)(C)(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 that the UPS loss of mail error was the cause of the delay at issue; that there was a business routine in place for ensuring that mail correspondence to/from inventors was properly and timely sent/received, docketed and forwarded to the USPTO; and that the personnel were sufficiently trained in docketing and monitoring due dates for reexamination proceedings, such that petitioner was prudent in relying upon such personnel. The nature and extent of training provided to the personnel should be set forth, with regard to the respective docketing and monitoring systems of reexamination cases, as opposed to regular applications, including a showing that such personnel were trained in and aware of the differences in the requirements relating to extensions of time between reexamination proceedings and applications. Any renewed petition based upon unavoidable delay should establish how the UPS loss of mail error was the cause of the delay at issue; should describe the business routine in place for ensuring that mail correspondence to/from inventors was properly and timely sent/received, docketed, monitored and forwarded to the USPTO that could reasonably be relied upon to avoid errors in its performance; and demonstrate that the personnel were sufficiently trained in docketing and monitoring due dates for reexamination proceedings, as opposed to regular applications, such that

reliance upon such employee(s) represented the exercise of due care.

Petitioner's showing is further inadequate to establish unavoidable delay within the meaning of 37 C.F.R. § 1.137(a), as an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for filing a proper response to the outstanding Office action, but through the intervention of unforseen circumstances, such as failure of mail, telegraph, facsimile transmission, or the negligence of otherwise reliable employees, the response is not timely received in the Office. Compare *Ex parte Pratt*, 1887 Dec. Comm'r Pat. 31 (The word "unavoidable" 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).

The petition fails to show that appropriate care and diligence was observed, and all necessary action was taken to avoid termination of the reexamination proceeding. A review of the record shows that a proposed response to the final Office action was originally filed with a certificate of mailing dated November 15, 2001, and was accompanied by a request for a one month extension of time including payment of a fee of $110.00, which therefore appears to be a request to extend the time for response under 37 C.F.R. § 1.136(a). As noted on the cover sheet of each and every Office communication in this reexamination proceeding, extensions of time in a reexamination proceeding are governed by 37 C.F.R. § 1.550(c), and **not** 37 C.F.R. § 1.136(a) or 37 C.F.R. § 1.136(b). Note also the explanation regarding extensions of time in the second paragraph on page 2 of the Order Granting Reexamination mailed on December 27, 2000. Since the request for extension of time was filed on November 15, 2001, i.e., after the October 16, 2001, due date for the response, such an extension of time could not be granted, as requests for extension of time in a reexamination proceeding must be filed prior to the expiration of the time period for response in accordance with 37 C.F.R. § 1.550(c). Accordingly, even though the papers of November 15, 2001, crossed in the mail with the Notice of Intent to Issue a Reexamination Certificate (NIRC) mailed on December 7, 2001, apparently due to mail delays, such request for extension of time would not have been effective to cause the November 15, 2001 response to be timely filed, nor to prevent the instant reexamination proceeding from being terminated via mailing of the NIRC on December 7, 2001.

Petitioner's showing is focused on how the delay in responding was caused by the apparent breakdown of a timely UPS return delivery of the initial signed declaration, and the subsequent UPS mailings to obtain the necessary substitute signed declaration. However, when it became apparent that the UPS delays would prevent a timely response to the outstanding Office action, petitioner's showing fails to address and explain why petitioner was "unavoidably" prevented from submitting a timely request for an extension of time under 37 C.F.R. § 1.550(c), prior to the expiration of the period for response. The petition does not explain why such a request for an extension of time was not filed, nor why a request for an extension of time under

37 C.F.R. § 1.136(a) was requested after the expiration of the response period. Note that delay resulting from the lack of knowledge or improper application of the patent statute, rules or practice or the MPEP, 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 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 response of November 15, 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 required 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.

Gerald A. Dost
Senior Legal Advisor
Office of Patent Legal Administration

July 2, 2002

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. 16

Tim A. Cheatham
Polaroid Corporation
Law and Patent Dept.
784 Memorial Drive
Cambridge, MA 02139

(For Patent Owner)

MAILED

AUG 0 6 2002

REEXAM UNIT

In re Reexamination Proceeding
Control No. 90/005,851
Filed: November 3, 2000
For: U.S. Patent No. 6,110,638
Patentee: Boggs, et al.

DECISION GRANTING PETITION

DO NOT ENTER

This is a decision on the patent owner PETITION UNDER 37 C.F.R. § 1.137(b) of July 30, 2002, for the entry of late papers on the grounds of unintentional delay, requesting the entry of the late filed response to the final Office action of August 16, 2001. A petition fee under 37 C.F.R. § 1.17(m) of $1280.00, for the reexamination proceeding has been charged to petitioner's deposit account 16-2195, as authorized on page 2 of the instant petition. 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 patent owner previously filed the reply required by 37 C.F.R. § 1.137(b)(1) on January 16, 2002, as part of a late response to the outstanding Office action of August 16, 2001. The petition of July 30, 2002, was accompanied by the petition fee, in compliance with 37 C.F.R. § 1.137(b)(2), and 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 under

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 1700 for consideration of the response to the final Office action.
3. Any further communications as to the merits of the reexamination proceeding should be directed to the patent examiner, R.L. Schilling, in Group Art Unit 1752.
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

August 2, 2002

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 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

90005435 - 20020506

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
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(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

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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.

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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

90005435 - 20020506

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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Richard A. Schwartz, Esq. (For Patent Owner)
Schwegman, Lundberg, Woessner & Kluth, P.A.
P.O. Box 2938
Minneapolis, MN 55402

MAILED

AUG 0 5 2005

REEXAM UNIT

David Rolf et al
Reexamination Proceeding
Control No. 90/005,877
Filed: December 7, 2000
For: U.S. Patent No. 5,536,263

DECISION GRANTING PETITION

This is a decision on the June 20, 2005, patent owner PETITION UNDER 37 CFR 1.137(b) TO REVIVE UNINTENTIONALLY TERMINATED REEXAMINATION PROCEEDING, 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 $750.00 set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b) has been charged to petitioner's Deposit Account No. 19-0743, in accordance with petitioner's authorization in the third paragraph of the instant petition (appearing on page 2 of the facsimile transmission received on June 20, 2005).

The Notice of Appeal fee of $250.00 has been charged to petitioner's Deposit Account No. 19-0743, in accordance with petitioner's authorization in the third paragraph of the paper captioned "Notice of Appeal From the Decision of the Examiner to the Board of Patent Appeals and Interferences" (appearing on page 32 of the facsimile transmission received on June 20, 2005).

The petition under 37 CFR 1.137(b) is granted.

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, a Notice of Appeal and a Response were filed with patent owner's June 20, 2005 petition, and the appropriate fee is being charged to petitioner's deposit account as set forth above, 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 is being charged to petitioner's deposit account as authorized in the 37 CFR 1.137(b) petition, thereby providing the "petition fee as set forth in 37 CFR 1.17(m)" pursuant to 37 CFR 1.137(b)(2). Accordingly, the petition under 37 CFR 1.137(b) is granted.

The authorized petition fee of $580.00 for a two-month extension of time has not been charged to petitioner's Deposit Account No. 19-0743, as a request for an extension of time is moot in a proceeding which is not pending.

CONCLUSION

1. The petition under 37 CFR 1.137(b) is **granted**.

2. The reexamination file is being returned to Technology Center 3700, in due course, for consideration of the amendment filed June 20, 2005, with the petition.

3. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Kim M. Lewis, in Art Unit 3743, who can be reached at (571) 272-4796.

4. 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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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Paper No. 15

David A. Nelson, Esq.
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FOR OWNER

25 OCT 2001

Edward R. Yoches
Finnegan, Henderson, Farabow,
Garrett & Dunner, L.L.P.
1300 I Street N.W.
Washington, D.C. 20005-3315

FOR THIRD PARTY REQUESTER

In re Hansen et al.
Reexamination Proceeding
Control No. 90/005,880
Filed: December 8, 2000
For: U.S. Patent No. 4,814,976

DECISION *SUA SPONTE*, MERGING REEXAMINATION PROCEEDINGS

In re Hansen et al.
Reexamination Proceeding
Control No. 90/006,049
Filed: July 2, 2001
For: U.S. Patent No. 4,814,976

In re Hansen et al.
Reexamination Proceeding
Control No. 90/006,096
Filed: August 27, 2001
For: U.S. Patent No. 4,814,976

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. 4,814,976 issued on March 21, 1989.

'5880 Proceeding

2. A first request for reexamination, Control No. 90/005,880 ('5880) was filed by the Third Party Requester on December 8, 2000. [Paper No.3]

3. Reexamination was ordered in the '5880 reexamination proceeding on January 30, 2001. [Paper No. 5]

5. A first Office action was mailed on June 8, 2001. [Paper No. 9]

6. An Interview was held with the examiner of record and the Patent Owner's representatives on August 1, 2001. An Interview Summary was mailed on August 7, 2001. [Paper No. 10]

7. An Information Disclosure Statement was filed on August 10, 2001. [Paper No.11]

8. A Declaration under 37 C.F.R. § 1.132 was filed on August 10, 2001. [Paper No.12]

9. A Summary of the August 1, 2001 Interview was filed by Patent Owner's representatives on August 10, 2001. [Paper No.13]

10. A Request for reconsideration was filed on August 10, 2001. [Paper No.14]

'6049 Proceeding

11. A second request for reexamination, Control No. 90/006,049 ('6049) was filed by the Third Party Requester on July 2, 2001. [Paper No. 3]

12. Reexamination was ordered in the '6049 reexamination proceeding on July 20, 2001. [Paper No. 5]

'6096 Proceeding

13. A third request for reexamination, Control No. 90/006,096 ('6096) was filed by the Third Party Requester on August 27, 2001. [Paper No. 3]

14. Reexamination was ordered in the '6096 reexamination proceeding on October 4, 2001. [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 '5880, '6049 and '6096 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 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.

Allen MacDonald 10-2401

Allen R. MacDonald, Group Director
Technology Center 2100
Computer Architecture, Software, and Electronic Commerce

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. 8/35

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MAILED

JAN 08 2001

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.

Henry Thau for

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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DEC 1 7 2001

Paper No. 10/49

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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

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

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Washington, D C 20231
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90/005,881
90/006,051
90/005,823

APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,392 90/005,384	09/27/2002	5162666	TTI666RES	2026

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.

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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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	:

Copy with citation

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

[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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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Date:

MAILED

APR 24 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90005881
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)).

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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www.uspto.gov

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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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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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

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.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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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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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
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EXAMINER	
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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)).

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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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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/24/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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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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UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Klarquist Sparkman LLP
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Portland, Oregon 97204

(For Patent Owner)

MAILED

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 concludes *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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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.
90/005,888	12/12/2000	6014634	3302REX

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EXAMINER
GRAVINI

ART UNIT	PAPER
2162	22

DATE MAILED: 04/10/02

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

90005888.120701

Commissioner of Patents and Trademarks

PTO-90C (Rev.3-98)

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WASHINGTON, D.C 2023
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Paper No. 22

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FOR PATENT OWNER

Michael P. Mazza
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181 West Madison Street
Suite 4600
Chicago, Illinois 60602

FOR THIRD PARTY REQUESTOR

In re Reexamination of:
U.S. Patent No. 6,014,634
Reexamination Control No.
90/005,888
For: SYSTEM AND METHOD FOR PROVIDING SHOPPING AIDS AND INCENTIVES TO CUSTOMERS THROUGH A COMPUTER NETWORK

DECISION ON PETITION UNDER 37 CFR § 1.181 TO INVOKE SUPERVISORY AUTHORITY

This is a decision on the renewed petition under 37 CFR 1.181, filed March 11, 2002 requesting the Group Director to require the Examiner to consider the Information Disclosure Statement (IDS) submitted August 20, 2001.

RELEVANT BACKGROUND

1. A first Office action was mailed on July 24, 2001. [Paper No.6]

2. An Information Disclosure Statement was filed on August 20, 2001. [Paper No.9]

3. An Amendment in response to the first Office action was filed on October 17, 2001. [Paper No.12]

4. An Information Disclosure Statement was filed on October 17, 2001. [Paper No.13]

5. Another Information Disclosure Statement was filed on October 19, 2001. [Paper No.14]

6. A Final rejection was mailed on November 29, 2001. [Paper No. 15]. In this communication the Examiner indicated that the Information Disclosure Statements of August 20, October 17 and October 19, 2001 (papers 9, 13, and 14) would not be considered.

RELIEF REQUESTED

The instant petition under 37 CFR § 1.181 requests that the Commissioner require the Examiner to consider the IDS submitted August 20, 2001.

DETAILED HISTORY

Applicant filed Information Disclosure statements on August 20 [Paper No. 9], October 17 [Paper No.13], and October 19, 2001 [Paper No. 14]. Each of these papers was captioned "**INFORMATION DISCLOSURE/RELATED CASE STATEMENT UNDER 37 CFR 1.97**".

A Final rejection was mailed on November 29, 2001. [Paper No. 15]. In this communication the Examiner indicated that the Information Disclosure Statements of August 20, October 17 and October 19, 2001 (papers 9, 13, and 14) would not be considered. This refusal indicated that the ID statements did not "comply with the provisions of 35 U.S.C. 301 and 37 CFR 1.501 & 555 and MPEP §§ 2204-2206".

The action justified this conclusion by providing reasons and requirements labeled (a)-(e) which are paraphrased immediately below. (The italicized phrases are interpolated comments interpreting the Examiner's position.)

(a) no written explanation of the pertinency and manner of applying prior art... *(Examiner appears to be applying the standard for Citation of Prior Art under 35 U.S.C. § 301.)*

(b) no written explanation has been made to show how the prior art differs from the claim under examination.. *(Examiner appears to be applying the standard for Citation of Prior Art under 37 CFR § 1.501(a).)*

(c) some of the submissions are not considered patents or printed publications... *(Examiner appears to be objecting that the references are not material under 37 CFR § 1.555(b) .)*

(d) non-timely submission. *(Examiner appears to be objecting based on the phrase "should be submitted within two months of the date of the order" found in CFR § 1.555(a))*

(e) the information disclosure statements are not material to patentability of the present

reexamination proceeding because the submission is cumulative to information of record and does not establish unpatentability or refute a position of the patent owner. *(Examiner appears to be objecting that the references are not material under 37 CFR § 1.555(b) .)*

.. In order for the examiner to properly determine patentability over the prior art submitted, ***it is requested that the patent owner explain*** the significance of each reference or highlight those documents which have been specifically brought to patent owner's attention and/or are known to be of most significance. ***Examiner requests elimination of clearly irrelevant and marginally pertinent cumulative information***. [Emphasis added]
(Examiner requires Applicant to make a showing of materiality of the submission in order to have it considered.)

BASIS OF OPINION

The relevant portions of the Statute, Rules, and MPEP are reproduced below. Emphasis is added to draw attention to the critical phrases.

35 U.S.C. 301 Citation of prior art.

Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent. If the person ***explains in writing the pertinency and manner of applying such prior art to at least one claim of the patent***, the citation of such prior art and the explanation thereof will become a part of the official file of the patent. At the written request of the person citing the prior art, his or her identity will be excluded from the patent file and kept confidential.

35 U.S.C. 305 Conduct of reexamination proceedings.

After 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 under the provisions of sections 132 and 133 of this title.*** ...

37 CFR § 1.501 Citation of prior art in patent files.

(a) At any time during the period of enforceability of a patent, any person may cite, to the Office in writing, prior art consisting of patents or printed publications which that person states to be pertinent and applicable to the patent and believes to have a bearing on the patentability of any claim of the patent. ***If the citation is made by the patent owner***, the explanation of pertinency and applicability ***may include an explanation*** of how the claims differ from the prior art. Such citations shall be entered in the patent file except as set forth in §§ 1.502 and 1.902.

37 CFR §1.502 provides:

"Citations by the patent owner under §1.555 .... will be entered in the reexamination file during a reexamination proceeding."

37 CFR §1.555 Information material to patentability in ex parte reexamination and inter partes reexamination proceedings provides in relevant 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 duty to disclose the information exists with respect to each claim pending in the reexamination proceeding until the claim is cancelled. Information material to the patentability of a cancelled claim need not be submitted if the information is not material to patentability of any claim remaining under consideration 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.

(b) Under this section, information is material to patentability in a reexamination proceeding ***when it is not cumulative to information of record*** or being made of record in the reexamination proceeding, and

(1) ***It is a patent or printed publication*** that establishes, by itself or in combination with other patents or printed publications, a prima facie case of unpatentability of a claim; or

(2) It refutes, or is inconsistent with, a position the patent owner takes in:
(i) Opposing an argument of unpatentability relied on by the Office, or
(ii) Asserting an argument of patentability.

A prima facie case of unpatentability of a claim pending in a reexamination proceeding is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

MPEP § 2206.II.3.B. CITATION DOES NOT QUALIFY FOR ENTRY UNDER 37 CFR 1.501

A. Citation by Third Party

If the citation is not proper ***(i.e., it is not limited to patents or printed publications***), it should not be entered in the patent file. The sender (if known) and the patent owner in all cases should be notified that the citation is improper and that it is not being entered in the patent file. The handling of the citation will vary depending on the particular following situation. (Emphasis added)

...

B. Citation Filed by the Patent Owner

If an improper prior art citation under 37 CFR 1.501 is filed by the patent owner prior to an order for reexamination, it should not be entered in the file. The patent owner should be notified of the nonentry, and the citation papers should be returned to the patent owner along with the notification. ***Prior art submission filed by the patent owner after an order for reexamination should be entered in the file under 37 CFR 1.555***

PETITIONER'S ARGUMENT

I. Petitioner presents an argument which is summarized in the following syllogisms:

(A) 35 U.S.C. §305 states that "reexamination will be conducted according to the ***procedures established for initial examination*** under the provisions of section 132 and 133 of this title". (Emphasis added)

(B) 37 CFR §1.97 and 37 CFR §1.98 are implementations of 35 U.S.C. §132 and §133.

Therefore, 37 CFR §1.97 and 37 CFR §1.98 govern the treatment of any IDS submitted in a reexamination proceeding.

(C) The IDS filed August 20, 2001 complied with 37 CFR §1.97 and §1.98.

(D) Any IDS which complies with 37 CFR §1.97 and §1.98 must be considered.

Therefore, the IDS must be considered by the Examiner.

II. Petitioner also addresses Examiner's statement that the IDS should be treated as a submission under 35 U.S.C. § 301 and 37 CFR §1.501 and §1.555. Specifically, Petitioner points out that 35 U.S.C. §301 and Rule 501 deal with prior art submissions not to information disclosure statements filed by patent owner after reexamination has been ordered.

OPINION

I. The minor premise (labeled "(B)" above) assumes too much. 35 U.S.C. §132 is directed to "Notice of rejection; reexamination" and 35 U.S.C. §133 deals with "Time for prosecuting application". That all rules are implementations of these two sections of 35 U.S.C. and are "procedures established for initial examination" under these sections is not a tenable position. Not all the rules which are applicable to an initial examination apply in reexamination proceedings. In particular, Rule 97 does not apply in reexamination.

The second syllogism is based on the conclusion of the first syllogism. Namely that information disclosure statements submitted during the course of a reexamination are governed by 37 CFR §1.97. However, as noted above, that is incorrect. It is 37 CFR §1.555 which governs in reexamination proceedings.

II. Petitioner submitted an IDS under 37 CFR §1.97 without clarifying whether it was intended to be a filing under 37 CFR §1.501 or 37 CFR §1.555. Because there was no explanation of the pertinency and manner of applying such prior art to at least one claim of the patent this filing was improper under 37 CFR §1.501. However, MPEP 2206 II.3.B states that an improper filing under 37 CFR §1.501 by patent owner after the grant of an order should be treated as submitted under 37 CFR §1.555 and entered in the file.

The citation to 37 CFR §1.502 supports petitioner as to the inapplicability of 35 U.S.C. § 301 and 37 CFR §1.501 to the submission of 20 August 2001. Submissions by patent owner will be entered even if non-compliant. Therefore, the objections to the IDS in paragraphs 1(a) and 1(b) of Paper No. 15 (requiring various written explanations) are not valid. Petitioner correctly points out that under CFR §1.555 the 2 month window is not obligatory. Accordingly, the objection of 1(d) is overruled.

Therefore, with respect to paragraphs (a) -(e) of the Examiner's action:

> (a) This objection is based on treating the IDS as a filing under 35 U.S.C. § 301. As noted above, the filing should be treated under 37 CFR §1.555. **This objection is withdrawn.**
>
> (b) This objection is based on treating the IDS as a filing under 35 U.S.C. § 301 and applying 37 CFR §1.501(a). As noted above, the filing should be treated under 37 CFR §1.555. Furthermore, even under, 37 CFR §1.501(a) the patent owner ***is not required*** to provide any explanation as to how the prior art differs from the claim. The phrase in 37 CFR §1.501(a) is permissive not obligatory. **This objection is withdrawn.**
>
> (c) This objection amounts to a statement that the references which are not patents or printed publications do not qualify as material under 37 CFR § 1.555(b) . Insofar as the Examiner can not use these items as a basis for rejecting the claims they are not material to patentability. However, as explained below Applicant may submit items which are not material. Therefore, the references will be considered by the Examiner but will not be used as the basis of any

rejections. **This objection is withdrawn.**

(d) This objection incorrectly treats hortatory language found in 37 CFR § 1.555(a) as obligatory. **This objection is withdrawn.**

(e) This objection amounts to a statement that the references, ***which are patents and printed publications***, are not material to patentability of the present reexamination proceeding. The Examiner couples this objection with a request that Applicant establish the materiality of each submitted reference that Applicant wishes to have considered. Petitioner has not availed himself of the opportunity to comply with this request. **As noted below, Applicant is not *required* to comply with this request.** Therefore, **this objection is withdrawn.**

DECISION

While the information disclosure statements filed clearly do not comply with the guidelines set forth in MPEP 2004 paragraph 13 regarding both the number of references cited and the elimination of clearly irrelevant art and marginally pertinent cumulative informative, compliance with these guidelines is not mandatory. Furthermore, 37 CFR § 1.555(b) and 1.98 do not require that the submitted information be material, rather they allow for submission of information regardless of its pertinence to the claimed invention. Also, there is no requirement to explain the materiality of submitted references. However, the cloaking of a clearly relevant reference by inclusion in a long list of citations may not comply with Applicant's duty of disclosure. See *Penn Yan Boats, Inc. v. Sea Lark Boats, Inc.*, 359 F. Supp. 948, 175 USPQ 260 (S.D. Fla. 1972), aff 'd, 479 F.2d 1338, 178 USPQ 577 (5th Cir. 1973), cert. denied, 414 U.S. 874 (1974).

The Application is being forwarded to the Examiner for consideration of the items cited in the IDS. The examiner is advised to consider these references in the same manner as references encountered during a normal search of Office search files. There is no duty to consider these references to a greater extent than those ordinarily looked at during a regular search by the Examiner. Insofar as certain references cannot form the basis of rejections the Examiner need not consider them to an extent greater then he would non-prior art references in an ordinary search.

Accordingly, the Petition is **GRANTED** to the extent which the submission complies with 37 C.F.R. §1.555 and 1.98. The Examiner will not address any items not in compliance with the rules.

John J. Love, Group Director
Technology Center 2100
Computer Architecture, Software, and Electronic Commerce

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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FEB 26 2002

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2100

Paper No. 18

Richard A. Neifeld
OBLON, SPIVACK, McCLELLAND,
MAIER AND NEUSTADT, P.C.
Fourth Floor
1755 Jefferson Davis Highway
Arlington, Virginia 22202

FOR PATENT OWNER

Michael P. Mazza
NIRO, SCAVONE, HALLER & NIRO
181 West Madison Street
Suite 4600
Chicago, Illinois 60602

FOR THIRD PARTY REQUESTOR

In re Reexamination of:
U.S. Patent No. 6,014,634
Reexamination Control No.
90/005,888
For: SYSTEM AND METHOD FOR PROVIDING SHOPPING AIDS AND INCENTIVES TO CUSTOMERS THROUGH A COMPUTER NETWORK

DECISION ON PETITION UNDER 37 CFR § 1.181 TO INVOKE SUPERVISORY AUTHORITY

This is a decision on the petition under 37 CFR 1.181, filed December 7, 2001 requesting the Group Director to require the Examiner to consider the Information Disclosure Statement (IDS) submitted August 20, 2001.

RELEVANT BACKGROUND

1. A first Office action was mailed on July 24, 2001. [Paper No.6]

2. An Information Disclosure Statement was filed on August 20, 2001. [Paper No.9]

3. An Amendment in response to the first Office action was filed on October 17, 2001. [Paper No.12]

4. An Information Disclosure Statement was filed on October 17, 2001. [Paper No.13]

5. Another Information Disclosure Statement was filed on October 19, 2001. [Paper No.14]

6. A Final rejection was mailed on November 29, 2001. [Paper No. 15]. In this communication the Examiner indicated that the Information Disclosure Statements of August 20, October 17 and October 19, 2001 (papers 9, 13, and 14) would not be considered.

RELIEF REQUESTED

The instant petition under 37 CFR § 1.181 requests that the Commissioner require the Examiner to consider the IDS submitted August 20, 2001.

Applicant presents the following argument (which is reproduced in its entirety) in support of the petition:

> The IDS I filed August 20, 2001 complied with the patent owner's duty to disclose, and it met all legal and regulatory requirements.
>
> The examiner's citation to 35 USC 301, 37 CFR 1.501 and 555, and MPEP section 2202 and 2206 are improper and irrelevant.

OPINION

Petitioner's submission states that Applicant believes that his submission complies with the relevant requirements and that the Examiner was incorrect in refusing to consider the IDS. These conclusory statements do not serve as argument as they do not address the specifics of the Examiner's position as laid out in the Office action. The applicant should present a fully developed position as to why the Examiner's action is not in compliance with the rules in the petition to invoke supervisory review.

Accordingly, the Petition is **DISMISSED**.

Any request for reconsideration must be filed within two months of the mailing date of this decision.

John J. Love, Group Director
Technology Center 2100
Computer Architecture, Software, and Electronic Commerce

UNITED STATES PATENT AND TRADEMARK OFFICE

#56 DW

JAN - 4 2005

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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JAN - 4 2005

OFFICE OF THE DIRECTOR
TC 3600

For the Patent Owner:

Oblon, Spivak, McClelland, Maier & Neustadt, PC
1940 Duke Street
Alexandria, VA 22314

For the Requester:

Michael P. Mazza
Niro, Scavone, Haller & Niro
181 West Madison Street
Suite 4600
Chicago, IL 60602

DECISION ON PETITION FOR THE ACCEPTANCE OF LATE PAPERS

In re Reexamination proceeding 90/005,888
Filed: December 12, 2000
For: SYSTEM AND METHOD FOR PROVIDINGSHOPPING AIDS AND INCENTIVES TO CUSTOMERS THROUGH A COMPUTER NETWORK

This is in reply to petitioner's communication filed December 2, 2004 which 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 the Appeal Brief with a Certificate of Service filed June 30, 2004, was apparently never received by the Office. The patent owner has submitted a copy of the above-noted amendment along with a post card receipt dated June 30, 2004. This is acceptable evidence of a timely filing of the lost correspondence.

The reexamination file is being forwarded to the Supervisory Legal Instruments Examiner to enter the communication from the patent owner filed December 2, 2004.

Steven N. Meyers
Patent Technology Center 3600
(703) 308-3868

SM/SM: 12/26/04

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Commissioner for Patents
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Alexandria, VA 22313-1450
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FROM DIRECTORS OFFICE

JUN 27 2005

TECHNOLOGY CENTER 3600

For the Patent Owner:

Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, VA 22314

For the Requester:

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181 West Madison Street, Suite 4600
Chicago, IL 60602

DECISION ON PETITION
FOR EXTENSION OF TIME

In re Ex Parte Reexamination proceeding 90/005,888
Filed: December 12, 2000
For: SYSTEM AND METHOD FOR PROVIDING SHOPPING AIDS AND INCENTIVES TO CUSTOMERS THROUGH A COMPUTER NETWORK

This is a decision on the request for an extension of time filed by the Patent Owner under 37 CFR 1.956 on June 7, 2005. There is no fee required for this petition.

The petition is **DISMISSED**.

A non-final Office action was mailed on May 10, 2005 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 non-final rejection. The reasons for the request are that the Office action in this Reexamination Proceeding was only forwarded to the petitioning attorney on June 1, 2005 from the attorney at the correspondence address. Additionally, petitioner asks that the extension be granted in order because of many attorneys taking vacations in the month of June, and asserts that due to these vacations it would be burdensome to prepare a suitable response by July 10, 2005.

A petition under 37 CFR 1.550 can be granted for a showing of "sufficient cause". MPEP 2665 provides that "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". Historically, it has been held that

sufficient cause has been shown when a petitioner outlines an unusual or unique situation that would hamper a proper response.

In this case, the argument that the Office action was just forwarded to the petitioning attorney is not a persuasive one for granting an extension. The action was sent to, and apparently received at, the proper correspondence address of record. Whatever movement of the action between law firms that subsequently causes a delay is not grounds for granting an extension of time.

As for the vacations scheduled for attorneys in the firm, a lengthy vacation by the attorney who is handling the reexamination proceeding can serve as grounds for an extension of time, however, a few days off or vacations by other attorneys in the firm is generally not considered a unusual or unique situation that would justify an extension of time. It is unclear if this reexamination proceeding is going to be directly handled by an attorney who will be taking a lengthy vacation during the response period.

Patent Owner's period for response continues to run 2 months from the May 10, 2005 mail date of the non-final Office action in this Ex Parte Reexamination Proceeding.

Questions concerning this decision should be directed to Special Programs Examiner Steven N. Meyers at (571) 272-6611.

Robert J. Oberleitner For

John Love, Director
Patent Technology Center 3600
(571) 272-5250

SM/SM: 6/21/05
SM

#9
(mas)

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. 9

Emery L. Tracy
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Boulder, CO 80306

(For Patent Owner)

John Dodds
DODDS & ASSOCIATES
1742 N. Street, NW
Washington, DC 20036

(For Requester)

MAILED

JUN 13 2001

REEXAM UNIT

In re reissue application of
Proctor
Serial No. 09/773,303
Filed: January 31, 2001
For: U.S. Patent No. 5,894,079

In re Proctor
Reexamination Proceeding
Control No. 90/005,892
Filed: December 20, 2000
For: U.S. Patent No. 5,894,079

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. 5,894,079 issued to Proctor on April 13, 1999.

2. A request for reexamination of the '079 patent was filed by a third party requester on December 20, 2000, and the resulting reexamination proceeding was assigned Control No. 90/005,892.

3. On January 31, 2001, patent owner filed a reissue application which was assigned Application No. 09/773,303.

4. On February 6, 2001, reexamination was ordered in the '5892 proceeding.

5. Notice of the filing of the reissue application was published in the *Official Gazette* on April 3, 2001.

6. On April 9, 2001, patent owner filed a request for a one month extension of time to file a statement pursuant to 37 C.F.R. § 1.530 in the '5892 proceeding. A one month extension of time was granted.

7. A patent owner's statement has not been filed in the '5892 proceeding.

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 '5892 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 '5892 reexamination file shows that the original specification, drawings and patent claims are presently in the reexamination file. No patent owner's statement pursuant to 37 C.F.R. § 1.530 has been filed. The reexamination proceeding is awaiting a first Office action on the merits by the examiner.

A review of the reissue (Application No. 09/773,303) prosecution history shows that the reissue application was published in the *Official Gazette* on April 3, 2001. The application is awaiting a first Office action on the merits by the examiner. In the reissue application, applicant has submitted new claims 16-58 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

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. 09/773,303, and Control Number 90/005,892. 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.

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
Special Projects Examiner
Office of Patent Legal Administration

June 13, 2001

TECH CENTER 2900

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.
09/773,303	01/31/01	Larry M. Proctor	

PATENT NUMBER	DATE OF THIS NOTICE	PAPER NUMBER
5,894,079	06/13/01	10

NOTICE OF MERGED REEXAM - REISSUE PROCEEDING

This reissue application has been merged with the reexamination proceeding listed below:

Control No. 90/ 005,892 Filing Date: 12/20/00

Requester (name, address) John Dodds
Dodds and Associates
1742 N. Street NW
Washington DC 20036

The front face of the reissue patent will include the following paragraph:

REEXAMINATION RESULTS

The questions raised in reexamination request No. 90/ 005892, filed 12/20/00, 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

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.
90/005,892	12/20/2000	5894079	396168	6243

7590 07/07/2010

EXAMINER	

Larry M. Proctor
2611 State Highway 348
Delta, CO 81416

ART UNIT	PAPER NUMBER

DATE MAILED: 07/07/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
LAW OFFICES OF DODDS & ASSOCIATES
1707 N ST., NW
WASHINGTON, DC 20036

Date: **MAILED**

JUL 0 7 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90005892
PATENT NO. : 5894079
ART UNIT : 3991

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)).

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.
09/773,303	01/31/2001	Larry M. Proctor	414634	8508

7590 07/08/2010

Larry M. Proctor
2611 State Highway 348
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EXAMINER	
MCELWAIN, ELIZABETH F	
ART UNIT	PAPER NUMBER
1638	

MAIL DATE	DELIVERY MODE
07/08/2010	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.

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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JUL 07 2010

CENTRAL REEXAMINATION UNIT

Larry M. Proctor
2611 State Highway 348
Delta, Colorado 81416

(For Patent Owner)

Law Offices of
Dodds & Associates
1707 N St., NW
Washington, DC 20036

(For Third Party Requester)

In re reissue application of
Larry M. Proctor
Application No. 09/773,303
Filed: January 31, 2001
For: U.S. Patent No. 5,894,079

In Larry M. Proctor
Reexamination Proceeding
Control No. 90/005,892
Filed: December 20, 2000
For: US. Patent No. 5,894,079

DECISION, SUA SPONTE, TO SEVER REEXAMINATION AND REISSUE PROCEEDINGS

The merged proceeding consisting of reissue application 09/773,303 and *ex parte* reexamination proceeding 90/005,892 is before the Office of Patent Legal Administration (OPLA) for consideration of whether the merger should be dissolved so that the reissue application and the reexamination proceeding can separately proceed.

BACKGROUND

1. Patent number 5,894,079 issued on April 13, 1999.
2. On December 20, 2000, a request for reexamination of claims 1-15, all of the claims in the '079 patent, was filed by a third party requester, and was accorded control number 90/005,892 (the '5892 proceeding).

3. On January 31, 2001, patent owner filed a reissue application, which was accorded application number 09/773,303 (the '303 reissue), requesting correction of errors in U.S. Patent number 5,894,079, and including claim amendments and new claims 16-58.

4. On February 6, 2001, reexamination of claims 1-15 was ordered in the '5892 proceeding.

5. On June 13, 2001, the Office issued a decision merging the above identified reissue application and reexamination proceeding.

6. On April 29, 2008, the Board of Appeals and Interferences affirmed the examiner's final rejection of claims 1-15, 51, 52, and 56-64, all of the claims pending and not withdrawn from consideration in the case.

7. On September 23, 2009, the Court of Appeals for the Federal Circuit (the Federal Circuit) issued a mandate affirming a finding of unpatentability for all of the claims at issue in the merged '079 patent proceeding of the '079 patent as being obvious, in violation of 35 U.S.C. § 103. *In re Pod-Ners*, 93 U.S.P.Q.2d 1411 (Fed. Cir. 2009).

RELEVANT LAW AND PROCEDURE

MPEP § 1216.01 provides:

> In an *ex parte* appeal, after the [Federal Circuit] mandate is issued, the application or reexamination file is then returned to the appropriate U.S. Patent and Trademark Office official for further proceedings consistent with the mandate. See MPEP § 1214.06 for handling of claims dependent on rejected claims.
>
> A. All Claims Rejected
> **If all claims in the case stand rejected, proceedings in the case are considered terminated on the issue date of the Federal Circuit's mandate**. Because the case is no longer considered pending, it is ordinarily not open to subsequent amendment and prosecution by the applicant. Continental Can Company v. Schuyler, 326 F. Supp. 283, 168 USPQ 625 (D.D.C. 1970). [Emphasis added]

MPEP § 1214.06 provides:

> I. NO CLAIMS STAND ALLOWED
> The proceedings in an application or ex parte reexamination proceeding are terminated as of the date of the expiration of the time for filing court action. The application is no longer considered as pending. It is to be stamped abandoned and sent to abandoned files. **In an ex parte reexamination proceeding, a reexamination certificate should be issued under 37 CFR 1.570**. [Emphasis added]

DECISION

The Office is acting, *sua sponte*, to determine the propriety of maintaining the merger of the proceedings in view of the September 23, 2009 Federal Circuit holding of unpatentability for all of the appealed claims in the '5892 reexamination and '303 reissue of the '079 patent. MPEP § 2286 states that reexamination will continue if there exists any original, new, or amended claim being examined that was not found invalid or unenforceable by the court so long as a substantial new question of patentability (SNQ) exists for that claim. The '5892 reexamination, subsequent to merger with the '303 reissue, contained patent claims 1-15 and new claims 16-61, of which only claims 1-15, 51, 52, and 56-64 were appealed.[1] As of September 23, 2010, the issue date of the Federal Circuit's mandate, the case is no longer pending and the proceedings in this case are considered terminated. When no claims stand allowed following the mandate of the Federal Circuit, prosecution of the reexamination is to be terminated pursuant to § 1214.06, and a reexamination certificate should be issued.

After consideration of the record of the merged application/proceeding, it is decided that the merger of the two proceedings is no longer the appropriate option for this fact situation. The Office's June 13, 2001 merger of the reissue application and reexamination proceeding is hereby severed, and the guidance set forth in the merger decision is no longer applicable to the now-separate reissue application and reexamination proceeding.

Further Treatment of Severed Proceedings

1. *Ex Parte* Reexamination Proceeding 90/005,892

No claims stand allowed in the reexamination proceeding. When following the mandate of the Federal Circuit no claims stand allowed, pursuant to MPEP §1214.06, prosecution of the reexamination is to be terminated, and a reexamination certificate should be issued. Therefore, the '5892 *ex parte* reexamination proceeding is being forwarded to the CRU to issue a Notice of Intent to Issue a Reexamination Certificate (NIRC), with the proceeding to be concluded in due course by issuance of a reexamination certificate.

2. Reissue Application 09/773,033

In view of the Federal Circuit decision of unpatentability for all of the claims appealed in the merged '5892 reexamination and '303 reissue proceeding of the '079 patent, the '033 reissue application is being forwarded to Technology Center 1600 for further handling consistent with the decision and in accordance with reissue practice and the guidance in MPEP §§ 1216.01 and 1214.06. As of September 23, 2010, the issue date of the Federal Circuit's mandate, the case is no longer pending and the proceedings in this case are considered terminated.

[1] Claims 54 and 55 have been cancelled. Claims 16-50, 53, and 65-71 were withdrawn from consideration.

CONCLUSION

1. The merger of the '5892 reexamination proceeding and the '303 reissue application is hereby severed.

2. Jurisdiction over the '5892 reexamination is forwarded to the CRU for further processing in view of the Federal Circuit decision of unpatentability for all of the claims at issue in the merged '5892 reexamination. *In re Pod-Ners*, 93 U.S.P.Q.2D (BNA) 1411 (Fed. Cir. 2009). Specifically, the CRU shall issue a NIRC directing cancellation of all claims in the proceeding, with the proceeding to be concluded in due course by issuance of a reexamination certificate cancelling claims 1-15 of the '079 patent.

3. Jurisdiction over the '303 reissue application is being returned to Technology Center 1600 for further processing in accordance with reissue practice in view of the finding of unpatentability for all of the claims at issue in the '303 reissue proceeding. *In re Pod-Ners*, 93 U.S.P.Q.2d 1411 (Fed. Cir. 2009).

4. Telephone inquiries related to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700, or in his absence, to Pinchus M. Laufer (571) 272-7726.

Pinchus M. Laufer
Legal Advisor
Office of Patent Legal Administration

July 7, 2010

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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#11

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(For Patent Owner)

Robert J. Frank, Esq.
Venable
1201 New York Avenue NW, Suite 1000
Washington DC 2005-3917

(For Requester)

Reexam Control No.: 90/005,696
Filed: April 5, 2000
For: U.S. Patent No. 5,275,595

Reexam Control No.: 90/005,900
Filed: January 3, 2001
For: U.S. Patent No. 5,275,595

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. 90/005,696 was ordered in a decision mailed June 29, 2000. Amendments to the specification, abstract, and claims were filed August 29, 2000, December 11, 2000, and December 15, 2000.

Reexamination in application Control No. 90/005,900 was ordered in a decision mailed February 21, 2001.

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

As noted above, the abstract, specification, and claims have been amended in the Reexam Control No. 90/005,696. The patent owner is required to maintain identical specifications, abstract, 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 specification, abstract, and 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 requester and requester will be sent copies of all papers mailed by the Office.

Conclusion

Reexamination Control Nos. 90/005,696 and 90/005,900 are hereby merged. Upon receipt of the required paper placing the same specification, abstract and 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: (703) 308-0873

ak/6/11/01

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MAY - 7 2001

Paper No. 15

John C. Altmiller
Kenyon and Kenyon
1500 K Street NW Suite 700
Washington, DC 20005-1247

(For Patent Owner)

Robert J. Frank, Esq
Venable
1201 New York Avenue, NW
Suite 1000
Washington, D.C. 20005-3917

(For Requester)

In re John D. Dobak, III et al.
Reexamination Proceeding
Control No. 90/005,697
Filed: April 5, 2000
For: U.S. Patent No. 5,758,505

In re John D. Dobak, III et al.
Reexamination Proceeding
Control No. 90/005,901
Filed: January 3, 2001
For: U.S. Patent No. 5,758,505

DECISION, *SUA SPONTE*, MERGING REEXAMINATION PROCEEDINGS

DECISION

The above noted reexamination files are now before the Director of Patent Examining Groups 3740 and 3750 for consideration of merger of the proceedings under 37 CFR § 1.565(c), in accordance with the practice set forth at MPEP § 2283.

I. Merger of Proceedings

As required by the practice pursuant to MPEP § 2283, and under the authority of 37 CFR § 1.565(c), the '697 and '901 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

All future submissions by Owner must be served on Requester of Control No. 90/005,901. The contents of each file will thereafter 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. 15 in both files. There will be no Paper Nos. 7-14 in Control No. 90/005,901.

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. Requester will receive the body of the action, with the appropriate cover sheet, while Owner will receive the body of the action and a copy of each cover sheet. All papers filed by Owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by Owner must consist of a single response, filed in duplicate, each bearing an original signature, for entry in each file. Owner is reminded that every paper filed in the merged proceedings subsequent to this Decision must be served on Requester, even papers filed *via* facsimile transmission.

Since there are no amendments to the specification or claims in Control No. 90/005,697, the reexam files will be forwarded to the examiner for an office action to be mailed in due course. The Primary Examiner should note that each reexamination file must reflect consideration of the identical prior art, and should, therefore, insure that each file reflects identical reference citations.

DECISION

Reexamination Control Nos. 90/005,697 and 90/005,901 are MERGED. Extensions of time are governed by 37 CFR § 1.550(c). The files are being forwarded to the Primary Examiner. Owner must keep the examiner advised as to the status of any presently existing or future litigation involving the patent under reexamination.

Richard A Bertsch

Richard Bertsch
Director, Technology Center 3700
Phone: (703) 308-0975
Fax: (703) 305-7764

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.
90/005,697 and 90/005,901	04/05/00	5758505	11499/2

QM01/0906

John C Altmiller
Kenyon and Kenyon
1500 K Street N W Suite 700
Washington DC 20005-1247

EXAMINER
DOERRLER, W

ART UNIT	PAPER NUMBER
3744	20

DATE MAILED: 09/06/01

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. GPO: 2000-473-000/44602

2 - Mail Copy

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WASHINGTON, D.C. 20231
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Paper No. 20

In re Application of 5758505
Appl. No.: 90/005,697
Filed: April 05, 2000
For: PRECOOLING SYSTEM FOR JOULE-THOMSON PROBE

DECISION ON PETITION UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b), filed May 23, 2000 to expunge information from the above identified application.

The petition is granted.

Petitioner requests that a document entitled pages 57-147, 148-233, 246-275 and 275-375 of the Deposition of Gerald W. Spinks, Esq. of December 14, 1999, Cite No. 152 ("Information") filed April 5, 2000, be expunged from the record. Petitioner states that either: (A) 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 information in question has been determined by the undersigned to not be material to the examination of the instant application.

Applicant is required to retain the expunged material(s) for the life of any patent which issues on the above-identified application.

The expunged material is returned herewith.

Enclosure: Above listed pages of the Spinks deposition

William C. Doerrler
Primary Examiner
TC 3744
July 20,2001

William C Doerrler

90005697.060501

#17
DW

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OFFICE OF THE DIRECTOR
TC 3600

Ned W. Randle
Polster, Lieder, Woodruff and Lucchesi, L.C.
763 New Ballas Road
St. Louis, MO 63141

Reexamination Control No. 90/005,905
Filed: January 5, 2001
For: MODULAR BACKREST SYSTEM FOR A WHEELCHAIR

DECISION ON PETITION FOR THE ACCEPTANCE OF LATE PAPERS

This is in reply to petitioner's communication filed September 27, 2004, which 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 Office action was mailed on March 8, 2004 wherein a two-month shortened statutory period for response was set. Petitioner alleges that a Notice of Appeal was timely filed on April 8, 2004 and an Appeal Brief was filed on April 19, 2004. Petitioner has submitted a copy of the Notice of Appeal and a copy of the Appeal Brief, along with copies of stamped post cards evidencing proof of these papers being filed on April 8, 2004 and April 19, 2004, respectfully. This is acceptable evidence of timely filing of the Notice of Appeal and Appeal Brief.

Telephone inquiries relative to this decision should be directed to Special Programs Examiner Kenneth J. Dorner at (703) 308-0866.

The reexamination file is being forwarded to the Supervisory Legal Instruments Examiner to enter the Notice of Appeal and Appeal Brief.

Kenneth J. Dorner, Special Programs Examiner
Patent Technology Center 3600
(703) 308-0866

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.
90/005,913	01/22/01	4849267	REEX-101

027682 IM22/0824
J. MICHAEL MARTINEZ DE ANDINO ESQ.
HUNTON & WILLIAMS
RIVERFRONT PLAZA, EAST TOWER
951 EAST BYRD ST.
RICHMOND VA 23219-4074

EXAMINER	
SINGH, A	
ART UNIT	PAPER NUMBER
1771	17

DATE MAILED: 08/24/01

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

Commissioner of Patents and Trademarks

SCANNED

J. Michael Martinez de Andino
Hunton & Williams
Riverfront Plaza, East Tower
951 East Byrd Street
Richmond, VA 23219-4074

(for Patent Owner)

Barry I. Hollander
Hollander Law Firm, P.L.C.
Suite 305
10300 Eaton Place
Fairfax, VA 22030

(for Third Party)

In re Ward et al
Reexamination Proceeding
Control No. 90/005,640
Filed: February 18, 2000
For: U.S. Patent No. 4,849,267

In re Ward et al
Reexamination Proceeding
Control No. 90/005,913
Filed: January 22, 2001
For: U.S. Patent No. 4,849,267

DECISION MERGING REEXAMINATION PROCEEDINGS

Paper #35

The above noted reexamination files are before the Director of Technology Center 1700 for consideration of the merger of the proceedings under 37 C.F.R. 1.565(c).

BACKGROUND

1. United States Patent 4,849,267, issued July 18, 1989, is the subject of Reexamination Control Nos. 90/005,640 and 90/005,913.

2. A first request for reexamination, assigned Reexamination Control No. 90/005,640 ('640), was filed February 18, 2000 by Barry Hollander of Hollander Law Firm, P.L.C., Suite 305, 10300 Eaton Place, Fairfax, VA 22030. The request urged that a substantial new question of patentability was raised by the teachings

of (a) U.S. patent 4,617,210; (b) U.S. patent 4,617,210, in combination with U.S. patent 3,704,197 and/or U.S. patent 3,922,464; (c) U.S. patent 4,617,210 in combination with the June 1983 Henry® 630 adhesive article and/or Henry® Flooring Adhesives Specification Guide and (d) U.S. patent 4,617,210, in combination with U.S. patent 3,014,829.

3. Reexamination was ordered for '640 on May 25, 2000.

4. A first Office action for '640 was mailed on September 22, 2000 and contained (a) the rejection of claims 1-4, 7, 10 and 11 under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 4,617,210 in view of U.S. patent Re. 24,906; (b) the rejection of claims 1-4 and 7-11 under 35 U.S.C. as being unpatentable over U.S. patent 3,704,197; and (c) the rejection of claims 1-4 and 7-11 under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 3,704,197, in view of U.S. patent 3,922,464. The patentability of claims 5, 6 and 12-19 was confirmed.

5. Patent owner responded to the first Office action on December 8, 2000. A one month extension of time to respond to the first Office action was approved on November 17, 2000.

6. A "Notice of Intent to Issue Reexamination Certificate" was mailed December 28, 2000 confirming the patentability of claims 1-19. A "Statement of Reasons for Patentability and/or Confirmation" was attached thereto, which set forth the examiner's reasons for patentability of the claims over the prior art of record.

7. Patent owner responded to the "Notice of Intent to Issue Reexamination Certificate" by submitting a "Request for Clarification of Discrepancy in the Record" on January 3, 2001.

8. A "Reexamination Interview Summary Form" was mailed on January 31, 2001 in which the record was clarified.

9. A second request for reexamination, assigned Reexamination Control No. 90/005,913 ('913), was filed January 22, 2001 by Barry Hollander of Hollander Law Firm, P.L.C., Suite 305, 10300 Eaton Place, Fairfax, VA 22030. The request urged that a substantial new question of patentability was raised by the teachings of (a) U.S. patent 4,617,210, in combination with U.S. patent 4,284,681; (b) U.S. patent 4,617,210, in combination with U.S. patent 4,284,681 and U.S. patent 3,704,197 and/or U.S. patent 3,922,464; (c) U.S. patent 4,617,210, in combination with U.S. patent 4,284,681 and the1983 Henry® 630 adhesive article and/or the Henry® Flooring Adhesives Specification Guide; (d) U.S. patent 4,617,210, in combination with U.S. patent 4,284,681 and U.S. patent 3,014,829.

10. Reexamination was ordered for '913 on March 28, 2001.

DISCUSSION

Under 37 C.F.R. 1.565(c):

> If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* proceeding has not been terminated, the *ex parte* 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 each of the above reexamination proceedings. Accordingly, merger of the proceedings under 37 C.F.R. 1.565(c) is appropriate. MPEP 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.

PROOF - NOT FILED

DECISION

I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. 1.565(c), the 90/005,640 and 90/005,913 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. REQUIREMENTS FOR THE 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 2283, "Merger of Reexaminations".

III. CONDUCT OF MERGED PROCEEDING

The "Notice of Intent to Issue Reexamination Certificate" mailed December 28, 2000 is hereby withdrawn and the files shall be forwarded to the examiner for consideration of the prior art, statements and evidence presented in the second Request for Reexamination.

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 Reexamination Control No. 90/005,640 and No. 90/005,913 as:

J. Michael Martinez de Andino, Esq.
HUNTON & WILLIAMS
Riverfront Plaza, East Tower
951 East Byrd Street
Richmond, VA 23219-4074

CONCLUSION
Reexamination Control Nos. 90/005,640 and 90/005,913 are merged. An Office action will be issued in due course.

Richard V. Fisher

Richard V. Fisher, Director
Technology Center 1700
Chemical and Materials Engineering

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APR 17 2005

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Fulbright & Jaworski, LLP
666 Fifth Avenue
New York, NY 10103-3198

(For Patent Owner)

Michael L Goldman, Esq.
Nixon Peabody LLP
Clinton Square P.O. Box 31051
Rochester, NY 14603-1051

(For Requester)

In re Cerasiv GMBH, Innovatives Keramik-Engineering
Reexamination Proceeding
Control No. 90/005,914
Filed: January 25, 2001
For: U.S. Patent No. 5,879,397

: DECISION ON PETITION

This is a decision on the petition filed on March 17, 2005 by which Owner requests that the amendment filed on September 22, 2004 be entered for examination. The petition is being considered under 37 CFR 1.181, and no fee is required.

The petition is dismissed.

The record shows that on June 30, 2004, the Board of Patent Appeals and Interferences (Board) decided an appeal from the final rejection of amended patent claims 1 and 4, and newly added claims 6-9. The Board held that the examiner's final rejection of claims 1, 4 and 6 was proper, and sustained the rejection. The Board also held that the final rejection of claims 7-9 was not proper, and reversed the rejection. However, the Board remanded the proceeding to the examiner so that the examiner could consider making a new rejection of claims 7-9 that was discussed in the decision. The Board did not enter a new ground of rejection under 37 CFR 1.196(b), the regulation then in effect (this regulation was replaced by new 37 CFR 41.50(b), which took effect on September 23, 2004, well after the date of the Board decision). The decision of the Board clearly states that in view of the remand, the Board's decision was not final.

The record further shows that on July 13, 2004, the examiner promulgated a nonfinal action in which the examiner stated that in accordance with the Board's decision, prosecution on claim 1, 4 and 6 was closed. The examiner then included a rejection of claims 7-9 in accordance with the rejection discussed in the Board's decision. On September 22, 2004, Owner filed a reply to the nonfinal action, in which claims 1, 4 and 6 were presented without amendment relative to the appealed version of those claims, claims 7-9 were presented without amendment relative to the appealed versions of those claims, and new claims 10-26 were presented.

The examiner held that the September 22, 2004 amendment was improper and refused to enter the amendment. The examiner did not promulgate a separate paper explaining the basis for this holding and setting a period in which Owner could present a proper amendment, apparently because claims 1, 4 and 6-9 had been presented in the September 22, 2004 paper without any amendment with respect to the appealed version of these claims. Instead, the examiner chose to act on those claims but to not act upon the new claims 10-26 . The examiner simply promulgated another **nonfinal** Office action on January 18, 2005, essentially repeating the position taken in the July 13, 2004 nonfinal Office action while incorporating his objections to the September 22, 2004 amendment.

Petitioner does not raise any procedural issues with respect to how the prosecution has been conducted subsequent to the Board's decision. Petitioner appears to be seeking relief principally out of concern that petitioner may ultimately be unable to file a second reexamination proceeding to continue prosecution in this application, and has attached to the petition a copy of the Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending, dated February 2, 2005, in which a change in the practice governing the filing of a second or subsequent reexamination request on a given patent was announced.

Petitioner does not present any basis upon which the requested relief can be granted. Petitioner is faced with the situation in which claims 1, 4 and 6 were held to be unpatentable by the Board, but the Board chose to promulgate a nonfinal decision in order to permit consideration of their comments regarding claims 7-9 which the Board had held to be patentable over the rejection that was reviewed in the appeal. See pages 9, and 10 of the Board decision and note the reference to 37 CFR 1.196(e) and the mention of "limited proceedings." This type of "limited proceeding" is described in MPEP § 1214.06(III) with respect to the practice under former regulation 37 CFR 1.196(b) in effect on the date of the Board decision. (It appears that the practice in current MPEP § 1214.06(III), would still apply under 37 CFR 41.50; see the comments regarding 37 CFR 41.50 that appear at 69 Fed. Reg. 49965). Pursuant to this practice, "the reexamination proceeding is not considered open to further prosecution except to such matters" that may arise as a result of the reversal.

Applying the practice discussed in MPEP § 1214.06(III) to the facts of this proceeding, it is clear that Owner cannot further prosecute claims 1, 4 and 6 because the Board has affirmed a rejection of those claims. It is also clear that Owner could prosecute newly rejected claims 7-9 by amending these claims in any way desired, or by requesting reconsideration of the rejection and providing argument and/or evidence demonstrating that the rejection was untenable. The September 22, 2004 presentation of seventeen (17) new claims, without amendment to the newly rejected claims, went beyond the bounds of the limited prosecution discussed in MPEP § 1214.06(III).

Note is taken of petitioner's argument with respect to the Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending. However, petitioner had the opportunity to present claims of varying scope during the prosecution of this proceeding prior to final rejection. Petitioner has the opportunity to amend rejected claims 7-9 at this point in the prosecution, or to maintain these claims as currently written and ultimately appeal the rejection if petitioner is of the opinion that the rejection of these claims is untenable. However, this proceeding is at the stage in which it is after final rejection, after appeal, and prosecution is limited in accordance with the decision of the Board. It is not seen that petitioner is entitled to relief from established procedure on an equitable basis so as to be able to present additional new claims in order to resume the prosecution as it stood prior to appeal by presenting an amendment that should have been presented prior to final rejection. The examiner should not be put into the position of having to begin prosecution all over again as though there had been no final rejection and no appeal. To hold that petitioner is entitled to do that would frustrate the intent of the change in

practice established by the above mentioned Notice, which, it should be noted, **limits** but does not abolish the ability of patent owners and third party requesters to file a second or subsequent reexamination proceeding during the pendency of this proceeding.

As petitioner has failed to demonstrate any abuse of discretion or clearly erroneous action on the part of the examiner, the relief requested will not be granted. Petitioner is entitled to file a renewed petition, without fee, provided that the renewed petition is filed within two months of this decision. However, petitioner should note that the filing of a renewed petition will not operate to stay any period for reply that may be running, and will not act to stay these proceedings. The proceeding will be forwarded to the examiner via the Supervisory Patent Examiner of Art Unit 3738 for **immediate** action on the reply filed on March 17, 2005. The examiner should take note of the fact that the version of claim 1 that is currently of record is not presented in accordance with the requirements of 37 CFR 1.530.(d)(2) because much of the language of the claim is underlined to indicate that the language is new with respect to the original text of the patent, while that same language is bracketed to indicate that it is to be deleted from the original text of the patent. Words appearing in the text of the patent that Owner intends to retain in the text of claim 1 must simply be presented without markings, while words that are being inserted before and after those words must be presented with underlining. Only words being entirely deleted from the text of patent claim 1 should appear in brackets. A requirement that Owner must file a housekeeping paper in which Owner either presents the current version of claim 1 in a format that complies with the requirements of 37 CFR 1.530(d)(2), or cancels the claim while re-writing claims 4 and 6 in independent form if it desired to retain claims 4 and 6, **must** be incorporated in the next Office action. The housekeeping paper **must** be a separate paper filed in addition to any paper that presents an amendment directed to claims 7-9.

PETITION DISMISSED.

/Richard A Bachand/

E. R. Kazenske, Director
Technology Center 3700

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MAILED JUN 19 2007

Michael L Goldman, Esq.
Nixon Peabody LLP (For Requester)
Clinton Square P.O. Box 31051
Rochester, NY 14603-1051

In re Cerasiv GMBH, Innovatives :
Keramik-Engineering :
Reexamination Proceeding : DECISION ON PETITION
Control No. 90/005,914 :
Filed: January 25, 2001 :
For: U.S. Patent No. 5,879,397 :

This is a decision on the renewed petition filed on June 3, 2005 under 37 CFR 1.181 by which Owner requests that the amendment filed on September 22, 2004 or April 12, 2005 be entered for examination. The petition has been alternatively filed under 37 CFR 1.182.

The petition under 37 CFR 1.181 is dismissed.

The petition under 37 CFR 1.182 is being forwarded to the Office of Patent Legal Administration for consideration.

Petitioner is referred to the previous petition decision under 37 CFR 1.181 mailed April 7, 2005 regarding the fact situation in this application. Since the last petition decision, petitioner has filed an amendment on April 12, 2005, which overlapped in the mail with the examiner's final office action mailed April 13, 2005.

Petitioner requests that the amendment filed on September 22, 2004 or the amendment filed April 12, 2005 in response to the request for a housekeeping amendment in the April 7, 2005 petition decision be entered.

Pursuant to 37 CFR 1.550(a):

"After issuance of the *ex parte* reexamination order and expiration of the time for submitting any responses, the examination will be conducted in accordance with §§ 1.104 through 1.116...."

Accordingly, the provisions of 37 CFR 1.111 apply to the response by a patent owner in an *ex parte* reexamination proceeding.

Pursuant to 37 CFR 1.111(a)(1)(2):

"Supplemental replies. (i) A reply that is supplemental to a reply that in compliance with Sec. 1.111(b) will not be entered as a matter of right except as provided in paragraph (a)(2)(ii) of this section. The Office may enter a supplemental reply if the supplemental reply is clearly limited to:
(A) Cancellation of a claim(s);
(B) Adoption of the examiner suggestion(s);
(C) Placement of the application in condition for allowance;
(D) Reply to an Office requirement made after the first reply was filed;
(E) Correction of informalities (e.g., typographical errors); or
(F) Simplification of issues for appeal.
(ii) A supplemental reply will be entered if the supplemental reply is filed within the period during which action by the Office is suspended under Sec. 1.103(a) or (c)."

In regard to the entry of the September 22, 2004 amendment, petitioner's renewed petition as considered under 37 CFR 1.181 fails to advance any further arguments or reasons as to why the amendment filed on September 22, 2004 should be further considered. Therefore, the decision of April 7, 2005 is maintained.

In regard to the entry of the April 12, 2005 amendment, a review of the amendment reveals that it is not merely correcting formal matters noted in the April 7, 2005 petition. Claim 1 was not amended to the language as appealed. Claims 7-9 were further amended. Since the amendment is not an amendment clearly correcting only formal matters, the amendment is being treated a supplemental reply pursuant to 37 CFR 1.111(a)(1)(2). In the present instance, the patent owner has not shown how 37 CFR 1.111(a)(1)(2)(i)(A)-(F) are satisfied, nor is such apparent from the record. Accordingly, the supplemental response filed April 12, 2005 has not been entered and considered with regard to deciding this petition. The supplemental response is, however, being retained in the file.

Since the petition under 37 CFR 1.181 is being dismissed, this application is being forwarded to the Office of Patent Legal Administration for consideration of the petition under 37 CFR 1.182.

PETITION UNDER 37 CFR 1.181 DISMISSED.

Any inquires regarding this decision should be directed to Special Program Examiner, Linda Sholl, at 571-272-4391.

Karen M. Young

Karen M. Young, Director
Technology Center 3700

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(For Patent Owner)

MAILED JUL 05 2007

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(For Requester)

In re Cerasiv GMBH, Innovatives Keramik-Engineering
Reexamination Proceeding
Control No. 90/005,914
Filed: January 25, 2001
For: U.S. Patent No. 5,879,397

: DECISION ON PETITION

This is a corrected decision on the renewed petition filed on June 3, 2005 under 37 CFR 1.181 by which Owner requests that the amendment filed on September 22, 2004 or April 12, 2005 be entered for examination. The petition has been alternatively filed under 37 CFR 1.182.

The petition under 37 CFR 1.181 is dismissed.

Petitioner is referred to the previous petition decision under 37 CFR 1.181 mailed April 7, 2005 regarding the fact situation in this application. Since the last petition decision, petitioner has filed an amendment on April 12, 2005, which overlapped in the mail with the examiner's final office action mailed April 13, 2005.

Petitioner requests that the amendment filed on September 22, 2004 or the amendment filed April 12, 2005 in response to the request for a housekeeping amendment in the April 7, 2005 petition decision be entered.

Pursuant to 37 CFR 1.4(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."

Pursuant to 37 CFR 1.550(a):

"After issuance of the *ex parte* reexamination order and expiration of the time for submitting any responses, the examination will be conducted in accordance with §§ 1.104 through 1.116...."

Accordingly, the provisions of 37 CFR 1.111 apply to the response by a patent owner in an *ex parte* reexamination proceeding.

Pursuant to 37 CFR 1.111(a)(1)(2):

"Supplemental replies. (i) A reply that is supplemental to a reply that in compliance with Sec. 1.111(b) will not be entered as a matter of right except as provided in paragraph (a)(2)(ii) of this section. The Office may enter a supplemental reply if the supplemental reply is clearly limited to:
(A) Cancellation of a claim(s);
(B) Adoption of the examiner suggestion(s);
(C) Placement of the application in condition for allowance;
(D) Reply to an Office requirement made after the first reply was filed;
(E) Correction of informalities (e.g., typographical errors); or
(F) Simplification of issues for appeal.
(ii) A supplemental reply will be entered if the supplemental reply is filed within the period during which action by the Office is suspended under Sec. 1.103(a) or (c)."

Since the alternative request under 37 CFR 1.182 is decided by a different section of the USPTO and there is no separate petition to decide, it will not be consider pursuant to 37 CFR 1.4(c). In addition, future petitions must be filed separately or neither petition will be considered.

In regard to the entry of the September 22, 2004 amendment, petitioner's renewed petition as considered under 37 CFR 1.181 fails to advance any further arguments or reasons as to why the amendment filed on September 22, 2004 should be further considered. Therefore, the decision of April 7, 2005 is maintained.

In regard to the entry of the April 12, 2005 amendment, a review of the amendment reveals that it is not merely correcting formal matters noted in the April 7, 2005 petition. Claim 1 was not amended to the language as appealed. Claims 7-9 were further amended. Since the amendment is not an amendment clearly correcting only formal matters, the amendment is being treated a supplemental reply pursuant to 37 CFR 1.111(a)(1)(2). In the present instance, the patent owner has not shown how 37 CFR 1.111(a)(1)(2)(i)(A)-(F) are satisfied, nor is such apparent from the record. Accordingly, the supplemental response filed April 12, 2005 has not been entered and considered with regard to deciding this petition. The supplemental response is, however, being retained in the file.

PETITION UNDER 37 CFR 1.181 DISMISSED.

The application will be forwarded to the examiner for consideration of the Appeal Brief filed August 5, 2005.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS 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 1.181."

Any inquires regarding this decision should be directed to Special Program Examiner, Linda Sholl, at 571-272-4391.

Karen M. Young

Karen M. Young, Director
Technology Center 3700

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APR 09 2004

Director's Office
Group 3700

FISH AND RICHARDSON P C
225 FRANKLIN STREET
BOSTON, MA 02110-2804

Paper No. 17

In re Reexamination Proceeding :
Control No. 90/005,918 :
Patent No. 5,297,574 : DECISION ON
Patentee: James W. Healy : PETITION
Filed: March 29, 1994 :
For: Fuel Dispensing Hose Breakaway Assembly :

DO NOT ENTER

This is a decision on the petition filed June 19, 2003 for resumption of reexamination proceedings, which is being treated as a request for an extension of time based upon failure to receive office action. Accompanying the petition is a response to Notice of Defective Paper in Ex Parte Reexamination.

An office action, a Notice of Defective Paper, which set a one month shortened statutory response period, was mailed on April 5, 2002, and was entered in the file as paper No. 14.

The petition indicates that petitioner did not receive the Notice of Defective Paper mailed on April 5, 2002. Petitioner has made a sufficient showing that the Notice mailed on April 5, 2002 was not received, therefore, the request for an extension of time is for sufficient cause and is granted.

The time to file a response to paper No. 14 is extended to expire on June 19, 2003. The response accompany the petition is considered to timely respond to the Notice and will be entered into the reexam for consideration.

Summary: Petition granted.

/Richard A. Bertsch/

Richard A. Bertsch, 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.
90/005,920	02/01/01	5820955	3510-M015

IM22/0730

GEORGE M. THOMAS ESQUIRE
THOMAS KAYDEN HORSTMEYER AND RISLEY LLP
SUITE 1500 100 GALLERIA PARKWAY N W
ATLANTA GA 30339

EXAMINER	
DYE,R	

ART UNIT	PAPER NUMBER
1742	

DATE MAILED: 07/30/01

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

Commissioner of Patents and Trademarks

90005920 07302001

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
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WAK
Mailed: Paper Number 7

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Atlanta, Georgia 30339 (for Patent Owner)

Michael G. Gilman
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1700 Diagonal Road
Suite 310
Alexander, VA 22314 (for Requestor)

In re Reexamination of
William Brander
Serial No.: 90/005,920
Filed: February 02, 2001
For: U.S. Patent 5,820,955

DECISION ON PETITION

This is a decision on the Petition Under 37 CFR 1.515 (c) filed on May 11, 2001 to request that the portion of the Primary Examiner's decision refusing to order reexamination of the '955 patent on the basis of the prior art subject matter of Dawson, claims 13 and 19, be reviewed and reversed.

DECISION

When a petition is filed, the Group Director will review the examiner's determination that a substantial new question of patentability has not been raised. The director's review will be *de novo*.

A review of the petitioner's request and the application record indicates that the request to review and reverse the examiner's position cannot be granted at this time.

A request for a petition under 35 U.S.C. 1.515 (c) is applicable once a request for reexamination has been denied. The request for reexamination was granted on April 11, 2001. Except for the limited exception described in MPEP 2246, no petition may be filed requesting a review of a decision *granting* a request for reexamination even if the decision grants the request for reasons other than

those advanced by requester or as to claims other than those for which requestor sought reexamination. No right to review exists if reexamination *is ordered* in such a case because all claims will be reexamined in view of all prior art during the reexamination under 37CFR 1.550.

The Primary Examiner did determine that Dawson raised a new question of patentability as to claim 13 under 35 U.S.C. 102(e). The reexamination of claim 19 was granted because in view of the Gujer '401, Greminger Jr. et al. '578, Power '907, Haigh et al. '654 and Sisson '876 references being taken alone or in combination. a substantial new question of patentability was raised.

The petition is **DISMISSED**.

This decision is final and nonappealable. 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

Richard V. Fisher, Director
Technology Center 1700
Chemical and Materials Engineering

U.S. PATENT AND TRADEMARK OFFICE

UNITED STATES PATENT and TRADEMARK OFFICE
UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
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WASHINGTON, D.C. 20231
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SEP 21 2001
GROUP 1100

BRC
Paper no. 16

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(for Requester)

In re Reexamination of
William M. Brander
Reexam Control No. 90/005,684
Filed: March 27, 2000
For: U.S. Pat. No. 5,820,955

DECISION ON MERGING REEXAMINATION PROCEEDINGS

In re Reexamination of
William M. Brander
Reexam Control No. 90/005,920
Filed: February 1, 2001
For: U.S. Pat. No. 5,820,955

DO NOT ENTER

BACKGROUND

1. United States Patent No. 5,820,955 issued on October 13, 1998.

2. A first request for reexamination, Control No. 90/005,684 was filed on March 27, 2000 on behalf of the Patent Owner by George M. Thomas, Esq., Thomas, Kayden, Horstemeyer & Risley, LLP, Suite 1500 100 Galleria Parkway N W, Atlanta, GA 30339.

3. Reexamination was ordered for 90/005,684 on June 21, 2000.

4. The Patent Owner filed a Statement in 90/005,684 on August 17, 2000.

5. A first Office Action was mailed November 6, 2000 and contained the following rejections:

(a) a rejection over claims 8, 9 and 14-21 under 35 U.S.C. 102(b) as being anticipated by Caggiano;

(b) a rejection over claims 7 and 10-13 under 35 U.S.C. 103 as being obvious over Caggiano;

(c) a rejection over claims 1-4 under 35 U.S.C. 103 as being obvious over Caggiano in view of Genske et al;

(d) a rejection over claims 7, 23 and 24 under 35 U.S.C. 103 as being obvious over Caggiano in view of Richman et al;

(e) a rejection over claims 1, 8, 9, 14-19 and 22 under 35 U.S.C. 102(b) as being anticipated by Kannankeril;

(f) a rejection over claims 7, 20 and 21 under 35 U.S.C. 103 as being obvious over Kannankeril;

(g) a rejection over claims 1, 3, 4, 8, 9 and 14-22 under 35 U.S.C. 102(b) as being anticipated by Beaver, Jr. et al;

(h) a rejection over claims 6 and 7 under 35 U.S.C. 103 as being obvious over Beaver, Jr. et al; and

(i) a rejection over claims 23 and 24 under 35 U.S.C. 103 as being obvious over Beaver, Jr. et al in view of Richman et al.

The patentability of claim 5 was confirmed.

6. The Patent Owner filed a timely Response on December 6, 2000.

7. A second Office Action was mailed on February 6, 2001 and contained the following rejections:

(a) a rejection over claims 9 and 59-64 under 35 U.S.C 305(a) as enlarging the scope of the claims of the patent being reexamined;

(b) a rejection over claims 9 and 59-64 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification;

(c) a rejection over claims 14-21, 74 and 76 under 35 U.S.C. 102(b) as being anticipated by Caggiano;

(d) a rejection over claims 6, 7, 41, 43, 44, 50, 52 and 53 under 35 U.S.C. 103 as being obvious over Caggiano;

(e) a rejection over claims 1, 3, 4, 25 and 27 under 35 U.S.C. 103 as being obvious over Caggiano in view of Genske et al;

(f) a rejection over claims 10-13, 65 and 67 under 35 U.S.C. 103 as being obvious over Caggiano in view of Gujer;

(g) a rejection over claim 2 under 35 U.S.C. 103 as being obvious over Caggiano in view of Genske et al and in further view of Gujer;

(h) a rejection over claims 7, 23, 24, 50, 52 and 53 under 35 U.S.C. 103 as being obvious over Caggiano in view of Richman et al;

(i) a rejection over claims 1, 14-19, 22, 25, 27, 74 and 76 under 35 U.S.C. 102(b) as being anticipated by Kannankeril;

(j) a rejection over claims 6, 7, 20, 21, 41, 43, 44, 50, 52 and 53 under 35 U.S.C. 103 as being obvious over Kannankeril;

(k) a rejection over claims 7, 23, 24, 50, 52 and 53 under 35 U.S.C. 103 as being obvious over Kannankeril in view of Richman;

(l) a rejection over claims 2, 7, 10, 23, 24, 50, 52, 53, 65 and 67 under 35 U.S.C. 103 as being obvious over Kannankeril in view of Richman and Gujer;

(m) a rejection over claims 1, 4, 14-22, 25, 27, 74 and 76 under 35 U.S.C. 102(b) as being anticipated by Beaver, Jr. et al;

(n) a rejection over claims 6, 7, 41, 43, 44, 50, 52 and 53 under 35 U.S.C. 103 as being obvious over Beaver, Jr. et al;

(o) a rejection over claims 7, 23, 24, 50, 52 and 53 under 35 U.S.C. 103 as being obvious over Beaver, Jr. et al in view of Richman et al;

(p) a rejection over claims 1, 9, 14-19, 21, 22, 25-27, 59-62, 64 and 74-76 under 35 U.S.C. 102(e) as being anticipated by Yeager;

(q) a rejection over claims 3, 4, 6, 7, 28-31, 42-58, 63 and 77-82 under 35 U.S.C. 103 as being obvious over Yeager; and

(r) a rejection over claims 2, 7, 10, 23, 24, 50-58 and 65-73 under 35 U.S.C. 103 as being obvious over Yeager in view of Richman and Gujer.

The patentability of claim 5 was confirmed and added claims 32-40 were allowed.

8. The Patent Owner filed a timely Reponse on March 9, 2001, with a Mailing Certificate of March 6, 2001. Additionally, the Patent Owner filed a Supplemental Respone on April 24, 2001 to reflect a summary of the Interview conducted with the Examiner on April 24, 2001.

9. A second request for reexamination, Control No. 90/005,920, was filed on February 1, 2001 on behalf of a third party requester by Michael G. Gilman, Lowe, Hauptman, Gilman & Berner, LLP, 1700 Diagonal Road Suite 310, Alexandria, VA 22314.

10. Reexamination was ordered for 90/005,920 on April 11, 2001. No Patent Owner's Statement was filed under 37 CFR 1.530. See MPEP 2249.

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 both of the above noted reexamination proceedings. Accordingly, merger of the proceedings under 37 C.F.R 1.565(c) is appropriate. The MPEP 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 90/005,684 and 90/005,920 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. The Patent Owner is given one (1) month from the date of this decision to provide a "housekeeping amendment" to make the claims the same in each file. See MPEP 2283, under "Merger of Reexaminations".

III. CONDUCT OF MERGED PROCEEDING

An Office Action will be issued in due course (after entry of the "housekeeping amendment") which applies to both Reexamination nos. 90/005,684 and 90/005,920. The Order Granting the Reexamination Request in 90/005,920 includes a finding of a substantial new question of patentability with Kannankeril (US '010), Caggiano (US '632), Gujer (US '401), Beaver (US '429), Greminger, Jr. et al (US '578), Power (US '907), Haigh et al (US '654) and Sisson (US '876) taken either alone or in combination.

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 single response, filed in triplicate, each bearing an original signature, for each 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.

Further, since MPEP 2240 states:

> "...If the requester includes in the second or subsequent request prior art which raised a substantial new question in the pending reexamination, reexamination would 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, upon petition by the patent owner under 37 CFR 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..."

Because the earlier reexamination proceeding has already considered the prior art (Kannankeril, Caggiano, Gujer, Beaver and Greminger, Jr. et al) upon which the 90/005,684 reexamination proceeding was granted, the requester is reminded that care should be taken in any subsequently filed reexamination to ensure that a substantial new question is raised by prior art not already of record in order to avoid denial of the reexamination pursuant to MPEP 2240.

CONCLUSION

Reexamination Control Nos. 90/005,684 and 90/005,920 are merged. The Patent Owner is given one (1) month from the date of this decision to provide a "housekeeping amendment" to make the claims the same in each file.

Richard V. Fisher

Richard V. Fisher, Director
Technology Center 1700
Chemical and Materials Engineering

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
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Paper No. 25

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MAILED

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REEXAM UNIT

In re Brander
Reexamination Proceeding
Control No. 90/005,684
Filed: March 27, 2000
For: U.S. Patent No. 5,820,955

In re Brander
Reexamination Proceeding
Control No. 90/005,920
Filed: February 1, 2001
For: U.S. Patent No. 5,820,955

DECISION DISMISSING PETITION

This is a decision on the October 29, 2002, patent owner petition for entry of belated papers filed under 37 C.F.R. § 1.137(b), based upon unintentional delay in this merged reexamination proceeding. The petition is before the Office of Patent Legal Administration for decision.

The petition fee of $640.00 pursuant to 37 C.F.R. § 1.17(m) for the petition under 37 C.F.R. § 1.137(b) in the merged proceeding

has been charged to deposit account no. 20-0778, as per petitioner's instructions in the supplement to the petition filed November 19, 2002, correcting page 2 of the present petition to authorize that such fee be charged to the above deposit account.

The petition for revival under 37 C.F.R. § 1.137(b) based upon unintentional delay 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)."

UNDELIVERABLE

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 petition fee, as well as a statement, as set forth in items (2) and (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.

The instant petition lack(s) item (1) above. Although a response to the outstanding non-final Office action was filed on April 5, 2002, and another response was filed on September 24, 2002, and a third response was filed with the present petition on October 29, 2002, none of these papers constitute "the required reply" pursuant to 37 C.F.R. § 1.137(b)(1). Specifically, the amendment of April 5, 2002, is improper for reasons of record in the Office communication mailed August 15,2002. Similarly, the amendments of September 24, 2002, and October 29, 2002, are **not** in compliance with 37 CFR § 1.530, as there is no explanation of the support in the original disclosure of the patent for the changes to the claims made by the amendments, as required by 37 CFR § 1.530(e). Also, in the amendment paper of September 24, 2002, the amendment is **not** in compliance with 37 C.F.R. § 1.530(d)(2), as some of the changes are not correctly presented with changes in bracketing and underlining with regard to the original patent text. Specifically, in claim 1, line 9 apparently "and" has been deleted and therefore it should be presented after the semicolon in brackets as -[and]-. Similarly, in claim 6, line 8 the comma should be underlined and in line 9 the semicolon should not be underlined. In claim 7, line 4 "impervious" should be presented as -[imperious] <u>impervious</u>-, as the "v" was missing from the original patent text. Claim 8 is presented as amended, whereas instructions were provided in the amendment of December 6, 2000, that claim 8 is cancelled. Note that in claim 8, line 6 after "liquid", if it is patent owner's intent to cancel "impervious and said second ply is liquid", then such text should appear in brackets. Similarly, in claim 9, line 9 "structural" should be presented as -[structure] <u>structural</u>-. Further, the amendment of October 29, 2002, is also **not** in compliance with 37 C.F.R. § 1.530(d)(2), as some of the changes are not correctly presented with changes in bracketing and underlining with regard to the original patent text. Specifically, in claim 7, line 4 "impervious" should be presented as -[imperious] <u>impervious</u>-, as the "v" was missing from the original patent text. Similarly, in claim 9, line 9 "structural" should be presented as -[structure] <u>structural</u>-.

In view of the above, the petition for the entry of late papers is **<u>not</u>** sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

The petition is **<u>dismissed</u>**.

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. The reexamination file will be stored in the Central Reexam Unit (CRU) for one month to await any such renewed petition. If no such renewed petition is timely received, the reexamination file will be forwarded to Technology Center 1700 for termination of the proceeding, and issuance of the Notice of Intent to Issue Reexamination Certificate (NIRC).

4. 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

5. Telephone inquiries with regard to this decision should be directed to the undersigned at (703) 308-0255.

Lynn M. Kryza

Lynn M. Kryza
Patent Special Projects Advisor
Office of Patent Legal Administration

November 25, 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 28

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MAILED

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REEXAM UNIT

In re Brander
Reexamination Proceeding
Control No. 90/005,684
Filed: March 27, 2000
For: U.S. Patent No. 5,820,955

In re Brander
Reexamination Proceeding
Control No. 90/005,920
Filed: February 1, 2001
For: U.S. Patent No. 5,820,955

DECISION GRANTING PETITION

This is a decision on the December 19, 2002, patent owner renewed 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 $640.00 pursuant to 37 C.F.R. § 1.17(m) for the petition under 37 C.F.R. § 1.137(b) in the merged proceeding was paid with the previous petition of October 29, 2002.

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 previous petition was accompanied by the petition fee, as well as a statement, as set forth in items (2) and (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 previous petition varies from the language required by 37 C.F.R. § 1.137(b)(3); however, the statement contained in the previous 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 outstanding nonfinal Office action of February 28, 2002, has been received. However, the amendment of December 19, 2002, is still **not** in compliance with 37 C.F.R. § 1.530(d)(2), as some of the changes are not correctly presented with changes in bracketing and underlining with regard to the original patent text. Specifically, in claim 1, line 10, the comma should be a semi-colon. In claim 7, line 4 "[imperious] impervious" should be presented as -[imperious] <u>impervious</u>-, note in the instant amendment, impervious is <u>not</u> underlined. In claim 10, line 18 the semi-colon should be underlined. Also, in claim 14, line 12 the semi-colon should be underlined.

However, as a courtesy to patent owner, given the numerous attempts to provide a proper amendment in response to the Office action of February 29, 2002, these changes will be made in red ink (initialed and dated) on the amendment papers of December 19, 2002, so that this petition can be granted and prosecution of this merged reexamination proceeding resumed.

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 3600 for consideration of the response to the final Office action of December 19, 2002.

3. Further inquiries with regard to this reexamination proceeding should be directed to the examiner, Rena Dye, of Group Art Unit 3627.

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

January 31, 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

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Reexamination Control No's. 90/005,684 and 90/005,920

FOR PATENT OWNER:

George M. Thomas
Thomas, Kayden, Horstmeyer and Risley LLP
100 Galleria Parkway N.W., Suite 1750
Atlanta, GA 30339-5948

FOR REQUESTER:

Michael G. Gilman
Lowe, Hauptman, Gilman & Berner LLP
1700 Diagonal Road, Suite 310
Alexandria, VA 22314

DECISION ON PETITION FOR THE ACCEPTANCE OF LATE PAPERS

MAILED

MAY 25 2004

REEXAM UNIT

This is in reply to petitioner's communication filed December 18, 2003 and supplemented on February 10, 2004 that will be treated as a Petition To Accept Late Filed Papers. There is no fee required for this petition. A Petition for Extension of Time Under 37 CFR 1.550 filed January 8, 2004 will also be treated in this decision.

The petition to accept late paper is **GRANTED**.
The petition for extension of time is **DISMISSED as Moot**.

A review of the above reexamination file indicates that a Final Rejection was mailed May 13, 2003. The after-final amendment and the Notice of Appeal with a Certificate of Mailing date of November 10, 2003 submitted by the patent owner in response to the final rejection was apparently never received by the Office. The patent owner has submitted a copy of the after-final amendment and the Notice of Appeal bearing the above-noted Certificate of Mailing dates. In addition, the patent owner has submitted, by facsimile transmission, on February 4, 2004 a statement by Mary N. Kilgore 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 and Notice of Appeal.

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. The Appeal Brief is due 2 months from the date of this decision.

As to the petition for extension of time filed January 8, 2004, in view of the 2 month time period to file the Appeal Brief from the date of this decision, the one month extension requested by the Patent Owner is seen as being moot and the petition is dismissed on that basis.

Steven N. Meyers
Special Programs Examiner,
Technology Center 3600
(703) 308-1020

snm: 2/8/04

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April 30, 2001

Paper No. 5

Gregory F. Wirzbicki
Union Oil Company of California
P.O. Box 7600
Brea, CA 92822-7600

(For Patent Owner)

Enclosure: Paper filed March 28, 2001

Robert L. Price
McDermott, Will & Emery
600 13th Street, N.W.
Washington, D.C. 20005-3096

(For Third Party Requester)

In re Jessup et al.
Reexamination Proceeding
Control No. 90/005,924
Filed: February 6, 2001
For: U.S. Patent No. 5,837,126

: DECISION DISMISSING
: PETITION AND RETURNING
: IMPROPER PAPER

This is a decision on the March 28, 2001, petition filed under 37 CFR 1.182 & 1.183 by the patent owner requesting the Commissioner to waive the provisions of 37 CFR 1.530 and permit entry and consideration of the instant petition prior to the initial determination on the request for reexamination. The petition is before the Office of Patent Legal Administration.

For the reasons set forth below, the petition is dismissed.

Patent owner argues that the petition is timely because the petition is not directed to the patentability issues raised in the request, but rather is an *ultra vires* challenge to the reexamination request as being in conflict with, and prohibited by, both *In re Portola Packaging, Inc.*, 42 USPQ2nd 1295 (Fed. Cir. 1997) and the USPTO Guidelines based thereon (64 Fed. Reg. 15346). Patent owner argues (1) that the request is not a valid request because it is intended purely for harassment of the patent owner; and (2) that because of manifestly misleading statements by requester as to the consideration given by the examiner in the prosecution of the '126 patent as to 10 of the 15 references relied upon by the requester, there is a danger that the examiner will order reexamination based upon one or more of the ten references. Patent owner requests that the reexamination be denied as predicated upon a critical misleading statement, or at a minimum that the examiner be informed of the arguments contained in the instant petition.

37 CFR 1.530(a) provides:

> 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 of other response is filed by the patent owner, it will not be acknowledged or considered in making the determination.

The petition filed by the patent owner is improper (and premature) under § 1.530(a) because it was filed prior to the issuance of a determination under § 1.515. Accordingly, the paper 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.

As to petitioner's request to waive the rules pursuant to § 1.183 in order to permit the patent owner to file a paper prior to the determination, an extraordinary situation which warrants a waiver of § 1.530(a) has not been established in the petition. A specific intent of § 1.530(a) is, *inter alia*, to facilitate a rapid determination of whether reexamination should proceed. Permitting comment by the patent owner at this stage of the proceeding (and rebuttal by the requester if so requested) would significantly delay the initial determination, which the statute requires to be made within three months of the filing of the request for reexamination. The three-month statutory time limit cannot be waived. It is to be noted that the statute was drafted to essentially provide patent owner the type of relief requested in the present petition before any patentability decision is made as to the prior art which is held (in the determination on the request) to raise a substantial new question of patentability. In this regard, should the examiner order reexamination, the statute provides the patent owner an opportunity to file a statement on the examiner's determination, and provides the reexamination requester an opportunity to file a reply to any such statement that is filed by the patent owner. Thus, prior to any patentability determination, the patent owner would have the opportunity to contest the examiner's finding as to whether or not the prior art is appropriate under *In re Portola Packaging, Inc.*, *supra*. Accordingly, absent a showing that a request for reexamination is improper on its face, (e.g., a request based on "on sale" or "public use" issues), it would be inappropriate to waive the rules and permit the patent owner to file arguments opposing issues raised in the request for reexamination prior to the determination on the request.

Additionally, the issue as to whether the ten references were previously considered in the prosecution of the patent application and thus are not available as prior art in the reexamination under *In re Portola Packaging, Inc.*, *supra*, has been raised in the reexamination request, and will be decided by the examiner. Patent owner has not shown that the examiner will not be able to make the appropriate decision upon a review of the entire record. The examiner will make his own independent inspection of the entirety of the record, and will consider the issue based upon that inspection and the USPTO's *Portola* guidelines. It cannot be assumed that the examiner will be "misled" by the requester's arguments, and thus needs the benefit of the arguments of patent owner in order to make a correct determination.

For all of the reasons set forth above, the petition to waive 37 CFR 1.530(a) and permit entry and consideration of the petition prior to the determination under 37 CFR 1.515 is dismissed, and is being returned herewith.

The reexamination file is being returned to the examiner for a determination under 37 CFR 1.515 on the request for reexamination.

Control No. 90/005,924

Telephone inquiries related to this decision should be directed to Gerald A. Dost, Senior Legal Advisor, at 703-305-8610.

Gerald A. Dost
Senior Legal Advisor
Office of Patent Legal Administration

C:\zJerry\90_5924 pat owner paper prior order 2.wpd

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Mailed: 24 JAN 2002 CST

Paper No. 8

Gregory F. Wirzbicki
Union Oil Company of California
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In re Jessup et al
Reexamination Proceeding
Control No. 90/005,924
Filed: February 6, 2001
For: U.S. Patent 5,837,126 : DECISION GRANTING PETITION UNDER 37 CFR § 1.515(c) and § 1.181 AND ORDERING REEXAMINATION

This is a decision on the PETITION UNDER 37 CFR § 1.515(c) AND § 1.181, filed June 1, 2001. Petitioner requests that that the examiner's decision denying the request for reexamination of U.S. Patent 5,837,126 be reversed. For the reasons set forth below, the petition is granted and reexamination is ordered. Patent owner is given two months to file an optional statement under 37 CFR 1.530.

Background

1. On February 6, 2001, a third party REEXAMINATION REQUEST UNDER 37 C.F.R. 1.510 was filed by Robert L. Price of McDermott, Will & Emery. The request cites 15 prior printed publications as raising a substantial new question of patentability with regard to claims 1-66 of U.S. Patent 5,837,126.

2. On May 2, 2001, the examiner denied the request for reexamination on the grounds that reexamination based on References 1-6, 8 and 11 was precluded in view of *In re Portola Packaging Inc.*, 110 F.3d 786, 42 USPQ2d 1295 (Fed Cir. 1997). The examiner considered each reference provided by the requester, and determined that References 1-6, 8 and 11 had been the basis of a rejection, or had been discussed with sufficient specificity, such that further reliance on these references was precluded by *In re Portola Packaging Inc.* See the Order Denying Request for Reexamination (Order), paragraphs **8-22**. Furthermore, the examiner analyzed References 7, 9, 10 and 12-15 and concluded that these references do not raise a substantial new question of patentability. See the Order, paragraphs **23-38**.

3. On June 1, 2001, the present petition was filed. The requester petitions for reversal of the Order Denying Request for Reexamination on the grounds that: (1) the examiner failed to properly follow the Guidelines for Reexamination Practice (64 Fed. Reg 15346); (2) the examiner misinterpreted the expressions "previous examination of the patent" and "prior related proceedings"; and (3) this case presents unusual facts that warrant reexamination.

Decision

A petition filed under 37 CFR § 1.515(c), requesting that the examiner's decision denying the request for reexamination be reversed, is decided by the TC Director. The Manual of Patent Examining Procedure 2248 further states that the TC Director's review will be *de novo.*

The requester petitions for reversal of the Order Denying Request for Reexamination on the grounds that: (1) the examiner failed to properly follow the Guidelines for Reexamination Practice (64 Fed. Reg. 15346); (2) the examiner misinterpreted the expressions "previous examination of the patent" and "prior related proceedings"; and (3) this case presents unusual facts that warrant reexamination.

The examiner's decision to deny the request for reexamination has been reviewed for compliance with all applicable statutes, regulations and case law. A review of the entire record shows that the examiner clearly complied with the relevant portions of the Guidelines for Reexamination Practice which require the examiner to:

(A) Read the reexamination request to identify the prior art on which the request is based;

(B) Conduct any necessary search of the prior art relevant to the subject matter of the patent for which reexamination was requested;

(C) Read the prosecution histories of all prior related PTO proceedings;

(D) Determine if the prior art in the reexamination request and the prior art found in any search was: (1) relied upon to reject any claim in a prior related proceeding; or (2) cited and its relevance to patentability of any claim discussed in a prior related PTO proceeding;

(E) Deny the reexamination request if the decision to order reexamination would be based only on prior art that was, in a prior related PTO proceeding, (1) relied upon to reject any claim, and/or (2) cited and its relevance to patentability of any claim discussed.

The Guidelines for Reexamination Practice (64 Fed. Reg. 15346, as well as MPEP 2242) set forth the criteria and procedures for the examiner to follow in deciding if a substantial new question of patentability is raised. The guidelines set forth in MPEP 2242, "SUBSTANTIAL NEW QUESTION OF PATENTABILITY," clearly state:

If the prior art patents or printed publications raise a substantial question of patentability of at least one claim of the patent, then a substantial new question of patentability is present, unless the same question of patentability has already been decided by (1) a final holding of invalidity by a Federal Court, or (2) by the Office in a previous examination of the patent. A "previous examination of the patent" is (1) the original examination of the application which matured into the patent; (2) the examination in a reissue application that has resulted in a reissue of the patent; or (3) an earlier concluded reexamination.

Furthermore, MPEP 2242 A. 3. describes the procedure that PTO personnel must follow when determining whether reexamination may be ordered. This procedure includes, *inter alia*, the following steps:

(C) Read the prosecution histories of all prior related PTO proceedings.

(D) Determine if the prior art in the reexamination request and the prior art found in any search was: (1) relied upon to reject any claim in a prior related proceeding; or (2) cited and its relevance to patentability of any claim discussed in a prior related PTO proceeding.

The requester urges that the examiner failed to properly follow the Guidelines for Reexamination Practice, because the examiner relied upon the prosecution histories of the parent applications of Application No. 08/904,594, which matured to U.S. Patent No.

5,837,126, rather than considering solely the prosecution history of Application No. 08/904,594.

The Guidelines for Reexamination Practice set forth in MPEP 2242 A. 2. state that the prior related PTO proceedings include "the original examination of the application which matured into the patent" that is being reexamined. Consideration of examination practice demonstrates that the phrase "original examination of the application which matured into the patent" includes any parent application of the application which matured into the patent. MPEP 609, MINIMUM REQUIREMENTS FOR AN INFORMATION DISCLOSURE STATEMENT, specifically states:

> Likewise, the examiner **will consider** information which has been considered by the Office in a parent application when examining (A) a continuation application filed under 37 CFR 1.53(b) or filed under former 37 CFR 1.60, (B) a divisional application filed under 37 CFR 1.53(b) or filed under former 37 CFR 1.60, or (C) a continuation-in-part application (see MPEP § 201.06(b)) filed under 37 CFR 1.53(b), and a list of the information need not be submitted in the continuation, divisional, or continuation-in-part application unless applicant desires the information to be printed on the patent. [emphasis added]

Similarly, MPEP 707.05 also stresses that the examiner should review all parent applications when examining an application:

> In all continuation and continuation-in-part applications, the parent applications should be reviewed for pertinent prior art.

Thus, during prosecution of an application, the examiner looks to any parent applications of the application being examined, as directed by MPEP 609 and 707.05. Likewise, in a reexamination proceeding, the examiner looks to any parent applications of that application which matured into the patent that is being reexamined, in addition to reviewing that application which matured into the patent that is being reexamined.

Accordingly, the terms "previous examination of the patent" and "prior related PTO proceedings" have been interpreted to include not only the application which matured into the patent that is being reexamined, but to include the parent applications of this application. See *Jonsson v. Stanley Works*, 903 F.2d 812, 817, 14 USPQ2d 1863, 1868 (Fed. Cir. 1990) ("[t]he entire record of proceedings in the Patent and Trademark Office, including representations made to the Examiner that the invention is patentable, are included in the patent's prosecution history")(emphasis added). The requester's objection that the *Jonsson* case is drawn to the interpretation of claims for infringement, rather than reexamination, is not persuasive. There is no rational basis for distinguishing prosecution history for claim interpretation from prosecution history for determinations of the availability of prior art for reexamination proceedings. In both instances, the issue is, what prior art and discussions were before the examiner that would have influenced his or her decisions that led to the determination of patentability.

Thus, the examiner was correct in relying upon discussions of the prior art made in the parent applications of Application 08/904,594, in denying the request for reexamination.

The requester further urges that because of unusual fact patterns in the present reexamination, the request for reexamination should be granted. Specifically, the requester notes that the 08/077,243 parent application was directed to a method for reducing the amount of pollutants emitted in the exhaust gases from an automotive engine having associated therewith a catalytic converter. The requester argues that the discussions of the prior art in the 08/077,243 parent application focused on the differences between the claimed method and the cited references. The requester further notes that the gasoline recited in the method claims of the 08/077,243 application (at the time that References 1, 3, 4, and 5 were discussed with the IDS No. 3) was actually narrower in scope than the gasoline composition recited in the claims which issued in the '126 patent.

These arguments are not persuasive because during the prosecution of Application No. 08/904,594, the examiner would have reviewed and considered all of the prior art which was cited in any of the parent applications, in compliance with MPEP 609, as discussed above.

The gasoline recited in the method claims at the time of filing IDS No. 3 in the 08/077,243 parent application (the amendment of April 28, 1994) is narrower than the gasoline which is recited in the claims of the '126 patent. However, the gasoline recited in the preliminary amendment in the 08/077,243 application (the amendment of June 14, 1993) is broader than the gasoline recited in the claims of the '126 patent (see claim 83, gasolines (5) and (6), of the amendment of June 14, 1993). Thus, applicants presented narrower claims in the amendment of April 28, 1994, to distinguish their invention from the prior art provided in IDS No. 3 (see page 14 of the amendment of April 28, 1994). Furthermore, method claims that were filed in File Wrapper Continuation Application No. 08/409,074, recite a gasoline that is broader than the gasoline set forth in the claims of the '126 patent. See claim 271 of the amendment of November 6, 1995; Application No. 08/409,074 is the File Wrapper Continuation of 08/077,243. Thus, the examiner would have considered a gasoline composition, during prosecution of the parent applications of Application 08/904,594, that was actually broader than that recited in the '126 patent. The Federal Circuit addressed this circumstance in *Portola Packaging*: "when the original examiner examined the original claims in light of the cited prior art, the subject matter of the **narrower**, amended claims, **was necessarily** considered in relation to the cited prior art." 110 F.3d at 791, 42 USPQ2d at 1300 (emphasis added). Furthermore, the Federal Circuit held that "reexamination was only intended for those instances in which the examiner did not have all of the relevant prior art at his disposal when he originally considered that patentability of an invention," *Id.* Here, the examiner had References 1, 3, 4, and 5 at her disposal when originally considering patentability of the invention. Accordingly, under *Portola Packaging*, those references cannot be the sole basis of a reexamination.

The requester further notes that select information from References 1, 2, 3, 4, and 5 was provided during the prosecution of the parent applications of the '126 patent. For example, the requester indicates that although Reference 1 was discussed in Application No. 08/077,243, the discussion of Reference 1 focused on Fuel A, which was closer to the claims of the 08/077,243 application. The requester also asserts that Fuel C of this Reference is actually more pertinent to the claims of the '126 patent. In Application No. 08/077,243, the examiner's attention was directed to both Fuel A and Fuel C. See the Order, paragraph **10**. Hence, Fuel C has already been considered, and is barred under *Portola Packaging*.

Moreover, the Guidelines for Reexamination Practice, set forth in MPEP 2242 A. 5. state that:

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

Accordingly, as the requester has merely provided a new interpretation of References 1, 2, 3, 4, and 5, and as these references were previously considered by the examiner in a prior related PTO proceeding, reexamination based on References 1, 2, 3, 4, and 5 is precluded by *In re Portola Packaging Inc.*

Based upon a *de novo* review of the request for reexamination, it is determined that a substantial new question of patentability affecting claims 1-4, 7-11, 13-28, 30-36 and 38 of United States patent 5,837,126 to Jessup is raised for the reasons set forth below. Accordingly, the request for reexamination is granted.

First Substantial New Question of Patentability

Consideration of Coordinating Research Council ("CRC") Report No. 510 entitled "1978 Fuel Rating Program: Road Octane Performance in 1978 Model Cars" in view of U.S. Patent 2,818,417 to Brown et al. raises a substantial new question of patentability as to claims 2, 4, 8(2), 8(4), 9(2), 9(4), 10(2), 10(4), 11(2), 11(4), 13(2), 14(4), 15(4), 16(4), 17(4), 18(4) and 19(4).

CRC Report No. 510 was discussed during the prosecution of U.S. patent 5,837,126 or related patent applications. Fuel 5 of CRC No. 510 has the following disclosed properties: RVP = 6.7 psi; T10 = 137°F; T50 = 213°F; T90 = 302°F; lead = 0.006g/gal; volume % olefins = 3.8 %; volume % paraffins = 82%; volume % aromatics = 14.2% and octane = 86.7. Fuel 5 meets all of the limitations of claims 2, 4, 8(2), 8(4), 9(2), 9(4), 10(2), 10(4), 11(2), 11(4), 13(2), 14(4), 15(4), 16(4), 17(4), 18(4) and 19(4) except for the claimed octane value of $\geq$ 87.

U.S. Patent 2,818,417 to Brown et al. was not considered by the PTO during prosecution of the 5,837,126 patent or related patent applications. Brown et al. teach hydrocarbon cyclomatic manganese tricarbonyl compounds, as well as lubricating oils, antiknock fluids,

and hydrocarbon fuels containing these compounds in small amounts sufficient to improve the engine operating characteristics, antiknock properties, and combustion characteristics of said fuels, oils and fluids (column 2, lines 15-22). When added to hydrocarbon fuels, the compounds act as antiknock agents enhancing the octane quality both of clear fuels and fuels containing other additives including other antiknock additives such as tetraethyllead (column 2, lines 62-66).

The teachings of CRC No. 510 in view of Brown et al. were not considered during the prosecution of the application that became U.S. patent 5,837,126. There is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not claims 2, 4, 8(2), 8(4), 9(2), 9(4), 10(2), 10(4), 11(2), 11(4), 13(2), 14(4), 15(4), 16(4), 17(4), 18(4) and 19(4) are patentable. Accordingly, CRC No. 510 in view of Brown et al. raises a substantial new question of patentability as to claims 2, 4, 8(2), 8(4), 9(2), 9(4), 10(2), 10(4), 11(2), 11(4), 13(2), 14(4), 15(4), 16(4), 17(4), 18(4) and 19(4) which question has not been decided in a previous examination of U.S. patent 5,837,126. See *In re Hiniker Co.*, 150 F.3d 1362, 1367, 47 USPQ2d 1523, 1527 (Fed. Cir. 1998). In *Hiniker Co.*, the court held that the reexamination proceeding was supported by a substantial new question of patentability where the rejection before the court was based on a combination of art that had been before the examiner during original prosecution, and art newly cited during the reexamination proceeding.

Second Substantial New Question of Patentability

Consideration of Coordinating Research Council ("CRC") Report No. 493 entitled "1976 Octane Number Requirement Survey" in view of the 1984 ANNUAL BOOK of ASTM STANDARDS raises a substantial new question of patentability as to claims 7, 9(7), 13(7), 20(7), 21(7), 22(7) and 38(7).

CRC Report No. 493 was discussed during the prosecution of U.S. patent 5,837,126 or related patent applications. Fuel 288 of CRC No. 493 has the following disclosed properties: RVP = 7.2; T10 = 139°F; T50 = 197°F; T90 = 311°F; lead = .005 gm/gal; volume % olefins = 0%; volume % paraffins = 53%; volume % aromatics = 47% and octane = 96.2. Fuel 288 meets all the limitations of claims 7, 9(7), 13(7), 20(7), 21(7), 22(7) and 38(7) except for the claimed RVP of <7.0.

The 1984 ANNUAL BOOK of ASTM STANDARDS (hereafter "ASTM STANDARDS") was not considered by the PTO during prosecution of U.S. patent 5,837,126 or related patent applications. ASTM STANDARDS, pages 176-181, sets forth the test method for determination of vapor pressure of gasoline. Page 180 of the ASTM STANDARDS sets forth the following:

17. Precision

17.1 The following criteria should be used for judging the acceptability of results (95 % confidence):

17.1.1 Repeatability—The difference between successive test results obtained by the same operator with the same apparatus under constant operating conditions on identical test material, in the long run, in the normal and correction operation of the test method, exceed the following value only in 1 case in 20.

Gage Range	psi	(kPa)
0 to 15 psi (0 to 100 kPa)	0.25	(1.7)
0 to 30 or 4 psi (0 to 200 or 300 kPa)	0.5	(3.4)

17.1.2 Reproducibility—The difference between two, single and independent results, obtained by different operators working in different laboratories on identical test material would, in the long run, in the normal and correct operation of the test method, exceed the following value only in 1 case in 20.

Gage Range	psi	(kPa)
0 to 15 psi (0 to 100 kPa)	0.55	(3.8)
0 to 30 or 4 psi (0 to 200 or 300 kPa)	0.8	(5.5)

A review of the ASTM STANDARDS shows that the vapor pressure of gasoline may vary as much as 0.55 psi within a gage range of 1 to 15 psi. Thus, one measurement of the gasoline vapor pressure may be 7.0 psi, while a different operator working in a different laboratory measuring the vapor pressure of an identical material could measure the vapor pressure as either higher or lower than 7.0 psi.

The teachings of CRC No. 493 in view of ASTM STANDARDS were not considered during the prosecution of the application that became U.S. patent 5,837,126. There is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not claims 7, 9(7), 13(7), 20(7), 21(7), 22(7) and 38(7) are patentable. Accordingly, CRC No. 493 in view of ASTM STANDARDS raises a substantial new question of patentability as to claims 7, 9(7), 13(7), 20(7), 21(7), 22(7) and 38(7) which question has not been decided in a previous examination of U.S. patent 5,837,126. See *In re Hiniker Co.*, 150 F.3d 1362, 1367, 47 USPQ2d 1523, 1527 (Fed. Cir. 1998).

Third Substantial New Question of Patentability

Consideration of Coordinating Research Council ("CRC") Report No. 494 entitled "1975 CRC Fuel Rating Program: Road Octane Performance in 1975 Model Cars" in view of the admission in Information Disclosure Statement ("IDS") No. 12 filed December 16, 1992, raises a substantial new question of patentability as to claims 1, 3, 4, 8(1), 8(3), 8(4), 9(1), 9(3), 9(4), 10(1), 10(3), 10(4), 11(1), 11(3), 11(4), 13(1), 13(3), 14(1), 14(3), 14(4), 15(1), 15(3), 15(4), 16(1), 16(3), 16(4), 17(1), 17(3), 17(4), 18(1), 18(3), 18(4), 19(1), 19(3), 19(4), 20(3), 20(4), 21(3), 21(4), 22(3), 22(4), 23(3), 23(4), 24(3), 24(4), 25(3), 25(4),

26(3), 26(4), 27(3), 27(4), 28(4), 30(4), 31(4), 32(3), 32(4), 33(3), 33(4), 34(3), 34(4), 35(3), 35(4) and 36(4).

Unusual fact patterns may appear in cases in which prior art was relied upon to reject any claim or cited and discussed with respect to the patentability of a claim in a prior related PTO proceeding, but other evidence clearly shows that the examiner did not appreciate the issues raised in the reexamination request or the ongoing reexamination with respect to that art. Such other evidence may appear in the reexamination request, in the nature of the prior art, in the prosecution history of the prior examination, or in an admission by the patent owner, applicant or inventor. 37 CFR 1.104(c)(3), *MPEP 2242 A. 5.*

CRC Report No. 494 was discussed during the prosecution of U.S. patent 5,837,126 patent or related patent applications. Fuel No. 6 of CRC No. 494 has the following disclosed properties: RVP = 6.3; T10 = 140°F; T50 = 194°F; T90 = 300°F; lead <0.002 g/gal; volume % olefins = 1.6%; volume % paraffins = 71.4%; volume % aromatics = 27% and octane = 87.2. Fuel 6 meets all the limitations of claims 1, 3, 4, 8(1), 8(3), 8(4), 9(1), 9(3), 9(4), 10(1), 10(3), 10(4), 11(1), 11(3), 11(4), 13(1), 13(3), 14(1), 14(3), 14(4), 15(1), 15(3), 15(4), 16(1), 16(3), 16(4), 17(1), 17(3), 17(4), 18(1), 18(3), 18(4), 19(1), 19(3), 19(4), 20(3), 20(4), 21(3), 21(4), 22(3), 22(4), 23(3), 23(4), 24(3), 24(4), 25(3), 25(4), 26(3), 26(4), 27(3), 27(4), 28(4), 30(4), 31(4), 32(3), 32(4), 33(3), 33(4), 34(3), 34(4), 35(3), 35(4) and 36(4) except for the claimed value or values: T10 < 140°F; T90 < 300°F and volume % paraffins > 72%.

IDS No. 12 states:

> This disclosure statement is submitted as a clarification to Information Disclosure Statement No. 4 (hereinafter IDS No. 4).
>
> In IDS No. 4, in paragraph (3) on page 2, it should be understood that the "experimental fuels" A/O 1111, A/O 2222 and A/O AVE came from a different experimental program than the experiments described in the specification and were not fuels originated by the inventors but in fact were fuels produced by Phillips Petroleum.
>
> In IDS No. 4, in the next to last paragraph, it should be understood that all the fuels in Table 5 are test fuels or check fuels prepared by the applicants (or at their direction) except for fuels Q, R, and S, which are A/O AVE, A/O 2222 and A/O 1111, respectively, the fuels produced by Phillips Petroleum. (Emphasis added).

Identifying fuels Q, R, and S as A/O AVE, A/O 2222 and A/O 1111, respectively, would not have led a reasonable examiner to compare fuel Q with A/O AVE, fuel R with A/O 2222 or fuel S with A/O 1111.

A comparison of fuel Q with A/O AVE, fuel R with A/O 2222 and fuel S with A/O 1111 shows that the properties of these fuels, which patent holder admits are the same fuels, differ in the disclosed properties:

FUEL	RVP psi	T10 (°F)	T50 (°F)	T90 (°F)	Olefins (Vol.%)	Paraffins (Vol.%.)	Aromatics (Vol.%)	Octane RO	Octane MO
A/0 1111	8.8	123	196	282	4.1	76.4	19.5	90.6	84.4
S	8.44	129	199	284	3.9	75	21.1	91	84.3
Difference	**0.36**	**6**	**3**	**2**	**0.2**	**1.4**	**1.6**	**0.4**	**0.1**
A/O 2222	8.8	125	221	356	21	15.4	48.3	99	86.1
R	8.37	130	224	358	21.9	26.1	52	98.8	85.5
Difference	**0.43**	**5**	**3**	**2**	**0.9**	**10.7**	**3.7**	**0.2**	**0.6**
A/O AVE	8.7	112	218	315	9.5	59.8	30.7	92.2	82.7
Q	8.31	129	220	331	9.9	58.3	31.8	92.1	82.7
Difference	**0.39**	**17**	**2**	**16**	**0.4**	**1.5**	**1.1**	**0.1**	**0**

The teachings of CRC No. 494 in view of the admission in IDS No. 12 were not considered during the prosecution of the application that became U.S. patent 5,837,126. There is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not claims 1, 3, 4, 8(1), 8(3), 8(4), 9(1), 9(3), 9(4), 10(1), 10(3), 10(4), 11(1), 11(3), 11(4), 13(1), 13(3), 14(1), 14(3), 14(4), 15(1), 15(3), 15(4), 16(1), 16(3), 16(4), 17(1), 17(3), 17(4), 18(1), 18(3), 18(4), 19(1), 19(3), 19(4), 20(3), 20(4), 21(3), 21(4), 22(3), 22(4), 23(3), 23(4), 24(3), 24(4), 25(3), 25(4), 26(3), 26(4), 27(3), 27(4), 28(4), 30(4), 31(4), 32(3), 32(4), 33(3), 33(4), 34(3), 34(4), 35(3), 35(4) and 36(4) are patentable. Accordingly, CRC No. 494 in view of the admission in IDS No. 12, filed December 16, 1992, raise a substantial new question of patentability as to claims 1, 3, 4, 8(1), 8(3), 8(4), 9(1), 9(3), 9(4), 10(1), 10(3), 10(4), 11(1), 11(3), 11(4), 13(1), 13(3), 14(1), 14(3), 14(4), 15(1), 15(3), 15(4), 16(1), 16(3), 16(4), 17(1), 17(3), 17(4), 18(1), 18(3), 18(4), 19(1), 19(3), 19(4), 20(3), 20(4), 21(3), 21(4), 22(3), 22(4), 23(3), 23(4), 24(3), 24(4), 25(3), 25(4), 26(3), 26(4), 27(3), 27(4), 28(4), 30(4), 31(4), 32(3), 32(4), 33(3), 33(4), 34(3), 34(4), 35(3), 35(4) and 36(4) which question has not been decided in a previous examination of U.S. patent 5,837,126. Although IDS No. 12 was cited and discussed during the prosecution of the application that became U.S. patent 5,837,126, it appears that the examiner did not fully appreciate that fuels identified as being the same actually differed in various properties. See MPEP A. 5. for a discussion of the application of Portola Packaging to unusual fact patterns.

Summary

A substantial new question of patentability affecting at least one claim of U.S. patent 5,837,126 is raised for the reasons set forth above. While the references discussed above do not appear to raise a substantial new question of patentability as to claims 5, 6, 12, 29, 37 and 39-66, claims 5, 6, 12, 29, 37 and 39-66 will be reexamined along with claims 1-4, 7-11, 13-28, 30-36 and 38.

The petition is **GRANTED**. This decision is final and non-appealable, pursuant to 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

The request for reexamination is **GRANTED**. The patent owner is given **TWO** months from the mail date of this decision to file an optional patent owner's statement per 37 CFR 1.530.

The requester is given **TWO** months from the date of service of any patent owner's statement per 37 CFR 1.535 to file an optional reply to the patent owner's statement. No extension of time is permitted. If patent owner does not file a timely statement under 37 CFR 1.530(b), no reply by the requester is permitted.

Petition Granted

Earlier Filed Petition

The PETITION UNDER 37 CFR §§ 1.182 AND 1.183, filed April 12, 2001 by the requester, was inadvertently not matched with this reexamination file until after the request for reexamination was denied, and after the petition by the patent owner filed March 28, 2001 was dismissed. The petition filed April 12, 2001 is an improper submission under 37 CFR 1.540, and will not be made of record in the reexamination file, and is being returned to the third party requester. This decision returning the paper, however, will be made of record in the reexamination file.

Richard V. Fisher, Director
Technology Center 1700
Chemical and Materials Engineering

Enclosure:
PETITION UNDER 37 CFR §§ 1.182 AND 1.183 filed April 12, 2001 (third party requester)

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
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FEB 7 2002

CST

Paper No. 9

Gregory F. Wirzbicki
Union Oil Company of California
Patent Department
P.O. Box 7600
Brea, California 92822-7600

(for Patent Owner)

Robert L. Price
McDermott, Will & Emery
600 13th Street, N.W.
Washington, D.C. 20005-3096

(for Requester)

In re Jessup et al
Reexamination Proceeding
Control No. 90/005,924
Filed: February 6, 2001
For: U.S. Patent 5,837,126

ADDENDUM TO
PETITION DECISION
MAILED JANUARY 24, 2002

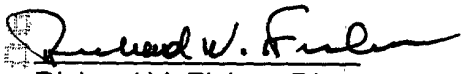
This is in response to a telephone call from Gregory Wirzbicki to Examiner Jerry Johnson on Thursday January 31, 2002 requesting that the petition decision of January 24, 2002 be remailed with a PTO-892 listing those references which were relied upon in ordering reexamination of U.S. Patent 5,837,126.

The omission of the PTO-892 is regretted. A PTO-892, listing those references which were not provided by the third party in the request for reexamination, is attached hereto. Copies of the listed references are also provided.

The date of the Order Granting the Request for Reexamination remains as January 24, 2002. However the time for patent owner to file an optional patent owner's statement per 37 CFR 1.530 is extended 1 month beyond the two months for response set forth in the original petition decision. Thus, the time for filing an optional patent owner's statement per 37 CFR 1.530 is set to expire **THREE** months from the original petition decision of January 24, 2002.

The requester is given **TWO** months from the date of service of any patent owner's statement per 37 CFR 1.535 to file an optional reply to the patent owner's statement. No extension of time is permitted. If patent owner does not file a timely statement under 37 CFR 1.530(b), no reply by the requester is permitted.

Reexamination Control No. 90/005,924 will be assigned to Examiner Jerry Johnson.



Richard V. Fisher, Director
Technology Center 1700
Chemical and Materials Engineering

Enclosure:
PTO-892 with references

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
90/005,924	02/06/2001	5837126	39591-039	2910

7590 07/21/2003

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EXAMINER	
ART UNIT	PAPER NUMBER

30

DATE MAILED: 07/21/2003

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

90005924 20030721

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

CST

Paper No. 30

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(for Patent Owner)

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(for Third Party)

Michael S. Marcus
Morgan & Finnegan, L.L.P.
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Washington, DC 20006

(for Third Party)

In re Jessup et al
Reexamination Proceeding
Control No. 90/005,924
Filed: February 6, 2001
For: U.S. Patent 5,837,126

In re Jessup et al
Reexamination Proceeding
Control No. 90/006,518
Filed: January 17, 2003
For: U.S. Patent 5,837,126

DECISION MERGING REEXAMINATION PROCEEDINGS

The above noted reexamination files are before the Director of Technology Center 1700 for consideration of the proceedings under 37 C.F.R. 1.565(c).

BACKGROUND

1. United States Patent 5,837,126, issued November 17, 1998, is the subject of Reexamination Control Nos. 90/005,924 and 90/006,518.

2. A first request for reexamination, assigned Reexamination Control No. 90/005,924 ('5924), was filed February 6, 2001 by Robert L. Price of McDermott, Will and Emery. The request urged that a substantial new question of patentability was raised by the teachings of (a) SAE Paper No. 730474, "An Evaluation of the Performance and Emissions of a CRF Engine Equipped with a Prechamber"; (b) "Carburetor Evaporation Losses", SAE Paper No. 12B; (c) CRC Report No. 510, "1978 Fuel Rating Program: Road Octane Performance in 1978 Model Cars"; (d) CRC Report No. 477, "1973 CRC Fuel Rating Program Part I: Road Octane Performance in 1973 Model Cars"; (e) CRC Report No. 494, "1975 CRC Fuel Rating Program: Road Octane Performance in 1975 Model Cars"; (f) File History of U.S. Patent 4,812,146 to P.J. Jessup; (g) SAE Paper No. 730616, "Gasolines for Low-Emission Vehicles"; (h) API Publication 4310; (i) California Air Resources Board Publication #SS-86-01, "California Perspective on Controlling Gasoline Evaporative Emissions"; (j) Kirk-Othmer Encyclopedia of Chemical Technology, Third Edition; (k) "A New Approach to Blending Octanes", Healy et al; (l) "The Interaction Approach to Gasoline Blending", William E. Morris; (m) SAE Publication 841206, Schmidt et al; (n) SAE Publication 841210, Dorn et al; and (o) GAO Report to Chairman, Subcommittee on Oversight and Investigations, Committee on Energy and Commerce, House of Representatives.

3. Patent owner filed a petition under 37 CFR 1.182 and 1.183 on March 28, 2001 requesting that the Commissioner waive the provisions of 37 CFR 1.530 and permit entry and consideration of this petition prior to the initial determination of the request for reexamination.

4. The petition filed on March 28, 2001 was dismissed on April 30, 2001.

5. The request for reexamination for '5924 was denied on May 2, 2001.

6. Robert L. Price of McDermott, Will and Emery petitioned for reversal of the examiner's decision denying the request for reexamination on June 1, 2001.

7. The petition for reversal of the examiner's decision denying the request for reexamination was granted on January 24, 2002. The request for reexamination for '5924 was thus granted.

8. A first Office action for '5924 was mailed on June 26, 2002. A supplemental Office action was subsequently mailed on July 25, 2002.

9. Patent owner timely responded to the first Office action on September 30, 2002 (certificate of mailing September 25, 2002).

10. A second request for reexamination, assigned Reexamination Control No. 90/006,518 ('6518), was filed January 17, 2003 by Michael S. Marcus of Morgan & Finnegan, LLP. The request urged that a substantial new question of patentability was raised by the teachings of (a) the January 17, 1972 Oil and Gas Journal publication ("GM-1"), either alone or in view of an August 1987 Notice of Proposed Rule Making published by the EPA ("the EPA RVP limits"); (b) the October 2, 1972 Oil and Gas Journal publication ("GM-2"), either alone or in view of the May 1973 Adams API publication ("Adams") and/or the EPA RVP limits; (c) GM-1, either alone or in view of the EPA RVP limits, together with the Kirk-Othmer publication describing gasoline blending and (d) GM-2, either alone or in view of Adams and/or the EPA RVP limits, together with Kirk-Othmer.

11. Reexamination was ordered for '6518 on March 18, 2003.

DISCUSSION

Under 37 C.F.R. 1.565(c):

> If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* proceeding has not been terminated, the *ex parte* 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 each of the above reexamination proceedings. Accordingly, merger of the proceedings under 37 C.F.R. 1.565(c) is appropriate. MPEP 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 90/005,924 and 90/006,518 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. Since the claims are the same in both files, a "housekeeping amendment" is NOT needed. See MPEP 2283, "Merger of Reexaminations."

III. CONDUCT OF MERGED PROCEEDING

The reexamination files shall be forwarded to the examiner for consideration of the Request for Reexamination in the '6518 reexamination proceeding, as well as consideration of the RESPONSE TO REJECTION, submitted September 30, 2002 (certificate of mailing September 25, 2002), in the '5924 reexamination proceeding.

All papers mailed by the Office throughout the merged proceeding 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 a signature and identifying data for both files, for entry into each file. All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control Nos. 90/005,924 and 90/006,518 as:

Gregory F. Wirzbicki
C/O Ingrid Impink
Unocal Corporation
1150 Connecticut Avenue, NW
Suite 1025
Washington, D.C. 20036

Also, until further notice, courtesy copies of all correspondence will be mailed to the California Attorney General's Office.

CONCLUSION

Reexamination Control Nos. 90/005,924 and 90/006,518 are merged. The merged reexamination files are being forwarded to the examiner for preparation of an Office action, to be issued in due course.

Jacqueline M. Stone

Jacqueline M. Stone
Director, Technology Center 1700
High Polymer Chemistry, Plastics,
Stock Materials and Compositions

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,138	11/02/2001	4946505	111583-00601-B	3396

7590 05/13/2002

George Wheeler, Esq.
McAndrews Held and Malloy, Ltd.
500 West Madison Street, 34th Floor
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/13/2002

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

90006138 - 05132002

UNITED STATES PATENT and TRADEMARK OFFICE
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WASHINGTON, D.C. 20231
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Mailed: CST

Paper No. 14

George Wheeler
McAndrews, Held & Malloy, Ltd.
500 West Madison Street, 34th Floor
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(for Patent Owner)

Charles R. Wolfe, Jr.
Blank, Rome, Comisky & McCauley, LLP
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900 17th Street, NW
Washington, DC 20006

(for Third Party)

In re Jungk
Reexamination Proceeding
Control No. 90/005,925
Filed: February 13, 2001
For: U.S. Patent 4,946,505

In re Jungk
Reexamination Proceeding
Control No. 90/006,138
Filed: November 2, 2001
For: U.S. Patent 4,946,505

DECISION MERGING REEXAMINATION PROCEEDINGS

The above noted reexamination files are before the Director of Technology Center 1700 for consideration of the proceedings under 37 C.F.R. 1.565(c).

BACKGROUND

1. United States Patent 4,946,505, issued August 7, 1990, is the subject of Reexamination Control Nos. 90/005,925 and 90/006,138.

2. A first request for reexamination, assigned Reexamination Control No. 90/005,925 ('925) was filed February 13, 2001 by Charles R. Wolfe, Jr. of Blank, Rome, Comisky & McCauley, LLP. The request urged that a substantial new question of patentability was raised by the teachings of (a) U.S. patent 3,843,380 to Beyn; (b) U.S. patent 3,843,380 to Beyn, in view of German patent 2,425,234 to Feige et al or U.S. patent 3,068,109 to Rodeffer; (c) U.S. patent 3,843,380 to Beyn, in view of U.S. patent 4,264,552 to McMahon et al; (d) Austrian patent 381,299 to Kneidinger et al; (e) Austrian patent 381,299 to Kneidinger et al, in view of German patent 2,425,234 to Feige et al; (f) Austrian patent 381,299 to Kneidinger et al, in view of U.S. patent 4,264,552 to McMahon et al; (g) U.S. patent 4,264,552 to McMahon et al, in view of either U.S. patent 3,843,380 to Beyn or Austrian patent 381,299 to Kneidinger et al; (h) U.S. patent 4,264,552 to McMahon et al, in view of U.S. patent 3,843,380 to Beyn or Austrian patent 381,299 to Kneidinger et al and German patent 2,425,234 to Feige et al or U.S. patent 3,068,109 to Rodeffer.

3. Reexamination was ordered for '925 on March 16, 2001.

4. A first Office action for '925 was mailed on August 8, 2001 and contained the rejection of claims 1-11 under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 3,843,380 to Beyn or Austrian patent 381,299 to Kneidinger et al alone or in view of U.S. patent 4,264,552 to McMahon et al or German patent 2,425,234 to Feige et al or U.S. patent 3,068,109 to Rodeffer.

5. Patent owner responded to the first Office action on October 9, 2001.

6. A "Notice of Intent to Issue Reexamination Certificate" was mailed on December 27, 2001 confirming the patentability of claims 1-11. A "Statement of Reasons for Patentability and/or Confirmation" was attached thereto, which set forth the examiner's reasons for patentability of the claims over the prior art of record.

7. A second request for reexamination, assigned Reexamination Control No. 90/006,138 ('138), filed November 2, 2001 by Charles R. Wolfe, Jr. of Blank, Rome, Comisky & McCauley, LLP. The request urged that a substantial new question of patentability was raised by the teachings of (a) U.S. patent 3,843,380 to Beyn; (b) U.S. patent 3,843,380 to Beyn, in view of German patent 2,425,234 to Feige et al or U.S. patent 3,068,109 to Rodeffer; (c) U.S. patent 3,843,380 to Beyn, in view of U.S. patent 4,264,552 to McMahon et al; (d) Austrian patent 381,299 to Kneidinger et al; (e) Austrian patent 381,299 to Kneidinger et al, in view of German patent 2,425,234 to Feige et al; (f) Austrian patent 381,299 to Kneidinger et al, in view of U.S. patent 4,264,552 to McMahon et al; (g) U.S. patent 4,264,552 to McMahon et al, in view of either U.S. patent 3,843,380 to Beyn or Austrian patent 381,299 to Kneidinger et al; (h) U.S. patent 4,264,552 to McMahon et al, in view of U.S. patent 3,843,380 to Beyn or Austrian patent 381,299 to Kneidinger et al and German patent 2,425,234 to Feige et al or U.S. patent 3,068,109 to Rodeffer; (i) U.S. patent 3,843,380 to Beyn or Austrian patent 381,299 to Kneidinger et al alone or in view of U.S. patent 4,264,552

to McMahon et al or German patent 2,425,234 to Feige et al or U.S. patent 3,068,109 to Rodeffer. Additional evidence was also provided to demonstrate that the Kneidinger et al patent is prior art to the '505 patent. A declaration by Peter Israiloff was also provided to explain certain aspects of the law deemed pertinent to the issue of whether the Kneidinger reference is prior art to the '505 patent.

8. A Petition of Patent Owner Under 35 U.S.C. § 304, 37 C.F.R. 1.550(g) and/or 37 C.F.R. 1.182 Requesting Denial of Duplicative Reexamination Request was submitted on January 3, 2002.

9. The Petition to Deny Second Request for Reexamination was dismissed on January 15, 2001.

10. Reexamination was ordered for '138 on January 17, 2001.

11. A timely filed Patent Owner's Statement under 37 C.F.R. §1.530 was submitted on February 1, 2002.

12. A timely filed Requester's Reply to Patent Owner's Statement Pursuant to 37 C.F.R. §1.535 was submitted on March 29, 2002.

DISCUSSION

Under 37 C.F.R. 1.565(c):

> If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* proceeding has not been terminated, the *ex parte* 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 each of the above reexamination proceedings. Accordingly, merger of the proceedings under 37 C.F.R. 1.565(c) is appropriate. MPEP 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 90/005,925 and 90/006,138 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. REQUIREMENTS FOR THE 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 2283, "Merger of Reexaminations".

III. CONDUCT OF MERGED PROCEEDING

The "Notice of Intent to Issue Reexamination Certificate" mailed December 27, 2001 is hereby withdrawn and the files shall be forwarded to the examiner for consideration of the prior art, statements and evidence presented in the second Request for Reexamination.

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 duplicate**, 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 Reexamination Control No. 90/005,925 and No. 90/006,138 as:

George Wheeler
McAndrews, Held & Malloy, Ltd.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661

CONCLUSION

Reexamination Control Nos. 90/005,925 and 90/006,138 are merged. An Office action will be issued in due course.

Richard V. Fisher

Richard V. Fisher, Director
Technology Center 1700
Chemical and Materials Engineering

20050525005

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address COMMISSIONER OF PATENTS AND TRADEMARKS
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/005,925 90/006138 90/006454	02/13/2001	4946505	111583-00601	6428

7590 03/27/2003

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CHICAGO, IL 60661

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/27/2003 28

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PTO-90C (Rev. 07-01)

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Mailed:

CST

Paper No. 27

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Washington, DC 20006

(for Third Party)

In re Jungk
Reexamination Proceeding
Control No. 90/005,925
Filed: February 13, 2001
For: U.S. Patent 4,946,505

In re Jungk
Reexamination Proceeding
Control No. 90/006,138
Filed: November 2, 2001
For: U.S. Patent 4,946,505

In re Jungk
Reexamination Proceeding
Control No. 90/006,454
Filed: November 19, 2002
For: U.S. Patent 4,946,505

DECISION MERGING REEXAMINATION PROCEEDINGS

The above noted reexamination files are before the Director of Technology Center 1700 for consideration of the proceedings under 37 C.F.R. 1.565(c).

BACKGROUND

1. United States Patent 4,946,505, issued August 7, 1990, is the subject of Reexamination Control Nos. 90/005,925, 90/006,138 and 90/006,454.

2. A first request for reexamination, assigned Reexamination Control No. 90/005,925 ('925) was filed February 13, 2001 by Charles R. Wolfe, Jr. of Blank, Rome, Comisky & McCauley, LLP. The request urged that a substantial new question of patentability was raised by the teachings of (a) U.S. patent 3,843,380 to Beyn; (b) U.S. patent 3,843,380 to Beyn, in view of German patent 2,425,234 to Feige et al or U.S. patent 3,068,109 to Rodeffer; (c) U.S. patent 3,843,380 to Beyn, in view of U.S. patent 4,264,552 to McMahon et al; (d) Austrian patent 381,299 to Kneidinger et al; (e) Austrian patent 381,299 to Kneidinger et al, in view of German patent 2,425,234 to Feige et al; (f) Austrian patent 381,299 to Kneidinger et al, in view of U.S. patent 4,264,552 to McMahon et al; (g) U.S. patent 4,264,552 to McMahon et al, in view of either U.S. patent 3,843,380 to Beyn or Austrian patent 381,299 to Kneidinger et al; (h) U.S. patent 4,264,552 to McMahon et al, in view of U.S. patent 3,843,380 to Beyn or Austrian patent 381,299 to Kneidinger et al and German patent 2,425,234 to Feige et al or U.S. patent 3,068,109 to Rodeffer.

3. Reexamination was ordered for '925 on March 16, 2001.

4. A first Office action for '925 was mailed on August 8, 2001 and contained the rejection of claims 1-11 under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 3,843,380 to Beyn or Austrian patent 381,299 to Kneidinger et al alone or in view of U.S. patent 4,264,552 to McMahon et al or German patent 2,425,234 to Feige et al or U.S. patent 3,068,109 to Rodeffer.

5. Patent owner responded to the first Office action on October 9, 2001.

6. A "Notice of Intent to Issue Reexamination Certificate" was mailed on December 27, 2001 confirming the patentability of claims 1-11. A "Statement of Reasons for Patentability and/or Confirmation" was attached thereto, which set forth the examiner's reasons for patentability of the claims over the prior art of record.

7. A second request for reexamination, assigned Reexamination Control No. 90/006,138 ('138), was filed November 2, 2001 by Charles R. Wolfe, Jr. of Blank, Rome, Comisky & McCauley, LLP. The request urged that a substantial new question of patentability was raised by the teachings of (a) U.S. patent 3,843,380 to Beyn; (b) U.S. patent 3,843,380 to Beyn, in view of German patent 2,425,234 to Feige et al or U.S. patent 3,068,109 to Rodeffer; (c) U.S. patent 3,843,380 to Beyn, in view of U.S. patent 4,264,552 to McMahon et al; (d) Austrian patent 381,299 to Kneidinger et al; (e) Austrian patent 381,299 to Kneidinger et al, in view of German patent 2,425,234 to Feige et al; (f) Austrian patent 381,299 to Kneidinger et al, in view of U.S. patent 4,264,552 to McMahon et al; (g) U.S. patent 4,264,552 to McMahon et al, in view of

either U.S. patent 3,843,380 to Beyn or Austrian patent 381,299 to Kneidinger et al; (h) U.S. patent 4,264,552 to McMahon et al, in view of U.S. patent 3,843,380 to Beyn or Austrian patent 381,299 to Kneidinger et al and German patent 2,425,234 to Feige et al or U.S. patent 3,068,109 to Rodeffer; (i) U.S. patent 3,843,380 to Beyn or Austrian patent 381,299 to Kneidinger et al alone or in view of U.S. patent 4,264,552 to McMahon et al or German patent 2,425,234 to Feige et al or U.S. patent 3,068,109 to Rodeffer. Additional evidence was also provided to demonstrate that the Kneidinger et al patent is prior art to the '505 patent. A declaration by Peter Israilloff was also provided to explain certain aspects of the law deemed pertinent to the issue of whether the Kneidinger reference is prior art to the '505 patent.

8. A Petition of Patent Owner Under 35 U.S.C. § 304, 37 C.F.R. 1.550(g) and/or 37 C.F.R. 1.182 Requesting Denial of Duplicative Reexamination Request was submitted on January 3, 2002.

9. The Petition to Deny Second Request for Reexamination was dismissed on January 15, 2001.

10. Reexamination was ordered for '138 on January 17, 2001.

11. A timely filed Patent Owner's Statement under 37 C.F.R. §1.530 was submitted on February 1, 2002.

12. A timely filed Requester's Reply to Patent Owner's Statement Pursuant to 37 C.F.R. §1.535 was submitted on March 29, 2002.

13. A Decision Merging Reexamination Control Nos. 90/005,925 and 90/006,138 was mailed on May 13, 2002.

14. A non-final Office action for the merged proceedings was mailed on May 20, 2002 and contained the rejection of claims 1-11 under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 3,843,380 to Beyn alone or in view of U.S. patent 4,264,552 to McMahon et al or German patent 2,425,234 to Feige et al or U.S. patent 3,068,109 to Rodeffer.

15. Patent owner responded to the non-final Office action on July 10, 2002.

16. A final Office action for the merged proceedings was mailed on September 20, 2002 and contained the rejection of claims 1-11 under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 3,843,380 to Beyn alone or in view of U.S. patent 4,264,552 to McMahon et al or German patent 2,425,234 to Feige et al or U.S. patent 3,068,109 to Rodeffer.

17. Patent owner responded to the final Office action on October 21, 2002.

18. An advisory action was mailed on November 12, 2002.

19. On November 20, 2002, patent owner submitted a second response to the final Office action and a Notice of Appeal.

20. An advisory action was mailed on December 20, 2002.

21. An Appeal Brief was submitted in the merged Reexamination Control Nos. 90/005,925 and 90/006,138 by patent owner on January 21, 2003.

22. A third request for reexamination, assigned Reexamination Control No. 90/006,454 ('454) was filed November 19, 2002 by George Wheeler of McAndrews, Held & Molloy, Ltd. The request urged that this request is based upon the same prior art and publications that supported the previous requests. An amendment adding claims 12-21 was also submitted.

23. Reexamination was ordered for '454 on January 6, 2003.

DISCUSSION

Under 37 C.F.R. 1.565(c):

> If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* proceeding has not been terminated, the *ex parte* 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 each of the above reexamination proceedings. Accordingly, merger of the proceedings under 37 C.F.R. 1.565(c) is appropriate. MPEP 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 90/005,925, 90/006,138 and 90/006,454 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. Patent Owner is given one (1) month from the date of this decision to provide a "housekeeping amendment" to make the claims the same in each file. Note that Patent Owner has submitted an amendment in Reexamination Control No. 90/006,454 in which claims 12-21 were added. See MPEP 2283, "Merger of Reexaminations."

III. CONDUCT OF MERGED PROCEEDING

An Office action will be issued in due course (after entry of the "housekeeping amendment") which applies to Reexamination Control Nos. 90/005,925, 90/006,138 and 90/006,454.

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 a 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 Reexamination Control Nos. 90/005,925, 90/006,138 and 90/006,454 as:

George Wheeler
McAndrews, Held & Malloy, Ltd.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661

CONCLUSION

Reexamination Control Nos. 90/005,925, 90/006,138 and 90/006,454 are merged. The Patent Owner is given one (1) month from the date of this decision to provide a "housekeeping amendment" to make the claims the same in each file.

JMStone

Jacqueline M. Stone
Director, Technology Center 1700
High Polymer Chemistry, Plastics,
Stock Materials and Compositions

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
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,138	11/02/2001	4946505	111583-00601-B	3396

7590 05/13/2002

George Wheeler, Esq.
McAndrews Held and Malloy, Ltd.
500 West Madison Street, 34th Floor
Chicago, IL 60661

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/13/2002

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

90006138 - 05132002

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

Mailed: CST

Paper No. 14

George Wheeler
McAndrews, Held & Malloy, Ltd.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661

(for Patent Owner)

Charles R. Wolfe, Jr.
Blank, Rome, Comisky & McCauley, LLP
The Farragut Building, Suite 1000
900 17th Street, NW
Washington, DC 20006

(for Third Party)

In re Jungk
Reexamination Proceeding
Control No. 90/005,925
Filed: February 13, 2001
For: U.S. Patent 4,946,505

In re Jungk
Reexamination Proceeding
Control No. 90/006,138
Filed: November 2, 2001
For: U.S. Patent 4,946,505

DECISION MERGING REEXAMINATION PROCEEDINGS

The above noted reexamination files are before the Director of Technology Center 1700 for consideration of the proceedings under 37 C.F.R. 1.565(c).

BACKGROUND

1. United States Patent 4,946,505, issued August 7, 1990, is the subject of Reexamination Control Nos. 90/005,925 and 90/006,138.

2. A first request for reexamination, assigned Reexamination Control No. 90/005,925 ('925) was filed February 13, 2001 by Charles R. Wolfe, Jr. of Blank, Rome, Comisky & McCauley, LLP. The request urged that a substantial new question of patentability was raised by the teachings of (a) U.S. patent 3,843,380 to Beyn; (b) U.S. patent 3,843,380 to Beyn, in view of German patent 2,425,234 to Feige et al or U.S. patent 3,068,109 to Rodeffer; (c) U.S. patent 3,843,380 to Beyn, in view of U.S. patent 4,264,552 to McMahon et al; (d) Austrian patent 381,299 to Kneidinger et al; (e) Austrian patent 381,299 to Kneidinger et al, in view of German patent 2,425,234 to Feige et al; (f) Austrian patent 381,299 to Kneidinger et al, in view of U.S. patent 4,264,552 to McMahon et al; (g) U.S. patent 4,264,552 to McMahon et al, in view of either U.S. patent 3,843,380 to Beyn or Austrian patent 381,299 to Kneidinger et al; (h) U.S. patent 4,264,552 to McMahon et al, in view of U.S. patent 3,843,380 to Beyn or Austrian patent 381,299 to Kneidinger et al and German patent 2,425,234 to Feige et al or U.S. patent 3,068,109 to Rodeffer.

3. Reexamination was ordered for '925 on March 16, 2001.

4. A first Office action for '925 was mailed on August 8, 2001 and contained the rejection of claims 1-11 under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 3,843,380 to Beyn or Austrian patent 381,299 to Kneidinger et al alone or in view of U.S. patent 4,264,552 to McMahon et al or German patent 2,425,234 to Feige et al or U.S. patent 3,068,109 to Rodeffer.

5. Patent owner responded to the first Office action on October 9, 2001.

6. A "Notice of Intent to Issue Reexamination Certificate" was mailed on December 27, 2001 confirming the patentability of claims 1-11. A "Statement of Reasons for Patentability and/or Confirmation" was attached thereto, which set forth the examiner's reasons for patentability of the claims over the prior art of record.

7. A second request for reexamination, assigned Reexamination Control No. 90/006,138 ('138), filed November 2, 2001 by Charles R. Wolfe, Jr. of Blank, Rome, Comisky & McCauley, LLP. The request urged that a substantial new question of patentability was raised by the teachings of (a) U.S. patent 3,843,380 to Beyn; (b) U.S. patent 3,843,380 to Beyn, in view of German patent 2,425,234 to Feige et al or U.S. patent 3,068,109 to Rodeffer; (c) U.S. patent 3,843,380 to Beyn, in view of U.S. patent 4,264,552 to McMahon et al; (d) Austrian patent 381,299 to Kneidinger et al; (e) Austrian patent 381,299 to Kneidinger et al, in view of German patent 2,425,234 to Feige et al; (f) Austrian patent 381,299 to Kneidinger et al, in view of U.S. patent 4,264,552 to McMahon et al; (g) U.S. patent 4,264,552 to McMahon et al, in view of either U.S. patent 3,843,380 to Beyn or Austrian patent 381,299 to Kneidinger et al; (h) U.S. patent 4,264,552 to McMahon et al, in view of U.S. patent 3,843,380 to Beyn or Austrian patent 381,299 to Kneidinger et al and German patent 2,425,234 to Feige et al or U.S. patent 3,068,109 to Rodeffer; (i) U.S. patent 3,843,380 to Beyn or Austrian patent 381,299 to Kneidinger et al alone or in view of U.S. patent 4,264,552

to McMahon et al or German patent 2,425,234 to Feige et al or U.S. patent 3,068,109 to Rodeffer. Additional evidence was also provided to demonstrate that the Kneidinger et al patent is prior art to the '505 patent. A declaration by Peter Israiloff was also provided to explain certain aspects of the law deemed pertinent to the issue of whether the Kneidinger reference is prior art to the '505 patent.

8. A Petition of Patent Owner Under 35 U.S.C. § 304, 37 C.F.R. 1.550(g) and/or 37 C.F.R. 1.182 Requesting Denial of Duplicative Reexamination Request was submitted on January 3, 2002.

9. The Petition to Deny Second Request for Reexamination was dismissed on January 15, 2001.

10. Reexamination was ordered for '138 on January 17, 2001.

11. A timely filed Patent Owner's Statement under 37 C.F.R. §1.530 was submitted on February 1, 2002.

12. A timely filed Requester's Reply to Patent Owner's Statement Pursuant to 37 C.F.R. §1.535 was submitted on March 29, 2002.

DISCUSSION

Under 37 C.F.R. 1.565(c):

> If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* proceeding has not been terminated, the *ex parte* 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 each of the above reexamination proceedings. Accordingly, merger of the proceedings under 37 C.F.R. 1.565(c) is appropriate. MPEP 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 90/005,925 and 90/006,138 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. REQUIREMENTS FOR THE 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 2283, "Merger of Reexaminations".

III. CONDUCT OF MERGED PROCEEDING

The "Notice of Intent to Issue Reexamination Certificate" mailed December 27, 2001 is hereby withdrawn and the files shall be forwarded to the examiner for consideration of the prior art, statements and evidence presented in the second Request for Reexamination.

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 duplicate**, 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 Reexamination Control No. 90/005,925 and No. 90/006,138 as:

George Wheeler
McAndrews, Held & Malloy, Ltd.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661

CONCLUSION

Reexamination Control Nos. 90/005,925 and 90/006,138 are merged. An Office action will be issued in due course.

Richard V. Fisher

Richard V. Fisher, Director
Technology Center 1700
Chemical and Materials Engineering

20050525005

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
www uspto gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/005,925 90/006138 90/006454	02/13/2001	4946505	111583-00601	6428

7590 03/27/2003

GEORGE WHEELER
McANDREWS, HELD & MALLOY, Ltd.
500 WEST MADISION STREET, SUITE 3400
CHICAGO, IL 60661

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/27/2003 28

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
WASHINGTON, D.C. 20231
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Mailed:

CST

Paper No. 27

George Wheeler
McAndrews, Held & Malloy, Ltd.
500 West Madison Street, 34th Floor
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(for Patent Owner)

Charles R. Wolfe, Jr.
Blank, Rome, Comisky & McCauley, LLP
The Farragut Building, Suite 1000
900 17th Street, NW
Washington, DC 20006

(for Third Party)

In re Jungk
Reexamination Proceeding
Control No. 90/005,925
Filed: February 13, 2001
For: U.S. Patent 4,946,505

In re Jungk
Reexamination Proceeding
Control No. 90/006,138
Filed: November 2, 2001
For: U.S. Patent 4,946,505

In re Jungk
Reexamination Proceeding
Control No. 90/006,454
Filed: November 19, 2002
For: U.S. Patent 4,946,505

DECISION MERGING REEXAMINATION PROCEEDINGS

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BACKGROUND

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2. A first request for reexamination, assigned Reexamination Control No. 90/005,925 ('925) was filed February 13, 2001 by Charles R. Wolfe, Jr. of Blank, Rome, Comisky & McCauley, LLP. The request urged that a substantial new question of patentability was raised by the teachings of (a) U.S. patent 3,843,380 to Beyn; (b) U.S. patent 3,843,380 to Beyn, in view of German patent 2,425,234 to Feige et al or U.S. patent 3,068,109 to Rodeffer; (c) U.S. patent 3,843,380 to Beyn, in view of U.S. patent 4,264,552 to McMahon et al; (d) Austrian patent 381,299 to Kneidinger et al; (e) Austrian patent 381,299 to Kneidinger et al, in view of German patent 2,425,234 to Feige et al; (f) Austrian patent 381,299 to Kneidinger et al, in view of U.S. patent 4,264,552 to McMahon et al; (g) U.S. patent 4,264,552 to McMahon et al, in view of either U.S. patent 3,843,380 to Beyn or Austrian patent 381,299 to Kneidinger et al; (h) U.S. patent 4,264,552 to McMahon et al, in view of U.S. patent 3,843,380 to Beyn or Austrian patent 381,299 to Kneidinger et al and German patent 2,425,234 to Feige et al or U.S. patent 3,068,109 to Rodeffer.

3. Reexamination was ordered for '925 on March 16, 2001.

4. A first Office action for '925 was mailed on August 8, 2001 and contained the rejection of claims 1-11 under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 3,843,380 to Beyn or Austrian patent 381,299 to Kneidinger et al alone or in view of U.S. patent 4,264,552 to McMahon et al or German patent 2,425,234 to Feige et al or U.S. patent 3,068,109 to Rodeffer.

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either U.S. patent 3,843,380 to Beyn or Austrian patent 381,299 to Kneidinger et al; (h) U.S. patent 4,264,552 to McMahon et al, in view of U.S. patent 3,843,380 to Beyn or Austrian patent 381,299 to Kneidinger et al and German patent 2,425,234 to Feige et al or U.S. patent 3,068,109 to Rodeffer; (i) U.S. patent 3,843,380 to Beyn or Austrian patent 381,299 to Kneidinger et al alone or in view of U.S. patent 4,264,552 to McMahon et al or German patent 2,425,234 to Feige et al or U.S. patent 3,068,109 to Rodeffer. Additional evidence was also provided to demonstrate that the Kneidinger et al patent is prior art to the '505 patent. A declaration by Peter Israilloff was also provided to explain certain aspects of the law deemed pertinent to the issue of whether the Kneidinger reference is prior art to the '505 patent.

8. A Petition of Patent Owner Under 35 U.S.C. § 304, 37 C.F.R. 1.550(g) and/or 37 C.F.R. 1.182 Requesting Denial of Duplicative Reexamination Request was submitted on January 3, 2002.

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12. A timely filed Requester's Reply to Patent Owner's Statement Pursuant to 37 C.F.R. §1.535 was submitted on March 29, 2002.

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23. Reexamination was ordered for '454 on January 6, 2003.

DISCUSSION

Under 37 C.F.R. 1.565(c):

> If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* proceeding has not been terminated, the *ex parte* reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570.

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DECISION

I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. 1.565(c), the 90/005,925, 90/006,138 and 90/006,454 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. Patent Owner is given one (1) month from the date of this decision to provide a "housekeeping amendment" to make the claims the same in each file. Note that Patent Owner has submitted an amendment in Reexamination Control No. 90/006,454 in which claims 12-21 were added. See MPEP 2283, "Merger of Reexaminations."

III. CONDUCT OF MERGED PROCEEDING

An Office action will be issued in due course (after entry of the "housekeeping amendment") which applies to Reexamination Control Nos. 90/005,925, 90/006,138 and 90/006,454.

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 a 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 Reexamination Control Nos. 90/005,925, 90/006,138 and 90/006,454 as:

George Wheeler
McAndrews, Held & Malloy, Ltd.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661

CONCLUSION

Reexamination Control Nos. 90/005,925, 90/006,138 and 90/006,454 are merged. The Patent Owner is given one (1) month from the date of this decision to provide a "housekeeping amendment" to make the claims the same in each file.

JMStone

Jacqueline M. Stone
Director, Technology Center 1700
High Polymer Chemistry, Plastics,
Stock Materials and Compositions

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/005,930	02/16/2001	5241219	111418-00288	1951

90/006078

7590 04/03/2002

Charles R Wolfe, Jr.
Blank Rome Comisky and McCauley LLP
The Farragut Building Suite 1000
900 17th Street NW
Washington, DC 20006

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/03/2002

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

90006078 20020403

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WASHINGTON, D.C 20231
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Paper No. 7

Charles R. Wolfe
Blank, Rome, Comisky & McCauley, LLP
The Farragut Building, Suite 1000
900 17th Street, N.W.
Washington, D.C. 20006

(for patent owner)

Gregor N. Neff, Esq.
Theodore J Mlynar, Esq.
Kramer, Levin, Naftalis & Frankel
919 Third Avenue
New York, NY 10022

(for requester)

90005930 - 04/30/02

In re LeBaron *et al.*
Reexamination Proceeding
Control Number 90/005,930
Filed: February 16, 2001
For: U.S. Patent No. 5,241,219
Title: Current Mode Coupler

DECISION MERGING
REEXAMINATION PROCEEDINGS

In re LeBaron *et al.*
Reexamination Proceeding
Control Number 90/006,078
Filed: February 16, 2001
For: U.S. Patent No. 5,241,219
Title: Current Mode Coupler

The above-identified reexamination files are before the Director of Examining Group 2830, Technology Center 2800, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 5,241,219 issued on August 31, 1993.

2. A first request for reexamination, Reexamination Control No. 90/005,930, was filed by the patent owner on February 16, 2001.

3. Reexamination was ordered in the '930 reexamination proceeding on March 21, 2001.

4. A second request for reexamination, Reexamination Control No. 90/006,078, was filed by a third party requester on August 10, 2001.

5. Reexamination was ordered in the '078 reexamination proceeding on September 20, 2001.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

> If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* reexamination has not been terminated, the *ex parte* reexamination proceedings will be consolidated and result in the issuance of a single certificate of a single certificate under § 1.570.

As noted above, 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 of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '930 and '078 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.

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. '930 and '078 are merged. The reexamination files are being forwarded to the examiner for issuing a first Office action.

for Richard K. Seidel, Group Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

Page 3 of 3

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)

GREGOR N. NEFF, ESQ.
THEODORE J. MLYNAR, ESQ.
KRAMER LEVIN NAFTALIS & FRANKEL
919 THIRD AVENUE
NEW YORK, NY 10022

REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/006,078 & 90/005,930

PATENT NO. 5,241,219

ART UNIT 2836

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

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address COMMISSIONER OF PATENTS AND TRADEMARKS
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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/005,931	02/16/2001	5825892	202128US25RX	1953

7590 04/24/2002

International Business Machines Corporation
Old Orchard Road
Armonk, NY 10504

EXAMINER	
Meislahn	
ART UNIT	PAPER NUMBER
2131	12

DATE MAILED: 04/24/2002

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 PATEN
UNITED STATES PATENT AND TRADEMARK OFFI
WASHINGTON, D.C. 2023
www.uspto.g

Paper No. 12

Louis Herzberg
International Business Machines Corporation
Old Orchard Road
Armonk, New York 10504

FOR PATENT OWNER

OBLON, SPIVACK, McCLELLAND,
MAIER AND NEUSTADT, P.C.
Fourth Floor
1755 Jefferson Davis Highway
Arlington, Virginia 22202

FOR THIRD PARTY REQUESTOR

In re Reexamination of:
U.S. Patent No. 5,825,892
Reexamination Control No.
90/005,931
For: PROTECTING IMAGES WITH AN IMAGE WATERMARK

DECISION ON PETITION UNDER 37 CFR § 1.103(a) TO SUSPEND ACTION

This is a decision on the petition under 37 CFR 1.103(a), filed February 19, 2002 requesting suspension of action pending a decision on a separate petition pending in the Office of Petitions.

RELEVANT BACKGROUND

1. A first Office action was mailed on November 23, 2001. [Paper No.6]

2. The first Office action was remailed on December 20, 2001 resetting the 2 month period for response. [Paper No.7]

3. Patent Owner filed a response with exhibits and a Petition to suspend action by Express Mail on February 20, 2002. This paper was received at the USPTO on February 25, 2002. Copies of these papers were served on Third Party Requestor on April 9, 2002. [Papers No.8 and No. 9]

4. Patent Owner filed a paper captioned "Petition to Reset Response date to Office Action in Reexamination under CFR Rules 1.550 and 1.104" on March 28, 2002. [Paper No. 10, served on third party April 22, 2002]

5. Patent Owner filed a Supplemental Petition on April 15, 2002 with additional materials and recharacterizing the petition as a request for extension of time under 37 CFR 1.550(c). [Paper No. 11]

BASIS OF OPINION

The relevant portion of the Statute is reproduced below. Emphasis is added to draw attention to the critical phrases.

35 U.S.C. 305 Conduct of reexamination proceedings.

> After 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 under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent. 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.***

37 CFR. § 1.550 Conduct of *ex parte* reexamination proceedings.

> ...
>
> (c) The time ***for taking any action*** by a patent owner in an *ex parte* reexamination proceeding will be extended only for 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.

OPINION

The current petition highlights the distinction between extensions of time and a suspension of prosecution. Extensions of time are available when Applicant has an outstanding period of response and requests that the period be extended for sufficient cause. Note that under 37 CFR. § 1.550(c) a specific period of extension must be included in the request. On the other hand, Suspensions of prosecution are only available when no reply is outstanding.

I. Petition for Extension of Time

Patent owner has filed a timely response to the first Office action within the 2 month response period. Accordingly, even assuming Petitioner's attempt to characterize the original request for Suspension as a mislabelled Petition for extension of time is effective, the Petition would not be granted. As explained above, extensions of time are not available when no response is outstanding. Furthermore, the petition is defective in that it does not specify a period of time requested.

II. Petition for Suspension of Prosecution

In accordance with 35 U.S.C. § 305 reexamination proceedings are conducted with special dispatch. There is no provision in the rules for suspension of action in a reexamination proceeding. The Federal Circuit has ruled that an indefinite suspension of reexamination proceedings is not consistent with the requirement of "special dispatch". *See, Ethicon Inc. v. Quigg,* 7 USPQ2d 1152.

Accordingly, the Petition is **DENIED**.

The Reexamination file is being forwarded to the Examiner for consideration of the response.

Margaret A. Focarino, Group Director
Technology Center 2100
Computer Architecture, Software, and Electronic Commerce

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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/005,931	02/16/2001	5825892	202128US25RX	1953

7590 02/10/2004

LOUIS P. HERZBERG
P.O. BOX 218
ROUTE 13/1101 KITCHAWAN ROAD
YORKTOWN HEIGHTS, NY 10598

EXAMINER
MEISLAHN

ART UNIT	PAPER NUMBER
2132	38

DATE MAILED: 02/10/2004

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATEN
UNITED STATES PATENT AND TRADEMARK OFFI
WASHINGTON, D C. 2023
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Paper No. 38

Louis Herzberg
P.O. Box 218
Route 131/1101 Kitchawan Road
Yorktown Heights, New York 10598

FOR PATENT OWNER

OBLON, SPIVACK, McCLELLAND,
MAIER AND NEUSTADT, P.C.
Fourth Floor
1755 Jefferson Davis Highway
Arlington, Virginia 22202

FOR THIRD PARTY REQUESTOR

In re Reexamination of:
U.S. Patent No. 5,825,892
Reexamination Control No.
90/005,931
For: PROTECTING IMAGES WITH AN IMAGE WATERMARK

DECISION ON PETITION TO ENTER THE REPLY BRIEF

This is a decision on the petition filed January 26, 2004 requesting that the reply brief filed January 26, 2004 be entered in the file.

In support of the petition, Petitioner states that the Examiner's Answer, mailed June 18, 2003 and remailed August 19, 2003, was not received by Patent Owner's representative. Patent Owner first became aware of the situation by way of a telephone inquiry from the USPTO on November 25, 2003. As a result of the telephone conversation a copy of the Examiner's Answer was faxed to Petitioner on that date. Petitioner points out that the Examiner's Answer was mailed to an incorrect correspondence address.

The petition is being treated as a request to restart the time period for filing the Reply Brief as of November 25, 2003 - the date Patent Owner received the Faxed copy of the Examiner's Answer.

A review of the file record indicates that the Correspondence was mailed to an incorrect address and has since been returned by the US Postal Service as undeliverable. Had Patent Owner followed proper procedure this request would have been filed immediately upon becoming aware of the improper mailing

as opposed to waiting for the expiration of the period of response before filing this request. Such a request would have been honored because the non-receipt of the Examiner's Answer was due to Office error in the mailing.

Accordingly, the Petition is **GRANTED.** The period to file a reply brief is restarted to run from November 25, 2003. Therefore, the reply brief filed on January 26, 2004 is timely and has been entered.

The Reexamination file is being forwarded to the Examiner for consideration of the reply brief.

Pinchus M. Laufer
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security
(703) 306-4160

Application/Control Number: 90/005,931

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
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#19/9
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9/6/01

SEP - 9 2001

Paper No. 19/9

Kenneth L. Cage
McDERMOTT, WILL & EMERY
600 13th Street, N.W.
Washington, DC 20005-3096

(For Patent Owner)

William H. Wright
HOGAN & HARTSON L.L.P.
500 South Grand Avenue, Suite 1900
Los Angeles, CA 90071

(For Third Party Requester)

In re Robert Bigler et al.
Reexamination Proceeding
Control No. 90/005,639
Filed: February 17, 2000
For U.S. Patent No. 5,912,541

In re Robert Bigler et al.
Reexamination Proceeding
Control No. 90/005,936
Filed: February 21, 2001
For U.S. Patent No. 5,912,541

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above-identified reexamination files are before the Director of Examining Group 2830, Technology Center 2800, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 5,912,541 issued on November 10, 1992.

2. Reexamination Control No. 90/005,639 was filed by a third party requester on February 17, 2000.

3. Reexamination was ordered in the '639 reexamination proceeding on April 25, 2000.

4. An amendment was filed on June 21, 2000 which amended claim 26 and canceled claim 29.

5. A non-final Office Action was mailed on September 27, 2000.

6. A second amendment was filed on January 26, 2001 which amended column 2 of the specification and added new claims 36-100.

7. Reexamination Control No. 90/005,936 was filed by the same third party requester on February 21, 2001.

8. Reexamination was ordered in the '936 reexamination proceeding on April 24, 2001.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

> If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* reexamination has not been terminated, the *ex parte* reexamination proceedings will be consolidated and result in the issuance of a single certificate 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

In accordance with 37 C.F.R. § 1.565(c), the '639 and '936 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

I. Requirements for Same Amendments in Both Proceedings

As noted above, the claims and specification have been amended in the '639 reexamination proceeding. A patent owner is required to maintain the same claims and specification in both files. A 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 ~~less than~~ under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

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

Reexamination Control Nos. '639 and '936 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.

Stewart J. Levy, Group Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

REEXAMINATION RECONSTRUCTION FILE

90/005936

RE-EXAM

90005936

CONTENTS

When Entering a Paper See Scanned Notice Inside File

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 18

Ronald M. Anderson, Esq. (For Patent Owner)
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Bellevue, WA 98004

Steven J. Hultquist, Esq. (For Requester)
P.O. Box 14329
Research Triangle Park, NC 27709

MAILED

JAN 23 2003

REEXAM UNIT

In re Bodle
Reexamination Proceeding
Control No. 90/005,937
Filed: February 22, 2001
For: U.S. Patent No. 5,961,072

DECISION DISMISSING PETITION

This is a decision on the December 17, 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.

The petition fee of $1280.00 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 **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 petition fee. The instant petition lacks items (1) and (3) above. Although a response to the outstanding non-final Office action was filed on December 17, 2002, this paper does not constitute "the required reply" pursuant to 37 C.F.R. § 1.137(b)(1), as the amendment is not in compliance with 37 CFR § 1.530. **Note that the manner of making amendments in applications set forth in 37 CFR § 1.121 does <u>not</u> apply to reexamination proceedings, as stated in 37 CFR § 1.121(i).** Specifically, the amendment is **not** in compliance with 37 CFR § 1.530, as it does not include an explanation of the support in the original disclosure of the patent for the changes to the claims made by the amendment papers, as required by 37 CFR § 1.530(e). Also, in the amendment paper, the amendment of claims 24 and 26 does not show the changes being made with bracketing and underlining, **<u>with regard to the original patent text,</u>** as required by 37 CFR § 1.530(d)(2) and (i)(emphasis added). With regard to 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 **<u>not</u>** sufficient to meet the requirement of 37 C.F.R. § 1.137(b)(3), as it merely indicates that "the delay causing the abandonment of the above-identified

reexamination proceeding 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. The reexamination file will be stored in the Central Reexam Unit (CRU) for one month to await any such renewed petition. If no such renewed petition is timely received, the reexamination file will be forwarded to Technology Center 3600 for termination of the proceeding, and issuance of the Notice of Intent to Issue Reexamination Certificate (NIRC).

4. 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

5. Telephone inquiries with regard to this decision should be directed to the undersigned at (703) 308-0255.

Lynn M. Kryza

Lynn M. Kryza
Patent Special Projects Advisor
Office of Patent Legal Administration

January 23, 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
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www.uspto.go

Paper No. 21

Ronald M. Anderson, Esq. (For Patent Owner)
Suite 507
600 108th Avenue, NE
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Steven J. Hultquist, Esq. (For Requester)
P.O. Box 14329
Research Triangle Park, NC 27709

In re Bodle
Reexamination Proceeding
Control No. 90/005,937
Filed: February 22, 2001
For: U.S. Patent No. 5,961,072

DECISION GRANTING PETITION

MAILED
MAR 0 3 2003
REEXAM UNIT

Application/Control Number: 90/005,937

This is a decision on the February 13, 2003, patent owner renewed 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 $1280.00 pursuant to 37 C.F.R. § 1.17(m) for the petition under 37 C.F.R. § 1.137(b) was received with the previous petition of December 17, 2002.

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 previous petition was 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 outstanding nonfinal Office action of August 27, 2002, has been received. The amendment of February 13, 2003, is in compliance with 37 C.F.R. § 1.530, as the changes are presented with changes in bracketing and underlining with regard to the original patent text, and the response includes an explanation of the support in the original disclosure of the patent for the changes to the claims made by the amendment papers.

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 3600 for consideration of the response to the nonfinal Office action of August 27, 2002.

3. Further inquiries with regard to this reexamination proceeding should be directed to the examiner, Brian Green, of Group Art Unit 3611.

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

February 20, 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
WWW.USPTO GOV

SEP 19 2001

#7

BROWDY AND NEIMARK PPLC
624 NINTH STREET NW SUITE 300
WASHINGTON DC 20001

EDWARD A. HEDMAN, ESQ.
HEDMAN & COSTIGAN, P.C.
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-2646

In re Reexamination of	:
Arpaia et al.	:
Serial No.: 90/005,940	: PETITION under 37 C.F.R. 1.181
Filed: 27 February 2001	:
Patent No. 5,767,067	:
Attorney Docket No.: 515-4166	:

This is in response to the Petition under 37 C.F.R. 1.181 filed 15 June 2001, by a third party requester for review pursuant to 37 C.F.R. 1.515(c) of the Order Denying the Request for Reexamination dated 15 May 2001. The delay in acting on this petition is regretted.

The Petition presents four points to be reviewed, as summarized below:

1. Has the examiner appreciated the issues raised by the Reexamination Request with respect to the prior art?

2. Has the instant case been decided on its particular facts, including other evidence, citing MPEP Section 2242 A.5?

3. Does the finding that the only difference between the Arpaia claims and the Reddy et al patents is the content of beta subunits raise a substantial new question of patentability?

4. Has the Examiner's Order raised a substantial new question of patentability by resurrecting an unpatentability rejection avoided in the record (MPEP 2217)?

Each of these four points will be addressed below.

The Request for Reexamination was filed 27 February 2001, based on the Reddy et al patent (US Patent No. 4,923,805) and Reddy et al published application (WO 86/04589). The Reddy et al patent and published application are cumulative in nature and teach biologically active human follicle stimulating hormone (FSH) which is produced using a recombinant DNA expression system. In Reddy et al '805 and '589, the genes encoding the alpha and beta subunits of FSH were cloned into expression vectors and expressed in transfected mouse cells. The Reddy et al patent and published application teach the open reading frame of the beta subunit gene. Reddy et al teach that

"...the beta subunit has a 18 amino acid signal peptide which is cleaved off post-translationally. The mature protein begins with the amino acid Asn..."

(See '805, col 5, lines 34-40; see '589, page 11, first full paragraph).

Thus Reddy et al teach that the FSH produced by their gene expression system would result in the production of a FSH protein that comprises a homogeneous population of beta chains that begin with the amino acid Asn.

Turning to Arpaia et al., the FSH of claim 1 requires a heterogeneous population of beta chains that begin with the amino acid Asn, Ser or Cys. See claim 1, part (2). Claims 2-10 depend upon and are so limited by claim 1. FSH comprising a heterogeneous population of beta chains, beginning with Asn, Ser or Cys, is neither taught nor fairly suggested by the Reddy et al documents. Thus the Reddy et al documents fail to raise a substantial new question of patentability as to any one of the Arpaia claims.

The Petition presents arguments based upon rejections made during the examination of the 07/767,297 application. The rejections concerned the variation of FSH proteins isolated from urinary preparations by van Hell et al. It is noted that the biochemical isolation of proteins from urine results in heterogeneous protein populations arising from tissue specific protein production, post-translational and post-secretional processing events, and proteolytic events occurring during biochemical isolation processes. In contrast, Reddy et al's FSH was produced using DNA recombinant technology methods which result in a homogenous protein product.

Therefore, comments made about van Hell et al's heterogeneous FSH isolated by biochemical methods from urine are not relevant to the instant reexamination request which is drawn to homogeneous FSH produced by Reddy et al's recombinant expression system. The van Hell et al and Reddy et al references teach two different FSH products isolated by and made by two different methods that are not combinable. The FSH products differ in their purity and degree of homogeneity. Arpaia et al's claims require a population of heterogeneous FSH alpha and beta chains, which is not raised by the Reddy et al patents.

Similarly, the Petition presents arguments based upon amendments that limit the amount of detectable impurity, lutenizing hormone (LH) in Arpaia et al's FSH. The amendments made to overcome a rejection based upon the level of purity of van Hell et al's FSH produced by biochemical isolation methods, are not relevant to the instant reexamination request, which is drawn to the FSH produced by Reddy et al's recombinant expression system. Van Hell et al's biochemical isolation of proteins from urine raises concerns about purity because urine contains many other types of proteins. In contrast, recombinant expression technology, such as Reddy et al's method for producing FSH, avoid the problems of contaminating hormones by using expression systems devoid of human serum and human urine. Thus the reasoning presented in the Order Denying the Request for the Reexamination does not present a shift in the reasons of allowance of the Arpaia et al patent.

The Petition asserts that the examiner has found that the only difference between the Arpaia et al claims and the Reddy et al patents is the content of beta subunits. This assertion is incorrect. The Order Denying the Request for Reexamination pointed out one difference between the Arpaia et al claims and the Reddy et al patents: FSH comprising the heterogeneous or homogenous beta chains. The Order has shown that this one difference is enough to determine that the Reddy et al documents fail to raise a substantial new question of patentability as to any one of the Arpaia et al claim.

A review of the Order Denying the Request for Reexamination shows that the examiner appreciated the issues raised by the Reexamination Request with respect to the prior art. The instant case has been decided on its particular facts, including other evidence, as referenced in MPEP Section 2242 A.5. Further, the finding of at least one significant difference between the Arpaia claims and the Reddy et al teachings, alone or combined with other references, is the content of beta subunits precludes the finding of a substantial new question of patentability.

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.

Should there be any questions with regard to this decision please contact Julie E. Burke, by letter addressed to the Group Director, Technology Center 1600, Washington, DC 20231, or by telephone at (703) 308-7553 or by facsimile transmission at (703) 305-7939.

John Doll
Director, Technology Center 1600

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.
90/005,942	03/01/2001	5288393	4215-4000	9918

7590 09/20/2002

Gregory F Wirzbicki
C/O Ingrid Impink Unocal Corporation
1150 Connecticut Avenue N W
Suite 1025
Washington, DC 20036

EXAMINER

ART UNIT	PAPER NUMBER

#23

DATE MAILED: 09/20/2002

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
WASHINGTON, D.C. 20231
WWW.USPTO.GOV

Mailed: CST

Paper No. 23

Gregory F. Wirzbicki
C/O Ingrid Impink
Unocal Corporation
1150 Connecticut Avenue, N.W.
Suite 1025
Washington, DC 20036

(for Patent Owner)

Michael S. Marcus
Morgan & Finnegan, L.L.P.
1775 Eye Street, N.W., Suite 400
Washington, DC 20006

(for Third Party)

In re Jessup et al
Reexamination Proceeding
Control No. 90/005,942
Filed: March 1, 2001
For: U.S. Patent 5,288,393

In re Jessup et al
Reexamination Proceeding
Control No. 90/006,295
Filed: May 20, 2002
For: U.S. Patent 5,288,393

DECISION MERGING REEXAMINATION PROCEEDINGS

Decision Merging

The above noted reexamination files are before the Director of Technology Center 1700 for consideration of the proceedings under 37 C.F.R. 1.565(c).

BACKGROUND

1. United States Patent 5,288,393, issued February 22, 1994, is the subject of Reexamination Control Nos. 90/005,942 and 90/006,295.

2. A first request for reexamination, assigned Reexamination Control No. 90/005,942 ('5942), was filed March 1, 2001 by Michael S. Marcus of Morgan & Finnegan, LLP. The request urged that a substantial new question of patentability was raised by the teachings of (a) the GM RFG specifications, in view of the EPA proposed RVP limits; (b) Auto/Oil unleaded gasoline Fuel 1111, in view of the GM RFG specifications and the EPA proposed RVP limits; (c) CRC unleaded gasoline Fuel No. 6, in view of the GM RFG specifications.

3. Reexamination was ordered for '5942 on May 22, 2001.

4. A first Office action for '5942 was mailed on February 12, 2002.

5. Patent owner responded to the first Office action on April 15, 2002 (certificate of mailing April 11, 2002).

6. A second request for reexamination, assigned Reexamination Control No. 90/006,295 ('6295), was filed May 20, 2002 by Michael S. Marcus of Morgan & Finnegan, LLP. The request urged that a substantial new question of patentability was raised by the teachings of (a) SAE Report No. 730836, Fuel C; (b) SAE Report No. 730836, Fuel C, in view of the 1984 Annual Book of ASTM Standards; (c) SAE Report No. 730836, Fuel C, in view of the 1984 Annual Book of ASTM Standards and U.S. Patent 2,818,417 to Brown et al; (d) Fuel 14 of CRC Report No. 461, in view of the 1984 Annual Book of ASTM Standards; (e) Fuel F-1 of SAE Report No. 770811, in view of the 1984 Annual Book of ASTM Standards.

7. A petition to void the '6295 proceeding (for lack of service on patent owner) was filed by the patent owner on June 4, 2002.

8. A "Notice of Service of Replacement Copy" of the present reexamination was then filed by the requester on June 7, 2002.

9. Also on June 7, 2002, the patent owner filed a petition to withdraw patent owner's June 4, 2002 petition.

10. A decision was issued by a Senior Legal Advisor of the Office of Patent Legal Administration on June 14, 2002 returning the two patent owner petitions and retaining the requester paper in the record as an information paper.

11. A petition under 37 CFR 1.182 to deny the second reexamination request was filed by the patent owner on June 24, 2002.

12. A decision was issued by a Senior Legal Advisor of the Office of Patent Legal Administration on July 3, 2002 returning the petition of June 24, 2002.

13. Reexamination was ordered for '6295 on July 3, 2002.

DISCUSSION

Under 37 C.F.R. 1.565(c):

> If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* proceeding has not been terminated, the *ex parte* 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 each of the above reexamination proceedings. Accordingly, merger of the proceedings under 37 C.F.R. 1.565(c) is appropriate. MPEP 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 90/005,942 and 90/006,295 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. Since the claims are the same in both files, a "housekeeping amendment" is NOT needed. See MPEP 2283, "Merger of Reexaminations."

III. CONDUCT OF MERGED PROCEEDING

The reexamination files shall be forwarded to the examiner for consideration of the Request for Reexamination in the '6295 reexamination proceeding, as well as consideration of the RESPONSE TO REJECTION, submitted April 15, 2002 (certificate of mailing April 11, 2002), in the '5942 reexamination proceeding.

All papers mailed by the Office throughout the merged proceeding 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 a signature and identifying data for both files, for entry into each file. All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control Nos. 90/005,942 and 90/006,295 as:

Gregory F. Wirzbicki
C/O Ingrid Impink
Unocal Corporation
1150 Connecticut Avenue, NW
Suite 1025
Washington, D.C. 20036

CONCLUSION

Reexamination Control Nos. 90/005,942 and 90/006,295 are merged. The merged reexamination files are being forwarded to the examiner for preparation of an Office action, to be issued in due course.

Richard V. Fisher

Richard V. Fisher, Director
Technology Center 1700
Chemical and Materials Engineering

UNITED STATES PATENT AND TRADEMARK OFFICE

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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.
90/005,942	03/01/2001	5288393	4215-4000	9918

7590 04/19/2004

Gregory F Wirzbicki
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Washington, DC 20036

EXAMINER	
ART UNIT	PAPER NUMBER

34

DATE MAILED. 04/19/2004

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

90005942 20040419

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COMMISSIONER FOR PATENTS
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ALEXANDRIA, VA 22313-1450
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Mailed:

CST

Paper No. 34

Gregory F. Wirzbicki
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Unocal Corporation
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Washington, DC 20036

(for Patent Owner)

Michael S. Marcus
Morgan & Finnegan, L.L.P.
1775 Eye Street, N.W., Suite 400
Washington, DC 20006

(for Third Party Requester)

In re Jessup et al
Reexamination Proceeding
Control No. 90/005,942
Filed: March 1, 2001
For: U.S. Patent 5,288,393

In re Jessup et al
Reexamination Proceeding

Control No. 90/006,295
Filed: May 20, 2002
For: U.S. Patent 5,288,393

In re Jessup et al
Reexamination Proceeding
Control No. 90/006,683
Filed: June 25, 2003
For: U.S. Patent 5,288,393

DECISION MERGING REEXAMINATION PROCEEDINGS

The above noted reexamination files are before the Director of Technology Center 1700 for consideration of the proceedings under 37 C.F.R. 1.565(c).

BACKGROUND

1. United States Patent 5,288,393, issued February 22, 1994, is the subject of Reexamination Control Nos. 90/005,942, 90/006,295 and 90/006,683.

2. A first request for reexamination, assigned Reexamination Control No. 90/005,942 ('5942), was filed March 1, 2001 by Michael S. Marcus of Morgan & Finnegan, LLP. The request urged that a substantial new question of patentability was raised by the teachings of (a) the GM RFG specifications, in view of the EPA proposed RVP limits; (b) Auto/Oil unleaded gasoline Fuel 1111, in view of the GM RFG specifications and the EPA proposed RVP limits; (c) CRC unleaded gasoline Fuel No. 6, in view of the GM RFG specifications.

3. Reexamination was ordered for '5942 on May 22, 2001.

4. A first Office action for '5942 was mailed on February 12, 2002.

5. Patent owner responded to the first Office action on April 15, 2002 (certificate of mailing April 11, 2002).

6. A second request for reexamination, assigned Reexamination Control No. 90/006,295 ('6295), was filed May 20, 2002 by Michael S. Marcus of Morgan & Finnegan, LLP. The request urged that a substantial new question of patentability was raised by the teachings of (a) SAE Report No. 730836, Fuel C; (b) SAE Report No. 730836, Fuel C, in view of the 1984 Annual Book of ASTM Standards; (c) SAE Report No. 730836, Fuel C, in view of the 1984 Annual Book of ASTM Standards and U.S. Patent 2,818,417 to Brown et al; (d) Fuel 14 of CRC Report No. 461, in view of the 1984 Annual Book of ASTM Standards; (e) Fuel F-1 of SAE Report No. 770811, in view of the 1984 Annual Book of ASTM Standards.

7. A petition to void the '6295 proceeding (for lack of service on patent owner) was filed by the patent owner on June 4, 2002.

8. A "Notice of Service of Replacement Copy" of the present reexamination was then filed by the requester on June 7, 2002.

9. Also on June 7, 2002, the patent owner filed a petition to withdraw patent owner's June 4, 2002 petition.

10. A decision was issued by a Senior Legal Advisor of the Office of Patent Legal Administration on June 14, 2002 returning the two patent owner petitions and retaining the requester paper in the record as an information paper.

11. A petition under 37 CFR 1.182 to deny the second reexamination request was filed by the patent owner on June 24, 2002.

12. A decision was issued by a Senior Legal Advisor of the Office of Patent Legal Administration on July 3, 2002 returning the petition of June 24, 2002.

13. Reexamination was ordered for '6295 on July 3, 2002.

14. A Decision Merging Reexamination Control Nos. 90/005,942 and 90/006,295 was mailed on September 20, 2002.

15. A non-final Office action for the merged proceeding was mailed on December 20, 2002.

16. Patent owner responded to the non-final Office action on March 13, 2003 by filing a Notice of Appeal, an Appeal Brief and a Declaration under 37 CFR 1.132.

17. A third request for reexamination, assigned Reexamination Control No. 90/006,683 ('6683) was filed June 25, 2003 by Michael S. Marcus of Morgan & Finnegan, LLP. The request urged that a substantial new question of patentability was raised by the teachings of (a) the January 17, 1972 Oil and Gas Journal publication describing GM's proposal for reduced emission motor gasoline ("GM-1"), either alone or in view of an August 1987 Notice of Proposed Rule Making published by the EPA concerning, *inter alia*, RVP limits for reduced emission motor gasoline ("the EPA RVP limits") and (b) the October 2, 1972 Oil and Gas Journal publication dscribing a second GM proposal for reduced emissions motor gasoline ("GM-2"), either alone or in view of the May 1973 Adams API publication discussing GM's proposals and/or the EPA RVP limits.

18. Reexamination was ordered for '6683 on September 10, 2003.

DISCUSSION

Under 37 C.F.R. 1.565(c):

> If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* proceeding has not been terminated, the *ex parte* 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 each of the above reexamination proceedings. Accordingly, merger of the proceedings under 37 C.F.R. 1.565(c) is appropriate. MPEP 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 90/005,942, 90/006,295 and 90/006,683 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. Since the claims are the same in both files, a "housekeeping amendment" is NOT needed. See MPEP 2283, "Merger of Reexaminations."

III. CONDUCT OF MERGED PROCEEDING

The reexamination files shall be forwarded to the examiner for consideration of the Request for Reexamination in the '6683 reexamination proceeding, as well as consideration of the Appeal Brief and Declaration under 37 CFR 1.132, submitted March 13, 2003 in the '5942 and '6295 merged reexamination proceeding.

All papers mailed by the Office throughout the merged proceeding 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 a signature and identifying data for all files, for entry into each file.

All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control Nos. 90/005,942, 90/006,295 and 90/006,683 as:

Gregory F. Wirzbicki
C/O Ingrid Impink
Unocal Corporation
1150 Connecticut Avenue, NW
Suite 1025
Washington, D.C. 20036

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control Nos. 90/005,942, 90/006,295 and 90/006,683 as:

Michael S. Marcus
Morgan & Finnegan, L.L.P.
1775 Eye Street, N.W., Suite 400
Washington, DC 20006

Also, until further notice, courtesy copies of all correspondence from the USPTO will be mailed to the California Attorney General's Office at the following address:

Marc N. Melnick
Deputy Attorney General
California Attorney General's Office
1515 Clay Street, 20th Floor
P.O. Box 70550
Oakland, CA 94612-1413.

DO NOT ENTER

CONCLUSION

Reexamination Control Nos. 90/005,942, 90/006,295 and 90/006,683 are merged. The merged reexamination files are being forwarded to the examiner for preparation of an Office action, to be issued in due course.

JMStone

Jacqueline M. Stone
Director, Technology Center 1700
High Polymer Chemistry, Plastics,
Stock Materials and Compositions

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DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
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#7

John C. Altmiller
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1500 K Street NW, Suite 700
Washington DC 20005-1247

(For Patent Owner)

SEP 24 2001

Laurence J. Marhoefer
Venable, Baetjer, Howard & Civiletti, LLP
1201 New York Avenue NW, Suite 1000
Washington DC 2005-3917

(For Requester)

Reexam Control No.: 90/005,698
Filed: April 5, 2000
For: U.S. Patent No. 5,910,104

Reexam Control No.: 90/005,945
Filed: March 2, 2001
For: U.S. Patent No. 5,910,104

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. 90/005,698 was ordered in a decision mailed June 29, 2000. Prosecution progressed through to the filing of an amendment on February 20, 2001.

Reexamination in application Control No. 90/005,945 was ordered in a decision mailed April 23, 2001.

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 requester and requester will be sent copies of all papers mailed by the Office.

Conclusion

Reexamination Control Nos. 90/005,698 and 90/0005,945 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

ak/9/22/01

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.
90/005,698 & 90/005,945	4/5/00 & 3/2/01	5,910,104	11499/1

JOHN C. ALTMILLER
KENYON & KENYON
1500 K STREET NW, SUITE 700
WASHINGTON, DC 20005-1247

EXAMINER	
PEFFLEY, M.	
ART UNIT	**PAPER**
3739	15

DATE MAILED: SEP 12 2003

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

Commissioner of Patents and Trademarks

cc: Laurence J. Marhoefer, 3rd party attorney

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O Box1450
Alexandria, VA 22313-1450
www.uspto.gov

SEP 12 2000

Paper No. 15

In re Application of U.S. Patent No.: 5,910,104
Appl. No.: 90/005,698 & 90/005,945
Filed: April 05, 2000
For: Cryosurgical Probe With Disposable Sheath

DECISION ON PETITION UNDER 37 CFR 1.59

DO NOT ENTER

This is a decision on the petition under 37 CFR 1.59(b), filed May 23, 2000, to expunge information from the above identified application.

The petition is granted.

Petitioner requests that a document consisting of pages 57-147, 148-233, 246-275, and 275-325 of the deposition of Gerald W. Spinks, Esq. Of December 14, 1999, referred to as Cite 181, filed April 5, 2000, be expunged from the record. Petitioner states that 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(h) has been paid.

The information in question has been determined by the undersigned to not be material to the examination of the instant application.

Applicant is required to retain the expunged material(s) for the life of the patent identified above.

The expunged material has been removed from the official file.

Enclosure: Pages 57-147, 148-233, 246-275, and 275-325 of the Deposition of Gerald W. Spinks, Esq. Of December 14, 1999, referred to as Cite 181.

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

ak/9/11/03

90005698 . 091203

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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03 JAN 2002

Paper No. 12

Joseph A. Catanzaro, Esq.
Abelman, Frayne & Schwab
150 East 42nd Street
New York, NY 10017-5612

: For Patent Owner

In re Reexamination
Control No. 90/005,946
U.S. Patent No. 5,749,447
Issued: May 12, 1998
Patent Owner: Rosetti Handbags and Accessories, Ltd.
Request Filed: March 2, 2001

: CORRECTED
: DECISION ON PETITION
: FOR EXTENSION OF TIME

This is a decision on the paper styled as "Request for Extension to File Patent Owner's Statement Under 37 CFR § 1.550(c)". The paper was filed by facsimile transmission and was received on December 17, 2001. The petition contains a request for a one month extension of time.

The petition is GRANTED.

The petition sets forth circumstances which adequately justify the necessity for a one month extension of time. Accordingly, Owner's request for an extension of time in which to file a reply to the Office letter dated October 19, 2001 is granted. Owner's reply to the outstanding Office letter is therefore due on or before January 19, 2002. 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). In no event can the period for filing a reply to the outstanding Office letter be extended more than six months from the date thereof.

This paper corrects a previously mailed version of paper No. 12 which gave an incorrect date for the expiration of the extended period. The previously mailed version should be discarded upon receipt of this paper.

PETITION GRANTED

Stephen Marcus, Special Program Examiner
Examining Groups 3710 and 3720

DO NOT DESTROY

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. 14

Joseph A. Catanzaro, Esq.
Abelman, Frayne & Schwab
150 East 42nd Street
New York, NY 10017-5612

: For Patent Owner

In re Reexamination
Control No. 90/005,946
U.S. Patent No. 5,749,447
Issued: May 12, 1998
Patent Owner: Rosetti Handbags and Accessories, Ltd.
Request Filed: March 2, 2001

: DECISION ON PETITION
: FOR EXTENSION OF TIME

DO NOT ENTER

This is a decision on the paper styled as "Request for Extension Pursuant to 37 CFR 1.550(c)". The paper was filed by facsimile transmission and was received on January 15, 2002. The paper is being construed as a petition by which Owner requests a two month extension of time.

The petition is GRANTED.

A first petition for extension of time was filed on December 17, 2001 and the petition was granted whereby the period for filing a reply to the Office letter dated October 19, 2001 was extended to run through January 19, 2002. Owner now requests an additional extension of time of two months in which to file a reply to the Office letter dated October 19, 2001.

35 USC 305 requires that reexamination proceedings be conducted with special dispatch within the Office. This requirement is implemented by the practice discussed at MPEP § 2265 which requires that all second or subsequent requests for an extension time and all requests for more than a one month extension of time be granted only in extraordinary situations. The present petition sets forth circumstances which adequately justify the necessity for an additional extension of time of two months. Owner's request for an additional extension of two months is based upon the inability of counsel to communicate with either the assignee or with the independent consultant with whom counsel was instructed by the assignee to consult due to the unavailability of those parties until the latter part of February or early to mid-March. The inability of counsel to consult with a client and/or consult with an individual as per instructions by the client is deemed to be an extraordinary circumstance warranting the grant of the requested extension of time.

Accordingly, Owner's request for an additional two month extension of time in which to file a reply to the Office letter dated October 19, 2001 is granted. Owner's reply to the outstanding Office letter is therefore due on or before March 19, 2002. 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) and MPEP § 2265. In no event can the period

for filing a reply to the outstanding Office letter be extended more than six months from the date thereof.

PETITION GRANTED

E. Rollins-Cross, Director
Technology Center 3700

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

#16 (mas)

SEP - 7 2001

SEP 2001

Reexamination Control No. 90/005,743 – Paper No. 16
Reexamination Control No. 90/005,947 – Paper No.'s 9-15

FOR PATENT OWNER:

Whyte, Hirschboeck, Dudek S.C.
111 East Wisconsin Avenue
Suite 2100
Milwaukee, WI 53202

DECISION ON REEXAMINATION MERGER
37 CFR 1.565(c)

Reexam Control Nos. 90/005,743 and 90/005,947

FOR FIRST REQUESTER;

Richard T. Redano
Duane, Morris & Heckscher LLP
One Liberty Place
Philadelphia, PA 19103

FOR SECOND REQUESTER;

J. Dean Lechtenberger
Howrey, Simon, Arnold & White LLP.
750 Bering Drive
Houston, TX 77057

NOTICE OF CONSOLIDATION OF REEXAMINATION PROCEEDINGS

Background

1. U.S. Letters Patent No. 5,865,251 issued on February 2, 1999.

2. A first request for reexamination was filed by a third party requester, Richard T. Redano, on June 9, 2000, and was assigned Reexamination Control No. 90/005,743.

3. Reexamination was ordered in Reexamination Control No. 90/005,743 on August 14, 2000.

4. In Reexamination Control No. 90/005,743 the examiner issued a first Office action on January 23, 2001, rejecting claims 4-11 and indicating claims 1-3 and 12 patentable (sic, confirmed).

5. On March 6, 2001, a second request for reexamination of U.S. Letters Patent No. 5,865,251 was filed by a third party requester, J. Dean Lechtenberger and was assigned Reexamination Control No. 90/005,947.

6. In Reexamination Control No. 90/005,743 the patent owner submitted, on March 23, 2001, an amendment that amended claim 7 and added new claims 13 and 14. On that same date the patent owner also submitted an affidavit under 37 CFR 1.132.

7. Reexamination was ordered in Reexamination Control No. 90/005,974 on June 6, 2001.

8. In Reexamination Control No. 90/005,743 the examiner issued a final Office action on July 31, 2001, rejecting claims 4-11 and indicating claims 1-3 and 12 confirmed.

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. 90/005,743 and 90/005,947 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

As noted above, claim 7 was amended and new claims 13 and 14 added in Reexamination Control No. 90/005,743 in the amendment of March 23, 2001. Patent owner must maintain the same claims and the same description/specification in both files. Therefore, patent owner is required to submit an appropriate "housekeeping" amendment within **ONE MONTH** from the mailing date of this decision, placing the same amendment proffered during the first reexamination proceeding in the second reexamination proceeding, i.e. Reexamination Controol No. 90/005,947. Since the time period for submission of a patent owner's statement has expired, 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 subsequent to the required "housekeeping" amendment 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 a separate complete file. 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. 90/005,743 and 90/005,947 are hereby merged and an Office action will be issued by the examiner for *ex parte* prosecution of the merged proceeding. Appropriate submissions by the patent owner, as set forth above, are required within **ONE MONTH** from the mailing date of this decision.

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
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July 2, 2004

Paper No. 28

Alan E. Wagner
WHYTE HIRSCHBOECK DUDEK S C
555 East Wells Street
Suite 1900
Milwaukee, WI 53202

(For Patent Owner)

Richard T. Redano
DUANE MORRIS & HECKSCHER
One Greenway Plaza
Suite 500
Houston, TX 77046

(For Requester)

J. Dean Lechtenberger
HOWREY SIMON ARNOLD & WHITE LLP
750 Bering Drive
Houston, TX 77057

(For Requester)

In re Rebardi, et al.
Reexamination Proceeding
Control No. 90/005,743
Filed: June 9, 2000
For: U.S. Patent No. 5,865,251

DECISION GRANTING PETITION

In re Rebardi, et al.
Reexamination Proceeding
Control No. 90/005,947
Filed: March 6, 2001
For: U.S. Patent No. 5,865,251

This is a decision on the patent owner petition filed November 26, 2003, for entry of late papers based upon unintentional delay under 37 CFR 1.137(b). Patent owner requests entry of a late-filed reply brief under 37 CFR 1.193(b)(1); and entry of a late-filed request for oral hearing under

37 CFR 1.194(b). The petition is before the Office of Patent Legal Administration for consideration.

The petition fee of $1,330 pursuant to 37 CFR 1.17(m) for the petition under 37 CFR 1.137(b), and the fee for the request for oral hearing of $290 pursuant to 37 CFR 1.17(d), have been charged to the deposit account 23-2053 as authorized in the respective papers.

The petition for entry of late papers based upon unintentional delay is **granted** for the reasons indicated below.

REVIEW OF FACTS

1. On January 31, 2002, patent owner filed a notice of appeal.

2. On March 29, 2002 patent owner filed the appeal brief.

3. On September 10, 2003, the examiner's answer was mailed.

4. Any reply brief and/or request for oral hearing was due no later than November 10, 2003.

5. On November 26, 2003, the following papers were filed by the patent owner:

   a. a reply brief under 37 CFR 1.193(b)(1);

   b. a request for oral hearing under 37 CFR 1.194(b); and,

   c. a petition for entry of late papers based upon unintentional delay under 37 CFR 1.137(b).

DECISION

Under 37 CFR 1.193(b)(1), patent owner may file a reply brief as a matter of right within two months from the mailing date of the examiner's answer. Extensions of time to file the reply brief may be granted pursuant to 37 CFR 1.550(c). MPEP 1208.03. Further, 37 CFR 1.194(b) provides that a patent owner who desires an oral hearing before the Board of Patent Appeals and Interferences (Board) must request the oral hearing within two months after the date of the examiner's answer. This time period may only be extended by filing a request for extension under 37 CFR 1.550(c). MPEP 1209.

Under 37 CFR 1.550(c):

> "The time for taking any action by a patent owner in an ex parte 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)."

Under the rules, the time for filing a reply brief and the time for filing a request for oral hearing may be extended. Under 37 CFR 1.550(c), however, a request for an extension of time for filing either or both papers must be filed before the expiration of the two-month period. As noted in the above review of facts, the reply brief and the request for oral hearing which were due no later than November 10, 2003, were filed on November 26, 2003, sixteen days after the due date. No request for extension of time was filed. On the same date (sixteen days from the due date), patent owner requested, by petition, acceptance and entry of the late papers under the unintentional delay standards of 37 CFR 1.137(b).

Under 37 CFR 1.550(e)(2):

> "(e) If a response by the patent owner is not timely filed in the Office, . . .
>
> (2) The response may nevertheless be accepted if the delay was unintentional; a petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b)."

As noted, 37 CFR 1.550(e)(2) provides an avenue of relief for the patent owner when a paper is not timely filed. The paper may be accepted under the guidelines of an unintentionally delayed response set forth in 37 CFR 1.137(b).

A grantable petition under 37 CFR 1.137(b) must be accompanied by:

(1) the paper for which the delay is to be excused, 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 paper from the due date for the paper until the filing of a grantable petition pursuant to 37 CFR 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 CFR 1.137(b) was unintentional, the Director may require additional information. See MPEP 711.03(c)(III)(C) and (D). In view of the fact that the petition was promptly filed sixteen days after the due date, no exceptional circumstances are seen which would indicate the need for any additional information.

In the present instance:

1. The reply brief to the Examiner's Answer of September 10, 2003, and the request for oral hearing have been received.

2. The petition is accompanied by the petition fee.

3. A statement is contained in the present petition which is being construed as the statement required by 37 CFR 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 the late papers is sufficient to meet the criteria set forth under 37 CFR 1.137(b). Accordingly, the papers will be accepted under the provisions of 37 CFR 1.550(e)(2).

CONCLUSION

1. The petition is **granted**.

2. The reply brief will be entered as timely filed. The reexamination file will be forwarded to Technology Center 3600 for consideration of the reply brief.

3. The request for oral hearing will be entered as timely filed. It is to be noted that this decision only excuses the delay (pursuant to 37 CFR 1.550(e)(2)) as to the filing of the request for oral hearing under 37 CFR 1.194(b). This decision does not address nor decide whether an oral hearing is necessary. That determination remains at the Board's discretion under 37 CFR 1.194(c) (last sentence).

4. Further inquiries with regard to this reexamination proceeding should be directed to the examiner, Hoang Dang, of Group Art Unit 3672.

5. Telephone inquiries with regard to this decision should be directed to the undersigned at (703) 308-5107.

Robert J. Spar
Director
Office of Patent Legal Administration

C:\zJerry\90_5743-5947 reply brief accepted via unintentional copy A wpd

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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OCT 16 2002

Reexamination Control No. 90/005,948 – Paper No. 18
Reexamination Control No. 90/006,251 – Paper No. 17

MAILED

OCT 16 2002

Office of the Director
Group 3600

FOR PATENT OWNER:

Sean V. O'Connell
McKinney & Stringer, P.C.
101 North Robinson
Oklahoma City, OK 73102

DECISION ON REEXAMINATION MERGER
37 CFR 1.565(c)

Reexam Control Nos. 90/005,948 and 90/006,251

FOR REQUESTER;

David G Schmaltz
Merchant & Gould
P.O. Box 2903
Minneapolis, MN 55402-0903

NOTICE OF CONSOLIDATION OF REEXAMINATION PROCEEDINGS

Background

1. U.S. Letters Patent No. 6,058,852 issued on July 11, 2000.

2. A first request for reexamination was filed by the requester, Vermeer Manufacturing Company, on March 6, 2001 and was assigned Reexamination Control No. 90/005,948.

3. Reexamination was ordered in Reexamination Control No. 90/005,948 on May 18, 2001.

4. On December 7, 2001 the examiner issued a first Office action in Reexamination Control No. 90/005,948 and set a one month period for response.

5. On December 20, 2001 patent owner requested an extension of time to respond for one month which was granted on December 28, 2001.

6. On February 15, 2002 (Certificate of Mail date February 7, 2002), patent owner filed a response in Reexamination Control No. 90/005,948 to the Office action of December 7, 2001. In that response, claims 223, 224, 232, 233, 237, 240, and 244 were amended.

7. On March 19, 2002, a second request for reexamination of U.S. Letters Patent No. 6,058,852 was filed by the same requester and was assigned Reexamination Control No. 90/006,251.

8. On May 20, 2002, reexamination was ordered in Reexamination Control No. 90/006,251.

9. On July 23, 2002, patent owner informed the examiner that no patent owner's statement had been filed in Reexamination Control No. 90/006,251.

Discussion

Under 37 CFR 1.565(c):

> If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* reexamination proceeding has not been terminated, the *ex parte* 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 the second reexamination proceeding while the first reexamination proceeding was pending. Accordingly, consolidation of the second reexamination proceeding with the first reexamination proceeding 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. 90/005,948 and 90/006,251 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

As noted above, patented claims 223, 224, 232, 233, 237, 240, and 244 were amended in reexamination proceeding 90/005,948 by the amendment filed on February 15, 2002. In accordance with the rules for merged reexamination proceedings, patent owner must maintain the same claims and the same description/specification in both reexam files. Therefore, patent owner is required to submit an appropriate "housekeeping" amendment within **ONE MONTH** from the mailing date of this decision, placing the same

amendment proffered during the first reexamination proceeding in the second reexamination proceeding, i.e., in Reexamination Control No. 90/006,251. Since the patent owner did not file a patent owner's statement, no reply or other submission by the requester will be considered in the merged reexamination proceeding or in Reexamination Control No. 90/006,251.

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 a separate complete file. 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. 90/005,948 and 90/006,251 are hereby merged and an Office action will be issued by the examiner for *ex parte* prosecution of the merged proceeding. Appropriate submissions by the patent owner, as set forth above, are required within **ONE MONTH** from the mailing date of this decision.

Randolph A. Reese
Special Programs Examiner
Technology Center 3600
(703)308-2121

Concur:
Jerry Goldberg
Director
Technology Center 3600

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

EXAMINER

WM41/0908

JEFFREY INGERMAN
FISH AND NEAVE
1251 AVENUE OF THE AMERICAS
NEW YORK NY 10020-1104

ART UNIT	PAPER NUMBER
BARNIE, R	21
2643	

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
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Paper No. 28

Jeffrey H. Ingerman (Patent Owner)
FISH & NEAVE
1251 Avenue of the Americas
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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

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

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 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.
90/005,954	03/16/01	5585258	0125-0106

HM11/0702

ALISA A HARBIN
CHIRON CORPORATION
INTELLECTUAL PROPERTY R440
P O BOX 8097
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EXAMINER	
PROUTY,R	
ART UNIT	**PAPER NUMBER**
1652	8

DATE MAILED: 07/02/01

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

Commissioner of Patents and Trademarks

PTO-90C (Rev 11/00)

1- File Copy

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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

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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.

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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MAY 24 2001

Paper No. 12

Donald J. Perreault *et al*
Hayes, Soloway, Hennessey, Grossman and Hag
175 Canal Street
Manchester, NH 03101

(For Patent Owner)

Peter C. Knops
Lathrop & Gage, LC
2345 Grand Boulevard
Suite 2800
Kansas City, MO 64108

(For Requester)

In re Howard J. Dananberg, D.P.M.
Reexamination Proceeding
Control No. 90/005,839
Filed: October 5, 2000
For: U.S. Patent No. 4,597,195

DECISION, *SUA SPONTE*,
MERGING REEXAMINATION
PROCEEDINGS

In re Howard J. Dananberg, D.P.M.
Reexamination Proceeding
Control No. 90/005,955
Filed: March 19, 2001
For: U.S. Patent No. 4,597,195

90005955, 05/24/2001

The above noted reexamination files are before the Director of Patent Examining Group 3720 for consideration of merger of the proceedings under 37 CFR 1.565(c), in accordance with the practice set forth at MPEP § 2283.

I. Merger of Proceedings

As required by the practice pursuant to MPEP § 2283, and under the authority of 37 CFR 1.565(c), the '736 and '751 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

Patent 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. 12 in both files. There will be no Paper Nos. 7-11 in Control No. 90/005,955. Any

reply to the examiner's action dated May 3, 2001 as promulgated in reexamination control number 90/005,839 must be filed in duplicate, each copy bearing an original signature, with one copy directed to each reexamination proceeding. That reply will be Paper No. 13 in both files. The reply must also serve to place the same claims and specification in both files, including any amendments made in response to the May 3, 2001 action as well as any changes which have previously been made in the earlier filed proceeding which have not yet been made in the later filed proceeding.

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. Requester will receive the body of the action, with the appropriate cover sheet(s), while Owner will receive the body of the action and a copy of each cover sheet. All papers filed by Owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by Owner must consist of a single response, filed in duplicate, each bearing an original signature, for entry in each file. Owner is reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on Requester, even papers filed *via* facsimile transmission.

Ex parte prosecution pursuant to 37 CFR 1.550 and 1.552 commenced in reexamination proceeding 90/005,839, and will resume in the event that a reply to the above mentioned examiner's action is timely filed, in accordance with Section II, *supra*. Failure to file a reply will result in termination of the merged proceedings and issuance of an appropriate Notice of Intent to Issue Reexamination Certificate, which will in turn result in the publication of a single Reexamination Certificate for this merged proceeding. The Primary Examiner should note that each reexamination file must reflect consideration of the identical prior art, and must, therefore, insure that each file reflects identical reference citations.

Owner is reminded of the continuing duty to inform the Office of changes in the status of any litigation involving the patent undergoing reexamination.

E. Rollins-Cross, Director, Patent
Examining Groups 3210 & 3720

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www uspto gov

#9

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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

In re Joram Agar
Reexamination Proceeding
Control No. 90/005,961
Filed: March 23, 2001
For U.S. Patent No. 5,101,367

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. 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.

90005961 "05/25/05

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.

90005961, 06/05/2002

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 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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#9

Paper No. 33/9

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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

In re Joram Agar
Reexamination Proceeding
Control No. 90/005,963
Filed: March 27, 2001
For U.S. Patent No. 5,263,363

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. 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

90005963 - 05/23/05

UNITED STATES PATENT AND TRADEMARK OFFICE

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WASHINGTON, D.C. 20231
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January 10, 2002

#14

Albert P. Halluin
Howrey Simon Arnold & White, LLP
301 Ravenswood Avenue, Box No. 34
Menlo Park, CA 94025

(For Patent Owner)

In re Jacobus et al.
Reexamination Proceeding
Control No. 90/005,969
Filed: April 2, 2001
For: U.S. Patent No. 5,763,447

: PETITION TO WITHDRAW
: NIRC AND TO ENTER
: AMENDMENT DENIED

This is a decision on the December 18, 2001, petition filed by the patent owner under 37 CFR § 1.313(a). Patent owner requests the Commissioner to withdraw the Notice of Intent to Issue a Reexamination Certificate of November 6, 2001 (NIRC), and enter an amendment to the claims in view of a U.S. patent cited in a concurrently filed Information Disclosure Statement. The petition is before the Office of Patent Legal Administration.

For the reasons set forth below, the petition is denied.

BACKGROUND

1. On April 2, 2001, the patent owner filed a request for reexamination of U.S. Patent No. 5,763,447. One of the inventors of the '447 patent is Karia M. Jacobus. The assignee is Inspire Pharmaceuticals. The attorney listed on the patent is Albert P. Halluin. The reexamination was filed in view of a single U.S. Patent No. 5,635,160 to Stutts et al.

2. Reexamination was ordered on June 13, 2001.

3. On July 10, 2001, an interview was conducted with the examiner during which the Stutts '160 patent was discussed. No other patents were discussed.

4. On July 11, 2001, the patent owner filed a statement under 37 CFR 1.530 in which only the Stutts '160 patent was discussed.

5. On November 6, 2001, the examiner issued a NIRC allowing all of the claims over the Stutts '160 patent. Prosecution on the merits was closed.

6. On December 18, 2001, patent owner filed an Information Disclosure Statement (IDS) submitting U.S. Patent No. 5,962,432. One of the inventors of the '432 patent is Karia Jacobus. The assignee is Inspire Pharmaceuticals. The attorney listed on the patent is Albert P. Halluin. In the IDS patent owner reserves the right to prove that the reference may not be prior art to the '447 patent.

7. On December 18, 2001, patent owner filed an amendment to the claims stating that the amendments are necessary in view of the newly submitted '432 reference.

8. On December 18, 2001, patent owner filed a petition requesting the Commissioner to withdraw the NIRC and enter the proposed amendment to the claims in view of the newly submitted '432 reference patent cited in a concurrently filed Information Disclosure Statement. Patent owner states the '432 patent is "pertinent" to the claims allowed in the reexamination.

DECISION

The petition received on December 18, 2001, was filed under 37 CFR § 1.313(a). Because reexamination proceedings are not applications, and the rules do not provide for an amendment to be filed in a reexamination proceeding after prosecution on the merits has been closed, petitioner's relief, if any, is appropriate under 37 CFR § 1.182. See MPEP 2287. Accordingly, the petition has been addressed under 37 CFR § 1.182.

The reexamination statute permits any person at any time to request the United States Patent and Trademark Office to reexamine, with special dispatch, any claim of a patent in view of a prior art patent or printed publication which raises a substantial new question of patentability. A purpose of reexamination is to have the examiner consider all of the prior art known at the time of the filing of the reexamination request and any prior art discovered prior to conclusion of the examination by the examiner. After a complete consideration of all the known prior art and resolution of all other issues, the examiner must close the prosecution on the merits and forward the reexamination file for publication of a reexamination certificate based on the prior art considered. Once the prosecution on the merits has been closed and the NIRC has been mailed, absent extraordinary circumstances or compelling reasons, no further prior art patent or printed publication is considered in the reexamination proceeding. The certificate will issue showing the results of the concluded reexamination in view of the prior art present and considered during the reexamination. A new request for reexamination may be filed based on any prior art patent or printed publication discovered after the examination in the current reexamination has been closed.

No extraordinary circumstances or compelling reasons are seen which would warrant reopening of prosecution and consideration of the submitted amendments and the newly submitted reference patent. Patent owner has at this late date in the proceeding presented proposed amendments to some of the claims based on a patent that could have been brought to the

attention of the examiner at an earlier stage of the proceeding. In this regard the patent owner had the opportunity to present the reference patent at the time the request for reexamination was received, during the interview with the examiner, and at the time the statement was filed. Patent owner chose not to do so. Patent owner cannot be heard to say that the existence of the patent was not known because, as noted above, one of the inventors, the assignee, and the attorney of record are common to both the patent under reexamination and the newly tendered reference patent. Further in this regard, an assertion that patent owner failed to realize the scope of the reference patent would not warrant reopening the prosecution of the present reexamination and delaying the issuance of the reexamination certificate.

It is further noted that petitioner has not positively stated that the newly tendered reference patent is prior art to the patent under reexamination. To the contrary, in the IDS patent owner specifically reserves the right to prove that this information may not be prior art. As noted above, both patents have a common assignee who is in a position to know, at this time, whether the reference patent is prior art. A request that examination be reopened to consider a reference which may not be prior art does not present extraordinary circumstances or compelling reasons which would warrant reopening of prosecution.

In view of all of the above, the petition is denied. The reexamination file will be forwarded for publication of the reexamination certificate based on the record at the time of the NIRC.

Should patent owner desire to have the Patent and Trademark Office consider the patentability of the patent claims in view of the proposed reference patent, a new request for reexamination may be filed at any time.

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
Office of the Deputy Commissioner
for Patent Examination Policy

H:\JERRY\90_5969 no amendment after NIRC.wpd

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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NOV 26 2001

Reexamination Control No. 90/005,811 – Paper No. 13
Reexamination Control No. 90/005,970 – Paper No. 13

MAILED

NOV 26 2001

Office of the Director
Group 3600

FOR PATENT OWNER:

Rick Martin
Law Offices of Rick Martin, P.C.
416 Coffman Street
Longmont, CO 80501

DECISION ON REEXAMINATION MERGER
37 CFR 1.565(c)

Reexam Control Nos. 90/005,811 and 90/005,970

FOR REQUESTER;

Thomas J. Edgington, Esq..
Kirkpatrick & Lockhart LLP
Henry W. Oliver Building
535 Smithfield Street
Pittsburgh, PA 15222-2312

NOTICE OF CONSOLIDATION OF REEXAMINATION PROCEEDINGS

Background

1. U.S. Letters Patent No. 5,956,916 issued on September 28, 1999.

2. A first request for reexamination was filed by the patent owner on September 5, 2000, and was assigned Reexamination Control No. 90/005,811.

3. Reexamination was ordered in Reexamination Control No. 90/005,811 on October 31, 2000. The order set a shortened statutory period of two months for the submission of patent owner's statement under 37 CFR 1.530(b).

4. On December 26, 2000 patent owner filed an owner's statement in Reexamination Control No. 90/005,811.

5. On March 6, 2001 the examiner issued a first Office action in Reexamination Control No. 90/005,811 in which claims 1-27 were rejected.

6. On March 6, 2001, patent owner filed a response in Reexamination Control No. 90/005,811 to the Office action of March 6, 2001. This response included amendments to patented claims 1, 4, 6, 7, 11, 14, 18, 21, 22, and 27 and added new claims 28-47. For some reason this response was not matched with the reexamination file. On June 8, 2001 patent owner submitted a copy of the response by facsimile transmission including evidence in the form of a date stamped post card showing that the response had, in fact, been received in the Office on March 6, 2001. In a letter dated June 25, 2001, the proceeding was reinstated based upon the evidence submitted.

7. On April, 2, 2001, a second request for reexamination of U.S. Letters Patent No. 5,956,916 was filed by a third party requester, Dietrich Industries, Inc., and was assigned Reexamination Control No. 90/005,970.

8. On May 16, 2001, reexamination was ordered in Reexamination Control No. 90/005,970. The Order set a shortened statutory period of two months for the submission of a patent owner's statement under 37 CFR 1.530(b).

9. On June 11, 2001 the patent owner submitted an owner's statement and an amendment which included amendments to patented claims 1, 4, 6, 7, 11, 14, 18, 21, 22, and 27 and added new claims 28-47 in Reexamination Control No. 90/005,970.

10. On July 9, 2001 the Office received verification in the form of a Certificate of Service in Reexamination Control No. 90/005,970 which indicated that requester had been served with a copy of the owner's statement (the June 11, 2001 paper) on July 5, 2001.

11. On July 11, 2001 a Notice of Defective Paper was mailed to patent owner indicating that the amendments included with the owner's statement in Reexamination Control No. 90/005,970 did not comply with 37 CFR 1.530(d) and giving patent owner one month to correct the deficiency by filing a proper amendment.

12. On July 27, 2001 a Notice of Defective Paper was mailed to patent owner indicating that the amendments submitted in Reexamination Control No. 90/005,811 did not comply with 37 CFR 1.530(d) and giving patent owner one month to correct the deficiency by filing a proper amendment.

13. On July 30, 2001 patent owner submitted an amendment in Reexamination Control No. 90/005,970 that corrected the deficiencies noted in the Notice of Defective Paper. The remarks included with this amendment are the same as the remarks made in the original owner's statement of July 11,2001.

14. On August 11, 2001 patent owner submitted an amendment in Reexamination Control No. 90/005,811 that corrected the deficiencies noted in the Notice of Defective Paper. Several minor errors in the July 30, 2001 amendment filed in

Reexamination Control No. 90/005,970 were noted in the remarks of this amendment. These errors were the failure to underline "floor" in lines 3 and 4 of claim 27. Three additional errors were noted by the examiner—"floor" in line 1 of claim 6 in both reexamination proceedings and "floor" in line 4 of claim 27 in Reexamination Control No. 90/005,811 were also not underlined. See "Requirements for Same Amendments in All Files" under Decision below for the manner in which these errors are to be corrected.

15. On August 30, 2001 requester submitted a reply to patent owner's statement in Reexamination Control No. 90/005,970.

Discussion

Under 37 CFR 1.565(c):

> If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* reexamination proceeding has not been terminated, the *ex parte* 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 the second reexamination proceeding while the first reexamination proceeding was pending. Accordingly, consolidation of the second reexamination proceeding with the first reexamination proceeding 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. 90/005,811 and 90/005,970 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

As noted above, patented claims 1, 4, 6, 7, 11, 14, 18, 21, 22, and 27 were amended in both reexamination proceedings and new claims 28-47 were added in both reexamination proceedings. The identical claims being in both files, there is no need for a housekeeping amendment. However, patent owner is reminded that the same claims and the same description/specification must be maintained in both files. As for the errors noted in Item 14 of the "Background", the three instances where "floor" was not underlined in Reexamination Control No. 90/005,970 and the two instances where "floor" was not underlined in Reexamination Control No. 90/005,811 are considered to be so minor in nature that it has been deemed unnecessary for patent owner to file a housekeeping amendment to correct them. Instead, underlining has been provided by the examiner in

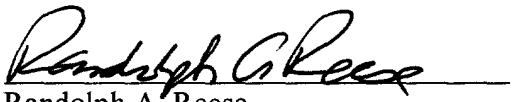
the five instances noted. In each case, the examiner has initialed and dated the changes in the margin next to the actual amendment. From this point, prosecution will proceed *ex parte*. No submission by the requester will be considered in the merged reexamination proceeding .

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 a separate complete file. 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. 90/005,811 and 90/005,970 are hereby merged and in due course an Office action will be issued by the examiner for *ex parte* prosecution of the merged proceeding.



Randolph A. Reese
Special Programs Examiner
Technology Center 3600
(703)308-2121

Concur:

Al Lawrence Smith,
Director
Technology Center 3600

Page 4 of 5 90005811

#19 (mas)

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 Nos. 90/005,811 & 90/005,970

FOR PATENT OWNER:

Dorsey & Whitney, LLP
Intellectual Property Department
370 Seventeenth Street
Suite 4700
Denver, CO 80202-5647

FOR REQUESTER:

Thomas J. Edgington Esq.
Kirkpatrick & Lockhart LLP
Henry W. Oliver Building
535 Smithfield Street
Pittsburgh, PA 15222-2312

DECISION ON PETITION FOR THE ACCEPTANCE OF LATE PAPERS

MAILED
SEP 29 2003
REEXAM UNIT

This is in reply to petitioner's Petition for the Acceptance of Late Papers filed February 24, 2003 and supplemented on April 22, 2003. There is no fee required for this petition.

The petition is **GRANTED**.

A review of the above reexamination file indicates that the Amendment and affidavits under 37 CFR 1.132 submitted on September 17, 2002 were never received by the Office. The patent owner has submitted a copy of the amendment and affidavits along with a copy of the post card receipt having a receipt date stamp date of September 17, 2002. This is acceptable evidence of a timely filing of the amendment and affidavits.

The reexamination file is being forwarded to the Supervisory Legal Instruments Examiner for entry of the amendment and affidavits filed September 17, 2002, and then to the examiner for prompt consideration of the amendment and affidavits. The papers which accompanied the petition (i.e., the Power of Attorney, statement under 37 CFR 3.73(b), Change of Address, and Certificate of Service for all these papers) will also be entered.

Kenneth J. Dorner, Special Programs Examiner
Patent Technology Center 3600
(703) 308-0866
Facsimile No.: (703) 605-0586

Kjd: 5/20/03

cc: Requester

05/20/2003

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

Reexamination Control Nos. 90/005,811 & 90/005,970

MAILED
FROM DIRECTORS OFFICE

FEB 15 2005

TECHNOLOGY CENTER 3600

Dorsey & Whitney, LLP (For Patent Owner)
Intellectual Property Department
370 Seventeenth Street
Suite 4700
Denver, CO 80202-5647

Thomas J. Edgington, Esq. (For Requestor)
Kirkpatrick & Lockhart LLP
Henry W. Oliver Building
535 Smithfield Street
Pittsburgh, PA 15222-2312

REQUEST FOR EXTENSION OF TIME
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 November 23, 2004.

An Office action was mailed on November 2, 2004 wherein a shortened statutory period for response of one month was set. Patent Owner requests an extension of time of one month to submit a response to the November 2, 2004 Office action. The reason for the request is that affidavits would be useful in responding to the Office action and the collection of facts and testimony for the affidavits would extend beyond the December 2, 2004 deadline for response.

An extension of time for the Patent Owner to submit a response is granted for a period of one month. The period for response will expire on January 2, 2005.

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**.

Kenneth J. Dorner
Special Programs Examiner
Technology Center 3600
(703)308-0866

Concur:
John J. Love, Director
Technology Center 3600
(703) 308-1020

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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WASHINGTON, D.C 20231
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Paper No. 14

Gerard T. Gallagher
BAKER & DANIELS
205 West Jefferson Blvd.
Suite 250
South Bend, IN 46601

(For Patent Owner)

MAILED

JUL 17 2002

REEXAM UNIT

In re Reexamination Proceeding
Control No. 90/005,973
Filed: April 5, 2001
For: U.S. Patent No. 5,295,430
Patentee: Dewald, Jr. et al.

DECISION GRANTING PETITION

This is a decision on the patent owner PETITION UNDER 37 C.F.R. § 1.137(b) of May 30, 2002, for the entry of late papers on the grounds of unintentional delay, requesting the entry of the late filed response to the non-final Office action of September 18, 2001. A petition fee under 37 C.F.R. § 1.17(m) of $1280.00, for the reexamination proceeding has been paid by check. 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 patent owner previously filed the reply required by 37 C.F.R. § 1.137(b)(1) on March 18, 2002, as part of a late response to

the outstanding Office action of September 18, 2001. The petition of May 30, 2002, was accompanied by the petition fee, in compliance with 37 C.F.R. § 1.137(b)(2), and 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 under 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 response to the non-final Office action.

3. Any further communications as to the merits of the reexamination proceeding should be directed to the patent examiner, Thomas E. Lazo, in Group Art Unit 3745.

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

July 16, 2002

Application/Control Number: 90/005,973

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.
90/005,974	04/05/01	6016317	

EXAMINER	
TOM, J	
ART UNIT	PAPER NUMBER
2661	14

DATE MAILED: 07/30/01

WM41/0730

MARK F. CONTOIS
CARTER, LEDYARD & MILBURN
1401 I STREET, N.W.
SUITE 300
WASHINGTON DC 20005

REEXAMINATION COMMUNICATION

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE ONE MONTH(S) FROM THE DATE OF THIS LETTER. EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).

RECEIVED
AUG 06 2001
TECHNOLOGY CENTER 2600

cc: Requester

UNITED STATES PATENT AND TRADEMARK OFFICE

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WASHINGTON, D.C. 20231
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Paper No. 14

Mark Comtois CARTER, LEDYARD, MILBURN 1401 I Street, NW Suite 300 Washington, D.C. 20005	)	FOR OWNER
Richard E. Campbell KNOBBE, MARTENS, OLSON & BEAR, LLP 550 W. C Street, Suite 1200 San Diego, CA 92101	)	FOR THIRD PARTY REQUESTER
In re Foster, Jr. et al. Reexamination Proceeding. Control No. 90/005726 Filed: May 15, 2000 For: U.S. Patent No. 6,016,313	)	DECISION SUA SPONTE, MERGING REEXAMINATION PROCEEDINGS
In re Foster, Jr. et al. Reexamination Proceeding Control No. 90/005974 Filed: April 5, 2001 For: U.S. Patent No. 6,016,313	)	

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. 6,016,313 issued on January 18, 2000.

2. A first request for reexamination, Control No. 90/005726 ('726) was filed by the Third Party Requester on May 15, 2000.

3. Reexamination was ordered in the '726 reexamination proceeding on August 1, 2000.

4. A first Office action was mailed on December 4, 2000 in the '726 reexamination proceeding rejecting claims 1-86 (all pending claims).

5. Interviews in the'726 reexamination proceeding were held on February 13, 2001 and February 28, 2001.

6. A response to the first Office Action in the '726 reexamination proceeding was filed on March 5, 2001.

7. A second request for reexamination, Control No. 90/005974 ('974) was filed by the Third Party Requester on April 5, 2001.

8. Reexamination was ordered in the '974 reexamination proceeding on June 4, 2001.

9. A Change of Correspondence Address for the Patent Owner was filed in both reexamination proceedings on June 20, 2001.

10. A Change of Correspondence Address for the Third Party Requester was filed in the '726 reexamination proceeding on July 19, 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 '726, and '974 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 Proceedings

The Patent Owner is required to maintain the same claims and specification in both files. Since the files do not maitain the same claims and/or specification, a "housekeeping" amendment is required to be submitted within **ONE MONTH** of this decision. Any discussion of the merits or issues of the proceedings within the housekeeping amendment 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.

Both files will be maintained as separate complete files and 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 addressed to both files and 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.

Jin F. Ng, Director
Technology Center 2600
Communications

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
90/005,975	04/05/2001	6190018	E001-ASP	5820

7590 05/23/2002

RICHARD L. WOOD
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120 SOUTH RIVERSIDE PLAZA, 22ND FLOOR
CHICAGO, IL 60606

EXAMINER
NEILS

ART UNIT	PAPER NUMBER
2875	16

DATE MAILED: 05/23/2002

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

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address COMMISSIONER OF PATENTS AND TRADEMARKS
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,160	12/19/2001	6190018	32405-177391	4328

7590 05/23/2002

RICHARD L. WOOD
WELSH & KATZ, LTD.
120 SOUTH RIVERSIDE PLAZA, 22ND FLOOR
CHICAGO, IL 60606

EXAMINER	
NEILS	
ART UNIT	PAPER NUMBER
2875	7

DATE MAILED: 05/23/2002

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90006160 * 05/23/2002

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Washington, D.C. 20231
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Paper No. 7/16

Richard L. Wood (For Patent Owner)
WELSH & KATZ. LTD.
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Stephen J. Holmes (For Third Party Requester)
BARLOW, JOSEPH & HOLMES, LTD.
101 Dyer Street, 5th Floor
Providence, RI 02903

Robert Kinberg (For Third Party Requester)
VENABLE
P.O. Box 34385
Washington, D.C. 20043-9998

In re Kevin L. Parson et al.
Reexamination Proceeding
Control No. 90/005,975
Filed: April 5, 2001
For U.S. Patent No. 6,190,018 B1

In re Kevin L. Parson et al.
Reexamination Proceeding
Control No. 90/006,160
Filed: December 19, 2001
For U.S. Patent No. 6,190,018 B1

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. 6,190,018 B1 issued on February 20, 2001.

2. A first request for reexamination, Control No. 90/005,975, was filed by the first third party on April 5, 2001.

3. Reexamination was ordered on May 18, 2001.

4. A non-final Office action was mailed on November 26, 2001.

5. A request for resetting the period for response due to late receipt of the non-final Office action was filed on December 14, 2001.

6. A decision granting the request was mailed on January 8, 2002, resetting of the period for response to run two (2) months from December 12, 2001.

7. A second request for reexamination, control No. 90/006,160, was filed by a second third party requester on December 19, 2001.

8. A personal interview was held on February 7, 2002, for the '975 reexamination proceeding.

9. A revocation and power of attorney by the assignee was received on February 7, 2002, for the '975 reexamination proceeding.

10. A response and a supplemental response to the Office action and an information disclosure statement were submitted on February 12, 2002, for the '975 reexamination proceeding. No claim has been amended.

11. Reexamination control No. 90/006,160 was ordered on March 6, 2002,

12. A second supplemental response was filed May 9, 2002, via facsimile transmission, in the '975 reexamination proceeding. No claim has been amended.

13. A notice from the patent owner was filed on May 9, 2002, via facsimile transmission,

90005975 20020506

waiving the right to file a patent owner's statement pursuant to 37 C.F.R. § 1.530(b) in the '160 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. <u>Merger proceedings</u>.

In accordance with 37 C.F.R. § 1.565(c), the '5975 and '6160 reexamination proceedings are <u>merged</u>. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

\III. <u>Conduct of Merged Proceeding</u>.

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 triplicate, each bearing an original signature, for entry in 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.

CONCLUSION

Reexamination Control Nos.'5975 and '6160 are merged. The application is being forwarded to the examiner for preparing an Office action.

Henry Phan for

Janice A. Falcone, Group Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

90005975.050902

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

ROBERT KINBERG
VENABLE
P.O. BOX 34385
WASHINGTON, DC 20043-9998

REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/006160

PATENT NO. 6,190,018

ART UNIT 2875

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).

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UNITED STATES PATENT AND TRADEMARK OFFICE
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STEPHEN J. HOLMES, ESQ.
BARLOW, JOSEPHS & HOLMES, LTD.
101 DYER STREET,
5TH FLOOR
PROVIDENCE, RI 02903.

REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/005,975*.

PATENT NO. *6,190,018* .

ART UNIT *2875*.

Enclosed is a copy of the latest communication from the Patent and Trademark Office in the above identified reexamination proceeding (37 CFR 1.550 (e)).

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 reexamination requester will be acknowledge or considered (37 CFR 1.550 (e)).

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
90/005,975	04/05/2001	6190018	E001-ASP	5820

7590 03/03/2003

RICHARD L. WOOD
WELSH & KATZ, LTD.
120 SOUTH RIVERSIDE PLAZA, 22ND FLOOR
CHICAGO, IL 60606

EXAMINER
NEILS

ART UNIT	PAPER NUMBER
2875	27

DATE MAILED: 03/03/2003

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

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
90/006,160	12/19/2001	6190018	32405-177391	4328

7590 03/03/2003

RICHARD L. WOOD
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EXAMINER
NEILS

ART UNIT	PAPER NUMBER
2875	27

DATE MAILED: 03/03/2003

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

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UNITED STATES DEPARTMENT OF COMMERCE
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Washington, D C 20231
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO.
90/006,445	11/07/2002	6190018	E001-ASP2	8526

7590 03/03/2003

Richard L. Wood
Welsh and Katz, Ltd.
120 South Riverside Plaza 22nd Floor
Chicago, IL 60606

EXAMINER	
NEILS	
ART UNIT	PAPER NUMBER
3875	8

DATE MAILED: 03/03/2003

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Paper No. 27/8

Richard L. Wood (For Patent Owner)
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Stephen J. Holmes (For Third Party Requester)
Mark E. Tetreault
BARLOW, JOSEPH & HOLMES, LTD.
101 Dyer Street, 5th Floor
Providence, RI 02903

Robert Kinberg (For Third Party Requester)
VENABLE
P.O. Box 34385
Washington, D.C. 20043-9998

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In re Kevin L. Parson et al.
Reexamination Proceeding
Control No. 90/005,975
Filed: April 5, 2001
For U.S. Patent No. 6,190,018 B1

DECISION MERGING REEXAMINATION PROCEEDINGS

In re Kevin L. Parson et al.
Reexamination Proceeding
Control No. 90/006,160
Filed: December 19, 2001
For U.S. Patent No. 6,190,018 B1

In re Kevin L. Parson et al.
Reexamination Proceeding
Control No. 90/006,445
Filed: November 7, 2002

For U.S. Patent No. 6,190,018 B1 :

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. 6,190,018 B1 issued on February 20, 2001.

2. A first request for reexamination, Control No. 90/005,975, was filed by the first third party on April 5, 2001.

3. Reexamination was ordered on May 18, 2001.

4. A non-final Office action was mailed on November 26, 2001.

5. A request for resetting the period for response due to late receipt of the non-final Office action was filed on December 14, 2001.

6. A decision granting the request was mailed on January 8, 2002, resetting of the period for response to run two (2) months from December 12, 2001.

7. A second request for reexamination, control No. 90/006,160, was filed by a second third party requester on December 19, 2001.

8. A personal interview was held on February 7, 2002, for the '5975 reexamination proceeding.

9. A revocation and power of attorney by the assignee was received on February 7, 2002, for the '5975 reexamination proceeding.

10. A response and a supplemental response to the Office action and an information disclosure statement were submitted on February 12, 2002, for the '5975 reexamination proceeding. No claim has been amended.

11. Reexamination control No. 90/006,160 was ordered on March 6, 2002.

12. A second supplemental response was filed May 9, 2002, via facsimile transmission, in

the '5975 reexamination proceeding. No claim has been amended.

13. A notice from the patent owner was filed on May 9, 2002, via facsimile transmission, waiving the right to file a patent owner's statement pursuant to 37 C.F.R. § 1.530(b) in the '6160 reexamination proceeding.

14. The '5975 and '6160 reexamination proceedings were merged by a decision mailed on May 23, 2002.

15. A non-final Office action was on mailed August 6, 2002.

16. A Response to Comments on Assignment of Reexamination and Decision Returning Improper Paper was issued by the Group Director on September 19, 2002.

17. A Decision Returning Improper Paper was issued by the Office of Patent Legal Administration on October 7, 2002.

18. A personal interview between inventor Kevin Parsons, patent owner's counsel and the examiners was held on October 15, 2002.

19. A third request for reexamination, Control No. 90/006,445, was filed on November 7, 2002 by a third party with the same address as the requester who requested the '5975 reexamination proceeding.

20. A response to the outstanding Office action was filed on November 20, 2002 for the merged reexamination proceedings. The response includes declarations under 37 C.F.R. §§ 1.131 and 1.132, an IDS. The response was supplemented on December 16, 2002, along with a Certificate of Service on the third party requesters.

21. Reexamination Control No. 90/006,445 was ordered on February 4, 2003.

22. A notice from the patent owner was filed on February 26, 2003, via facsimile transmission, waiving the right to file a patent owner's statement pursuant to 37 C.F.R. § 1.530(b) in the '6445 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 all three of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is appropriate.

Electronic Acknowledgement Receipt

DECISION

I. Merger proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '5975, '6160 and '6445 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 both requesters and both requesters will be sent copies of all papers mailed by the Office. Since the two requesters for the '5975 and the '6445 reexamination proceedings have the same correspondence address, only one copy of all papers issued by the Office will be sent to the Providence, RI, address.

CONCLUSION

Reexamination Control Nos.'5975, '6160 and '6445 are merged. The reexamination files are being forwarded to the examiner for preparing an Office action.

Richard K. Seidel, 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

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

STEPHEN J. HOLMES
BARLOW, JOSEPHS & HOLMES, LTD.
101 DYER STREET, 5TH FLOOR
PROVIDENCE, RI 02903-3908

REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/005,975

PATENT NO. 6,190,018

ART UNIT 2875

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).

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REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/006,445

PATENT NO. 6,190,018

ART UNIT 2875

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
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ROBERT KINBERG
VENABLE
P.O. BOX 34385
WASHINGTON, DC 20043-9998

REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/006160

PATENT NO. 6,190,018

ART UNIT 2875

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

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PO Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO.
90/006,160	12/19/2001	6190018	32405-177391	4328

90/006,573
90/006,445
90/005,975

7590 05/19/2003

RICHARD L. WOOD
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CHICAGO, IL 60606

EXAMINER

ART UNIT	PAPER NUMBER
	31

DATE MAILED: 05/19/2003

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

90005975.051903

PTO-90C (Rev. 07-01)

UNITED STATES PATENT AND TRADEMARK OFFICE

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WASHINGTON, D.C 20231
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Paper No. 30/9

Richard L. Wood
WELSH & KATZ. LTD.
120 South Riverside Plaza, 22nd Floor
Chicago, Illinois 60606

(For Patent Owner)

Stephen J. Holmes
Mark E. Tetreault
BARLOW, JOSEPH & HOLMES, LTD.
101 Dyer Street, 5th Floor
Providence, RI 02903

(For Third Party Requester)

Robert Kinberg
VENABLE
P.O. Box 34385
Washington, D.C. 20043-9998

(For Third Party Requester)

90005975 .051903

In re Kevin L. Parson et al.
Reexamination Proceeding
Control No. 90/005,975
Filed: April 5, 2001
For U.S. Patent No. 6,190,018 B1

In re Kevin L. Parson et al.
Reexamination Proceeding
Control No. 90/006,160
Filed: December 19, 2001
For U.S. Patent No. 6,190,018 B1

In re Kevin L. Parson et al.
Reexamination Proceeding
Control No. 90/006,445
Filed: November 7, 2002
For U.S. Patent No. 6,190,018 B1

DECISION MERGING
REEXAMINATION
PROCEEDINGS

In re Kevin L. Parson et al. :
Reexamination Proceeding :
Control No. 90/006,573 :
Filed: March 24, 2003 :
For U.S. Patent No. 6,190,018 B1 :

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. 6,190,018 B1 issued on February 20, 2001.

2. A first request for reexamination, Control No. 90/005,975, was filed by the first third party on April 5, 2001.

3. Reexamination was ordered on May 18, 2001.

4. A non-final Office action was mailed on November 26, 2001.

5. A request for resetting the period for response due to late receipt of the non-final Office action was filed on December 14, 2001.

6. A decision granting the request was mailed on January 8, 2002, resetting of the period for response to run two (2) months from December 12, 2001.

7. A second request for reexamination, control No. 90/006,160, was filed by a second third party requester on December 19, 2001.

8. A personal interview was held on February 7, 2002, for the '5975 reexamination proceeding.

9. A revocation and power of attorney by the assignee was received on February 7, 2002, for the '5975 reexamination proceeding.

10. A response and a supplemental response to the Office action and an information disclosure statement were submitted on February 12, 2002, for the '5975 reexamination proceeding. No claim has been amended.

11. Reexamination control No. 90/006,160 was ordered on March 6, 2002.

12. A second supplemental response was filed May 9, 2002, via facsimile transmission, in the '5975 reexamination proceeding. No claim has been amended.

13. A notice from the patent owner was filed on May 9, 2002, via facsimile transmission, waiving the right to file a patent owner's statement pursuant to 37 C.F.R. § 1.530(b) in the '6160 reexamination proceeding.

14. The '5975 and '6160 reexamination proceedings were merged by a decision mailed on May 23, 2002.

15. A non-final Office action was on mailed August 6, 2002.

16. A Response to Comments on Assignment of Reexamination and Decision Returning Improper Paper was issued by the Group Director on September 19, 2002.

17. A Decision Returning Improper Paper was issued by the Office of Patent Legal Administration on October 7, 2002.

18. A personal interview between inventor Kevin Parsons, patent owner's counsel and the examiners was held on October 15, 2002.

19. A third request for reexamination, Control No. 90/006,445, was filed on November 7, 2002 by a third party with the same address as the requester who requested the '5975 reexamination proceeding.

20. A response to the outstanding Office action was filed on November 20, 2002 for the merged reexamination proceedings. The response includes declarations under 37 C.F.R. §§ 1.131 and 1.132, an IDS. The response was supplemented on December 16, 2002, along with a Certificate of Service on the third party requesters.

21. Reexamination Control No. 90/006,445 was ordered on February 4, 2003.

22. A notice from the patent owner was filed on February 26, 2003, via facsimile transmission, waiving the right to file a patent owner's statement pursuant to 37 C.F.R. § 1.530(b) in the '6445 reexamination proceeding.

23. The '5975, '6160 and '6445 reexamination proceedings were merged by a decision mailed on March 3, 2003.

24. A fourth request for reexamination, Control No. 90/006,573, was filed on Marc 24, 2003 by Mark E. Tetreault, the same third party who requested the '5975 and '6445 reexamination proceedings.

25. A housekeeping amendment was filed in the '6445 reexamination proceeding on March 31, 2003.

26. Reexamination Control No. 90/006,573 was ordered on April 30, 2003.

27. A notice from the patent owner was filed on May 2, 2003, waiving the right to file a patent owner's statement pursuant to 37 C.F.R. § 1.530(b) in the '6573 reexamination proceeding.

28. An amendment was filed in the '6573 reexamination proceeding on May 2, 2003 to put the same claims all four reexamination proceedings.

90005975 - 05/30/03

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 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 '5975, '6160, '6445 and '6573 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 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 quadruplet, each bearing an original signature, for entry in 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 two requesters for the '5975, the '6445 and the '6573 reexamination proceedings have the same correspondence address, only one copy of all papers issued by the Office will be sent to the Providence, RI, address.

CONCLUSION

Reexamination Control Nos.'5975, '6160, '6445 and '6573 are merged. The reexamination files are being forwarded to the examiner for preparing an Office action.

Richard K. Seidel, Group Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/006160, 90/006,445, 90/005,975, 90/006,573

PATENT NO. 6,190,018

ART UNIT 2875

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).

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Patent and Trademark Office
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Washington, D C 20231

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

MARK E. TETREAULT
BARLOW, JOSEPHS & HOLMES, LTD.
101 DYER STREET, 5TH FLOOR
PROVIDENCE, RI 02903-3908

REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/006,445 & 90/005,975, 90/006,160, 90/006,573

PATENT NO. 6,190,018

ART UNIT 2875

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).

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DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
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SEP 26 2001
GROUP 1100

Mailed:

WAK
Paper Number 10

David J. Serbin
Law Office of David J. Serbin
Unit 2, First Floor
1423 Powhatan Street
Alexandria, VA 22314

(for Patent Owner)

In re Tenney
Reexamination Proceeding
Control No. 90/005,978
Filed: April 12, 2001
For: U.S. Patent 5,895,638

DECISION MERGING
REEXAMINATION
PROCEEDINGS

In re Tenney
Reexamination Proceeding
Control No. 90/005,999
Filed: May 09, 2001
For: U.S. Patent 5,895,638

The above noted reexamination files are before the Director of Technical Center 1700 for consideration of the merger of the proceedings under37 C.F.R. 1.565(c).

BACKGROUND

1. United States Patent 5,895,638 issued April 20, 1999, is the subject of Reexamination Control Nos. 90/005,978 and 90/005,999.

2. A first request for reexamination, assigned Reexamination Control No. 90/005,978 ("978), was filed April 12, 2001 by David J. Serbin of Law Office of David J. Serbin, Unit 2, First Floor, 1423 Powhatan Street, Alexandria, VA 22314. The request urged that a substantial new question of patentability was raised by the teachings of U.S. Patent 2,833,624 to Sprauer. The amendments submitted April 12, 2001 and July 31, 2001 have been entered.

3. A second request for reexamination, assigned Reexamination Control No. 90/005,999 ("999), was filed May 9, 2001 by David J. Serbin of Law Office of David J. Serbin, Unit 2, First Floor, 1423

Powhatan Street, Alexandria, VA 22314. The request urged that a substantial new question of patentability was raised by the teachings of U.S. Patent 4,534,952 to Rapson et al.

4. Reexamination was ordered for '978 on May 7, 2001

5. Reexamination was ordered for '999 on July 6, 2001.

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 90/005,978 and 90/005,999 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 not the same in both files, a housekeeping amendment is needed. See MPEP 2283, under Merger of Reexaminations. Patent owner is required to submit an appropriate "housekeeping amendment" within (1) month of this decision placing the same amendments that were filed in "978 in "999. 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

An Office Action will be issued in due course (after entry of the "housekeeping amendment") which applies to Reexamination no. 90/005,999.

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. 90/005,978 and No. 90/005,999 as:

David J. Serbin
Law Office of David J. Serbin
Unit 2, First Floor
1423 Powhatan Street
Alexandria, VA 22314

CONCLUSION

Reexamination Control Nos. 90/005,978 and 90/005,999 are merged. After receipt of the patent owner's housekeeping amendment, the files shall be forwarded to the examiner and an Office action shall follow in due course.

Richard V. Fisher

Richard V. Fisher, Director
Technology Center 1700
Chemical and Materials Engineering

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
www uspto gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/005,981	04/17/2001	5146512	11703/51027	2739

7590 03/26/2002

Martin Korn
Locke Liddell & Sapp, LLP
2200 Ross Avenue Suite 2200
Dallas, TX 75201-6776

EXAMINER	
ART UNIT	PAPER NUMBER

7

DATE MAILED: 03/26/2002

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

Paper No. 7

mailed 26 MAR 2002

Martin Korn LOCKE LIDDELL & SAPP LLP 2200 Ross Avenue Suite 2200 Dallas, TX 75201-6776	)	FOR OWNER
John P. Phillips MERCHANT & GOULD PC P.O. BOX 2903 Minneapolis, MN 55402-0903	)	FOR THIRD PARTY REQUESTER
In re Weideman et al. Reexamination Proceeding. Control No. 90/005,981 Filed: April 17, 2001 For: U.S. Patent No. 5,146,512	)	DECISION SUA SPONTE, MERGING REEXAMINATION PROCEEDINGS
In re Weideman et al. Reexamination Proceeding Control No. 90/006,065 Filed: July 20, 2001 For: U.S. Patent No. 5,146,512	)	

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. 5,146,512 issued on September 8, 1992.

2. A first request for reexamination, Control No. 90/005981 ('981) was filed by the Patent Owner on April 17, 2001.

3. Reexamination was ordered in the '981 reexamination proceeding on June 4, 2001.

4. A second request for reexamination, Control No. 90/006065 ('065) was filed by the Third Party Requester on July 20, 2001.

5. Reexamination was ordered in the '065 reexamination proceeding on October 5, 2001.

6. No Patent Owner's statement was filed in either of the reexamination proceedings.

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 '981, and '065 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 Proceedings

The Patent Owner is required to maintain the same claims and specification in both files. Since these files have the same claims and specification, a "housekeeping" amendment is not required. Therefore, the files will be forwarded to the examiner for action on the merits.

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.

Joseph J. Rolla, Jr., Director
Technology Center 2600
Communications

UNITED STATES PATENT AND TRADEMARK OFFICE

Paper No. 26

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
WASHINGTON, D.C. 20231
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(For Patent Owner)

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Jenner & Block
One IBM Plaza
CHICAGO, IL 60611

(For Requester)

MAILED

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REEXAM UNIT

In re Allier, et al
Reexamination Proceeding
Control No. 90/005,985
Filed: April 17, 2001
For: U.S. Patent No. 6,039,575

DECISION ON PETITIONS

RECEIVED

This is a decision on the September 18, 2002, patent owner PETITION UNDER 37 C.F.R. § 1.8(b) TO ACCEPT AND CONSIDER TIMELY PREVIOUSLY FILED APPEAL BRIEF UNDER 37 C.F.R. 1.192.

This is also a decision on the October 11, 2002, patent owner PETITION UNDER 37 C.F.R. § 1.137(b) TO REVIVE UNINTENTIONALLY TERMINATED REEXAMINATION PROCEEDING, requesting revival of the present proceeding under the "unintentional" standard.

The two petitions are 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. 50-0324, in accordance with petitioner's authorization in the third from last paragraph of the instant petition.

The petition under 37 CFR 1.8(b) is dismissed.

The petition under 37 CFR 1.137(b) is granted.

DECISION ON PETITION UNDER 37 CFR 1.8(b)

The instant petition under 37 CFR 1.8(b) points out that, on September 16, 2002, an Appeal Brief under 37 CFR 1.192 was deposited in a United States Postal Service Mail Box, with the required Certificate of Mailing being included. Further, on September 18, 2002, the papers were returned to petitioner as not being compliant with the United States Postal Service (USPS) requirement that all domestic first-class mail, bearing stamps and weighing sixteen ounces, or over, be "presented to a retail clerk at a post office."

Correspondence must be deposited with the USPS as first class mail in compliance with any and all applicable requirements of the USPS to be considered "[d]eposited with the U.S. Postal service" within the meaning of 37 CFR 1.8(a)(1)(i)(A). Correspondence presented to the USPS in a manner that does not comply with the applicable requirements of the USPS is not "[d]eposited with the U.S. Postal service" within the meaning of 37 CFR 1.8(a)(1)(i)(A), and is thus not entitled to any benefit under 37 CFR 1.8.

In the present instance, the Appeal Brief correspondence papers were not presented to the USPS in a manner that complied with the applicable requirements of the USPS, because the papers weighed sixteen ounces or more, yet were not presented to a retail clerk at a post office. Accordingly, the Appeal Brief correspondence papers are not entitled to any benefit under 37 CFR 1.8, [1] and the petition under 37 CFR 1.8(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, an Appeal Brief under 37 CFR 1.192 was filed with patent owner's September 18, 2002, petition under 37 CFR 1.8(b). Further, the required petition fee is being charged to petitioner's deposit account as authorized in the 37 CFR 1.137(b) petition. Accordingly, the petition under 37 CFR 1.137(b) is granted.

---

[1] See Official Gazette Notice entitled "Treatment of Correspondence Deposited as First Class Mail Pursuant to 37 CFR 1.8 and Returned by the U.S. Postal Service" 1192 *Off. Gaz. Pat. Office* 43 (November 12, 1996).

CONCLUSION

1. The petition under 37 CFR 1.8(b) is **dismissed**.

2. The petition under 37 CFR 1.137(b) is **granted**.

3. The reexamination file is being returned to Technology Center 3700 to, in due course, address the Appeal Brief filed September 18, 2002.

4. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, John E. Rovnak, in Technology Center 3714.

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\5985UNIN.&cm; 11-12-02

UNITED STATES PATENT AND TRADEMARK OFFICE

Paper No. 26

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
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ORLANDO, FL 32802

(For Patent Owner)

Steven M. Zeller
Jenner & Block
One IBM Plaza
CHICAGO, IL 60611

(For Requester)

MAILED

NOV 12 2002

REEXAM UNIT

In re Allier, et al
Reexamination Proceeding
Control No. 90/005,985
Filed: April 17, 2001
For: U.S. Patent No. 6,039,575

DECISION ON PETITIONS

RECEIVED

This is a decision on the September 18, 2002, patent owner PETITION UNDER 37 C.F.R. § 1.8(b) TO ACCEPT AND CONSIDER TIMELY PREVIOUSLY FILED APPEAL BRIEF UNDER 37 C.F.R. 1.192.

This is also a decision on the October 11, 2002, patent owner PETITION UNDER 37 C.F.R. § 1.137(b) TO REVIVE UNINTENTIONALLY TERMINATED REEXAMINATION PROCEEDING, requesting revival of the present proceeding under the "unintentional" standard.

The two petitions are 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. 50-0324, in accordance with petitioner's authorization in the third from last paragraph of the instant petition.

The petition under 37 CFR 1.8(b) is dismissed.

The petition under 37 CFR 1.137(b) is granted.

DECISION ON PETITION UNDER 37 CFR 1.8(b)

The instant petition under 37 CFR 1.8(b) points out that, on September 16, 2002, an Appeal Brief under 37 CFR 1.192 was deposited in a United States Postal Service Mail Box, with the required Certificate of Mailing being included. Further, on September 18, 2002, the papers were returned to petitioner as not being compliant with the United States Postal Service (USPS) requirement that all domestic first-class mail, bearing stamps and weighing sixteen ounces, or over, be "presented to a retail clerk at a post office."

Correspondence must be deposited with the USPS as first class mail in compliance with any and all applicable requirements of the USPS to be considered "[d]eposited with the U.S. Postal service" within the meaning of 37 CFR 1.8(a)(1)(i)(A). Correspondence presented to the USPS in a manner that does not comply with the applicable requirements of the USPS is not "[d]eposited with the U.S. Postal service" within the meaning of 37 CFR 1.8(a)(1)(i)(A), and is thus not entitled to any benefit under 37 CFR 1.8.

In the present instance, the Appeal Brief correspondence papers were not presented to the USPS in a manner that complied with the applicable requirements of the USPS, because the papers weighed sixteen ounces or more, yet were not presented to a retail clerk at a post office. Accordingly, the Appeal Brief correspondence papers are not entitled to any benefit under 37 CFR 1.8, [1] and the petition under 37 CFR 1.8(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, an Appeal Brief under 37 CFR 1.192 was filed with patent owner's September 18, 2002, petition under 37 CFR 1.8(b). Further, the required petition fee is being charged to petitioner's deposit account as authorized in the 37 CFR 1.137(b) petition. Accordingly, the petition under 37 CFR 1.137(b) is granted.

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[1] See Official Gazette Notice entitled "Treatment of Correspondence Deposited as First Class Mail Pursuant to 37 CFR 1.8 and Returned by the U.S. Postal Service" 1192 *Off. Gaz. Pat. Office* 43 (November 12, 1996).

CONCLUSION

1. The petition under 37 CFR 1.8(b) is **dismissed**.

2. The petition under 37 CFR 1.137(b) is **granted**.

3. The reexamination file is being returned to Technology Center 3700 to, in due course, address the Appeal Brief filed September 18, 2002.

4. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, John E. Rovnak, in Technology Center 3714.

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\5985UNIN.&cm; 11-12-02

5

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.
90/005,985	04/17/01	6039575	32152-10020

EXAMINER

QM21/0606

JACQUELINE E. HARTT, PH. D.
ALLEN DYER DOPPELT MILBRATH AND GILCHRIS
255 SOUTH ORANGE AVE., SUITE 1401
P O BOX 3791
ORLANDO FL 32802

ROVNAK, J	
ART UNIT	PAPER
3713	5

DATE MAILED: 06/06/01

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

Commissioner of Patents and Trademarks

90005985 06060101

PTO-90C (Rev.3-98)

Order Granting / Denying Request For Reexamination	Control No.	Patent Under Reexamination	
	90/005,985	6039575	
	Examiner	Art Unit	
	John E. Rovnak	3713	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The request for reexamination filed *17 April 2001* has been considered. Identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a)☐ PTO-892, b)☒ PTO-1449, c)☐ Other: _____

1. ☒ The request for reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date This communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(C).**

For Requester's Reply (optional): TWO MONTHS from the date of service of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), no reply by requester is permitted.

2. ☒ The request for reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303 (c)). Requester may seek review by petition to the Commissioner within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 (c) will be made to requester:

a)☐ by Treasury check or,

b)☐ by credit to Deposit Account No. _____, unless otherwise notified (35 U.S.C. 303 (c)).

John E. Rovnak
Examiner
Art Unit: 3713

cc:Requester (if third party requester)

DECISION

1. A substantial new question of patentability affecting claims 1-7 of United States Patent Number 6,039,575 to L'Allier et al is raised by the request for reexamination. Claims 1-7 will be reexamined.

Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extension of time in reexamination proceedings are provided for in 37 CFR 1.550(c).

2. The request indicates that Requester considers that Claims 1, 2, 4, 5 and 6 are unpatentable over the PLATO CMI Author's Guide and the PLATO CMI System Overview Manual effectively incorporated therein (collectively "PLATO CMI Author/Overview").

3. The request further indicates that Requester considers that Claims 1-7 are unpatentable over the previously disclosed patent to Egnor (U.S. Patent No. 5,180,309) in view of the PLATO CMI Author/Overview, the PLATO Brochure, the Dennis and Grunner Article, the L'Allier et al. Article, and the previously disclosed Skill Builder 5.2 Reference.

4. It is agreed that the consideration of the PLATO CMI Author/Overview raises a substantial new question of patentability as to claims 1, 2, 4, 5 and 6 of the L'Allier et al patent. As pointed out on pages 10-19 of the request, the PLATO CMI Author/Overview teaches a method for using a computer to create pretests, developing learning

prescriptions based on the pretests, presenting the prescribed instruction to an individual via the computer, and presenting post-tests. The teaching as to developing learning prescriptions based on the pretests and presenting the prescribed instruction to an individual via the computer was not present in the prosecution of the application which became the L'Allier et al patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not the claims are patentable. Accordingly, the PLATO CMI Author/Overview raises a substantial new question of patentability as to claims 1, 2, 4, 5 and 6, which question has not been decided in a previous examination of the L'Allier et al patent.

5. It is further agreed that the consideration of the previously disclosed Egnor patent in view of the PLATO CMI Author/Overview, the PLATO Brochure, the Dennis and Grunner Article, the L'Allier et al. Article, and the previously disclosed Skill Builder 5.2 Reference raises a substantial new question of patentability as to claims 1-7 of the L'Allier et al patent. The Egnor patent teaches computer-based learning methods including the following steps: prepare question/answer set, store by category, select category, select question, display question, respond by Auto Compare, evaluate with tolerance, automatically grade, and advance category to next question. Egnor teaches random and sequential selection and the evaluation of each response against a predetermined standard before the next question is selected. The teaching as to the step of automatically determining, in response to a pretest, a series of instructional units needed to master a particular topic was not present in the prosecution of the application which became the L'Allier Patent.

90005985 20050504

The PLATO CMI Author/Overview and PLATO Brochure teach the steps of computer-generated evaluation, processing the results, prescribing a learning sequence, and presenting the prescribed unmastered instructional units via the computer and other media. Furthermore, Dennis and Grunner teach the generation of a learning prescription based on a student's performance on either a pretest or post-test. The Skill Builder 5.2 Reference teaches the presenting, after preassessment, of prescribed instructional units via a computer. Moreover the L'Allier et al. Article teaches the process of generating a pretest on a computer, using the information from the pretest to determine what content learners already know and what they need to learn, and customizing the instruction accordingly. There is substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not the claims are patentable. Accordingly, consideration of Egnor in view of the PLATO CMI Author/Overview, the PLATO Brochure, the Dennis and Grunner Article, the L'Allier et al. Article, and the Skill Builder 5.2 Reference raises a substantial new question of patentability as to Claims 1-7, which question has not been decided in a previous examination of the L'Allier Patent.

90005985 05505

6. The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 6,039,575 throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise

the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

John E. Rovnak

Examiner, Art Unit 3713

90005985 • 05/05/04

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

15 JAN 2002

Paper No. 14

Jacqueline E. Hartt, Ph.D
Allen Dyer Doppelt Milbrath and Gilchrist, PA
255 South Orange Ave., Suite 1401
P. O. Box 3791
Orlando, FL 32802

: For Patent Owner

Steven M. Zeller
Jenner & Block
One IBM Plaza
Chicago, IL 60611

: For Requester

In re Reexamination
Control No. 90/005,985
U.S. Patent No. 6,039,575
Issued: March 21, 2000
Patent Owner: National Education Corporation
Request Filed: April 17, 2001

: DECISION ON PETITION
: FOR EXTENSION OF TIME

90005985 20020115

This is a decision on the paper styled as "Request for Extension of Time" filed by facsimile transmission on January 14, 2002. The paper is being treated as a petition under 37 CFR 1.550(c) for a one month extension of time in which to reply to the Office letter dated December 16, 2001.

The petition is GRANTED.

The petition sets forth circumstances which adequately justify the necessity for a one month extension of time. Accordingly, Owner's request for an extension of time in which to file a reply to the above mentioned Office letter is granted. The reply is therefore due on or before February 16, 2002. 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), particularly as this reexamination proceeding involves a patent in which there is litigation that has been stayed pending the outcome of the reexamination proceeding. See MPEP § 2263. In no event can the period for filing a reply to the final Office action be extended more than six months from the date thereof.

PETITION GRANTED

E. Rollins-Cross, Director, Patent
Examining Groups 3710 and 3720

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

MAY 3 2002

Paper No. 19

Jacqueline E. Hartt, Ph.D
Allen Dyer Doppelt Milbrath and Gilchrist, PA
255 South Orange Ave., Suite 1401
P. O. Box 3791
Orlando, FL 32802

: For Patent Owner

Steven M. Zeller
Jenner & Block
One IBM Plaza
Chicago, IL 60611

: For Requester

In re Reexamination
Control No. 90/005,985
U.S. Patent No. 6,039,575
Issued: March 21, 2000
Patent Owner: National Education Corporation
Request Filed: April 17, 2001

: DECISION ON PETITION
: FOR EXTENSION OF TIME

This is a decision on the paper styled as "Request for Extension of Time" filed by facsimile transmission on May 1, 2002. The paper is being treated as a petition under 37 CFR 1.550(c) for a one month extension of time in which to reply to the Office letter dated April 10, 2002.

The petition is GRANTED.

The petition sets forth circumstances which adequately justify the necessity for a one month extension of time. Accordingly, Owner's request for an extension of time in which to file a reply to the above mentioned Office letter is granted. The reply is therefore due on or before ~~May~~ June 10th, 2002. 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), particularly as this reexamination proceeding involves a patent in which there is litigation that has been stayed pending the outcome of the reexamination proceeding. See MPEP § 2263. In no event can the period for filing a reply to the final Office action be extended more than six months from the date thereof. Owner should note that the filing of a first response to a final rejection is construed as being a petition for a one month extension of time which will be granted. See MPEP § 2272.

PETITION GRANTED.

E. Rollins Cross, Director, Patent
Examining Groups 3710 and 3720

UNITED STATES PATENT AND TRADEMARK OFFICE

Paper No. 26

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
WASHINGTON, D.C. 20231
www.uspto.go

Jacqueline E. Hartt, Ph.d. (For Patent Owner)
Allen, Dyer, Doppelt,
Franjola & Milbrath, P.A.
255 South Orange Ave.
SUITE 1401, P.O. BOX 3791
ORLANDO, FL 32802

Steven M. Zeller (For Requester)
Jenner & Block
One IBM Plaza
CHICAGO, IL 60611

MAILED

NOV 12 2002

REEXAM UNIT

In re Allier, et al :
Reexamination Proceeding : **DECISION**
Control No. 90/005,985 : **ON**
Filed: April 17, 2001 : **PETITIONS**
For: U.S. Patent No. 6,039,575 :

DO NOT ENTER

This is a decision on the September 18, 2002, patent owner PETITION UNDER 37 C.F.R. § 1.8(b) TO ACCEPT AND CONSIDER TIMELY PREVIOUSLY FILED APPEAL BRIEF UNDER 37 C.F.R. 1.192.

This is also a decision on the October 11, 2002, patent owner PETITION UNDER 37 C.F.R. § 1.137(b) TO REVIVE UNINTENTIONALLY TERMINATED REEXAMINATION PROCEEDING, requesting revival of the present proceeding under the "unintentional" standard.

The two petitions are 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. 50-0324, in accordance with petitioner's authorization in the third from last paragraph of the instant petition.

The petition under 37 CFR 1.8(b) is dismissed.

The petition under 37 CFR 1.137(b) is granted.

DECISION ON PETITION UNDER 37 CFR 1.8(b)

The instant petition under 37 CFR 1.8(b) points out that, on September 16, 2002, an Appeal Brief under 37 CFR 1.192 was deposited in a United States Postal Service Mail Box, with the required Certificate of Mailing being included. Further, on September 18, 2002, the papers were returned to petitioner as not being compliant with the United States Postal Service (USPS) requirement that all domestic first-class mail, bearing stamps and weighing sixteen ounces, or over, be "presented to a retail clerk at a post office."

Correspondence must be deposited with the USPS as first class mail in compliance with any and all applicable requirements of the USPS to be considered "[d]eposited with the U.S. Postal service" within the meaning of 37 CFR 1.8(a)(1)(i)(A). Correspondence presented to the USPS in a manner that does not comply with the applicable requirements of the USPS is not "[d]eposited with the U.S. Postal service" within the meaning of 37 CFR 1.8(a)(1)(i)(A), and is thus not entitled to any benefit under 37 CFR 1.8.

In the present instance, the Appeal Brief correspondence papers were not presented to the USPS in a manner that complied with the applicable requirements of the USPS, because the papers weighed sixteen ounces or more, yet were not presented to a retail clerk at a post office. Accordingly, the Appeal Brief correspondence papers are not entitled to any benefit under 37 CFR 1.8, [1] and the petition under 37 CFR 1.8(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, an Appeal Brief under 37 CFR 1.192 was filed with patent owner's September 18, 2002, petition under 37 CFR 1.8(b). Further, the required petition fee is being charged to petitioner's deposit account as authorized in the 37 CFR 1.137(b) petition. Accordingly, the petition under 37 CFR 1.137(b) is granted.

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[1] See Official Gazette Notice entitled "Treatment of Correspondence Deposited as First Class Mail Pursuant to 37 CFR 1.8 and Returned by the U.S. Postal Service" 1192 *Off. Gaz. Pat. Office* 43 (November 12, 1996).

CONCLUSION

1. The petition under 37 CFR 1.8(b) is **dismissed**.

2. The petition under 37 CFR 1.137(b) is **granted**.

3. The reexamination file is being returned to Technology Center 3700 to, in due course, address the Appeal Brief filed September 18, 2002.

4. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, John E. Rovnak, in Technology Center 3714.

5. Telephone inquiries related 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

DOCKET ALARM

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
WASHINGTON, D.C. 20231
www.uspto.go

Paper No. 11

Deborah M. Altman, Esq.
PPG Industries, Inc.
One PPG Place
Pittsburgh, PA 15272

(For Patent Owner)

MAILED

DEC 13 2002

REEXAM UNIT

In re Kaylo et al.
Reexamination Proceeding
Control No. 90/005,988
Filed: April 24, 2001
For: U.S. Patent No. 6,132,581

DECISION
DISMISSING
PETITION

This is a decision on the November 7, 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.

The petition fee of $1280.00 pursuant to 37 C.F.R. § 1.17(m) for the petition under 37 C.F.R. § 1.137(b) has been charged to deposit account no. 16-2025, as per petitioner's instructions on page 2 of the present petition.

The petition for revival under 37 C.F.R. § 1.137(b) based upon unintentional delay 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 petition fee, as well as a statement, as set forth in items (2) and (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.

The instant petition lack(s) item (1) above. Although a response to the outstanding non-final Office action was filed on February 22, 2002, and a supplemental response was filed on August 2, 2002, neither of these papers constitute "the required reply" pursuant to 37 C.F.R. § 1.137(b)(1). Specifically, the amendments of February 22, 2002 and August 2, 2002, are **not** in compliance with 37 CFR § 1.530, as they do not include 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 original disclosure of the patent for the changes to the claims made by the amendment papers, as required by 37 CFR § 1.530(e). Also, in both amendment papers, the

amendment of claim 4 shows the text of original patent claim 5, with changes shown in bracketing and underlining, and **not** the text of original patent claim 4, with changes shown in bracketing and underlining, as required by 37 CFR § 1.530(d)(2) and (i). Note that patent claims may not be renumbered (see 37 CFR § 1.530(g)).

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. The reexamination file will be stored in the Central Reexam Unit (CRU) for one month to await any such renewed petition. If no such renewed petition is timely received, the reexamination file will be forwarded to Technology Center 1700 for termination of the proceeding, and issuance of the Notice of Intent to Issue Reexamination Certificate (NIRC).

4. 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

5. Telephone inquiries with regard to this decision should be directed to the undersigned at (703) 308-0255.

Lynn M. Kryza

Lynn M. Kryza
Patent Special Projects Advisor
Office of Patent Legal Administration

December 11, 2002

Electronic Acknowledgement Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
WASHINGTON, D.C. 20231
www.uspto.go

Paper No. 15

Deborah M. Altman
PPG Industries, Inc.
One PPG Place
Pittsburgh, PA 15272

(For Patent Owner)

MAILED

MAR 0 4 2003

REEXAM UNIT

In re Kaylo et al.
Reexamination Proceeding
Control No. 90/005,988
Filed: April 24, 2001
For: U.S. Patent No. 6,132,581

DECISION GRANTING PETITION

This is a decision on the January 15, 2003, patent owner renewed 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 $1280.00 pursuant to 37 C.F.R. § 1.17(m) for the petition under 37 C.F.R. § 1.137(b) was received with the previous petition of November 7, 2002.

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 previous petition was accompanied by the petition fee, as well as 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 required reply to the outstanding nonfinal Office action of November 8, 2001, has been received. It is noted that the amendment of January 15, 2003, includes a clean copy of the claims, which is required by 37 C.F.R. § 1.121. However, please note that the amendment practice as set forth in 37 C.F.R. § 1.121, **does NOT apply to reexamination proceedings**, as specifically set forth in this rule, **see 37 C.F.R. § 1.121(i)**. However, **in this instance only,** the amendment of January 15, 2003, is being accepted, as a careful review of this amendment reveals that the changes are presented with changes in bracketing and underlining with regard to the original patent text, the response sets forth the status of the claims, and the response includes an explanation of the support in the original disclosure of the patent for the changes to the claims made by the amendment papers, as required by 37 C.F.R. § 1.530. Note that the clean copy of the claims will be lined through, as submission of such is neither required by nor appropriate for an amendment under 37 C.F.R. § 1.530.

Any and all subsequent amendments in this reexamination proceeding must be filed in accordance with 37 C.F.R. § 1.530, or they will be refused entry and consideration.

In view of the above, the renewed 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 1700 for consideration of the response to the nonfinal Office action of November 8, 2001.
3. Further inquiries with regard to this reexamination proceeding should be directed to the examiner, Thao Tran, of Group Art Unit 1741.
4. Telephone inquiries with regard to this decision should be directed to the undersigned at (703) 308-0255.

DECISION MAILED

Lynn M. Kryza
Patent Special Projects Advisor
Office of Patent Legal Administration

March 3, 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
WWW.USPTO.GOV

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SEP 26 2001
GROUP 1100

Mailed:

WAK
Paper Number 10

David J. Serbin
Law Office of David J. Serbin
Unit 2, First Floor
1423 Powhatan Street
Alexandria, VA 22314

(for Patent Owner)

In re Tenney
Reexamination Proceeding
Control No. 90/005,978
Filed: April 12, 2001
For: U.S. Patent 5,895,638

DECISION MERGING
REEXAMINATION
PROCEEDINGS

In re Tenney
Reexamination Proceeding
Control No. 90/005,999
Filed: May 09, 2001
For: U.S. Patent 5,895,638

The above noted reexamination files are before the Director of Technical Center 1700 for consideration of the merger of the proceedings under37 C.F.R. 1.565(c).

BACKGROUND

1. United States Patent 5,895,638 issued April 20, 1999, is the subject of Reexamination Control Nos. 90/005,978 and 90/005,999.

2. A first request for reexamination, assigned Reexamination Control No. 90/005,978 ("978), was filed April 12, 2001 by David J. Serbin of Law Office of David J. Serbin, Unit 2, First Floor, 1423 Powhatan Street, Alexandria, VA 22314. The request urged that a substantial new question of patentability was raised by the teachings of U.S. Patent 2,833,624 to Sprauer. The amendments submitted April 12, 2001 and July 31, 2001 have been entered.

3. A second request for reexamination, assigned Reexamination Control No. 90/005,999 ("999), was filed May 9, 2001 by David J. Serbin of Law Office of David J. Serbin, Unit 2, First Floor, 1423

Powhatan Street, Alexandria, VA 22314. The request urged that a substantial new question of patentability was raised by the teachings of U.S. Patent 4,534,952 to Rapson et al.

4. Reexamination was ordered for '978 on May 7, 2001

5. Reexamination was ordered for '999 on July 6, 2001.

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 90/005,978 and 90/005,999 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 not the same in both files, a housekeeping amendment is needed. See MPEP 2283, under Merger of Reexaminations. Patent owner is required to submit an appropriate "housekeeping amendment" within (1) month of this decision placing the same amendments that were filed in "978 in "999. 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

An Office Action will be issued in due course (after entry of the "housekeeping amendment") which applies to Reexamination no. 90/005,999.

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. 90/005,978 and No. 90/005,999 as:

David J. Serbin
Law Office of David J. Serbin
Unit 2, First Floor
1423 Powhatan Street
Alexandria, VA 22314

CONCLUSION

Reexamination Control Nos. 90/005,978 and 90/005,999 are merged. After receipt of the patent owner's housekeeping amendment, the files shall be forwarded to the examiner and an Office action shall follow in due course.

Richard V. Fisher

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, DC 20231
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OK
SM

Reexamination Control No. 90/006,000

FOR PATENT OWNER:

Robert S. Salzman, Esq.
Salzman and Levy
Press Building, Suite 902
19 Chenango Street
Binghamton, NY 13901

DECISION ON PETITION
TO ACCEPT A
LATE COMMUNICATION

FOR REQUESTER:

Richard O. Gray, Jr., Esq.
Graybeal Jackson & Haley, LLP
155 108th Avenue, N.E.
Suite 350
Bellevue, WA 98004-5901

This is in response to the patent owner's petition to accept a late communication under 37 CFR 1.181, filed in the United States Patent and Trademark Office on May 14, 2003 and supplemented on May 22, 2003 and June 6, 2003.

The petition is **GRANTED**.

A review of the file record indicates that an Office action was mailed to patent owner on October 8, 2002.

Patent owner's petition includes a copy of a Response with a Certificate of Mailing dated December 6, 2002. A statement by Mark Levy was received on May 22, 2003, which attests to the personal knowledge of mailing the Response on the date indicated on the Certificate of Mailing. This is sufficient evidence of a timely response.

Since a timely response to the Office action was filed, the reexamination file is being forwarded to the Supervisory Legal Instruments Examiner for entry of the Reply filed with the petition, and then to the Examiner for prompt action on the merits of the claims.

Steven N. Meyers, Special Programs Examiner
Patent Technology Center 3600
Telephone No.: (703) 308-3868

SNM/tpl: 6/30/03

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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Robert S. Salzman, Esq.
Salzman and Levy
Press Building Suite 902
19 Chenango Street
Binghamton, NY 13901

(For Patent Owner)

MAILED
FROM DIRECTORS OFFICE

OCT 13 2005

TECHNOLOGY CENTER 3600

Richard O. Gray, Esq.
Graybeal, Jackson, Haley, LLP
155 108th Avenue, N.E., Suite 350
Bellevue, Washington 98004-5901

(For Requester)

Reexamination Control No. 90/006,000
Filed: May 7, 2001
For: U.S. Patent No. 4,938,313

DECISION ON PETITION
FOR THE ACCEPTANCE
OF LATE PAPERS

This is in reply to petitioner's communication filed July 11,2005 which will be treated as a Petition To Accept Late Filed Papers. There is no fee required for this petition.

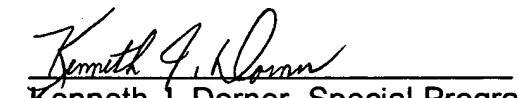
The petition is granted to the extent of accepting the papers filed May 10, 2004 but **DENIED** with respect to withdrawing the Notice of Intent To Issue a Reexamination Certificate.

A review of the above reexamination file indicates that a final Office action was mailed on October 8, 2002 wherein a two-month shortened statutory period for response was set. Petitioner alleges that a timely response was filed on May 12, 2004. Petitioner has submitted copy of the amendment, which bears a Certificate of Mailing indicating that the amendment was timely mailed on May 10, 2004.

A further review of the file reveals that the amendment was in fact timely received as petitioner alleges. (The original amendment is in the file). Further, that amendment was considered by the examiner as evidenced in the Advisory Action mailed April 23,

2005 and found to be not persuasive to alter the rejection of claims 1-23 set forth in the final rejection. The statutory six month period within which to respond to the final rejection expired on September 8, 2004. Since a Notice of Appeal or an amendment which placed all the claims in condition for allowance was not filed, the examiner properly proceeded to cancel claims 1-23 and issue a Notice of Intent To Issue a Reexamination Certificate on June 16, 2005 in accordance with MPEP 2287, II.

Telephone inquiries relative to this decision should be directed to Special Programs Examiner Kenneth J. Dorner at (571) 272-6587.



Kenneth J. Dorner, Special Programs Examiner
Patent Technology Center 3600
(571) 272-6587

kjd: 10/5/05

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Costas S. Krikelis
Ratner and Prestia
P O Box 1596
Wilmington DE 19899

(For Patent Owner)

MAILED

MAY 19 2005

REEXAM UNIT

In re Reexamination Proceeding :
Donald J. Sauer :
Control No. 90/006,003 : DECISION GRANTING PETITION
Filed: May 11, 2001 :
U.S. Patent No. 5,336,879 :
Attorney Docket No. DSR-1279US :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on January 27, 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 $1,500.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3). The requisite response, an amendment (item 1), was previously filed on November 26, 2004, with a copy of the amendment in a slightly different format being filed with the present petition.

The petition is granted.

A review of the record reveals that the amendment filed November 26, 2004, is not in compliance with the manner of making amendments for reexamination proceedings (as strike-through is not permitted), and therefore, will not be entered or used during the prosecution of this application. 37 CFR 1.530 (d)-(j).

The copy of the amendment filed January 27, 2005, with the present petition will be used for examination purposes.

§ 1.550 Conduct of *ex parte* reexamination proceedings (c) states:

> The time for taking any action by a patent owner in an *ex parte* 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 fee 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 or for commencing a civil action.

37 CFR 1.136(a) does not apply to reexamination proceedings. The time for taking any action by a patent owner in an *ex parte* 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 37 CFR 1.550(c) set forth above.

The reexamination file is being returned to Technology Center Art Unit 2878 for further examination and consideration of the amendment filed January 27, 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, Stephone Allen, in Technology Center Art Unit 2878, who can be reached at 571-272-2434.

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

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address COMMISSIONER OF PATENTS AND TRADEMARKS
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,005	05/11/2001	5763831	1390/679	2338

23123 7590 06/03/2003

SCHMEISER OLSEN & WATTS
18 E UNIVERSITY DRIVE
SUITE # 101
MESA, AZ 85201

EXAMINER	
ESTRADA	
ART UNIT	**PAPER NUMBER**
2831	14

DATE MAILED: 06/03/2003

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

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.
90/006,497	12/27/2002	5763831	1390/679	6163

23123 7590 06/03/2003

SCHMEISER OLSEN & WATTS
18 E UNIVERSITY DRIVE
SUITE # 101
MESA, AZ 85201

EXAMINER	
ESTRADA	
ART UNIT	PAPER NUMBER
2831	14

DATE MAILED: 06/03/2003

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

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UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Paper No. 14

Schmeiser Olsen & Watts
18 E. University Drive, Suite 101
Mesa, AZ 85201

(for patent owner)

William F. Prendergast
Brinks, Hofer, Gilson & Lione
P.O. Box 10395
Chicago, IL 60610

(for requester)

In re Shotey *et al.*
Reexamination Proceeding
Control Number 90/006,005
Filed: May 11, 2001
For: U.S. Patent No. 5,763,831

DECISION MERGING
REEXAMINATION PROCEEDINGS

In re Shotey *et al.*
Reexamination Proceeding
Control Number 90/006,005
Filed: December 27, 2002
For: U.S. Patent No. 5,763,831

MAILED

JUN 0 3 2003

TECHNOLOGY CENTER 2800
SPECIAL PROGRAM CENTER

DECISION MERGING REEXAMINATION PROCEEDINGS

The above-identified reexamination files are before the Director of Examining Group 2830, Technology Center 2800, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 5,763,831 issued on June 9, 1998.

2. A first request for reexamination, Reexamination Control No. 90/006,005, was filed by a third party requester on May 11, 2001.

3. Reexamination was ordered in the '005 reexamination proceeding on August 3, 2001.

4. A statement indicating that the patent owner elects not to file a patent owner's statement was filed on February 28, 2002.

5. A non-final Office action was mailed on July 10, 2002, rejecting claims 8-12 and 14-16 under 35 U.S.C. §§ 102 and 103, and confirming the patentability of claims 1-7, 13, and 17-20.

6. A telephone interview between Michael Shotey, an inventor, Ken Booth, representative for patent owner, Angel Estrada and Dean Reichard, PTO personnel, was held on September 10, 2002.

7. An amendment amending claims 8 and 14, and adding new claims 21-40 was submitted on September 10, 2002, the same day the telephone interview was held.

8. On November 21, 2002, an Information Disclosure Statement and a supplemental amendment amending claim 14 and adding new claim 41 was submitted. A certificate of service for the communications of November 21, 2002, was filed on December 4, 2002.

9. A Notice of Defective Paper in Ex Parte Reexamination was mailed on December 10, 2002, indicating that the amendments filed September 10, 2002 and November 21, 2002, did not fully comply with 37 C.F.R. § 1.530(d)-(j).

10. A second request for reexamination, Reexamination Control No. 90/006,497, was filed by the third party requester on December 27, 2002.

11. A Notice of Concurrent Office Proceeding was filed on January 3, 2003, by the third party requester.

12. On January 10, 2003, an amendment in response to the notice mailed December 10, 2002 was filed.

13. Reexamination was ordered in the '497 reexamination proceeding on March 14, 2003.

14. To date, no patent owner's statement pursuant to 37 C.F.R. § 1.530(b) has been received for the '497 reexamination proceeding and the two-month time period for filing such statement has expired.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

> If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* reexamination proceeding has not been terminated, the *ex parte* reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570.

As noted above, 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 of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '005 and '497 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 '005 reexamination proceeding and the claims have not been amended in the '497 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. 90/006,005 and 90/006,497 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.

Richard K. Seidel, Group Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

U.S. Patent and Trademark Office

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

William F. Prendergast
Brinks Hofer Gilson & Lione
P O Box 10395
Chicago, Illinois 60610

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/006,497*.

PATENT NO. *5763831*.

ART UNIT *2831*.

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(e)).

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(e)).

UNITED STATES PATENT AND TRADEMARK OFFICE

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WASHINGTON, D.C 20231
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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

William F. Prendergast
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P.O Box 10395
Chicago, IL 60610

REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/006,005*.

PATENT NO. *5763831* .

ART UNIT *2831* .

Enclosed is a copy of the latest communication from the Patent and Trademark Office in the above identified reexamination proceeding (37 CFR 1.550 (e)).

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 reexamination requester will be acknowledge or considered (37 CFR 1.550 (e)).

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

FEB 12 2002

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FEB 12 2002
OFFICE OF THE DIRECTOR
TC 3600

Reexamination Control No. 90/006,010 – Paper No. 8
Reexamination Control No. 90/006,080 – Paper No. 8

FOR PATENT OWNER:

OYEN WIGGS GREEN & MUTALA
#480-The Station
601 West Cordova Street
Vancouver, B.C.
Canada V6B 1-G1

DECISION ON REEXAMINATION MERGER
37 CFR 1.565(c)

Reexam Control Nos. 90/006,010 and 90/006,080

FOR REQUESTER:

E.I. DuPont de Nemours & Co.,c/o
Roger D. Schaffer, Esq..
Clifford Chance Rogers & Wells LLP
200 Park Avenue
New York, NY 10166-0153

Page 1 of 5 pages

NOTICE OF CONSOLIDATION OF REEXAMINATION PROCEEDINGS

Background

1. U.S. Letters Patent No. 5,826,390 issued on October 27, 1998.

2. A first request for reexamination was filed by the patent owner, Sacks Industrial Corp. on May 17, 2001, and was assigned Reexamination Control No. 90/006,010.

3. On August 13, 2001, a second request for reexamination of U.S. Letters Patent No. 5,826,390 was filed by a third party requester, E.I. DuPont de Nemours & Co., and was assigned Reexamination Control No. 90/006,080

4. Reexamination was ordered in Reexamination Control No. 90/006,010 on July 23, 2001 and in Reexamination Control No. 90/006,080 on November 7, 2001.

5. An Information Disclosure Statement was filed by the patent owner on August 14, 2001 in Reexamination Control No. 90/ 006,010.

6. On January 4, 2002, the patent owner filed a notice that he would not be filing a Patent Owner's Statement in Reexamination Control No. 90/006,080.

Application/Control Number: 90/006,080
Art Unit: 3992

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 both reexamination proceedings. 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. 90/006,010 and 90/006,080 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 requester and such requester will be sent copies of all papers mailed by the Office during these merged proceedings.

Conclusion

Reexamination Control Nos. 90/006,010 and 90/006,080 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 :

Gerald Goldberg
Director
Technology Center 3600

90006010 . 091602

mas

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Lucian Wayne Beavers (For Requester)
Waddey and Patterson
Suite 2020, Bank of America Plaza
Nashville, TN 37219

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MAR 1 4 2005

REEXAM UNIT

In re Frederick :
Reexamination Proceeding : **DECISION**
Control No. 90/006,019 : **ON PETITIONS**
Filed: May 25, 2001 :
For: U.S. Patent No. 5,308,196 :
:

This is a decision on the February 24, 2003, patent owner petition for entry of belated papers filed under 37 C.F.R. § 1.137(b), based upon unintentional delay, or alternatively, a petition to suspend the rules and enter paper. This is also a decision on the February 24, 2003, and March 4, 2003, petitions to expunge information filed under 37 C.F.R. § 1.59(b). The petitions are before the Office of Patent Legal Administration for decision.

The petition fee of $1300.00 pursuant to 37 C.F.R. § 1.17(m) for the petition under 37 C.F.R. § 1.137(b) has been charged to deposit account 50-0581, per the instructions on page 3 of the instant petition. The petition to expunge indicated that a check accompanied the petition, however, no check was received by the Office. Accordingly, the petition fee of $130.00 pursuant to 37 C.F.R. § 1.17(h) has been charged to deposit account 50-0581 using the fee authorization on page 3 of the "Additional Response to Second Office Action in Reexamination" filed February 24, 2003.

The petition for revival under 37 C.F.R. § 1.137(b) based upon unintentional delay is **granted** for the reasons indicated below. The petition to suspend the rules is **dismissed** as being moot in view of the granting of the unintentional delay petition. The petition to expunge information pursuant to 37 C.F.R. § 1.59(b) is **dismissed** for the reasons indicated below.

DECISION

With respect to the petition considered under 37 CFR 1.137(b):

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)(II)(C) and (D).

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 instant petition includes a statement that the "entire delay in the time period from January 18, 2003 when the response to office action was due until February 14, 2003 when the response to office action was actually filed was inadvertant, unintentional, and without deceptive intent." The statement contained in the petition varies from the language required by 37 C.F.R. § 1.137(b)(3); however, the statement contained in the 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 petition fee was paid, and was accompanied by, *inter alia*, a statement filed to supplement the original response to the outstanding nonfinal Office action, received November 13, 2002, and a statement in response to the notice of defective paper mailed December 18, 2002, which meet the criteria of 37 C.F.R. § 1.137(b)(1).

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).

A terminal disclaimer and fee accompanied the petition for entry of late papers filed February 24, 2003. It should be noted that no terminal disclaimer was required to be filed with the instant petition. See 37 CFR § 1.137(d)(3).

With respect to the petition considered under 37 CFR 1.183:

The instant petition requested, in the alternative, that the petition for entry of late papers under 37 C.F.R. § 1.137(b) be considered as a petition to suspend the rules. This request has been construed as a petition under 37 C.F.R. § 1.183. In view of the granting of the petition for entry of late papers under 37 C.F.R. § 1.137(b), the petition under 37 C.F.R. § 1.183 is dismissed as moot.

With respect to the petition considered under 37 CFR 1.59(b):

The petition requested to expunge portions of a declaration filed June 5, 2002, and signed by Kerry A. Frame (hereinafter referred to as the "Frame declaration"). The petition stated that the information to be expunged was considered by the examiner and was found to be insufficient to provide a persuasive rebuttal to the examiner's assertions. The petition further stated that the relevant portions of the declaration were not believed to be material information under 37 C.F.R. § 1.56, and that said information was believed by the licensee to constitute trade secrets. The petition also stated that "irreparable harm may come" to both the assignee and the licensee if the information is not expunged.

37 C.F.R. § 1.59(b) states:

> (b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(h) and establish to the

satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

The instant petition fails to meet the burden in 37 C.F.R. § 1.59(b) of establishing that expungement of the information is appropriate in this instance. *Ex parte* reexaminations are open to the public. See MPEP 2209. As such, the application papers, including the Frame declaration, were scanned into the Office's Image File Wrapper (IFW) system and made available to the public via the Internet.

While petitioner contends that, in his belief, the information contained in the Frame declaration "is not material information under 37 C.F.R. § 1.56," the declaration was filed in the above-identified *ex parte* reexamination application in response to the nonfinal Office action mailed March 25, 2002. The examiner provided a detailed response to the declaration in the Office action mailed August 28, 2002. The fact that the examiner found the declaration insufficient to overcome the rejection of Claim 32 does not render it immaterial. Furthermore, removal of the Frame declaration would confuse the record since the document is discussed in the Office action mailed August 28, 2002. Accordingly, the Frame declaration is, on its face, considered material to patentability and relevant to the record.

Petitioner asserts a belief that "irreparable harm" may come to both the patent assignee and the patent licensee if the Frame declaration is not expunged. The instant petition provided no evidence in support of this belief, and as such, has not established that the expungement of the information is appropriate.

In view of the above, the petition for expungement is not sufficient to meet the criteria set forth under 37 C.F.R. § 1.59(b).

The petition for revival under 37 C.F.R. § 1.137(b) is **granted**. The petition to suspend the rules is **dismissed** as being moot. The petition to expunge information under 37 C.F.R. § 1.59(b) is **dismissed**.

CONCLUSION

1. The petition under 37 C.F.R. § 1.137(b) is **granted**.

2. The petition under 37 C.F.R. § 1.183 is **dismissed** as moot.

3. The petition under 37 C.F.R. § 1.59(b) is **dismissed**.

4. The reexamination file will be returned to Technology Center 3600, for the examiner's immediate consideration of the supplemental response and the response to the notice of defective papers mailed December 18, 2002.

5. Any inquiries with regard to the merits of this proceeding should be directed to Examiner John Kreck, of Group Art Unit 3673.

6. Any telephone inquiries with regard to this decision should be directed to Terry J. Dey at (571) 272-7730 or to the undersigned at (571) 272-7722.

Lynn M. Kryza
Senior Patent Special Projects Advisor
Office of Patent Legal Administration

March 11, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,019	05/25/2001	5308196	N-7236	9959

7590 06/16/2005

EXAMINER	

Daniel P. McCarthy
Parsons Behle and Latimer
201 South Main Street, Suite 1800
P.O. Box 45898
Salt Lake City, UT 84145

ART UNIT	PAPER NUMBER

DATE MAILED: 06/16/2005

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Daniel P. McCarthy
Parsons Behle and Latimer
201 South Main Street, Suite 1800
P.O. Box 45898
Salt Lake City UT 84145

(For Patent Owner)

MAILED
JUN 16 2005
REEXAM UNIT

Lucien Wayne Beavers
Waddy and Patterson
Suite 2020
Bank of America Plaza
Nashville, TN 37219

(For Requesteor)

In re Reexamination Proceeding :
John R. Frederick :
Control No. 90/006,019 : DECISION ON PETITIONS
Filed: May 25, 2001 :
U.S. Patent No. 5,308,196 :
Attorney Docket No. N-7236 :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on May 20, 2005, for entry of belated papers filed under 37 CFR 1.137(b) based upon unintentional delay, or in the alternative, the petition to suspend the rules under 37 CFR 1.183 and enter the response.

The petitions are 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*, the requisite response entitled,

Reply To Notice of Defective Paper in Ex Parte Reexamination (item 1), an authorization to charge the requisite petition fee to counsel's deposit account (item 2) and the requisite statement (item 3).

The petition under 37 CFR 1.137(b) is granted.

The instant petition requested, in the alternative, that the petition be considered as a petition to suspend the rules under 37 CFR 1.183. In view of the granting of the petition under 37 CFR 1.137(b), the petition under 37 CFR 1.183 is dismissed as moot.

The $1,500.00 petition fee under 37 CFR 1.137(b) has been charged to counsel's deposit account as authorized in the present petition.

Thereafter, the reexamination file will be returned to Technology Center Art Unit 3673 for further examination and consideration of the amendment filed May 20, 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, John Kreck, in Technology Center Art Unit 3673, who can be reached at 571-272-4429.

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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,019	05/25/2001	5308196	N-7236	9959

7590 12/05/2005

EXAMINER	

ART UNIT	PAPER NUMBER

Daniel P. McCarthy
Parsons Behle and Latimer
201 South Main Street, Suite 1800
P.O. Box 45898
Salt Lake City, UT 84145

DATE MAILED: 12/05/2005

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Daniel P. McCarthy, Esq. (For Patent Owner)
Parsons Behle and Latimer
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P.O. Box 45898
Salt Lake City, UT 84145

MAILED
DEC 05 2005
REEXAM UNIT

Lucien Wayne Beavers (For Third Party Requestor)
Waddey and Patterson
Roundabout Plaza
1600 Division Street, Suite 500
Nashville, TN 37203

Frederick, John R. :
Reexamination Proceeding : **DECISION**
Control No. 90/006,019 : **GRANTING**
Filed: May 25, 2001 : **PETITION**
For: U.S. Patent No. 5,308,196 :

This is a decision on the September 23, 2005, patent owner PETITION UNDER 37 CFR 1.137(b), 1.313 OR 1.183, including the following requests:

1. Revival of the present proceeding under the "unintentional" standard under 37 CFR 1.137(b);
2. To the extent necessary, withdrawal from Issue of an *Ex Parte* Reexamination Certificate under 37 CFR 1.313; and
3. To the extent necessary, suspension of rules under 37 CFR 1.183.

The petition is before the Office of Patent Legal Administration for decision.

The petition fee of $1,500.00 set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b) has been charged to petitioner's Deposit Account No. 50-0581, in accordance with petitioner's authorization on page two of the petition sent via facsimile on September 23, 2005.

The petition under 37 CFR 1.137(b) is granted.

DECISION

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, a Renewed Amendment was filed on December 2, 2005,[1] to accompany patent owner's September 23, 2005 petition. The Renewed Amendment presents the claims in proper marked-up form and incorporates by reference the Remarks in the Amendment originally submitted with the September 23, 2005 petition. The combination of the Remarks and the Renewed Amendment thereby provides the response "required to the outstanding Office action or notice" pursuant to 37 CFR 1.137(b)(1). Further, the required petition fee is being charged to petitioner's deposit account as authorized on page two of the 37 CFR 1.137(b) petition, thereby providing the "petition fee as set forth in 37 CFR 1.17(m)" pursuant to 37 CFR 1.137(b)(2). Accordingly, the petition the petition, to the extent that relief is requested under 37 CFR 1.137(b), is granted.

There is no need to address the requested withdrawal from Issue of "an *Ex Parte* Reexamination Certificate" under 37 CFR 1.313, since the proceeding has not begun the publication process. In addition, there is no need to address the requested suspension of rules under 37 CFR 1.183, since the relief requested by patent owner as to restoring the proceeding to pendency has been afforded under 37 CFR 1.137(b). Accordingly, the petition, to the extent that relief is requested under 37 CFR 1.313 and under 37 CFR 1.183 is dismissed as moot. It is further to be noted that 37 CFR 1.313 applies to withdrawal from issue of applications, and does not apply to a reexamination proceeding.

AMENDMENTS IN REEXAMINATION

The patent owner is reminded that amendments in a reexamination proceeding are submitted in accordance with 37 CFR 1.530(d)+. Thus, the filing of any future amendments to the drawings, specification, or claims must comply with the provisions of 37 CFR 1.530(d)+ and the guidelines of MPEP 2250+. It is to be noted that 37 CFR 1.121 does not apply to amendments in a reexamination proceeding. Rather, pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and the drawings, which are in effect for the patent

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[1]In response to a request for same, in a telephone call made by Legal Advisor Samuel Broda to the office of Daniel McCarthy on December 1, 2005.

being reexamined; amendments are not to be made relative to previous amendments. Amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim. Thus, for all amendments other than claim cancellation, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets. Further, clean copies of the amended claims are not required, and such clean copies are not to be submitted.

CONCLUSION

1. The petition, to the extent that relief is requested under 37 CFR 1.137(b), is **granted**.

2. The petition, to the extent that relief is requested under 37 CFR 1.313 and under 37 CFR 1.183, is **dismissed**.

3. Jurisdiction over the reexamination proceeding is being returned to Technology Center 3600 for consideration, in due course, of the Renewed Amendment filed December 2,2005 to accompany the petition.

4. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, John Kreck, in Art Unit 3673, who can be reached at (571) 272-6828.

5. Telephone inquiries related to this decision should be directed to Samuel Broda, Legal Advisor, at (571)272-7711.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

December 5, 2005
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MAILED
FROM DIRECTORS OFFICE
MAY 05 2006
TECHNOLOGY CENTER 3600

Daniel P. McCarthy (For Patent Owner)
Parsons Behle and Latimer
201 South Main Street, Suite 1800
P.O. Box 45898
Salt Lake City, UT

REQUEST FOR EXTENSION OF TIME
37 CFR 1.550(c)

Lucian Wayne Beavers (For Requestor)
Waddey & Patterson
414 Union Street, Suite 2020
Bank of America Plaza
Nashville, TN 37219

In re Ex Parte Reexamination proceeding 90/006,019
Filed: May 25, 2001
For: YIELDABLE CONFINED CORE MINE ROOF SUPPORT

This is a decision on the request for extension of time filed by the Patent Owner under 37 CFR 1.550(c) on May 2, 2006.

A final Office action was mailed on March 7, 2006 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 March 7, 2006 final Office action. The reason for the request is that affidavits are needed to support arguments in support of patentability to be filed in response to the March 7, 2006 final Office action. The individuals that the owner has identified as being qualified to make such affidavits have only become available in the last day. The affidavits are expected to be lengthy due to the technical nature and amount of facts and/or data contained therein.

An extension of time for the Patent Owner to submit a response is granted for a period of one month. The period for response will expire on June 7, 2006.

Further extensions of time to respond to the Office action should not be expected, and will be granted only in extraordinary circumstances.

Petitioner has indicated that he has been authorized to act on behalf of the patent owner to conduct the prosecution of this reexamination proceeding. However, since no revocation/new power of attorney and/or change of address have been filed, this correspondence is being sent to the attorney of record at the correspondence address of record. A courtesy copy is being sent to petitioner. Future correspondence should not be expected to be sent anywhere but the current correspondence address of record.

SUMMARY: Request **granted**.

Kenneth J. Dorner
Special Programs Examiner
Technology Center 3600
(571) 272-6587

Concur:
Donald Hajec, Director
Technology Center 3600
(571) 272-5150

cc: Christopher Kulish
Holland & Hart, LLP
P.O. Box 8749
Denver, CO 80201-8749

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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NOV - 7 2001

Paper No. 9

Fred H. Zollinger III
Sand and Sebolt
Aston Park Professional Center
Suite 194
4801 Dressler Road NW
Canton, OH 44718

(For Patent Owner)

Stephen A. Becker
McDermott Will & Emery
600 13th Street NW
Washington, DC 20005-3096

(For Requester)

In re Nexpak Corporation :
Reexamination Proceeding :
Control No. 90/006,020 :
Filed: May 25, 2001 :
For: U.S. Patent No. 5,944,185 :
: DECISION, *SUA SPONTE*,
: MERGING REEXAMINATION
: PROCEEDINGS
In re Nexpak Corporation :
Reexamination Proceeding :
Control No. 90/006,047 :
Filed: June 29, 2001 :
For: U.S. Patent No. 5,944,185 :

The above noted reexamination files are before the Director of Patent Examining Group 3720 for consideration of merger of the proceedings under 37 CFR 1.565(c), in accordance with the practice set forth at MPEP § 2283.

I Merger of Proceedings

As required by the practice pursuant to MPEP § 2283, and under the authority of 37 CFR 1.565(c), the '020 and '047 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

Patent 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. 9 in both files. There will be no paper Nos. 6-8 in Control No. 90/006,047.

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. Requester will receive the body of the action, with the appropriate cover sheet, while Owner will receive the body of the action and a copy of each cover sheet. All papers filed by Owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by Owner must consist of a single response, filed in duplicate, each bearing an original signature, for entry in each file. Owner and Requester are reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on the other party, including papers filed *via* facsimile transmission. 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 format. **Clean copies of the amended claims are not required; only so called "marked-up" copies of the claims in which all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets are required.**

IV. Housekeeping Amendment

It is noted that Owner filed a preliminary amendment in control No. 90/006,020. That amendment will be entered prior to the commencement of *ex parte* examination Therefore, Owner is required to file a housekeeping amendment in control No. 90/006,047 entering the identical claims therein. That paper will be paper No. 10 in control No. 90/006,047. There will be no paper No. 10 in 90/006,020, unless Owner elects to file additional claims. If that is the case, such additional claims must also be added to the housekeeping amendment filed in control No. 90/006,047. The next action by the Primary Examiner will be paper No. 11 in both files. **Owner is required to file the housekeeping amendment not later than ONE MONTH from the date of this decision.**

V. Citation of Patents and Printed Publications

Following the filing of the housekeeping amendment, the examiner will promulgate an action on the merits of the claims. That action will be paper No. 11. The examiner will review the files to insure that each file contains identical citations of prior patents and printed publications, and will make cite such documents as are necessary as part of the next action in order to place the files in that condition.

The reexamination proceeding files are being returned to storage in the Technology Center 3700 Central Files awaiting the filing of the above described housekeeping amendment. The amendment must be filed by Owner **not later than one month from the date of this decision.**

E. Rollins-Cross, Director, Patent
Examining Groups 3210 & 3720

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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NOV - 7 2001

Paper No. 9

Fred H. Zollinger III
Sand and Sebolt
Aston Park Professional Center
Suite 194
4801 Dressler Road NW
Canton, OH 44718

(For Patent Owner)

Stephen A. Becker
McDermott Will & Emery
600 13th Street NW
Washington, DC 20005-3096

(For Requester)

In re Nexpak Corporation
Reexamination Proceeding
Control No. 90/006,021
Filed: May 25, 2001
For: U.S. Patent No. 6,135,280

In re Nexpak Corporation
Reexamination Proceeding
Control No. 90/006,048
Filed: June 29, 2001
For: U.S. Patent No. 6,135,280

DECISION, *SUA SPONTE*,
MERGING REEXAMINATION
PROCEEDINGS

The above noted reexamination files are before the Director of Patent Examining Group 3720 for consideration of merger of the proceedings under 37 CFR 1.565(c), in accordance with the practice set forth at MPEP § 2283.

I. Merger of Proceedings

As required by the practice pursuant to MPEP § 2283, and under the authority of 37 CFR 1.565(c), the '021 and '048 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

Patent 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. 9 in both files. There will be no paper Nos. 6-8 in Control No. 90/006,048.

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. Requester will receive the body of the action, with the appropriate cover sheet, while Owner will receive the body of the action and a copy of each cover sheet. All papers filed by Owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by Owner must consist of a single response, filed in duplicate, each bearing an original signature, for entry in each file. Owner and Requester are reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on the other party, including papers filed *via* facsimile transmission. 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 format. **Clean copies of the amended claims are not required; only so called "marked-up" copies of the claims in which all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets are required.**

IV. Housekeeping Amendment

It is noted that Owner filed a preliminary amendment in control No. 90/006,021. That amendment will be entered prior to the commencement of *ex parte* examination. Therefore, Owner is required to file a housekeeping amendment in control No. 90/006,048 entering the identical claims therein. That paper will be paper No. 10 in control No. 90/006,048. There will be no paper No. 10 in 90/006,021, unless Owner elects to file additional claims. If that is the case, such additional claims must also be added to the housekeeping amendment filed in control No. 90/006,048. The next action by the Primary Examiner will be paper No. 11 in both files. **Owner is required to file the housekeeping amendment not later than ONE MONTH from the date of this decision.**

V. Citation of Patents and Printed Publications

Following the filing of the housekeeping amendment, the examiner will promulgate an action on the merits of the claims. That action will be paper No. 11. The examiner will review the files to insure that each file contains identical citations of prior patents and printed publications, and will make cite such documents as are necessary as part of the next action in order to place the files in that condition.

The reexamination proceeding files are being returned to storage in the Technology Center 3700 Central Files awaiting the filing of the above described housekeeping amendment. The amendment must be filed by Owner **not later than one month from the date of this decision.**

E. Rollins-Cross, Director, Patent
Examining Groups 3210 & 3720

UNITED STATES PATENT AND TRADEMARK OFFICE

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Wacker Drive Station, Sears Tower
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(For Third Party Requester)

In re Hsue et al
Reexamination Proceeding
Control No.: 90/006, 029
Filed: June 7, 2001
For: U.S. Patent No.: 5,559,352

: DECISION
: GRANTING
: PETITION

MAILED
JAN 30 2006
REEXAM UNIT

This is a decision on the December 12, 2005 patent owner petition entitled PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b).

The petition is before the Office of Patent Legal Administration for decision.

The petition fee of $1,500.00 set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b) has been charged to petitioner's Deposit Account No. 23-3264, pursuant to petitioner's authorization on the Fee Transmittal Form PTO/SB/17 included with the petition filed on December 12, 2005.

The petition under 37 CFR 1.137(b) is granted.

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, a (Revised) Amendment C & Response to Advisory Office Action containing a corrected amendment was filed on January 19, 2006,[1] to accompany patent owner's December 12, 2005 petition. The corrected amendment presents the claims in proper marked-up form and incorporates by reference the Remarks in the Amendment originally submitted with the December 12, 2005 petition. The combination of the Remarks and the corrected amendment thereby

[1] In response to a request for same, in a telephone call made by Samuel Broda to J. Nicholas Gross on January 19, 2006.

provides the response "required to the outstanding Office action or notice" pursuant to 37 CFR 1.137(b)(1). Further, the required petition fee is being charged to petitioner's deposit account as authorized on the Fee Transmittal Form PTO/SB/17 included with the petition, thereby providing the "petition fee as set forth in 37 CFR 1.17(m)" pursuant to 37 CFR 1.137(b)(2). Accordingly, the petition under 37 CFR 1.137(b) is granted.

The terminal disclaimer proffered with the instant petition is not required for the granting of the petition, since it is not applicable in reexamination proceedings. 37 CFR 1.137(d)(3) states (emphasis added):

> "**The provisions of paragraph (d)(1) of this section do not apply** to applications for which revival is sought solely for purposes of copendency with a utility or plant application filed on or after June 8, 1995, to lapsed patents, to reissue applications, **or to reexamination proceedings.**"

See also the text appearing in MPEP Section 711.013(c) (8th Edition Rev. 3, August 2005) under the heading "G. Terminal Disclaimer Requirement."

Because the proffered terminal disclaimer and its accompanying fee are inapplicable in reexamination proceedings: (1) the terminal disclaimer has not been entered, and (2) the terminal disclaimer fee of $130 authorized via the Fee Transmittal Form has not been charged to petitioner's deposit account.

CONCLUSION

1. The petition under 37 CFR 1.137(b) is granted.

2. The terminal disclaimer submitted as part of the petition under 37 CFR 1.137(b) has not been entered.

3. Jurisdiction over the reexamination proceeding is being returned to Technology Center 2800 for consideration, in due course, of the (Revised) Amendment C filed January 19, 2006 , and the corresponding Remarks filed December 12, 2005.

4. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Allan Wilson , in Art Unit 2815, who can be reached at (571) 272-1738.

5. Telephone inquiries related to this decision should be directed to Samuel Broda at (571) 272-7711.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

SSB
1/19/2006

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1/27/06

UNITED STATES PATENT AND TRADEMARK OFFICE

Paper No. 8

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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MC DONNELL BOEHNEN HULBERT
& BERGHOFF, LTD.
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CHICAGO, IL 60606

(For Patent Owner)

KAWAI LAU
MORRISON & FOERSTER LLP
3811 VALLEY CENTRE DRIVE
SUITE 500
SAN DIEGO, CA 92130-2332

(For Third Party Requester)

MAILED

NOV 26 2001

REEXAM UNIT

In re Sullenger et al. :
Reexamination Proceeding : DECISION
Control No. 90/006,036 : DISMISSING
Filed: June 11, 2001 : PETITION
For: U.S. Patent No. 5,854,038 :

This is a decision on the October 12, 2001, patent owner "PETITION TO GRANT REEXAMINATION ON THE BASIS OF A SPECIFIC DOCUMENT 37 C.F.R. § 1.515(c) AND 37 C.F.R. § 1.181." The petition is taken as a petition under 37 CFR 1.182 and 37 CFR 1.182, for the reasons discussed below.

A petition fee of $130.00 has been charged to Deposit Account No. 03-1952 (referencing docket No. 397272801000) for the petition under 37 CFR 1.182 and 37 CFR 1.182, as authorized in the last paragraph of the petition.

The petition is before the Office of Patent Legal Administration for decision.

The petition under 37 CFR 1.182 and 37 CFR 1.183 is dismissed for the reasons pointed out below.

REVIEW OF FACTS

1. U.S. Patent No. 5,854,038 (the '038 patent) issued to Sullenger et al on December 29, 1998.

2. On June 11, 2001 , a request for reexamination of the '038 patent was filed by a third party requester and was assigned Control No. 90/006,036 (the '6036 proceeding). Reexamination was requested based upon two publications - Dropulic et al (1991) and Dropulic et al (1992).

3. On September 6, 2001, an order granting reexamination was issued in the '6036 proceeding. Reexamination was granted based upon Dropulic et al (1991). The decision also found that Dropulic et al (1992) did not provide a basis for reexamination, because this publication was "made of record in the '038 patent and portions thereof were cited in an Office action." Accordingly, the examiner presumed that "the patentability of claims 1-13 under 35 U.S.C. § 102 or § 103 was considered." [See page 1 of the "Decision on Request for Reexamination."]

4. On October 12, 2001, patent owner filed the present "PETITION TO GRANT REEXAMINATION ON THE BASIS OF A SPECIFIC DOCUMENT 37 C.F.R. § 1.515(c) AND 37 C.F.R. § 1.181," requesting "reversal" of the decision not to grant reexamination based upon Dropulic et al (1992).

Page 2 of 6

THE PRESENT PETITION IS TAKEN AS A PETITION UNDER 37 CFR 1.182 AND 37 CFR 1.183

The relief that was requested in petitioner's June 11, 2001, request for reexamination was the reexamination of the '038 patent. That relief was granted the September 6, 2001, Order Granting Reexamination. It is unfortunate that the examiner stated at page 1 of the September 6, 2001, Order:

> "Therefore, Dropulic et al (1992) does not raise a substantial new question of patentability vis-a-vis claims 1-13 of the '038 patent **and the request for reexamination is denied.**" [Emphasis Added]

This statement by the examiner was not, however, a correct statement, because the request for reexamination was in no way denied; rather, the Office declined to find a substantial new question of patentability based upon one of the two grounds for reexamination advanced by requester.

As stated in part (1) of the cover sheet of the September 6, 2001, Order [the examiner placed an X in that box], "The request for reexamination is GRANTED." Thus, the Office has exercised jurisdiction over the '038 patent, to reexamine the patent in the examination stage of the proceeding, to follow. That the Office declined to find a substantial new question of patentability based upon one of the grounds for reexamination advanced by requester does not change the fact that reexamination was granted.

The first sentence of 37 CFR 1.515(c) states:

> "The requester may seek review by a petition to the Commissioner under § 1.181 within one month of the mailing date of the examiner's determination **refusing *ex parte* reexamination.** Any such petition must comply with § 1.181(b)." [Emphasis Added]

In the present instance, there has been no determination refusing reexamination. Although one of requester's proposed grounds for reexamination has not been adopted, reexamination has been granted, and the proceeding will advance to the examination stage in due course. Thus, the present petition under 37 CFR 1.515(c) and 37 CFR 1.181, as requester has titled the petition, cannot in fact be based upon 37 CFR 1.515(c), since there is no authority for such in that rule. Further, requester has not advanced any other grounds to support the presentation of the petition. Accordingly, the petition is taken as a petition based upon 37 CFR 1.182, for a situation not specifically provided for in the regulations.[1]

Even though the present petition is taken as a petition under 37 CFR 1.182, it still remains to be determined is whether the

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[1] 37 CFR 1.182 reads as follows:
All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Commissioner, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(h).

petition has an entry right. In regard to this, the second sentence of 37 CFR 1.540 states:

> "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."

The present petition is not a statement pursuant to 37 CFR 1.530 nor is it a reply by the requester pursuant to 37 CFR 1.535.

In MPEP 2246, it is pointed out that a party may, at this stage of the proceeding, file a petition to vacate an *ultra vires* reexamination order and challenge the Office's jurisdiction to order the reexamination. The present petition is not, however, a challenge to Office's jurisdiction over the reexamination, since the Office has asserted jurisdiction based on the substantial new question of patentability provided by Dropulic et al (1991).

Accordingly, under the rules, the present petition does not have entry right. Rather, it would require a waiver of the second sentence of 37 CFR 1.540 to provide for entry and consideration of the present petition as a petition based upon 37 CFR 1.182. Such relief may be available only under 37 CFR 1.183 [2] and only "[I]n an extraordinary situation, when justice requires" suspension or waiver of the rules.

In view of this discussion, the present petition is taken as a petition under 37 CFR 1.183 to waive the second sentence of 37 CFR 1.540 and provide entry of the petition, and a petition under 37 CFR 1.182 to provide a review of the examiner's finding as to one of the two grounds of the request, which remedy is not specifically provided for in the regulations

A petition under 37 CFR 1.182 and/or 37 CFR 1.183 must be accompanied by the petition fee set forth in 37 CFR 1.17(h). Thus, a fee of $130.00 has been charged to Deposit Account No. 03-1952 (referencing docket No. 397272801000) for the petition, as authorized in the last paragraph of the petition.

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[2] Which provides for suspension or waiver of the rules.

DECISION

As pointed out above, 37 CFR 1.183 which provides for suspension or waiver of the rules only in an "extraordinary situation," when "justice requires" such suspension of the rules. Relief will only be granted under 37 CFR 1.183 if the present fact-situation makes out such an extraordinary situation, and the petition and the record has been reviewed in such context.

In MPEP 2246, the following is stated:

> "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).** [Emphasis Added]

In the present instance, the finding of a substantial new question to support the request for reexamination is based on less than all the grounds urged by the requester, and thus, the fact situation fall squarely within the guidelines of the MPEP. The petition has not set forth any showing as to why the present fact situation should be made an exception to the guidelines set forth in the MPEP, i.e., as to why the rules should be waived to permit entry and consideration of the petition. The petition sets forth no "extraordinary situation" that would justify entry of the petition to review a decision based on less than all the grounds urged by the requester, in spite of the general guidelines that there is no right to such a petition.

In the present instance, requester is not barred from obtaining the relief being sought. Rather, it appears that requester can obtain such relief via an alternative avenue. If requester desires a review of the examiner's refusal to find a substantial new question of patentability based on Dropulic et al (1992), requester is free to file a subsequent request for reexamination prior to the conclusion of the present reexamination proceeding in which only the art cited is Dropulic et al (1992).

MPEP 2240 states:

> If the second or subsequent requester does not include the prior art which raised a substantial new question of patentability in the pending reexamination, reexamination may or may not be ordered depending on whether the different prior art raises a substantial new question of patentability. The second or subsequent request should be determined on its own merits without reference to the pending reexamination.

Thus, if a second request is filed, the decision will be based on Dropulic et al (1992), without reference to Dropulic et al (1991), which was used as the basis for ordering reexamination in the present pending reexamination. If the second request is denied, requester would be free to petition that denial under 37 CFR 1.515(c). (Before filing such a request, however, petitioner may wish to take note of the advisory portion of this decision found below.)

An additional point as to the relief requested is as follows: During the examination stage of this reexamination proceeding, examiner is free to reconsider the *Portola* issue and the use of Dropulic et al (1992) by itself (although, again, the below "advisory" portion of this decision should be noted). Further, during the examination stage, the examiner is free to consider use Dropulic et al (1992) in combination with Dropulic et al (1991), even where its use alone is barred by the *Portola* analysis. Thus, the decision to not order reexamination based upon Dropulic et al (1992) does not bar further consideration of the publication in the proceeding; rather, requester will in fact obtain further consideration of Dropulic et al (1992) in the examination stage of the proceeding.

In conclusion, the petition has <u>not</u> provided a showing of an "extraordinary situation," where "justice requires" a waiver of the rules to grant entry of the petition and the relief requested. Accordingly, the present petition is dismissed.

Page 6 of 9

ADVISORY INFORMATION AS TO THE PORTOLA ISSUE RAISED IN THE PETITION

As an advisory matter only, the following is noted with respect to the *Portola Packaging* issue raised in the petition:

As a preliminary matter, it is pointed out that the final guidelines for reviewing requests for reexaminations and ongoing reexaminations for compliance with the *Portola Packaging* decision [3] that published in the *Federal Register* [4] have now been incorporated into MPEP 2242. Thus, the below discussion will reference the appropriate portions of MPEP 2242, rather than the original guidelines Notice.

As a general rule, a "substantial new question of patentability" is not raised by prior art presented in a reexamination request if the prior art was, in a prior related Office proceeding, (1) relied upon to reject any claim, and/or (2) cited and its relevance to patentability of any claim discussed. See *Portola Packaging, Inc.*, 110 F.3d at 790, 42 USPQ2d at 1299 (examiner presumed to have done his/her job). MPEP 2242 (see "POLICY IN SPECIFIC SITUATIONS" part A5), however, points out that "unusual fact patterns may appear in cases in which prior art was relied upon to reject any claim or cited and discussed with respect to the patentability of a claim in a prior related Office proceeding, but other evidence clearly shows that the examiner did not appreciate the issues raised in the reexamination request or the ongoing reexamination with respect to that art."

Petitioner urges that, despite the citation and consideration of Dropulic et al (1992) in the prosecution of the '038 patent, an "unusual fact pattern" exists, which permits the use of Dropulic et al (1992) as a sole basis for providing a substantial new question of patentability. Petitioner relies upon the first example of an "unusual fact pattern" given in MPEP 2242, stating:

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[3] *In re Portola Packaging Inc.*, 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997).

[4] *See Guidelines for Reexamination of Cases in View of In re Portola Packaging, Inc., 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997)*; Notice, 64 FR 15346 (March 31, 1999), 1223 *Off. Gaz. Pat. Office* 124 (June 22, 1999).

> "The first example of such unusual fact patterns relates to a textbook where only select information was discussed with respect to the patentability of the claims, but other information teaches what is required by the claims. While Dropulic et al (1992) is not a textbook, this "unusual fact pattern" is exactly that found here."

The present fact pattern is not, however, analogous to that set forth in MPEP 2242 for the textbook. On this point, the following discussion is presented:

Initially, the content of Dropulic et al (1992) is not of the large magnitude as is a text book. In the case of a textbook, there may be concern that the examiner in charge of the application reviewed one section of the textbook, or one chapter of the textbook, but did not review another. There is no such concern here. The Dropulic et al (1992) publication is pages 1432-1441 taken from Volume 66 (Number 3) of the *Journal of Virology*. It would be quite reasonable to presume that the examiner reviewed the entire Dropulic document, since it is only 10 pages. This is no more than a given U.S. patent, and an examiner was considered to have reviewed the entirety of a U.S. patent in *Portola Packaging*.

Additionally, the portion of Dropulic et al (1992) stated at page 4 of the present petition to be relied upon in the request for reexamination is found on same page of the Dropulic document as the page referred to in page 5 of the examiner's Office action attached as Exhibit A of the present petition. [This is page 1440 of the Dropulic document.] Content found on the same page of a document as that referred to in an Office action is again quite reasonably presumed to have been reviewed by the examiner.

Finally, it is noted that Dropulic et al (1992) was cited in the prosecution of the patent <u>by the examiner</u>. [See Notice of References cited dated May 30, 1994, attached to the paper 9 Office action.] It is to be presumed that, in reviewing the reference prior to citation of same and discussing it in an Office action, the examiner reviewed the entirety of the reference, in order to decide which portion of the reference to discuss in the Office action.

From the above, it can be observed that the fact pattern of the instant situation (as to Dropulic et al (1992)) is far removed from the textbook example of an "unusual fact pattern" given by the MPEP 2242 *Portola* Guidelines, and there would be no reason to assume an "unusual fact pattern" (as discussed in the guidelines) is presented here.

CONCLUSION

1. The petition under 37 CFR 1.182 and 37 CFR 1.183 is dismissed.

2. The reexamination file is being forwarded to the examiner via the Group Director of Technology Center 1600, for issuance of a first Office action in due course.

4. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Jeffery S. Parkin (703-308-2227), of Technology Center Art Unit 1648.

5. 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
Office of the Deputy Commissioner
for Patent Examining Policy

November 20, 2001
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UNITED STATES PATENT AND TRADEMARK OFFICE
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NOV - 7 2001

Paper No. 9

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(For Requester)

In re Nexpak Corporation
Reexamination Proceeding
Control No. 90/006,020
Filed: May 25, 2001
For: U.S. Patent No. 5,944,185

DECISION, *SUA SPONTE*,
MERGING REEXAMINATION
PROCEEDINGS

In re Nexpak Corporation
Reexamination Proceeding
Control No. 90/006,047
Filed: June 29, 2001
For: U.S. Patent No. 5,944,185

The above noted reexamination files are before the Director of Patent Examining Group 3720 for consideration of merger of the proceedings under 37 CFR 1.565(c), in accordance with the practice set forth at MPEP § 2283.

I. Merger of Proceedings

As required by the practice pursuant to MPEP § 2283, and under the authority of 37 CFR 1.565(c), the '020 and '047 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

Patent 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. 9 in both files. There will be no paper Nos. 6-8 in Control No. 90/006,047.

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. Requester will receive the body of the action, with the appropriate cover sheet, while Owner will receive the body of the action and a copy of each cover sheet. All papers filed by Owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by Owner must consist of a single response, filed in duplicate, each bearing an original signature, for entry in each file. Owner and Requester are reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on the other party, including papers filed *via* facsimile transmission. 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 format. **Clean copies of the amended claims are not required; only so called "marked-up" copies of the claims in which all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets are required.**

IV. Housekeeping Amendment

It is noted that Owner filed a preliminary amendment in control No. 90/006,020. That amendment will be entered prior to the commencement of *ex parte* examination. Therefore, Owner is required to file a housekeeping amendment in control No. 90/006,047 entering the identical claims therein. That paper will be paper No. 10 in control No. 90/006,047. There will be no paper No. 10 in 90/006,020, unless Owner elects to file additional claims. If that is the case, such additional claims must also be added to the housekeeping amendment filed in control No. 90/006,047. The next action by the Primary Examiner will be paper No. 11 in both files. **Owner is required to file the housekeeping amendment not later than ONE MONTH from the date of this decision.**

V. Citation of Patents and Printed Publications

Following the filing of the housekeeping amendment, the examiner will promulgate an action on the merits of the claims. That action will be paper No. 11. The examiner will review the files to insure that each file contains identical citations of prior patents and printed publications, and will make cite such documents as are necessary as part of the next action in order to place the files in that condition.

The reexamination proceeding files are being returned to storage in the Technology Center 3700 Central Files awaiting the filing of the above described housekeeping amendment. The amendment must be filed by Owner **not later than one month from the date of this decision.**

E. Rollins-Cross, Director, Patent
Examining Groups 3210 & 3720

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NOV - 7 2001

Paper No. 9

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(For Patent Owner)

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(For Requester)

In re Nexpak Corporation	:	
Reexamination Proceeding	:	
Control No. 90/006,021	:	
Filed: May 25, 2001	:	
For: U.S. Patent No. 6,135,280	:	
	:	DECISION, *SUA SPONTE*,
	:	MERGING REEXAMINATION
	:	PROCEEDINGS
In re Nexpak Corporation	:	
Reexamination Proceeding	:	
Control No. 90/006,048	:	
Filed: June 29, 2001	:	
For: U.S. Patent No. 6,135,280	:	

The above noted reexamination files are before the Director of Patent Examining Group 3720 for consideration of merger of the proceedings under 37 CFR 1.565(c), in accordance with the practice set forth at MPEP § 2283.

I. Merger of Proceedings

As required by the practice pursuant to MPEP § 2283, and under the authority of 37 CFR 1.565(c), the '021 and '048 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

Patent 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. 9 in both files. There will be no paper Nos. 6-8 in Control No. 90/006,048.

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IV. Housekeeping Amendment

It is noted that Owner filed a preliminary amendment in control No. 90/006,021. That amendment will be entered prior to the commencement of *ex parte* examination. Therefore, Owner is required to file a housekeeping amendment in control No. 90/006,048 entering the identical claims therein. That paper will be paper No. 10 in control No. 90/006,048. There will be no paper No. 10 in 90/006,021, unless Owner elects to file additional claims. If that is the case, such additional claims must also be added to the housekeeping amendment filed in control No. 90/006,048. The next action by the Primary Examiner will be paper No. 11 in both files. **Owner is required to file the housekeeping amendment not later than ONE MONTH from the date of this decision.**

V. Citation of Patents and Printed Publications

Following the filing of the housekeeping amendment, the examiner will promulgate an action on the merits of the claims. That action will be paper No. 11. The examiner will review the files to insure that each file contains identical citations of prior patents and printed publications, and will make cite such documents as are necessary as part of the next action in order to place the files in that condition.

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E. Rollins-Cross, Director, Patent
Examining Groups 3210 & 3720

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IV. Housekeeping Amendment

It is noted that Owner filed a preliminary amendment in control No. 90/006,021. That amendment will be entered prior to the commencement of *ex parte* examination. Therefore, Owner is required to file a housekeeping amendment in control No. 90/006,048 entering the identical claims therein. That paper will be paper No. 10 in control No. 90/006,048. There will be no paper No. 10 in 90/006,021, unless Owner elects to file additional claims. If that is the case, such additional claims must also be added to the housekeeping amendment filed in control No. 90/006,048. The next action by the Primary Examiner will be paper No. 11 in both files. **Owner is required to file the housekeeping amendment not later than ONE MONTH from the date of this decision.**

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E. Rollins-Cross, Director, Patent
Examining Groups 3210 & 3720

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Paper No. 15

David A. Nelson, Esq. Latham & Watkins 5800 Sears Tower Chicago, Illinois 60606	)	**FOR OWNER**

25 OCT 2001

Edward R. Yoches Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P. 1300 I Street N.W. Washington, D.C. 20005-3315	)	**FOR THIRD PARTY REQUESTER**

In re Hansen et al. Reexamination Proceeding Control No. 90/005,880 Filed: December 8, 2000 For: U.S. Patent No. 4,814,976	)	**DECISION *SUA SPONTE*, MERGING REEXAMINATION PROCEEDINGS**

In re Hansen et al. Reexamination Proceeding Control No. 90/006,049 Filed: July 2, 2001 For: U.S. Patent No. 4,814,976	)

In re Hansen et al. Reexamination Proceeding Control No. 90/006,096 Filed: August 27, 2001 For: U.S. Patent No. 4,814,976	)

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. 4,814,976 issued on March 21, 1989.

'5880 Proceeding

2. A first request for reexamination, Control No. 90/005,880 ('5880) was filed by the Third Party Requester on December 8, 2000. [Paper No.3]

3. Reexamination was ordered in the '5880 reexamination proceeding on January 30, 2001. [Paper No. 5]

5. A first Office action was mailed on June 8, 2001. [Paper No. 9]

6. An Interview was held with the examiner of record and the Patent Owner's representatives on August 1, 2001. An Interview Summary was mailed on August 7, 2001. [Paper No. 10]

7. An Information Disclosure Statement was filed on August 10, 2001. [Paper No.11]

8. A Declaration under 37 C.F.R. § 1.132 was filed on August 10, 2001. [Paper No.12]

9. A Summary of the August 1, 2001 Interview was filed by Patent Owner's representatives on August 10, 2001. [Paper No.13]

10. A Request for reconsideration was filed on August 10, 2001. [Paper No.14]

'6049 Proceeding

11. A second request for reexamination, Control No. 90/006,049 ('6049) was filed by the Third Party Requester on July 2, 2001. [Paper No. 3]

12. Reexamination was ordered in the '6049 reexamination proceeding on July 20, 2001. [Paper No. 5]

'6096 Proceeding

13. A third request for reexamination, Control No. 90/006,096 ('6096) was filed by the Third Party Requester on August 27, 2001. [Paper No. 3]

14. Reexamination was ordered in the '6096 reexamination proceeding on October 4, 2001. [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 '5880, '6049 and '6096 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 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.

Allen MacDonald 10-2401

Allen R. MacDonald, Group Director
Technology Center 2100
Computer Architecture, Software, and Electronic Commerce

DOCKET ALARM

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
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MAILED

DEC 17 2001

Paper No. 10/49

TECHNOLOGY CENTER 2800
SPECIAL PROGRAM CENTER

John X. Garred
Arten and Harden
1100 Huntington Building
925 Euclid Avenue
Cleveland, OH 44115-1475

(For Patent Owner)

Alan R. Loudermilk
LOUDERMILK & ASSOCIATES
10950 N. Blaney Avenue, Suite B
Cupertino, CA 95014

(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

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

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.

Page 5 of 6

CONCLUSION

Reexamination Control Nos. '5384, '5823, '5881 and '6051 are merged.

Henry S. Phan for

Janice A. Falcone, Group Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Washington, D C 20231
www uspto gov

90/005,881
90/004051
90/005,384
90/005,803

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,392	09/27/2002	5162666	TTI666RES	2026

23380 7590 01/14/2003

ARTER & HADDEN, LLP
1100 HUNTINGTON BUILDING
925 EUCLID AVENUE
CLEVELAND, OH 44115-1475

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
www.uspto.gov

Paper No. 67/8

John X. Garred
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Cleveland, OH 44115-1475

(For Patent Owner)

Alan R. Loudermilk
LOUDERMILK & ASSOCIATES
10950 N. Blaney Avenue, Suite B
Cupertino, CA 95014

(For Third Party Requester)

Entered and Effective

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	:

Application/Control Number: 90/006,051
Art Unit: 3992

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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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

KLARQUIST SPARKMAN, LLP
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/24/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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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
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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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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)).

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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www.uspto.gov

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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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/24/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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LOUDERMILK & ASSOCIATES
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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)).

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)).

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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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

KLARQUIST SPARKMAN, LLP
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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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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. : 90005881
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)).

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.
90/006,392	09/27/2002	5162666	TTI666RES	2026

24197 7590 04/24/2009

KLARQUIST SPARKMAN, LLP
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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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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)).

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

Klarquist Sparkman LLP
121 SW Salmon Street
Suite 1600
Portland, Oregon 97204

(For Patent Owner)

MAILED

APR 24 2009

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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Paper No. 6

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MAILED
APR 29 2002
REEXAM UNIT

In re reissue application of
Megens
Application No. 08/747,873
Filed: November 13, 1996
For: U.S. Patent No. 5,042,103

In re reissue application of
Megens
Application No. 09/598,785
Filed: June 20, 2000
For: U.S. Patent No. 5,042,103

In re Megens
Reexamination Proceeding
Control No. 90/006,053
Filed: July 9, 2001
For: U.S. Patent No. 5,042,103

DECISION MERGING REEXAMINATION AND REISSUE PROCEEDINGS

The above-identified reissue applications 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. 5,042,103 issued to Megens, on August 27, 1991.

2. A first reissue application was filed on the '103 patent on September 22, 1995, and was assigned application no. 08/532,415. The '415 reissue application is now abandoned.

3. A second reissue application, which is a continuation of reissue application no. 08/532,415, now abandoned, was filed on the '103 patent on November 13, 1996, and was assigned application no. 08/747,873. A non-final rejection was mailed on March 27, 2001, in the '873 continuation reissue application, and a response to the non-final rejection, including drawings, was received on August 27, 2001.

4. A third reissue application was filed on the '103 patent on June 20, 2000, and was assigned application no. 09/598,785. A non-final rejection was mailed on May 4, 2001, in the '785 reissue application, and a response to the non-final rejection was received on October 4, 2001.

5. A request for reexamination of the '103 patent was filed by a third party requester on July 9, 2001, and the resulting reexamination proceeding was assigned Control No. 90/006,053. On September 13, 2001, reexamination was ordered in the '6053 proceeding.

6. The time period for filing a patent owner's statement under 37 C.F.R. § 1.530 has expired, and no owner's statement has been received in the '6053 proceeding.

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 applications and the reexamination proceeding are currently pending. Since the Order has been mailed pursuant to § 1.525 in the '6053 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 '6053 reexamination file shows that the original specification, drawings and patent claims 1-11, are presently in the reexamination file. The reexamination proceeding is awaiting the examiner's preparation of a first Office action on the merits.

A review of the second reissue (Application No. 08/747,873) prosecution history shows that the continuation reissue application was affirmed-in-part at the Board of Patent Appeals and Interferences (BPAI), and a nonfinal Office action was mailed on March 27, 2001. A response to the nonfinal Office action was received on August 27, 2001, and the application is awaiting a second Office action on the merits by the examiner. In the reissue application, applicant includes original patent claims 4 and 6-11, and has amended claims 1-3 and 5 and submitted new claims 12-16 and 22-27 for consideration (claims 17-21 have been canceled), as well as amended the specification at Cols. 1 and 2, and amended Figures 3 and 5. It should be noted that the amendments of June 25, 2001, and August 27, 2001, have not been entered, as they are not in compliance with the format for amending reissue applications, specifically 37 C.F.R. § 1.173.

A review of the third reissue (Application No. 09/598,785) prosecution history shows that a nonfinal Office action was mailed on May 4, 2001. A response to the nonfinal Office action was received on October 4, 2001, which response includes amendments that are not in the proper amendment format for reissue

applications (37 C.F.R. § 1.173). The application is awaiting a second Office action on the merits by the examiner. In this reissue application, applicant has canceled claims 1-24 and submitted new claims 25-47 for consideration, as per the amendment of June 20, 2000. It should be noted that since the amendment to the specification filed on October 4, 2001, is not in compliance with the format for amending reissue applications, specifically 37 C.F.R. § 1.173, it has not been entered.

Thus, the claims are not identical in all three proceedings. In order to provide efficient, consistent and prompt handling of all three proceedings, it is appropriate that the reissue applications and the reexamination proceeding be merged and a joint examination be conducted. Accordingly, the examination of the reissue applications 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 applications 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 All Proceedings

The above-identified reissue applications and reexamination proceeding are merged in accordance with 37 C.F.R. § 1.565(d), for the **purpose of joint examination only**. In view of the fact that the two reissue applications contain separate sets of claims, which is appropriate under 37 C.F.R. § 1.177(b), the requirement for patent owner to present the same claims in all three cases is hereby **waived**.

However, since the amendments of June 25, 2001, and August 27, 2001, in reissue application no. 08/747,873 have not been

entered, and since the amendment to the specification filed on October 4, 2001, in reissue application no. 09/598,785 has not been entered, patent owner/applicant is hereby given **one month** from the mailing date of this merge decision in which to file proper reissue amendments in compliance with 37 C.F.R. § 1.173. Such amendments should be filed in accordance with the procedure set forth in Part III. of this decision, the third paragraph, items 2-4 below. Note that it is not necessary to file a copy of any of the amendments from the reissue applications in the reexamination proceeding at this time, as discussed in more detail below.

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.

The requirement that the same Office actions and patent owner responses will be placed in all three cases is hereby **waived**.

Each proceeding will proceed **independently, but simultaneously**, within the merged proceedings, as follows:

1. A joint examination of the proceedings will be conducted, and any Office actions will be **mailed at the same time** in both reissue cases.

2. The patent owner is **required to file responses** in both reissue cases independently, but **simultaneously**.

3. Such responses should include identifying data, e.g., the application number, for that case, but should also make reference to the other two cases of the merged proceeding.

4. Any such responses must be served on the third party requester, who will also be sent copies of all Office actions. See 37 C.F.R. § 1.550(f).

5. Due to the different claims in all three cases, and because the merged examination will be conducted on the basis of the rules relating to the broader, reissue application examination, the reexamination file will remain dormant, in that no papers mailed by the USPTO nor any papers filed by patent owner, pertaining to the merged proceeding, will be made of record in the reexamination file at this time, although all of the papers mailed/filed in the two reissue applications will constitute the merged proceeding.

6. Due to the unique nature of these merged proceedings, all papers will be centrally processed in the USPTO by the Central Reexamination Unit (CRU), and will be scanned into the electronic database (REPS) in the CRU, so as to be readily available for public viewing and copying. The reissue application files will be electronically linked to the reexamination proceeding file, as they constitute the merged proceeding.

When all claims are indicated to be allowable in one of the cases, all three files must be returned to the Office of Patent Legal Administration for reconsideration of the merge decision. At that time, the Office of Patent Legal Administration may consider suspending the allowable case, to await conclusion of the other proceedings, in order to permit the cases to issue simultaneously.

If the reissue applications ultimately mature 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 in one of the reissue applications, the merged proceeding will be terminated as follows. That reissue application will be held abandoned, and the merger will be dissolved as to that reissue application. However, the other two cases will remain intact, and must be returned to the Office of Patent Legal Administration for reconsideration of the merge decision, which will most likely result in reverting to normal reissue/reexamination merger practice.

If the applicant/patent owner fails to file a timely and

appropriate response to any Office action in both of the reissue applications, the merged proceeding will be terminated as follows. The reissue applications 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 37 C.F.R. § 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 in one of the reissue applications pursuant to 37 C.F.R. § 1.138, the next Office action of the examiner will accept the express abandonment, and the merged proceeding will be dissolved as to that reissue application. However, the other two cases will remain intact, and must be returned to the Office of Patent Legal Administration for reconsideration of the merge decision.

If the applicant/patent owner files an express abandonment in both of the reissue applications pursuant to 37 C.F.R. § 1.138, the next Office action of the examiner will accept the express abandonments, 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 above-identified reissue applications and reexamination proceeding **ARE MERGED** into a single consolidated proceeding. A copy of this merge decision will be made of record in each of the three files.

2. The requirement for placing the same amendments in all three cases of the present merged proceeding is waived.

3. Patent owner/applicant is given **one month** from the mailing date of this merge decision in which to file proper reissue amendments in compliance with 37 C.F.R. § 1.173, since the amendments of June 25, 2001, and August 27, 2001, in reissue application no. 08/747,873 and the amendment filed on October 4, 2001, in reissue application no. 09/598,785 have not been entered. Such amendments must be filed in accordance with the procedure set forth in Part III. of this decision, the third paragraph, items 2-4, above.

4. The cases will be stored in the CRU to await the receipt of such proper reissue amendments, or expiration of the one month time period for filing such amendments, whichever comes first.

5. The reissue application files and the reexamination file will then be forwarded to the Group Director of Technology Center 3600. All further examination should be conducted in accordance with this decision. The examiner should prepare Office actions on the merits for the present merged proceeding of the reissue applications and reexamination proceeding, which Office actions and all files should be forwarded to the CRU for central processing and simultaneous mailing of the Office actions.

6. If all claims are indicated to be allowable in one of the three cases, all three files **must be returned** to the Office of Patent Legal Administration for reconsideration of the merge decision, and consideration of possible suspension of such case.

7. 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

April 26, 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

Paper No. 48

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MAILED

MAR 30 2005

REEXAM UNIT

In re reissue application of
Megens
Application No. 08/747,873
Filed: November 13, 1996
For: U.S. Patent No. 5,042,103

In re reissue application of
Megens
Application No. 09/598,785
Filed: June 20, 2000
For: U.S. Patent No. 5,042,103

In re Megens
Reexamination Proceeding
Control No. 90/006,053 ✓
Filed: July 9, 2001
For: U.S. Patent No. 5,042,103

DECISION ON MERGER OF REEXAMINATION AND REISSUE PROCEEDINGS

The above-identified reissue applications and reexamination proceeding are before the Office of Patent Legal Administration for consideration of whether the proceedings should remain merged at this time.

REVIEW OF FACTS

1. U.S. Patent No. 5,042,103 issued to Megens, on August 27, 1991.

2. A first reissue application was filed on the '103 patent on September 22, 1995, and was assigned application no. 08/532,415. The '415 reissue application is now abandoned.

3. A second reissue application, which is a continuation of reissue application no. 08/532,415, now abandoned, was filed on the '103 patent on November 13, 1996, and was assigned application no. 08/747,873. A non-final rejection was mailed on March 27, 2001, in the '873 continuation reissue application, and a response to the non-final rejection, including drawings, was received on August 27, 2001.

4. A third reissue application was filed on the '103 patent on June 20, 2000, and was assigned application no. 09/598,785. A non-final rejection was mailed on May 4, 2001, in the '785 reissue application.

5. A request for reexamination of the '103 patent was filed by a third party requester on July 9, 2001, and the resulting reexamination proceeding was assigned Control No. 90/006,053. On September 13, 2001, reexamination was ordered in the '6053 proceeding.

6. A response to the non-final rejection was received in the '785 reissue application on October 4, 2001.

7. No patent owner's statement under 37 C.F.R. § 1.530 was received in the '6053 proceeding.

8. A decision merging all three proceedings was mailed on April 29, 2002, which indicated that each reissue proceeding will proceed **independently, but simultaneously**, within the merged proceedings, and the reexamination file will remain dormant.

9. On June 3, 2002, the patent owner sent in corrected amendments for both the '785 and '873 reissue proceedings, as required in response to the merge decision. (Note that the reexamination file has remained dormant, per the April 29, 2002, decision.)

10. On March 26, 2003, a supplemental amendment including a statement of support was filed in both the '873 and '785 reissue proceedings.

11. A final rejection was mailed in both of the '785 and '873 reissue proceedings on March 28, 2003.

12. On July 31, 2003, a letter of express abandonment was filed in the '785 reissue proceeding, and a request for an extension of time of one month was requested in the '873 reissue proceeding, which was accompanied by a proposed amendment/response to the outstanding final rejection. On same date, the request for an extension of time of one month was granted.

DECISION DISSOLVING MERGER AS TO REISSUE APPLICATION NO. 09/598,785

The Decision Merging the above-identified Reissue Applications and the Reexamination Proceeding mailed on April 29, 2002, specified that if the applicant/patent owner filed an express abandonment in one of the reissue applications pursuant to 37 C.F.R. § 1.138, then the next Office action of the examiner would accept the express abandonment, and the merged proceeding would be dissolved as to that reissue application. The decision also indicated that the other two cases would remain intact, and must be returned to the Office of Patent Legal Administration for reconsideration of the decision merging proceedings.

Since a letter of express abandonment was filed in the '785 reissue proceeding on July 31, 2003, and has been recognized per MPEP 711.01, the '785 reissue application is abandoned, and therefore the merged proceeding is dissolved as to the '785 reissue proceeding. The merger of the '873 reissue application and the '6053 reexamination proceeding remains intact, and is properly before the Office of Patent Legal Administration for reconsideration of the conduct of the merged proceeding set forth in the previous decision of April 29, 2002.

DISCUSSION OF REMAINING MERGER

The '873 reissue application and the '6053 reexamination proceeding **remain merged**, and reconsideration of the conduct of these merged proceedings is now appropriately before the Office of Patent Legal Administration.

A review of the prosecution history of the '6053 reexamination file shows that the original specification, drawings and patent claims 1-11, are presently in the reexamination file. The reexamination proceeding also contains the decision merging proceedings of April 29, 2002, but no further papers have been added to this file, per the directions set forth in same decision.

A review of the '873 reissue prosecution history shows that the rejections on appeal in this continuation reissue application were affirmed-in-part at the Board of Patent Appeals and Interferences (BPAI), and a non-final Office action was mailed on March 27, 2001. A response to the non-final Office action was received on August 27, 2001, and the decision merging proceedings was mailed on April 29, 2002. Subsequent to the merge decision, a housekeeping amendment was filed on June 3, 2002, which provided the previously filed informal amendments in the appropriate format for reissue applications; and on March 26, 2003, a supplemental amendment including a statement of support was filed in the '873 reissue application. A final rejection was mailed on March 28, 2003, in which claims 1-4, 6-7, 9-12 and 25-28 were rejected; claim 5 was objected to; and claims 13-15 were indicated to be allowable. A response to the final rejection was filed on July 31, 2003, in which the applicant proposes to amend the drawings; to amend the specification, Cols. 1-4; cancel claims 1-7, 9-12 and 25-28; and indicates that claims 13-15 are pending.

Thus, the claims are <u>not</u> identical in both proceedings. In order to provide efficient, consistent and prompt handling of both proceedings, it is appropriate that the reissue application and the reexamination proceeding remain 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 ON THE CONDUCT OF THE REMAINING MERGED REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The 08/747,873 reissue application and the 90/006,053 reexamination proceeding remain 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 drawings, specification, and claims are NOT the same in both files.

However, since all of the amendments subsequent to the merge decision apply to the merged proceeding, and include the appropriate identifiers for the merged cases as directed in the prior merge decision, it is appropriate and now timely for the reexamination file to be physically updated. The merged proceedings will be updated to include all of the same amendments in both of the remaining merged files, specifically, Application No. 08/747,873, and Control Number 90/006,053.

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 '873 reissue application and the '6053 reexamination proceeding. Each action will be entered into both files (which will be maintained as separate files), and copies will be mailed to the patent owner and the requester.

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.). Any such responses must be served on the third party requester, who will also be sent copies of all Office actions. See 37 C.F.R. § 1.550(f).

Because the merged examination will be conducted on the basis of the rules relating to the broader, reissue application examination, any amendments 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 amendments to the specification, claims and drawings should contain bracketing and underlining with regard to the original patent text pursuant to 37 C.F.R. § 1.173. All new claims must be completely underlined pursuant to 37 C.F.R. § 1.173(b)(2) and (d)(2).

Since the conduct of these merged proceedings will now be the same as the standard type of reissue/reexam merger described in MPEP 2285, subsequent to the mailing of this decision, all papers will be processed in the Office by the Technology Center 3600 personnel.

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 09/598,785 reissue application is abandoned, and the merger of the above-identified reissue applications and reexamination proceeding into a single consolidated proceeding of April 29, 2002, is **DISSOLVED** as to the 09/598,785 reissue application.

2. The merger of April 29, 2002, continues as to reissue application no. 08/747,873 and reexamination proceeding control no. 90/006,053, which **REMAIN MERGED** as a single consolidated proceeding.

3. The '6053 reexamination file will be updated by the Central Reexamination Unit (CRU) to include all of the same documents entered in reissue application no. 08/747,873, since the previous merge decision of April 29, 2002.

4. A copy of the instant decision will be placed in all three files of the above-identified proceedings.

5. The 08/747,873 reissue application file and the 90/006,053 reexamination file will then be forwarded to Technology Center 2800 for the examiner's immediate consideration of the proposed amendment-after-final of July 31, 2003, in the merged proceeding. All further examination should be conducted in accordance with this decision.

6. The examiner should promptly issue an Office action for the present merged proceeding of the reissue application and reexamination proceeding.

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 (571) 272-7722.

Lynn M. Kryza
Senior Patent Special Projects Advisor
Office of Patent Legal Administration

March 29, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
WASHINGTON, D.C. 20231
www.uspto.go

Paper No. 9

Reginald J. Suyat
FISH & RICHARDSON, P.C.
500 Arguello Street
Suite 500
Redwood City, CA 94063

(For Patent Owner)

Leonard R. Svensson
BIRCH STEWART KOLASCH & BIRCH
P.O. Box 747
Falls Church, VA 22040-0747

(For Requester)

MAILED

DEC 16 2002

REEXAM UNIT

In re Radomsky
Reexamination Proceeding
Control No. 90/006,055
Filed: July 10, 2001
For: U.S. Patent No. 5,942,499

DECISION DISMISSING PETITION

DO NOT ENTER

This is a decision on the November 27, 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.

The petition fee of $1280.00 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 **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 petition fee. The instant petition lacks items (1) and (3) above. Although a response to the outstanding non-final Office action was filed on November 27, 2002, this paper does not constitute "the required reply" pursuant to 37 C.F.R. § 1.137(b)(1), as the amendment is not in compliance with 37 CFR § 1.530. **Note that the manner of making amendments in applications set forth in 37 CFR § 1.121 does not apply to reexamination proceedings, as stated in 37 CFR § 1.121(i).** Specifically, the amendment is **not** in compliance with 37 CFR § 1.530, as it does not include 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 original disclosure of the patent for the changes to the claims made by the amendment papers, as required by 37 CFR § 1.530(e). Also, in the amendment paper, the amendment of claims 1 and 6 does not show the changes being made with bracketing and underlining, with regard to the original patent text, as required by 37 CFR § 1.530(d)(2) and (i). With regard to 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 from the due date of November 4, 2002 to the present date 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. The reexamination file will be stored in the Central Reexam Unit (CRU) for one month to await any such renewed petition. If no such renewed petition is timely received, the reexamination file will be forwarded to Technology Center 1600 for termination of the proceeding, and issuance of the Notice of Intent to Issue Reexamination Certificate (NIRC).

4. 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

5. Telephone inquiries with regard to this decision should be directed to the undersigned at (703) 308-0255.

Lynn M. Kryza

Lynn M. Kryza
Patent Special Projects Advisor
Office of Patent Legal Administration

December 13, 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
WASHINGTON, D.C. 20231
www.uspto.go

Paper No. 12

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(For Patent Owner)

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P.O. Box 747
Falls Church, VA 22040-0747

(For Requester)

MAILED

FEB 1 3 2003

REEXAM UNIT

In re Radomsky
Reexamination Proceeding
Control No. 90/006,055
Filed: July 10, 2001
For: U.S. Patent No. 5,942,499

DECISION GRANTING PETITION

This is a decision on the January 21, 2003, patent owner renewed 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 $1280.00 pursuant to 37 C.F.R. § 1.17(m) for the petition under 37 C.F.R. § 1.137(b) was received with the previous petition of November 27, 2002.

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 previous petition was 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 outstanding nonfinal Office action of September 4, 2002, has been received. However, the amendment of January 21, 2003, is still **not** in compliance with 37 C.F.R. § 1.530(d)(2), as some of the changes are not correctly presented with changes in bracketing and underlining with regard to the original patent text. Specifically, in claim 1, line 4 "<u>, said mixture</u>" should be presented as -[and] <u>, said mixture</u> -, as note in the instant amendment, "and" does <u>not</u> appear in brackets. However, as a courtesy to patent owner, given the numerous attempts to provide a proper amendment in response to the Office action of September 4, 2002, these changes will be made in red ink (initialed and dated) on the amendment papers of January 21, 2003, so that this petition can be granted and prosecution of this merged reexamination proceeding resumed.

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 nonfinal Office action of September 4, 2002.

3. Further inquiries with regard to this reexamination proceeding should be directed to the examiner, Patrick Lewis, of Group Art Unit 1623.

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

February 11, 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, DC 20231
www.uspto.gov

OCT - 5 2001

Paper No. 8

Albert W. Hilburger Perman and Green LLP 425 Post Road Fairfield, CT 06430	For Patent Owner
John B. Hardaway, III Nexsen, Pruet, Jacobs & Pollard LLC P.O. Box 10107 Greenville, SC 29603	For Requester
In re Reexamination Control No. 90/006,060 U.S. Patent No. 6,186,934 B1 Issued: February 13, 2001 Patent Owner: Todd M. Addison Request Filed: July 12, 2001	DECISION ON PETITION FOR EXTENSION OF TIME

90006060 10052001

This is a decision on the paper styled as "Request for Extension to File Patent Owner's Statement Under 37 CFR § 1.550(c)". The paper was filed by facsimile transmission on September 27, 2001. Although a three week extension is being requested, the petition is being considered as a petition for a one month extension of time.

The petition is GRANTED.

The petition sets forth circumstances which adequately justify the necessity for a one month extension of time. Accordingly, Owner's request for an extension of time in which to file a an Owner's Statement in response to the Order granting reexamination dated August 3, 2001 is granted. Owner's Statement is therefore due on or before November 3, 2001. 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). In no event can the period for filing a reply to the final Office action be extended more than six months from the date thereof.

PETITION GRANTED

E. Rollins-Cross, Director, Patent
Examining Groups 3710 and 3720

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
WASHINGTON, D C. 20231
www.uspto.go

October 30, 2002

Paper No. 18

Albert W. Hilburger
Perman and Green, LLP
425 Post Road
Fairfield, CT 06430

(Patent Owner)

John B. Hardaway III
Nexsen, Pruet, Jacobs & Pollard, LLC
201 West McBee Avenue
P.O. Box 10107
Greenville, SC 29603

(Requester)

Enclosure: Petition filed June 11, 2002.

In re Addison
Reexamination Proceeding
Control No. 90/006,060
Filed: July 12, 2001
For: U.S. Patent No. 6,186,934

DECISION DISMISSING
AND RETURNING
PETITION UNDER 37 CFR 1.181

This is a decision on the June 11, 2002, petition filed by the third party requester under 37 CFR 1.181 requesting the Commissioner to exercise supervisory authority over the present reexamination proceeding and return the reexamination to the examiner for further prosecution on the merits. The petition is before the Office of Patent Legal Administration for decision.

The petition is dismissed and is being returned to the third party requester for the reasons set forth below.

REVIEW OF FACTS

1. On January 15, 2002, the examiner issued an Office action rejecting all of the patent claims.

2. On March 22, 2002, the patent owner filed a response to the Office action requesting reconsideration of the examiner's rejection. A declaration under 37 CFR 1.132 accompanied the response.

3. On April 30, 2002, the examiner issued a Notice of Intent to Issue a Reexamination Certificate. All of the patent claims were confirmed.

4. On June 11, 2002, the third party requester filed the instant petition requesting the Commissioner to exercise supervisory authority over the present reexamination proceeding and return the reexamination to the examiner for further prosecution on the merits.

5. On July 23, 2002, the reexamination certificate issued confirming all of the patent claims.

DELETED

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 (Commr. Pats. 1981). The statute and its intent are clear that a reexamination proceeding requested under 35 U.S.C. 302 must be *ex parte*. Petitioner asserts that the examiner did not

apply the correct legal standard of patentability during the prosecution of the reexamination. 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. See *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 June 11, 2002, is an improper submission under 37 CFR 1.550(g), and it is being returned to the third party requester.

CONCLUSION

1. The third party requester petition filed June 11, 2002, is **dismissed** and is being returned to requester.

2. A copy of this decision is being made of record in the reexamination file.

3. Telephone inquiries related to this decision should be directed to Gerald A. Dost, Senior Legal Advisor, at (703) 305-8610.

DENIED
DISMISSED

Gerald A. Dost

Gerald A. Dost
Senior Legal Advisor
Special Program Law Office
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

C:\zJerry\90_6060 3PR assertion that wrong pat stnd used in reexam.wpd

UNITED STATES
PATENT AND
TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
PO BOX 1450, ALEXANDRIA, VA 22313-1450
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#11

mailed
9/25/03

HERBERT GOODMAN, ESQ.
FRISHAUF, HOLTZ, GOODMAN,
LANGER & CHICK, P.C.
767 THIRD AVENUE - 25TH FLOOR
NEW YORK NY 10017-2023

FOR PATENT OWNER

CHALIIN A. SMITH
SMITH PATENT CONSULTING
P. O. BOX 2726
ALEXANDRIA, VA 22301-2726

FOR REQUESTER

In re Olefsky
Reexamination Proceeding
Control No.: 90/006,062
Filed: July 19, 2001
For: U.S. Patent No. 5,478,852

In re Olefsky
Reexamination Proceeding
Control No.: 90/006,599
Filed: April 14, 2003
For: U.S. Patent No. 5,478,852

: DECISION MERGING
: REEXAMINATION
: PROCEEDINGS

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.5,478,852 issued December 26, 1995.

2. A first request for reexamination, Control No. 90/006,062, was filed by third party requester on July 19, 2001.

3. Reexamination was ordered In the '062 reexamination proceeding on October 1, 2001.

4. A second request for reexamination, Control No. 90/006,599, was filed by third party requester on April 14, 2003.

5. Reexamination was ordered In the '599 reexamination proceeding on May 21, 2003.

6. Patent Owner filed a statement in the '599 proceeding on July 17, 2003.

7. Requester filed a reply to Patent Owner's statement on September 17, 2003.

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 all 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 '062, and '599 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 all files. Patent Owner is given one month within which to provide a "housekeeping" amendment in the '599 proceeding. Amendments must be In accordance with 37 CFR 1.530 (see M.P.E.P. 2250).

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 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 third party requester and requester will be sent copies of all papers mailed by the Office.

CONCLUSION

Reexamination Control Nos. 90/006,062, and 90/006,599 are merged.

John Doll
Director, Technology Center 1600

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
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,065	07/20/2001	5146512	40002.0009USRE	9403

7590 03/26/2002

Martin Korn, Esq.
Locke Liddell and Sapp LLP
2200 Ross Avenue Suite 2200
Dallas, TX 75201-6776

EXAMINER	
ART UNIT	PAPER NUMBER
	7

DATE MAILED: 03/26/2002

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

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. 7

mailed - 26 MAR 2002

Martin Korn
LOCKE LIDDELL & SAPP LLP
2200 Ross Avenue
Suite 2200
Dallas, TX 75201-6776

FOR OWNER

John P. Phillips
MERCHANT & GOULD PC
P.O. BOX 2903
Minneapolis, MN 55402-0903

FOR THIRD PARTY REQUESTER

In re Weideman et al.
Reexamination Proceeding.
Control No. 90/005,981
Filed: April 17, 2001
For: U.S. Patent No. 5,146,512

DECISION SUA SPONTE, MERGING REEXAMINATION PROCEEDINGS

In re Weideman et al.
Reexamination Proceeding
Control No. 90/006,065
Filed: July 20, 2001
For: U.S. Patent No. 5,146,512

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. 5,146,512 issued on September 8, 1992.

2. A first request for reexamination, Control No. 90/005981 ('981) was filed by the Patent Owner on April 17, 2001.

3. Reexamination was ordered in the '981 reexamination proceeding on June 4, 2001.

4. A second request for reexamination, Control No. 90/006065 ('065) was filed by the Third Party Requester on July 20, 2001.

5. Reexamination was ordered in the '065 reexamination proceeding on October 5, 2001.

6. No Patent Owner's statement was filed in either of the reexamination proceedings.

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 '981, and '065 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 Proceedings

The Patent Owner is required to maintain the same claims and specification in both files. Since these files have the same claims and specification, a "housekeeping" amendment is not required. Therefore, the files will be forwarded to the examiner for action on the merits.

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.

Joseph J. Rolla, Jr., 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. 13

David M. Mundt (For Patent Owner)
COOK, ALEX, McFARRON, MANZO
CUMMINGS & MEHLER, LTD.
200 W. Adams St., Suite 2850
Chicago, IL 60606

MATTHEW F. JODZIEWICZ (Withdrawing Attorney)
3447 Mandeville Canyon Road
Los Angeles, CA 90049

In re Neil T. Stone et al.	:	
Reexamination Proceeding	:	DECISION ON REQUEST
Control No. 90/006,066	:	TO WITHDRAW AS
Filed: July 20, 2001	:	ATTORNEY OF RECORD
For: U.S. Patent No. 5,594,513	:	

This is a decision on the request to withdraw as attorney of record under 37 C.F.R. § 1.36, filed September 5, 2001.

The request is APPROVED.

The request was signed by Matthew F. Jodziewicz on behalf of himself.

Any inquiry relating to this letter should be directed to Hien H. Phan, Special Program Examiner, at (703) 308-7502.

Henry J. Phan for

Janice A. Falcone, Director
Technology Center 2800
Semiconductor, Electrical and Optical
Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

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AR

#15

Michael G. Panian (For Patent Owner)
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PITTSBURGH, PA 15219

MAILED
AUG 23 2002
REEXAM UNIT

VOLPE & KOENIG, P.C. (For Requester)
INTELLECTUAL PROPERTY LAW
Ste. 400, ONE PENN CENTER
1617 JOHN F. KENNEDY BLVD.
PHILADELPHIA, PA 19103

Undelivered

In re Zimmerman :
Reexamination Proceeding : **DECISION**
Control No. 90/006,069 : **DISMISSING**
Filed: July 25, 2001 : **PETITION**
For: U.S. Patent No. 5,055,252 :
:

This is a decision on the August 7, 2002, patent owner PETITION TO REVIVE ABANDONED APPLICATION, requesting revival of the present reexamination proceeding under the unintentional standard, pursuant to 37 CFR 1.137(b). The petition is before the Office of Patent Legal Administration for decision.

The petition is **dismissed.**

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 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)."

DECISION

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 (1) above.

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."[1] The present petition is incomplete as to item (1) because this required statement has not been made by patent owner.

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 is not included with the instant petition papers, nor with its attachments. Such proof was also not included with the May 20, 2002, and July 8, 2002, papers filed by patent owner.

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 and the May 20, 2002, and July 8, 2002, papers have been served on the third party requester in the manner provided by § 1.248.[2]

---

[1] **For reexamination proceedings, the word "reply" is to be replaced by "response."**

[2] Obviously, if the papers have not yet been served, patent owner must first do so, before providing the Certificate to the Office.

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).

PETITION FEE

The Office records show the patent owner to be a small entity. The small entity petition fee under 37 CFR 1.17(m) is $640. A check for $605 was enclosed with the petition. The balance of $35 has been charged to petitioner's deposit account number 02-4553 as per petitioner's instructions on page 2 of the petition to charge "any other fees [that] are necessary."

PETITION FOR EXTENSION OF TIME

The non-final Office action of March 7, 2002, set a 2-month shortened statutory period for filing a response.

(1) A response to that Office action was filed on July 8, 2002, together with a petition for extension of time under 37 CFR 1.136(c) [presumably 37 CFR 1.136(a) was meant].

(2) A copy of the petition for extension of time has now been attached with the present petition.

As to the petition for extension of time under 37 CFR 1.136 filed on July 8, 2002, with the response:

Extensions of time under 37 CFR 1.136 do not apply in reexamination proceedings; but rather, extensions of time in reexamination proceedings are provided for in 37 CFR 1.550(c). Pursuant to 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." In the present instance, the period for response to the Office action of March 7, 2002 expired after May 7, 2002; thus, the July 8, 2002, request (petition) for extension of time was not timely filed. Further, there was no showing of "sufficient cause" for the extension. Accordingly, the July 8, 2002, petition for extension of time could not be granted.

Additionally, since the $400 extension of time fee submitted with the petition for extension of time on July 8, 2002, was not applicable in reexamination (since no fee is provided for in 37 CFR 1.550(c)), this fee was unnecessary and will be credited to petitioner's deposit account number 02-4553.

As to the copy of the petition for extension of time that is attached with the present petition:

To the extent that the copy of the petition for extension of time attached with the present petition is a renewal of the previously filed petition for extension of time (in conjunction with the present petition for revival), the petition for extension of time is dismissed as not being applicable. The question of granting an extension of time is not ripe for consideration at this point, since the present reexamination proceeding is not pending. Questions as to the granting of an extension of time can only be considered if the present proceeding is restored to pending status.

CONCLUSION

1. The present petition under 37 CFR 1.137(b) is **dismissed**.

2. **For the granting of the present petition, it is required that patent owner provide:**

   (A) A Certificate that the petition papers and the May 20, 2002, and July 8, 2002, papers have been served on the third party requester; **and**

   (B) A statement that: The entire delay in filing the required response from the due date for the response until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

If petitioner desires to make the required submissions in order that the present petition be granted, the submissions should be included in a cover letter entitled **"Renewed Petition under 37 CFR 1.137(b)."**

3. Any renewed petition must be filed within **ONE (1) MONTH** of the mailing date of this decision. An extension of time to file a renewed petition may be requested **only** under 37 CFR 1.550(c); extensions of time under 37 CFR 1.136 are **not** available in reexamination proceedings.

4. 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 to: (703) 305-1013
Central Reexamination Unit

By hand: Central Reexamination Unit
Crystal Plaza Three-Four, 3D68
2201 South Clark Place
Arlington, Va

5. 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

August 22, 2002
C:\KIVA\KPET-ABE\6069UNIN.DIS

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Washington, D C 20231
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,069	07/25/2001	5055252	WMI-1D	1336

7590 10/02/2002

Michael G. Panian
Buchanan Ingersoll, P.C.
One Oxford Centre 301 Grant Street
20th Floor
Pittsburgh, PA 15219

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/02/2002

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 PATENT
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WASHINGTON, D C. 20231
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AR

#18

Michael G. Panian (For Patent Owner)
BUCHANAN INGERSOLL, P.C.
ONE OXFORD CENTRE
301 GRANT STREET,
20TH FLOOR
PITTSBURGH, PA 15219

MAILED

OCT 0 2 2002

REEXAM UNIT

VOLPE & KOENIG, P.C. (For Requester)
INTELLECTUAL PROPERTY LAW
Ste. 400, ONE PENN CENTER
1617 JOHN F. KENNEDY BLVD.
PHILADELPHIA, PA 19103

90006069

Enclosure: Copy of patent owner's September 26, 2002, SUPPLEMENTAL RENEWED PETITION UNDER 37 C.F.R. 1.137(b).

In re Zimmerman :
Reexamination Proceeding : **DECISION**
Control No. 90/006,069 : **GRANTING**
Filed: July 25, 2001 : **PETITION**
For: U.S. Patent No. 5,055,252 :

This is a decision on patent owner's September 16, 2002, RENEWED PETITION UNDER 37 C.F.R. 1.137(b) and September 26, 2002, SUPPLEMENTAL RENEWED PETITION UNDER 37 C.F.R. 1.137(b), the petitions both requesting revival of the present reexamination proceeding under the unintentional standard, pursuant to 37 CFR 1.137(b). The petitions are before the Office of Patent Legal Administration for decision.

The petitions taken together are **granted**.

DECISION

In the August 23, 2002, decision dismissing patent owner's PETITION TO REVIVE ABANDONED APPLICATION, it was stated:

> **"For the granting of the ... petition, it is required that patent owner provide:**
>
> > "(A) A Certificate that the petition papers and the May 20, 2002, and July 8, 2002, papers have been served on the third party requester; **and**
> >
> > **"(B)** A statement that: The entire delay in filing the required response from the due date for the response until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional."

By way of the present renewed and supplemental renewed petitions under 37 CFR 1.137(b), patent owner has now satisfied these requirements. The petition under 37 CFR 1.137(b) is accordingly granted.

It is noted that the present September 26, 2002, Supplemental Renewed Petition is not accompanied by a Certificate that the September 26, 2002, supplemental petition has been served on the third party requester. Since there is no indication that the third party requester was provided with a copy of the September 26, 2002, petition papers, a copy of such petition papers is 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).

CONCLUSION

1. The petition under 37 CFR 1.137(b) is **granted**.

2. The reexamination file is being returned to Technology Center 1700 for issuance of an Office action in due course.

3. Any further communications as to the merits of the reexamination proceeding should be directed to the examiner, Michael I. Poe, in Technology Center 1732, at (703)306-9170.

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

October 2, 2002
C:\KIVA\KPET-ABE\6069UNIN.GRT

90006069 20021002

UNITED STATES PATENT AND TRADEMARK OFFICE

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ALEXANDRIA, VA 22313-1450
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Paper No. 11

Jeffrey W. Salmon, Esq.
WELSH & KATZ, Ltd.
120 South Riverside Plaza
22nd Floor
Chicago, IL 60606

(For Patent Owner)

MAILED

JUN 30 2004

REEXAM UNIT

In re Green, et al.
Reexamination Proceeding
Control No. 90/006,074
Filed: July 31, 2001
For: U.S. Patent No. 6,084,973

DECISION GRANTING PETITION

This is a decision on the patent owner petition filed March 11, 2004, for entry of belated papers under 37 CFR 1.137(b), based upon unintentional delay. The petition is before the Office of Patent Legal Administration for consideration.

The petition fee of $1330 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.

A copy of the required reply to the non-final Office action of September 9, 2003, accompanied 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**.

CONCLUSION

1. The petition is **granted**.

2. The reexamination file will be forwarded to Technology Center 2600 for consideration of the response to the non-final Office action of September 9, 2003.

3. Further inquiries with regard to this reexamination proceeding should be directed to the examiner, Xu Mei, of Group Art Unit 2644.

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

May 11, 2004

90006074.063004

UNITED STATES PATENT AND TRADEMARK OFFICE

#6
3/14/02

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Paper No. 6

MAR 14 2002

Peter J. Wied, Esq.
IRELL and MANELLA LLP
1800 Avenue of The Stars, Suite 900
Los Angeles, CA 90067

FOR PATENT OWNER

SmartDisk Corporation
c/o Mark E. Nusbaum
NIXON & CANDERHYE, P.C.
1100 North Glebe Road, 8th Floor
Arlington, Virginia 22201

FOR THIRD PARTY REQUESTER

In re GORDON et al.
Reexamination Proceeding.
Control No. 90/006,136
Filed: October 31, 2001
For: U.S. Patent No. 5,224,216

DECISION SUA SPONTE, MERGING REEXAMINATION PROCEEDINGS

In re GORDON et al.
Reexamination Proceeding
Control No. 90/006,077
Filed: August 6, 2001
For: U.S. Patent No. 5,224,216

DECISION

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. 5,224,216 issued on June 29, 1993.

2. A first request for reexamination, Control No. 90/006,077 ('077) was filed by the Patent Owner on August 6, 2001.

3. Reexamination was ordered in the '077 reexamination proceeding on August 31, 2001.

4. A second request for reexamination, Control No. 90/006,136 ('136) was filed by the Third Party Requester on October 31, 2001.

5. Reexamination was ordered in the '136 reexamination proceeding on December 31, 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 '077 and '136 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 Proceedings

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 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.

Stewart J. Levy, Director
Technology Center 2100
Computer Architecture, Software, and
Electronic Commerce

Page 2 of 2

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,078 ✓	08/10/2001	5241219	181939-00084 (332-7140)	3190

90/005,930

7590 04/03/2002

Charles R. Wolfe, Jr., Esq.
Blank Rome Comisky and McCauley LLP
The Farragut Building Suite 1000
900 Seventeenth Street N. W.
Washington, DC 20006

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/03/2002

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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Paper No. 7

Charles R. Wolfe
Blank, Rome, Comisky & McCauley, LLP
The Farragut Building, Suite 1000
900 17th Street, N.W.
Washington, D.C. 20006

(for patent owner)

Gregor N. Neff, Esq.
Theodore J Mlynar, Esq.
Kramer, Levin, Naftalis & Frankel
919 Third Avenue
New York, NY 10022

(for requester)

Document Options

In re LeBaron *et al.*
Reexamination Proceeding
Control Number 90/005,930
Filed: February 16, 2001
For: U.S. Patent No. 5,241,219
Title: Current Mode Coupler

DECISION MERGING
REEXAMINATION PROCEEDINGS

In re LeBaron *et al.*
Reexamination Proceeding
Control Number 90/006,078
Filed: February 16, 2001
For: U.S. Patent No. 5,241,219
Title: Current Mode Coupler

The above-identified reexamination files are before the Director of Examining Group 2830, Technology Center 2800, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 5,241,219 issued on August 31, 1993.

2. A first request for reexamination, Reexamination Control No. 90/005,930, was filed by the patent owner on February 16, 2001.

3. Reexamination was ordered in the '930 reexamination proceeding on March 21, 2001.

4. A second request for reexamination, Reexamination Control No. 90/006,078, was filed by a third party requester on August 10, 2001.

5. Reexamination was ordered in the '078 reexamination proceeding on September 20, 2001.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

> If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* reexamination has not been terminated, the *ex parte* reexamination proceedings will be consolidated and result in the issuance of a single certificate of a single certificate under § 1.570.

As noted above, 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 of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '930 and '078 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.

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. '930 and '078 are merged. The reexamination files are being forwarded to the examiner for issuing a first Office action.

for Richard K. Seidel, Group Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

90006078 . 040302

UNITED STATES DEPARTMENT OF COMMERCE
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Washington, D.C 20231

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

GREGOR N. NEFF, ESQ.
THEODORE J. MLYNAR, ESQ.
KRAMER LEVIN NAFTALIS & FRANKEL
919 THIRD AVENUE
NEW YORK, NY 10022

REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/006,078 & 90/605,930

PATENT NO. 5,241,219

ART UNIT 2836

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).

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ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No. 17

Daniel R. Johnson, Esq.
RYAN KRUMHOLZ & MANION, S.C.
P.O. Box 26618
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(For Patent Owner)

Michael J. Keenan
NIXON & VANDERHYE, P.C.
1100 N. Glebe Rd., 8th Floor
Arlington, VA 22201

(For Requester)

MAILED

DEC 10 2003

REEXAM UNIT

In re Tentler, et al.
Reexamination Proceeding
Control No. 90/006,079
Filed: August 10, 2001
For: U.S. Patent No. 6,125,833

DECISION DISMISSING PETITION

This is a decision on the October 16, 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 $650.00 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 **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 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 instant petition lacks item(1) above. Although a response to the outstanding non-final Office action was filed on September 3, 2002, this paper does not constitute "the required reply" pursuant to 37 C.F.R. § 1.137(b)(1), as the amendment is not in compliance with 37 CFR § 1.530. Specifically, the amendment is **not** in compliance with 37 CFR § 1.530, because the amendment of newly added claim 15 should not show any deletions being made with bracketing. Claim 15 is a new claim to the patent and only the desired text of this claim should appear and should be completely underlined as required by 37 CFR § 1.530(d)(2) and (f). Only text being deleted from the original patent should be bracketed. Note that the manner of making amendments in applications set forth in 37 CFR § 1.121 does not apply to reexamination proceedings, as stated in 37 CFR § 1.121(i).

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. The reexamination file will be stored in the Central Reexam Unit (CRU) for one month to await any such renewed petition. If no such renewed petition is timely received, the reexamination file will be forwarded to Technology Center 3700 for termination of the proceeding, and issuance of the Notice of Intent to Issue Reexamination Certificate (NIRC).

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

DECISION MAILED

By mail:

Assistant Commissioner for Patents
Box DAC
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX:

(703) 308-6916
Attn: Office of Patent Legal Administration

By hand:

Crystal Plaza Four, Suite 3C23
2201 South Clark Place
Arlington, VA

5. 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

December 8, 2003

90006079.121003

UNITED STATES PATENT AND TRADEMARK OFFICE

Paper No. 24

COMMISSIONER FOR PATENTS
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Briggs & Morgan P. A.
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80 South 8th Street
Minneapolis MN 55402

(For Patent Owner)

Michael J. Keenan
NIXON & VANDERHYE, P.C.
1100 N. Glebe Rd., 8th Floor
Arlington, VA 22201

(For Requester)

MAILED

MAR 2 4 2005

REEXAM UNIT

In re Tentler, et al.
Reexamination Proceeding
Control No. 90/006,079
Filed: August 10, 2001
For: U.S. Patent No. 6,125,833

DECISION GRANTING PETITION

This is a decision on the January 7, 2004, patent owner renewed 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 pursuant to 37 C.F.R. § 1.17(m) for the petition under 37 C.F.R. § 1.137(b) was paid with the previous 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)(II)(C) and (D).

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 instant petition includes 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 under 37 C.F.R. § 1.137(b) was unintentional." The statement contained in the petition varies from the language required by 37 C.F.R. § 1.137(b)(3); however, the statement contained in the 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 petition fee was paid with the previous petition. The renewed petition was accompanied by a response to the outstanding final rejection, which the primary examiner, John Ricci, has indicated renders the claims prima facie patentable and places the case in condition for the Notice of Intent to Issue Reexamination Certificate (NIRC), which meets the criteria of 37 C.F.R. § 1.137(b)(1).

In view of the above, the renewed 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 3700 for consideration of the response to the outstanding final rejection, and preparation of the Notice of Intent to Issue Reexamination Certificate.

3. Any inquiries with regard to the merits of this proceeding should be directed to Primary Examiner John Ricci, of Group Art Unit 3714.

4. Any telephone inquiries with regard 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

March 7, 2005

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

2/17/08 T.M

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FEB 12 2002
OFFICE OF THE DIRECTOR
TC 3600

Reexamination Control No. 90/006,010 – Paper No. 8
Reexamination Control No. 90/006,080 – Paper No. 8

FOR PATENT OWNER:

OYEN WIGGS GREEN & MUTALA
#480-The Station
601 West Cordova Street
Vancouver, B.C.
Canada V6B 1-G1

DECISION ON REEXAMINATION MERGER
37 CFR 1.565(c)

Reexam Control Nos. 90/006,010 and 90/006,080

FOR REQUESTER:

E.I. DuPont de Nemours & Co.,c/o
Roger D. Schaffer, Esq..
Clifford Chance Rogers & Wells LLP
200 Park Avenue
New York, NY 10166-0153

DO NOT ENTER

NOTICE OF CONSOLIDATION OF REEXAMINATION PROCEEDINGS

Background

1. U.S. Letters Patent No. 5,826,390 issued on October 27, 1998.

2. A first request for reexamination was filed by the patent owner, Sacks Industrial Corp. on May 17, 2001, and was assigned Reexamination Control No. 90/006,010.

3. On August 13, 2001, a second request for reexamination of U.S. Letters Patent No. 5,826,390 was filed by a third party requester, E.I. DuPont de Nemours & Co., and was assigned Reexamination Control No. 90/006,080

4. Reexamination was ordered in Reexamination Control No. 90/006,010 on July 23, 2001 and in Reexamination Control No. 90/006,080 on November 7, 2001.

5. An Information Disclosure Statement was filed by the patent owner on August 14, 2001 in Reexamination Control No. 90/ 006,010.

6. On January 4, 2002, the patent owner filed a notice that he would not be filing a Patent Owner's Statement in Reexamination Control No. 90/006,080.

90006080

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 both reexamination proceedings. 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. 90/006,010 and 90/006,080 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 requester and such requester will be sent copies of all papers mailed by the Office during these merged proceedings.

Conclusion

Reexamination Control Nos. 90/006,010 and 90/006,080 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 :

Gerald Goldberg
Director
Technology Center 3600

20050808

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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STEPHEN MCNAMARA (For Patent Owner)
ST. ONGE STEWARD JOHNSTON & REENS
986 BEDFORD STREET
STAMFORD, CT 06905

#7

ERIC A. LA MORTE (For Third Party Requester)
P.O. Box 434
YARDLEY, PA 19067

Enclosure: Requester's petition filed January 4, 2002

MAILED
JAN 28 2002
REEXAM UNIT

Perricone :
Reexamination Proceeding : DECISION
Control No. 90/006,081 : RETURNING
Filed: August 13, 2001 : PETITION
For: U.S. Patent No. 5,709,868 :

This is a decision on the January 4, 2002, third party requester "PETITION TO REVIEW IN PART DECISION FOR GRANTING REQUEST FOR EX PARTE REEXAMINATION." The petition is taken as a petition under 37 CFR 1.182 for the reasons pointed out below. The petition is before the Office of Patent Legal Administration for decision.

The petition paper is returned to the requester for the reasons pointed out below.

DECISION RETURNING IMPROPER SUBMISSION
AND DISMISSING PETITION

The third party requester petition filed January 4, 2002, is being returned with this decision, since the petition is an improper submission under 37 CFR 1.540.

Pursuant to the second sentence of 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 petition filed January 4, 2002 is not a statement under 37 CFR 1.530, nor is it a reply under 37 CFR 1.535. Accordingly, the petition is improper submission under 37 CFR 1.540. The petition is being returned pursuant to MPEP 2267; the present decision will, however, be made of record in the file of the present reexamination. It should be noted that the petition has not been considered other than to return it as an improper submission.

The relief requested in the petition is that the Commissioner "Review the request for Reexamination so that Japanese patent disclosure No. 62-175415 can be considered within the reexamination process." With respect to this requested relief, the following is to be noted:

MPEP 2246 states:

> "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).** [Emphasis Added]

In the present instance, the finding of a substantial new question to support the request for reexamination is based on less than all the grounds urged by the requester; the proposed ground based upon Japanese patent disclosure No. 62-175415 was not adopted in the decision granting reexamination. Thus, the fact situation falls squarely within the guidelines of the MPEP, and there is no right to petition the examiner's finding (in the order for reexamination) to the Commissioner.

An additional point as to the relief requested is as follows:

The rules do not provide for a review of the examiner's failure to adopt one of the grounds proposed by requester where reexamination is granted (ordered), because all the art in the proceeding will again be considered during the examination stage of the reexamination proceeding. In the examination stage, the examiner will review the entire record, including the file history of the patent, and will apply all grounds of rejection deemed appropriate. The examiner is free to reconsider the use of Japanese patent disclosure No. 62-175415 by itself, or in combination with other art. Thus, the examiner's decision not to base the order for reexamination upon Japanese patent disclosure No. 62-175415 does not bar further consideration of that patent in the proceeding; rather, requester will in fact obtain further consideration of Japanese patent disclosure No. 62-175415 in the examination stage of the proceeding.

As a final point, in the present instance, requester is not barred from obtaining the relief being sought, since requester can obtain such relief via an alternative avenue. If requester desires a further review of Japanese patent disclosure No. 62-175415 based upon the comments submitted in the present petition, or other comments or information, requester is free to file a subsequent request for reexamination prior to the conclusion of the present reexamination proceeding citing Japanese patent disclosure No. 62-175415 and providing any new information or comments requester deems appropriate. See MPEP 2240 and MPEP 2283.

THE PRESENT PETITION IS TAKEN AS
A PETITION UNDER 37 CFR 1.182

1. The present petition fails to identify the rule or rules upon which the relief requested in the petition is grounded.

As pointed out above, the relief requested in the petition is that the Commissioner "Review the request for Reexamination so that Japanese patent disclosure No. 62-175415 can be considered within the reexamination process." There is, however, no provision authorizing such relief in the rules or statute. Accordingly, the petition is taken as a petition based upon

37 CFR 1.182, for a situation not specifically provided for in the regulations.[1]

A petition under 37 CFR 1.182 must be accompanied by the petition fee set forth in 37 CFR 1.17(h) of $130.00. Such fee has been paid by petitioner.

2. It is to be noted that the petition cannot be taken as a petition under 37 CFR 1.515(c), despite the examiner's refusal to adopt one of the grounds proposed in the request.

The relief requested in the request for reexamination was the reexamination of patent number 5,709,868 (the '868 patent). That relief was granted the October 29, 2001, Order Granting Reexamination.[2]

The first sentence of 37 CFR 1.515(c) states:

> "The requester may seek review by a petition to the Commissioner under § 1.181 within one month of the mailing date of the examiner's determination **refusing *ex parte* reexamination.** Any such petition must comply with § 1.181(b)." [Emphasis Added]

Reexamination in this instance was not refused; rather, the Office declined to find a substantial new question of patentability based upon one of the grounds for reexamination advanced by requester (the ground based upon Japanese patent disclosure 62-175415). Thus, the Office has exercised jurisdiction over the '868 patent, to reexamine the patent in the examination stage of the proceeding, to follow. That the Office declined to find a substantial new question of patentability based upon one of the grounds for reexamination advanced by requester does not change the fact that reexamination was granted.

---

[1] 37 CFR 1.182 reads as follows:
All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Commissioner, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(h).

[2] As stated in part (1) of the cover sheet of the October 6, 2001, Order [the examiner placed an X in that box], "The request for reexamination is GRANTED."

In the present instance, there has been no determination refusing reexamination. Although one of requester's proposed grounds for reexamination has not been adopted, reexamination has been granted, and the proceeding will advance to the examination stage in due course. Accordingly, the present petition cannot be taken as a petition under 37 CFR 1.515(c), since there is no authority for such in that rule.

CONCLUSION

1. The petition under 37 CFR 1.182 is returned to requester with the present decision.

2. The reexamination file is being forwarded to the examiner via the Group Director of Technology Center 1600, for the issuance of a first Office action in due course.

4. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Michael A. Willis (703-305-1679), of Technology Center Art Unit 1619.

5. 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
Office of the Deputy Commissioner
for Patent Examining Policy

January 23, 2002
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UNITED STATES PATENT AND TRADEMARK OFFICE

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STEPHEN MCNAMARA (For Patent Owner)
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ERIC A. LA MORTE (For Third Party Requester)
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Enclosure: Requester's petition filed January 4, 2002

MAILED
JAN 28 2002
REEXAM UNIT

Perricone :
Reexamination Proceeding : DECISION
Control No. 90/006,081 : RETURNING
Filed: August 13, 2001 : PETITION
For: U.S. Patent No. 5,709,868 :

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The relief requested in the petition is that the Commissioner "Review the request for Reexamination so that Japanese patent disclosure No. 62-175415 can be considered within the reexamination process." With respect to this requested relief, the following is to be noted:

MPEP 2246 states:

> "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).** [Emphasis Added]

In the present instance, the finding of a substantial new question to support the request for reexamination is based on less than all the grounds urged by the requester; the proposed ground based upon Japanese patent disclosure No. 62-175415 was not adopted in the decision granting reexamination. Thus, the fact situation falls squarely within the guidelines of the MPEP, and there is no right to petition the examiner's finding (in the order for reexamination) to the Commissioner.

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As a final point, in the present instance, requester is not barred from obtaining the relief being sought, since requester can obtain such relief via an alternative avenue. If requester desires a further review of Japanese patent disclosure No. 62-175415 based upon the comments submitted in the present petition, or other comments or information, requester is free to file a subsequent request for reexamination prior to the conclusion of the present reexamination proceeding citing Japanese patent disclosure No. 62-175415 and providing any new information or comments requester deems appropriate. See MPEP 2240 and MPEP 2283.

THE PRESENT PETITION IS TAKEN AS
A PETITION UNDER 37 CFR 1.182

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37 CFR 1.182, for a situation not specifically provided for in the regulations.[1]

A petition under 37 CFR 1.182 must be accompanied by the petition fee set forth in 37 CFR 1.17(h) of $130.00. Such fee has been paid by petitioner.

2. It is to be noted that the petition cannot be taken as a petition under 37 CFR 1.515(c), despite the examiner's refusal to adopt one of the grounds proposed in the request.

The relief requested in the request for reexamination was the reexamination of patent number 5,709,868 (the '868 patent). That relief was granted the October 29, 2001, Order Granting Reexamination.[2]

The first sentence of 37 CFR 1.515(c) states:

> "The requester may seek review by a petition to the Commissioner under § 1.181 within one month of the mailing date of the examiner's determination **refusing *ex parte* reexamination.** Any such petition must comply with § 1.181(b)." [Emphasis Added]

Reexamination in this instance was not refused; rather, the Office declined to find a substantial new question of patentability based upon one of the grounds for reexamination advanced by requester (the ground based upon Japanese patent disclosure 62-175415). Thus, the Office has exercised jurisdiction over the '868 patent, to reexamine the patent in the examination stage of the proceeding, to follow. That the Office declined to find a substantial new question of patentability based upon one of the grounds for reexamination advanced by requester does not change the fact that reexamination was granted.

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All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Commissioner, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(h).

[2] As stated in part (1) of the cover sheet of the October 6, 2001, Order [the examiner placed an X in that box], "The request for reexamination is GRANTED."

In the present instance, there has been no determination refusing reexamination. Although one of requester's proposed grounds for reexamination has not been adopted, reexamination has been granted, and the proceeding will advance to the examination stage in due course. Accordingly, the present petition cannot be taken as a petition under 37 CFR 1.515(c), since there is no authority for such in that rule.

CONCLUSION

1. The petition under 37 CFR 1.182 is returned to requester with the present decision.

2. The reexamination file is being forwarded to the examiner via the Group Director of Technology Center 1600, for the issuance of a first Office action in due course.

4. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Michael A. Willis (703-305-1679), of Technology Center Art Unit 1619.

5. 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
Office of the Deputy Commissioner
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January 23, 2002
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