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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO.
90/006,083	08/14/2001	6126697	T9430	4851

7590 03/11/2002

James F. Harvey
Harvey and Associates P. C.
3750 West Main Suite 120
Norman, OK 73072

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/11/2002 7

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

UNITED STATES PATENT and TRADEMARK OFFICE
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Mailed: 11 MAR 2002

CST

Paper No. 7

James F. Harvey Harvey and Associates, P.C. 3750 West Main Street, Suite 120 Norman, OK 73072	(for Patent Owner)
M. Wayne Western Thorpe, North & Western, LLP 8180 South 700 East, Suite 200 Sandy, Utah 84070	(for Requester)
In re Ebberts Reexamination Proceeding Control No. 90/006,083 Filed: August 14, 2001 For: U.S. Patent No. 6,126,697	DECISION ON PETITION UNDER 37 C.F.R. 1.181 SEEKING REVIEW OF ORDER DENYING REQUEST FOR *EX PARTE* REEXAMINATION

This is a decision on the PETITION UNDER 37 C.F.R. 1.181 SEEKING REVIEW OF ORDER DENYING REQUEST FOR *EX PARTE* REEXAMINATION, filed November 30, 2001 (certificate of mailing). Petitioner requests that that the examiner's decision denying the request for reexamination of U.S. Patent 6,126,697 be reversed.

Background

1. On August 14, 2001, a third party REQUEST FOR REEXAMINATION of U.S. Patent No. 6,126,697 was filed by Mr. M. Wayne Western of Thorpe, North & Western, LLP. The request cites U.S. Patent 5,718,729 to Harris, in view of the article "NEW TECHNOLOGIES: Carbonate/Bicarbonate-Based Systems Provide Numerous Applications Across Surface Substrate and Soil Type" by Bolkan, and U.S. patent

5,718,729 to Harris and U.S. Patent 5,244,468 to Harris, in view of the article "NEW TECHNOLOGIES: Carbonate/Bicarbonate-Based Systems Provide Numerous Applications Across Surface Substrate and Soil Type" by Bolkan, as raising a substantial new question of patentability with regard to claims 1-22 of U.S. Patent 6,126,697.

2. On October 31, 2001, the examiner denied the request for reexamination on the grounds that the teachings of the Bolkan reference would not be considered important to a reasonable examiner in deciding whether or not claims of U.S. patent 6,126,697 are patentable. Furthermore, the examiner noted that reexamination based on Harris '729 and Harris '468, considered alone or in combination, was precluded in view of *In re Portola Packaging Inc.,* 110 F. 3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997).

3. On November 30, 2001, the present petition was filed.

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 U.S. Patent 5,718,729 to Harris, in view of the article "NEW TECHNOLOGIES: Carbonate/Bicarbonate-Based Systems Provide Numerous Applications Across Surface Substrate and Soil Type" by Bolkan, and U.S. patent 5,718,729 to Harris and U.S. Patent 5,244,468 to Harris, in view of the article "NEW TECHNOLOGIES: Carbonate/Bicarbonate-Based Systems Provide Numerous Applications Across Surface Substrate and Soil Type" by Bolkan, each raise a substantial new question of patentability with regard to claims 1-22 of U.S. Patent 6,126,697 to Ebberts.

Petitioner argues that had the examiner been in possession of the Bolkan reference at the time of the initial examination, the examiner would have concluded that the mixture of the two critical carbonates claimed in the Ebberts patent merely produces the same composition, and results in the same method as that disclosed by the prior art.

It is agreed that consideration of Harris '729, in view of Bolkan raises a substantial new question of patentability as to claims 1-22 of the Ebberts patent. Harris '729 was discussed during the prosecution of U.S. patent 6,126,697. In the examiner's statement of reasons for allowance of June 19, 2000 in Application No. 09/461,261, the examiner indicated that although Harris '729 generally discloses mixtures of sodium carbonate and sodium bicarbonate in cleaning compositions, Harris '729 does not provide any examples of cleaning compositions containing both sodium carbonate and sodium bicarbonate. It was further noted that Harris '729 does not disclose the weight and/or volume amounts of sodium carbonate and sodium bicarbonate present in a mixture of the two. Harris '729

also teaches that when the acid solution is combined with the carbonate solution, the pH will usually be in the range of 6 to 8 and will preferably be about 7 (col. 8, lines 52-62).

Bolkan was not considered by the PTO during prosecution of the 6,126,697 patent. Bolkan teaches that compositions can be formulated over a range of pHs by using the proper ratio of carbonate and bicarbonate as shown in Figure 2 (pages 4 and 5). Furthermore, Bolkan teaches that carbonic acid, bicarbonate and carbonate exist together in equilibrium, and that the relative concentrations of the various carbonate forms are a function of pH (see page 17 of the Request). These teachings were not present in the prosecution of the application which became the Ebberts patent.

The teachings of Harris '729, in view of Bolkan were not considered during the prosecution of the application that became US patent 6,126,697. There is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not claims 1-22 are patentable. Accordingly, Harris '729 in view of Bolkan raises a substantial new question of patentability as to claims 1-22 which question has not been decided in a previous examination of US patent 6,126,697. 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.

Similarly, it is agreed that consideration of Harris '729 and Harris '468, in view of Bolkan raises a substantial new question of patentability as to claims 1-22 of the Ebberts patent. As discussed *supra*, Harris '729 was discussed during the prosecution of U.S. patent 6,126,697. Both Harris '729 and Harris '468 were employed in the office action of May 26, 1999 and in the final office action of October 19, 1999 in Application No. 09/283,254 to reject claims 1-22. Neither Harris '729 nor Harris '468 provide any examples of cleaning compositions which contain both sodium carbonate and sodium bicarbonate. Also, neither Harris '729 nor Harris '468 disclose the weight and/or volume amounts of sodium carbonate and sodium bicarbonate present in a mixture of the two.

Bolkan was not considered by the PTO during prosecution of the 6,126,697 patent. As discussed *supra,* Bolkan teaches that compositions can be formulated over a range of pHs by using the proper ratio of carbonate and bicarbonate as shown in Figure 2 (pages 4 and 5).

The teachings of Harris '729 and Harris '468, in view of Bolkan were not considered during the prosecution of the application that became US patent 6,126,697. There is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not claims 1-22 are patentable. Accordingly, Harris '729 and Harris '468, in view of Bolkan raises a substantial new question of patentability as to claims 1-22 which question has not been decided in a previous examination of US patent

6,126,697. See *In re Hiniker Co.*, 150 F.3d 1362, 1367, 47 USPQ2d 1523, 1527 (Fed. Cir. 1998).

Summary

A substantial new question of patentability affecting at least one claim of U.S. patent 6,126,697 to Ebberts is raised for the reasons set forth above.

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.

Richard V. Fisher

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,350 ; 90/006,083	08/08/2002	6126697	11392.0201	6638

7590 01/14/2003

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EXAMINER

ART UNIT	PAPER NUMBER
	8

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
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Paper No. 8

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M. Wayne Western Thorpe, North & Western, LLP 8180 South 700 East, Suite 200 Sandy, Utah 84070	(for Third Party)
Michael W. Starkweather Jones, Waldo, Holbrook & McDonough 170 South Main Street, Suite 1500 Salt Lake City, Utah 84101	(for Third Party)
In re Ebberts Reexamination Proceeding Control No. 90/006,083 Filed: August 14, 2001 For: U.S. Patent 6,126,697 In re Ebberts Reexamination Proceeding Control No. 90/006,350 Filed: August 8, 2002 For: U.S. Patent 6,126,697	**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 6,126,697, issued October 3, 2002, is the subject of Reexamination Control Nos. 90/006,083 and 90/006,350.

2. A first request for reexamination, assigned Reexamination Control No. 90/006,083 ('083) was filed August 14, 2001 by M. Wayne Western of Thorpe, North & Western, LLP. The request urged that a substantial new question of patentability was raised by the teachings of (a) U.S. patent 5,718,729 to Harris, in view of Bolkan, "New Technologies: Carbonate/bicarbonate-based systems provide numerous applications across surface substrate and soil type," Precision Cleaning Magazine, January/February, 1996; or (b) U.S. patent 5,718,729 to Harris and U.S. patent 5,244,468 to Harris et al, in view of Bolkan, "New Technologies: Carbonate/bicarbonate-based systems provide numerous applications across surface substrate and soil type," Precision Cleaning Magazine, January/February, 1996.

3. The request for reexamination was denied for '083 on October 31, 2001.

4. A Petition Under 37 C.F.R. 1.181 Seeking Review of Order Denying Request for *Ex Parte* Reexamination was received on December 11, 2001 (certificate of mailing November 30, 2001).

5. The Petition Under 37 C.F.R. 1.181 Seeking Review of Order Denying Request for *Ex Parte* Reexamination was granted on March 11, 2002. In this decision, it was set forth that reexamination was ordered for '083.

6. A second request for reexamination, assigned Reexamination Control No. 90/006,350 ('350), was filed August 8, 2002 by Michael W. Starkweather of Jones, Waldo, Holbrook & McDonough. The request urged that a substantial new question of patentability was raised by the teachings of U.S. patent 5,718,729 to Harris and U.S. patent 5,244,468 to Harris et al, in view of WO 98/46716 to Spadoni et al.

7. Reexamination was ordered for '350 on October 9, 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 90/006,083 and 90/006,350 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 files shall be forwarded to the examiner for preparation of an Office action.

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. 90/006,083 and 90/006,350 as:

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CONCLUSION

Reexamination Control Nos. 90/006,083 and 90/006,350 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

UNITED STATES PATENT AND TRADEMARK OFFICE

#9

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
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Reexamination Control No. 90/006,088

Paper No. 9

MAILED

FEB 14 2002

Office of the Director
Group 3600

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FOR REQUESTER:

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DECISION ON PETITION TO VACATE ORDER GRANTING REEXAMINATION

This decision is in response to the "Petition Under 37 C.F.R. §1.181(a)(3) or §1.182 and Section 1002.02(c)(3) of the M.P.E.P" received in the United States Patent and Trademark Office (USPTO) on October 29, 2001. This petition is considered to be a request to invoke the supervisory authority of the Commissioner under 37 CFR §1.181. The relief requested is for the USPTO to withdraw the reexamination order in view of the cumulative nature of the prior art and/or in view of *In re Recreative Technologies Corp.*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996) and related case law.

The petition is **DENIED**.

The request for reexamination of U.S. Patent No. 6,052,334 ('334) was filed by third party requester on August 20, 2001. On October 19, 2001 the examiner determined that the prior art submitted by the requester raised a substantial new question of patentability and issued the order granting reexamination. On October 23, 2001 a Submission of Prior Art Under 35 U.S.C. §301 and 37 C.F.R. 1.501 (hereinafter the 1.501 statement) was received for inclusion in the file of the '334 patent. On October 29, 2001 the petition under consideration was received by facsimile transmission. Included with the petition was a copy of the 1.501 statement submitted in the patented file. The prior art documents discussed in the 1.501 statement were not included with the petition since they were already included in the reexamination file as the references forming the basis for the reexamination request.

Patent owner does not have a right to petition the removal of an order granting reexamination As set forth in Section 2246 of the Manual of Patent Examining Procedure (MPEP):

> 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).

When considering a request to reexamine a patent, the examiner, in most instances, has discretion to grant or deny the request. However, in cases where no discretion to grant a request for reexamination exists, a petition under 37 CFR 1.181(a)(3) to vacate the decision to grant the request will be entertained. In MPEP 2246 several examples of situations where such a petition would be entertained are set forth. One of those situations is when the reexamination order is based wholly on prior art previously considered in an earlier concluded examination of the patent by the Office (e.g., the application which matured into the patent, a prior reexamination, an interference proceeding). With regard to this particular situation MPEP 2246 cites *In re Hiniker Co.*, 150 F.3d 1362, 47 USPQ2d 1523 (Fed. Cir. 1998), *In re Portola Packaging Inc.*, 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997), and *In re Recreative Technologies Corp.*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir 1996) as being relevant, and directs the reader to MPEP 2242 for the criteria for vacating a reexamination order in view of these decisions.

In the petition patent owner asserts that the reexamination should be vacated since the prior art cited by the requester is cumulative to the references previously considered during the prosecution of the '334 patent. A prior art patent or printed publication raises a substantial question of patentability where there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. In making a determination whether to reexamine a patent based on a request, the examiner should consider the prior art patents and/or printed publications to determine if there is a substantial likelihood that a

reasonable examiner would consider them important in deciding whether or not at least one claim is patentable. If, however, the same question of patentability as to the claim has been decided by the Office in a previous examination of the patent (this includes examination of the application which matured into the patent), then granting reexamination of the patent in question would be inappropriate. For example, the same question of patentability may have already been decided by the Office where the examiner finds that additional prior art patents or printed publications are merely cumulative to similar prior art already fully considered by the Office in a previous examination of the claim, MPEP 2242.

Guidance for the examiner in evaluating the *Portola Packaging* implications with respect to a potential cumulative reference situation is provided in MPEP 2242.

> To the extent that a cumulative reference is repetitive of a prior art reference that was previously **applied or discussed**, *Portola Packaging* may prohibit reexamination of the patent claims based only on the repetitive reference. For purposes of reexamination, a cumulative reference that is repetitive is one that substantially reiterates verbatim the teachings of a reference that was either **previously relied upon or discussed in a prior Office proceeding** even though the title or the citation of the reference may be different. However, it is expected that a repetitive reference which cannot be considered by the Office during reexamination will be a rare occurrence since most references teach additional information or present information in a different way than other references, even though the references might address the same general subject matter. (Emphasis added)

The threshold consideration that must be addressed is whether or not *Portola Packaging* even applies to the present situation. The application that matured into the '334 patent was allowed by the examiner on the first Office action. The reasons for allowance included with the Notice of Allowability and the initialed copies of the Information Disclosure Statement by Applicant (PTO- 1449) do not specifically address any of the cited references by name. The examiner only mentions that the prior art does not show "...determining a directional spectrum utilizing a sensitivity vector and range cells." In the portion of the '334 specification headed "Description of the Related Technology" (pages 1-4 of the application and columns 1-3 of the '334 patent) two cited documents are specifically identified and discussed. Only one of the specifically identified documents in the patent is discussed in the 1.501 statement, the Krogstad, et al article "High Resolution Directional Wave Spectra From Horizontally Mounted Acoustic Doppler Current Meters," *Journal of Atmospheric and Oceanic Technology*, V.5, No 4:340-352, (1988). The Takayama, et al article "Development of a Submerged Doppler-Type Directional Wave Meter", *Coastal Engineering*, 46:624-634, (1994) cited on the cover page of the '334 patent, which patent owner alleges discloses the same information as the Takayama, et al reference (Japanese document 2,948,472) cited by the requester, is not discussed at all. Requester proposes that there are substantial new questions of

patentability with regard to the Takayama, et al patent document taken alone and in combination with various other documents cited in the request. Patent owner's attempt at having the order granting reexamination vacated due to the alleged cumulative teachings of the Takayama, et al patent document when compared to the Takayama, et al publication cited in the '334 patent does not fit within the guidelines for applying *Portola Packaging* set forth in MPEP 2242. The Takayama, et al publication was neither applied to the claims of the application nor discussed in the application file by either the examiner or applicants. Therefore, to now urge that the Takayama, et al patent document is cumulative of the Takayama, et al publication is not on point.

The Krogstad, et al article noted above was specifically addressed in the specification of the application. This fact makes *Portola Packaging* relevant with respect to any proposed substantial new question of patentability involving the Krogstad, et al document. Requester proposes four substantial new questions of patentability, the first being the anticipation of certain claims of the '334 patent under 35 U.S.C. §102 by the Takayama, et al patent document. The remaining three proposed new questions of patentability are questions of obviousness under 35 U.S.C. §103 using each of the three newly cited publications in combination with the Takayama, et al patent document. Patent owner urges that the three newly cited articles are cumulative to the disclosure of the Krogstad, et al article mentioned above. Assuming *arguendo* that the Krogstad, et al article discussed in the '334 patent was cited by requester as the sole reference supporting a substantial new question of patentability, *Portola Packaging* would preclude ordering reexamination of the patent based on the Krogstad, et al article. However, if the Krogstad, et al article discussed in the patent were combined with another prior art reference that had not been considered during the prosecution of the application which resulted in the '334 patent, reexamination of the patent may have been ordered, *In re Hiniker, supra.* Patent owner argues that the publications cited by requester are cumulative to the information provided by the Krogstad, et al article cited in the patent. This argument is not persuasive for the same reason discussed above *vis-à-vis* the Krogstad, et al article cited in the patent.

In the 1.501 statement, patent owner asserts that the Takayama et al reference (Japanese document 2,948,472) "...**appears** to disclose precisely the relevant information as in the publication Takayama, et al. 'Development of a Submerged Doppler-Type Directional Wave Meter', *Coastal Engineering*, 46:624-634, (1994) listed on the front page of the Brumley, et al. patent (USPN 6,052,334)." (emphasis added). Patent owner includes additional comments regarding the alleged similarities between the Takayama et al patent document and the Takayama et al publication which was cited in the '334 patent. Assuming *arguendo* that *Portola Packaging* applies, these statements are patent owner's opinions that are not as persuasive as definitive statements regarding the similarities of the two references would be. Further, since one reference is a technical publication and the other a patent document, it would be necessary for patent owner to show that the information provided in one document is identical to the information provided in the other for there to be a persuasive argument of cumulative references. As set forth in MPEP 2242 and discussed above, for purposes of reexamination, a cumulative reference that is repetitive is one that substantially reiterates verbatim the teachings of a reference

that was either previously relied upon or discussed in a prior Office proceeding even though the title or the citation of the reference may be different. However, it is expected that a repetitive reference which cannot be considered by the Office during reexamination will be a rare occurrence since most references teach additional information or present information in a different way than other references, even though the references might address the same general subject matter.

In determining the differences in the Takayama, et al patent document *vis-a-vis* the Takayama, et al article, the examiner determined that the information provided by the patent document was of sufficient importance and sufficiently different from the article to qualify as a viable reference which would raise a substantial new question of patentability. The other documents cited by the requester were also discussed in the 1.501 statement. It is noted, however, that the rejections proposed by the requester used these additional references in combination with the Takayama, et al patent document. Again, assuming *arguendo* that *Portola Packaging* applies, whether or not these documents are individually cumulative *vis-à-vis* references considered in the prosecution of the original patent is not dispositive in view of the determination made with respect to the Takayama et al patent document in the above paragraph. However, it is noted that patent owner has tied all three articles cited by requester to the Krogstad, et al publication cited on the cover page of the '334 patent. None of the three newly cited publications is identical to the Krogstad, et al publication cited in the patent. Each newly cited publication contains different information which the examiner considers to be of sufficient importance to justify the grant of reexamination when taken in combination with the Takayama, et al patent document.

Reexamination of United States Patent 6,052,334 is deemed to be appropriate and, therefore, the order granting reexamination will not be vacated. The reexamination file will be forwarded to the examiner for prompt commencement of *ex parte* examination since the two month time period for filing a patent owner's statement expired on December 19, 2001.

SUMMARY:

The petition to vacate the order granting reexamination is **DENIED**.

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RR
rar: 1/23/02

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JUN 0 6 2006

REEXAM UNIT

In re Reissue Application of Jui-Teng Lin Application No. 10/621,105 Filed: July 10, 2003 For: U.S. Patent No. 6,258,082	:	**DECISION, *SUA SPONTE*, TO MERGE REISSUE AND REEXAMINATION PROCEEDINGS**
In re Jui-Teng Lin Reexamination Proceeding Control No. 90/006,089 Filed: August 21, 2001 For: U.S. Patent No. 6,258,082	:	

The above-captioned reissue and reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.565(d) at this time.

REVIEW OF FACTS

1. U.S. patent No. 6,258,082 (the '082 patent) issued on July 10, 2001, with 15 claims.

2. A request for reexamination was filed by a third party requester on August 21, 2001, and was assigned control No. 90/006,089 (the '089 proceeding).

3. Reexamination was ordered for the '089 proceeding on October 9, 2001.

4. An application for reissue, assigned application No. 10/621,105 (the '105 application), was filed by the patent owner on July 10, 2003.

5. A non-final Office action was mailed in the '089 proceeding on September 20, 2005.

6. A response to the non-final office action in the '089 proceeding was received from the patent owner on November 15, 2005.

7. In the '105 application, a petition entitled "Petition to accept an unexecuted declaration under 37 CFR 1.47 (b)" was filed on December 1, 2005. This petition was granted on December 19, 2005.

8. The filing of the '105 reissue application was announced in the *Official Gazette* on January 24, 2006.

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. 10/621,105 and reexamination control No. 90/006,089 are currently pending. The order to reexamine has been mailed in the reexamination proceeding, and notice of the reissue application has been published in the *Official Gazette*. Accordingly, 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, and 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 the reissue and reexamination proceedings and to prevent inconsistent, and possibly conflicting, amendments from being introduced on behalf of the patent owner, it is appropriate that the instant reissue and reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexamination proceeding will be merged in accordance with the decision set forth below.

It is to be noted, however, that the grant of merger of a reissue application and an *ex parte* reexamination proceeding under 37 CFR 1.565(d) **is discretionary**. *The present merger is not an assurance that, in a future similar situation, merger would be ordered.*

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-captioned reissue and reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in Both Proceedings

1. The patent owner is required to maintain identical amendments in the reissue application and the reexamination files for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the reissue and

reexamination proceedings remain merged. See 37 CFR 1.565(d).

2. A review of the file for reexamination control No. 90/006,089 shows:

(a) Original patent claims 1-15 are present, with claim 3 being last amended on November 15, 2005, and claims 4-10, 12, and 13 also having been amended.

(b) New claims 16-18 have been added.

A review of reissue application No. 10/621,105 shows:

(a) Original patent claims 1-15 are present; with claims 3-10, 12, and 13 having been amended on July 10, 2003.

(b) New claims 16-18 have been added.

At least claim 3 in the reexamination, as amended on November 15, 2005, is not identical to claim 3 as it was amended in the reissue application.

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 both proceedings, specifically, Application No. 10/621,105 and Control Number 90/006,089. The response to this requirement must be limited to formally placing the same amendments in all cases, and patent owner must **not** address any issue of patentability in the housekeeping amendment. It is to be noted that, pursuant to MPEP 2285, amendments in a merged proceeding are submitted under 37 CFR 1.173, in accordance with reissue practice.

III. Conduct of the Merged Reissue Application Examination and Reexamination Proceedings

1. After the appropriate housekeeping amendment (see Part II above) is received, or after the time for same expires, the examiner should promptly prepare an Office action for the merged proceeding.

2. In the event that 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 claim, and thus failing to particularly point out the invention.

3. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. 305 relating to the conduct of *ex parte* reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue-application examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. **However, periods for response should be set at TWO (2) months to comply with the statutory requirement for special dispatch in *ex parte* 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 proceeding. Each action will contain identifying data *for both of the cases*, i.e, the reissue application and the reexamination proceeding, and each action will be entered into both files (which will be maintained as separate files).

5. Any response by the applicant/patent owner must consist of a single response, with two copies being filed for entry in the two files, with each of the two bearing a signature. Any such response must contain identifying data *for both of the cases*, i.e, the reissue application and the reexamination proceeding. *Any such responses must be served on the requester*, who will also be sent copies of Office actions.

6. Pursuant to MPEP 2285, for a merged proceeding containing a reexamination proceeding and a reissue application:

"Amendments should be submitted in accordance with the reissue practice under ... 37 CFR 1.173; see MPEP § 1453."

Thus, the filing of any amendments to the specification, claims, or drawings must comply with the provisions of 37 CFR 1.173, and with the guidelines of MPEP 1453. It is to be noted that 37 CFR 1.121 does not apply to amendments in a reissue application. Accordingly, clean copies of the amended claims are not required, *and such clean copies are not to be submitted*. Instead, pursuant to 37 CFR 1.173(b)(2), amendments are to be presented via markings pursuant to 37 CFR 1.173(d), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.173(g), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the reissue application. *Amendments are not to be made relative to previous amendments*. Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

7. Where a paper is filed which requires payment of a fee (e.g., petition fee, excess claims fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for any patent owner appeal brief, even though such a brief would relate to the merged multiple proceedings, and even though copies must be filed (as pointed out above) for each file of the merged proceeding.

8. The examiner (a) will review the files to ensure that each file contains identical citations of prior patents and printed publications, and (b) will cite such documents as are necessary as part of the next Office action in order to place the files in that condition.

9. If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be concluded by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 CFR 1.570. See MPEP 2285.

10. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be dissolved. The reissue application will be held abandoned. The reexamination prosecution will be terminated, and a reexamination certificate under 37 CFR 1.570 will be issued in accordance with the last action of the Office, unless further action in the reexamination proceeding is needed as a result of the difference in the rules relating to reexamination and reissue proceedings. If further action in the reexamination proceeding is needed, any grounds of rejection that are not applicable under reexamination would be withdrawn (e.g., based on public use or on 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 for consideration in reexamination pursuant to 37 CFR 1.552(c).

10. If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 CFR 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue examination as to the reexamination proceeding. Such examination would be conducted as set forth in the immediately preceding paragraph.

CONCLUSION

1. Reissue application No. 10/621,105 and reexamination control No. 90/006,089 **are merged** into a single proceeding.

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

3. Jurisdiction over the merged reissue and reexamination proceeding is being transferred to Technology Center 3700 in which the reissue proceeding is assigned. The examiner assigned the merged proceeding is not to be one who was

involved in any part of the examination of the '082 patent (e.g., by preparing/signing an action). See MPEP 2236.

4. The examiner should not issue an Office action for the present merged proceeding 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 MONTH period from the mailing of this decision for filing the amendment.

5. All further examination in the merged proceeding should be conducted in accordance with Part III of this decision.

6. Telephone inquiries related to this decision should be directed to Karen Hastings, Legal Advisor, at (571) 272-7717.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

kmh
25 May 2006

June 4, 2006
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Richard A. DeCristofaro (For Patent Owner)
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MAILED

MAY 23 2005

REEXAM UNIT

William A. Munck, Esq. (For Requester)
P.O. Drawer 800889
Dallas, TX 75380

In re Reissue Application of Jui-Teng Lin Application No.: 10/626,486 Filed: July 24, 2003 For: U.S. Patent No. 6,263,879 In re Jui-Teng Lin Reexamination Proceeding Control No.: 90/006,090 Filed: August 22, 2001 For: U.S. Patent No.: 6,263,879	DECISION, *SUA SPONTE*, TO MERGE REISSUE AND REEXAMINATION PROCEEDINGS

The above reissue application and reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.565(d) at this time.

REVIEW OF FACTS

1. U.S. Patent No. 6,263,879 (the '879 patent) issued on July 24, 2001.

2. A request for reexamination, assigned control No. 90/006,090 (the '6090 reexamination proceeding), was filed by a third party requester on August 22, 2001.

3. Reexamination was ordered for the '6090 reexamination proceeding on October 9, 2001.

4. A terminal disclaimer for the '879 patent was received from the patent owner on January 30, 2002.

5. A non-final Office action was mailed in the '6090 reexamination proceeding on May 28, 2003.

6. A response to the non-final Office action in the '6090 reexamination proceeding was received from the patent owner on July 21, 2003.

7. An application for reissue, assigned application No. 10/626,486 (the '6486 application), was filed by the patent owner on July 24, 2003.

8. A supplemental response to the non-final Office action in the '6090 reexamination proceeding was received from the patent owner on March 1, 2004.

9. A non-final Office action was mailed in the '6090 reexamination proceeding on April 29, 2005.

10. Notice of the filing of the reissue application was published in the *Official Gazette* on October 7, 2003.

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. 10/626,486 and reexamination control No. 90/006,090 are currently pending. Since the order to reexamine has been mailed in the reexamination proceeding, a decision under 37 CFR 1.565(d) is timely.

The general policy of the Office is that a reissue application examination and a reexamination proceeding will not be conducted separately at the same time as to a particular patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of both proceedings. In making a decision on whether or not to merge the two proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

In order to provide efficient and prompt handling of all proceedings and to prevent inconsistent, and possibly conflicting, amendments from being introduced on behalf of the patent owner, it is appropriate that the instant 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 merged in accordance with the decision set forth below.

It is to be noted, however, that the grant of merger of a reissue application and an *ex parte* reexamination proceeding under 37 CFR 1.565(d) is discretionary. *The present merger is not an assurance that, in a future similar situation, merger would be ordered.*

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-captioned reissue and reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in Both Proceedings

1. The patent owner is required to maintain identical amendments in the reissue application and the reexamination proceeding files for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the proceedings remain merged. See 37 CFR 1.565(d).

2. A review of the reexamination file for the proceeding of reexamination control No. 90/006,090 shows that original patent claims 1-13 are present and claims 14-23 are added by amendment. A review of reissue application No. 10/626,486 shows that original patent claims 1-13 are present and claims 14-23 are added by amendment. Accordingly, the claims are identical in number, but may or may not be identical as to content in both proceedings.

   If the claims are different as to content, an appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both cases, specifically, Application No. 10/626,486, and Control Number 90/006,090. 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.

   If the claims are identical as to text, a patent owner statement to that effect is required within ONE (1) MONTH of this decision.

III. Conduct of the Merged Reissue Application Examination and Reexamination Proceedings

1. After the appropriate housekeeping amendment or statement as per 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 *ex parte* 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 proceeding. Each action will contain identifying data for both of the cases, i.e, the reissue application and the reexamination proceeding, and each action will be physically entered into both files (which will be maintained as separate files).

5. Any response by the applicant/patent owner must consist of a single response, with two copies being filed for entry into 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.

6. The filing of any amendments to the drawings, specification or claims must comply with the provisions for amendment in a reissue application set forth in 37 CFR 1.173, and the guidelines of MPEP § 1453 37 CFR 1.121 does not apply to amendments in reissue. Accordingly, clean copies of the amended claims are not required and *are not to be submitted*. Instead, amendments are to be presented via markings pursuant to 37 CFR 1.173(d) of this section, except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

   Pursuant to 37 CFR 1.173(g), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the reissue application. Amendments are *not to be made relative to previous amendments*. Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from *the patent* appear in brackets.

7. Where a paper is filed which requires payment of a fee (e.g., petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appeal brief, even though the brief relates to merged multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding.

8. Upon return of the present merged proceeding to the examiner, the examiner will review the files to insure that each file contains identical citations of prior patents and printed publications, and the examiner will cite such documents as are necessary as part of the next action in order to place the files in that condition.

9. If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be concluded by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 CFR 1.570. See MPEP 2285.

10. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the reissue application will be held abandoned, and the merger will be dissolved. With respect to the reexamination proceeding, the Director will proceed to issue a reexamination certificate under 37 CFR 1.570 in accordance with the last action of the Office, unless further action is clearly needed as a result of the difference in rules relating to reexamination and reissue proceedings. For any further action in the reexamination proceeding, any grounds of rejection 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 CFR 1.552(c).

11. If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 CFR 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue examination as to the reexamination proceedings. Such examination would be conducted as set forth in the immediately preceding paragraph.

CONCLUSION

1. Reissue application No. 10/626,486 and reexamination control No. 90/006,090. ARE MERGED into a single consolidated proceeding. A copy of this merger decision will be made of record in both of the files.

2. Pursuant to Part II of this decision, to the extent the claims differ between the two proceedings, a housekeeping amendment is required within ONE MONTH of this decision, placing the same amendments in all cases of the present merged proceeding. **If the claims are identical as to text, a patent owner statement to that effect is required within ONE MONTH of this decision.**

3. The reissue and reexamination files are being forwarded to the examiner via the Director of Technology Center 3700. Upon receipt of same, the examiner should not issue an Office action for the present merged proceeding of the reissue and reexamination proceedings until after the earlier of (a) the submission of the housekeeping amendment to place the same amendments in both cases or a statement that the claims are identical as to text, or (b) the expiration of the ONE MONTH period (from the mailing of this decision) set in part 2 of the "Conclusion."

4. All further examination in the merged proceeding should be conducted in accordance with Part III of this decision.

5. Telephone inquiries related to this decision should be directed to Anton W. Fetting, Senior Legal Advisor, at (571) 272-7717.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

May 20, 2005
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APR 25 2002

UNITED STATES PATENT & TRADEMARK OFFICE

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

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TC 3000

Reexamination Control No. 90/004,947 -- Paper No. 37
Reexamination Control No. 90/005,211 -- Paper No. 37
Reexamination Control No. 90/006,095 -- Paper No. 8-37

FOR PATENT OWNER:

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DECISION ON REEXAMINATION MERGER
37 CFR 1.565(c)

Reexam Control Nos. 90/004,947, 90/005,211 and 90/006,095

FOR REQUESTER:

Kenyon & Kenyon
One Broadway
New York, NY 10004

NOTICE OF CONSOLIDATION OF REEXAMINATION PROCEEDINGS

Background

1. U.S. Letters Patent No. 4,550,540 issued on November 5, 1985.

2. A first request for reexamination of U.S. Letters Patent No. 4,550,540 was filed by a third party, Kenyon & Kenyon, on March 24, 1998, and was assigned Reexamination Control No. 90/004,947.

3. On November 30, 1998, a second request for reexamination of U.S. Letters Patent No. 4,550,540 was filed by a third party requester, Kenyon & Kenyon, and was assigned Reexamination Control No. 90/005,211.

4. On August 24, 2001, a third request for reexamination of U.S. Letters Patent No. 4,550,540 was filed by a third party, Kenyon & Kenyon, and was assigned Reexamination Control No. 90/006,095.

5. Reexamination was ordered in Reexamination Control No. 90/004,947 on May 14, 1998; in Reexamination Control No. 90/005,211 on February 10, 1999; and in Reexamination Control No. 90/006,095 on November 20, 2001.

6. Reexamination Control Nos. 90/004,947 and 90/005,211 were merged on June 2, 1999.

7. No Patent Owner's Statement has been filed in Reexamination Control No. 90/006,095.

Discussion

Under 37 CFR 1.565(c):

> If reexamination is ordered while a prior reexamination proceeding is pending, the Reexamination proceedings will be consolidated and result in the issuance of a single Certificate under § 1.570.

As noted in the "Background", reexamination has been ordered in all reexamination proceedings. Accordingly, merging of the three reexamination proceedings is mandated by 37 CFR 1.565(c).

Decision

Under the provisions of 37 CFR 1.565(c), reexamination proceedings designated as Reexamination Control Nos. 90/004,947, 90/005,211 and 90/006,095 are merged for consolidated proceedings. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

I. Requirements for Same Amendments in All Files

Patent owner must maintain the same claims and the same description/specification in both files. Since the patent owner has not filed a patent owner's statement, and the submission of the required "housekeeping" amendment prior to a first Office action does not invoke the provisions of 37 CFR 1.535, prosecution will proceed *ex parte*. No reply or other submission will be considered in the merged reexamination proceeding filed by the third party requester.

It is noted that a request to change correspondence address has been filed by the representative of the patent owner in Reexamination Control No. 90/ 006,095 on October 9, 2001. In order to maintain consistent addresses for the patent owner, it is required that a request to change correspondence address be filed in Reexamination Control Nos. 90/004,947 and 90/005,211.

II. Conduct of Merged Proceeding

All papers mailed by the Office will take the form of a single action, which applies to both reexamination proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for both files and will be physically entered in each separate reexamination file. Any papers filed by the patent owner must consist of a single response addressed to all reexamination files, filed in triplicate, each bearing an original signature, for entry in all files. Each file will be maintained as separate complete files. All papers filed by the patent owner must be served upon the above-identified third party requester and such requester will be sent copies of all papers mailed by the Office during these merged proceedings.

Conclusion

Reexamination Control Nos. 90/004,947, 90/005,211 and 90/006,095 are hereby merged and an Office action will be issued by the examiner for *ex parte* prosecution of the merged proceeding.

Kenneth J. Dorner
Special Programs Examiner
Technology Center 3600
(703) 308-0866

Concur:
Anthony Knight
Acting Director
Technology Center 3600

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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 10-24-01

Allen R. MacDonald, 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
90/006,099	08/28/2001	6027774	011365	2782

7590 09/24/2003

Max Shaftal
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/24/2003 19

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

90006099.092203

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CST
Paper Number 19

In re Fine et al Reexam No. 90/006,099 Filed: August 28, 2001 For: PHOTO DISPLAY GLOBE WITH LIQUID FILLED SHELL	:	DECISION ON PETITION

This is a decision on the petition filed on September 22, 2003 requesting that the shortened statutory period for reply set forth in the Office communication mailed on July 31, 2003 be reset.

The petition is **GRANTED**.

Petitioner has provided a statement that the Office communication in question was received at the correspondence address of record on August 27, 2003. A copy of the Office action having the date of receipt of the Office action and a copy of the envelope which contained the Office action showing the postmark date were also provided. A substantial portion of the set reply period had elapsed on the date of receipt.

Accordingly, the shortened statutory period that was originally set forth in the Office communication originally mailed on July 31, 2003 is hereby reset to run TWO months FROM THE RECEIPT DATE OF August 27, 2003.

Christine Skane Tierney
Special Program Examiner
Technology Center 1700
703-308-2526

PATZIK, FRANK & SAMOTNY LTD
150 South Wacker Drive
Suite 900
Chicago, IL 60606

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,099	08/28/2001	6027774	011365	2782

7590 06/18/2004

Max Shaftal
Patzik, Frank & Samotny Ltd.
150 South Wacker Drive
Suite 900
Chicago, IL 60606

EXAMINER

ART UNIT	PAPER NUMBER
	25

DATE MAILED: 06/18/2004

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

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CST

Paper No. 25

Max Shaftal Patzik, Frank & Samotny Ltd. 150 South Wacker Drive Suite 900 Chicago, IL 60606	:	(for Patent Owner)
In re Fine et al Reexamination Proceeding Control No. 90/006,099 Filed: August 28, 2001 For: U.S. Patent 6,027,774	:	**DECISION ON PETITION**

This is a decision on the PETITION FROM REFUSAL TO ENTER AMENDMENT UNDER 37 CFR 1.127, received February 6, 2004 (certificate of facsimile February 2, 2004). The petitioner requests entry and consideration of the Amendment and Supplemental Declaration of Neil Fine submitted October 27, 2003

DECISION

A review of the record indicates that the request has merit. On October 27, 2003 (certificate of mailing), patent owner submitted an amendment after final rejection, together with a Supplemental Declaration of Neil Fine. In this amendment, patent owner added the limitation that the plug operatively associated with said drain port be removable (claims 1, 21 and 25). On January 7, 2004, an Advisory Action was mailed in which the examiner indicated that the proposed amendment would not be entered because it raised new issues that would require further consideration and/or search, and that the proposed amendment did not deem to place the proceeding in better form for appeal by materially reducing or simplifying the issues on appeal. The examiner also went on to explain that the references relied upon in the final rejection did teach a removable plug.

As the patent owner has argued that the language present in claims 1, 21 and 25 prior to final rejection would have led one to interpret the plug as being removable, and as

the examiner indicated that the references relied upon in the final rejection did teach a removable plug, this reexamination proceeding shall be returned to the examiner for prompt entry and consideration of the Amendment and Communication of October 27, 2003. The Supplemental Declaration of Neil Fine will be considered as well.

The petition is **GRANTED**.

JMStone

Jacqueline M. Stone
Director, Technology Center 1700
High Polymer Chemistry, Plastics,
Stock Materials and Compositions

UNITED STATES PATENT AND TRADEMARK OFFICE

#8

COMMISSIONER FOR PATENTS
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Paper No. 8

James W. Badie
Stoll, Miskin, Hofman &Badie
The Empire State Building
350 Fifth Avenue, Suite 6110
New York, NY 10118

(for patent owner)

MAILED

SEP 04 2002

TECHNOLOGY CENTER 2800
SPECIAL PROGRAM CENTER

John James McGlew
McGlew and Tuttle
Scarborough Station
Scarborough, NY 10510-0827

(for requester)

In re Cin Chen Chang
Reexamination Proceeding
Control Number 90/006,106
Filed: September 7, 2001
For: U.S. Patent No. 5,645,342

DECISION ON PETITION FOR EXTENSION OF TIME

This is a decision on the petition filed February 11, 2002. The petition is for an extension of time of two months within which to file a patent owner's statement.

The petition is **dismissed** as moot.

An inspection of the written record indicates that patent owner withdrew the petition for extension of time in a communication filed February 21, 2002. Accordingly, the petition is dismissed as moot.

The petition was accompanied by a check in the amount of $200 to cover the fee for a two month extension under 37 C.F.R § 1.136(a). Because no fee is required for an extension of time under 37 C.F.R. § 1.550(c) in a reexamination proceeding, the $200 fee will be refunded in due course.

The reexamination file is being forwarded to the Technology Center 2800 Technical Support Staff for refunding the $200 fee. From there, the file will be forwarded to the examiner for further 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

Janice A. Falcone, 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
90/006,112	09/20/2001	5870224	35079.02200	7772

21171 7590 01/06/2003
STAAS & HALSEY LLP
700 11TH STREET, NW
SUITE 500
WASHINGTON, DC 20001

MAHONEY
EXAMINER

2851
ART UNIT | PAPER NUMBER

DATE MAILED: 01/06/2003 #14

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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WASHINGTON, D C 20231
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Paper No. 14

STAAS & HALSEY, LLP
700 11th Street, N.W., Suite 500
Washington, D.C. 20001

(for patent owner)

MAILED

JAN 06 2003

OFFICE OF THE SPECIAL PROGRAMS EXAMINER

Lawrence T. Kass
Milbank, Tweed, Hadley & McCloy, LLP
One Chase Manhattan Plaza
New York, NY 10005-1413

(for requester)

In re Saitoh *et al.*
Reexamination Proceeding
Control Number 90/006,112
Filed: September 20, 2001
For: U.S. Patent No. 5,870,224

DECISION ON REQUEST FOR EXTENSION OF TIME

This is a decision on the request for extension of time under 37 C.F.R. § 1.550(c) filed December 18, 2002. The request is for an extension of time of one (1) month within which to file a response to the Office action mailed November 6, 2002.

Pursuant to 37 C.F.R. § 1.550(c):

> (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 a request effect any extension. See Section 1.304(a) for extensions of time for filing a Notice of Appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.

The request sets forth sufficient cause. Accordingly, the request for an extension of time is granted to extend one (1) month from January 6, 2003.

The request is GRANTED.

The period for filing a response is hereby extended to run three (3) months from November 6, 2002, the date the Office action was mailed, and expires February 6, 2002. No further extension

of time is expected to be granted.

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

for Howard Goldberg, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

90006112 .122102

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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
90/006,112	09/20/2001	5870224	35079.02200	7772

21171 7590 01/06/2003
STAAS & HALSEY LLP
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SUITE 500
WASHINGTON, DC 20001

MAHONEY
EXAMINER

2851
ART UNIT | PAPER NUMBER

DATE MAILED: 01/06/2003 #14

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

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Paper No. 14

STAAS & HALSEY, LLP
700 11th Street, N.W., Suite 500
Washington, D.C. 20001

(for patent owner)

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JAN 06 2003

OFFICE OF THE SPECIAL PROGRAMS EXAMINER

Lawrence T. Kass
Milbank, Tweed, Hadley & McCloy, LLP
One Chase Manhattan Plaza
New York, NY 10005-1413

(for requester)

In re Saitoh *et al.*
Reexamination Proceeding
Control Number 90/006,112
Filed: September 20, 2001
For: U.S. Patent No. 5,870,224

DECISION ON REQUEST FOR EXTENSION OF TIME

This is a decision on the request for extension of time under 37 C.F.R. § 1.550(c) filed December 18, 2002. The request is for an extension of time of one (1) month within which to file a response to the Office action mailed November 6, 2002.

Pursuant to 37 C.F.R. § 1.550(c):

> (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 a request effect any extension. See Section 1.304(a) for extensions of time for filing a Notice of Appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.

The request sets forth sufficient cause. Accordingly, the request for an extension of time is granted to extend one (1) month from January 6, 2003.

The request is GRANTED.

The period for filing a response is hereby extended to run three (3) months from November 6, 2002, the date the Office action was mailed, and expires February 6, 2002. No further extension

of time is expected to be granted.

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

for Howard Goldberg, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

90006112 .122102

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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
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#14

JUN 17 2002

George R. Repper
Rothwell Figg Ernst & Manbeck
555 Thirteenth Street, N.W., Suite 701 East
Washington DC 20004

(For Patent Owner)

Nate F. Scarpelli, Esq.
Marshall O'Toole Gerstein Murray & Borun
6300 Sears Tower
233 South Wacker Drive
Chicago IL 60606-6402

(For Requester)

James A. Flight, Esq.
Marshall, Gerstein & Borun
6300 Sears Tower
233 South Wacker Drive
Chicago IL 60606-6402

(For Requester)

Reexam Control No.: 90/005,747 Filed: June 21, 2000 For: U.S. Patent No. 5,207,675	:	DECISION MERGING REEXAMINATION PROCEEDINGS
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	:	

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

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mat

Paper No. 23

David G. Duckworth
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4590 MacArthur Blvd.
Suite 500
Newport Beach, CA 92660

(Patent Owner)

David H. Bluestone
BRINKS HOFER GILSON & LIONE
P.O. Box 10395
Chicago, IL 60610

(Requester)

MAILED
APR 18 2005
REEXAM UNIT

In re Stamega
Reexamination Proceeding
Control No. 90/006,116
Filed: September 24, 2001
For: U.S. Patent No. 5,797,088

: DECISION
: DISMISSING
: PETITION

The above-captioned reexamination proceeding is before the Office of Patent Legal Administration for a decision on the patent owner's February 25, 2004 petition to continue the pending reexamination or initiate a second reexamination of U.S. Patent No. 5,797,088.

The petition is dismissed as moot for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 5,797,088 issued on August 18, 1998.

2. A request for reexamination of the '088 patent was filed by a third party requester on September 24, 2001. The resulting proceeding was assigned control No. 90/006,116.

3. Reexamination was ordered for the '6116 reexamination proceeding on November 19, 2001.

4. A non-final Office action was mailed on May 20, 2002.

5. A response from the patent owner to the non-final Office action was received on June 24, 2002.

6. Notifications of the existence of litigation proceedings as to the '088 patent were filed (pursuant to MPEP 2282) on July 8, 2002, on December 17, 2002, and on January 22, 2003.

7. A second non-final Office action was mailed on February 10, 2003.

8. Further notifications pursuant to MPEP 2282 were filed on March 6, 2003 and on April 11, 2003.

9. A response from the patent owner to the second non-final Office action was received on May 12, 2003.

10. The patent owner filed the present petition on February 25, 2004.

11. A further notification pursuant to MPEP 2282 was filed on December 2, 2004.

DECISION ON PETITION

The petition is dismissed for the reasons set forth below.

The petition requests that the present reexamination continue, or, in the alternative, that an additional reexamination proceeding be initiated if there is a substantial question of patentability remaining which should be resolved.

The petition is not ripe for a decision on the arguments/issues raised in the petition. The petition states that the Solicitor Office has indicated that it may terminate the reexamination proceedings as a result of a non-precedential opinion issued from the U.S. District Court, Northern District of Illinois, holding the '088 patent invalid, unenforceable and not infringed. There is, however, nothing in the present record to indicate that the reexamination prosecution has been suspended or terminated. The record shows that the reexamination proceeding remains pending in the Office, after a patent owner response to the February 10, 2003 non-final Office. As to any statement that may have been made by the Solicitor Office (as alleged in the petition, it is to be noted that, pursuant to 37 CFR 1.2:

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

Should the reexamination prosecution ultimately be terminated, then only at that point in time would the Office's action would be ripe for challenge of the nature of the present petition.

As to the request that a separate reexamination be initiated, the Office has made no determination for which a Director ordered reexamination would be appropriate under 37 CFR 1.520. At present, a Director ordered reexamination proceeding would be cumulative to the ongoing reexamination proceeding. Should the reexamination prosecution ultimately be terminated, the issue may be raised again.

Petitioner should, however, be aware that MPEP 2239 provides:

> "The Director of the USPTO will not normally consider requests to order reexamination at the Director's initiative received from members of the public."

And further:

> "The number of such Director-initiated orders is expected to be very small."

Initiating a reexamination proceeding at the behest of a party whose proceeding has been terminated would not appear to be one of the rare instances that is contemplated, especially if the patent is indeed found to be controlled by the District Court holding of the '088 patent as invalid, unenforceable and not infringed.

In summary, no action has been taken by the Office to make petitioner's requested relief timely. The petition is not ripe for a decision, and the third party requester petition is accordingly dismissed.

RETURN OF THE PROCEEDING TO THE TECHNOLOGY CENTER

The reexamination proceeding is being returned to the Technology Center for further action in the proceeding. Any request for prompt action on this matter [1] would be appropriately addressed to the Technology Center as a petition under 37 CFR 1.181 for supervisory intervention to provide such prompt action.

CONCLUSION

1. The third party requester request for continuing the '6116 reexamination, filed February 25, 2003, is dismissed.
2. The reexamination proceeding is being forwarded via the Group Director of the Technology Center for action in the proceeding not inconsistent with this decision.
3. Telephone inquiries related to this decision should be directed to Anton W. Fetting, Senior Legal Advisor, at (571) 272-7717.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

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April 16, 2005

[1] The record indicates that the last response from the patent owner was received by the Office twenty three months ago.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
90/006,118	09/28/2001	6196681		8310

90/006,254 7590 09/18/2002

Charles Heiken, Esq.
Fish and Richardson, PC
225 Franklin Street
Boston, MA 02110-2804

EXAMINER
Mai

ART UNIT	PAPER NUMBER
2873	7

DATE MAILED: 09/18/2002

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

09/18/2002

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 7

Charles Heiken, Esq. Fish & Richardson, PC 225 Franklin Street Boston, MA 02110-2804	:	(for patent owner)
Michael A. Cantor, Esq. Cantor Colburn LLP 55 Griffin Road South Bloomfield, CT 06002	:	(for requester)
In re Canavan Reexamination Proceeding Control Number 90/006,118 Filed: September 28, 2001 For: U.S. Patent No. 6,196,681 Title: Eye Covering	:	
In re Canavan Reexamination Proceeding Control Number 90/006,254 Filed: March 26, 2002 For: U.S. Patent No. 6,196,681 Title: Eye Covering	:	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. 6,196,681 issued on March 6, 2001.

2. A first request for reexamination, Reexamination Control No. 90/006,118, was filed by a third party requester on September 28, 2001.

3. Reexamination was ordered in the '118 reexamination proceeding on December 11, 2001.

4. A second request for reexamination, Reexamination Control No. 90/006,254, was filed by the third party requester on March 26, 2002.

5. Reexamination was ordered in the '254 reexamination proceeding on June 7, 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* 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 '118 and '254 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. 90/006,118 and 90/006,254 are merged. The reexamination files are being forwarded to the examiner for issuing a first Office action.

Janice A. Falcone

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

90006118.051802

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Michael A. Cantor, Esq.
CANTOR COLBURN LLP
55 Griffin Road South
Bloomfield, CT 06002.

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/006,254*.

PATENT NO. *6,196,681* .

ART UNIT *2873* .

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)).

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Paper No. 15

Jeffrey I. Kaplan Kaplan and Gilman 900 Route 9 North Woodbridge, New Jersey 07095	)	**FOR PATENT OWNER**
Mr. Walter J. Madden 341 S. Keel Way Port Ludlow, Washington 98365	)	**FOR THIRD PARTY REQUESTOR**
In re Reexamination of: U.S. Patent No. 5,792,659 Reexamination Control No. 90/006,119 For: TERMINAL EMULATOR ENHANCER WITH LOCAL CONFIGURABILITY	)	**DECISION ON PETITION UNDER 37 C.F.R. §1.8(b) TO ACCEPT PAPERS AS TIMELY FILED**

This is a decision on the petition filed by facsimile, January 15, 2003, under 37 C.F.R. § 1.8(b) to accept papers as timely filed and thereby prevent premature termination of this reexamination proceeding. This petition was originally filed January 8, 2003 by US mail but has as yet not been matched to the file.

The petition is **GRANTED**.

BACKGROUND

A Notice of Defective Paper in Ex Parte Reexamination was mailed on November 29, 2002. This paper noted two deficiencies in the Amendment filed November 13, 2002: (1) failure to provide proof of service on the third party and (2) non-compliance with 37 C.F.R. §1.530(d)-(j) which govern proper amendment procedure in ex parte reexamination. Patent owner was given one month to rectify these shortcomings.

As of January 3, 2003 no response had been received. The undersigned called Patent Owner's representative to inquire as to the status and was informed that a response had been submitted on December 3, 2002 During the course of the conversation it became clear that the response filed on December 3 did not resolve all outstanding issues.

DECISION

37 C.F.R. § 1.8(b) states:

> (b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:
>
> (1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence,
>
> (2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate, and
>
> (3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

In support of the petition, Petitioner provides (1) a copy of an amendment filed in response to the Notice of mail date November 29, 2002 with a certificate of mailing and a certificate of service upon Walter J. Madden (for third party requester) each dated December 3, 2002 signed by Michael R. Philips; (2) a statement by Michael R. Philips attesting on a personal knowledge that the documents were mailed on December 3, 2002; (3) a request for correction of the inventor's name; (4) a supplemental amendment originally filed January 8, 2003; (5) a statement that the third party requestor is now at a different correspondence address; and (6) a certificate of service indicating that the supplemental amendment was was served upon third party requester on January 3, 2003. It is not clear from the documents whether the petition accompanying the supplemental amendment was served on the third party. Therefore, a copy of the petition is included in with the copy of this decision mailed to the third party requestor.

As a result, Petitioner has established that the December 3, 2002 response was timely filed. This response was not completely responsive as it failed to correct the deficiencies of form. However, had the response was submitted promptly and had it been matched to the file in the ordinary course, the undersigned would have called Patent owner's representatives and afforded them the opportunity to correct the deficiency. The supplemental amendment filed with the petition has been served on the third party requestor and complies with 37 C.F.R. §1.530(d)-(j).

Accordingly, Patent Owner is deemed to have responded in a timely manner to the Notice of November 29, 2002. The response of December 3 will be placed in the file but not entered. The response dated January 8 will be entered in the file and the file will then be forwarded to the Examiner of record for appropriate action.

A courtesy copy of this decision is being provided to Walter J. Madden at the address listed below. This courtesy **WILL NOT BE EXTENDED** in any further communication. Practitioner is required to inform the Office of any change of correspondence address by filing a specific paper in the reexamination proceeding.

Pinchus M. Laufer
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security
(703) 306-4160

cc: Mr. Walter J. Madden
10560 Seabeck Hwy., NW
Seabeck, Washington 98365

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APR 17 2005

J. David Nelson & Denver C. Snuffer
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Michael F. Krieger
Kirton & McConkie
1800 Eagle Gate Tower (For Requester)
60 East South Temple
P.O. Box 45120
Salt Lake City, UT 84145-0120

In re James Hoyt Clark
Reexamination Proceeding :
Control No. 90/006,126 :
Filed: October 9, 2001 :
For: U.S. Patent No. 6,142,927 :
: DECISION, *SUA SPONTE*,
: MERGING REEXAMINATION
: PROCEEDINGS

In re James Hoyt Clark
Reexamination Proceeding :
Control No. 90/007,076 :
Filed: June 14, 2004 :
For: U.S. Patent No. 6,142,927 :

The above noted *ex parte* reexamination proceedings are before the Director of Technology Center 3700 for consideration of merger of the proceedings under 37 CFR 1.565(c), in accordance with the practice set forth at MPEP § 2283.

Merger of Copending Reexamination Proceedings

I. Merger of Proceedings

As required by the practice pursuant to MPEP § 2283, and under the authority of 37 CFR 1.565(c), the 90/006,126 and 90/007,076 reexamination proceedings are hereby MERGED. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in Both Proceedings

Owner is required to maintain the same claims and specification in both files. The contents of each file will be hereafter be maintained identically, and all actions promulgated and papers filed subsequent to this Decision will bear the same paper number.

III. Housekeeping Amendment

No amendments to the specification, claims or drawings have been filed in either proceeding. Therefore, no housekeeping amendment is necessary to make the specification, claims and drawings identical in each proceeding. Accordingly, no housekeeping amendment is required.

IV. Conduct of Merged Proceeding

All actions 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 and Owner will each receive one copy of the body of the action, and a copy of the cover sheet (*e.g.* Form PTO-466). 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 "marked-up" claims and paragraphs in which specification amendments are requested must be filed, together with material satisfying the requirements of 37 CFR 1.530(e).** All words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets. New drawing figures must be labeled "New", while amended drawing figures must be labeled "Amended". Owner is also reminded that all requests for an extension of time in this proceeding are governed by 37 CFR 1.550(c). and that effective November 22, 2004, any request for an extension of time pursuant to 37 CFR 1.550(c) must include the petition fee set forth in 37 CFR 1.17(g). That fee is currently $ 200.00,. with no reduction for small entity status

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. The examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and as part of the next action, will cite such documents as are necessary in order to place the files in that condition.

Upon mailing of this decision, the examiner will be notified to begin preparing the next action in this proceeding.

Richard A Bertsch

E. R. Kazenske, Director
Technology Center 3700

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.
90/006,126 90/007,076	10/09/2001	6142927	8603.57	3245

7590 07/21/2005

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EXAMINER
GILBERT, S.

ART UNIT	PAPER NUMBER
3736	10

DATE MAILED: 07/21/2005 AC

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Reexam Control No.: 90/006,126 Filed: October 9, 2001 For: U.S. Patent No. 6,142,927 Reexam Control No.: 90/007,076 Filed: June 14, 2004 For: U.S. Patent No. 6,142,927	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. 90/006,126 was ordered in a decision mailed December 13, 2001. Prosecution proceeded through the mailing of an Office action on July 15, 2002.

Reexamination in application Control No. 90/007,076 was ordered in a decision mailed July 14, 2004. A Patent Owner's statement was received on September 14, 2004. No Requester's Reply to Patent Owner's statement was filed.

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, abstract, claims and claim numbering in both files. In view of the fact that both reexamination applications contain identical specifications, drawings, and claims, no amendment is required at this time.

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. See 37 CFR 1.565 (d).

Conclusion

Reexamination Control Nos. 90/006,126 and 90/007,076 are hereby merged. At this time there is no further action required by Patent Owner. These proceedings will be forwarded to the Examiner for an action on the merits.

Frederick R. Schmidt, Director
Technology Center 3700

ak/7/21/05

UNITED STATES PATENT AND TRADEMARK OFFICE

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DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
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#14

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	:	DECISION MERGING REEXAMINATION PROCEEDINGS
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	:	

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

JMacalisto
3/7/02

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.
90/006,130	10/16/2001	5335160	04058.0003U1	5306

90/006,719
90/005,715

7590 03/07/2002

Thomas W. Cole, Esquire
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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.

6/Dec. Mtg.
Reexam.
Proceedings

90006130 . 030702

PTO-90C (Rev. 07-01)

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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
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Paper No. 15/15/6

Thomas W. Cole
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(For Patent Owner)

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(For Third Party Requester)

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.

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

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

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

Thomas W Cole Esq
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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.

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)

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127 Peachtree Street, NE
Atlanta, Georgia 30303-1811

(for requester)

MAILED

OCT 21 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

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 DEPARTMENT OF COMMERCE
Patent and Trademark Office

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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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Paper No. 36

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Lawrence D. Maxwell (For Third Party Requester)
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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 <u>will be merged</u> 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 PATENT AND TRADEMARK OFFICE

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MAR 14 2002

Paper No. 6

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	

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

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REEXAM UNIT

Paper No.9

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(For Requester)

In re Niemiro, et al.
Reexamination Proceeding
Control No. 90/006,137
Filed: October 31, 2001
For: U.S. Patent No. 5,868,071

DECISION GRANTING PETITION

This is a decision on the April 8, 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 $1300.00 pursuant to 37 C.F.R. § 1.17(m) for the petition under 37 C.F.R. § 1.137(b) has been received.

The petition for revival under 37 C.F.R. § 1.137(b) based upon unintentional delay is **granted** for the reasons indicated below.

DECISION

A grantable petition under 37 C.F.R. § 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed;

(2) the petition fee required by 37 C.F.R. § 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional.

Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 C.F.R. § 1.137(b) was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D).

The petition is accompanied by the petition fee. It should be noted that 37 C.F.R. § 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional. The statement contained in the present petition varies from the language required by 37 C.F.R. § 1.137(b)(3); however, the statement contained in the present petition is being construed as the statement required by 37 C.F.R. § 1.137(b)(3). Petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

The required reply to the outstanding nonfinal Office action of November 4, 2002, has been received.

In view of the above, the petition for the entry of late papers is sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

The petition is **granted**.

CONCLUSION

1. The petition is **granted**.

2. The reexamination file will be forwarded to Technology Center 2800 for consideration of the response to the nonfinal Office action of November 4, 2002.

3. Further inquiries with regard to this reexamination proceeding should be directed to the examiner, Leslie Evanisko, of Group Art Unit 2854.

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

April 14, 2003

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January 15, 2002 Paper No. 8

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(For Patent Owner)

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(For Requester)

In Axel E. Jungk
Reexamination Proceeding
Control No. 90/006,138
Filed: November 2, 2001
For: U.S. Patent No. 4,946,505

: PETITION TO DENY
: SECOND REQUEST FOR
: REEXAMINATION DISMISSED

This is a decision on the January 3, 2002, petition filed by the patent owner under 37 CFR § 1.182. Patent owner, *inter alia*, requests the Commissioner to deny a second request for reexamination of the '505 patent filed during the pendency of a first request for reexamination of the '505 patent which first request was filed by the same third party requester who filed the second request for reexamination. The petition is before the Office of Patent Legal Administration.

For the reasons set forth below, the petition is dismissed.

BACKGROUND

1. U.S. Patent No. 4,946,505 issued August 7, 1990.

2. On February 13, 2001, a first request for reexamination of the '505 patent was filed by a third party requester. The first reexamination was assigned Control No. 90/005,925. The request was based on the Kneidinger Austrian patent document and four other references.

3. On March 16, 2001, 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 August 8, 2001, the examiner issued an Office action rejecting, *inter alia*, all of the patent claims over the Kneidinger patent submitted with the first request for reexamination under 35 USC 103 alone, or in combination with other patents. All of the patent claims were also rejected over the patent to Beyn under 35 USC 103 alone, or in combination with other patents.

5. On October 9, 2001, patent owner filed a response to the Office action in the first reexamination. Patent owner (1) argued that the Kneidinger reference is not prior art to the '505 patent, and (2) argued the technical merits of the § 103 rejections over Kneidinger and Beyn.

6. On November 2, 2001, a second request for reexamination of the '505 patent was filed by the same third party requester. The second request for reexamination was assigned Control No. 90/006,138. The second reexamination is based on the same prior art as the first reexamination with additional evidence that the Kneidinger reference is prior art to the '505 patent. The second request includes a declaration by Peter Israiloff submitted to explain certain aspects of the law deemed pertinent to the issue whether the Kneidinger reference is prior art to the '505 patent.

7. On December 27, 2001, the examiner issued a Notice of Intent to Issue a Reexamination Certificate (NIRC) in the first reexamination. The examiner noted that in the response to the Office action patent owner argued that the Kneidinger reference is not prior art to the '505 patent. The examiner states that the Beyn reference would appear to be the closest prior art, but held all of the patent claims to be patentable over the prior art.

8. On January 3, 2002, the patent owner filed the present petition in the second reexamination. Petitioner requests the following relief:

   a. That the second request for reexamination be denied, 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 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.

   b. That the second request for reexamination be denied on the ground that the requester is harassing the patent owner by filing multiple requests for reexamination merely for reiterating its position based on prior art already of record in an earlier proceeding affecting the same patent, (i.e., the first reexamination). Patent owner (footnote 3) does not agree with MPEP 2240 which provides that it is appropriate to grant a second request for reexamination when the only art relied upon has been cited in an earlier (but copending) reexamination.

DECISION

I. Waiver of rule to 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.

II. 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 Kneidinger reference which the examiner withdrew from consideration in the first reexamination pursuant to arguments raised by patent owner that the Kneidinger reference is not prior art to the '505 patent. In addition to the Kneidinger reference, the second request submits additional declaration evidence relating to the issue as to whether or not the Kneidinger reference is prior art to the '505 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. 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.

With regard to patent owner's disagreement with MPEP 2240 which provides that it is appropriate to grant a second request for reexamination when the only art relied upon has been cited in an earlier (but copending) reexamination, the court in *Heinl v Godici*, 143 F.Supp.2d 593 (E.D.Va. 2001) stated in footnote 18:

> As noted, MPEP § 2240 provides that a second reexamination request can be ordered if that request includes prior art that raises a substantial new question of patentability being considered in a *pending* reexamination. The justification for this regulation is clear. The PTO should grant a request for a second or subsequent reexamination because no determination concerning the proffered prior art has been made in the first reexamination, and hence this prior art continues to raise a substantial new question of patentability (original emphasis).

III. 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. Patent owner argues that a substantial new question of patentability is not raised in the second reexamination by the same references already of record in examination of the same patent in an earlier proceeding. Patent owner notes (footnote 1) that MPEP 2242 defines an "earlier proceeding" as being a "concluded proceeding." In this regard patent owner first argues that the first reexamination is already concluded as the examiner has issued a NIRC in the first reexamination. Patent owner further argues that the limitation of an "earlier proceeding" to a concluded proceeding is unreasonable as it permits a requester to reargue the same prior art as many times as it wants to in overlapping proceedings. Patent owner contends that such an interpretation plainly contradicts the statutory requirement that each request for reexamination must present a substantial new question of patentability.

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 shows 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 (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 Kneidinger reference.

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 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 in the NIRC during the first 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 Kneidinger reference has not been finally resolved in the first reexamination. In the first Office action the examiner rejected the claims over the Kneidinger reference alone, and further in combination with other references. The patent owner filed a response to the Office action in which patent owner (1) argued that the Kneidinger reference is not prior art to the '505 patent, and (2) argued the technical merits of the § 103 rejections over Kneidinger and Beyn. Thereafter the examiner issued a NIRC in the first reexamination. In the statement of reasons for patentability the examiner noted that in the response to the Office action patent owner argued that the Kneidinger reference is not prior art to the '505 patent. The examiner states that the Beyn reference would appear to be the closest prior art, but held all of the patent claims to be patentable over the prior art (emphasis added). A fair construction of the examiner's statement is that he did not determine in the first reexamination whether the Kneidinger reference is prior art to the '505 patent because there was insufficient evidence to do so. Thus it is appropriate that this question be addressed in the second reexamination in view of the additional evidence directed to this issue. Compare *Heinl v Godici*, supra at 603 and further at footnote 18.

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.

SUMMARY

1. The provisions of § 1.530(a) are waived under § 1.183, and the merits of the petition filed by the patent owner on January 3, 2002, challenging the legality of the second reexamination has been considered.

2. Patent owner has failed to show that the second reexamination was filed for purposes of harassment.

3. 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.

4. The petition is dismissed.

Telephone inquiries related to this decision should be directed to Gerald A. Dost, Senior Legal Advisor, at 703-305-8610.

Gerald A. Dost

Gerald A. Dost
Senior Legal Advisor
Office of Patent Legal Administration

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
90/005,925	02/13/2001	4946505	111583-00601	6428

23446 7590 05/13/2002

MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
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.

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PTO-90C (Rev. 07-01)

UNITED STATES PATENT and TRADEMARK OFFICE
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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

90006138.052002

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
90/005,925 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
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EXAMINER

ART UNIT	PAPER NUMBER
	28

DATE MAILED: 03/27/2003

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
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Paper No. 27

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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 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.

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.

Jacqueline M. Stone
Director, Technology Center 1700
High Polymer Chemistry, Plastics,
Stock Materials and Compositions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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January 15, 2002 Paper No. 8

George Wheeler
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500 West Madison Street, 34th Floor
Chicago, IL 60661

(For Patent Owner)

Charles R. Wolfe, Jr.
Blank, Rome, Comisky & McCauley, LLP
The Farragut Bldg., Suite 1000
900 17th St., N.W.
Washington, D.C. 20006

(For Requester)

In Axel E. Jungk
Reexamination Proceeding
Control No. 90/006,138
Filed: November 2, 2001
For: U.S. Patent No. 4,946,505

: PETITION TO DENY
: SECOND REQUEST FOR
: REEXAMINATION DISMISSED

This is a decision on the January 3, 2002, petition filed by the patent owner under 37 CFR § 1.182. Patent owner, *inter alia*, requests the Commissioner to deny a second request for reexamination of the '505 patent filed during the pendency of a first request for reexamination of the '505 patent which first request was filed by the same third party requester who filed the second request for reexamination. The petition is before the Office of Patent Legal Administration.

For the reasons set forth below, the petition is dismissed.

BACKGROUND

1. U.S. Patent No. 4,946,505 issued August 7, 1990.

2. On February 13, 2001, a first request for reexamination of the '505 patent was filed by a third party requester. The first reexamination was assigned Control No. 90/005,925. The request was based on the Kneidinger Austrian patent document and four other references.

3. On March 16, 2001, 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 August 8, 2001, the examiner issued an Office action rejecting, *inter alia*, all of the patent claims over the Kneidinger patent submitted with the first request for reexamination under 35 USC 103 alone, or in combination with other patents. All of the patent claims were also rejected over the patent to Beyn under 35 USC 103 alone, or in combination with other patents.

5. On October 9, 2001, patent owner filed a response to the Office action in the first reexamination. Patent owner (1) argued that the Kneidinger reference is not prior art to the '505 patent, and (2) argued the technical merits of the § 103 rejections over Kneidinger and Beyn.

6. On November 2, 2001, a second request for reexamination of the '505 patent was filed by the same third party requester. The second request for reexamination was assigned Control No. 90/006,138. The second reexamination is based on the same prior art as the first reexamination with additional evidence that the Kneidinger reference is prior art to the '505 patent. The second request includes a declaration by Peter Israiloff submitted to explain certain aspects of the law deemed pertinent to the issue whether the Kneidinger reference is prior art to the '505 patent.

7. On December 27, 2001, the examiner issued a Notice of Intent to Issue a Reexamination Certificate (NIRC) in the first reexamination. The examiner noted that in the response to the Office action patent owner argued that the Kneidinger reference is not prior art to the '505 patent. The examiner states that the Beyn reference would appear to be the closest prior art, but held all of the patent claims to be patentable over the prior art.

8. On January 3, 2002, the patent owner filed the present petition in the second reexamination. Petitioner requests the following relief:

   a. That the second request for reexamination be denied, 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 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.

   b. That the second request for reexamination be denied on the ground that the requester is harassing the patent owner by filing multiple requests for reexamination merely for reiterating its position based on prior art already of record in an earlier proceeding affecting the same patent, (i.e., the first reexamination). Patent owner (footnote 3) does not agree with MPEP 2240 which provides that it is appropriate to grant a second request for reexamination when the only art relied upon has been cited in an earlier (but copending) reexamination.

DECISION

I. Waiver of rule to 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.

II. 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 Kneidinger reference which the examiner withdrew from consideration in the first reexamination pursuant to arguments raised by patent owner that the Kneidinger reference is not prior art to the '505 patent. In addition to the Kneidinger reference, the second request submits additional declaration evidence relating to the issue as to whether or not the Kneidinger reference is prior art to the '505 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. 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.

With regard to patent owner's disagreement with MPEP 2240 which provides that it is appropriate to grant a second request for reexamination when the only art relied upon has been cited in an earlier (but copending) reexamination, the court in *Heinl v Godici*, 143 F.Supp.2d 593 (E.D.Va. 2001) stated in footnote 18:

> As noted, MPEP § 2240 provides that a second reexamination request can be ordered if that request includes prior art that raises a substantial new question of patentability being considered in a *pending* reexamination. The justification for this regulation is clear. The PTO should grant a request for a second or subsequent reexamination because no determination concerning the proffered prior art has been made in the first reexamination, and hence this prior art continues to raise a substantial new question of patentability (original emphasis).

III. 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. Patent owner argues that a substantial new question of patentability is not raised in the second reexamination by the same references already of record in examination of the same patent in an earlier proceeding. Patent owner notes (footnote 1) that MPEP 2242 defines an "earlier proceeding" as being a "concluded proceeding." In this regard patent owner first argues that the first reexamination is already concluded as the examiner has issued a NIRC in the first reexamination. Patent owner further argues that the limitation of an "earlier proceeding" to a concluded proceeding is unreasonable as it permits a requester to reargue the same prior art as many times as it wants to in overlapping proceedings. Patent owner contends that such an interpretation plainly contradicts the statutory requirement that each request for reexamination must present a substantial new question of patentability.

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 shows 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 (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 Kneidinger reference.

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 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 in the NIRC during the first 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 Kneidinger reference has not been finally resolved in the first reexamination. In the first Office action the examiner rejected the claims over the Kneidinger reference alone, and further in combination with other references. The patent owner filed a response to the Office action in which patent owner (1) argued that the Kneidinger reference is not prior art to the '505 patent, and (2) argued the technical merits of the § 103 rejections over Kneidinger and Beyn. Thereafter the examiner issued a NIRC in the first reexamination. In the statement of reasons for patentability the examiner noted that in the response to the Office action patent owner argued that the Kneidinger reference is not prior art to the '505 patent. The examiner states that the Beyn reference would appear to be the closest prior art, but held all of the patent claims to be patentable over the prior art (emphasis added). A fair construction of the examiner's statement is that he did not determine in the first reexamination whether the Kneidinger reference is prior art to the '505 patent because there was insufficient evidence to do so. Thus it is appropriate that this question be addressed in the second reexamination in view of the additional evidence directed to this issue. Compare *Heinl v Godici*, supra at 603 and further at footnote 18.

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.

SUMMARY

1. The provisions of § 1.530(a) are waived under § 1.183, and the merits of the petition filed by the patent owner on January 3, 2002, challenging the legality of the second reexamination has been considered.

2. Patent owner has failed to show that the second reexamination was filed for purposes of harassment.

3. 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.

4. The petition is dismissed.

Telephone inquiries related to this decision should be directed to Gerald A. Dost, Senior Legal Advisor, at 703-305-8610.

Gerald A. Dost

Gerald A. Dost
Senior Legal Advisor
Office of Patent Legal Administration

C:\zJerry\90_6138 pat owner pet to deny no 2 reexam.wpd

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
90/005,925	02/13/2001	4946505	111583-00601	6428

23446 7590 05/13/2002

MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
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.

90005925 051302

PTO-90C (Rev. 07-01)

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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 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

90006138.052002

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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

GEORGE WHEELER
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500 WEST MADISION STREET, SUITE 3400
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EXAMINER

ART UNIT	PAPER NUMBER
	28

DATE MAILED: 03/27/2003

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Paper No. 27

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

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 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.

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.

Jacqueline M. Stone
Director, Technology Center 1700
High Polymer Chemistry, Plastics,
Stock Materials and Compositions

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MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD
SUITE 400
MCLEAN VA 22102

(For Patent Owner)

MAILED SEP 28 2007

In re Inagaki et al.	:
Reexamination Proceeding	: DECISION ON PETITION
Control No. 90/006,139	:
Filed: November 7, 2001	:
For: U.S. Patent No. 5,687,732	:

This is a decision on the petition filed on September 1, 2005 under 37 CFR 1.181 by which Owner requests that the finality of the office action mailed March 4, 2005 be withdrawn and that the amendment filed on September 1, 2005 be entered.

The petition under 37 CFR 1.181 is dismissed.

REVIEW OF FACTS

1. U.S. Patent No. 5,687,732 issued on November 18, 1997.
2. Patent Owner filed a request for reexamination on November 7, 2001.
3. An order granting the request for Ex Parte Reexamination was mailed on January 16, 2002.
4. A response to the order granting Reexamination was filed on February 20, 2002.
5. A non-final office action was mailed on May 1, 2002.
6. A response to the office action was filed on June 28, 2002.
7. A non-final office action was mailed November 5, 2002.
8. A response to the office action was filed on December 2, 2002.
9. A final office action was mailed January 23, 2003.
10. A response to the final was filed on March 24, 2003.
11. An advisory action was mailed June 23, 2003.
12. A response and Notice of Appeal were filed on July 17, 2003.
13. Interview and Conditional Petition for Extension of time were filed on September 17, 2003.
14. Interview and Conditional Petition for Extension of time were filed on February 17, 2004.
15. A final office action was mailed March 4, 2005.
16. A response after final was filed on April 18, 2005.
17. An advisory action was mailed July 18, 2005.
18. A response, Notice of Appeal, petition for extension of time and petition to withdraw the finality of the March 4, 2005 office action were filed on September 1, 2005.
19. An Appeal Brief and petition for extension of time under 37 CFR 1.136(a) for five months were on filed April 3, 2006.

REGULATION AND PRACTICE

37 CFR 1.116(b) states:

(b) After a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):

(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;

(2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or

(3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

37 CFR 1.181 (c) and (f) state:

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Director to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

37 CFR 1.550 (c) and (d) state:

(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. 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.

(d) If the patent owner fails to file a timely and appropriate response to any Office action or any written statement of an interview required under § 1.560(b), the *ex parte* reexamination proceeding will be terminated, and the Director will proceed to issue a certificate under § 1.570 in accordance with the last action of the Office.

MPEP 2272 states in part:

It should be kept in mind that a patent owner cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection, or reinstate previously canceled claims. *>For an amendment filed after final rejection and prior to the appeal brief, a< showing under 37 CFR 1.116(b) is required and will be evaluated by the examiner for all proposed amendments after final rejection except where an amendment merely cancels claims, adopts examiner's suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner. An amendment filed at any time after final rejection but before an appeal brief is filed, may be entered upon or after filing of an appeal provided **>:

(A)the total effect of the amendment is to cancel claims or comply with any requirement of form expressly set forth in a previous Office action, or present rejected claims in better form for consideration on appeal;

(B)for an amendment touching the merits of the patent under reexamination, the patent owner provides a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.<

DISCUSSION

Petitioner requests that the finality of the office action mailed March 4, 2005 be withdrawn and that the amendment filed on September 1, 2005 be entered due to the nature of reexamination proceedings in that there is no means by which the patent owner can have amendments entered to place this patent in better form for appeal, eliminate errors in the claims which have come to their attention, and to introduce an amendment agreed upon by the Examiner and patent owner's representative that would overcome the prior art.

It does not appear that the petition is timely for the reason petitioner requests relief. The petition nor the amendment after final filed on April 18, 2005 indicate that the final was premature and therefore do not request relief for such. Such a reason would allow the amendment after final to be considered a request for reconsideration as set forth in 37 CFR 1.181(c). The reason indicated by petitioner does not require reconsideration by the examiner. As such, the petition needed to be filed within two months of the date of the March 4, 2005 final office action. See 37 CFR 1.181 (f). It is also noted that entry of reexamination after final amendments is not a matter of right and a showing under 37 CFR 1.116(b) is required. See MPEP 2272.

Even if the petition was timely, petitioner's request is without merit. On March 1, 2005, the Official Gazette Notice entitled, "Notice of Changes in Requirement for an Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending" (copy attached) indicates in section D that until the new request for continued reexamination (RCR) is in effect a petition under 37 CFR 1.182 to seek relief that is not currently provided by an existing rule can be used to continue prosecution of a reexamination. Such a petition must be filed with a submission that would clearly advance prosecution. The petition must set forth an explanation as to why the submission would clearly advance prosecution and why the submission wasn't earlier filed.

A review of the file also indicates that the Appeal Brief filed on April 3, 2006 is late. Extensions of time in reexaminations are governed by 37 CFR 1.550(c). As such, the request for an extension of time under 37 CFR 1.136(a) is improper. It is also noted that the filing of a petition does not stay any period for reply that may be running against the proceeding. See 37 CFR 1.181(f). Therefore in accordance with 37 CFR 1.550(d), the reexamination is terminated. The office will proceed to issue a certificate under § 1.570 in accordance with the last action of the Office. Petitioner may wish to consider filing a petition to revive under 37 CFR 1.137. See MPEP 2268.

CONCLUSION

For the above stated reasons, the petition under 37 CFR 1.181 is **dismissed**.

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."

Since this reexamination is terminated, the reexamination will be forwarded to the examiner for preparation of the Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC).

Any inquires regarding this decision should be directed to Special Programs Examiner, Linda Sholl, at 571-272-4391.

Karen M. Young

Karen M. Young, Director
Technology Center 3700

Attachment: O.G. Notice: March 1, 2005

United States Patent and Trademark Office OG Notices: 01 March 2005

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

A. Summary: The United States Patent and Trademark Office (Office) revised section 2240 of the Manual of Patent Examining Procedure (MPEP) in May of 2004 to set forth a new policy when a second or subsequent request for reexamination is filed while an "earlier filed reexamination" is pending, and the second or subsequent request cites only prior art (hereinafter "old art") which raised a substantial new question of patentability (SNQ) in the pending reexamination proceeding. See MPEP 2240 (8th ed. 2001)(Rev. 2, May 2004). Under the new policy, the second or subsequent request for reexamination will be ordered only if that old prior art raises a substantial new question of patentability which is different than that raised in the pending reexamination proceeding. If the old prior art cited (in the second or subsequent request) raises only the same issues that were raised to initiate the pending reexamination proceeding, the second or subsequent request will be denied.

It is to be noted that reliance on prior art cited in the pending reexamination (old art) does not preclude the existence of a SNQ that is based exclusively on that old art. Determinations on whether a SNQ exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis. For example, a SNQ may be based solely on old art where the old art is being presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request. The presentation/viewing of old art in a new light, or in a different way, is discussed in Ex parte Chicago Rawhide, 223 USPQ 351 (Bd. Pat. App. & Inter. 1984).

B. Background: A request for ex parte reexamination of a patent pursuant to 35 U.S.C. 302, and a request for inter partes reexamination of a patent pursuant to 35 U.S.C. 311, must raise a substantial new question of patentability (SNQ) in order for a reexamination of the patent to be initiated. More than one reexamination request may be filed for the same patent, and a second or subsequent reexamination request for reexamination of a patent, where a first reexamination proceeding is pending, has historically been granted based on the same prior art that raised the SNQ in a pending first reexamination proceeding.

It has been the Office's experience, however, that both patent owners and third party requesters have used a second or subsequent reexamination request (based on the same substantial new question of patentability initially raised or existing in the pending reexamination proceeding) to prolong the reexamination proceeding, and in some instances, to turn it essentially into an inter partes proceeding. These actions by patent owners and third party requesters have resulted in multiple reexaminations taking years to conclude, thus making it extremely difficult for the Office to conclude reexamination proceedings with "special dispatch" as required by statute (35 U.S.C. 305 for ex parte reexamination, 35 U.S.C. 314 inter partes reexamination). For example, under the prior practice, a patent owner whose claims are rejected in a pending reexamination proceeding could repeatedly file multiple ex

parte reexamination requests based on the same substantial new question of patentability raised, or existing, in the pending reexamination proceeding. By doing so, the patent owner could keep the reexamination proceeding pending indefinitely, to delay the issue of a reexamination certificate canceling the claims of the patent being reexamined. Additionally, a third party requester could file a second or subsequent reexamination request, while a first reexamination proceeding is pending, based on the same substantial new question of patentability raised, or existing, in the first reexamination proceeding, in order to address any responses to Office actions made by the patent owner. This use of a second or subsequent reexamination request has permitted third party requesters to, in effect, obtain an inter partes type of reexamination process in an ex parte reexamination proceeding.

Moreover, concerns regarding lengthy ex parte reexamination pendency resulting from multiple reexamination request filings were raised by witnesses at the Office's Round Table on the Equities of Inter Partes Reexamination Proceedings held February 17, 2004.

C. Implementation of New Policy: Responsive to these concerns, the Office revised its policy to be as is now set forth in the current (May 2004) revision of MPEP 2240, that is: the SNQ for a second or subsequent request for reexamination must be new and different than any SNQ that was raised, or existed, during any prior pending or concluded reexamination proceeding for the patent. This revised policy is consistent with the statutory mandate of special dispatch and the intent of the ex parte reexamination. statute (an ex parte reexamination proceeding is not an inter partes type of reexamination process). Further, 35 U.S.C. 303(a) states that "[w]ithin three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request." It is reasonable to interpret this provision as requiring each request for reexamination to raise its own substantial new question of patentability as compared not only to the original prosecution (in the application for the patent) and any earlier, concluded reexamination proceedings, but to pending reexamination proceedings as well. To accompany the revision of MPEP 2240, MPEP 2640, which was newly added to the MPEP in May of 2004 to address inter partes reexamination proceedings, was drafted to implement this revision of policy for inter partes reexamination proceedings.

D. Transition Procedure: It is noted that, as a consequence of the changes made to MPEP 2240, a patent owner will now be prevented from obtaining entry of an amendment and/or evidence not entered after final rejection in an ex parte reexamination proceeding by filing another request for reexamination based on the same substantial question of patentability raised/existing in the pending reexamination proceeding. In order to provide relief to the patent owner, the Office plans to propose a revision to the patent rules to provide for the filing of a request for continued reexamination (RCR) which would be similar to the request for continued examination (RCE) practice for applications. If the RCR practice is implemented, the patent owner, by filing an RCR, could obtain continued prosecution on the merits in the reexamination proceeding, including entry of an amendment and/or evidence that was denied entry after a final rejection in an ex parte reexamination proceeding or after an action closing prosecution in an inter partes reexamination proceeding.

Until these new rules become effective, however, patent owners are advised to use either: (1) the petition procedure under 37 CFR 1.181 to seek review of a denial of entry of an amendment submitted after final rejection in an ex parte reexamination proceeding or after an action closing prosecution in an inter partes reexamination proceeding; or (2) the petition procedure under 37 CFR 1.182 to seek relief that is not currently provided by an existing rule, but that would be provided when a new request for continued reexamination (RCR) practice is in effect.

E. Inquiries: Inquiries regarding this matter may be directed to Kenneth M. Schor, Senior Legal Advisor, Office of Patent Legal Administration at telephone: (571) 272-7710.

JOSEPH J. ROLLA
Deputy Commissioner for
Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,139	11/07/2001	5687732	163852009430	4618

25227 7590 01/28/2008

MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD
SUITE 400
MCLEAN, VA 22102

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/28/2008

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

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1650 TYSONS BOULEVARD
SUITE 400
MCLEAN VA 22102

(For Patent Owner)

MAILED

JAN 28 2008

CENTRAL REEXAMINATION UNIT

In re Reexamination Proceeding :
Inagaki et al. :
Control No. 90/006,139 : DECISION GRANTING PETITION
Filed: November 7, 2001 :
U.S. Patent No. 5,687,732 :
Attorney Docket No. 163852009430 :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on November 28, 2007, for entry of late papers based upon unintentional delay.

On November 28, 2007, a Renewed Petition Under 37 CFR 1.182, Request For Continued Reexamination filed was also filed.

The petitions are before the Office of Patent Legal Administration (OPLA) for decision.

37 CFR 1.137(b) states, in part:

> "*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 ...."

The present petition under 37 CFR 1.137(b) includes, inter alia, an authorization to charge counsel's deposit account for the $1,540.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3).

A review of the record reveals that the requisite response (Appeal Brief - item 1) was filed April 3, 2006.

The petition under 37 CFR 1.137(b) for entry of the late papers is granted.

$1,540.00 has been charged to counsel's deposit account no. 03-1952 in accordance with the present petition.

Jurisdiction over the present reexamination proceeding is being retained by OPLA for consideration of the Renewed Petition Under 37 CFR 1.182, Request For Continued Reexamination filed November 28, 2007, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Robert Nasser, in Technology Center Art Unit 3735, who can be reached at 571-272-4731.

Telephone inquiries related to this decision on the petition under 37 CFR 1.137(b) only should be directed to Fred A. Silverberg at 571-272-7719.

Fred A. Silverberg

Fred A. Silverberg
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy

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CENTRAL REEXAMINATION UNIT

MORRISON & FOERSTER LLP
1650 Tysons Boulevard
Suite 400
McLean, VA 22102

(For Patent Owner)

In re Inagaki *et al.*	: **DECISION ON PETITION**
Reexamination Proceeding	: **TO CONTINUE**
Control No.: 90/006,139	: ***EX PARTE***
Filed: November 7, 2001	: **REEXAMINATION**
For: U.S. Patent 5,687,732	: **PROCEEDING**

This is a decision on the November 28, 2007, patent owner Renewed Petition Under 37 CFR 1.182 Request for Continued Reexamination.

The petition is before the Office of Patent Legal Administration.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182 has been charged to Deposit Account No. 03-1952, pursuant to the instructions given at page 1 of the November 28, 2007 Renewed Petition.

For the reasons set forth below, the petition under 37 CFR 1.182 is granted.

REVIEW OF FACTS

1) U.S. Patent No. 5,687,732 (the '732 patent) issued on November 18, 1997.

2) Patent owner filed a request for reexamination on November 7, 2001.

3) An Order granting the request for *Ex Parte* Reexamination was mailed on January 16, 2002.

4) A patent owner reply to the Order granting Reexamination was filed on February 20, 2002.

5) A non-final Office action was mailed on May 1, 2002.

6) A response to the non-final Office action was filed on June 28, 2002.

7) A second non-final Office action was mailed on November 5, 2002.

8) A response to the second non-final Office action was filed on December 2, 2002.

9) A final Office action was mailed on January 23, 2003.

10) A response to the final Office action was filed on March 24, 2003.[1]

11) An advisory Office action was mailed on June 23, 2003.

12) A patent owner response and Notice of Appeal were filed on July 17, 2003.

13) A personal interview was conducted between the examiner and the patent owner on September 16, 2003, and a conditional petition for extension of time was filed on September 17, 2003.

14) On February 17, 2004, a second personal interview was conducted, and a conditional petition for extension of time was filed.

15) A second final Office action was mailed on March 4, 2005.

16) A response after the second final Office action was filed on April 18, 2005.

17) An advisory Office action was mailed July 18, 2005.

18) A response, Notice of Appeal, petition for extension of time, and petition to withdraw the finality of the March 4, 2005 Office action were filed by patent owner on September 1, 2005.

19) An Appeal Brief and petition for extension of time under 37 CFR 1.136(a) for five months were then filed on April, 3, 2006.

20) On September 28, 2007, a decision dismissing the September 1, 2005 petition was mailed. The decision informed patent owner that the '6139 reexamination proceeding was terminated.

21) On November 28, 2007, patent owner filed a Renewed Petition Under 37 CFR 1.182, requesting continued reexamination – the petition presently under consideration. The renewed petition requests that the Office continue prosecution of the present reexamination proceeding to thereby provide consideration of the Amendment that accompanied the September 1, 2005 petition.

22) On November 28, 2007, patent owner also filed a Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b).

23) On January 28, 2008, the Office mailed a decision granting the

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[1] The two-month period for responding to the January 23, 2003, final Office action fell on Sunday, March 23, 2003. Accordingly, the filing of a response to the final Office action on Monday, March 24, 2003, was timely.

November 28, 2007 patent owner petition under 37 CFR 1.137(b) for entry of late papers based upon unintentional delay.

DECISION ON PETITION UNDER 37 CFR 1.182

In the present petition, it is requested that the Office continue the prosecution of the '6139 reexamination proceeding to provide consideration of the September 1, 2005 Amendment.[2]

In March of 2005, the Office issued a Notice titled "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."[3] Notice was provided therein that a second (or subsequent) reexamination would no longer be ordered on the basis of a "substantial new question of patentability" (SNQ) that is the same as a SNQ raised in an earlier pending reexamination. Notice was also provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding.

By filing such a petition, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding. Accordingly, relief in the form of a continuation of the reexamination prosecution (after a final Office action) was made available by the Office via a 37 CFR 1.182 petition, in appropriate circumstances. This petition will be referred to herein as "the § 1.182 petition."

The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. This is critical in the reexamination setting, where 35 U.S.C. 305 (for *ex parte* reexamination) and 35 U.S.C. 314 (for *inter partes* reexamination) mandate that reexamination proceedings must be conducted "with special dispatch within the Office." Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, or already of record, to define the issues for appeal, or for the issuance of a reexamination certificate, since this is a key factor in reducing pendency of a reexamination proceeding. Stated another way, the § 1.182 petition practice includes a requirement that the filing of the § 1.182 petition be accompanied by a submission that provides a *bona fide* effort to advance the prosecution toward appeal, or toward the

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[2] Item 18 in the Review of Facts.

[3] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

issuance of a reexamination certificate.

In the '6139 reexamination proceeding, the patent owner was not aware prior to the July 18, 2005 advisory action that, although the rejection of claim 7 was listed under a 35 U.S.C. 102 heading in the March 4, 2005 final Office action, the rejection of claim 7 in the March 4, 2005 final Office action was actually a 35 U.S.C. 103 obviousness rejection. Further, the Remarks section of the September 1, 2005 amendment includes a written statement of a telephonic interview during which the examiner apparently agreed with patent owner that the claim 7 amendment would overcome the pending rejection, were it not ineligible for entry due to its raising of a new issue requiring search or consideration. Based on the facts and circumstances of the present situation, petitioner patent owner's presentation of the September 1, 2005 amendment paper is deemed a *bona fide* effort to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate. As such, the granting of the present petition is consistent with the requirement of 35 U.S.C. 305 to conduct reexamination proceedings "with special dispatch within the Office."

In view of the above and the fact situation presented by the present record, the petition is granted, and the prosecution in the above-noted reexamination proceeding is hereby continued. Prosecution is reopened for consideration of the September 1, 2005 amendment. This paper will be entered in the '6139 reexamination proceeding, and the '6139 proceeding will be forwarded to the examiner for action consistent with this decision. The examiner will consider the September 1, 2005 Amendment and then issue an Office action treating this paper as a patent owner response received **after** a first Office action.

CONCLUSION

1) The petition under 37 CFR 1.182 is granted.

2) The prosecution of the present '6139 *ex parte* reexamination proceeding is continued. No further continuation of the present reexamination proceeding will be granted absent a showing of extraordinary circumstances.

3) The closing of prosecution rendered via the March 4, 2005 final Office action is withdrawn, and prosecution of the proceeding is reopened.

4) The September 1, 2005 amendment will be entered [4] by the Central Reexamination Unit, and will then be considered by the examiner. These papers will be treated as a response by patent owner received **after** a first Office action.

---

[4] This decision takes no position on the propriety of the amendment, or whether it introduces new matter. Any issues raised by the amendment will be addressed by the examiner in the next Office action.

5) Jurisdiction over the reexamination proceeding is being forwarded to the Central Reexamination Unit for further handling and examination not inconsistent with this decision.

6) Telephone inquiries related to this decision should be directed to Raul Tamayo, Legal Advisor, at (571) 272-7728.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

February 25, 2008
C:\Kiva\Kenpet6\ 6139_RCR-grant-103 rej was listed as 102.doc

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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.
90/006,143	11/26/2001	6164444		2508

23363 7590 01/28/2003
CHRISTIE, PARKER & HALE, LLP
350 WEST COLORADO BOULEVARD
SUITE 500
PASADENA, CA 91105

EXAMINER

ART UNIT	PAPER NUMBER
	9

DATE MAILED: 01/28/2003

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PTO-90C (Rev. 07-01)

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Mailed:

CST

Paper No. 9

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In re Bernard
Reexamination Proceeding
Control No. 90/006,143
Filed: November 26, 2001
For: U.S. Patent 5,164,444

In re Bernard
Reexamination Proceeding
Control No. 90/006,354
Filed: August 8, 2002
For: U.S. Patent 5,164,444

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 5,164,444, issued November 17, 1992, is the subject of Reexamination Control Nos. 90/006,143 and 90/006,354. Reexamination Certificate 5,164,444 C1 issued on October 16, 2001

2. A first request for reexamination, assigned Reexamination Control No. 90/006,143 ('143) was filed November 26, 2001 by Professor Chen-Yen Cheng. The request urged that a substantial new question of patentability was raised by the teachings of Japanese patent 51-21811, in view of U.S. patent 4,725,639 to Lenney, U.S. patents 2,884,126 and RE 24,906 to Ulrich, U.S. patent 3,971,766 to Ono et al, U.S. patent 4,822,676 to Mudge and/or the printed publications of Blackley, Ceska and Feast.

3. Reexamination was ordered for '143 on February 13, 2002.

4. A second request for reexamination, assigned Reexamination Control No. 90/006,354 ('354), was filed August 8, 2002 by Irah H. Donner of Hale and Dorr, LLP. The request urged that a substantial new question of patentability was raised by the teachings of (a) U.S. patent 4,507,429 to Lenney; (b) JP 51-21811, in view of U.S. patent 3,971,766 to Ono et al; (c) JP 51-21811, in view of U.S. patent 4,822,676 to Mudge; (d) JP 51-21811, in view of U.S. patent RE 24,906 to Ulrich; (e) JP 51-21811, in view of U.S. patent RE 24,906 to Ulrich and U.S. patent 4,822,676 to Mudge; (f) U.S. patent 4,507,429 to Lenney, in view of JP 51-21811 and U.S. patent 4,822,676 to Mudge; (g) JP 51-21811, in view of U.S. patent 4,507,429 to Lenney and U.S. patent 4,822,676 to Mudge; (h) U.S. patent 4,185,050 to Lazear, in view of U.S. patent 4,507,429 to Lenney; (i) U.S. patent 4,185,050 to Lazear, in view of JP 51-21811 or JP 51-21811, in view of U.S. patent 4,185,050 to Lazear; (j) U.S. patent 3,275,589 to Alexander, in view of U.S. patent 4,822,676 to Mudge.

5. Reexamination was ordered for '354 on October 24, 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 90/006,143 and 90/006,354 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 files shall be forwarded to the examiner for preparation of an Office action.

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. 90/006,143 and 90/006,354 as:

John D. Carpenter
Christie, Parker & Hale, LLP
350 W. Colorado Boulevard, Suite 500
Pasadena, CA 91105

CONCLUSION

Reexamination Control Nos. 90/006,143 and 90/006,354 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

REEXAMINATION

66548 U.S. PTO
90/006143
11/26/01

RE-EXAM
90006143

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FROM DIRECTORS OFFICE

JUN 1 0 2005

TECHNOLOGY CENTER 3600

Christopher W. Day (for Patent Owner)
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
1300 I Street, NW, Suite 700
Washington, DC 20005-3315

Borsari & Associates (for Requester)
2001 Jefferson Davis Highway, Suite 808
Arlington, VA 22202

In re Reexamination Proceeding No. 90/006,147	:	**REQUEST FOR**
Filed: November 20, 2001	:	**EXTENSION OF TIME**
For: U.S. Patent No. 6,219,399	:	*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 June 9, 2005.

A final Office action on the merits was mailed on October 15, 2004 that set a two-month shortened statutory period for response. On December 6, 2004, Patent Owner submitted a response to the final Office action which was denied entry due to due to formal errors in the presentation of the proposed amendments. Patent Owner was informed of the denial of entry in an Advisory Action mailed March 11, 2005 in which the examiner extended the period of response to the final rejection to April 15, 2005, the full six months permitted by law. On April 6, 2005 Patent Owner submitted another amendment and on April 13, 2005 Patent Owner submitted a Notice of Appeal. Patent Owner's appeal brief is due no later than June 13, 2005.

The request for extension of time was timely submitted in accordance with 37 CFR 1.550(c). The reason for the request is "...to provide the Patent Owner with the opportunity to consult with its counsel regarding its options in light of the Office's disposition of the Second Proposed Amendment. Without such an Advisory Action, the Patent Owner and its counsel cannot evaluate whether it is necessary to file an Appeal Brief, or take other action."

The reasons set forth by Patent Owner are deemed to be sufficient to warrant an extension of time so as to determine Patent Owner's best course of action. An extension of time for Patent Owner to submit a Brief on Appeal or take other appropriate action is granted for a period of one month to expire on July 13, 2005.

Further extensions of time to submit a proper response to the Office action should not be expected, and will be granted only in extraordinary circumstances.

SUMMARY: Request **granted**.

Donald Hajec, Director
Technology Center 3600
(571) 272-5150

DH:rar:6/10/05

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2001 Jefferson Davis Highway
Suite 808
Arlington, VA 22202

MAILED

JUL 0 7 2005

REEXAM UNIT

In re Yoshihiro Naruse et al.	:
Reexamination Proceeding	: DECISION ON PETITION
Control No.: 90/006,147	: TO CONTINUE
Filed: November 20, 2001	: *EX PARTE*
For: U.S. Patent No.: 6,219,399	: REEXAMINATION
	: PROCEEDINGS

This is a decision on the June 27, 2005 patent owner petition titled PETITION UNDER 37 C.F.R. § 1.182 FOR CONTINUED REEXAMINATION.

The petition is before the Office of Patent Legal Administration.

The fee set forth in 37 CFR 1.17(f) for a under 37 CFR 1.182 is $400, The petition fee paid by check was $130. An additional $270 will be charged to the petitioner's deposit account No. 06-0916 as authorized by the petitioner on p. 7 of the petition.

For the reasons set forth below, the petition is granted. Prosecution of the proceeding is reopened, and the reexamination prosecution is hereby continued to the extent set forth below.

REVIEW OF FACTS

1) U.S. Patent No. 6,219,399 (the '399 patent) issued on April 17, 2001.

2) The present request for reexamination, assigned control No. 90/006,147, was filed by a third party requester on November 20, 2001.

3) Reexamination was ordered for the '6147 reexamination proceeding on February 15, 2002.

4) A patent owner's statement under 37 CFR 1.530 was not received in the '6147 reexamination proceeding.

5) A non-final Office action was mailed in the '6147 reexamination proceeding on November 19, 2002.

6) An interview between the patent owner and examiner was held on January 21, 2003.

7) A response from the patent owner to the non-final Office action was received in the Office on February 21, 2003.

8) A final rejection was mailed on October 15, 2004.

9) A response to the final rejection was received in the Office on December 6, 2004.

10) An advisory Office action was mailed on March 11, 2005.

11) A second response to the final rejection was received in the Office on April 6, 2005.

12) A Notice of Appeal was received in the Office on April 13, 2005.

13) A second interview between the patent owner and the examiner was held on June 9, 2005.

14) A second advisory Office action was mailed on June 9, 2005.

15) A petition for Extension of Time was received in the Office on June 9, 2005, and a decision granting a one month extension of time was mailed on June 10, 2005.

16) The present petition under 37 C.F.R. 1.182 for continued reexamination was received in the Office on June 27, 2005.

DECISION

In the present petition, it is requested that the Office continue the prosecution of the instant reexamination proceeding to provide consideration of the Second Proposed Amendment dated April 6, 2004.

In March of 2005, the Office issued a Notice titled "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"[1]. Notice was provided therein that a second (or subsequent) reexamination will no longer be ordered on the basis of a "substantial new question of patentability" (SNQ) that is the same as a SNQ raised in an earlier pending reexamination. The Notice stated that:

> "a patent owner will now be prevented from obtaining entry of an amendment and/or evidence not entered after final rejection in an *ex parte* reexamination proceeding by filing another request for reexamination based on the same substantial question of patentability raised/existing in the pending reexamination

[1] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005

> proceeding. In order to provide relief to the patent owner, the Office plans to propose a revision to the patent rules to provide for the filing of a request for continued reexamination (RCR) which would be similar to the request for continued examination (RCE) practice for applications. If the RCR practice is implemented, the patent owner, by filing an RCR, could obtain continued prosecution on the merits in the reexamination proceeding, including entry of an amendment and/or evidence that was denied entry after a final rejection in an ex parte reexamination proceeding or after an action closing prosecution in an inter partes reexamination proceeding.
>
> Until these new rules become effective, however, patent owners are advised to use either: (1) the petition procedure under 37 CFR 1.181 to seek review of a denial of entry of an amendment submitted after final rejection in an ex parte reexamination proceeding or after an action closing prosecution in an inter partes reexamination proceeding; or (2) the petition procedure under 37 CFR 1.182 to seek relief that is not currently provided by an existing rule, but that would be provided when a new request for continued reexamination (RCR) practice is in effect."

Accordingly, relief in the form of a continuation of the reexamination prosecution (after a final rejection) is now available via a 37 CFR 1.182 petition in appropriate circumstances.

As with a Request for Continued Examination (RCE) in an application, a RCR must be filed to further the prosecution of the reexamination proceeding, rather than to delay it. Thus, the patent owner must make a *bona fide* effort to define the issues for appeal, or the issuance of a reexamination certificate, when filing a request for continued reexamination, since this is a key factor in reducing pendency of a reexamination proceeding. Stated another way, the proposed RCR practice includes a requirement that the filing of a RCR be accompanied by a submission that provides a *bona fide* effort to advance the prosecution toward appeal, or the issuance of a reexamination certificate.

The patent owner's petition notes that an after-final amendment that furthers the prosecution of the reexamination proceeding rather than delaying it has been submitted in the instant proceeding. The petition states that "[i]n the Advisory Action dated June 9, 2005, the Examiner decided to decline entry into the record and give substantive consideration of the Second Proposed Amendment dated April 6, 2004." The basis for this decision was the Examiner's conclusion that new issues requiring further consideration and/or search were raised by the proposed changes to claims. In particular, the Examiner stated that "[c]onsideration of the issues raised by the new amendments to the claims would involve a new interpretation, search and/or review of the applied prior art." Advisory Action at p. 3. This action by the examiner is taken as evidence a furtherance of the prosecution by the patent owner.

In view of the above, the petition is granted, and the prosecution in the above-noted

reexamination proceeding is hereby continued. The finality of the October 15, 2004 Office action is withdrawn, and the prosecution is reopened for consideration of the Second Proposed Amendment dated April 6, 2004. The April 6, 2004 amendment will be entered in the reexamination proceeding, and the proceeding will be forwarded to the examiner for action on the amendment. The examiner will consider the amendment and then issue an Office action treating the amendment as a response received after a first Office action.

CONCLUSION

1) The petition under 37 CFR 1.182 is granted.

2) The prosecution of the present '6147 reexamination proceeding is continued.

3) The finality of the October 15, 2004 Office action is withdrawn, and prosecution of the proceeding is reopened.

4) The Second Proposed Amendment dated April 6, 2004 will be entered by the Technology Center, and then considered by the examiner. The amendment will be addressed and treated as a response received after a first Office action

5) The reexamination proceeding is being forwarded to the Technology Center for further handling and examination not inconsistent with this decision.

6) Telephone inquiries related to this decision should be directed to Anton W. Fetting, Senior Legal Advisor, at (571) 272-7717, or in his absence, Kenneth Schor, Senior Legal Advisor, at (571) 272-7710.

Kenneth W. Schor

Kenneth Schor, Senior Legal Advisor
Office of Patent Legal Administration
Office of Patent Examination Policy

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June 29, 2005

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(For Patent Owner)

MAILED
MAR 13 2006
REEXAM UNIT

Peter Borsari, Esq.
BORSARI & ASSOCIATES
2001 Jefferson Davis Highway
Suite 808
Arlington, VA 22202

(For Requester)

Enclosure: Copy of Patent Owner RESUBMISSION OF PETITION FOR CONTINUED REEXAMINATION filed February 27, 2006

In re Yoshihiro NARUSE et al.	: DECISION ON PETITION
Reexamination Proceeding	: TO CONTINUE
Control No.: 90/006,147	: *EX PARTE*
Filed: November 20, 2001	: REEXAMINATION
For: U.S. Patent No.: 6,219,399	: PROCEEDING

This is a decision on the January 9, 2006, patent owner petition titled PETITION UNDER 37 C.F.R. § 1.182 FOR CONTINUED REEXAMINATION and the February 27, 2006, patent owner correspondence titled RESUBMISSION OF PETITION FOR CONTINUED REEXAMINATION.

The petition is before the Office of Patent Legal Administration.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182 has been paid by check.

For the reasons set forth below, the petition is granted. This is the second and final continuation of this reexamination proceeding. *No further continuations of the present reexamination proceeding will be granted under 37 CFR 1.182.* Prosecution of the proceeding is reopened, and the reexamination prosecution is hereby continued to the extent set forth below.

REVIEW OF FACTS

1) U.S. Patent No. 6,219,399 (the '399 patent) issued on April 17, 2001.

2) The present request for reexamination, assigned control No. 90/006,147, was filed by a third party requester on November 20, 2001.

3) Reexamination was ordered for the '6147 reexamination proceeding on February 15, 2002.

4) A patent owner's statement under 37 CFR 1.530 was not received in the '6147 reexamination proceeding.

5) A non-final Office action was mailed in the '6147 reexamination proceeding on November 19, 2002.

6) An interview between the patent owner and examiner was held on January 15, 2003.

7) An examiner interview summary was mailed on January 21, 2003.

8) An *Ex Parte* reexamination communication that extended the period for responding to the non-final Office action until February 21, 2003 was mailed on January 21, 2003.

9) A response from the patent owner to the non-final Office action was received in the Office on February 21, 2003.

10) A final Office action was mailed on October 15, 2004.

11) A response from the patent owner to the final Office action was received in the Office on December 6, 2004.

12) An advisory Office action was mailed on March 11, 2005.

13) A second response from the patent owner to the final Office action was received in the Office on April 6, 2005.

14) A Notice of Appeal was received in the Office on April 13, 2005.

15) A second interview between the patent owner and the examiner was held on June 9, 2005.

16) A second advisory Office action was mailed on June 9, 2005.

17) A petition for Extension of Time from the patent owner was received in the Office on June 9, 2005, and a decision granting a one month extension of time was mailed on June 10, 2005.

18) A patent owner petition under 37 CFR 1.182 requesting continued reexamination was received in the Office on June 24, 2005.

19) A decision granting the patent owner's request for continued reexamination was mailed on July 7, 2005.[1]

20) A response from the patent owner to the advisory Office action of June 9, 2005, and the decision of July 7, 2005, was received in the Office on July 12, 2005.

21) A final Office action was mailed on August 29, 2005.[2]

22) A response from the patent owner to the final Office action of August 29, 2005, was received in the Office on October 27, 2005.

23) An advisory Office action, in which the examiner extended the period for response to the final Office action until February 28, 2006, the full six months permitted by law, was mailed on November 17, 2005.

24) The present petition under 37 C.F.R. 1.182 for continued reexamination was received in the Office on January 9, 2006.

25) The present resubmission of the petition for continued reexamination filed January 9, 2006, was received on February 27, 2006.

DECISION

In the present petition and resubmission of petition, it is requested that the Office continue the prosecution of the instant reexamination proceeding to provide consideration of the Proposed Amendment After Final received in the Office on October 27, 2005.

As with a Request for Continued Examination (RCE) in an application, a petition requesting a continued prosecution in a reexamination (RCR) must be filed to further the prosecution of the reexamination proceeding, rather than to delay it. Thus, the patent owner must make a *bona fide* effort to define the issues for appeal, or the issuance of a reexamination certificate, when filing a request for continued reexamination, since this is a key factor in reducing pendency of a reexamination proceeding. Stated another way, the RCR petition practice includes a requirement that the filing of a RCR be accompanied by a submission that provides a *bona fide* effort to advance the prosecution toward appeal, or the issuance of a reexamination certificate.

---

[1] The Decision indicated that the Amendment filed on April 6, 2005, would be treated as a response received after a first Office action.

[2] This final Office action was issued by an examiner who was assigned to the reexamination proceeding subsequent to the advisory Office action of June 9, 2005.

[3] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005

The patent owner's petition urges that an after-final amendment that furthers the prosecution of the reexamination proceeding rather than delaying it has been submitted in the instant proceeding. The fact situation presented by the record shows the assignment of the present proceeding of a different examiner after the advisory Office action of June 9, 2005. The new examiner issued a final rejection providing the new examiner's points of argument. The patent owner then addressed a response to the new examiner's points of argument. Then, as petitioner points out, "[T]he Examiner refused entry of the Proposed Amendment After Final because he concluded that it raised substantial new questions of patentability." The Examiner's decision was based on a conclusion that new issues requiring further consideration and/or search were raised by the proposed changes to claim 1. Specifically, the Examiner stated, "The issues raised by the new amendment to claim 1 would involve more than cusory [sic] consideration and/or search, i.e., they would require new interpretation, new search and/or review of the applied prior art." Advisory Action at p. 3. This action by the examiner, is taken as evidence of a *bona fide* effort by the patent owner to advance the prosecution, in response to the new examiner's points of argument.

Given the unique facts of this proceeding, the petition is granted, and the prosecution in the above-noted reexamination proceeding is hereby continued. **This is, however, the second and <u>final</u> continuation of this reexamination proceeding. No further continuations of the present reexamination proceeding will be granted under 37 CFR 1.182.**

The finality of the August 29, 2005, Office action is withdrawn, and the prosecution is reopened for consideration of the Proposed Amendment After Final received October 27, 2005. This amendment will be entered in the reexamination proceeding, and the proceeding will be forwarded to the examiner for action consistent with this Decision. The examiner will consider the Proposed Amendment After Final, and then issue an Office action <u>treating the amendment as a response received after a first Office action</u>.

<u>LACK OF SERVICE</u>

The RESUBMISSION OF PETITION FOR CONTINUED REEXAMINATION received from the patent owner on February 27, 2006, is deficient for failure to reflect service of the response on the third party requester in accordance with 37 CFR 1.550(f).

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.

The requisite proof of service on the third party requester (a Certificate of Service) was not included with the papers filed February 27, 2006. In this instance the RESUBMISSION OF PETITION FOR CONTINUED REEXAMINATION is being forwarded to the third party requester. Any future communications filed by the patent owner in this proceeding 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 1.182 is granted.

2) The prosecution of the present '6147 reexamination proceeding is continued. No further continuation of the present reexamination proceeding will be granted under 37 CFR 1.182.

3) The finality of the August 29, 2005, Office action is withdrawn, and prosecution of the proceeding is reopened.

4) The Amendment After Final received October 27, 2005, will be entered by the Technology Center, and then considered by the examiner. This response will be addressed and treated as a response received after a first Office action

5) The reexamination proceeding is being forwarded to the Technology Center for further handling and examination not inconsistent with this Decision.

6) 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

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March 13, 2006

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Paper No. 8

Ann M. Mueting
3M Office of Intellectual
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P.O. Box 33427
St. Paul, MN 55133-3427

(For Patent Owner)

MAILED

OCT 18 2002

REEXAM UNIT

In re Wilson et al.
Reexamination Proceeding
Control No. 90/006,152
Filed: October 31, 2001
For: U.S. Patent No. 5,882,796

DECISION DISMISSING PETITION

This is a decision on the September 23, 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. 13-4895, as per petitioner's instructions on page 3 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 and the required reply to the outstanding nonfinal Office action. The instant petition lack(s) item (3) above. It should be noted that 37 C.F.R. § 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional. The statement contained in the instant petition varies from the language required by 37 C.F.R. § 1.137(b)(3), and is **not** sufficient to meet the requirement of 37 C.F.R. § 1.137(b)(3), as it merely indicates that "The entire delay in responding to the Office action was absolutely 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 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 the undersigned at (703) 308-0255.

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

October 18, 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
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Paper No. 10

Ann M. Mueting
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St. Paul, MN 55133-3427

(For Patent Owner)

MAILED

NOV 19 2002

REEXAM UNIT

In re Wilson et al.
Reexamination Proceeding
Control No. 90/006,152
Filed: October 31, 2001
For: U.S. Patent No. 5,882,796

DECISION GRANTING PETITION

This is a decision on the November 1, 2002, 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) has been charged to deposit account no. 13-4895, as per petitioner's instructions on page 3 of the original petition of September 23, 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 original petition was accompanied by the petition fee and the required reply to the outstanding non-final Office action. The present renewed petition contains 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 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 outstanding non-final Office action.

3. Any questions with regard to this reexamination proceeding should be directed to the examiner, Michael E. Grendzynski, Group Art Unit 1774.

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

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

November 18, 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

Paper no. 15

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

Reexamination Control No. 90/006,153

MAILED

SEP 18 2002

REEXAM UNIT

FOR PATENT OWNER:

John R. Thompson
STOEL RIVES, LLP
201 South Main Street, Suite 1100
Salt Lake City, UT 84111

FOR REQUESTER:

Holly M. Amjad
POLSINELLI, SHALTON & WELTE, P.C.
700 West 47th Street, Suite 1000
Kansas City, Missouri 64108

DECISION ON PETITION FOR THE ACCEPTANCE OF LATE PAPERS

This is in reply to petitioner's Petition To Accept Late Filed Papers under 37 CFR 1.10 filed June 13, 2002. There is no fee required for this petition.

The petition is **GRANTED**.

A review of the above reexamination file indicates that an Order Granting a Request for Reexamination was mailed February 15, 2002. The Patent Owner's Statement having an Express Mail date of April 15, 2002 was apparently never received by the Office.

The requirements for filing a grantable petition in the case of a correspondence mailed using "Express Mail" and never received by the Office are outlined in 37 CFR 1.10(e) and include the following:

(A) Be filed promptly after the person becomes aware that the Office has no evidence of receipt of the correspondence;

(B) Include a showing that the "Express Mail" mailing label was placed on each piece of correspondence prior to original mailing;

(C) Include a true copy of the originally deposited correspondence showing the number of the "Express Mail" mailing label thereon, a copy of any returned post card receipt, a copy of the "Express Mail" mailing label showing the "date-in" or other official notation entered by the USPS; and

(D) Include a statement, signed by the person who deposited the documents as "Express Mail" with the USPS, setting forth the date and time of deposit, and declaring that the copies of the correspondence, "Express Mail" mailing label, and returned postcard receipt accompanying the petition are true copies of the correspondence, mailing label and returned postcard receipt originally mailed or received.

Patent Owner's petition includes a copy of a Patent Owner's Statement bearing an Express Mail date of April 15, 2002, a copy of the "Express Mail" mailing label, and the required statement under 37 CFR 1.10(e)(4). This is sufficient evidence of a timely response.

Since a timely response to the Order Granting Reexamination was filed, the reexamination file is being forwarded to the Supervisory Legal Instrument Examiner for entry of the Patent Owner's Statement filed with the petition before forwarding to the examiner for treatment on the merits.

Telephone inquiries relative to this decision should be directed to Special Programs Examiner Steven N. Meyers at (703) 308-3868.

Steven N. Meyers, Special Program Examiner
Technology Center 3600
(703) 308-3868
Facsimile: (703) 306-0586

snm: 9/9/02

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

Reexamination Control No. 90/006,153

MAILED

MAY 23 2003

Office of the Director
Group 3600

FOR PATENT OWNER:

John R. Thompson
STOEL RIVES LLP
201 South Main Street
Suite 1100
Salt Lake City, UT 84111

DECISION ON PETITION
TO ACCEPT A
LATE COMMUNICATION

FOR REQUESTER:

John S. Artz
ARTZ & ARTZ, PC
28333 Telegraph Road
Suite 250
Southfield, MI 48034

This is in response to the third party requester's petition to accept a late communication under 37 CFR 1.181, filed in the United States Patent and Trademark Office on October 28, 2002 and supplemented on October 31, 2002.

The petition is **GRANTED**.

A review of the file record indicates that a Response to Order Granting Reexamination was mailed to the third party requester on June 28, 2002, as noted in the Certificate of Service dated June 28, 2002.

Third party requester's petition includes a copy of a Reply to Statement of Patent Owner and a copy of a post card identifying the Reply that included a USPTO Mail Room receipt date of August 27, 2002. This is acceptable evidence of a timely response.

Since a timely response to the Patent Owner Statement was filed, the reexamination file is being forwarded to the Central Reexamination Unit for entry of the Reply filed with the petition, and then to the Examiner for prompt action on the merits of the claims.

Randolph A. Reese

Randolph A. Reese, Special Programs Examiner
Patent Technology Center 3600
Telephone No.: (703) 308-2121
Facsimile No.: (703) 605-0586

RAR/tpl: 5/20/03

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 11 2005

Gary R. Maze
Duane Morris LLP
3200 Southwest Freeway
Suite 3150
Houston, TX 77027

In re Reexamination of :
U.S. Patent No. 5,794,701 :
Oceaneering International, Inc. (Owner) : **DECISION ON PETITION**
Control No. 90/006,154 : **FOR THE ACCEPTANCE**
Filed: December 4, 2001 : **OF LATE PAPERS**
Attorney Docket No. D5433-00006 :
For: SUBSEA CONNECTION

This is in reply to petitioner's Petition to Withdraw Holding of Abandonment, which will be treated as a Petition for the Acceptance of Late Papers, filed on April 11, 2005. There is no fee required for this petition.

The petition is **GRANTED**.

A review of the above reexamination file indicates that the Change of Correspondence Address submitted on April 12, 2004 was never entered in the file. Thus the communication mailed October 13, 2004 was not mailed to the new address. The patent owner has submitted a copy of the change of address along with a copy of the post card receipt having a receipt date stamp of April 12, 2004. This is acceptable evidence of a timely filing of the change of address. The change of address has now been processed.

The reexamination file is being forwarded to the Supervisory Legal Instruments Examiner with instructions to re-date and re-mail the communication originally mailed on October 13, 2004.

Randolph A. Reese

Randolph A. Reese
Special Programs Examiner
Patent Technology Center 3600
(571) 272-6619

RAR/dgd: 5/3/05

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
90/006,160	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

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
Washington, D C 20231
www uspto gov

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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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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 7/16

Richard L. Wood
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Stephen J. Holmes
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Providence, RI 02903

(For Third Party Requester)

Robert Kinberg
VENABLE
P.O. Box 34385
Washington, D.C. 20043-9998

(For Third Party Requester)

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,

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

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

DO NOT USE IN PALM PRINTER

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

ROBERT KINBERG
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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

COMMISSIONER FOR PATENTS
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WASHINGTON, D.C. 20231
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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

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
90/006,160	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.

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
Washington, D C 20231
www uspto gov

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
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EXAMINER
NEILS

ART UNIT	PAPER NUMBER
2875	8

DATE MAILED: 03/03/2003

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
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
90/005,975	04/05/2001	6190018	E001-ASP	5820

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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 27/8

Richard L. Wood
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(For Patent Owner)

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Providence, RI 02903

(For Third Party Requester)

Robert Kinberg
VENABLE
P.O. Box 34385
Washington, D.C. 20043-9998

(For Third Party Requester)

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

DECISION MERGING
REEXAMINATION
PROCEEDINGS

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.

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
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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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101 DYER STREET, 5TH FLOOR
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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).

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

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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
Patent and Trademark Office
Address COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D C 20231

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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

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address COMMISSIONER OF PATENTS AND TRADEMARKS
PO Box 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
WELSH & KATZ, LTD.
120 SOUTH RIVERSIDE PLAZA, 22ND FLOOR
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.

05/19/2003

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 30/9

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(For Patent Owner)

Stephen J. Holmes
Mark E. Tetreault
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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)

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.

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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(THIRD PARTY REQUESTERS CORRESPONDENCE ADDRESS)

ROBERT KINBERG
VENABLE
P.O. BOX 34385
WASHINGTON, DC 20043-9998

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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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,162	12/17/2001	5435411	731117.0011	9830

7590 09/13/2005

Mark D. Giarratana
McCarter & English LLP
CityPlace I
185 Asylum Street
Hartford, CT 06103-3495

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/13/2005

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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James J. Merrick, Esq. (For Patent Owner)
McCarter & English
City Place I
185 Asylum Street
Hartford, CT 06103

Anthony J. Borgatti	:	
Reexamination Proceeding	:	**DECISION**
Control No. 90/006,162	:	**GRANTING**
Filed: December 17, 2001	:	**PETITION**
For: U.S. Patent No. 5,435,411	:	

This is a decision on the August 17, 2005, patent owner PETITION TO REVIVE A TERMINATED REEXAMINATION PROCEEDING PURSUANT TO 37 C.F.R § 1.137(b), requesting revival of the present proceeding under the "unintentional" standard.

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

The petition fee of $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. 50-3569, in accordance with petitioner's authorization on page 2 of the petition.

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 Supplemental Appeal Brief was filed with patent owner's August 17, 2005 petition, thereby providing 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 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.

It is not apparent whether the person signing the statement of unintentional delay, Mr. James Merrick, was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Office records do not indicate that a power of attorney designating Mr. Merrick has been made for this reexamination. Nevertheless, the statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of the delay. *See* 37 C.F.R. 10.18(b) and *Changes to Patent Practice and Procedure*; Final Rule Notice, 62 *Fed. Reg.* 53131, 53178 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* 63, 103 (October 21, 1997). If such an inquiry has not been made, then petitioner must make such an inquiry. If such inquiry results in the discovery that is incorrect 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, then petitioner must notify the Office.

CONCLUSION

1. The petition under 37 CFR 1.137(b) is **granted**.

2. The reexamination file is being returned to Technology Center 3600 for consideration, in due course, of the Supplemental Appeal Brief filed August 17, 2005, with the petition.

3. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Alvin Chin-Shue, in Art Unit 3634, who can be reached at (571) 272-6828.

4. 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

#12

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JAN 29 2003

Office of the Director
Group 3600

W. Thomas Timmons
2401 Turtle Creek Blvd.
Dallas, TX 75219

(For Patent Owner)

Charles E. Leahy
General Motors Corporation
300 Renaissance Center, GM Legal Staff/Intellectual Prop
Mail Code: 482-C23-B21
Detroit, MI 48265-3000

(For Requester)

In re Reexamination Proceeding No. 90/006,167	:	**DECISION ON REQUEST**
Filed: December 21, 2001	:	**TO TRANSFER REEXAM**
For: U.S. Patent No. 5,638,711	:	**FROM ORIGINAL EXAMINER**

This is a decision on the request of May 6, 2002 made by third party requester to have the instant reexamination proceeding reassigned to another examiner. The delay in responding to this request is regretted.

The order granting reexamination was mailed on March 19, 2002 and was signed by Suzanne Dino Barrett, Primary Examiner in Technology Center 3600. Requester subsequently filed the instant request. The relief requested is the removal of Examiner Barrett as the examiner of record in the present reexamination proceeding in accordance with the policy set forth in MPEP 2236. Requester asks for additional relief in restarting the reexamination process or correction of the Order Granting Reexamination due to alleged deficiencies in the original Order.

With respect to the first request, a portion of MPEP 2236 was cited by requester which stipulates the policy of the USPTO when assigning reexamination proceedings to examiners. As stated in MPEP 2236 and quoted by requester, "...under normal circumstances, the reexamination request will not be assigned to an SPE, primary examiner or, assistant examiner who was involved in any part of the examination of the patent for which reexamination is requested (e.g., by preparing/signing an action)." Requester asserts that since Primary Examiner Dino signed the Notice of Intent to Issue Reexamination Certificate (NIRC) at the conclusion of the first reexamination of U.S. Patent 5,638,711, assignment of the present reexamination to her violates the stated Office policy. This argument is not persuasive and the request to reassign the present reexamination to another examiner will not be granted. Office policy in this matter as set forth in MPEP 2236 and quoted by requester stipulates that the examiner of record in a reexamination proceeding will not be one who was involved in the examination of the patent under reexamination. Examiner involvement is defined as "preparing/signing an action." In this

case, Examiner Dino served as a conferee in a patentability review conference for the previous reexamination and, as such, did not prepare or sign the action as the examiner responsible for the original examination, or in the instant case the reexamination of the original patent. Therefore, assigning Examiner Dino to the present reexamination is in compliance with stated Office policy.

As for the request to restart the reexamination process or correction of the Order Granting Reexamination to include the examiner's position with respect to certain claims and one of the publications cited in the reexamination request, requester is correct that it would have been helpful had the examiner addressed claims 1 and 4-7 and the Chevrolet Service Manual. However, patent owner has submitted a thorough owner's statement and requester has submitted a thorough reply thereto. To further delay the reexamination proceeding in order to modify the examiner's order granting reexamination, particularly in view of the fact that patent owner and requester have addressed the issues in question is inappropriate. The examiner will fully consider all issues raised in the request, the owner's statement, and the requester's reply during *ex parte* prosecution.

The reexamination file will be forwarded to the primary examiner for prompt examination.

Donald T. Hajec, Director
Technology Center 3600
Telephone No.: (703) 306-4180
Facsimile No.: (703) 306-4598

DTJ:rar:1/27/03

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Office of the Director
Group 3600

For the Patent Owner:

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For the Requester:

Charles E. Leahy
General Motors Corporation
300 Renaissance Center,
GM Legal Staff/Intellectual Property
Mail Code 482-C23-B21
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DECISION ON PETITION FOR THE ACCEPTANCE OF LATE PAPERS

In re Reexamination proceeding 90/006,167
Filed: December 21, 2001
For: SPARE TIRE LOCKING DEVICE

This is in reply to petitioner's communication filed December 17, 2003 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 Substitute Proposed Amendment submitted by the patent owner in response to the Notice of Defective Paper of May 2, 2003, was apparently never received by the Office. The patent owner has submitted a copy of the above-noted amendment having a Certificate of Mail dated May 12, 2003, along with a statement under 37 CFR 1.8(b)(3) by the person signing the Certificate of Mail. This is acceptable evidence of a timely filing of the lost amendment.

The reexamination file is being forwarded to the Supervisory Legal Instruments Examiner to enter the communication from the patent owner filed June 30, 2000.

Steven N. Meyers
Patent Technology Center 3600
(703) 308-3868

SM/SM: 1/17/04

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FROM DIRECTORS OFFICE

AUG 25 2005

TECHNOLOGY CENTER 3600

For the Patent Owner:

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For the Requester:

Charles E. Leahy
GM Legal Staff
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Detroit, MI 48265-3000

DECISION ON PETITION
FOR THE ACCEPTANCE
OF LATE PAPERS AND
EXTENSION OF TIME

In re Reexamination proceeding 90/006,167
Filed: December 21, 2001
For: SPARE TIRE LOCKING DEVICE

This is in reply to petitioner's communication filed July 6, 2005, Petition To Accept Late Filed Papers and for Extension of Time. There is no fee required for this petition.

The Petition to Accept Late Papers is **GRANTED**.

The Petition for Extension of Time is **DISMISSED**.

A review of the above reexamination file indicates that the IDS submitted by the patent owner was apparently never received by the Office. The patent owner has submitted a copy of the above-noted IDS having a Certificate of Mail dated May 21, 2004, along with a statement under 37 CFR 1.8(b)(3) by the person signing the Certificate of Mail. This is acceptable evidence of a timely filing of the lost paper.

Applicant has requested a four month extension of time to respond to the final Office action so that the examiner will have sufficient time to review the additional references. A petition under 37 CFR 1.550(c) can be granted for a showing of "sufficient cause." MPEP 2265 provides that evaluation of sufficient cause has been shown for an extension of time must be made in the context of providing the patent owner with a fair opportunity to respond and the requirement of the statute (35 USC 305) 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 examiner should have time to review the additional references is not considered "sufficient cause". All the references used in the final rejection of the claims that are currently on appeal are of record. It is not seen that a lost IDS containing additional art would materially impact the rejections on appeal or hamper patent owner's ability to file a complete and proper appeal brief. The appeal brief must be timely filed regardless of any decision the examiner makes in view of the additionally cited references.

The reexamination file is being forwarded to the Supervisory Legal Instruments Examiner to accept the IDS from the patent owner filed May 21, 2004 as timely filed. Patent Owner's period for submission of the appeal brief continues to run two months from the notice of appeal, filed July 5, 2005.

Steven N. Meyers
Special Program Examiner
Patent Technology Center 3600
(571) 272-6611

SM/js: 8/25/05

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Paper No. 18

Mark A. Newman
BARNES & THORNBURG
750 17th Street
Suite 900
Washington, DC 20006-4607

(For Patent Owner)

MAILED

APR 01 2004

REEXAM UNIT

In re Vidal et al.
Reexamination Proceeding
Control No. 90/006,170
Filed: January 24, 2002
For: U.S. Patent No. 6,215,754

In re reissue application of
Vidal et al.
Application No. 10/409,700
Filed: April 9, 2003
For: U.S. Patent No. 6,215,754

DECISION *SUA SPONTE* MERGING REEXAMINATION AND REISSUE PROCEEDINGS

The above-identified reissue application and reexamination proceeding are before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged at this time.

REVIEW OF FACTS

1. U.S. Patent No. 6,215,754 issued to Vidal, et al., on April 10, 2001.

2. Reexamination of the '754 patent was ordered by the Director of the USPTO on January 24, 2002, and the resulting reexamination proceeding was assigned Control No. 90/006,170.

3. Patent owner filed a reissue application based on the '754 patent, on April 9, 2003, which was assigned Application No. 10/409,700. Claims 30-56 were added.

4. A non-final rejection was mailed in the '6170 proceeding on June 12, 2002.

5. A response was filed in the '6170 proceeding on August 12, 2002 a second response was filed on October 15, 2002 (not entered), and a third response was filed on October 21, 2002.

6. A second non-final rejection was mailed in the '6170 proceeding on February 14, 2003.

7. On June 11, 2003, a response to the non-final Office action was filed in the '6170 proceeding.

8. Notice of the filing of the reissue application was published in the *Official Gazette* on July 8, 2003.

9. A second response to the non-final Office action was filed in the '6170 proceeding on September 9, 2003 (not entered).

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 '6170 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 '6170 reexamination file shows that several amendments were made in the reexamination file, but only the amendments of October 21, 2002, and June 11, 2003. In the amendment of October 21, 2002, claims 1-7, 10-15 and 23 were amended, claims 30-82 were added, and claims 8-9 and 21-22 were cancelled. In the amendment of June 11, 2003, it was requested to "amend claims 1-7, 10-15 and 23 back to their status as granted" in the patent, to "reinstate claims 8-9 and 21-22 back to their status as granted" in the patent, claims 30-56 were cancelled, and claims 83-129 were added.

A review of the reissue (Application No. 10/409,700) prosecution history shows that the reissue application was published in the *Official Gazette* on July 8, 2003. In the reissue application, patent owner has added claims 30-56. Therefore, the claims are **not** identical in both proceedings.

In order to provide efficient and prompt handling of both proceedings, and to prevent inconsistent and possibly conflicting amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexamination proceeding will be conducted in accordance with the decision set forth below.

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-identified reissue and reexamination proceedings are merged. A joint examination will be conducted in accordance with the guidelines and requirements which follow.

II. Requirement for Same Amendments in Both Proceedings

The patent owner is required to maintain identical amendments in the reissue application and the reexamination file for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the proceedings remain merged. See 37 C.F.R. § 1.565(d). As noted above with regard to the amendments submitted, the claims are NOT the same in both files. **An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both cases**, specifically, Application No. 10/409,700, and Control Number 90/006,170. The response to the requirement must be limited to placing the same amendments in both cases, and patent owner must **not** address the issues of either of the proceedings in the housekeeping amendment. The housekeeping amendment should be submitted as a single paper, including the identifying data for both files (*i.e,* the reissue Application No. and the reexamination proceeding Control No.) and a signature, and should be filed in duplicate for entry into each of the reissue and reexamination files.

It should be noted that some of the previous amendments filed in the '6170 proceeding are not in the appropriate format for reexamination and therefore were not entered. Note that the housekeeping amendment for the merged proceeding should be provided in the proper format for reissue applications. **Amendments in a reissue application must be in compliance with 37 C.F.R. § 1.173,** therefore all new claims must be completely underlined pursuant to 37 C.F.R. § 1.173(b)(2) and (d)(2). Please be aware that a "clean copy" of the amendment is **not** required by this rule. **Note that amendment practice pursuant to 37 C.F.R. § 1.121 does not apply to reissue applications, as specifically indicated in 37 C.F.R. § 1.121(a) and (h), and therefore "Revised Amendment Practice" does not apply to reissue applications.** Therefore, the required housekeeping amendment must be in compliance with 37 C.F.R. § 1.173, *e.g.*, all new claims must be completely underlined pursuant to 37 C.F.R. § 1.173(b)(2) and (d)(2).

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, and containing identifying data for both of the cases (*i.e,* the reissue Application No. and the reexamination proceeding Control No.).

If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be terminated by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 C.F.R. § 1.570. See MPEP 2285.

If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated as follows. The reissue application will be held abandoned, and the merger will be dissolved. With respect to the reexamination proceeding, the Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office, unless further action is clearly needed as a result of the difference in rules relating to reexamination and reissue proceedings.

If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 C.F.R. § 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue examination as to the reexamination proceeding. Any grounds of rejection which are not applicable under reexamination would be withdrawn (*e.g.,* based on public use or sale), and any new grounds of rejection which are applicable under reexamination (*e.g.,* improperly broadened claims) would be made by the examiner upon dissolution of the merged proceeding. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 C.F.R. § 1.552(c).

If applicant/patent owner files a Request for Continued Examination (RCE) of the reissue application under 37 C.F.R. § 1.114, the reissue application is not considered to be expressly abandoned; rather the finality of the Office action is withdrawn, and the merged proceeding will continue. This is so, because an RCE is not an abandonment of any application, whether it be a reissue application or a non-reissue application.

CONCLUSION

1. The above-identified reissue application and reexamination proceeding **ARE MERGED** into a single consolidated proceeding.

2. The reissue application file and the reexamination file are being forwarded to the Group Director of Technology Center 2600. All further examination should be conducted in accordance with this decision.

3. Pursuant to Part II of this decision, a housekeeping amendment is required **within ONE (1) MONTH of this decision**, placing the same amendments in both cases of the present merged proceeding, which amendment must be in compliance with 37 C.F.R. § 1.173.

4. The examiner should issue an Office action for the present merged proceeding of the reissue application and reexamination proceeding **after** the earlier of:

   (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. 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 both files will result in the Office's rejection of any claim that does not contain identical text in both merged proceedings under 35 U.S.C. § 112, second paragraph, as being indefinite as to the content of the claim, and therefore failing to particularly point out the invention.

6. All further examination should be conducted in accordance with Parts II and III of this decision.

7. Telephone inquiries related to this decision should be directed to the undersigned at (703) 308-0255.

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

April 1, 2004

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.
10/409,700	04/09/2003	Joel Vidal	

PATENT NUMBER	DATE OF THIS NOTICE	PAPER NUMBER
6,215,754	04/01/2004	19

NOTICE OF MERGED REEXAM - REISSUE PROCEEDING

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

Control No. 90/006,170 Filing Date: 01/24/2002

Requester (name, address) NONE

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

REEXAMINATION RESULTS

The questions raised in reexamination request No. 90/006,170, filed 01/24/2002, have been considered and the results thereof are reflected in this reissue patent which constitutes the reexamination certificate required by 35 U.S.C. 307 as provided in 37 CFR 1.570(e).

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Washington DC 20006-4607

(For Patent Owner)
(First reissue)
(Reexamination)

Seyfarth Shaw
55 East Monroe Street
Suite 4200
Chicago IL 60603-5803

(For Patent Owner)
(Second reissue)

MAILED

MAY 2 6 2005

REEXAM UNIT

In re reissue application of
Vidal et al.
Application No. 10/996,329
Filed: November 24, 2004
For: U.S. Patent No. 6,215,754

In re reissue application of
Vidal et al.
Application No. 10/409,700
Filed: April 9, 2003
For: U.S. Patent No. 6,215,754

In re Vidal et al.
Reexamination Proceeding
Control No. 90/006,170
Filed: January 24, 2002
For: U.S. Patent No. 6,215,754

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. 6,215,754 issued to Vidal et al. on April 10, 2001.

2. On January 24, 2002, reexamination of the '754 patent was ordered at the initiative of the Director of the USPTO, and the resulting reexamination proceeding was assigned Control No. 90/006,170 (the '6170 reexamination proceeding).

3. Prosecution was carried out for the '6170 reexamination proceeding.

4. The patent owner filed a first reissue application based on the '754 patent, on April 9, 2003, which was assigned Application No. 10/409,700 (the '700 reissue application).

5. Notice of the filing of the '700 reissue application was published in the *Official Gazette* on July 8, 2003.

6. A decision merging the '6170 reexamination proceeding and the '700 reissue application was mailed April 1, 2004.

7. Prosecution has been carried out for the merged proceeding.

8. The patent owner filed a second reissue application based on the '754 patent, on November 24, 2004, which was assigned Application No. 10/996,329 (the '329 reissue application).

9. Notice of the filing of the '329 reissue application was published in the *Official Gazette* on January 18, 2005.

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 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 37 CFR 1.525 in the '6053 reexamination proceeding, a decision under 37 CFR 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 files of the merged proceeding for the '6170 reexamination and the '700 reissue application shows the presence of original patent claims 1-9, and new claims 85-92 and 107-113. Original claims 10-29, and new claims 30-84, 93-106, and 114-133 have been cancelled. The merged proceeding is awaiting the examiner's preparation of an Office action on the merits.

A review of the '329 reissue application file shows that original patent claims 1-9 and new claims 85-92 and 107-113 have been cancelled. Original claims 10-29, and new claims 30-84, 93-106, and 114-133 have been presented. The application is awaiting a first Office action on the merits by the examiner.

In order to provide efficient, consistent and prompt handling of all three proceedings, it is appropriate that the instant reissue applications and the reexamination proceeding be merged and a joint examination be conducted. Accordingly, the three proceedings will be merged, and examination of the merged proceeding will be conducted in accordance with the decision set forth immediately 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. No Requirement for Same Amendments and Same Paper Entry in All Files

Pursuant to 37 CFR 1.565(d):

> "Where merger of a reissue application and an *ex parte* reexamination proceeding is ordered,... the patent owner will be required to place and maintain the same claims in the reissue application and the *ex parte* reexamination proceeding during the pendency of the merged proceeding."

In the present instance, the above-identified reissue applications and reexamination proceeding are merged in accordance with 37 CFR 1.565(d), for the **purpose of joint examination only**. The two reissue applications contain separate sets of claims, as is appropriate under 37 CFR 1.177(b), and, accordingly, a requirement for patent owner to present the same claims in all three cases would be inappropriate. Thus, the requirement of 37 CFR 1.565(d) for patent owner to present and maintain the same claims in all three cases is hereby **waived**.

Pursuant to 37 CFR 1.565(d):

> "The examiner's actions and responses by the patent owner in a merged proceeding will apply to both the reissue application and the *ex parte* reexamination proceeding and be physically entered into both files."

As pointed out, the two reissue applications contain separate sets of claims, as is appropriate under 37 CFR 1.177(b). Accordingly, the issues in the examiner's actions and responses by the patent owner will differ for the two application. Therefore, the requirement for Office actions and responses to (1) apply to both the reissue application and the reexamination proceeding, and (2) be physically entered into both files, would be inappropriate. Thus, the requirement that the same Office actions and patent owner responses will be placed in all three cases is hereby **waived**

III. Requirement for Same Address in Both Proceedings

In the '6170 reexamination proceeding and the '700 reissue application, the applicant/patent owner's correspondence address is given as:

Mark A. Newman
Barnes & Thornburg
750 17th Street, N.W.
Suite 900
Washington DC 20006-4607

In the '329 reissue application, the applicant/patent owner's correspondence address is given as:

Seyfarth Shaw
55 East Monroe Street
Suite 4200
Chicago IL 60603-5803

An appropriate change of address is required within ONE (1) MONTH of this decision, providing the same patent owner correspondence address in all three cases.

Failure to comply with this requirement will result in the use of the Barnes & Thornburg address for the merged proceeding, as that is the address for the previously merged proceeding for the '6170 reexamination proceeding and the '700 reissue application.

IV. Conduct of the Merged Reissue and Reexamination Proceeding

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 for response should be set at TWO (2) months, in order to comply with the statutory requirement for special dispatch in an *ex parte* reexamination proceeding (35 U.S.C. 305).

Each proceeding will proceed **independently, but simultaneously**, within the merged proceeding, as follows:

1. A joint examination of the proceedings will be conducted, and the examiner will prepare separate Office actions for the two reissue applications. Any Office actions will be **mailed at the same time in both reissue applications**.

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 the reissue application to which the responses are addressed, but should also make reference to the other two cases of the merged proceeding.

4. In this instance, there is no third party requester, upon whom to serve copies of all responses and Office actions. See 37 CFR 1.550(f).

5. Due to the different claims in the 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 Office, nor any papers filed by patent owner, pertaining to the merged proceeding, will be made of record in the reexamination file at this time. This is so, even though all of the papers mailed/filed in the two reissue applications will constitute the merged proceeding. A copy of the present decision will, however, be placed in the reexamination file.

6. Due to the unique nature of these merged proceedings, all papers will be centrally processed in the Office by the Central Reexamination Unit (CRU). The reissue application files will be electronically linked to the reexamination proceeding file, as they constitute the merged proceeding.

If all claims are indicated to be allowable in one of the reissue applications, then all three files must be returned to the Office of Patent Legal Administration for reconsideration of the merger decision. At that time, the Office of Patent Legal Administration may consider suspending the allowable application, to await conclusion of the other proceedings, in order to permit the applications to issue simultaneously.

If the reissue applications ultimately mature into a reissue patent, the reexamination proceeding shall be concluded by the grant of the reissue patents, and the reissue patents taken together 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 in one of the reissue applications, that reissue application will be held abandoned. If the applicant/patent owner files an express abandonment in one of the reissue applications pursuant to 37 CFR 1.138, the next Office action of the examiner will accept the express abandonment. In either case, the other two proceedings will be forwarded to the Office of Patent Legal Administration for reconsideration/reconfiguration of the present merger decision, which will most likely result in dissolving the merger as to the abandoned reissue application, retaining the merger as to the other two proceedings, and reverting to the practice for a single-reissue/reexamination merger.

If the applicant/patent owner fails to file a timely and appropriate response to any Office action in both of the reissue applications, the two reissue applications will be held abandoned, and the merger will be dissolved. With respect to the reexamination proceeding, the Director of the USPTO 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. As to any further action in 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 could not 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 the applicant/patent owner files an express abandonment in both of the reissue applications pursuant to 37 CFR 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, and any new grounds of rejection which are applicable under reexamination would be made by the examiner upon dissolution of the merged proceeding. The existence of any questions/issues remaining which could not be considered under reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 CFR 1.552(c).

CONCLUSION

1. The above-identified reissue applications and reexamination proceeding, i.e., reissue applications 10/996,329 and 10/409,700 and reexamination 90/006,170, **ARE MERGED** into a single consolidated proceeding. A copy of this merger decision will be made of record in each of the **THREE** files.

2. The present decision **waives** the requirements of 37 CFR 1.565(d) for:

   (A) The patent owner to present and maintain the same claims in all three files of the merged proceeding, and

   (B) The same Office actions and patent owner responses to be placed in all three files.

3. Pursuant to Part III of this decision, an appropriate change of address is required within **ONE MONTH of this decision** providing the same patent owner correspondence address in all cases of the merged proceeding.

4. The merged proceeding is being forwarded to the Group Director of Technology Center 2600. After the receipt of an appropriate change of address as per part 2 of this conclusion, or the expiration of the one month time period for filing same, whichever comes first, the Technology Center will process the files to provide the same correspondence address for all the files as per part III of this decision. The merged proceeding will then be forwarded to the examiner to prepare Office actions on the merits for the present merged proceeding of the reissue applications and reexamination proceeding. **After the Office actions are prepared, the Office actions and the merged proceeding should be forwarded to the CRU for central processing and simultaneous mailing of the Office actions.** All further examination should be conducted in accordance with this decision.

5. If all claims are indicated to be allowable in one of the reissue applications, all three files **must be returned** to the Office of Patent Legal Administration for reconsideration of the merger decision, and consideration of possible suspension of the allowed application.

6. Telephone inquiries related to this decision should be directed to the undersigned, at (571) 272-7710.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

May 24, 2005
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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.
90/006,170	01/24/2002	6215754	38439-400100	4592

27717 7590 06/11/2010

SEYFARTH SHAW LLP
131 S. DEARBORN ST., SUITE 2400
CHICAGO, IL 60603-5803

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/11/2010

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
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.
10/409,700	04/09/2003	Joel Vidal	142.0001-01000	9196

22882 7590 06/14/2010
MARTIN & FERRARO, LLP
1557 LAKE O'PINES STREET, NE
HARTVILLE, OH 44632

EXAMINER
HINDI, NABIL Z

ART UNIT	PAPER NUMBER
2627	

MAIL DATE	DELIVERY MODE
06/14/2010	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

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/996,329	11/24/2004	Joel Vidal	142.0001-02000	7244

22882 7590 06/14/2010
MARTIN & FERRARO, LLP
1557 LAKE O'PINES STREET, NE
HARTVILLE, OH 44632

EXAMINER
HINDI, NABIL Z

ART UNIT	PAPER NUMBER
2627	

MAIL DATE	DELIVERY MODE
06/14/2010	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
www.uspto.gov

Gottlieb, Rackman & Reisman, P.C.
Associate Attorneys for Applicants
270 Madison Avenue
New York, NY 10016

(For Patent Owner)

MAILED

JUN 1 1 2010

CENTRAL REEXAMINATION UNIT

Martin & Ferraro, LLP
1557 Lake O'Pines Street, NE
Hartville, OH 44632

(For Patent Owner)
(First reissue)
(Second reissue)

Seyfarth Shaw LLP
131 S. Dearborn Street
Suite 2400
Chicago, IL 60603-5803

(Courtesy Copy)

In re reissue application of
Joel Vidal et al.
Application No. 10/409,700
Filed: April 9, 2003
For: U.S. Patent No. 6,215,754

In re reissue application of
Joel Vidal et al.
Application No. 10/996,329
Filed: November 24, 2004
For: U.S. Patent No. 6,215,754

In re Joel Vidal et al.
Reexamination Proceeding
Control No. 90/006,170
Filed: January 24, 2002
For: US. Patent No. 6,215,754

DECISION
***SUA SPONTE* SEVERING**
MERGER OF
REISSUE APPLICATIONS
AND *EX PARTE*
REEXAMINATION
PROCEEDING

The merged proceeding consisting of reissue application 10/409,700, reissue application 10/996,329, and *ex parte* reexamination proceeding 90/006,170 is before the Office of Patent Legal Administration for *sua sponte* consideration of whether the merged proceeding should be severed at this time.

BACKGROUND

1. U.S. Patent No. 6,215,754 ("the '754 patent") issued to Joel Vidal et al. on April 10, 2001.

2. On January 24, 2002, reexamination of the '754 patent was ordered at the initiative of the Director of the USPTO, and the resulting reexamination proceeding was assigned Control No. 90/006,170 ("the '6170 reexamination proceeding").
3. A non-final rejection action was mailed in the '6170 reexamination proceeding on June 12, 2002.
4. A response was filed in the '6170 reexamination proceeding on August 12, 2002, a second response was filed on October 15, 2002 (not entered), and a third response was filed on October 21, 2002.
5. A second action non-final rejection was mailed in the '6170 reexamination proceeding on February 14, 2003.
6. The patent owner filed a first reissue application based on the '754 patent on April 9, 2003, which was assigned Application No. 10/409,700 ("the '700 reissue application").
7. On June 11, 2003, a response to the February 14, 2003 non-final rejection action was filed in the '6170 reexamination proceeding.
8. Notice of the filing of the '700 reissue application was published in the *Official Gazette* on July 8, 2003.
9. A second response to the February 14, 2003 non-final rejection was filed in the '6170 reexamination proceeding on September 9, 2003 (not entered).
10. A decision merging the '6170 reexamination proceeding and the '700 reissue application was mailed April 1, 2004.
11. Prosecution and examination was carried out for the merged proceeding.
12. On November 24, 2004, the patent owner filed a second reissue application based on the '754 patent, which was assigned Application No. 10/996,329 ("the '329 reissue application").
13. Notice of the filing of the '329 reissue application was published in the *Official Gazette* on January 18, 2005.
14. A decision merging the '6170 reexamination proceeding and the '700 and '329 reissue applications was mailed May 26, 2005. The May 26, 2005 decision requires the patent owner to file responses in both reissue cases independently but simultaneously. The May 26, 2005 decision states that "the reexamination file will remain dormant."
15. Prosecution of the '700 reissue application proceeded, including a nonfinal Office action issued on April 11, 2006, followed by patent owner response filed on July 11, 2006. Prosecution of the '700 reissue application was closed in a final Office action issued on January 4, 2007, finally rejecting all pending claims, claims 1-9, 85-92, 107-113, and 134-135.
16. Prosecution of the '329 reissue application proceeded, including a nonfinal Office action issued on April 11, 2006, followed by patent owner's response filed on July 11, 2006. Prosecution of the '329 reissue application was closed in a final Office action issued on January 4, 2007, finally rejecting all pending claims, claims 10-84, 93-106, and 114-135.

17. Subsequent to the January 4, 2007 final Office action in the '700 reissue application, (i) patent owner filed a Notice of Appeal on April 9, 2007, (ii) patent owner filed an Appeal Brief on June 7, 2007, (iii) an Examiner's Answer issued June 24, 2008, and (iv) patent owner filed a Reply Brief on August 25, 2008.
18. Subsequent to the January 4, 2007 final Office action in the '329 reissue application, (i) patent owner filed a Notice of Appeal on April 9, 2007, (ii) patent owner filed an Appeal Brief on June 7, 2007, (iii) an Examiner's Answer issued July 1, 2008, and (iv) patent owner on August 25, 2008, filed a Replay Brief and an Amendment canceling claims 23-30, 126-131, and 135.
19. The Board of Patent Appeals and Interferences issued, on September 28, 2009, a Decision on Appeal affirming both the final rejection of claims 1-9, 85-92, 107-113, and 134-135 in the '700 reissue application and the final rejection of claims 10-22, 31-84, 93-106, 114-125, and 132-134 in the '329 reissue application.
20. On November 24, 2009, patent owner filed a Request for Continued Examination and an Amendment in the '700 reissue application.
21. On November 24, 2009, patent owner filed a Request for Continued Examination and an Amendment in the '329 reissue application.

RELEVANT LAW AND PROCEDURE

35 U.S.C. 305 Conduct of reexamination proceedings.

> . . . All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with **special dispatch** within the Office. (Emphasis added.)

37 CFR 1.103(e) provides:

> Notice of suspension on initiative of the Office. The Office will notify applicant if the Office suspends action by the Office on an application on its own initiative.

37 CFR 1.565(d) provides, in part:

> 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.

37 CFR 1.570(d) provides:

> 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.

MPEP § 1452 Request for Continued Examination of Reissue Application

> A request for continued examination (RCE) under 37 CFR 1.114 is available for a reissue application. Effective May 29, 2000, an applicant in a reissue application may file a request for continued examination of the reissue application, if the reissue application was filed on or after June 8, 1995. This applies even where the application, which resulted in the original patent, was filed before June 8, 1995. An RCE continues the prosecution of the existing reissue application and is not a filing of a new reissue application. Thus, the filing of an RCE will not be announced in the *Official Gazette*. Additionally, if a reissue application is merged with a reexamination proceeding (see MPEP § 1449.01), the filing of an RCE will not dissolve the merger, because the reissue application does not become abandoned. **The Office, however, may choose to dissolve the merger based on the individual facts and circumstances of the case, e.g., to promote the statutorily mandated requirement for special dispatch in reexamination**. (Emphasis added.)

MPEP § 2285 Copending *Ex Parte* Reexamination and Reissue Proceedings

> The general policy of the Office is that a reissue application examination and an *ex parte* reexamination proceeding will not be conducted separately at the same time as to a particular patent. The reason for this policy is to permit timely resolution of both proceedings to the extent possible and to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner. Accordingly, **if both a reissue application and an *ex parte* reexamination proceeding are pending concurrently on a patent, a decision will normally be made (A) to merge the two proceedings or (B) to stay one of the two proceedings.** See *In re Onda*, 229 USPQ 235 (Comm'r Pat. 1985). (Emphasis added.)

DECISION

Pursuant to 35 U.S.C. 305, a reexamination proceeding must be conducted with "special dispatch." The filing of RCEs delays the reexamination proceeding as to the resolution of the substantial new question of patentability raised by the reexamination request. Such delay in the Office is contrary to statutory mandate for special dispatch. Further, the filing of the RCEs is effective for the reissue applications, but not permitted for the reexamination proceeding. Accordingly, the proceedings of the merged proceeding are being severed to permit the reexamination proceeding to proceed to conclusion with special dispatch.

It is not appropriate to conduct the examination of the two reissue proceedings and the reexamination proceeding separately, and at the same time, for the '754 patent. The reason for this Office policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the multiple proceedings on behalf of the patent owner, and not providing complex requirements for separate concurrent prosecution of three proceedings. In this instance, separate and concurrent prosecution would involve undue complexities in coordinating the proceedings which clearly would run contrary to the special dispatch requirement of 35 U.S.C. 305, and would require re-work in each proceeding based on resulting outcomes of the other proceeding.

Since examination of the two reissue proceedings and reexamination proceeding will not be conducted separately and at the same time, and are no longer be merged, the two reissue proceedings are hereby suspended pursuant to 37 CFR 1.103(e) in favor of the reexamination proceeding.[1] Suspension of the '700 and '329 reissue applications shall remain in effect until the conclusion of the '6170 reexamination proceeding by the issuance and publication of the reexamination certificate. To the extent that 37 CFR 1.570(d) would preclude prosecution of the '700 and '329 reissue applications in the event that the prosecution in the '6170 proceeding results in cancellation of all claims of the '754 patent, it is noted that patent owner has filed each of the '700 and '329 reissue applications prior to publication of a reexamination certificate for the '754 patent. Therefore, patent owner would be entitled to file a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.570(d) to request that prosecution of the reissue applications could continue, even if a reexamination certificate should issue canceling all patent claims (and not adding any new claims to the patent).

Patent owner is given ONE (1) MONTH from this decision to revise the claims **as they appear in the '6170 reexamination proceeding** as patent owner deems appropriate in view of the differences in reexamination proceeding and the two reissue proceedings, by filing an amendment only in the reexamination proceeding. After that, a new Office action will be issued for the '6170 reexamination proceeding.

If broadened claims are present **in the '6170 reexamination proceeding**, they will be rejected under 35 U.S.C. 305, which prohibits broadened claims in reexamination. Any rejection directed to the reissue applications that does not apply in reexamination will be withdrawn in the new Office action issued in the reexamination proceeding. As pointed out above, prosecution of the '700 and '329 reissue applications is being suspended.

From this point on, papers (including this decision) will be placed in the reexamination proceeding. As to the time prior to this point, the reexamination proceeding incorporates by reference all of the papers previously placed in the two reissue proceedings that were filed during the time the proceedings were merged and not placed in the present reexamination proceeding.

PATENT OWNER'S ADDRESS

The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings, pursuant to 37 CFR 1.33(c). The current correspondence address of record for the 6,215,754 patent file is that of Gottlieb, Rackman & Reisman, P.C., Associate Attorneys for Applicants, 270 Madison Avenue, New York, NY 10016.

As a courtesy, this decision is being mailed to Seyfarth Shaw LLP, 131 S. Dearborn Street, Suite 2400, Chicago, IL 60603-5803, in view of the January 11, 2005 Power of Attorney in the file of the '6170 reexamination proceeding.

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[1] This is equitable, since it was the patent owner (the reissue applicant) who decided to file the two RCEs for the two reissue applications well after the reexamination request was filed.

The address of Gottlieb, Rackman & Reisman, P.C., Associate Attorneys for Applicants, 270 Madison Avenue, New York, NY 10016, will be the sole patent owner correspondence address used in future correspondence, until a change in correspondence address in the '754 patent file is made in accordance with 37 CFR 1.33(c).

CONCLUSION

1. The merged proceeding of reissue application No. 10/409,700, reissue application No. 10/996,329, and reexamination control No. 90/006,170 **is hereby severed**.

2. Prosecution of the 10/409,700 and 10/996,329 reissue applications is hereby suspended until the conclusion of the '6170 reexamination proceeding by the issuance and publication of a reexamination certificate.

3. **Patent owner is given ONE (1) MONTH from this decision to revise the claims as they appear in the '6170 reexamination proceeding as patent owner deems appropriate in view of the differences in reexamination proceeding and the two reissue proceedings, by filing an amendment only in the reexamination proceeding.**

4. After the issuance and publication of a reexamination certificate, patent owner may call up the '700 and '329 reissue applications for action, by notifying the Office of such completion. The patent owner may include an amendment of the claims of the '700 and '329 reissue applications at that time, if it is deemed appropriate based upon the results of the '6170 reexamination proceeding. In the event that the prosecution in the '6170 proceeding results in cancellation of all claims of the '754 patent, the patent owner would need to file a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.570(d) to request that prosecution of the '700 and '329 reissue applications continue (see discussion above).

5. Jurisdiction over the '6170 reexamination proceeding is transferred to the Central Reexamination Unit (CRU), since the CRU is now handling the majority of reexamination proceedings and has agreed to take jurisdiction over the reexamination proceeding. Jurisdiction over the '700 and '329 reissue applications is returned to Technology Center Art Unit 2627.

6. The address of Gottlieb, Rackman & Reisman, P.C., Associate Attorneys for Applicants, 270 Madison Avenue, New York, NY 10016, will be the sole patent owner correspondence address used in future correspondence, until a change in correspondence address in the '754 patent file is made in accordance with 37 CFR 1.33(c).

7. Telephone inquiries related to this decision should be directed to Raul Tamayo, Legal Advisor, at (571) 272-7728.

Kenneth M. Schor

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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mailed 2/06/04

FOLEY & LARDNER
3000 K ST. N.W.
SUITE 500
WASHINGTON DC 20007-5109

In re Reexamination Proceeding Morishita et al Control No.: 90/006,175 Filed: January 4, 2002 For Patent No.: 6,262,033	PETITION DECISION

This is in response to the petition under 37 CFR 1.181, filed January 23, 2004, to invoke the supervisory authority of the Commissioner in the above identified Reexamination Proceeding.

A review of the Proceeding shows that a Final Office action was mailed to Patent Owner on December 29, 2003, setting a two month shortened statutory period for reply. The Office action contained, *inter alia,* a reference to a power of attorney which had been submitted in the proceeding. As stated in the Office action the power is from someone other than the Patent Owner, possibly the Requester of the Reexamination. It was noted that the paper contained the signature of an individual who represents Cogentech. As Cogentech is not the Patent Owner according to Office records the power was not entered. In order to inform Patent Owner of this paper mention was made of it by the examiner on advice of the Special Program Examiner for TC 1600. No contact with Cogentech or its representatives, other than receipt of this paper, has occurred. It was also noted, though not expressed in the Office action, that a copy had not been served on all parties to the Reexamination.

The reference to the power was made so that if Patent Owner had submitted the power, patent owner would know that it had not been accepted because Office records do not indicate Cogentech as the Assignee/Patent Owner. Patent Owner could then submit appropriate forms to correct/update Office records and, if necessary, resubmit the power of attorney. Likewise, third party Requester is required to keep the Office informed of a current correspondence address and this may have been an attempt to do so. If so, Requester has now been informed that such submission was improper and can correct the submission. It is noted also that a Requester can at any time and without comment provide information regarding new or ongoing litigation or change of correspondence address. Thus some limited third party Requester papers are permitted entry in the file.

Patent Owner's petition requests that the Final Office action be stricken. Patent Owner has provided no good and sufficient reason for doing so. The mention of the unacceptable power of

attorney does not affect the merits of the examination process or the rejections set forth. Further, the relationship of Cogentech to Patent Owner was unknown until submission of this petiton. Such relationship has no bearing on the merits of examination. The examiner's reference to Cogentech was informational only and does not create any influence or prejudice, fair or unfair, to Patent Owner. In response to Patent Owner's question as to other improper papers having been filed, there have been none.

For Patent Owner's convenience a copy of the unacceptable power of attorney is included with this decision.

The petition is **DENIED**.

The time period for filing a reply to the Office action mailed December 29, 2003, remains as set therein. Extension of time may only be obtained under 37 CFR 1.136(b).

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number.

John Doll
Director, Technology Center 1600

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DEC 1 2 2003
OFFICIAL

HellerEhrman
ATTORNEYS

Facsimile Transmittal

275 Middlefield Road
Menlo Park, CA 94025-3506
Main (650) 324-7000
Fax (650) 324-0638

To:	Examiner Lacourciere, USPTO		
Telephone:	703/308-7523	**Fax:**	703/872-9306
From:	Ginger R. Dreger		
Telephone:	(650) 324-7115		
Direct Fax:	(650) 324-0638		
No. of Pages:	3 (including cover)		
Date:	December 12, 2003		

#19/Revoc. w/P.O.A (N.E)

39753.0013 (7041)
Atty not assigned to application

Message:

Re: Reexamination Control No. 90/006,175
Applicant: Morishita, et al.
Patent No.: 6,262,033
Patent Issue Date: July 17, 2001
Our Docket No.: 39753-0013

Enclosed in this facsimile are the following documents:

1. **Transmittal (1 page);**
2. **Revocation of Prior Powers of Attorney and Appointment of New Attorney of Record.**

The information contained in this communication is intended only for the use of the addressee and may be confidential, may be attorney-client privileged and may constitute inside information. Unauthorized use, disclosure or copying is strictly prohibited, and may be unlawful. If you have received this communication in error or you have not received all pages, please call the sender immediately at (650) 324-7000.

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DEC 1 2 2003
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Morishita, et al.	Docket No.:	39753-0013
Reexamination Control No..:	90/006,175	Group Art Unit:	1635
Patent No.	6,262,033	Examiner:	K. Lacourciere
Patent Issue Date:	July 17, 2001		
For:	**REMEDY FOR DISEASES ASSOCIATED WITH NF-κB**		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL

☒ Transmitted herewith are the following documents:

(1) Transmittal;

(2) Revocation of Prior Powers of Attorney and Appointment of New Attorneys of Record.

☒ The Commissioner is authorized to charge any required fees, or credit any overpayment to Deposit Account No. 08-1641.

☐ Attached is a postcard for date-stamped return as confirmation of receipt of these materials.

Respectfully submitted,

Date: December 12, 2003

Ginger R. Dreger
Reg. No. 33,055

HELLER EHRMAN WHITE & MCAULIFFE LLP
Customer No. 25213
275 Middlefield Road
Menlo Park, CA 94025
Telephone: (650) 324-7000
Facsimile: (650) 324-0638

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being forwarded via facsimile to Examiner Karen Lacourciere in Group No. 1635 at facsimile number (703) 872-9306 located at Commissioner for Patents, Washington, D.C. 20231 on December 12, 2003.

Date: December 12, 2003

Cheryl Ann Rogers

SV 472391 v1
12/12/03 11:27 AM (39753.0013)

UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Morishita, et al.	Docket No.:	39753-0013
Reexamination Control No..:	90/006,175	Group Art Unit:	1635
Patent No.	6,262,033	Examiner:	J. Schultz
Patent Issue Date:	July 17, 2001		
For:	**REMEDY FOR DISEASES ASSOCIATED WITH NF-κB**		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REVOCATION OF PRIOR POWERS OF ATTORNEY AND APPOINTMENT OF NEW ATTORNEYS OF RECORD

I hereby revoke all powers of attorney previously given, and appoint **HELLER EHRMAN WHITE & McAULIFFE, LLP** (Customer No. 25213) to prosecute and transact all business in the Patent and Trademark Office connected therewith.

Please send all correspondence in this matter to:

Ginger R. Dreger, Esq.
HELLER EHRMAN WHITE & MCAULIFFE, LLP
275 Middlefield Road
Menlo Park, CA 94025

and direct all telephone calls to Ginger R. Dreger at 650-324-7115 (fax 650-324-0638).

Corgentech, Inc.

Dated: 12/10/03

By: [signature]
Name: John McLaughlin, Esq.
Title: President & CEO

Assignee: Corgentech, Inc.
Address: 650 Gateway Boulevard
South San Francisco, CA 94080

mcw

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. 32

FOLEY & LARDNER
3000 K St., NW
Suite 500
Washington, D.C. 2007-5109

(For Patent Owner)

Paul T. Clark
CLARK & ELBING, LLP
176 Federal St.
Boston, MA 02112

(For Requester)

MAILED

NOV 03 2004

REEXAM UNIT

enclosure: courtesy copy of petition of 9/14/04

In re Morishita, et al.
Reexamination Proceeding
Control No. 90/006,175
Filed: January 4, 2002
For: U.S. Patent No. 6,262,033

DECISION GRANTING PETITION

This is a decision on the September 14, 2004, 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 $1330.00 pursuant to 37 C.F.R. § 1.17(m) for the petition under 37 C.F.R. § 1.137(b) was paid with the petition.

The petition for revival under 37 C.F.R. § 1.137(b) based upon unintentional delay is **granted** for the reasons indicated below.

DECISION

A grantable petition under 37 C.F.R. § 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed;

(2) the petition fee required by 37 C.F.R. § 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional.

Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 C.F.R. § 1.137(b) was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D).

The petition of September 14, 2004, includes items (1) through (3) above, i.e., a notice of appeal, notice of appeal fee, and 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 petition fee has been paid.

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 for revival under 37 C.F.R. § 1.137(b) based upon unintentional delay is **granted**.

It is noted that while a certificate of service was included with the instant petition, the party that was served is not the third party requester of record. Accordingly, a courtesy copy of the petition is being sent to the third party requester, along with a copy of the petition decision.

It is also noted that a petition for an extension of time was filed on October 21, 2004, requesting a 2 month extension of time to file an appeal brief. However, such request for an extension of time is moot in view of the instant petition decision, which sets a time period of 2 months from the mailing date of this decision for patent owner to file the appeal brief.

CONCLUSION

1. The petition for revival under 37 C.F.R. § 1.137(b) based upon unintentional delay is **granted**.

2. The request for an extension of time to file the appeal brief is moot in view of the instant petition decision.

3. The appeal brief is due within 2 months of the mailing date of this petition decision, and should be directed to the attention of the Primary Examiner, Karen A. Lacourciere, in Group Art Unit 1635.

4. The reexamination file will be forwarded to Technology Center 1600 to await receipt of the appeal brief.

5. A courtesy copy of the petition of September 14, 2004, is being sent to the third party requester, along with a copy of the petition decision.

6. 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

November 2, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Mailed: January 4, 2005

FOLEY & LARDNER
3000 K St. N.W.
Suite 500
Washington DC 20007-5109

In re Ryuichi Morishita et al.
Reexamination Proceeding
Control No.: 90/006,175
Filed: January 4, 2002
For: U.S.Patent No. 6,262,033

: DECISION ON
: REQUEST FOR
: EXTENSION OF TIME

This is a decision on Patent Owner's Request for a one-month Extension of Time filed on December 30, 2004. Patent Owner states that there is sufficient cause to justify the extension of time in order to allow the examiner a sufficient amount of time to decide whether or not to enter the amendment after final of December 23, 2004. Entry of this amendment would simplify the issues remaining for appeal or render the appeal unnecessary.

The Request is **GRANTED** for one month.

Patent Owner's reply to the Decision Granting Petition for Revival mailed November 3, 2004 to file the Brief on Appeal is extended by one-month from November 3, 2004 to February 3, 2005.

Marianne C. Seidel for

Jasemine C. Chambers
Director, Technology Center 1600

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20060911

DATE : September 11, 2006

TO SPE OF : ART UNIT 3753

SUBJECT : Request for Certificate of Correction on Patent No.: 5730418

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

Please complete this form and return with file, within **7** days to:
Certificates of Correction Branch - PK 3-910
Palm location **7590** - Tel. No. 305-8201

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

Thank You For Your Assistance **Certificates of Correction Branch**

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

☐ **Approved** **All** changes apply.

☒ **Approved in Part** Specify below which changes **do not** apply.

☐ **Denied** State the reasons for denial below.

Comments:

The dependency of claim 58 should not be changed. It is not an office error and would change the scope of the claims.

Eric Keasel

SPE: Eric Keasel **Art Unit** 3753

PTO/SB/44 (04-05)
Approved for use through 04/30/2007. OMB 0651-0033
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.
(Also Form PTO-1050)

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT NO. : 5,730,418 C1

APPLICATION NO.: 90/006,177

ISSUE DATE : April 11, 2006

INVENTOR(S) : Feith et al.

It is certified that an error appears or errors appear in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

Column 8, line 27, remove the comma between "A self-flushing connector" and "comprising"
Column 9, line 3, "claim 56" should read --claim 55--
Column 10, line 11, insert the word --out-- between "valve outlet port" and "of the self-flushing connector"
Column 10, line 48, insert the word --the-- between "is removed from" and "valve inlet port"

MAILING ADDRESS OF SENDER (Please do not use customer number below):

Arne M. Olson (Reg. No. 30,203)
OLSON & HIERL, LTD.
20 N. Wacker Drive, 36th Floor, Chicago, IL 60606-3113

This collection of information is required by 37 CFR 1.322, 1.323, and 1.324. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Attention Certificate of Corrections Branch, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

MAY 25 2006

SCAN! **Please forward case and paper to address shown below.**

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 11/27/07

TO SPE OF : ART UNIT 3753 Eric Keasel (Spe)

SUBJECT : Request for Certificate of Correction for Appl. No.: 90/006177 Patent No.: 5730418

Please respond to this request for a certificate of correction within 7 days.

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (CofC)
South Tower - 9A22
Palm Location 7580

Claim 58 will it still change the scope of the claims! please respond Thanks

HENRY RANDALL
Certificates of Correction Branch
703-308-9390 ext. _____

Thank You For Your Assistance

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

- ☐ Approved — All changes apply.
- ☒ Approved in Part — Specify below which changes do not apply.
- ☐ Denied — State the reasons for denial below.

Comments: Yes, changing the dependency of claim 58 changes the scope of the claims. The other three changes are proper. Please note, this is a certificate of Correction for the Reexam Certificate.

Eric Keasel 3992
SPE Art Unit

PTO/SB/44 (04-05)
Approved for use through 04/30/2007. OMB 0651-0033
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.
(Also Form PTO-1050)

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT NO. : 5,730,418 C1

APPLICATION NO.: 90/006,177

ISSUE DATE : April 11, 2006

INVENTOR(S) : Feith et al.

It is certified that an error appears or errors appear in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

Column 8, line 27, remove the comma between "A self-flushing connector" and "comprising"
~~Column 9, line 3, "claim 56" should read --claim 55--~~
Column 10, line 11, insert the word --out-- between "valve outlet port" and "of the self-flushing connector"
Column 10, line 48, insert the word --the-- between "is removed from" and "valve inlet port"

MAILING ADDRESS OF SENDER (Please do not use customer number below):

Arne M. Olson (Reg. No. 30,203)
OLSON & HIERL, LTD.
20 N. Wacker Drive, 36th Floor, Chicago, IL 60606-3113

This collection of information is required by 37 CFR 1.322, 1.323, and 1.324. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: **Attention Certificate of Corrections Branch, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

MAY 25 2006

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20060911

DATE : September 11, 2006

TO SPE OF : ART UNIT 3753

SUBJECT : Request for Certificate of Correction on Patent No.: 5730418

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

Please complete this form and return with file, within **7** days to:
Certificates of Correction Branch - PK 3-910
Palm location **7590** - Tel. No. 305-8201

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

Thank You For Your Assistance **Certificates of Correction Branch**

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

☐ **Approved** All changes apply.

☒ **Approved in Part** Specify below which changes **do not** apply.

☐ **Denied** State the reasons for denial below.

Comments:

The dependency of claim 58 should not be changed. It is not an office error and would change the scope of the claims.

Eric Keasel

SPE: Eric Keasel **Art Unit** 3753

PTOL-306 (Rev. 7/03) U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 10

Edgar E. Spielman, Jr.
Albemarle Corporation
Law Department
451 Florida Street
Baton Rouge, LA 70801-1765

(For Patent Owner)

MAILED

NOV 2 6 2002

REEXAM UNIT

In re Sanders, et al.
Reexamination Proceeding
Control No. 90/006,183
Filed: January 9, 2002
For: U.S. Patent No. 6,303,038

DECISION GRANTING PETITION

This is a decision on the October 25, 2002, patent owner petition for entry of belated papers filed under 37 C.F.R. § 1.137(b), based upon unintentional delay. The petition is before the Office of Patent Legal Administration for decision.

A petition for entry of belated papers filed under 37 C.F.R. § 1.137(b), requires a fee under 37 C.F.R. § 1.17(m) of $1280.00. The instant petition was accompanied by a credit card payment authorization for the petition fee, which has been charged as per petitioner's instructions on page 1 of the instant petition.

The petition for revival under 37 C.F.R. § 1.137(b) based upon unintentional delay is **granted** for the reasons indicated below.

DECISION

A grantable petition under 37 C.F.R. § 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed;

(2) the petition fee required by 37 C.F.R. § 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional.

Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 C.F.R. § 1.137(b) was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D).

The required reply to the outstanding final Office action of July 19, 2002, in the form of a response to the non-final rejection, accompanied the present petition. As discussed above, the petition fee required by 37 C.F.R. § 1.17(m) was charged to a credit card, as per petitioner's instructions on page 1 of the instant petition. The instant petition includes the statement of item (3) above, specifically, 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 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 non-final Office action of July 19, 2002.

3. Further inquiries with regard to this reexamination proceeding should be directed to the examiner, Peter Hruskoci, of Group Art Unit 1724.

4. 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 26, 2002

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. 25
Mailed: February 11, 2004

JONES DAY
222 EAST 41ST STREET
NEW YORK NY 10017

In re Gelfand et al Reexamination Proceeding Control No.: 90/006,184 Filed: January 10, 2002 For: U.S.Patent No. 4,889,818	DECISION MERGING REEXAMINATION PROCEEDINGS
In re Gelfand et al Reexamination Proceeding Control No.: 90/006,805 Filed: October 9, 2003 For: U.S.Patent No. 4,889,818	

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. 4,889,818 issued December 26, 1989.

2. A first request for reexamination, Control No. 90/006,184, was filed by patent owner on January 10, 2002.

3. Reexamination was ordered in the '184 reexamination proceeding on April 4, 2002.

4. A second request for reexamination, Control No. 90/006,805, was filed by patent owner on October 9, 2003.

5. Reexamination was ordered in the '805 reexamination proceeding on December 22, 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 both of the above noted reexamination proceedings. Accordingly, merger of the proceedings under 37 CFR 1.565(c) is appropriate.

DECISION

Merger of Proceedings.

In accordance with 37 CFR 1.565(c), the '184 and '805 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

Requirement for Same Amendments in Both Proceedings.

Patent Owner is required to maintain the same claims and specification in both files.

Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the Patent Owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the Patent Owner must consist of a single response, filed in duplicate, each bearing an original signature, for entry in each file.

CONCLUSION

Reexamination Control Nos. 90/006,184 and 90/006,805 are merged.

Bruce M. Kisliuk
Director, Technology Center 1600

mar

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

Philip R. Warn (For Patent Owner)
WARN, BURGESS & HOFFMAN, P.C.
P.O. BOX 70098
Rochester Hills, MI 48307

John H. Mion (For Requester)
SUGHRUE MION PLLC
Suite 800
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3213

MAILED
AUG 12 2003
REEXAM UNIT

In re reissue application of
Zimmermann, et al.,
Application No. 10/214,511
Filed: December 26, 2002
For: U.S. Patent No. 6,099,153

In re Zimmermann, et al.,
Reexamination Proceeding
Control No. 90/006,187
Filed: January 11, 2002
For: U.S. Patent No. 6,099,153

DECISION *SUA SPONTE* MERGING REEXAMINATION AND REISSUE PROCEEDINGS

The above-identified reissue application and reexamination proceeding are before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged at this time.

REVIEW OF FACTS

1. U.S. Patent No. 6,099,153 issued to Zimmermann, et al., on August 8, 2000.

2. A request for reexamination of the '153 patent was filed by a third party requester on January 11, 2002, and the resulting reexamination proceeding was assigned Control No. 90/006,187.

3. On April 4, 2002, reexamination was ordered in the '6187 proceeding.

4. Patent owner filed a reissue application based on the '153 patent, on August 8, 2002, which was assigned Application No. 10/214,511, and a filing date of December 26, 2002. Claims 15-217 were added.

5. Notice of the filing of the reissue application was published in the *Official Gazette* on October 22, 2002.

6. On February 12, 2003, a non-final Office action was mailed in the reexamination proceeding.

7. A response to the Office action was filed in the reexamination proceeding on April 14, 2003. No claim has been amended or added in the reexamination 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 '6187 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 '6187 reexamination file shows that no amendments were made in the reexamination file.

A review of the reissue (Application No. 10/214,511) prosecution history shows that the reissue application was published in the *Official Gazette* on October 22, 2002. In the reissue application, patent owner has added claims 15-217. Therefore, the claims are **not** identical in both proceedings. In order to provide efficient and prompt handling of both proceedings, and to prevent inconsistent and possibly conflicting amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexamination proceeding will be conducted in accordance with the decision set forth below.

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-identified reissue and reexamination proceedings are merged. A joint examination will be conducted in accordance with the guidelines and requirements which follow.

II. Requirement for Same Amendments in Both Proceedings

The patent owner is required to maintain identical amendments in the reissue application and the reexamination file for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the proceedings remain merged. See 37 C.F.R. § 1.565(d). As noted above with regard to the amendments submitted, the claims are NOT the same in both files. **An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both cases**, specifically, Application No. 10/214,511, and Control Number 90/006,187. The response to the requirement must be limited to placing the same amendments in both cases, and patent owner must **not** address the issues of either of the proceedings in the housekeeping amendment. The housekeeping amendment should be submitted as a single paper, including the identifying data for both files (*i.e*, the reissue Application No. and the reexamination proceeding Control No.) and a signature, and should be filed in duplicate for entry into each of the reissue and reexamination files. **The amendment must be in compliance with 37 C.F.R. § 1.173.** Note that a "clean copy" of the amendment is **not** required by this rule. **Note that amendment practice pursuant to 37 C.F.R. § 1.121 does not apply to reissue applications, as specifically indicated in 37 C.F.R. § 1.121(a) and (h).**

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, and containing identifying data for both of the cases (*i.e*, the reissue Application No. and the reexamination proceeding Control No.).

If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be terminated by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 C.F.R. § 1.570. See MPEP 2285.

If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated as follows. The reissue application will be held abandoned, and the merger will be dissolved. With respect to the reexamination proceeding, the Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office, unless further action is clearly needed as a result of the difference in rules relating to reexamination and reissue proceedings.

If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 C.F.R. § 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue examination as to the reexamination proceeding. Any grounds of rejection which are not applicable under reexamination would be withdrawn (*e.g.*, based on public use or sale), and any new grounds of rejection which are applicable under reexamination (*e.g.*, improperly broadened claims) would be made by the examiner upon dissolution of the merged proceeding. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 C.F.R. § 1.552(c).

CONCLUSION

1. The 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

2800. 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. 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 both files will result in the Office's rejection of any claim that does not contain identical text in both merged proceedings under 35 U.S.C. § 112, second paragraph, as being indefinite as to the content of the claim, and therefore failing to particularly point out the invention.

6. All further examination should be conducted in accordance with Parts II and III of this decision.

7. 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

August 8, 2003

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.
10/214,511	12/26/2002	Werner Zimmerman	

PATENT NUMBER	DATE OF THIS NOTICE	PAPER NUMBER
6,099,153	08/12/2003	15

NOTICE OF MERGED REEXAM - REISSUE PROCEEDING

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

Control No. 90/006,187 Filing Date: 01/11/2002

Requester (name, address)
John H. Mion
SHUGRUE MION PLLC
2100 Pennsylvania Avenue NW
Suite 800
Washington DC 20037-3213

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

REEXAMINATION RESULTS

The questions raised in reexamination request No. 90/006,187, filed 01/11/2002, have been considered and the results thereof are reflected in this reissue patent which constitutes the reexamination certificate required by 35 U.S.C. 307 as provided in 37 CFR 1.570(e).

FORM PTO-1527
(3-84)

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Paper no. 17

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2200 Ross Ave.
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(For Patent Owner)

MAILED

FEB 14 2005

REEXAM UNIT

In re Perry et al.
Reexamination Proceeding
Control No. 90/006,192
Filed: January 14, 2002
For: U.S. Patent No. 6,160,621

In re reissue application of
Perry et al.
Application No. 10/603,740
Filed: June 26, 2003
For: U.S. Patent No. 6,160,621

DECISION MERGING REEXAMINATION AND REISSUE PROCEEDINGS

The above-identified reissue application and reexamination proceeding are before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged at this time.

REVIEW OF FACTS

1. U.S. Patent No. 6,160,621 issued to Perry, et al., on December 12, 2000.

2. Reexamination of the '621 patent was requested by the patent owner on January 24, 2002, and the resulting reexamination proceeding was assigned Control No. 90/006,192.

3. Reexamination was ordered in the '6192 proceeding on March 29, 2002.

4. A non-final rejection was mailed in the '6192 proceeding on October 25, 2002.

5. On January 2, 2003, a response was filed in the '6192 proceeding, which amended claims 1-21.

6. A second non-final rejection was mailed in the '6192 proceeding on May 14, 2003.

7. Patent owner filed a reissue application based on the '621 patent, on June 26, 2003, which was assigned Application No. 10/603,740. Claims 1-2, 11-12 and 21-22 were cancelled and claims 3-6, 8-10, 13-16, 18-20, 23-26 and 28-31 were amended.

8. On July 10, 2003, a response was filed in the '6192 proceeding, and a supplemental response was filed on July 25, 2003.

9. Notice of the filing of the reissue application was published in the *Official Gazette* on September 30, 2003.

DISCUSSION REGARDING MERGER

Under 37 C.F.R. § 1.565(d):

> (d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings

or to suspend one of the two proceedings....

As evidenced by the above review of facts, the reissue application and the reexamination proceeding are currently pending. Since the Order has been mailed pursuant to § 1.525 in the '6192 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 '6192 reexamination file shows that in the amendment of January 2, 2003, claims 1-21 were amended.

A review of the reissue (Application No. 10/603,740) prosecution history shows that the reissue application was published in the *Official Gazette* on September 30, 2003. In the reissue application, patent owner has cancelled claims 1-2, 11-12 and 21-22 and amended claims 3-6, 8-10, 13-16, 18-20, 23-26 and 28-31. Therefore, the claims are **not** identical in both proceedings.

In order to provide efficient and prompt handling of both proceedings, and to prevent inconsistent and possibly conflicting amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexamination proceeding will be conducted in accordance with the decision set forth below.

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-identified reissue and reexamination proceedings are merged. A joint examination will be conducted in accordance with the guidelines and requirements which follow.

II. Requirement for Same Amendments in Both Proceedings

The patent owner is required to maintain identical amendments in the reissue application and the reexamination file for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the proceedings remain merged. See 37 C.F.R. § 1.565(d). As noted above with regard to the amendments submitted, the claims are NOT the same in both files. **An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both cases**, specifically, Application No. 10/603,740, and Control Number 90/006,192. The response to the requirement must be limited to placing the same amendments in both cases, and patent owner must **not** address the issues of either of the proceedings in the housekeeping amendment. The housekeeping amendment should be submitted as a single paper, including the identifying data for both files (*i.e,* the reissue Application No. and the reexamination proceeding Control No.) and a signature, and should be filed in duplicate for entry into each of the reissue and reexamination files.

It should be noted that the housekeeping amendment for the merged proceeding should be provided in the proper format for reissue applications. **Amendments in a reissue application must be in compliance with 37 C.F.R. § 1.173,** therefore all amended claims should contain bracketing and underlining with regard to the original patent text pursuant to 37 C.F.R. § 1.173(b)(2), (d) and (g) and all new claims must be completely underlined pursuant to 37 C.F.R. § 1.173(b)(2) and (d)(2). Please be aware that a "clean copy" of the amendment is **not** required by this rule. **Note that amendment practice pursuant to 37 C.F.R. § 1.121 does not apply to reissue applications, as specifically indicated in 37 C.F.R. § 1.121(a) and (i), and therefore "Revised Amendment Practice" does not apply to reissue applications.** Therefore, the required housekeeping amendment must be in compliance with 37 C.F.R. § 1.173, *e.g.*, all amended claims should contain bracketing and underlining with regard to the original patent text pursuant to 37 C.F.R. § 1.173(b)(2), (d) and (g).

III. Conduct of the Merged Reissue and Reexamination Proceedings

Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application, examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding.

Each Office action issued by the examiner will take the form of a *single action* which jointly applies to the reissue application and the reexamination proceeding. Each action will contain identifying data *for both of the cases*, *i.e*, the reissue application and the reexamination proceeding. Each action will be entered into both files (which will be maintained as separate files).

Any response by the applicant/patent owner must consist of a single response, with **two copies being filed** for entry in both files, with each of the two copies bearing a signature, and containing identifying data for both of the cases (*i.e,* the reissue Application No. and the reexamination proceeding Control No.).

If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be terminated by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 C.F.R. § 1.570. See MPEP 2285.

If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated as follows. The reissue application will be held abandoned, and the merger will be dissolved. With respect to the reexamination proceeding, the Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office, unless further action is clearly needed as a result of the difference in rules relating to reexamination and reissue proceedings.

If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 C.F.R. § 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue examination as to the reexamination proceeding. Any grounds of rejection which are not applicable under reexamination would be withdrawn (*e.g.,* based on public use or sale), and any new grounds of rejection which are applicable under reexamination (*e.g.,* improperly broadened claims) would be made by the examiner upon dissolution of the merged proceeding. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 C.F.R. § 1.552(c).

If applicant/patent owner files a Request for Continued Examination (RCE) of the reissue application under 37 C.F.R. § 1.114, the reissue application is not considered to be expressly abandoned; rather the finality of the Office action is withdrawn, and the merged proceeding will continue. This is so, because an RCE is not an abandonment of any application, whether it be a reissue application or a non-reissue application.

CONCLUSION

1. The above-identified reissue application and reexamination 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 2800. All further examination should be conducted in accordance with this decision.

3. Pursuant to Part II of this decision, a housekeeping amendment is required **within ONE (1) MONTH of this decision**, placing the same amendments in both cases of the present merged proceeding, which amendment must be in compliance with 37 C.F.R. § 1.173.

4. The examiner should issue an Office action for the present merged proceeding of the reissue application and reexamination proceeding **after** the earlier of:

   (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. 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 both files will result in the Office's rejection of any claim that does not contain identical text in both merged proceedings under 35 U.S.C. § 112, second paragraph, as being indefinite as to the content of the claim, and therefore failing to particularly point out the invention.

6. All further examination should be conducted in accordance with Parts II and III of this decision.

7. 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

February 9, 2005

Paper no. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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1800 Avenue of the Stars
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Los Angeles, CA 90067

(For Patent Owner)

MAILED

FEB 23 2005

REEXAM UNIT

In re Orbach	:	
Reexamination Proceeding	:	**DECISION**
Control No. 90/006,197	:	**GRANTING**
Filed: January 17, 2002	:	**PETITION**
For: U.S. Patent No. 4,949,257	:	
	:	

This is a decision on the April 27, 2004, 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 paid by check with the instant petition.

The petition for revival under 37 C.F.R. § 1.137(b) based upon unintentional delay is **granted** for the reasons indicated below.

DECISION

A grantable petition under 37 C.F.R. § 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed;

(2) the petition fee required by 37 C.F.R. § 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional.

Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 C.F.R. § 1.137(b) was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(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, and was accompanied by an appeal brief filed in triplicate and the appeal brief fee, which meets 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).

The petition is **granted**.

It is noted that a reissue application for U.S. Patent No. 4,949,257 was filed on September 22, 2003, and was assigned application no. 10/668,094. Although this reissue application was originally determined to be incomplete, it is noted that as of October 8, 2004, the reissue application is now complete and therefore ready for examination. Accordingly, the instant reexamination proceeding 90/006,197 and the reissue application no. 10/668,094 are ready for consideration of merger of proceedings by the Office of Patent Legal Administration (OPLA).

CONCLUSION

1. The petition is **granted**.

2. The reexamination file will remain in the Office of Patent Legal Administration (OPLA) for consideration of merger of proceedings with reissue application no. 10/668,094.

3. The reexamination file will be returned to Technology Center 3600 in due course for preparation of the next appropriate Office action.

4. Any inquiries with regard to the merits of this proceeding should be directed to Examiner Andrew Fischer, of Group Art Unit 3627.

5. 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

February 22, 2005

Paper no. 20
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Kenneth Weatherwax
IRELL & MANELLA, LLP
1800 Avenue of the Stars
Suite 900
Los Angeles, CA 90067

(For Patent Owner)

MAILED

MAR 25 2005

REEXAM UNIT

In re Orbach
Reexamination Proceeding
Control No. 90/006,197
Filed: January 17, 2002
For: U.S. Patent No. 4,949,257

In re reissue application of
Orbach
Application No. 10/668,094
Filed: September 22, 2003
For: U.S. Patent No. 4,949,257

DECISION MERGING REEXAMINATION AND REISSUE PROCEEDINGS

The above-identified reissue application and reexamination proceeding are before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged at this time.

REVIEW OF FACTS

1. U.S. Patent No. 4,949,257 issued to Orbach, on August 14, 1990.

2. Reexamination of the '257 patent was requested by the patent owner on January 17, 2002, and the resulting reexamination proceeding was assigned Control No. 90/006,197.

3. Reexamination was ordered in the '6197 proceeding on March 11, 2002.

4. On May 16, 2002, a patent owner's statement was filed in which new claims 19-54 were added.

5. A non-final rejection was mailed in the '6197 proceeding on October 30, 2002.

6. On January 2, 2003, a response was filed in the '6197 proceeding.

7. A final rejection was mailed in the '6197 proceeding on March 24, 2003.

8. On June 2, 2003, a proposed amendment of claim 1 was filed in the '6197 proceeding in response to the final rejection.

9. An advisory action was mailed on August 18, 2003, in the '6197 proceeding, advising the patent owner that the proposed amendment in response to the final rejection was not entered.

10. Patent owner filed a reissue application based on the '257 patent, on September 22, 2003, which was assigned Application No. 10/668,094. The specification was amended in Col. 2; claims 1, 2, 9, 14 and 16-18 were amended; and new claims 19-75 were added.

11. On September 23, 2003, a Notice of Appeal was filed in the '6197 proceeding

12. On September 29, 2003, a proposed amendment of claims 1, 2, 9, 14-20, 27, 32-38, 45 and 50-54 was filed in the '6197 proceeding in response to the final rejection.

13. A Notice of Incomplete Application was mailed in the '094 reissue application on December 1, 2003.

14. An advisory action was mailed in the '6197 proceeding on December 18, 2003, advising the patent owner that the second proposed amendment in response to the final rejection was not entered.

15. On April 27, 2004, a petition to revive the '6197 proceeding was filed, and was accompanied by an Appeal Brief.

16. A response to the Notice of Incomplete Application was filed on July 6, 2004, and the reissue application was found to be complete.

17. Notice of the filing of the '094 reissue application was published in the *Official Gazette* on October 5, 2004.

18. A decision granting the petition to revive was mailed in the '6197 proceeding on February 23, 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 suspend one of the two proceedings....

As evidenced by the above review of facts, the reissue application and the reexamination proceeding are currently pending. Since the Order has been mailed pursuant to § 1.525 in the '6197 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 '6197 reexamination file shows that in the amendment of May 16, 2002, new claims 19-54 were added.

A review of the reissue (Application No. 10/668,094) prosecution history shows that the reissue application was published in the *Official Gazette* on October 5, 2004. In the reissue application, patent owner has amended the specification at Col. 2; amended claims 1, 2, 9, 14 and 16-18; and added claims 19-75. Therefore, the specification and claims are **not** identical in both proceedings.

In order to provide efficient and prompt handling of both proceedings, and to prevent inconsistent and possibly conflicting amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexamination proceeding will be conducted in accordance with the decision set forth below.

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-identified reissue and reexamination proceedings are merged. A joint examination will be conducted in accordance with the guidelines and requirements which follow.

II. Requirement for Same Amendments in Both Proceedings

The patent owner is required to maintain identical amendments in the reissue application and the reexamination file for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the proceedings remain merged. See 37 C.F.R. § 1.565(d). As noted above with regard to the amendments submitted, the claims are NOT the same in both files. **An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both cases**, specifically, Application No. 10/668,094, and Control Number 90/006,197. The response to the requirement must be limited to placing the same amendments in both cases, and patent owner must **not** address the issues of either of the proceedings in the housekeeping amendment. The housekeeping amendment should be submitted as a single paper, including the identifying data for both files (*i.e*, the reissue Application No. and the reexamination proceeding Control No.) and a signature, and should be filed in duplicate for entry into each of the reissue and reexamination files.

It should be noted that the housekeeping amendment for the merged proceeding should be provided in the proper format for reissue applications. **Amendments in a reissue application must be in compliance with 37 C.F.R. § 1.173,** therefore all amended claims should contain bracketing and underlining with regard to the original patent text pursuant to 37 C.F.R. § 1.173(b)(2), (d) and (g) and all new claims must be completely underlined pursuant to 37 C.F.R. § 1.173(b)(2) and (d)(2). Please be aware that a "clean copy" of the amendment is **not** required by this rule. **Note that amendment practice pursuant to 37 C.F.R. § 1.121 does not apply to reissue applications, as specifically indicated in 37 C.F.R. § 1.121(a) and (i), and therefore "Revised Amendment Practice" does not apply to reissue applications.** Therefore, the required housekeeping amendment must be in compliance with 37 C.F.R. § 1.173, *e.g.*, all amended claims should contain bracketing and underlining with regard to the original patent text pursuant to 37 C.F.R. § 1.173(b)(2), (d) and (g).

III. Conduct of the Merged Reissue and Reexamination Proceedings

Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to

35 U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application, examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding.

Each Office action issued by the examiner will take the form of a *single action* which jointly applies to the reissue application and the reexamination proceeding. Each action will contain identifying data *for both of the cases, i.e,* the reissue application and the reexamination proceeding. Each action will be entered into both files (which will be maintained as separate files).

Any response by the applicant/patent owner must consist of a single response, with **two copies being filed** for entry in both files, with each of the two copies bearing a signature, and containing identifying data for <u>both</u> of the cases (*i.e,* the reissue Application No. and the reexamination proceeding Control No.).

If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be terminated by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 C.F.R. § 1.570. See MPEP 2285.

If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated as follows. The reissue application will be held abandoned, and the merger will be dissolved. With respect to the reexamination proceeding, the Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office, unless further action is clearly needed as a result of the difference in rules relating to reexamination and reissue proceedings.

If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 C.F.R. § 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue examination as to the reexamination proceeding. Any grounds of rejection which are not applicable under reexamination would be withdrawn (*e.g.,* based on public use or sale), and any new grounds of rejection which are applicable under reexamination (*e.g.,* improperly broadened claims) would be made by the examiner upon dissolution of the merged proceeding. The existence of any questions/issues remaining which cannot be considered under

reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 C.F.R. § 1.552(c).

If applicant/patent owner files a Request for Continued Examination (RCE) of the reissue application under 37 C.F.R. § 1.114, the reissue application is not considered to be expressly abandoned; rather the finality of the Office action is withdrawn, and the merged proceeding will continue. This is so, because an RCE is not an abandonment of any application, whether it be a reissue application or a non-reissue application.

CONCLUSION

1. The above-identified reissue application and reexamination 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 3600. All further examination should be conducted in accordance with this decision.

3. Pursuant to Part II of this decision, a housekeeping amendment is required **within ONE (1) MONTH of this decision**, placing the same amendments in both cases of the present merged proceeding, which amendment must be in compliance with 37 C.F.R. § 1.173.

4. The examiner should withdraw the finality of the previous Office action in the reexamination proceeding, and issue an Office action for the present merged proceeding of the reissue application and reexamination proceeding **after** the earlier of the following events have occurred:

   (a) the submission of the housekeeping amendment to place the same amendments in both cases; or

   (b) the expiration of the ONE (1) month period from the mailing of this decision for filing the amendment.

5. It should be noted that failure to submit an appropriate "housekeeping amendment" **within <u>one month</u> of this decision** placing the same amendments in both files will result in the

Office's rejection of any claim that does not contain identical text in both merged proceedings under 35 U.S.C. § 112, second paragraph, as being indefinite as to the content of the claim, and therefore failing to particularly point out the invention.

6. All further examination should be conducted in accordance with Parts II and III of this decision.

7. 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 23, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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MAR 28 2005

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Jones Tullar & Cooper, P.C. (For Requester)
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In re Pixl Golf Company
Reexamination Proceeding :
Control No. 90/006,198 : DECISION ON PETITION
Filed: January 24, 2002 :
For: U.S. Patent No. 5,807,190 :

The above noted *ex parte* reexamination proceedings are before the Director of Technology Center 3700 for consideration of the petition filed by Patent Owner (Owner) on February 3, 2005 by which Owner requests supervisory review of the examiner's holding that the Supplemental Appeal Brief filed on July 27, 2004 does not comply with the regulations governing the filing of an appeal brief. No fee is required for the petition.

The petition is granted.

A review of the file history shows that the examiner held the Supplemental Appeal Brief to be non-compliant with 37 CFR 1.192(c)(7). This regulation was superceded by 37 CFR 41.37, effective September 13, 2004. While it would appear on its face that an appeal brief filed prior to September 13, 2004 would be governed by the requirements of 37 CFR 1.192, the regulation then effect, by Notice published in the Official Gazette for October 12, 2004, the Office announced that "a brief filed before September 13, 2004 that is compliant with new Sec. 41.37(c) will be acceptable." Therefore, the Supplemental Appeal Brief filed on July 27, 2004 would not be objectionable if in compliance with either 37 CFR 1.192(c) or superceding regulation 37 CFR 41.37(c).

Review of the file history shows that the examiner objected to the Supplemental Appeal Brief on the grounds that "[t]he arguments do not provide reasons for separate patentability for each of claims 2, 4, 5, 8-10, 13, 240-242 and 247 as set forth in Issue 1 of appellant's Brief." The examiner further stated that "[t]he mere fact that a plurality of rejections have been made does not relieve appellant of the burden of providing such support as to why the claims do not stand or fall together."

Petitioner argues that the Supplemental Appeal Brief complies with 37 CFR 1.192(c) because the regulation merely "requires the Appellant to perform two affirmative acts, i.e., the Appellant must (A) state that the claims do not stand or fall together and (B) present arguments why the claims subject to the same rejection are separately patentable.

The issue framed above illustrates why 37 CFR 41.37(c) was promulgated to replace 37 CFR 1.192(c) and remove the requirements regarding so -called "grouping of claims." In point of fact, this regulation required that an appellant state that, **with respect to all claims grouped together in a given ground of rejection,** whether or not the claims **in that grouping** are considered to stand or fall together. A review of the matter shows that the Supplemental Appeal Brief does not explicitly do that. At page 8 of the Supplemental Appeal Brief, , Section VII. Grouping of Claims, petitioner stated that:

> "[t]he claims do not stand or fall together since the claims present different issues of patentability as evidenced by the 3 prior art rejections set forth in the final Official Action, each of which is argued separately in this appeal. Accordingly, the grouping of claims set forth in the 3 different grounds of rejection establish that the claims do not stand or fall together. Further, because the Patent Owner contests the Examiner's holding regarding the level of ordinary skill in the art, separate issues of patentability are presented for each of the claims under rejection in that the level of ordinary skill must be considered and the evidence of secondary considerations must be weighed with respect to each of the prior art rejections under 35 U.S.C. § 103 and each of the claims under rejection."

The above statement merely indicates the obvious, to wit, that since there are three separate grounds of rejection, the claims listed in any one of the grounds of rejection stand or fall separately from the claims listed in any of the other grounds of rejection, because each rejection is on a different ground and presents separate patentability issues. This is not the same as stating that some or all of the claims **grouped together under a given ground of rejection** do not stand or fall together. As petitioner's intent was to have all of the claims in the first ground of rejection stand or fall together, but to have the sole claim in the second ground of rejection and the sole claim in the third ground of rejection stand or fall separately from all other claims, it would have been proper for petitioner's Supplemental Appeal Brief to say nothing at all about claims standing or falling together, and to have simply argued each of the three grounds of rejection.

Nevertheless, petitioner's point as presented at page 7, second full paragraph of the petition is well taken; it appears to be reasonable to construe Section VII. Grouping of Claims in light of Section VIII. Argument together. Read together, these sections clearly demonstrate petitioner's intention that claims 1, 2 4, 5, 8-10, 13, 240-242 and 247 are to stand or fall together, while claim 6 does not stand or fall with any other claim and claim 11 does not stand or fall with any other claim. Accordingly, it is agreed that the Supplemental Appeal Brief filed on July 27, 2004 complies with 37 CFR 1.192(c). Accordingly, it is agreed that the Supplemental Appeal Brief is compliant with 37 CFR 1.192(c). Therefore, it is unnecessary to consider whether the Supplemental Appeal Brief complies 37 CFR 41.37(c).

This application is being returned to the Supervisory Patent Examiner for Art Unit 3711, who will ensure that the Primary Examiner takes this proceeding up as the next matter acted upon. The Primary Examiner will take appropriate action in this matter, and return the file to Special Program Examiner together with the patented file upon which this proceeding is based for immediate review and mailing of the action.

PETITION GRANTED.

E. R. Kazenske, Director
Technology Center 3700

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P.O. BOX 1450
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Paper No. 20

Thomas E. Watson
WOODCOCK WASHBURN LLP
One Liberty Place, 46th floor
Philadelphia, PA 19103

(For Patent Owner)

MAILED

MAR 30 2004

REEXAM UNIT

In re Vaidyanathan, et al.
Reexamination Proceeding
Control No. 90/006,200
Filed: January 25, 2002
For: U.S. Patent No. 6,305,008

DECISION GRANTING PETITION

This is a decision on the January 22, 2004, patent owner petition for entry of belated papers filed under 37 C.F.R. § 1.137(b), based upon unintentional delay. The petition is before the Office of Patent Legal Administration for decision.

A petition for entry of belated papers filed under 37 C.F.R. § 1.137(b), requires a fee under 37 C.F.R. § 1.17(m) of $1330.00, which 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 instant petition was accompanied by the petition fee. The instant petition includes the statement of item (3) above. It should be noted that 37 C.F.R. § 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional. The statement contained in the instant petition varies from the language required by 37 C.F.R. § 1.137(b)(3); however, the statement contained in the instant petition is being construed as the statement required by 37 C.F.R. § 1.137(b)(3). Petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

The required reply to the outstanding final Office action of May 30, 2003, in the form of a Notice of Appeal and the Notice of Appeal fee have been received.

In view of the above, the petition for the entry of late papers is sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

The petition is **granted**.

Patent owner's Appeal Brief is due within two months of the mailing date of this petition decision.

CONCLUSION

1. The petition is **granted**.

2. Patent owner's appeal brief is due within two months of the mailing date of this petition decision.

3. The reexamination file will be forwarded to Technology Center 2100 to await receipt of the Appeal Brief.

4. Further inquiries with regard to this reexamination proceeding should be directed to the examiner, Ba Nguyen Ba, of Group Art Unit 2122.

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

March 29, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

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Thomas E. Watson
Woodcock Washburn LLP
One Liberty Place 46th Floor
Philadelphia PA 19103

(For Patent Owner)

MAILED

JAN 3 1 2006

REEXAM UNIT

In re Reexamination Proceeding
Vaidyanathan et al.
Control No. 90/006,200
Filed: January 25, 2002
U.S. Patent No. 6,305,008
Attorney Docket No. MSFT-1146/37458.03

DECISION GRANTING PETITION

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on January 3, 2006, for entry of late papers based upon unintentional delay.

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

37 CFR 1.137(b) states:

> "*Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by: (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in § 1.17(m); (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section."

A review of the petition reveals that the bottom of page 1 ends with a complete sentence while the top of page numbered 2 begins with an incomplete sentence. While on its face there appears to be some omitted text, there is enough information present to treat the petition on its merits.

The present petition under 37 CFR 1.137(b) includes the requisite response (Reply Pursuant To 37 CFR § 1.116) (item 1), a $1500.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3).

The petition for entry of the late papers is granted.

Jurisdiction over the reexamination proceeding is being returned to Technology Center Art Unit 2192 for further examination and consideration of the Reply Pursuant To 37 CFR § 1.116 filed January 3, 2006, 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, Anthony Nguyen-Ba, in Technology Center Art Unit 2192, who can be reached at 571-272-3701.

Telephone inquiries related to this decision should be directed to Fred A. Silverberg at 571-272-7719.

Fred A. Silverberg
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy

Kenneth M. Schor
Conferee: Kenneth M. Schor

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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006596 2 90/006,206	01/25/2002	6260050	016499-000300US	5870

21967 7590 05/22/2003

HUNTON & WILLIAMS
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON, DC 20006-1109

EXAMINER
Joseph Feild

ART UNIT	PAPER NUMBER
2176	19

DATE MAILED: 05/22/2003

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

90006596 . 052203

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

DO NOT USE IN PALM PRINTER

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

MAY 22 2003

STEPHEN Y. PANG
TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER 8TH FLOOR
SAN FRANCISCO, CA 94111-3834

REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/006,206 And 90/006596

PATENT NO. 6,260,050

ART UNIT ~~2176~~

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 PATENT
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WASHINGTON, D C. 2023 I
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Paper No. 19

Brian M. Buroker Hunton & Williams 1900 K. Street, N.W Suite 1200 Washington, D.C. 20006-1109	)	**FOR OWNER** MAY 2 2 2003
Stephen Y. Pang Townsend and Townsend and Crew, L.L.P. Two Embarcadero Center 8th Floor San Francisco, California 94111-3834	)	**FOR THIRD PARTY REQUESTER**
In re Trenkamp et al. Reexamination Proceeding Control No. 90/006,206 Filed: January 25, 2002 For: U.S. Patent No. 6,260,050	)	**DECISION *SUA SPONTE*, MERGING REEXAMINATION PROCEEDINGS**
In re Trenkamp et al. Reexamination Proceeding Control No. 90/006,596 Filed: April 8, 2003 For: U.S. Patent No. 6,260,050	)	

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. 6,260,050 issued on July 10, 2001.

'6206 Proceeding

2. A first request for reexamination, Control No. 90/006,206 ('6206) was filed by the Third Party Requester on January 25, 2002.

3. Reexamination was ordered in the '6206 reexamination proceeding on March 27, 2002. [Paper No. 5]

4. A request for extension of time under 37 C.F.R. §1.550(c) was filed on May 20, 2002. [paper No. 6]

5. A decision granting an extension to June 27, 2002 for filing of the Patent Owner's Statement was mailed on May 24, 2002. [Paper No. 7]

6. A Patent Owner's Statement under 37 C.F.R. §1.530 was filed on June 25, 2002. [Paper No. 8]

7. An Information Disclosure Statement was filed on June 25, 2002. [Paper No.9]

8. The Requestor's Reply under 37 C.F.R. §1.535 was filed on August 6, 2002. [Paper No. 10]

9. An Information Disclosure Statement was filed on October 9, 2002. [Paper No.11]

10. A Supplemental Information Disclosure Statement was filed on January 14, 2003. [Paper No.12]

11. A first Office action was mailed on February 5, 2003. [Paper No. 13]

12. An Interview was held with the examiner of record and the Patent Owner's representatives on February 14, 2003. An Interview Summary was mailed on February 19, 2003. [Paper No. 14]

13. A Declaration under 37 C.F.R. § 1.132 was filed on March 17, 2003. [Paper No.15]

14. A response including amendments to the claims and a Summary of the February 14, 2003 Interview was filed by Patent Owner's representatives on March 16, 2003. [Paper No.16]

16. A revocation and appointment of attorneys was filed on May 20, 2003. [Paper No. 17]

'6596 Proceeding

17. A second request for reexamination, Control No. 90/006,596 ('6596) was filed by the Third Party Requester on April 8, 2003.

18. Reexamination was ordered in the '6596 reexamination proceeding on May 13, 2003. [Paper No. 7]

19. Patent Owner waives a response under 37 C.F.. §1.530 in a submission filed May 15, 2003 [Paper No. 8]

20. A revocation and appointment of attorneys was filed on May 20, 2003. [Paper No. 9]

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 '6206 and '6596 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.

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.

Margaret A. Focarino

Margaret A. Focarino, Director
Technology Center 2100
Computer Architecture, Software, and Information Security

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MAR 14 2008

CENTRAL REEXAMINATION UNIT

Peter D. McDermott (For Patent Owner)
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Robert B. Murray (For Requester)
Rothwell, Figg, Ernst & Manbeck P.C.
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Washington D.C. 20005

In re Reissue Application	:	
of Yousheng Shen, *et al.*	:	
Application No. 10/621,637	:	
Filed: July 17, 2003	:	
For: U.S. Patent No. 5,650,054	:	**DECISION, *SUA SPONTE*,**
	:	**TO MERGE**
In re Yousheng Shen, *et al.*	:	**REISSUE AND**
Reexamination Proceeding	:	**REEXAMINATION**
Control No. 90/006,209	:	**PROCEEDINGS**
Filed: January 29, 2002	:	
For: U.S. Patent No. 5,650,054	:	

The above-captioned reissue and reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.565(d) at this time.

REVIEW OF FACTS

1. U.S. patent No. 5,650,054 (the '054 patent) issued on July 22, 1997, with 65 claims.

2. A request for reexamination was filed by a third party requester on January 29, 2002, and was assigned control No. 90/006,209 (hereinafter, the '209 proceeding).

3. Reexamination was ordered for the '209 proceeding on April 12, 2002.

4. An application for reissue, assigned application No. 10/621,637 (the '637 application), was filed by the patent owner on July 17, 2003. The Reissue Application Declaration by Assignee did not identify (i) the residence (e.g. city and either state or foreign country) of each inventor; (ii) the citizenship of each inventor; and (3) whether the inventor is a sole or joint inventor, as is required under 37 CFR 1.63.

5. On July 17, 2003, a Statement Under 37 CFR 1.178(b) was filed by the patent owner in the '637 application, notifying the Office of the '209 proceeding.

6. On July 18, 2003, a Statement Under 37 CFR 1.565(a) was filed by the patent owner in the '209 proceeding, notifying the Office of the filing of the '637 application.

7. A patent owner's statement under 37 CFR 1.530 has not been received in the '209 proceeding, and the time for filing same expired.

8. On October 8, 2003, the Office mailed a Notice of Informal Application. The Notice states that the '637 application is considered to be informal, because the Declaration filed on July 17, 2003 did not comply with 37 CFR 1.63, as noted above in item 4. The image file wrapper (IFW) on the Office's public Patent Application Information Retrieval (public PAIR) includes an electronic copy of the Notice under the document description "re-exam Formalities Notice."

9. The filing of the '637 application was announced in the *Official Gazette* on November 11, 2003.

10. In the '209 proceeding, prosecution advanced to the point that a final Office action was issued on December 16, 2002. In response to the final Office action, the patent owner filed an Appeal Brief on April 21, 2003, in the '209 proceeding. The Board issued a Decision on Appeal on March 28, 2007, in which the Board affirmed-in-part and entered new grounds of rejection. The patent owner filed on May 29, 2007, a Request to Reopen Prosecution Under 37 CFR 41.50(b)(1) accompanied by an Amendment and a

Supplemental Declaration of Commercial Success Under 37 CFR 1.132.

11. An Office action on the merits has not been issued in the '637 application.

12. On October 11, 2007, the Office issued a Show cause order as to why the '637 application should not be terminated. The show cause order gave patent owner thirty days to either show cause as to why the Reissue proceeding should not be terminated or in the alternative provide a grantable petition for entry of belated papers under 37 CFR 1.137.

13. On November 8, 2007, patent owner timely filed a response to the October 11, 2007 show cause order, including a petition for revival under 37 CFR 1.137(b).

14. On December 12, 2007, the Office issued a decision granting patent owner's petition to revive the '637 reissue application.

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 set forth in the above Review of Facts, the '637 application and the '209 proceeding are currently pending. The order to reexamine has been mailed in the '209 proceeding, and notice of the '637 application has been published in the *Official Gazette*. Accordingly, 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, and 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 to merge the two proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

As also set forth in the above Review of Facts, prosecution will begin anew in the '209 proceeding, in view of the filing on May 29, 2007, of a Request to Reopen Prosecution Under 37 CFR 41.50(b)(1). The '637 application has been revived and, prosecution on the merits has yet to begin in the '637 application. Therefore, the '209 proceeding and the '637 application can be examined at the same time. Still further, in order to provide efficient and prompt handling and to prevent inconsistent, and possibly conflicting, amendments from being introduced on behalf of the patent owner, it is appropriate for the '637 application and the '209 proceeding to be merged, and for a joint examination to be conducted. Accordingly, the examination of the '637 application and the '209 proceeding will be merged in accordance with the decision set forth below.

It is to be noted, however, that the grant of merger of a reissue application and an *ex parte* reexamination proceeding under 37 CFR 1.565(d) **is discretionary**. *The present merger is not an assurance that, in a future similar situation, merger would be ordered.*

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-identified reissue application and reexamination proceeding (*i.e.*, the '637 application and '209 proceeding) are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in Both Proceedings

1. The patent owner is required to maintain identical amendments in the reissue application and the

reexamination files for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the reissue application and reexamination proceeding remain merged. See 37 CFR 1.565(d).

2. A review of the file for the '209 reexamination proceeding shows:

   (a) Original patent claims 1-65 are present.

   (b) Original claims 1 and 52 were amended on June 4, 2007.

   (c) New claims 66 and 67 were added on October 10, 2002, and new claim 66 was amended on June 4, 2007.

3. A review of the '637 application shows:

   (a) Original patent claims 1-65 are present.

   (b) New claims 66-75 were added on July 17, 2003.

4. **Accordingly, the claims are not identical in both proceedings.**

5. **An appropriate housekeeping amendment is required within <u>ONE (1) MONTH</u> of this decision, placing the same amendments in both proceedings**, specifically, Application No. 10/621,637 and Control Number 90/006,209. The response to this requirement <u>must be limited to</u> formally placing the same amendments in all cases, and patent owner must **not** address any issue of patentability in the housekeeping amendment. It is to be noted that, pursuant to MPEP 2285, amendments in a merged reexamination/reissue proceeding are submitted <u>under 37 CFR 1.173</u>, in accordance with reissue practice.

III. Conduct of the Merged Reissue Application Examination and Reexamination Proceedings

1. After the appropriate housekeeping amendment (see Part II above) is received, or after the time for same expires, the examiner should promptly prepare an Office action for the merged proceeding.

2. In the event that a housekeeping amendment is not timely submitted to place the same changes in both proceedings, any claim which does not contain identical text in both proceedings should be rejected under 35 USC 112, second paragraph, as being indefinite as to the content of the claim, and thus failing to particularly point out the invention.

3. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 USC 305 relating to the conduct of *ex parte* reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue-application examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. **However, periods for response should be set at TWO (2) months to comply with the statutory requirement for special dispatch in *ex parte* reexamination (35 USC 305).**

4. Each Office action issued by the examiner will take the form of a *single action* that jointly applies to the reissue application and the reexamination proceeding. Each action will contain identifying data *for both of the cases, i.e.*, the reissue application and the reexamination proceeding, and each action will be entered into both files (which will be maintained as separate files).

5. Any response by the applicant/patent owner must consist of a single response, with two copies being filed for entry in the two files, with each of the two bearing a signature. Any such response must contain identifying data *for both of the cases, i.e.*, the reissue application and the reexamination proceeding. *Any such responses must be*

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

6. Pursuant to MPEP 2285, for a merged proceeding containing a reexamination proceeding and a reissue application:

> "Amendments should be submitted in accordance with the reissue practice under ... 37 CFR 1.173; see MPEP 1453."

Thus, the filing of any amendments to the specification, claims, or drawings must comply with the provisions of 37 CFR 1.173, and with the guidelines of MPEP 1453. It is to be noted that 37 CFR 1.121 does not apply to amendments in a reissue application. Accordingly, clean copies of the amended claims are not required, *and such clean copies are not to be submitted*. Instead, pursuant to 37 CFR 1.173(b)(2), amendments are to be presented via markings pursuant to 37 CFR 1.173(d), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.173(g), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the reissue application. *Amendments are not to be made relative to previous amendments*. Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

7. Where a paper is filed which requires payment of a fee (*e.g.*, petition fee, excess claims fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for any patent owner appeal brief, even though such a brief would relate to the merged multiple proceedings, and even though copies must be filed (as pointed out above) for each file of the merged proceeding.

8. The examiner (a) will review the files to ensure that each file contains identical citations of prior patents and printed publications, and (b) will cite such documents as

are necessary as part of the next Office action in order to place the files in that condition.

9. If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be concluded by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 CFR 1.570. See MPEP 2285.

10. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be dissolved. The reissue application will be held abandoned. The reexamination prosecution will be terminated, and a reexamination certificate under 37 CFR 1.570 will be issued in accordance with the last action of the Office, unless further action in the reexamination proceeding is needed as a result of the difference in the rules relating to reexamination and reissue proceedings. If further action in the reexamination proceeding is needed, any grounds of rejection that are not applicable under reexamination would be withdrawn (*e.g.*, based on public use or on 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 for consideration in reexamination pursuant to 37 CFR 1.552(c).

11. If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 CFR 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue examination as to the reexamination proceeding. Such examination would be conducted as set forth in the immediately preceding paragraph.

CONCLUSION

1. Reissue application No. 10/621,637 and reexamination control No. 90/006,209 **are merged** into a single proceeding.

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

3. Jurisdiction over the merged reissue and reexamination proceeding is being transferred to Technology Center 1700, in which the reissue proceeding is assigned. The examiner assigned the merged proceeding is not to be one who was involved in any part of the examination of the '054 patent (*e.g.*, by preparing/signing an action). See MPEP 2236.

4. The examiner should not issue an Office action for the present merged proceeding until after the earlier of: (a) the submission of the required housekeeping amendment to place the same amendments in both cases, or (b) the expiration of the ONE MONTH period from the mailing of this decision for filing the amendment.

5. All further examination in the merged proceeding should be conducted in accordance with Part III of this decision.

6. Telephone inquiries related to this decision should be directed to Joseph F. Weiss, Jr, Legal Advisor, at (571) 272-7759.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

Mar. 13, 2008
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Alexandria, Virginia 22313-1450
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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO.
90/006,211	01/25/2002	6287704	2156-417	5875

7590 03/05/2004

Pearne Gordon McCoy & Granger
1200 Leader Building
Cleveland, OH 44114

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED. 03/05/2004

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

Pearne, Gordon, McCoy & Granger 1200 Leader Building Cleveland, OH 44114	(for Patent Owner)
Arthur G. Schaier 65 Stebbins Road Carmel, NY 10512	(for Third Party)
In re Preikschat et al Reexamination Proceeding Control No. 90/006,211 Filed: January 25, 2002 For: U.S. Patent 6,287,704	**DECISION MERGING REEXAMINATION PROCEEDINGS**
In re Preikschat et al Reexamination Proceeding Control No. 90/006,672 Filed: June 20, 2003 For: U.S. Patent 6,287,704	

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 6,287,704, issued September 11, 2001, is the subject of Reexamination Control Nos. 90/006,211 and 90/006,672.

2. A first request for reexamination, assigned Reexamination Control No. 90/006,211 ('211) was filed January 25, 2002 by Arthur Schaier. The request urged that a substantial new question of patentability was raised by the following references, either alone or in combination: (a) U.S. patent 5,368,655 to Klos; (b) U.S. patent 4,349,392 to Huvar; (c) U.S. patent 5,407,749 to Bishop; (d) U.S. patent 5,393,354 to Bishop;

(e) U.S. patent 4,578,122 to Crotty; (f) U.S. patent 3,843,430 to Kinder; (g) Great Britain patent 2,097,024 (h) the publication "Chromate Coating from Trivalent Solution", published in the Products Finishing Magazine; (i) the publication "Non-Chromate Passivation Treatment for Zinc" from the Transactions of the Institute of Metal Finishing, Volume 60, Part 2; and (j) the publication "Clear Chromates: Theory and Practice", published in Products Finishing.

3. Reexamination was ordered for '211 on March 25, 2002.

4. A first Office action for '211 was mailed on August 5, 2002 and contained the rejection of claims 1-34 and 36-62.

5. Patent owner responded to the first Office action on December 4, 2002 (Certificate of Mailing).

6. A final Office action for '211 was mailed on April 22, 2003 and contained the rejection of claims 21-34, 36-51, 53, 56 and 57.

7. Patent owner responded to the final Office action on May 30, 2003 (Certificate of Mailing).

8. An Advisory action was mailed on June 10, 2003.

9. Patent owner responded to the Advisory action on June 16, 2003 (Certificate of Mailing) and July 1, 2003 (Certificate of Mailing).

10. A second request for reexamination, assigned Reexamination Control No. 90/006,672 ('672), was filed June 20, 2003 by Arthur Schaier. The request urged that a substantial new question of patentability was raised by the the following references, either alone or in combination: (a) U.S. patent 5,368,655 to Klos; (b) U.S. patent 4,444,601 to Greene; (c) U.S. patent 4,263,059 to Guhde et al; (d) U.S. patent 3,932,198 to Schneider; (e) U.S. patent 3,843,430 to Kinder; (f) the publication "Non-Chromate Passivation Treatments for Zinc" from the Transactions of the Institute of Metal Finishing, Summer 1982.

11. Reexamination was ordered for '672 on September 2, 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 90/006,211 and 90/006,672 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. 90/006,211 on December 4, 2002 (certificate of mailing) and has submitted several amendments after final rejection. 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. 90/006,211 and 90/006,672.

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 <u>all</u> 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 <u>all</u> 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. 90/006,211 and 90/006,672 as:

Pearne, Gordon, McCoy & Granger
1200 Leader Building
Cleveland, OH 44114

CONCLUSION

Reexamination Control Nos. 90/006,211 and 90/006,672 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

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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO.
90/006,211	01/25/2002	6287704	2156-417	5875

7590 03/05/2004

Pearne Gordon McCoy & Granger
1200 Leader Building
Cleveland, OH 44114

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED. 03/05/2004

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

Pearne, Gordon, McCoy & Granger 1200 Leader Building Cleveland, OH 44114	(for Patent Owner)
Arthur G. Schaier 65 Stebbins Road Carmel, NY 10512	(for Third Party)
In re Preikschat et al Reexamination Proceeding Control No. 90/006,211 Filed: January 25, 2002 For: U.S. Patent 6,287,704	**DECISION MERGING REEXAMINATION PROCEEDINGS**
In re Preikschat et al Reexamination Proceeding Control No. 90/006,672 Filed: June 20, 2003 For: U.S. Patent 6,287,704	

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 6,287,704, issued September 11, 2001, is the subject of Reexamination Control Nos. 90/006,211 and 90/006,672.

2. A first request for reexamination, assigned Reexamination Control No. 90/006,211 ('211) was filed January 25, 2002 by Arthur Schaier. The request urged that a substantial new question of patentability was raised by the following references, either alone or in combination: (a) U.S. patent 5,368,655 to Klos; (b) U.S. patent 4,349,392 to Huvar; (c) U.S. patent 5,407,749 to Bishop; (d) U.S. patent 5,393,354 to Bishop;

(e) U.S. patent 4,578,122 to Crotty; (f) U.S. patent 3,843,430 to Kinder; (g) Great Britain patent 2,097,024 (h) the publication "Chromate Coating from Trivalent Solution", published in the Products Finishing Magazine; (i) the publication "Non-Chromate Passivation Treatment for Zinc" from the Transactions of the Institute of Metal Finishing, Volume 60, Part 2; and (j) the publication "Clear Chromates: Theory and Practice", published in Products Finishing.

3. Reexamination was ordered for '211 on March 25, 2002.

4. A first Office action for '211 was mailed on August 5, 2002 and contained the rejection of claims 1-34 and 36-62.

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7. Patent owner responded to the final Office action on May 30, 2003 (Certificate of Mailing).

8. An Advisory action was mailed on June 10, 2003.

9. Patent owner responded to the Advisory action on June 16, 2003 (Certificate of Mailing) and July 1, 2003 (Certificate of Mailing).

10. A second request for reexamination, assigned Reexamination Control No. 90/006,672 ('672), was filed June 20, 2003 by Arthur Schaier. The request urged that a substantial new question of patentability was raised by the the following references, either alone or in combination: (a) U.S. patent 5,368,655 to Klos; (b) U.S. patent 4,444,601 to Greene; (c) U.S. patent 4,263,059 to Guhde et al; (d) U.S. patent 3,932,198 to Schneider; (e) U.S. patent 3,843,430 to Kinder; (f) the publication "Non-Chromate Passivation Treatments for Zinc" from the Transactions of the Institute of Metal Finishing, Summer 1982.

11. Reexamination was ordered for '672 on September 2, 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 90/006,211 and 90/006,672 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. 90/006,211 on December 4, 2002 (certificate of mailing) and has submitted several amendments after final rejection. 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. 90/006,211 and 90/006,672.

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 <u>all</u> 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 <u>all</u> 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. 90/006,211 and 90/006,672 as:

Pearne, Gordon, McCoy & Granger
1200 Leader Building
Cleveland, OH 44114

CONCLUSION

Reexamination Control Nos. 90/006,211 and 90/006,672 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

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Office of the Director
Group 3600

Loren G. Helmreich
Browning Bushman PC
5718 Westheimer Rd., Suite 1800
Houston, TX 77057-5771

Reexamination Control No. 90/006,218
Filed: February 12, 2002
For: TUBING STRING HANGING APPARATUS

DECISION ON PETITION FOR THE ACCEPTANCE OF LATE PAPERS

This is in reply to petitioner's communication filed September 23, 2003 and supplemented on October 1, 2003, 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 an Office action was mailed on April 29, 2003 wherein a two-month shortened statutory period for response was set. Petitioner alleges that a timely response was filed on June 18, 2003. Petitioner has submitted copy of the amendment, which bears a Certificate of Facsimile Transmission indicating that the amendment was timely faxed on June 18, 2003. A statement under 37 CFR 1.8(b)(3) attesting to the previous timely transmission also accompanied the petition. This is acceptable evidence of a timely filing of the amendment.

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 amendment filed June 18, 2003.

Kenneth J. Dorner, Special Programs Examiner
Patent Technology Center 3600
(703) 308-0866

kjd: 10/21/03

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,218	02/12/2002	5465788	R&M-128	2509

7590 10/21/2005

EXAMINER

Loren G. Helmreich
Browning Bushman PC
5718 Westheimer Rd., Suite 1800
Houston, TX 77057-5771

ART UNIT	PAPER NUMBER

DATE MAILED: 10/21/2005

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

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Paper No. 31

Loren G. Helmreich
BROWNING BUSHMAN
5718 Westheimer
Suite 1800
Houston, TX 77057

(For Patent Owner)

MAILED
OCT 21 2005
REEXAM UNIT

In re Andrew Wright
Reexamination Proceeding
Control No.: 90/006,218
Filed: February 12, 2002
For: U.S. Patent No.: 5,465,788

: DECISION ON PETITION
: TO CONTINUE
: *EX PARTE*
: REEXAMINATION
: PROCEEDINGS

This is a decision on the September 20, 2005 patent owner petition titled PETITION UNDER 37 C.F.R. § 1.182, taken as a petition to continue the prosecution of the instant reexamination proceeding.

The petition is before the Office of Patent Legal Administration.

For the reasons set forth below, the petition is dismissed as being incomplete.

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); [1] 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 1.182."

REVIEW OF FACTS

1) U.S. Patent No. 5,465,788 (the '788 patent) issued on November 14, 1995.

[1] 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.

[2] 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.

[3] 37 CFR §1.182 was amended on September 21, 2004, to require the petition fee set forth in 37 CFR § 1.17(f). This amendment became effective on November 22, 2004.

2) The present request for reexamination, assigned control No. 90/006,218, was filed by the patent owner on February 12, 2002.

3) A Preliminary amendment from the patent owner was received in the Office on February 12, 2002. This Preliminary Amendment did not comply with 37 CFR 1.530 and was accordingly not entered.

4) Reexamination was ordered for the '6218 reexamination proceeding on April 23, 2002.

5) A Supplemental Preliminary Amendment from the patent owner was received in the Office on May 13, 2002, and entered.

6) A second Supplemental Preliminary Amendment from the patent owner was received in the Office on July 2, 2002, and returned to the patent owner, along with a Decision Returning Improper Papers, on October 10, 2002.

7) A paper titled Supplemental Remarks Regarding Prior Art was received from the patent owner on July 24, 2002, and returned to the patent owner, along with the Decision Returning Improper Papers, on October 10, 2002.

8) A non-final Office action was mailed in the '6218 reexamination proceeding on October 1, 2002.

9) A response from the patent owner to the non-final Office action was received on October 18, 2002.

10) An additional response from the patent owner to the non-final Office action was received on November 12, 2002.

11) A Notice of Defective Paper in *Ex Parte* Reexamination was mailed on January 14, 2003, advising the patent owner that the response received in the Office on November 12, 2002, did not comply with 37 CFR1.530(d)-(j).

12) A response from the patent owner (to the January 14, 2003 Notice of Defective Paper) was received on February 18, 2003.

13) A second non-final Office action was mailed on April 29, 2003.

14) A petition from the patent owner for the acceptance of late filed papers in response to the Office action of April 29, 2003, was received in the Office on September 23, 2003.

15) A supplemental petition from the patent owner regarding the acceptance of the late filed papers was received in the Office on October 1, 2003.

16) A decision granting the petition for the acceptance of late filed papers received on September 23, 2003, and supplemented on October 1, 2003, was mailed on November 3, 2003.

17) A Notice of Defective Paper in *Ex Parte* Reexamination was mailed on December 22, 2003, advising the patent owner that the response received in the Office on September 23, 2003, did not comply with 37 CFR 1.530(d)-(j).

18) A response from the patent owner (to the December 22, 2003 Notice of Defective Papers) was received in the Office on January 15, 2004.

19) A Notice of Defective Paper in *Ex Parte* Reexamination was mailed on April 8, 2004, advising the patent owner that the response received in the Office on January 15, 2004, did not comply with 37 CFR1.530(d)-(j).

20) A response from the patent owner (to the April 8, 2004 Notice of Defective Papers) was received in the Office on April 19, 2004.

21) A Notice of Defective Paper in *Ex Parte* Reexamination was mailed on July 14, 2004, advising the patent owner that the response received in the Office on April 19, 2004, did not comply with 37 CFR 1.530(d)-(j).

22) A response from the patent owner (to the July 14, 2004 Notice of Defective Papers) was received in the Office on July 23, 2004.

23) A telephone interview between the patent owner and the examiner was conducted on October 28, 2004. An Interview Summary was mailed the same day.

24) A supplemental Amendment from the patent owner was received in the Office on November 3, 2004.

25) A response from the patent owner to the Interview Summary of October 28, 2004, was received in the Office on December 15, 2004.

26) A Notice of Intent to Issue *Ex Parte* Reexamination Certificate was mailed by the Office on January 6, 2005.

27) A supplemental Notice of Intent to Issue an *Ex Parte* Reexamination Certificate was mailed on August 1, 2005.

28) The present petition under 37 CFR1.182 was received in the Office on September 20, 2005. It is requested that the Office reopen the prosecution of the re-examination proceeding to address an amendment presenting new claims 72-90, which accompanied this petition.

DECISION

37 CFR 1.182 states, "Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f)." (emphasis added).[4] Pursuant to 37 CFR 1.17(f), the fee for filing a petition under 37 CFR § 1.182 is $400. On page 2 of the petition, petitioner authorizes payment of the fee set forth in 37 CFR 1.17(h). The petition fee under 37 CFR 1.17(h) is $130. Accordingly, the fee authorization is deficient by $270; the difference between the $400 fee required under 37 CFR 1.17(f) and the $130 authorized fee. The petition does not include authorization to charge the $270 difference in fees to a deposit account. Similarly, the Reexamination proceeding does not include a general authorization to charge any required fees to a deposit account. Therefore, the petition does not include the required fee. Accordingly, the petition must be dismissed as incomplete as to the required fee.

The following discussion is provided In order to inform petitioner as to matters other than the petition fee that would need to be addressed in the event the petitioner chooses to renew the petition.

In the present petition under 37 CFR 1.182, the patent owner requests that the Office reopen the prosecution of the '6218 reexamination proceeding for consideration of the amendment filed on September 20, 2005, more than nine months after the Office mailed the first Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC).

MPEP §2287 states:

> A NIRC informs the patent owner and any third party requester that the reexamination proceeding has been terminated. The rules do not provide for an amendment to be filed in a reexamination proceeding after prosecution has been terminated. The provisions of 37 CFR § 1.312 do not apply in reexamination. Any amendment, information disclosure statement, or other paper related to the merits of the reexamination proceeding filed after prosecution has been terminated must be accompanied by a petition under 37 CFR § 1.182 to have the amendment considered.

For such a petition to be considered, petitioner must provide a showing of good and sufficient reasons why the amendments are necessary and were not earlier presented. Cf. 37 CFR 1.313(a) ("To request that the Office withdraw an application from issue, applicant must file a petition . . . and a showing of good and sufficient reasons why withdrawal of the application from issue is necessary."), and 37 CFR 1.116 (b)(3) (After a final rejection or other final action in an *ex parte* reexamination, an amendment

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[4] 37 CFR §1.182 was amended on September 21, 2004, to require the petition fee set forth in 37 CFR § 1.17(f). This amendment became effective on November 22, 2004.

touching the merits of the "patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.").

In support of why the amendment is now necessary and was not earlier presented, the patent owner states, "During a review of the claims as allowed in the above reexamination and a review of the prosecution history, [the patent owner] recognized that dependent claims considered allowable in an Office Action dated April 29, 2003 were not presented in independent form."[5] However, this statement does not satisfy petitioner's burden of providing the required showing. Specifically, this statement does not identify when the above-mentioned review of the allowed claims and the prosecution history occurred. Similarly, this statement does not indicate when the patent owner first recognized that the patentable dependent claims had not been presented in independent form.[6] Furthermore, the patent owner has not explained why new claims 72-90 were not presented in response to the second Office action or the first NIRC. Absent a sufficient showing as to why the amendment of September 20, 2005, was not earlier presented, the prosecution of the re-examination proceeding will not be reopened.

It is additionally noted that the form of the amendment of September 20, 2005, does not comply with 37 CFR 1.530(e). Specifically, 37 CFR 1.530(e) states:

> Whenever there is an amendment to the claims pursuant to paragraph (d) of this section, there must also be supplied, on pages separate from the pages containing the changes, <u>the status (i.e., pending or canceled), as of the date of the amendment, of all patent claims</u> and of all added claims, and an <u>explanation of the support in the disclosure of the patent for the changes to the claims made by the amendment paper</u>. (emphasis added).

The amendment received in the Office on September 20, 2005 does not comply with 1.530(e). Specifically, the amendment does not provide the status of claims 1-71. Additionally, the patent owner did not provide an *explanation of support for each of new claims 72-90*, as required.

In view of the above, the petition is dismissed as being incomplete.

---

[5] The amendment of September 20, 2005, does not present the dependent claims indicated to be allowable in the Office action of April 29, 2003, in independent form. Instead, this amendment presents claims of a scope not previously considered by the examiner during this reexamination proceeding.

[6] Claims 1 and 26 of the '788 patent were amended prior to the first Office action by the supplemental Preliminary Amendment of May 13, 2002. The patentability of claims 1-28 should not have been "confirmed" in either the first or the second Office action. Instead, amended claims 1-28 should have been identified as "patentable" in the Office actions and the NIRCs.

CONCLUSION

1) The petition under 37 CFR1.182 is dismissed.

2) The prosecution of the present '6218 reexamination proceeding is not reopened.

3) The Amendment (after NIRC) dated September 20, 2005, will not be entered by the Technology Center, or considered by the examiner.

4) 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 1.182."

5) Any renewed petition under 37 CFR 1.182 should be directed:

By U.S. Postal Service Mail:	Mail Stop *Ex Parte* Reexam Central Reexamination Unit Patent & Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450
By FAX to:	(571) 273-9900 Central Reexamination Unit
By hand (or delivery service):	Customer Service Window Attn: Central Reexamination Unit Randolph Building, Lobby Level 401 Dulany St. Alexandria, VA 22314

6) Jurisdiction over the instant reexamination proceeding is being retained by the Office of Patent Legal Administration. If no renewed petition is received within a month of the mailing date of this decision (or within the time as extended, if an extension of time under 37 CFR 1.550(c) should be granted), then the proceeding will be returned to the publication process.

7) Telephone inquiries related to this decision should be directed to Brian E. Hanlon, Legal Advisor, at (571) 272-5047, or in his absence, Kenneth Schor, Senior Legal Advisor, at (571) 272-7710.

Kenneth Schor,
Senior Legal Advisor
Office of Patent Legal Administration
Office of Patent Examination Policy

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October 21, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

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DEC 2 1 2005

REEXAM UNIT

Paper No. 33

Loren G. Helmreich
BROWNING BUSHMAN
5718 Westheimer
Suite 1800
Houston, TX 77057

(For Patent Owner)

In re Andrew Wright	:	
Reexamination Proceeding	:	DECISION GRANTING
Control No.: 90/006,218	:	RENEWED PETITION
Filed: February 12, 2002	:	UNDER 37 CFR 1.182
For: U.S. Patent No.: 5,465,788	:	

This is a decision on the November 2, 2005 renewed patent owner petition titled RENEWED PETITION UNDER 37 C.F.R. § 1.182, to continue the prosecution of the instant reexamination proceeding.

The petition is before the Office of Patent Legal Administration.

The petition is granted.

DECISION ON PETITION UNDER 37 CFR 1.182

The patent owner filed an original Petition Under 37 CFR 1.182 on September 20, 2005, that was taken as a petition to continue the prosecution of the instant reexamination proceeding. The original petition was dismissed as being incomplete, *inter alia*, as to the required fee.[1]

The patent owner's original petition included authorization to charge the petitioner's deposit account the $130 petition fee set forth in 37 CFR 1.17(h), not the proper petition fee of $400 set forth in 37 CFR 1.17(f). The renewed petition received November 2, 2005, includes authorization to charge petitioner's deposit account the $270 difference between the previously authorized petition fee of $130 and the required petition fee of $400.[2] Accordingly, the $270 difference in petition fees is being charged to petitioner's Deposit Account No. 02-4345, as

[1] See Decision On Petition To Continue *Ex Parte* Reexamination Proceedings mailed October 21, 2005.
[2] On page 2 of the September 20, 2005, petition, petitioner authorized payment of the fee set forth in 37 CFR 1.17(h). This $130 petition fee under 37 CFR 1.17(h) was charged to petitioner's deposit account on October 7, 2005.

authorized on the first page of the renewed petition, thereby providing the "petition fee as set forth in § 1.17(f)" pursuant to 37 CFR 1.182.

In addition to the deficient fee, the original petition failed to provide the required showing of good and sufficient reasons as to why the newly presented claims were necessary and not earlier presented. The decision mailed October 21, 2005, stated:

> "For such a petition to be considered, petitioner must provide a showing of good and sufficient reasons why the amendments are necessary and were not earlier presented."

By way of the renewed petition, patent owner has provided the required showing of good and sufficient reasons as to why the amendments were not earlier presented. Based upon the equities of the present situation with respect to the patent owner, the petition under 37 CFR 1.182 is granted, and the prosecution in the above-noted reexamination proceeding is hereby continued.

The Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) of January 6, 2005, and the supplemental NIRC of August 1, 2005, are hereby withdrawn, for consideration of the amendment submitted November 2, 2005 with the renewed petition. The prosecution of the proceeding is reopened to the extent that the November 2, 2005 amendment will be treated <u>as a response received after a first Office action</u>.

The November 2, 2005 amendment will be entered in the reexamination proceeding, and the proceeding will be forwarded to the examiner for action on the amendment. The examiner will then consider the amendment and then issue an Office action treating the amendment as a response received after a first Office action.

THE NOVEMBER 2, 2005 AMENDMENT

As required by 37 CFR 1.530(e), the amendment filed concurrently with the renewed petition on November 2, 2005, provides the status of all patented claims and all added claims on a page separate from the pages containing the claim amendments. Similarly, this amendment provides an explanation of support for the new claims as required by § 1.530(e).

However, the status of claims 1-31, 33-41, 43-46, 48-53, 55-62 and 64-71 set forth in the amendment of November 2, 2005 is unclear in that these claims, as presented in the amendment, include the parenthetical identifier "pending," as well as bracketing and underlining.

37 CFR 1.530(d) states:

> An amendment paper must include the entire text of each patent claim which is being proposed to be changed by such amendment paper and of each new claim being proposed to be added by such amendment paper. For any claim changed by the amendment paper, a parenthetical expression "amended," "twice amended," *etc.*, should follow the claim number. Each patent claim proposed to be changed and each proposed added claim must include markings pursuant to paragraph (f) of this section . . . .
>
> 37 CFR 1.530(f) states:
>
> Any changes relative to the patent being reexamined which are made to the specification, including the claims, must include the following markings:
> (1) The matter to be omitted by the reexamination proceeding must be enclosed in brackets; and
> (2) The matter to be added by the reexamination proceeding must be underlined.

After reviewing the record of this reexamination proceeding, it appears that claims 1-31, 33-41, 43-46, 48-53, 55-62 and 64-71, as filed on November 2, 2005, each remain unchanged from the version that was indicated allowable in the Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) of January 6, 2005, and the supplemental NIRC of August 1, 2005. Therefore, the Office is interpreting the parenthetical identifier "pending" for each of these claims to mean "previously presented." If this interpretation by the Office is correct, then, to the extent that 37 CFR 1.530(d) must be waived for the entry of the amendment filed November 2, 2005, it is hereby waived.

If the Office's interpretation of the status of claims 1-31, 33-41, 43-46, 48-53, 55-62 and 64-71 is incorrect, petitioner is required to correct the Office's understanding and provide an amendment including the proper parenthetical identifiers for all claims. Any such corrected amendment must be submitted within **ONE (1) MONTH** of the mail date of this decision. **NO EXTENSION OF TIME WILL BE GRANTED.**

CONCLUSION

1) The petition under 37 CFR 1.182 is granted.

2) The prosecution of the present '6218 reexamination proceeding is continued. No further continuation of the present reexamination proceeding will be granted under 37 CFR 1.182.

3) The Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) of January 6, 2005, and the supplemental NIRC of August 1, 2005, have been withdrawn, and prosecution of the proceeding is reopened to the extent set forth above.

4) Jurisdiction over the proceeding will be retained by the Office of Patent Legal Administration for one month. If no response to this decision is received by the Office as to the nature of the claims presented in the amendment within the one month time period set forth above, then jurisdiction over the reexamination proceeding will be forwarded to the Technology Center for further handling and examination not inconsistent with this decision.

5) After jurisdiction over the reexamination proceeding is forwarded to the Technology Center, the amendment dated November 2, 2005, will be entered by the Technology Center, and then considered by the examiner. The amendment will be addressed and treated as a response received after a first Office action.

6) Telephone inquiries related to this decision should be directed to Brian E. Hanlon, Legal Advisor, at (571) 272-5047, or in his absence, Kenneth Schor, Senior Legal Advisor, at (571) 272-7710.

Kenneth Schor,
Senior Legal Advisor
Office of Patent Legal Administration
Office of Patent Examination Policy

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12-20-05

UNITED STATES PATENT AND TRADEMARK OFFICE

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90/006219

MAILED

MAY 29 2003

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

#10

FOR PATENT OWNER:

Gale R. Rhodes, Jr.
MOSER, PATTERSON & SHERIDAN, LLP
595 Shrewsbury Avenue, Suite 100
Shrewsbury, NJ 07702

FOR REQUESTER:

Norman E. Lehrer
Norman E. Lehrer, P.C.
1205 North Kings Highway
Cherry Hill, NJ 08034

DECISION ON PETITION
TO ACCEPT A
LATE COMMUNICATION

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 13, 2003.

The petition is **GRANTED**.

A review of the file record indicates that a Final rejection setting a two month shortened statutory period was mailed to the patent owner on December 17, 2002.

Patent owner's petition includes a copy of a response and includes a USPTO facsimile return receipt bearing a transmittal date of February 7, 2003. This is sufficient evidence of a timely response.

Since a timely response to the Office action was filed, the application is being forwarded to the Supervisory Legal Instruments Examiner for entry of the Amendment filed with the petition, and then to the Examiner for prompt action on the merits of the claims.

Kenneth J. Dorner

Kenneth J. Dorner, Special Programs Examiner
Patent Technology Center 3600
Telephone No.: (703) 308-0866
Facsimile No.: (703) 605-0586

KJD/tpl: 5/16/03

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Paper No. 14

James E. Bradley
BRACEWELL & PATTERSON, L.L.P.
P.O. Box 61389
Houston, TX 77208-1389

(For Patent Owner)

MAILED
DEC 10 2003
REEXAM UNIT

In re Schader, et al.
Reexamination Proceeding
Control No. 90/006,222
Filed: February 20, 2002
For: U.S. Patent No. RE 37,127

DECISION GRANTING PETITION

This is a decision on the December 1, 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 $1300.00 pursuant to 37 C.F.R. § 1.17(m) for the petition under 37 C.F.R. § 1.137(b) was paid with the original petition of August 29, 2003.

The renewed 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 renewed petition includes items (1) and (3) above.

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 1700 for consideration of the amendment, and issuance of the next appropriate Office action.

3. 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

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Paper No. 14

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(For Patent Owner)

MAILED
DEC 10 2003
REEXAM UNIT

In re Schader, et al.
Reexamination Proceeding
Control No. 90/006,222
Filed: February 20, 2002
For: U.S. Patent No. RE 37,127

DECISION GRANTING PETITION

This is a decision on the December 1, 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 $1300.00 pursuant to 37 C.F.R. § 1.17(m) for the petition under 37 C.F.R. § 1.137(b) was paid with the original petition of August 29, 2003.

The renewed 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 renewed petition includes items (1) and (3) above.

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 1700 for consideration of the amendment, and issuance of the next appropriate Office action.

3. 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

90006222.120103

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Paper No. 20

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Houston, TX 77208-1389

(For Patent Owner)

MAILED

AUG 30 2004

REEXAM UNIT

In re Schader, et al.
Reexamination Proceeding
Control No. 90/006,222
Filed: February 20, 2002
For: U.S. Patent No. RE 37,127

DECISION GRANTING PETITION

This is a decision on the April 22, 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 of $1300.00 pursuant to 37 C.F.R. § 1.17(m) for the petition under 37 C.F.R. § 1.137(b) was paid with the original petition of August 29, 2003.

The renewed 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 renewed petition includes items (1) and (3) above, i.e., a notice of appeal and 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. An appeal brief was filed on June 25, 2004. The petition fee was previously paid.

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 1700 for consideration of the appeal brief, and issuance of the next appropriate Office action.

3. 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

August 13, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

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DEC 24 2002

Paper No. 12

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(For Requester)

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(For Requester)

In re CMC Magnetics Corporation Reexamination Proceeding Control No. 90/006,223 Filed: February 20, 2002 For: U.S. Patent No. 6,283,282	DECISION, *SUA SPONTE*, MERGING REEXAMINATION PROCEEDINGS
In re CMC Magnetics Corporation Reexamination Proceeding Control No. 90/006,266 Filed: April 15, 2002 For: U.S. Patent No. 6,283,282	

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.

Preliminary Matters

On July 28, 2002, papers were filed in the '266 reexamination proceeding on behalf of Owner. These papers were an Owner's Statement, a preliminary amendment, and a Substitute Power of Attorney. The amendment was entered. It is noted, however, that the amendment was entered in part because the proposed amendment to the drawings failed to comply with 37 CFR 1.530(d), penultimate sentence. The Owner's Statement was entered. However, the Substitute Power of

Attorney was not accepted because it was not signed by a person having apparent authority to bind Owner. Owner was notified of this defect, and was requested to submit a proper substitute power of attorney in both reexamination proceedings, and was informed that failure to do so would communication would only be with counsel then of record in the proceedings, and not with new counsel. Owner has not filed a proper substitute power of attorney.

Merger of Copending Reexamination Proceedings

I. Merger of Proceedings

As required by the practice pursuant to MPEP § 2283, and under the authority of 37 CFR 1.565(c), the '223 and '266 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. 6-11 in Control No. 90/006,223.

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. Each 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 Requesters are reminded that any 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" claims and paragraphs in which specification amendments are requested must be filed together with material satisfying the requirements of 37 CFR 1.530(e).** All words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets. New drawing figures must be labeled "New", while amended drawing figures must be labeled "Amended".

IV. Housekeeping Amendment

As discussed above, Owner filed a preliminary amendment in control No. 90/006,0266 That amendment has been entered except for the proposed amendment to the drawings. Therefore, Owner is required to file a housekeeping amendment in control No. 90/006,223 entering the identical claims therein. That paper will be paper No. 13 in control No. 90/006,223. There will then be no paper No. 13 in 90/006,266, 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. 90/006,223. The next action by the Primary Examiner will then be paper No. 14 in both files. **Owner is required to file the housekeeping amendment not later than ONE MONTH from the date of this decision.** Attention is invited to MPEP § 2282, subsection entitled "Merger of Reexaminations", last paragraph.

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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Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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MAILED
NOV 29 2006
CENTRAL REEXAMINATION UNIT

Law Offices of David L. Hoffman 27023 McBean Parkway Suite 422 Valencia, CA 91355	:	For Patent Owner
Thomas L. Rozsa Rozsa & Chen LLP 15910 Ventura Boulevard, Suite 1601 Encino, CA 91436-2815	:	For Requester
In re Devaney et al. *Ex Parte* Reexamination Proceeding Control No. 90/006,224 Filed: February 15, 2002 For: US Patent No. 6,195,831	:	DECISION GRANTING PETITION FOR EXTENSION OF TIME [37 CFR 1.550(c)]

This is a decision on the November 1, 2006, "Combined Declaration and Request for Extension of Time under 37 CFR 1.550(c) to Respond to Office Action Dated October 3, 2006" requesting that the time for responding to the Office action dated October 3, 2006 be extended by two months.

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

The petition is granted for two months for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action dated October 3, 2006, which set a one month date for filing a response thereto. The Office action is a Notification of Non-compliant Appeal Brief and the request for extension is the first request for an extension of time with respect to the outstanding Office action. The present petition for extension of time was timely filed on November 1, 2006, together with the required $200.00 petition fee.

37 CFR 1.956 states:

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

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

> Evaluation of whether "sufficient cause" has been shown for an extension must be made by balancing the desire to provide the patent owner with a fair opportunity to respond, against the requirement of the statute, 35 U.S.C. 314(c), that the proceedings be conducted with special dispatch.
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons should include a statement of what action the patent owner has taken, and why in spite of the action taken thus far, the additional time is needed. All requests must be submitted as a separate paper, not directed to any matter other than the request for the extension.
>
> The reasons stated in the request will be evaluated, and the request will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response or comments within the statutory time period.

Patent Owners Showing of Sufficient Cause to Grant an Extension of Time

The petition notes that the prosecuting attorney is a solo practitioner who has been hospitalized for some time, suffering from, *inter alia*, gallstones and pancreatitus. The petition notes that the attorney requires surgery, and includes a declaration from the attending physician attesting to the illness and need for further recuperation.

Analysis and Findings

It is considered that the petition explains the "sufficient cause" for an extension of time of two months quite convincingly. Serious illness on the part of the sole attorney prosecuting the case for Patent Owner is considered sufficient cause for a two month extension of time, given the need for surgery and the physician's suggested recovery time.

Accordingly, the time for filing a reply to the outstanding Office action is extended for two months and therefore the reply is due on January 3, 2007. Patent Owner may expect that any further extension of time to respond to the Office action will be granted only in an extraordinary situation. See MPEP 2665.

Conclusion

1. The Patent Owner's petition for extension of time filed on November 1, 2006 is <u>granted</u> for two months.

2. The Patent Owner's response is due January 3, 2007.

3. The response may be submitted as follows:

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

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

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

4. Telephone inquiries with regard to this decision should be directed to Gregory Mills, Quality Assurance Specialist in the Central Reexamination Unit, at (571) 272-1439.

Lissi Mojica Marquis,
Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

SEP 04 2007

CENTRAL REEXAMINATION UNIT

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Law Offices of David L. Hoffman 27023 McBean Parkway Suite 422 Valencia, CA 91355	:	For Patent Owner
Thomas L. Rozsa Rozsa & Chen LLP 15910 Ventura Boulevard, Suite 1601 Encino, CA 91436-2815	:	For Requester
In re Devaney et al. *Ex Parte* Reexamination Proceeding Control No. 90/006,224 Filed: February 15, 2002 For: US Patent No. 6,195,831	:	DECISION ON PETITION

This is a decision on the May 21, 2007 PETITION TO THE DIRECTOR UNDER 37 CFR 1.181, 1.182 AND 1.183, AND COMBINED REQUEST FOR REFUND, which requests that:

1. The notification of non-compliant appeal brief dated 4/18/07 be withdrawn;
2. The rules be waived even if the notification was correct;
3. The examiner in charge of the case be changed;
4. The case be handled expeditiously; and
5. Various fees be refunded.

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

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

Decision

As an initial matter, it is noted that 37 CFR 1.4(c) states:

> Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

With the instant petition, patentee makes five separate and distinct requests, which present issues decided by different officials of the USPTO. Accordingly, only patentee's first request, to withdraw the notification of non-compliant appeal brief dated 4/18/07 will be considered in this decision. Patentee's remaining requests 2-5 above are **DISMISSED** under 37 CFR 1.4(c) as improperly joined.

Turning to the merits of patentee's request to withdraw the notification of non-compliant appeal brief dated 4/18/07, it is noted that the question of whether a brief complies with the rules is a matter within the joint jurisdiction of the examiner and the Board (MPEP 1205.03). Accordingly, this decision has been made in consultation with appropriate officials of the Board.

It is agreed that the notification is incorrect, substantially for the reasons presented by patentee in the reply to the notice of non-compliance submitted 5/21/07. The brief filed 1/8/07 complies with 37 CFR 41.37, with the exception of 37 CFR 41.37(c)(1)(x), in that while the prior Board decision was submitted, it was not submitted under the appropriate heading, "Related Proceedings Appendix." In accordance with the MPEP 1205.03, this oversight should be considered as minor. The examiner, in the answer, should simply comment that it is assumed that the appellant meant to stipulate the cited Board Decision as constituting the Related Proceedings Appendix.

Accordingly, patentee's request to withdraw the notification of non-compliant appeal brief dated 4/18/07 is **GRANTED**. The case will be forwarded to the examiner for appropriate action on the appeal brief dated 1/8/07.

Conclusion

1. The Patent Owner's petition for withdrawal of the notification of non-compliant brief is granted. The Patent Owner's remaining requests are dismissed.

2. The case will be forwarded to the examiner for an appropriate action on the appeal brief filed 1/8/07.

3. Further correspondence may be submitted as follows:

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

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

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

4. Telephone inquiries with regard to this decision should be directed to Gregory Mills, Quality Assurance Specialist in the Central Reexamination Unit, at (571) 272-1439.

Lissi Mojica Marquis,
Director
Central Reexamination Unit

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COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.go

Paper No. 14

David A. Jackson, Esq.
KLAUBER & JACKSON
Continental Plaza
411 Hackensack Avenue
Hackensack, NJ 07601

(For Patent Owner)

Glenn P. Ladwig
SALIWANCHIK, LLOYD & SALIWANCHIK
2421 N.W. 41st Street
Suite A-1
Gainesville, FL 32606-6669

(For Requester)

MAILED

SEP 24 2003

REEXAM UNIT

In re Stringer
Reexamination Proceeding
Control No. 90/006,226
Filed: February 25, 2002
For: U.S. Patent No. 6,197,585

DECISION GRANTING PETITION

This is a decision on the July 10, 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 **granted** for the reasons indicated below.

DECISION

A grantable petition under 37 C.F.R. § 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed;

(2) the petition fee required by 37 C.F.R. § 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional.

Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 C.F.R. § 1.137(b) was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D).

The petition is accompanied by the petition fee. It should be noted that 37 C.F.R. § 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional. The statement contained in the present petition varies from the language required by 37 C.F.R. § 1.137(b)(3); however, the statement contained in the present petition is being construed as the statement required by 37 C.F.R. § 1.137(b)(3). Petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

The required reply to the outstanding nonfinal Office action of February 6, 2003, has been received.

In view of the above, the petition for the entry of late papers is sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

The petition is **granted**.

CONCLUSION

1. The petition is **granted**.

2. The reexamination file will be forwarded to Technology Center 1600 for consideration of the response to the nonfinal Office action of February 6, 2003.

3. Further inquiries with regard to this reexamination proceeding should be directed to the examiner, Terry McKelvey, of Group Art Unit 1636.

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

September 16, 2003

90006226.091403

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
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ALEXANDRIA, VA 22313-1450
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Paper No. 14

David A. Jackson, Esq.
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Continental Plaza
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Hackensack, NJ 07601

(For Patent Owner)

Glenn P. Ladwig
SALIWANCHIK, LLOYD & SALIWANCHIK
2421 N.W. 41st Street
Suite A-1
Gainesville, FL 32606-6669

(For Requester)

MAILED

SEP 24 2003

REEXAM UNIT

In re Stringer
Reexamination Proceeding
Control No. 90/006,226
Filed: February 25, 2002
For: U.S. Patent No. 6,197,585

DECISION GRANTING PETITION

This is a decision on the July 10, 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 **granted** for the reasons indicated below.

DECISION

A grantable petition under 37 C.F.R. § 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed;

(2) the petition fee required by 37 C.F.R. § 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional.

Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 C.F.R. § 1.137(b) was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D).

The petition is accompanied by the petition fee. It should be noted that 37 C.F.R. § 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional. The statement contained in the present petition varies from the language required by 37 C.F.R. § 1.137(b)(3); however, the statement contained in the present petition is being construed as the statement required by 37 C.F.R. § 1.137(b)(3). Petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

The required reply to the outstanding nonfinal Office action of February 6, 2003, has been received.

In view of the above, the petition for the entry of late papers is sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

The petition is **granted**.

CONCLUSION

1. The petition is **granted**.

2. The reexamination file will be forwarded to Technology Center 1600 for consideration of the response to the nonfinal Office action of February 6, 2003.

3. Further inquiries with regard to this reexamination proceeding should be directed to the examiner, Terry McKelvey, of Group Art Unit 1636.

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

September 16, 2003

90006226.091403

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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WWW.USPTO.GOV

7/22/03
#11

JANIS K. FRASER, ESQ.
FISH AND RICHARDSON
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FOR PATENT OWNER

LOUIS GUBINSKY, ESQ
SUGHRUE, MION PLLC
2100 PENNSYLVANIA AVENUE, NW
WASHINGTON, DC, 20037-3213

FOR REQUESTER

In re Tsai et al	:
Reexamination Proceeding	:
Control No.: 90/006,227	:
Filed: February 27, 2002	:
For: U.S. Patent No. 6,228,875	: DECISION MERGING
	: REEXAMINATION
In re Tsai et al	: PROCEEDINGS
Reexamination Proceeding	:
Control No.: 90/006,539	:
Filed: February 6, 2003	:
For: U.S. Patent No.6,228,875	:

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.6,228,875 issued May 8, 2001.

2. A first request for reexamination, Control No. 90/006,227, was filed by third party requester on February 27, 2002.

3. Reexamination was ordered in the '227 reexamination proceeding on May 17, 2002.

4. A second request for reexamination, Control No. 90/006,539, was filed by third party requester on February 6, 2003.

5. Reexamination was ordered in the '539 reexamination proceeding on April 3, 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 both of the above noted reexamination proceedings. Accordingly, merger of the proceedings under 37 CFR 1.565(c) is appropriate. The delay in merging these proceedings is regretted.

DECISION

Merger of Proceedings.

In accordance with 37 CFR 1.565(c), the '227 and '539 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

Requirement for Same Amendments in Both Proceedings.

Patent Owner is required to maintain the same claims and specification in both files. **Patent Owner is given ONE MONTH within which to provide a housekeeping amendment in the '539 proceeding so that identical claims are in both files.**

Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to both proceedings. **All papers** issued by the Office or **filed by the Patent Owner will contain the identifying data for both files** and will be physically entered in each reexamination file. All **papers filed by the Patent Owner must consist of a single response, filed in duplicate**, each bearing an original signature, for entry in each file. **All papers filed by the Patent Owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office.**

CONCLUSION

Reexamination Control Nos. 90/006,227 and 90/006,539 are merged. The files will be forwarded to the examiner for further consideration.

John Doll
Director, Technology Center 1600

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Paper No. 17 GR

MAILED

JUN 02 2004

REEXAM UNIT

Janis K. Fraser, Esq. (For Patent Owner)
Fish and Richardson
225 Franklin Street
Boston Ma 02110-2804

Enclosure: Copy of initialed Form PTO-1449 submitted by patent owner on May 20, 2003.

Louis Gubinsky, Esq (For Requester)
Sughrue, Mion PLLC
2100 Pennsylvania Avenue, NW
Washington, DC, 20037-3213

Enclosure: Copy of initialed Form PTO-1449 submitted by patent owner on May 20, 2003.

In re Tsai et al Reexamination Proceeding Control No.: 90/006,227 Filed: February 27, 2002 For: U.S. Patent No. 6,228,875	:	DECISION DISMISSING PETITION
In re Tsai et al Reexamination Proceeding Control No.: 90/006,539 Filed: February 6, 2003 For: U.S. Patent No. 6,228,875	:	

This is a decision on the April 19, 2004, patent owner PETITION TO WITHDRAW NOTICE OF INTENT TO ISSUE REEXAMINATION CERTIFICATE. 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.

The petition is dismissed for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 6,228,875 issued May 8, 2001.

2. On February 27, 2002, a first request for reexamination of the '875 patent was filed by a third party requester, and it was assigned Control No. 90/006,227.

3. Reexamination was ordered in the '227 reexamination proceeding on May 17, 2002.

4. On February 6, 2003, a second request for reexamination of the '875 patent was filed by a third party requester, and it was assigned Control No. 90/006,539.

5. Reexamination was ordered in the '539 reexamination proceeding on April 3, 2003.

6. On July 22, 2003, a decision merging reexamination Control Nos. 90/006,227 and 90/006,539 was issued by the Director of Technology Center 1600.

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

8. On April 19, 2004, the patent owner filed the present petition requesting entry and consideration of a proposed amendment submitted as part the petition. Patent owner also is requesting a copy of the initialed (by the examiner) Form PTO-1449 submitted by patent owner with an Information Disclosure Statement (IDS) [1] on May 20, 2003.

[1] The IDS is actually a Prior Art Statement Under 37 CFR 1.501

DECISION ON PROPOSED AMENDMENT

1. The present patent owner petition to withdraw the Notice of Intent to Issue Reexamination Certificate (NIRC) 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, would only be appropriate under 37 CFR 1.182. See MPEP 2287. Accordingly, the petition is being 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 prior art patents or printed publications which raises substantial new question of patentability. A purpose of reexamination is to have the examiner consider, with special dispatch, all of the prior art of record with respect to all claims proposed by the patent owner during the reexamination proceeding. After a complete consideration of the prior art with respect to the claims 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 and claims considered. Once the prosecution on the merits has been closed and the NIRC has been mailed, absent extraordinary circumstances or compelling reasons, no further amendment is considered in the reexamination proceeding. Rather, the certificate will issue showing the results of the concluded prosecution in the reexamination.

In the present instance, no extraordinary circumstances or compelling reasons have been shown which would warrant reopening of prosecution and consideration of the submitted amendments. It is noted that the petition is not accompanied by an unequivocal statement that one or more claims are unpatentable (with an identification of such claim(s)), nor is there an explanation as to how the proffered amendment causes such claim or claims to be patentable.

Patent owner has at this late date in the proceeding presented proposed amendments to the claims, and addition of new claims, that could have been brought to the attention of the examiner at an earlier stage of the proceeding, and the petition has not made a showing of why the amendments should be entered.

2. 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."

In the present instance, the amendment is incorporated within the body of the petition, and thus fails to comply with § 1.4(c). It is to be noted that the petition is being addressed in the Office of Patent Legal Administration, while the amendment would be addressed in the Technology Center by the examiner.

3. If appropriate, a request for reissue of the patent (as it is revised by the reexamination certificate to issue) may be subsequently filed based on the amendment that has been submitted as part of the present petition.

PTO-1449 SUBMITTED MAY 20, 2003

Patent owner has requested a copy of the initialed (by the examiner) Form PTO-1449 submitted by patent owner with an Information Disclosure Statement on May 20, 2003.

A review of the record shows that the Form PTO-1449 submitted by patent owner on May 20, 2003, was indeed initialed and signed by the examiner, and it was dated "10/21/03." A copy of same is accordingly being provided, as requested; it is enclosed with this decision.

CONCLUSION

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

2. A copy of the initialed Form PTO-1449 submitted by patent owner with an Information Disclosure Statement on May 20, 2003, is being provided with this decision to the patent owner and the requester.

3. Any renewed petition under 37 CFR 1.182 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. If a renewed petition is not filed within one month of this decision, the reexamination file will be forwarded for publication of an *ex parte* reexamination certificate in accordance with 37 CFR 1.570 setting forth the results of the reexamination proceeding and not including the amendment proffered as part of the present petition.

5. **All** correspondence relating to this reexamination proceeding should be directed:

By Mail to: Central Reexamination Unit
Office of Patent Legal Administration
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (703) 305-1013
Central Reexamination Unit

By Hand to: Central Reexamination Unit
Crystal Plaza Three-Four, 3D68
2201 South Clark Place
Arlington, VA

6. Telephone inquiries related to the present 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

June 1, 2004
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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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Paper No. 10

Timothy H. Gens
The Technology Law Group
265 Cambridge Avenue
Box 61029
Palo Alto, CA 94306

(For Patent Owner)

Robert H. Jordan, Esq.
Office of Intellectual Property Counsel
3M Innovative Properties Commpany
3M Center, P.O. Box 33427
St. Paul, MN 55133-3427

(For Requester)

MAILED

JUL 2 8 2004

REEXAM UNIT

In re Ferrell, et al.
Reexamination Proceeding
Control No. 90/006,231
Filed: October 25, 2001
For: U.S. Patent No. 5,974,689

DECISION GRANTING PETITION

This is a decision on the patent owner petition filed January 23, 2004, for entry of late papers based upon unintentional delay under 37 CFR § 1.137(b). Patent owner requests entry of a late-filed response to the non-final Office action mailed July 28, 2003. The petition is before the Office of Patent Legal Administration for consideration.

The petition is **granted**.

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 paid by check.

The petition for entry of late papers under 37 C.F.R. § 1.137(b) based upon unintentional delay is **granted** for the reasons indicated below.

DECISION

35 U.S.C. 41(a) states in part:

> The Director shall charge the following fees:
>
> > (7) . . . for an unintentionally delayed response by the patent owner in any reexamination proceeding, . . .

37 C.F.R. § 1.550(e)(2) states:

> (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).

A grantable petition under 37 C.F.R. § 1.137(b) must be accompanied by:

> (1) the 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 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 response to the non-final Office action mailed July 28, 2003, and the petition fee were included with the instant petition.

It should be noted that 37 C.F.R. § 1.137(b)(3) requires a statement that the entire delay in filing the 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.

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 3700 for consideration of the response to the non-final Office action of July 28, 2003.

3. Further inquiries with regard to this reexamination proceeding should be directed to the examiner, Pamela Wilson, of Group Art Unit 3749.

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

July 20, 2004

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UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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Paper No. 10

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265 Cambridge Avenue
Box 61029
Palo Alto, CA 94306

(For Patent Owner)

Robert H. Jordan, Esq.
Office of Intellectual Property Counsel
3M Innovative Properties Commpany
3M Center, P.O. Box 33427
St. Paul, MN 55133-3427

(For Requester)

MAILED

JUL 28 2004

REEXAM UNIT

In re Ferrell, et al.
Reexamination Proceeding
Control No. 90/006,232
Filed: October 25, 2001
For: U.S. Patent No. 6,119,366

DECISION GRANTING PETITION

This is a decision on the patent owner petition filed January 23, 2004, for entry of late papers based upon unintentional delay under 37 CFR § 1.137(b). Patent owner requests entry of a late-filed response to the non-final Office action mailed July 28, 2003. The petition is before the Office of Patent Legal Administration for consideration.

The petition is **granted**.

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 paid by check.

The petition for entry of late papers under 37 C.F.R. § 1.137(b) based upon unintentional delay is **granted** for the reasons indicated below.

DECISION

35 U.S.C. 41(a) states in part:

> The Director shall charge the following fees:
>
> > (7) . . . for an unintentionally delayed response by the patent owner in any reexamination proceeding, . . .

37 C.F.R. § 1.550(e)(2) states:

> (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).

A grantable petition under 37 C.F.R. § 1.137(b) must be accompanied by:

> (1) the 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 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 response to the non-final Office action mailed July 28, 2003, and the petition fee were included with the instant petition.

It should be noted that 37 C.F.R. § 1.137(b)(3) requires a

statement that the entire delay in filing the 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.

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 3700 for consideration of the response to the non-final Office action of July 28, 2003.

3. Further inquiries with regard to this reexamination proceeding should be directed to the examiner, Pamela Wilson, of Group Art Unit 3749.

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

July 20, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED
OCT 28 2005
REEXAM UNIT

Schneck & Schneck
P.O. Box 2-E
San Jose, CA 95109-0005

(For Patent Owner)

Robert H. Jordan, Esq.
Office of Intellectual Property Counsel
3M Innovative Properties Company

(For Third Party Requester)

In re Reexamination Proceeding
Ferrell et al.
Control No. 90/006,232
Filed: October 25, 2001
U.S. Patent No. 6,119,366
Attorney Docket No. SEZ-012

: DECISION GRANTING PETITION

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on September 30, 2005, for entry of late papers based upon unintentional delay.

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

37 CFR 1.137(b) states:

> "*Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by: (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in § 1.17(m); (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section."

The present petition under 37 CFR 1.137(b) includes the requisite response (item 1), a $1500.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3).

The petition for entry of the late papers is granted.

The reexamination proceeding is being returned to Technology Center Art Unit 3749 for further examination and consideration of the response filed September 30, 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, Kenneth Rinehart, in Technology Center Art Unit 3749, who can be reached at 571-272-4881.

Telephone inquiries related to this decision should be directed to Fred A. Silverberg at 571-272-7719.

Fred A. Silverberg

Fred A. Silverberg
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy

Kenneth M. Schor

Conferee: Kenneth M. Schor

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.
90/006,233	03/01/2002	6170960	728256-100123	1539

34026 7590 08/04/2004

JONES DAY
555 WEST FIFTH STREET, SUITE 4600
LOS ANGELES, CA 90013-1025

EXAMINER
SEMBER

ART UNIT	PAPER NUMBER
2875	13

DATE MAILED: 08/04/2004

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
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Alexandria, VA 22313-1450
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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

BRENT P. JOHNSON
SHERIDAN ROSS
1560 BROADWAY, SUITE 800
DENVER, COLORADO 80202

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/006,233*.

PATENT NO. *6,170,960*.

ART UNIT *2875*.

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

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
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ALEXANDRIA, VA 22313-1450
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Paper No. 13

Jones Day
555 W. Fifth Street
Suite 4600
Los Angeles, CA 90013-1025

(For Patent Owner)

Brent P. Johnson
Sheridon Ross
1560 Broadway Suite 1200
Denver, CO 80202

(For Third Party Requester)

In re Anthony MAGLICA)
Reexamination Proceeding)
Control No. 90/006,233)
Filed: March 01, 2002)
For: U.S. Patent No. 6,170,960)
Title: MINIATURE FLASHLIGHT)

DECISION ACCEPTING PAPERS

This is a decision in response to the request to accept the papers filed on June 29, 2004, as having been timely filed on October 10, 2003 and October 09, 2003.

The request is **granted.**

The petitioner asserts that a first communication, including a Power of Attorney and Revocation of Prior Powers by Assignee and a Letter Re Change of Attorney Docket No., were timely filed in the U.S. Patent and Trademark Office (PTO), via Certificate of Mailing, on October 10, 2003. The petitioner further asserts that a second communication, including a Notification of Existence of Prior and Concurrent proceedings and Decisions thereon was filed, via Certificate of Mailing, on October 09, 2003. To support these assertions, the petitioner has submitted a copy of the communications and a copy of a return postcard that properly identifies and acknowledges receipt of the communications by the Patent and Trademark Office on October 10, 2003 and October 09, 2003.

A review of the application file record reveals that the above-identified communications were not of record in the application file and cannot be located. However, M.P.E.P. § 503 states that a

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

The copies of the communications submitted with the instant request are accepted.

The first communication included a Power of Attorney and a Change of Address. These papers have been processed and all further communications will be addressed to the patent owner as indicated above.

A review of the application file record reveals that the Office action of March 26, 2004 was mailed to an incorrect address. Accordingly re-mailing the Office action is appropriate.

The application file is being forwarded to the Technology Center 2800 support staff for re-mailing the Office action of March 26, 2004. The shortened statutory period for response set therein will be reset to run two months from the date the Office action is re-mailed. Extensions of time are governed by 37 C.F.R. 1.550(c).

Thereafter the application will be forwarded to the examiner for appropriate action, as a result of the second communication including an Information Disclosure Statement.

Janice A. Falcone, 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

#8

Paper No. 38/8

Paul S. Madan
MADAN, MOSSMAN & SRIRAM, P.C.
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Houston, Texas 77057

(For Patent Owner)

MAILED

MAY 29 2002

TECHNOLOGY CENTER 2800
SPECIAL PROGRAM CENTER

29 MAY 2002

Thomas S. Birney
DORR, CARSON, SLOAN & BIRNEY
3010 East Sixth Avenue
Denver, Colorado 80206

(For Third Party Requester)

In re Joram Agar
Reexamination Proceeding
Control No. 90/004,524
Filed: January 22, 1997
For U.S. Patent No. 4,774,680

In re Joram Agar
Reexamination Proceeding
Control No. 90/006,236
Filed: March 6, 2002
For U.S. Patent No. 4,774,680

DECISION MERGING REEXAMINATION PROCEEDINGS

The above-identified reexamination files are before the Group Director of Examining Group 2850, Technology Center 2800, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 4,774,680 issued on September 27, 1988.

2. A first request for reexamination, Control No. 90/002,684, was filed by the patent owner on March 27, 1992.

3. Reexamination was ordered for the '2684 reexamination proceeding on May 20, 1992.

4. A first Reexamination Certificate B1-4,774,680 was issued October 12, 1993, with the patentability of claims 1 through 16 being confirmed and new claims 17 through 34 being allowed.

5. A second request for reexamination, Control No. 90/004,524, was filed by the third party requester on January 22, 1997.

6. Reexamination was ordered for the '4524 reexamination proceeding on April 8, 1997.

7. A first Office action was issued on January 27, 1998, wherein the patentability of claims 22, 23, 32 and 33 was confirmed and claims 1-21, 24-31 and 34 were rejected as being unpatentable.

8. An amendment was filed on March 11, 1998, amending claims 2 through 6 and 14 through 16.

9. A second Office action was issued May 22, 1998, wherein the patentability of claims 1 through 21, 24 through 31 and 34 was confirmed and claims 22, 23, 32 and 33 were rejected as being unpatentable.

10. A response was filed on July 20, 1998, and supplemented on July 24, 1998. No amendment was made to the claims.

11. A final rejection was issued on September 23, 1998, wherein claims 22, 23, 32 and 33 were finality rejected and the patentability of claims 1 through 21, 24 through 31 and 34 was confirmed.

12. A Notice of Appeal was filed on November 23, 2000.

13. An Appeal Brief was filed on January 20, 1999.

14. An Examiner's Answer was mailed on December 2, 1999.

15. A Reply Brief was filed on January 24, 2000.

16. A Response to The Reply Brief was mailed on April 25, 2000.

17. A decision on appeal was issued on August 22, 2000, affirming the final rejections of claims 22, 23, 32 and 33.

18. A Request for Rehearing was filed on October 25, 2000.

19. The Request for Rehearing was denied in a decision mailed November 22, 2000.

20. An Appeal to the Federal Circuit was filed on January 9, 2001.

21. An Appeal Brief was filed by the patent owner/appellant April 27, 2001.

22. A corrected Appeal Brief was filed by the patent owner/appellant on May 15, 2001.

23. An Appeal Brief by the Director of the USPTO/Appellee was filed on June 25, 2001.

24. A Reply Brief by the patent owner/appellant was filed July 25, 2001.

25. A third request for reexamination, control No. 90/006,236, was filed on March 6, 2002, by the patent owner along with an amendment to claims 2 and 15.

26. Reexamination was ordered for the '6236 reexamination on April 5, 2002.

27. A joint motion to remand the '4943 reexamination proceeding was made to the Federal Circuit.

28. The '4943 reexamination proceeding was remanded to the USPTO in a decision, issued April 10, 2002, granting the joint motion to remand.

29. Both the '4943 and '6236 reexamination proceedings are now pending in front of the USPTO. A statement by the patent owner pursuant to 37 C.F.R. § 1.530(b) was not received for the '6236 reexamination proceeding.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

> If reexamination is ordered while a prior reexamination proceeding is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570.

As noted in the above noted facts, reexamination has been ordered in both of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is appropriate.

DECISION

I. Merger proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '4524 and '6236 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Three Proceedings.

As noted above, the claims have been amended in the '4524 and '6236 reexamination proceedings. The claims in the '4524 reexamination proceeding are not the same as the claims in the '6236 reexamination proceeding. The patent owner is required to maintain the same claims and specification in both files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in both files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

III. Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for both files and will be physically entered in each reexamination file. All

papers filed by the patent owner must consist of a single response, filed duplicate, each bearing an original signature, for entry in each file. All papers filed by the patent owner must be served on the requester and requester will be sent copies of all papers mailed by the Office.

CONCLUSION

Reexamination Control Nos.'4524 and '6236 are merged. Patent owner has **one month** from the date of this decision to submit an appropriate "housekeeping" amendment. Upon receipt of the "housekeeping" amendment, an Office action will be issued in due course.

Henry Thau for

Howard N. Goldberg, Group Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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Dayton, OH 45402

(For Requester)

MAILED

NOV 02 2006

CENTRAL REEXAMINATION UNIT

In re Maryann Lehmann MURLJACIC	:
Reexamination Proceeding	:
Control No.: 90/006,247	: DECISION ON PETITION
Filed: March 14, 2002	: UNDER 37 CFR 1.182
For: U.S. Patent No.: 5,766,006	:
Certificate Issued: February 22, 2005	:

This is a decision on the October 20, 2005 patent owner petition titled PETITION UNDER 37 C.F.R. § 1.182. This is also a decision on the patent owner's October 20, 2005 REQUEST FOR CERTIFICATE OF CORRECTION UNDER 37 C.F.R. §§ 1.322 and 1.323.

The petition and request are before the Office of Patent Legal Administration.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182, has been charged to the deposit account No. 50-1814.[1]

The petition, and the request for a certificate of correction, are dismissed for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 5,766,006 (the '006 patent) issued on June 16, 1998.

2. The Office recorded an assignment of the '006 patent from Maryann Lehmann to "Tooth Shade Analyzing Technologies, Inc." on December 8, 1998.[2]

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[1] 37 CFR § 1.182 states, "Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f)" (emphasis added). Pursuant to 37 CFR § 1.17(f), the fee for filing a petition under 37 CFR § 1.182 is $400, not $130 as suggested in the present petition. Accordingly, the required fee of $400 has been charged to petitioner's deposit account.

3. A request for reexamination of the '006 patent was filed on March 14, 2002. The request was assigned control No. 90/006,247 (the '6247 proceeding).

4. In the '6247 proceeding, the Office issued a final Office action on April 15, 2004.

5. A telephone interview between the examiner and the patent owner's representative was conducted on June 10, 2004.

6. The patent owner filed a first Amendment After Final on June 14, 2004. The examiner did not enter this amendment.

7. The patent owner filed a Second Amendment After Final on September 13, 2004.

8. An *Ex Parte* Reexamination Certificate issued for the '6247 proceeding on February 22, 2005.

9. On October 5, 2005, the patent owner recorded a document to correct an error on the cover sheet recorded December 8, 1998 regarding the name of the assignee of record.

DECISION

Petitioner requests a Certificate of Correction for the *ex parte* Reexamination Certificate (reexamination certificate) issued February 22, 2005, for the '006 patent. Petitioner requests amendment of claims 3, 7, and 13, and petitioner also seeks correction of the name of the assignee of record identified on the reexamination certificate.

Requested Claim Amendments due to Patent owner Error

Petitioner seeks correction of three alleged errors in the claims listed in the reexamination certificate issued February 22, 2005. Petitioner requests that the word "and" be deleted from the portion of claim 3 appearing in column 2, line 16 of the reexamination certificate. Also, petitioner seeks inclusion of the phrase "to be altered" after the word "tooth" in line 2 of claims 7 and 13.[3] As discussed in detail below, the present petition does not demonstrate that the errors for which correction is sought meet the statutory requirements for issuance of a certificate of

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[2] The cover sheet recorded on December 8, 1998, identified the assignee as "Tooth Shade Analyzing Technologies, Inc." The assignment submitted with the cover sheet identified the assignee as "Shade Analyzing Technologies, Inc."

[3] Claim 14 was renumbered as claim 13 for publication purposes at the conclusion of the '6427 reexamination proceeding. The phrase "claim 13" as used herein refers to claim 14, renumbered as claim 13 for publication.

correction.[4] Although a certificate of correction would not be appropriate in this instance, the patent owner may wish to consider the filing of a reissue application to address the alleged errors in claims 1, 7 and 13.

35 USC § 255 states:

> Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent and Trademark Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Director may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination. Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form.

In re Arnott [5] discussed the two statutory requirements that must be met before a certificate of correction for an applicant mistake pursuant to 35 USC § 255 may issue. The first statutory requirement concerns the nature, i.e., type, of the mistake for which a correction is sought. The mistake must be:

1. Clerical in nature,
2. Typographical in nature, or
3. A mistake of minor character.

The second statutory requirement concerns the nature of the proposed correction. The correction must not involve changes that would:

1. Constitute new matter, or
2. Require reexamination.

If the above requirements are not satisfied, then a certificate of correction for a patent owner's mistake will not issue, and reissue must be employed as the vehicle to "correct" the patent. Usually, any mistake affecting claim scope must be corrected by reissue. A mistake is not considered to be of the "minor" character required for the issuance of a certificate of correction, if the requested change would materially affect the scope or meaning of the patent.[6]

Addition of "and" to Claim 3

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[4] *See* 35 U.S.C. § 255, *and* MPEP 1481.
[5] 19 USPQ2d 1049, 1052 (Comm'r Pat. 1991).
[6] MPEP 1481.

The patent owner does not explain how the alleged error regarding the duplicate inclusion of the word "and" in claim 3 meets the two statutory requirements of § 255.[7] For example, the petitioner does state in the petition that the second inclusion of the word "and" in claim 3 (column 2, line 16 of the reexamination certificate) was a clerical or typographical error. Similarly, the petitioner does not explain how the removal of the instance of the word "and" in question will not constitute new matter or require reexamination. Furthermore, neither the present petition nor the request for a certificate of correction explains why claim 3 was not amended in accordance with 37 CFR 1.530(d) and (f) when the word "and" was added. For at least these reasons, the present petition does not satisfy the requirements of § 255, and a certificate of correction reflecting the requested amendment to claim 3 is not proper.

Addition of "to be altered" to claims 7 and 13

The language that petitioner seeks to add to claims 7 and 13 was first presented in a non-entered Amendment After Final filed June 14, 2004. It was again presented in these same claims in the Second Amendment After Final filed September 13, 2004.[8]

In the present Request for a Certificate of Correction, petitioner fails to explain how the phrase "to be altered" meets the statutory requirements for the issuance of a certificate of correction set forth above. Petitioner also fails to explain how this amendment is proper for a certificate of correction, especially in view of the patent owner's express statement in the remarks accompanying the amendment of September 13, 2004, that the examiner had informed the patent owner that inclusion of the phrase "to be altered" *raised new issues* that would not be considered in the '6427 reexamination proceeding.[9] Furthermore, petitioner has not explained why the phrase "to be altered" remained in the versions of these claims presented in the amendment of September 13, 2004, when the patent owner's comments accompanying the claim amendments expressly stated "the Patent Owner cannot present such an amendment during this procedure." Until petitioner explains why these requested amendments are proper for a certificate of correction and how they satisfy the statutory requirements of § 255, no certificate including these amendments shall be issued.

For the reasons set forth above, the petition is dismissed as to this aspect of the requested relief.

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[7] The word "and," for which deletion is requested, first appeared in the second after final amendment filed September 13, 2004.

[8] Patent owner used the identifier "previously presented" for claims 7 and 14 despite these claims never having been previously entered by the examiner.

[9] See page 10, second paragraph, of the Second Amendment After Final filed September 13, 2004 (Patent owner states, "During the interview and prior to finalizing the amendment, Patent Owner's attorneys discussed the possibility of writing claims 7 and 14 in independent form, and to amend those claims to more explicitly recite that the image that is displayed is of the tooth to be altered, rather than the surrounding teeth, rather than the surrounding teeth. . . . The Examiner noted that this would raise new issues that would require further search and consideration. For that reason, the Patent Owner cannot present such an amendment during this procedure."(emphasis added)).

Name of Assignee

On October 5, 2005, a date after both the '006 patent and the related reexamination certificate issued, the Office recorded a document filed by the patent owner that changed the assignee of record for the '006 patent from "Tooth Shade Analyzing Technologies, Inc." to "Shade Analyzing Technologies, Inc." Petitioner now seeks a certificate of correction to change the name of the assignee listed on the reexamination certificate for the '006 patent from "Tooth Shade Analyzing Technologies, Inc." to "Shade Analyzing Technologies, Inc."

No Office Error in Patent or Reexamination Certificate

Petitioner's attention is directed to 35 USC § 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, "upon the application made and the specification sworn to by the inventor," 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. This statute, however, makes no provision for issuance of a patent to an assignee by way of an assignment or other conveyance recorded, or submitted for recordation, after issuance of the patent, as the application is then no longer pending but is rather an issued patent. Likewise, § 152 makes no provision for the Office to issue a reexamination certificate to an assignee based upon the recordation of an assignment or other conveyance **after** the reexamination certificate has issued.

In this instance, the patent owner recorded an assignment of the '006 patent from Maryann Lehmann to "Shade Analyzing Technologies, Inc." on December 8, 1998, using a cover sheet that incorrectly identified the assignee as "Tooth Shade Analyzing Technologies, Inc." When the title report was generated during the reexamination proceeding, the Office properly identified the assignee as that listed on the recorded cover sheet, - "Tooth Shade Analyzing Technologies, Inc." [10] A document correcting the assignee name on the originally recorded cover sheet (correcting the assignee name from "Tooth Shade Analyzing Technologies, Inc." to "Shade Analyzing Technologies, Inc.") was recorded by the patent owner on October 5, 2005, a date after the issuance of both the '006 patent and the reexamination certificate. Since the correction of the patent owner error occurred after the issuance of the reexamination certificate, the Office properly issued the reexamination certificate in the name of "Tooth Shade Analyzing Technologies, Inc."

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[10] The record of the reexamination proceeding does not include a patent owner statement under 37 CFR 3.73(b) indicating that title of the '006 patent was in "Shade Analyzing Technologies, Inc."

It would appear that the patent owner is asserting that the mistake that occurred during the reexamination proceeding was patent owner's failure to file a statement under 37 CFR 3.73(b) to establish the ownership of Shade Analyzing Technologies, Inc., of the '006 patent. If such is the case, the patent owner may file a second petition for a certificate of correction to the reexamination certificate requesting that the assignee name be corrected and a 37 CFR 3.73(b) statement establishing that title of the patent rests in Shade Analyzing Technologies, Inc.[11]

CONCLUSION

1) The petition is dismissed.

2) A copy of this decision is also being placed in the file of the present reexamination proceeding, and is also being placed in the file of U.S. Patent No. 5,766,006, which is the patent that was subjected to Reexamination Proceeding 90/006,427.

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

November 1, 2006
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[11] In view of 37 CFR 3.81(b) and MPEP 1481, a certificate of correction to the patent would not be proper because it cannot be stated that the assignment submission was submitted for recordation as set forth in 37 CFR 3.11 before issuance of the "patent." Instead, the assignment was submitted for recordation almost 6 months after the issuance of the '006 patent.

UNITED STATES PATENT AND TRADEMARK OFFICE

SEP 24 2002

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

Paper No. 9

Banner & Witcoff, Ltd.
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1001 G Street, NW
Washington, DC 20001-4597

(For Patent Owner)

Maryann Pierce Perttunen
39577 Woodward Avenue
Suite 300
Bloomfield Hills, MI 48304-5086

(For Requester)

In re Southwest Die Corporation	:	
Reexamination Proceeding	:	
Control No. 90/006,248	:	Decision on Petition
Filed: March 15, 2002	:	
For: U.S. Patent No. 5,676,302	:	
	:	

This is a decision on the petition filed by Patent Owner on July 12, 2002, concurrently with Patent Owner's Statement filed pursuant to 37 CFR 1.530(b). The petition is being considered under 37 CFR 1.181. No fee is required. It is noted that on September 12, 2002, during consideration of the petition, Requester filed a Reply to the Statement and Petition under 37 CFR 1.535.

The petition is dismissed.

Patent Owner requests that the Order Granting Request for Ex Parte Reexamination (Order) be vacated on the grounds that one of the documents relied upon as the basis for the Order is not a printed publication. Reexamination must be based upon patents or printed publications. 35 USC § 303.

37 CFR 1.181 provides that a petition may be taken to the Commissioner from any action or requirement not subject to appeal to the Board of Patent Appeals and Interferences (BPAI), or to a court. The question of whether a reference is a printed publication has long been the subject of appeal to the Board of Patent Appeals and Interferences. MPEP 2128 *et seq* contains numerous citations to court decisions, many of which are appeals from prior decisions on appeal to the BPAI. These decisions deal with a number of aspects of the general question of whether a given reference is in fact a printed publication. It is clear that during the *ex parte* phase of this reexamination proceeding, this general question will be one which is proper for appeal pursuant to 35 USC §§ 134, 141 and 145, and pursuant to the 37 CFR 1.191, and 1.301 *et seq.*

Patent Owner cites MPEP § 2246, subsection entitled "Petition to Vacate the Order Granting

Reexamination", as authority for the proposition that a petition may be filed to vacate an Order granting reexamination when that Order is not based upon patents or printed publications. However, careful review of that subsection shows that the meaning of that statement is that a petition will lie where it is clear that the reexamination Order is *ultra vires*, that is where there is no discretion to grant reexamination and the reexamination was clearly granted without jurisdiction under 35 USC § 303 to do so, as for example when an Order granting reexamination is based upon an allegation of public use and sale. In other words, it is one thing to assume jurisdiction under 37 CFR 1.181 when it is clear that a reexamination proceeding has been based upon subject matter outside of 35 USC § 303. It is quite another to assume petition jurisdiction to decide a question on petition when such jurisdiction only arguably exists, and historically the matter is not petitionable.

In this proceeding, it is far from clear that the Order is based upon other than patents or printed publications. To construe the language of MPEP § 2246 to mean that a petition would lie when an Order granting reexamination is based upon a reference which either may or may not be a printed publication would be to interpret MPEP § 2246 as converting an issue historically determined to be an appeal issue into a petitionable issue. In effect, holding that this matter is petitionable in this proceeding would be to beg the very question upon which the petition is premised. Patent Owner fails to set forth any reason to support such a construction of MPEP § 2246, or why it is otherwise necessary to vacate the present Order in order to prevent any prejudice or damage to Owner, as opposed to simply proceeding to the *ex parte* prosecution phase of this proceeding wherein it may well be determined that the reference in question is not a printed publication, either by the examiner upon reconsideration, or ultimately on appeal.

Because the question of whether a reference is a printed publication has historically been a matter resolved upon appeal, and because to do so in this proceeding will in no way prejudice Owner's rights, there is no basis for holding that the undersigned should intervene by way of a decision on the merits of this petition and by doing so convert an appeal matter into a matter resolved by petition. Accordingly, this proceeding is being forwarded to the examiner for *ex parte* examination pursuant to 37 CFR § 305 and 37 CFR 1.550 *et seq.* The examiner is directed to consider the material set forth in Patent Owner's Statement, and Requester's Reply, and to carefully consider the issue with respect to whether all of the prior art references relied upon are patents or printed publications. The examiner's findings with respect to that issue must be set forth in the first *ex parte* action on the merits.

PETITION DISMISSED.

E. Rollins-Cross, Director, Patent
Examining Groups 3210 & 3720

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.
90/006,249	03/19/2002	5744161	108064-00068	6464

4372 7590 07/19/2005

ARENT FOX PLLC
1050 CONNECTICUT AVENUE, N.W.
SUITE 400
WASHINGTON, DC 20036

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/19/2005

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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ARENT FOX PLLC
1050 CONNECTICUT AVENUE, N.W.
SUITE 400
WASHINGTON DC 20036

(For Patent Owner)

MAILED
JUL 19 2005
REEXAM UNIT

In re Reexamination Proceeding	:
Majeed et al.	:
Control No. 90/006,249	: DECISION GRANTING PETITION
Filed: March 19, 2002	:
U.S. Patent No. 5,744,161	:
Attorney Docket No. 108064-00068	:

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on July 5, 2005, to revive the present reexamination preceding.

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

37 CFR 1.137(b) states:

> "*Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by: (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in § 1.17(m); (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section."

The present petition under 37 CFR 1.137(b) includes the requisite response (item 1), a $1500.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3).

The petition is granted.

A review of the record reveals that a petition for extension of time under 37 CFR 1.136(b) along with a check for $200.00 accompanied the present petition to revive. In view of the above, the petition for extension of time is deemed moot. The $200.00 petition fee will be refunded to counsel's deposit account No. 01-2300 after the mailing of this decision.

Thereafter, the reexamination file will be returned to Technology Center Art Unit 1615 for

further examination and consideration of the Notice of Appeal filed July 5, 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, Jyothsna Venkat, in Technology Center Art Unit 1615, who can be reached at 571-272-0607.

Telephone inquiries related to this decision should be directed to Fred A. Silverberg at 571-272-7719.

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

Conferee: Fred A. Silverberg

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Paper No. 15

ARENT FOX KINTNER PLOTKIN & KAHN PLLC
1050 CONNECTICUT AVENUE, NW, SUITE 400
WASHINGTON DC 20036-5339

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MAY 21 2004
OFFICE OF PETITIONS

In re Reexamination Proceeding No. 90/006,250
For Patent No. 5,972,382
Issue Date: October 26, 1999
Attorney Docket No. 108064-00069

ON PETITION

This is a decision on the petition filed February 4, 2004, which is being treated as a petition under 37 CFR 1.181 to review the decision of the Certificates of Correction Branch which refused, absent a petition under 37 CFR 1.183, to accept the correction of the assignee on the front page of the Reexamination Certificate published on March 4, 2003.

The petition is **dismissed**.

Petitioner requests issuance of a certificate of correction in the reexamination proceeding certificate in the names of "Sabinsa Corporation, Piscataway, NJ (US) and Sami Chemicals & Extracts (P) Ltd., Bangalore (IN)."

Petitioner states that he disagrees with the decision of the Certificates of Correction Branch mailed December 3, 2003 insofar as it requires a petition to correct the assignee data on the Reexamination Certificate, "because the assignment of an undivided one-half interest by Sabinsa Corporation to Sami Chemicals & Extracts (P) Ltd., Bangalore, India was recorded on September 6, 2000, after the patent had been issued and before the mailing of the Notice of Intent to Issue Reexamination Certificate." Petitioner further complains that "[t]he granting of the Reexamination Certificate did not involve any Issue Fee Transmittal that requires applicants to provide the correct names of the assignees."

Petitioner is correct in asserting that a petition under 37 CFR 1.183 to correct or change the assignee data is not the appropriate avenue of relief as there is no like provision for printing assignee data on the Reexamination Certificate as there is on a regular utility, design, or plant application. Unfortunately, petitioner is incorrect in assuming there is an error in the patent in not naming Sami as a co-assignee, much less that there is an error correctable by a Certificate of Correction.

The communication from the Certificates of Correction Branch erred in suggesting that a petition under 37 CFR 1.183 was required. Rather, that only applies when 37 CFR 3.81 was not complied with at the time the issue fee was remitted. *See* MPEP 1481. However, 37 CFR 3.81 requires that the assignment be already recorded, or submitted for recordation, at the time the issue fee is paid. That only can occur when the application is pending and the patent has not yet issued. In this regard, 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 USPTO may issue a patent to the assignee of record of a pending application, or an assignee whose assignment was submitted for recordation against a pending application, at the USPTO. This 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. That is, the statute does not authorize the USPTO to issue a patent to an assignee by way of an assignment that is recorded, or has been submitted for recordation, **after** the patent has issued. Likewise, this statute does not provide for a reexamination certificate to reflect that the previously issued patent in fact issued to an assignee not of record, or submitted for recordation at the time the patent issued. In other words, any change in the record assignee **after** issuance of the patent is immaterial as to whom the patent could have issued while it was pending.

The Reexamination Certificate is merely a document which reflects the status of all claims upon conclusion of the reexamination proceedings. *See* 35 U.S.C. § 307. A Reexamination proceeding is a proceeding applied to an issued patent, not to a pending application. *See* 35 U.S.C. § 305. There is no like provision in reexamination proceedings to either provide assignee data to be printed on the Reexamination Certificate or to request a correction or change to the assignee data. Further, as pointed out by petitioner herein, an assignment in the names of both of the assignees sought to be added on the Reexamination Certificate was submitted for recordation after the issuance of the original patent. Petitioner is reminded that an application may issue in the name(s) of the assignee(s) consistent with the application's assignment where a request for such issuance along with the processing fee is submitted after the date of payment of the issue fee, **but prior to issuance of the patent,** provided the assignment has been previously recorded or submitted for recording in the Office. If the assignment had been recorded or submitted for recordation **prior to issuance of the original patent**, and there was a discrepancy in the assignee's name between what was recorded or submitted for recordation, and what appeared on the as-printed

patent, then it would have been appropriate for issuance of a Certificate of Correction in the original patent as suggested by Certificates of Correction Branch. In view of the circumstances of this case, issuance of a Certificate of Correction would be improper and as such none will be forthcoming.

In other words, there is no error in the original patent in not reflecting the post-issuance conveyance of some of Sabinsa Corporation's rights in this patent to Sami Chemicals & Extracts. The reexamination proceeding did not, and could not, change this circumstance. There is simply no error correctable in this patent within the meaning of 35 U.S.C. § 254 or even § 255. A Certificate of Correction does not lie and will not be issued.

A copy of this decision is also being placed in the file of U.S. Patent No. 5,972,382, which is the patent subject of Reexamination Proceeding 90/006,250.

This file is being returned to the Files Repository.

Any questions concerning this matter may be directed to the undersigned at (703) 305-8680.

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
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OCT 16 2002

Reexamination Control No. 90/005,948 – Paper No. 18
Reexamination Control No. 90/006,251 – Paper No. 18

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

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Joel R. Petrow, Esq. (For Patent Owner)
Smith & Nephew, Inc.
1450 Brooks Road
Memphis, TN 38116

MAILED

JUN 21 2005

REEXAM UNIT

Alan E. Shluzas et al	:	
Reexamination Proceeding	:	**DECISION**
Control No. 90/006,253	:	**GRANTING**
Filed: March 22, 2002	:	**PETITION**
For: U.S. Patent No. 6,051,006	:	

This is a decision on the June 2, 2005, patent owner [1] PETITION TO REVIVE APPLICATION UNDER 37 CFR § 1.137(b), requesting revival of the present proceeding under the "unintentional" standard.

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

The petition 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 a statement "that the entire period of delay was unintentional." 37 CFR 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 CFR 1.137(b) was unintentional. Since the statement contained in the instant petition varies from the language required by 37 CFR 1.137(b)(3), the statement contained in the instant petition is being construed as the statement required by 37 CFR 1.137(b)(3), and petitioner must notify the Office if this is not a correct interpretation of the statement contained in the instant petition.

---

[1] The petition was filed by Ido Rabinovitch, who has been accorded limited recogr under 37 CFR 11.9(b) (expiring March 30, 2006) by the Director of Enrollment and Dicipl a paper attached to the petition.

In addition, a "NOTICE OF APPEAL..." was filed with patent owner's June 2, 2005 petition, thereby providing the "reply required to the outstanding Office action or notice" pursuant to 37 CFR 1.137(b)(1). Further, the required petition fee of $1500 set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b) has been paid by check, 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.

CONCLUSION

1. The petition under 37 CFR 1.137(b) is **granted**.

2. The reexamination proceeding is being returned to Technology Center 3700.

3. Telephone inquiries related to the examination of the reexamination proceeding should be directed to Examiner Gary Jackson of Art Unit 3731 at (571)272-4697.

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

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6-17-05

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,254	03/26/2002	6196681	CAO 0266R	6190

90/006,118 7590 09/18/2002

Charles Heiken, Esq.
Fish and Richardson PC
225 Franklin Street
Boston, MA 02110-2804

EXAMINER
Mai

ART UNIT	PAPER NUMBER
2873	7

DATE MAILED: 09/18/2002

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

90006254.091802

PTO-90C (Rev. 07-01)

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

Charles Heiken, Esq. Fish & Richardson, PC 225 Franklin Street Boston, MA 02110-2804	:	(for patent owner)
Michael A. Cantor, Esq. Cantor Colburn LLP 55 Griffin Road South Bloomfield, CT 06002	:	(for requester)
In re Canavan Reexamination Proceeding Control Number 90/006,118 Filed: September 28, 2001 For: U.S. Patent No. 6,196,681 Title: Eye Covering	:	
In re Canavan Reexamination Proceeding Control Number 90/006,254 Filed: March 26, 2002 For: U.S. Patent No. 6,196,681 Title: Eye Covering	:	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. 6,196,681 issued on March 6, 2001.

2. A first request for reexamination, Reexamination Control No. 90/006,118, was filed by a third party requester on September 28, 2001.

3. Reexamination was ordered in the '118 reexamination proceeding on December 11, 2001.

4. A second request for reexamination, Reexamination Control No. 90/006,254, was filed by the third party requester on March 26, 2002.

5. Reexamination was ordered in the '254 reexamination proceeding on June 7, 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* 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 '118 and '254 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. 90/006,118 and 90/006,254 are merged. The reexamination files are being forwarded to the examiner for issuing a first Office action.

Janice A. Falcone

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Michael A. Cantor, Esq.
CANTOR COLBURN LLP
55 Griffin Road South
Bloomfield, CT 06002.

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/006,254*.

PATENT NO. *6,196,681* .

ART UNIT *2873* .

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)).

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Paper No. 15

DAVIS WRIGHT TREMAINE, LLP
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(For Patent Owner)

Calvin B. Ward
The Law Offices of Calvin B. Ward
18 Crow Canyon Court
Suite 305
San Ramon, CA 94583

(For Requester)

MAILED
SEP 23 2003
REEXAM UNIT

In re Cooledge, et al.
Reexamination Proceeding
Control No. 90/006,261
Filed: April 4, 2002
For: U.S. Patent No. 5,258,214

DECISION GRANTING PETITION

This is a decision on the May 12, 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 **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 and 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 January 10, 2003, has been received.

In view of the above, the petition for the entry of late papers is sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

The petition is **granted**.

CONCLUSION

1. The petition is **granted**.
2. The reexamination file will be forwarded to Technology Center 1700 for consideration of the response to the nonfinal Office action of January 10, 2003.

3. Further inquiries with regard to this reexamination proceeding should be directed to the examiner, Donald J. Loney, of Group Art Unit 1772.

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

September 16, 2003

90006261.091603

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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DEC 24 2002

Paper No. 12

David E. Dougherty
Dougherty and Troxell
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Falls Church VA 22041

(For Patent Owner)

Ronald P. Kananen
Rader Fishman and Grauer
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Suite 501
Washington, DC 20036

(For Requester)

Alan L. Unikel
Seyfarth Shaw
55 E. Monroe Street
Suite 4200
Chicago, IL 60603

(For Requester)

In re CMC Magnetics Corporation
Reexamination Proceeding
Control No. 90/006,223
Filed: February 20, 2002
For: U.S. Patent No. 6,283,282

In re CMC Magnetics Corporation
Reexamination Proceeding
Control No. 90/006,266
Filed: April 15, 2002
For: U.S. Patent No. 6,283,282

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.

Preliminary Matters

On July 28, 2002, papers were filed in the '266 reexamination proceeding on behalf of Owner. These papers were an Owner's Statement, a preliminary amendment, and a Substitute Power of Attorney. The amendment was entered. It is noted, however, that the amendment was entered in part because the proposed amendment to the drawings failed to comply with 37 CFR 1.530(d), penultimate sentence. The Owner's Statement was entered. However, the Substitute Power of

Attorney was not accepted because it was not signed by a person having apparent authority to bind Owner. Owner was notified of this defect, and was requested to submit a proper substitute power of attorney in both reexamination proceedings, and was informed that failure to do so would communication would only be with counsel then of record in the proceedings, and not with new counsel. Owner has not filed a proper substitute power of attorney.

Merger of Copending Reexamination Proceedings

I. Merger of Proceedings

As required by the practice pursuant to MPEP § 2283, and under the authority of 37 CFR 1.565(c), the '223 and '266 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. 6-11 in Control No. 90/006,223.

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. Each 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 Requesters are reminded that any 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" claims and paragraphs in which specification amendments are requested must be filed together with material satisfying the requirements of 37 CFR 1.530(e).** All words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets. New drawing figures must be labeled "New", while amended drawing figures must be labeled "Amended".

IV. Housekeeping Amendment

As discussed above, Owner filed a preliminary amendment in control No. 90/006,0266 That amendment has been entered except for the proposed amendment to the drawings. Therefore, Owner is required to file a housekeeping amendment in control No. 90/006,223 entering the identical claims therein. That paper will be paper No. 13 in control No. 90/006,223. There will then be no paper No. 13 in 90/006,266, 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. 90/006,223. The next action by the Primary Examiner will then be paper No. 14 in both files. **Owner is required to file the housekeeping amendment not later than ONE MONTH from the date of this decision.** Attention is invited to MPEP § 2282, subsection entitled "Merger of Reexaminations", last paragraph.

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

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

BAKER BOTTS L.L.P. (For Patent Owner)
PATENT DEPARTMENT
98 SAN JACINTO BLVD., SUITE 1500
AUSTIN, TX 78701-4039

Enclosure: Copy of Notice mailed April 18, 2005 (2 pages)

COPY MAILED
JUL 11 2005
OFFICE OF PETITIONS

In re Stevens et al.	:	
Reexamination Proceeding	:	**DECISION**
Control No. 90/006,270	:	**DISMISSING**
Filed: April 24, 2002	:	**PETITION**
For: U.S. Patent No. 6,029,558	:	

This is a decision on the June 24, 2005 patent owner petition titled NON-FEE PETITION UNDER 37 C.F.R. § 1.181 TO REVIVE HOLDING OF ABANDONMENT, which is properly taken as a petition under 37 CFR 1.181 requesting withdrawal of the termination of the present reexamination proceeding.

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

The petition under 37 CFR 1.181 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 1.181."

DECISION ON PETITION UNDER 37 CFR 1.181

The reexamination proceeding was terminated under 37 CFR 1.550(d) for failure to timely respond to the Notice of Defective Paper in *Ex Parte* Reexamination mailed April 18, 2005. On instant petition, petitioner asserts that the Notice was never received by the patent owner.

A review of the file for the present reexamination proceeding reveals no irregularities in the mailing of the Notice of Defective Paper in *Ex Parte* Reexamination, as mailed on April 18, 2005. Receipt of the change of address to customer number 31625 (Baker Botts) filed in this proceeding on May 17, 2004 was made of record in the file. A review of the record confirms that the Notice was properly mailed to the patent owner at the correspondence address of record. Thus, there is a strong presumption that the correspondence was properly mailed to, and received by, the patent owner at the correspondence address of record. In the absence of demonstrated irregularities in mailing of the April 18, 2005 Notice, petitioner must submit evidence to overcome this presumption.

Section 711.03(c), part II, of the Manual of Patent Examining Procedure sets forth that a grantable petition establishing non-receipt 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 instant 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 April 18, 2005 Notice was not received. Nor does the petition include a copy of the docket record(s) where the non-received Office communication would have been entered had it been received and docketed.

In view thereof, the petition is **DISMISSED**. This decision is made without prejudice to reconsideration upon a timely submission of the items required to establish non-receipt.

ALTERNATE VENUE

Alternatively, petitioner has the option to seek revival of the reexamination prosecution, pursuant to under 37 CFR 1.137, based on either unintentional or unavoidable delay.

A grantable petition for entry of belated papers under 37 CFR 1.137(b) must be accompanied by (1) the response required to the outstanding Office action or notice, unless previously filed; (2) the petition fee (set forth in 37 CFR 1.17(m)) required by law; and (3) a proper 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.

A grantable petition for entry of belated papers under 37 CFR 1.137(a) must be accompanied by (1) the response required to the outstanding Office action or notice, unless previously filed; (2) the petition fee (set forth in 37 CFR 1.17(l)) required by law; and (3) a showing to the satisfaction of the Director 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(a) was unavoidable.

A proposed response to the April 18, 2005 Notice of Defective Paper in Ex Parte Reexamination accompanied the filing of the instant petition. However, petitioner indicates that this response is prepared based on a telephone conversation with the examiner. A copy of the Notice accompanies this decision for petitioner's convenience in determining whether the proposed response is sufficient.

CONCLUSION

1. The petition under 37 CFR 1.181 is **dismissed**.

2. For the granting of the instant petition, it is required that the patent owner provide:

   (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.

   If petitioner desires to make the required submissions in order to complete the instant petition, the submissions should be included in a cover letter entitled "Renewed Petition under 37 CFR 1.181."

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. If the petitioner chooses to file a petition to revive under either 37 CFR 1.137(a) or (b), the patent owner must comply with the requirements of those provisions, as set forth in the regulations and repeated in the body of this decision.

   If the petitioner desires to make the required submissions in order that a petition under § 1.137 be granted, the submissions should be included in a cover letter entitled "Petition under 37 CFR 1.137(a)" or "Petition under 37 CFR 1.137(b)" depending upon the avenue of requested relief chosen by petitioner.

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

   By U.S. Postal Service Mail:

   Mail Stop *Inter Partes* Reexam
   Central Reexamination Unit
   Office of Patent Legal Administration
   United States Patent & Trademark Office
   P.O. Box 1450
   Alexandria, VA 22313-1450

   By FAX to: (571) 273-0100
   Central Reexamination Unit
   Attention: Nancy Johnson

   By hand (or delivery service):

   Customer Service Window
   Randolph Building
   401 Dulany St.
   Alexandria, VA 22314

6. Telephone inquiries related to this decision should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

C:\Kiva\kpet-abe\6270_WD_Dismiss.wpd
July 11, 2005

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United States Patent and Trademark Office
Washington, D.C. 20231
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BAKER BOTTS L.L.P. (For Patent Owner)
PATENT DEPARTMENT
98 SAN JACINTO BLVD., SUITE 1500
AUSTIN, TX 78701-4039

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OFFICE OF PETITIONS

In re Stevens et al.	:	
Reexamination Proceeding	:	**DECISION**
Control No. 90/006,270	:	**GRANTING**
Filed: April 24, 2002	:	**PETITION**
For: U.S. Patent No. 6,029,558	:	

This is a decision on the August 11, 2005 patent owner RENEWED NON-FEE PETITION UNDER 37 C.F.R. § 1.181 TO REVIVE HOLDING OF ABANDONMENT, which is properly taken as a petition under 37 CFR 1.181 requesting withdrawal of the termination of the reexamination proceeding.

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

The petition under 37 CFR 1.181 is **GRANTED**.

DECISION ON RENEWED PETITION UNDER 37 CFR 1.181

The reexamination proceeding was terminated under 37 CFR 1.550(d) for failure to timely respond to the Notice of Defective Paper in *Ex Parte* Reexamination mailed April 18, 2005. On June 24, 2005, patent owner filed the initial petition, asserting that the Notice was never received by Applicants. By decision mailed July 11, 2005, the petition was dismissed without prejudice to reconsideration upon timely submission of the items required to establish non-receipt.

On instant renewed petition, petitioner submitted a statement from the practitioner attesting to the fact that a search of the

file jacket and docket records indicates that the Office communication was not received. In addition, petitioner included a copy of the docket record where the non-received Office communication would have been entered had it been received and docketed. Petitioner has thus overcome the presumption of proper mailing of the Office action to the correspondence address of record.

In view thereof, the petition is **GRANTED**, and the holding of terminated reexamination proceedings is hereby **WITHDRAWN**.

It is noted that a response (reply) to the April 18, 2005 Notice of Defective Paper in Ex Parte Reexamination accompanied the filing of the initial petition filed June 24, 2005. In addition, a copy of the Notice was forwarded to petitioner with the petition decision mailed July 11, 2005. Petitioner has a copy of the Notice, and there is, thus, no need to re-mail the Notice to patent owner.

CONCLUSION

1. The petition under 37 CFR 1.181 is granted.

2. The reexamination file is being returned to Technology Center 3641 to address the response to the April 18, 2005 Notice of Defective Paper in Ex Parte Reexamination filed on June 24, 2005.

3. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Michelle Clement, in Technology Center 3641, who can be reached at (571) 272-6884.

4. Telephone inquiries related to this decision should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

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Baker Botts L.L.P.
Patent Department
98 San Jacinto Blvd.
Suite 1500
Austin, TX 78701-4039

(For Patent Owner)

MAILED
MAY 01 2006
REEXAM UNIT

In re Reexamination Proceeding :
Stevens et al. :
Control No. 90/006,270 : DECISION GRANTING PETITION
Filed: April 24, 2002 :
U.S. Patent No. 6,029,558 :
Attorney Docket No. 090936.0451 :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on March 9, 2006, for entry of late papers based upon unintentional delay.

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

37 CFR 1.137(b) states:

> "*Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by: (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in § 1.17(m); (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section."

The present petition under 37 CFR 1.137(b) includes the requisite response - Request For Reconsideration (item 1), a $750.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3).

The petition for entry of the late papers is granted.

$750.00 has been charged to counsel's deposit account no. 50-2148 in accordance with the present petition.

Jurisdiction over the reexamination proceeding is being returned to Technology Center Art Unit 3641 for further examination and consideration of the Request For Reconsideration filed March 9,

2006, 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, Michelle Clement, in Technology Center Art Unit 3641, who can be reached at 571-272-6884.

Telephone inquiries related to this decision should be directed to Fred A. Silverberg at 571-272-7719.

Fred A. Silverberg
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy

Conferee: Kenneth M. Schor

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

#8

Paper No. 8

MAILED

OCT 10 2002

Office of the Director
Group 3600

C. Jean Domingue (For Patent Owner)
Domingue & Waddell, PLC
First National Bank Towers
600 Jefferson Street, Suite 515
Lafayette, LA 70501

In re Reexamination Proceeding No. 90/006,281	:	**REQUEST FOR**
Filed: May 6, 2002	:	**EXTENSION OF TIME**
For: U.S. Patent No. 6,250,387	:	*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 September 24, 2002.

An Order Granting Reexamination was mailed on August 1, 2002 wherein a shortened statutory period for a Patent Owner's Statement of two months was set. Patent Owner requests an extension of time of one month to submit a statement to the August 1, 2002 Grant Order. The reasons for the request are that the patent owner's U.K. attorney experienced a death in the family and the U.S. attorney being located in Louisiana has had to contend with Hurricane Isidore. These delays resulted in insufficient time for the attorneys to consult with the patent owner in the preparation of a Patent Owner's Statement in response to the August 1, 2002 Order Granting Reexamination.

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 November 1, 2002.

Further extensions of time to respond to the Office action should not be expected, and will be granted only in extraordinary circumstances.

SUMMARY: Request **GRANTED**.

Steven N. Meyers
Special Programs Examiner
Technology Center 3600
(703) 308-3868

Concur:
Gerald Goldberg,
Director,
Technology Center 3600
(703) 308-1134
Facsimile (703) 308-2177

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OFFICE OF THE DIRECTOR
TC 3600

For the Patent Owner:

Seed Intellectual Property Law Group PLLC
701 Fifth Ave., Suite 6300
Seattle, WA 98104-7092

In re Reexamination proceeding 90/006,281
Filed: May 6, 2002
For: APPARATUS FOR CATCHING DEBRIS IN A WELL-BORE

DECISION ON PETITION FOR THE ACCEPTANCE OF LATE PAPERS

This is in reply to petitioner's communication filed August 5, 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 Amendment submitted by the patent owner in response to the Office action of August 13, 2003, was apparently lost by the Office. The patent owner has submitted a copy of the above-noted amendment along with a post card receipt that indicates a timely receipt date. This is acceptable evidence of a timely filing of the lost amendment.

The reexamination file is being forwarded to the Supervisory Legal Instruments Examiner to accept the amendment from the patent owner filed August 5, 2004 as timely filed.

Steven N. Meyers
Patent Technology Center 3600
(703) 308-3868

SM/SM: 9/15/04

#10

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Howard & Howard Attorneys, P.C.
The Pinehurst Office Center, Suite 101
39400 Woodard Avenue
Bloomfield Hills, MI 48304-5151 (For Patent Owner)

MAR 29 2005

Collard & Roe, P.C.
1077 Northern Boulevard
Roslyn, NY 11576 (For Requester)

Young & Basile, P.C.
3001 West Big Beaver Road, Suite 624
Troy, MI 48084-3107 (For Requester)

In Re Xiluo et al. Reexamination Proceeding Control No. 90/006,284 Filed: May 8, 2002 For: US Patent Number 6,260,472	DECISION, *SUA SPONTE*, MERGING REEXAMINATION PROCEEDINGS
In Re Xiluo et al. Reexamination Proceeding Control No. 90/006,384 Filed: September 16, 2002 For: US Patent Number 6,260,472	

The above noted reexamination files are now before the Director of Technology Center 3700 for consideration of merger of the proceedings under 37 CFR 1.565(c), in accordance with the practice set forth at MPEP § 2283. It is noted that Requester Collard & Roe, P.C. has filed the '284 proceeding and Requestor Young & Basile, P.C. has filed the '384 proceeding.

I. Merger of Proceedings

As required by the practice pursuant to MPEP § 2283, and under the authority of 37 CFR § 1.565(c), the '284 and '384 reexamination proceedings are hereby MERGED. The merged proceedings 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. Currently, no amendments have been made. All future submissions by Owner must continue to be served on both Requesters. The contents of each file will thereafter be maintained identically. The request for a certificate of correction and director's report were processed in Control No. 90/006,284. A copy of these papers has been placed in Control No. 90/006,384.

III. Conduct of Merged Proceedings

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. The Requesters 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 Requesters, even papers filed *via* facsimile transmission.

An office Action by the examiner will follow. 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

Reëxamination Control Nos. 90/006,284 and 90/006,384 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.

Owner has filed a request to combine dual Reexaminations and a Change of Address. It is noted that these papers were not served on the Requesters. A copy of these papers will be provided to the Requesters and will act as the certificate of service. Owner should not expect the Office to serve papers in the future.

Richard A Bertsch

Richard Bertsch, Director
Technology Center 3700

Attachments for third party requesters only:
Request for certificate of correction
Director's Report
Request to combine dual Reexaminations
Change of Address

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FEB 10 2005

OFFICE OF THE DIRECTOR
TC 3600

Reexamination Control No. 90/006,286

FOR PATENT OWNER:

Pillsbury Winthrop LLP
Intellectual Property Group
1600 Tysons Boulevard
McLean, VA 22102

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 February 2, 2005.

A Notice of Appeal was filed on December 7, 2004 from which a shortened statutory period of two months for an Appeal Brief to be filed runs. Patent Owner requests an extension of time of one month to submit an Appeal Brief. The reason for the request is that a petition for Supervisory Review filed on January 4, 2005 has not yet been decided. The decision rendered in response to this petition will impact the content of the Appeal Brief.

An extension of time for the Patent Owner to submit an Appeal Brief is **GRANTED** for a period of one month. The period for response will expire on March 7, 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**.

Steven N. Meyers
Special Programs Examiner
Technology Center 3600
(703) 308-3868

Concur:
John Love
Director
Technology Center 3600
(703) 308-1020

Sm: 2/6/05

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MAY 17 2005

For the Patent Owner:

Pillsbury Winthrop LLP
Intellectual Property Group
1600 Tysons Boulevard
McLean, VA 22102

In re Reexamination Proceeding of: :
DECISION ON PETITION
Paul Artemi : **UNDER 37 C.F.R. 1.181**
Control No. 90/006,286
Filed May 10, 2002
For: Device for Holding Garment Hangers

This is a decision on the Petition under 37 C.F.R. 1.181 from the Examiner's refusal in Advisory Action of December 7, 2004 under 37 CFR 1.116 and 1.530 to enter an After Final Amendment filed October 4, 2004 in the above-captioned reexamination proceeding.

Petitioner asserts that the amendment after final (1) does not raise new issues that would require further consideration and/or search; (2) does not conform with 37 CFR 1.530 because the "changes are not relative to the patent claim," and "only the claim being amended in this amendment are to be included"; and (3) "present a corresponding number of finally rejected claims."

37 CFR 1.116(c) states in part "they <u>may</u> be admitted upon a showing of <u>good</u> and <u>sufficient</u> reasons why they are <u>necessary</u> and were <u>not earlier presented</u>. (Underline added for emphasis)

Petitioner's amendment after final (1) raised new issues that would have required further consideration and/or search and (2) presented additional claims without canceling a corresponding number of finally requested claims.

In regards to the new issue question the phrase "located on an exterior of the ring and facing internally with respect to the hook" and "wherein the ring and the hook are formed continuously together as one piece from the plastics material" are clearly positive recitations, which are new to the claims under final rejection.

Concerning the presentations of additional claims, petitioner had claims 1-7 at the time of final. The amendment after final presented claims 1-3 and 5-10. Thus, there were two more claims after final than at final. It is noted that the petitioner did not amended the claims after the first office action and that the same rejections were made in the final rejection as in the first office action.

Petitioner's assertion that the positive insertion into the claims of limitations which had been previously argued but not positively recited as not being a new issue, is not persuasive. It is deemed that the insertion of such new limitations after final would cause further consideration and search on the part of the examiner.

The Reexamination Proceeding is being forward to the examiner for her consideration of the SUPPLEMENTAL AMENDMENT AFTER FINAL UNDER 37 CFR 1.116 filed January 4, 2005 and to the petitioner's APPEAL BRIEF filed March 7, 2005.

Any questions regarding this decision should be directed to Leslie A. Braun at 571-272-6815.

SUMMARY: The petition is DENIED.

John Love, Director
Patent Technology Center 3600
Tel. (571) 272-5250
Facsimile No. (703) 872-9306
LAB:snm 5/2/05

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PILLSBURY WINTHROP SHAW PITTMAN

MAY 18 2005

CL 23003 MT# 280879
ATTY(S) ART/BPC
DUE:
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For the Patent Owner:

Pillsbury Winthrop LLP
Intellectual Property Group
1600 Tysons Boulevard
McLean, VA 22102

In re Reexamination Proceeding of:
DECISION ON PETITION
Paul Artemi
Control No. 90/006,286
Filed May 10, 2002
For: Device for Holding
Garment Hangers

: UNDER 37 C.F.R. 1.181

This is a decision on the Petition under 37 C.F.R. 1.181 from the Examiner's refusal in Advisory Action of December 7, 2004 under 37 CFR 1.116 and 1.530 to enter an After Final Amendment filed October 4, 2004 in the above-captioned reexamination proceeding.

Petitioner asserts that the amendment after final (1) does not raise new issues that would require further consideration and/or search; (2) does not conform with 37 CFR 1.530 because the "changes are not relative to the patent claim," and "only the claim being amended in this amendment are to be included"; and (3) "present a corresponding number of finally rejected claims."

37 CFR 1.116(c) states in part "they may be admitted upon a showing of good and sufficient reasons why they are necessary and were not earlier presented. (Underline added for emphasis)

Petitioner's amendment after final (1) raised new issues that would have required further consideration and/or search and (2) presented additional claims without canceling a corresponding number of finally requested claims.

In regards to the new issue question the phrase "located on an exterior of the ring and facing internally with respect to the hook" and "wherein the ring and the hook are formed continuously together as one piece from the plastics material" are clearly positive recitations, which are new to the claims under final rejection.

Concerning the presentations of additional claims, petitioner had claims 1-7 at the time of final. The amendment after final presented claims 1-3 and 5-10. Thus, there were two more claims after final than at final. It is noted that the petitioner did not amended the claims after the first office action and that the same rejections were made in the final rejection as in the first office action.

Petitioner's assertion that the positive insertion into the claims of limitations which had been previously argued but not positively recited as not being a new issue, is not persuasive. It is deemed that the insertion of such new limitations after final would cause further consideration and search on the part of the examiner.

The Reexamination Proceeding is being forward to the examiner for her consideration of the SUPPLEMENTAL AMENDMENT AFTER FINAL UNDER 37 CFR 1.116 filed January 4, 2005 and to the petitioner's APPEAL BRIEF filed March 7, 2005.

Any questions regarding this decision should be directed to Leslie A. Braun at 571-272-6815.

SUMMARY: The petition is DENIED.

John J Love

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(For Patent Owner)

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OCT 31 2005

REEXAM UNIT

In re Paul Artemi
Reexamination Proceeding
Control No.: 90/006,286
Filed: May 10, 2002
For: U.S. Patent No.: 5,584,455

: **DECISION**
: **DENYING**
: **PETITION**

This is a decision on the June 23, 2005 patent owner petition entitled "PETITION TO THE DIRECTOR OF THE USPTO 'IN PERSON' UNDER 37 CFR 1.181." Patent owner requests review of the Technology Center Director's decision on petition dated May 17, 2005, and direction that the amendment after final rejection filed October 4, 2004 be entered.

The petition is before the Director of the Office of Patent Legal Administration for consideration. Although the petition is addressed to the Director of the USPTO in person, inasmuch as the authority for deciding petitions requesting entry of amendments has been delegated to the Technology Center Directors, [1] and since a Technology Center Director has rendered a decision on a request for entry of an amendment, the term "in person" is treated as a request for review of the Director's decision by a higher official.

The petition is granted to the extent that the Technology Center Director's May 17, 2005 decision has been reviewed, but is denied as to making a change in that decision - for the reasons set forth below.

BACKGROUND

1. U.S. Patent No. 5,584,455 (hereinafter the '455 patent) issued on December 17, 1996 and contains claims 1-7.

2. Patent owner filed a request for *ex parte* reexamination [2] of the '455 patent on May 10, 2002, and the resulting reexamination proceeding was assigned Control No. 90/006,286 (hereinafter the '6286 proceeding).

3. Reexamination was ordered on August 8, 2002.

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[1] See MPEP § 1002.02(c).
[2] 35 U.S.C. § 302.

4.. On February 25, 2003, a first Office action was issued, rejecting patent claims 1, 3, 4 and 6, and confirming patent claims 2, 5 and 7.

5. On March 26, 2003, a personal interview with patent owner was conducted by the examiner.

6. On April 25, 2003, patent owner filed a timely response to the February 25, 2003 Office action. The response did not include any amendment to the patent claims, but included remarks in which patent owner argued that the claim rejections were improper. The response acknowledged the interview and stated that patent owner's remarks incorporated the arguments presented at the interview. The response also included a 37 CFR 1.132 declaration executed by the inventor.

7. On August 7, 2004, a final rejection [3] was mailed. Patent claims 1, 3, 4 and 6 were again rejected and claims 2, 5 and 7 were again confirmed. The grounds of rejection are the same grounds that were set forth in the February 25, 2003 Office action.

8. On October 4, 2004 patent owner filed an amendment document after final action, to amend patent claim 1, to cancel patent claim 4, and to add new claims 8-10. [4]

9. On October 7, 2004, patent owner filed a detailed summary of the March 26, 2003 personal interview.

10. On December 7, 2004, patent owner filed a notice of appeal together with the appeal fee. [5]

11. Also on December 7, 2004, the Office mailed an advisory action,[6] stating that the amendment after final action filed on October 4, 2004 would not be entered, and providing reasons in support of the Office's refusal to enter the amendment.

12. On January 4, 2005, patent owner filed a petition under 37 CFR 1.181 seeking relief from the examiner's refusal to enter the October 4, 2004 amendment after final rejection.

13. On March 7, 2005, patent owner filed an appeal brief. [7] The appeal brief was timely filed by reason of an extension of time pursuant to 37 CFR 1.550(c) which was granted on February 10, 2005.

14. On May 17, 2005, the Technology Center Director dismissed the January 4, 2005 petition under 37 CFR 1.181.

15. On June 6, 2005, an examiner's answer [8] was mailed by the Office.

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[3] 37 CFR 1.113.
[4] The Image File Wrapper (IFW) does not contain this amendment as originally filed. It appears that the amendment was not "scanned in" to the IFW. Patent owner supplied a copy of the amendment on March 1, 2005, and the copy is of record in the IFW file.
[5] 37 CFR 41.31(a)(3).
[6] MPEP § 714.13(III).
[7] 37 CFR 41.37.
[8] 37 CFR 41.39.

16. On June 23, 2005, patent owner filed the present petition, requesting (a) review of the Technology Center Director's decision on petition dated May 17, 2005, and (b) direction that the amendment after final rejection filed October 4, 2004 be entered.

17 On August 4, 2005, a reply brief [9] was filed by patent owner. It does not appear that the examiner has considered the reply brief.

GROUNDS ASSERTED AS WARRANTING THE RELIEF REQUESTED

In the present June 23, 2005 petition, the patent owner alleges that the Technology Center Director's refusal to direct entry of the October 4, 2004 amendment after final rejection was erroneous because:

I. Patent owner was deprived of a full and fair opportunity to pursue its claim amendments;[10]

II. The Technology Center Director's finding that the October 4, 2004 amendment after final rejection presented new issues requiring further consideration and/or search as a basis for denying entry of the January 4, 2005 petition was clearly erroneous because:

   A. The amendment did not raise any "significant" new issues, since the limitations added by the amendment had been previously "dealt with substantively"; [11] and

   B. Patent owner had "good cause" for not amending after the first office action because patent owner believed that the claims as originally presented and examined already contained the limitations added by the amendment after final rejection. [12]

III. The Technology Center Director's reliance on procedural issues under 37 CFR 1.530 as a basis for denying the January 4, 2005 petition was clear error because:

   A. The amended claims in fact conformed to the requirements of 37 CFR 1.530; [13] and

   B. The presentation of new claims 8-10 did not present any new burden on the examiner , since these claims were simply the previously allowed (*i.e.*, confirmed) claims rewritten in independent form and were ultimately presented in underlined format as required by 37 CFR 1.530.

DECISION

1. Patent Owner Had a Full and Fair Opportunity to Pursue Its Claim Amendments.

The record does not show that patent owner was deprived of a full and fair opportunity to amend the patent claims. The record shows that after the first Office action dated February 25, 2003 a personal interview was held with the examiner. The record further shows that the interview did not result in the examiner agreeing with patent owner's position that the

[9] 37 CFR 41.41.
[10] Petition, pages 3-4.
[11] Petition, pages 5-7.
[12] Petition, pages 7-8.
[13] Petition, pages 9-10.

rejections set forth in the first Office action were improper. [14] Despite the fact that an amendment to the claims was permitted, of right, in the reexamination proceeding [15] at that point in the prosecution, patent owner **elected** to file a response to the February 25, 2003 Office action that did not amend the rejected patent claims. Instead, patent owner filed a response, on April 25, 2003, relying solely upon argument of counsel and opinion evidence in the form of a 37 CFR 1.132 declaration by the '455 patentee. [16] Patent owner **chose** to prosecute the application prior to final rejection by arguing that the that the examiner's interpretation of the claim language was overly broad or unreasonable, and chose to rely upon the opinion of the '455 patentee as being dispositive on the issue of how the patent claims would be construed by one of ordinary skill in the art. In the response to the February 25, 2003 first Office action, patent owner could easily have included new claims addressing the examiner's position as to the scope of the claim language, while also retaining the rejected patent claims "as-is" and providing arguments that they were patentable without amendment. Patent owner **chose** not to do so.

Patent owner also makes much of the fact that this is a reexamination proceeding and not the "traditional application process" [17] in which there are "several routes" by which patent rights can be secured such as the use of a continuation application [18] or Request for Continued Examination (RCE). [19] Patent owner provides no explanation, however, as to why, given patent owner's awareness of the limitations inherent in reexamination proceedings, patent owner did not simply provide amended versions of the rejected claims while at the same time retaining the unamended patent claims and continuing to argue that the examiner's first Office action rejections were in error. As pointed out above, the patent owner could have easily prosecuted the proceeding after the first Office action by presenting amended versions of the rejected claims while retaining the original patent claims without amendment and submitting both argument and factual showings in support of patent owner's belief that the existing patent claims were patentable over the prior art relied upon in the first Office action. Patent owner **elected** not to amend the claims, notwithstanding that the regulations are clear that final rejection practice fully applies to reexamination proceedings. [20]

2. The Refusal to Direct Entry of Amendment After Final Rejection Filed on October 4, 2004 Was Not Clear Error

A. The October 4, 2004 Amendment After Final Action Clearly Raises New Issues

Patent owner argues that the October 4, 2004 amendment after final rejection did not raise any new issues because the April 25, 2004 response to the first Office action and the August 7, 2004 final rejection shows that the amendment after final action had already dealt with the limitations added to the claims by the amendment after final rejection. [21] Patent owner's position seems to be that: the claims as originally filed and examined in the first Office action

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[14] In particular, see both the examiner's interview summary record dated March 26, 2003 and, in particular, the patent owner's summary of that interview filed, in compliance with 37 CFR 1.560(b), on October 7, 2003.
[15] 37 CFR 1.550(b); MPEP § 2266.
[16] See response filed April 25, 2003.
[17] Petition, page 2.
[18] 37 CFR 1.53(b).
[19] 37 CFR 1.114.
[20] See 37 CFR 1.550(a), which states that Sections 1.104-1.116 of Title 37apply to reexamination *ex parte* reexamination proceedings. Therefore, Sections 1.113 and 1.116, which govern after final practice, apply to *ex parte* reexamination proceedings.
[21] Petition, page 5.

contained limitations that patent owner *believed to be* inherent in the unamended claims; thus, the addition of language to the claims that added these limitations to the claims does not present a "significant" new issue - because the limitations were already in the claim by implication. This argument is not persuasive, because the argument **assumes** the correctness of patent owner's position regarding the proper construction of the unamended patent claims. From the examiner's point of view, however, the addition of express language to the claims after final rejection certainly presented claims that were more limited than the finally rejected claims, [22] and the issue of whether or not the more limited claims were in fact patentable was properly considered to be a new issue touching the merits of the merits, for which additional consideration and/or search would be required. Patent owner's belief that the unamended claims contained certain inherent limitations is entitled to no more weight than the examiner's belief that the claims did not contain these inherent limitations. Thus, the matter of the new issue is clearly raised by the amendment. It is further to be noted that that if patent owner's position is correct that the unamended claims contained the added limitations as inherent limitations, there would be no reason to present the amendment, and patent owner is not harmed by the non-entry of same. In this instance, the reliance by patent owner on more than what it considers to be inherent is presented for the first time after final rejection, and this is a new issue to be considered. As pointed out above, the patent owner was aware of the examiner's position that the limitations at issue were not deemed inherent by the examiner after first Office action, and yet chose to wait until after the issuance of the final rejection before squarely presenting the question of the claims containing the limitations at issue before the Office. Amendments after final action are appropriately refused entry under such circumstances. [23]

Not only is it is clear the scope of claim 1 was, *prima facie*, significantly narrowed by the proposed amendment after final action, it is equally clear from that record that there was a disagreement over the scope of the claims. The examiner's interview summary dated March 26, 2003 stated, *inter alia*, that "[t]he examiner believes that the Robertson patent meets the limitations of the claim invention ..." and that no agreement was reached at the interview. Patent owner's October 7, 2003 summary of the same interview appears to confirm that when presented with numerous arguments concerning the correct interpretation of claim 1, the examiner had expressed her belief that the claims were not so limited as patent owner believed them to be. Therefore, it is clear from the record that patent owner and the examiner both "knew" that there was **an** issue as to the scope of the claims that were the subject of the first Office action. This does not mean, however, that patent owner's amending of the claims after final rejection by adding additional limitations not previously recited in the claims did not raise **a new issue of patentability**. The Technology Center Director correctly found that the amendment after final rejection raised a new issue of patentability, i.e., an issue as to the patentability of the finally rejected claims *as amended to include new limitations*, which the record shows that the examiner did not find present in the claims that were initially and then finally, rejected. [24] Prior to the amendment after final rejection, the Office was faced with resolving the issue of whether the limitations argued to be inherent are indeed inherent. If the amendment at issue were entered, the Office would additionally be faced with resolving the question of whether the claims containing the limitations that would be added are patentable over the art. This change in scope of the issues to be addressed represents a "substantive" change with respect to the scope of the claims as examined prior to the amendment. Far from being a new

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[22] It is noteworthy that the examiner's position had clearly been communicated to patent owner at the interview that occurred prior to the filing of the response to the first Office action.

[23] MPEP § 714.13, subsections (II) and (III).

[24] Decision on Petition dated May 17, 2005.

issue in a "rigid hypertechnical sense", [25] this type of change is a classic example of a new issue presented after final rejection by way of an amendment not earlier presented when the patent owner had an opportunity to do so. The proposed presentation of a new claim that is deemed to be of a different and narrower scope than the corresponding finally rejected version of that claim clearly necessitates additional consideration and/or search, notwithstanding that the examiner was aware that patent owner disagreed with the examiner's interpretation of the finally rejected claims. [26]

B. Patent Owner's Belief That There Existed "Good Cause" For Failing to Amend the Claims After First Action Does Not Establish a Right to Have the Amendment After Final Action Entered

The first of patent owner's arguments supporting the existence of "good cause" for not amending the rejected patent claims prior to the final rejection is that the final rejection dated August 7, 2004 was the first time that the examiner "outright" disagreed with patent owner's interpretation of the claims. [27] This argument appears to be addressed to the question of the propriety of making the August 7, 2004 rejection final (whether the final rejection was presenting a new ground of rejection despite the claims not being amended), rather than to the question of whether the amendment after final rejection was properly refused entry. The two issues are dissimilar, and the Technology Center Director's May 17, 2005 petition decision quite properly does not address the of issue whether the August 7, 2004 Office action was properly made final, because the January 4, 2005 petition did not positively raise the issue of premature finality of the August 7, 2004 Office action. Moreover, since the petition was filed June 23, 2005, almost five months after the August 7, 2004 final rejection was issued, the question of premature finality of the August 7, 2004 Office action would not have been timely, because 37 CFR 1.181(d) states in pertinent part that:

> "Any petition under this part not filed within two months of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period in not extendable."

In addition, it is again noted that both the examiner's record of the March 26, 2003 personal interview and patent owner's October 7, 2003 summary of the same interview, (which took place prior to the final rejection), clearly show *prior to the final rejection* that the examiner did not agree with patent owner's interpretation of the claims.

Patent owner's second argument regarding "good cause" for not earlier presenting the amendment after final rejection is that the claims were believed to be patentable without the amendment, and that the examiner's first Office action was based upon an incorrect claim interpretation. However, the issue of whether the claims were, or were not, properly rejected by the examiner is a matter for appeal, and not for petition. [28] A determination of whether or not the examiner's rejection of the unamended patent claims was proper would have exceeded the scope of the Director's jurisdiction to decide a petition filed under 37 CFR 1.181(a). [29] The record does not establish that patent owner's claim construction was correct and that the

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[25] Petition, page 6.
[26] See MPEP § 714.13, subsections II. and III, which describe the practice implementation of 37 CFR 1.116.
[27] Petition, page 7.
[28] 37 CFR 1.181.
[29] 37 CFR 1.181(a)(1) states in pertinent part: "Petition may be taken to the Director: From any action or requirement of any examiner in *ex parte* ... prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court."

examiner's was erroneous, and the record will not will not resolve that issue (contrary to the examiner's determination) absent a decision on appeal.

Moreover, as discussed above, the patent owner is aware that reexamination proceedings do not contain the numerous options for continuing prosecution subsequent to a final rejection that are available during the prosecution of a nonprovisional application. [30] Patent owner has not alleged that this issue was not recognized during prosecution of the reexamination proceeding prior to final action. Patent owner's mere belief that the examiner's position on the patentability of the claims was incorrect does not satisfy 37 CFR 1.116 which requires that an amendment after final rejection touching the merits of the claims must be supported by a showing of "good and sufficient reasons why the amendment is not necessary and was not earlier presented." Even if it were desired to retain the finally rejected claims for purposes of appeal in the belief that such claims were patentable without amendment, amended versions of the claims could also have been presented subsequent to the first action, with specific explanation as to the reasons why the unamended claims were being retained and amended versions to facilitate prosecution were also being presented.

3. The Technology Center Director's Decision Refusing to Direct Entry of the Amendment After Final Rejection Did Not Rely Upon a Procedural Error Under 37 CFR 1.530 as a Basis for Refusing to Enter the Amendment

A review of the Technology Center Director's Decision dated May 17, 2005, shows that the Technology Center Director's decision merely alluded to 37 CFR 1.530 as being one of the bases set forth in the examiner's advisory action which informed patent owner of the non-entry of the October 1, 2004 amendment after final. However, the Technology Center Director's decision denying relief was not based upon failure to comply with 37 CFR 1.530, and it appears that there was, in fact, compliance with this regulation. Therefore, there is no need to discuss patent owner's first two arguments with respect to the compliance of the amendment after final rejection with 37 CFR 1.530.

4. Refusal to Direct Entry of Amendment After Final Rejection Based on Presentation of Additional Claims Without Canceling a Corresponding Number of Finally Rejected Claims

The patent owner includes an argument in the section of the patent owner's petition in which owner discusses procedural errors under 37 CFR 1.530 section of the petition that does not in fact involve 37 CFR 1.530. This argument [31] briefly addresses the Technology Center Director's holding that the amendment rejection was properly refused entry on the grounds that the amendment presented additional claims without canceling a corresponding number of finally rejected claims. [32] The record shows that the examiner had confirmed the patentability of patent claims 2, 5 and 7. Patent owner argues that the amendment after final rejection merely added new claims 8-10 as claims 2, 5 and 7 rewritten in independent form, and that the resulting

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[30] Attention is invited to the notice entitled "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 published in the March 1, 2005 *Official Gazette*, Volume 1292, No.1. The practice under 37 CFR 1.182 described in the Notice was available prior to the decision on petition dated May 17, 2005, prior to the filing of the Appeal Brief on March 7, 2005, and prior to the issuance of the June 6, 2005 Examiner's Answer. Patent owner could have availed itself of the 37 CFR 1.182 avenue of relief, but patent owner chose rather to file the Appeal Brief and await the Examiner's Answer (together with the filing of the instant petition under37 CFR 1.181).

[31] Petition at page 9, second full paragraph.

[32] Decision on petition, page 2, first paragraph; see also page 9, second full paragraph.

increase in the number of pending claims should not have been a basis for refusing entry of the amendment after final rejection.

An amendment after final rejection may properly be refused entry when it presents additional claims without canceling a corresponding number of finally rejected claims. An amendment after final rejection that increases the number of pending claims does not place the proceeding in better condition for appeal. [33] Therefore, an amendment of that type does not comply with 37 CFR 1.116(b)(2). [34] Since the final rejection confirmed patent claims 2, 5 and 7 as being patentable, there was no requirement to rewrite these claims if patent owner wished to preserve these patent claims without further limiting the overall scope of the claims. The amendment to place claims 2, 5 and 7 in independent form simply did not place those claims in better condition for appeal, but rather required additional effort on the part of the Office to ensure that all of the independent claim limitations were in fact correctly put into the newly re-written claim. More important, the rewriting of the patentable claims permitted the patent owner to amend independent claim 1 to provide a claim with newly provided limitations not previously provided. Thus, the overall number of the claims with differing scope increased. Stated another way, the patent owner elected to amend claim 1, and that amendment after final rejection not only raised a new issue as discussed in Section 2, *supra*, it also required the examiner to consider new claims 8-10 to confirm that they were presented accurately with respect to the existing record, thereby increasing the matters requiring examiner consideration. As noted in *Ex parte* Wirt, 1905 C.D. 47, 117 O.G. 599 (Comm'r Pat. 1905), there is no right to have an amendment after final rejection entered when that amendment increases the matters requiring examiner consideration.

CONCLUSION

1. The petition is granted to the extent that the Technology Center Director's May 17, 2005 decision has been reviewed, but is denied as to making a change in that decision for the reasons set forth below.

2. The patent owner has not established that the Technology Center Director's refusal to enter the amendment after final rejection filed October 4, 2004 was clearly erroneous, or constituted an arbitrary or capricious action amounting to an abuse of discretion.

3. It will not be directed that the October 4, 2004 amendment after final rejection be entered.

4. This decision is a final agency action within the meaning of 5 U.S.C. § 704.

5. The jurisdiction over the proceeding is returned to the Technology Center for transfer to the Board of Patent Appeals and Interferences for decision of the appeal.

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[33] MPEP § 714.13(III), Rev. 2. (May 2004), at page 700-223.

[34] "After a final rejection or other final action (§ 1.113) ... in an ex parte reexamination under § 1.50 ...but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title): An amendment presenting rejected claims in better form for consideration on appeal may be admitted ...."

7. Telephone inquiries with regard to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or, in his absence, to Kenneth M. Schor, Senior Legal Advisor, at (571) 272-7710.

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

Sm/Kms/Rjs
October 31, 2005

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In re Reissue Application of Artemi Application No. 11/397,053 Filed: April 4, 2006 For: U.S. Patent No. 5,584,455	:	**DECISION, *SUA SPONTE*, TO MERGE REISSUE AND REEXAMINATION PROCEEDINGS**
In re Artemi Reexamination Proceeding Control No. 90/006,286 Filed: May 10, 2002 For: U.S. Patent No. 5,584,455	:	

The above-captioned reissue and reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.565(d) at this time.

REVIEW OF FACTS

1. U.S. patent No. 5,584,455 (the '455 patent) issued on December 17, 1996, with 7 claims.

2. A request for reexamination was filed by patent owner on May 10, 2002, and was assigned control No. 90/006,286 (the '6286 proceeding).

3. Reexamination was ordered for the '6286 proceeding on August 8, 2002.

4. Prosecution proceeded in the '6826 proceeding until, on April 4, 2006, patent owner requested that the appeal currently pending before the Board of Appeals and Interferences be withdrawn, and the proceeding be remanded to the examiner for issuance of a NIRC confirming the patentability of dependent claims 2, 5, and 7.

5. An application for reissue of the '455 patent, assigned application No. 11/397,053 (the '053 application), was filed by the patent owner on April 4, 2006.

6. On April 4, 2006, the patent owner filed, in the '6286 proceeding, a notice of concurrent proceeding under 37 CFR 1.565 - informing the Office of the '053 reissue application.

7. On April 6, 2006, the Board of Appeals and Interferences dismissed the appeal of the '6826 proceeding, returning the application to the examiner for further action as appropriate.

8. The filing of the '053 reissue application was announced in the *Official Gazette* on July 25, 2006.

9. Prosecution proceeded on the '053 application until, on December 12, 2008, a nonfinal action was issued by the Office rejecting all pending claims (8-16) on newly discovered art.

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. 11/397,053 and reexamination control No. 90/006,286 are currently pending. The order to reexamine has been mailed in the reexamination proceeding, and notice of the reissue application has been published in the *Official Gazette*. Accordingly, 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, and 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 the reissue and reexamination proceedings and to prevent inconsistent, and possibly conflicting, amendments from being introduced on behalf of the patent owner, it is appropriate that the instant reissue and reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexamination proceeding <u>will be merged</u> in accordance with the decision set forth below.

It is to be noted, however, that the grant of merger of a reissue application and an *ex parte* reexamination proceeding under 37 CFR 1.565(d) **is discretionary**. *The present merger is not an assurance that, in a future similar situation or if a continuation of the present reissue application is filed, merger would be ordered. Likewise, if a Request for Continued*

Examination (RCE) of the present reissue application is filed, there is no assurance that the merger will not be severed.

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-captioned reissue and reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in Both Proceedings

1. The patent owner is required to maintain identical amendments in the reissue application and the reexamination files for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the reissue and reexamination proceedings remain merged. See 37 CFR 1.565(d).

2. A review of the file for reexamination control No. 90/006,286 shows:

(a) Claims 2, 5, and 7 stand confirmed.

(b) Claims 1, 3, 4, and 6 stand cancelled as set forth in an Office action mailed on the same date herewith. Cancellation of these claims was authorized through patent owner's filing of a request to withdraw the appeal on April 4, 2006.

A review of reissue application No. 11/605,488 shows:

(a) Original patent claims 1-7 have been cancelled.

(b) New claims 8-16 were added on October 9, 2007.

At least claims 8-16 in the reissue application are not identical to the claims in the reexamination

proceeding. **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 both proceedings, specifically, Application No. 11/397,053 and Control Number 90/006,286. The response to this requirement must be limited to formally placing the same amendments in all cases, and patent owner must **not** address any issue of patentability in the housekeeping amendment. It is to be noted that, pursuant to MPEP 2285, amendments in a merged reexamination/reissue proceeding are submitted under 37 CFR 1.173, in accordance with reissue practice.

III. Conduct of the Merged Reissue Application Examination and Reexamination Proceedings

1. After the appropriate housekeeping amendment (see Part II above) is received, or after the time for same expires, the examiner should promptly prepare an Office action for the merged proceeding.

2. In the event that a housekeeping amendment is not timely submitted to place the same changes in both proceedings, 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 claim, and thus failing to particularly point out the invention.

3. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. 305 relating to the conduct of *ex parte* reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue-application examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. **However, periods for response should be set at TWO (2) months to comply with the statutory requirement for special dispatch in *ex parte* 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 proceeding. Each action will contain identifying data *for both of the cases*, i.e., the reissue application and the reexamination proceeding, and each action will be entered into both files (which will be maintained as separate files).

5. Any response by the applicant/patent owner must consist of a single response, with two copies being filed for entry in the two files, with each of the two bearing a signature. Any such response must contain identifying data *for both of the cases*, i.e., the reissue application and the reexamination proceeding. *Any such responses must be served on the requester*, who will also be sent copies of Office actions.

6. Pursuant to MPEP 2285, for a merged proceeding containing a reexamination proceeding and a reissue application:

> "Amendments should be submitted in accordance with the reissue practice under ... 37 CFR 1.173; see MPEP § 1453."

Thus, the filing of any amendments to the specification, claims, or drawings must comply with the provisions of 37 CFR 1.173, and with the guidelines of MPEP 1453. It is to be noted that 37 CFR 1.121 does <u>not</u> apply to amendments in a reissue application. Accordingly, clean copies of the amended claims are not required, *and such clean copies are not to be submitted*. Instead, pursuant to 37 CFR 1.173(b)(2), amendments are to be presented via markings pursuant to 37 CFR 1.173(d), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.173(g), all amendments must be made relative to the patent specification, including the claims, and drawings, which are <u>in effect as of the date of filing the reissue application</u>. *Amendments are <u>not</u> to be made relative to previous amendments*. Thus, for all amendments, all words not appearing in the <u>patent</u> are always underlined, and only words being deleted from the <u>patent</u> appear in brackets.

7. Where a paper is filed which requires payment of a fee (e.g., petition fee, excess claims fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for any patent owner appeal brief, even though such a brief would relate to the merged multiple proceedings, and even though copies must be filed (as pointed out above) for each file of the merged proceeding.

8. The examiner (a) will review the files to ensure that each file contains identical citations of prior patents and printed publications, and (b) will cite such documents as are necessary as part of the next Office action in order to place the files in that condition.

9. If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be concluded by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 CFR 1.570. See MPEP 2285.

10. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be dissolved. The reissue application will be held abandoned. The reexamination prosecution will be terminated, and a reexamination certificate under 37 CFR 1.570 will be issued in accordance with the last action of the Office, unless further action in the reexamination proceeding is needed as a result of the difference in the rules relating to reexamination and reissue proceedings. If further action in the reexamination proceeding is needed, any grounds of rejection that are not applicable under reexamination would be withdrawn (e.g., based on public use or on 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 for consideration in reexamination pursuant to 37 CFR 1.552(c).

11. If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 CFR 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue examination as to the reexamination proceeding. Such examination would be conducted as set forth in the immediately preceding paragraph.

PATENT OWNER'S ADDRESS

The patent owner is called upon to clarify and coordinate the patent owner's addresses in (1) the patent, (2) the reissue application and (3) the reexamination proceeding. The current address for the patent and for the reexamination proceeding is Pillsbury Winthrop LLP, Intellectual Property Group, 1600 Tysons Boulevard, McLean, VA 22102. The current address for the reissue application is Pillsbury Winthrop Sway Pittman, LLP, P.O. Box 10500, McLean, VA 22102.

Clarification is needed so that all future correspondence can be directed to a single address for the patent owner. Accordingly, **patent owner is required to, within <u>ONE (1) MONTH</u> of this decision:**

(a) Designate one of the two correspondence addresses and attorneys prosecuting these proceedings as the correspondence address and attorney of record in both proceedings (to provide one address and attorney for the merged proceeding) and the patent file, and

(b) Supply the designated attorney with the power of attorney in the appropriate proceedings.

As a courtesy, this decision is being mailed to both addresses.

CONCLUSION

1. Reissue application No. 11/397,053 and reexamination control No. 90/006,826 **are merged** into a single proceeding.

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

3. The patent owner is further required to, within **ONE MONTH** of this decision **unify the correspondence addresses and attorneys prosecuting these proceedings** as set forth in the last section of this decision. If no address is designated for the merged proceeding, the Office will use the Pillsbury Winthrop Sway Pittman, LLP, P.O. Box 10500, McLean, VA 22102 address because it appears to be more current, as it appears on the last-filed (April 4, 2006) paper in the reexamination, and is the address on the reissue application filed April 4, 2006.

4. Jurisdiction over the merged reissue and reexamination proceeding is being transferred to Technology Center 3600, in which the reissue proceeding is assigned. The examiner assigned the merged proceeding is not to be one who was involved in any part of the examination of the '455 patent (e.g., by preparing/signing an action). See MPEP 2236.

5. The examiner should not issue an Office action for the present merged proceeding until after the earlier of:

   (A) The expiration of the one month period from the mailing of this decision for the filing of (i) the required housekeeping amendment and (ii) the papers unifying the correspondence address and attorney of record in both proceedings or the receipt of such papers, or

   (B) The receipt of both the required amendment and papers.

6. All further examination in the merged proceeding should be conducted in accordance with Part III of this decision.

7. Telephone inquiries related to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.

Kenneth M. Schor
Senior Legal 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 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.

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 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.

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

Leydig, Voit & Mayer, Ltd.
Two Prudential Plaza,
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Chicago, IL 60601-6780

EXAMINER

ART UNIT	PAPER NUMBER
	46

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	**DECISION MERGING REEXAMINATION PROCEEDINGS**
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	

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 <u>not</u> 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

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.
90/006,295	05/20/2002	5288393	4215-4000	8033

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.

90006295 .091502

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. 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	**DECISION MERGING REEXAMINATION PROCEEDINGS**
In re Jessup et al Reexamination Proceeding Control No. 90/006,295 Filed: May 20, 2002 For: U.S. Patent 5,288,393	

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

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
90/005,942	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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Mailed: CST

Paper No. 34

Gregory F. Wirzbicki
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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 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 <u>all</u> 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 <u>all</u> 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.

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

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.
90/006,301	06/06/2002	6360693		9949

7590 10/09/2003

Risto A. Rinne, Jr.
2173 East Francisco Blvd., Suite E
San Rafael, CA 94901

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/09/2003

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

#9

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

Risto A. Rinne, Jr.
2173 East Francisco Blvd., Suite E
San Rafael , CA
94901

(For Patent Owner)

MAILED

OCT 9 2003

Office of the Director
Group 3600

In re Reexam Proceeding No. 90/006,301
Filed: June 6, 2002
For: U.S. Patent No. 6,360,693

DECISION ON PETITION TO RESET A PERIOD FOR REPLY (DEFECTIVE OFFICE ACTION)

This is in reply to the Petition to Reset a Period for Reply Due to a defect in an Office action, received in the Patent and Trademark Office on September 22, 2003. There is no fee required for this petition.

The petition is **GRANTED**.

In accordance with MPEP 710.06, the Office will grant a petition to reset the period for reply to run from the date the error is corrected, when an Office action contains some defect and the error is called to the attention of the Office within one month of the mail date of the action. If the error is brought to the attention of the Office greater than one month after the date of the Office action but before the expiration of the reply period, the Office will set a new period for reply, if requested to do so by the applicant, to substantially equal the time remaining in the reply period. Any such reset period being at least one month. If any such error is not brought to the attention of the Office prior to the expiration of the response period, the period will not be restarted and any response would require the appropriate extension fee to be considered timely.

A review of the file record reveals that a non-final Office action was mailed to the address of record on September 10, 2003. Applicant's petition indicates that the references referred to within the Office action were missing. Applicant's petition was filed within one month of the mailing date of the Office action.

The application is being forwarded to the Supervisory Legal Instruments Examiner to re-mail and re-date the Office action of September 10, 2003, including a copy of the references cited.

Telephone inquiries relative to this decision should be directed to me at the phone number below.

Kenneth J. Dorner

Kenneth J. Dorner, Special Program Examiner
Patent Technology Center 3600
(703) 308-0866
kjd:10/02/03

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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PO Box 1450
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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO.
90/006,312	06/19/2002	6254978	P 30268/0000014	8839

7590 05/02/2003

MORGAN & FINNEGAN, LLP
345 PARK AVENUE
NEW YORK, NY 10154

EXAMINER

ART UNIT	PAPER NUMBER
	11

DATE MAILED: 05/02/2003

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, DC 20231
www.USPTO.gov

Mailed: wak Paper Number _____

In re application of	:	
Bahar at al.	:	DECISION ON
Serial No. 90/006,312	:	
U.S. Patent 6,254,978	:	PETITION
Issue Date: July 3, 2001	:	

This is a PETITION UNDER 37 CFR 1.181 TO CONSIDER PATENT OWNER'S INFORMATION DISCLOSURE STATEMENTS AND VACATE AND REISSUE A COMPLETE OFFICE ACTION ON THE MERITS, filed April 21, 2003.

DECISION

The request is accepted as a petition under the provisions of 37 CFR 1.181 (no fee).

On November 8, 2002, Patent Owner filed a first IDS in accordance with 37 CFR 1.98. A second IDS was filed six days later, on November 14, 2002. On March 21, 2003, a first Office Action was issue indicating a refusal to consider any of the references that were listed on Patent Owner's IDS.

The purpose of reexamination is for consideration of the patent claims in view of prior art patents and publications. Since the IDS submission was timely filed after the order, but prior to the first Office action, it should have been considered , as per MPEP 2256.

The Petition is **Granted**.

The reexamination proceeding will be reassigned and the newly assigned examiner will withdraw the previous action, properly consider the IDS, and prepare a non-final Office Action based on the prior art of record.

Jacqueline M. Stone, Director
Technology Center 1700
Chemical and Materials Engineering

Michael S. Marcus
Morgan & Finnegan, L.L.P.
1775 Eye Street, N.W.
Washington, D.C. 20006-2401

Richard A. Steinberg
Pillsbury Winthrop L.L.P.
Intellectual Property Grp.,
1600 Tysons Blvd.
McLean, VA 22102

#18

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO.
90/006,312	06/19/2002	6254978	P 30268/0000014	8839

7590 12/22/2003

MORGAN & FINNEGAN, LLP
345 PARK AVENUE
NEW YORK, NY 10154

EXAMINER

ART UNIT	PAPER NUMBER
	18

DATE MAILED: 12/22/2003

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
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Mailed: DEC 2 2 2003

td
Paper Number: 18

In re Bahar et al.
Reexamination Proceeding
Control No. 90/006,312
U.S. Patent No. 6,254,978
Issue date: July 3, 2001

DECISION ON PETITION

For: ULTRA-THIN INTEGRAL COMPOSITE MEMBRANE

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION mailed October 10, 2003.

On May 21, 2003, a non-final office action was mailed to applicant rejecting all of the claims under various grounds of rejection. A response was filed by patentees on July 21, 2003 which presented an amendment to the claims. The examiner prepared a final office action which was mailed October 10, 2003.

On November 19, 2003 the instant petition under 37 CFR 1.181 was timely filed to formally request the withdrawal of finality of the October 10, 2003 office action.

Applicants position for the withdrawal of the finality is that no clear issue as been established between the examiner and applicants prior to the final rejection.

DECISION

Section 706.07 of the MPEP states:

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection. Switching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection.

The first office action contained a rejection under 35 USC 103 over JP 64-22932 in view of GB 2091166. The motivation relied upon by the examiner is that it would have been obvious to one of ordinary skill in the art to use a microporous PTFE sheet as the polymeric support for an ion-exchange membrane, motivated by the desire to produce an ion-exchange membrane which has improved toughness, dimensional stability and reduced tearing in all directions.

In the final rejection mailed October 10, 2003, the examiner maintained the aforementioned 35 USC 103 rejection over many of the same claims. Patentees argued that there was no motivation to replace the JP '932 reference's UHMWPE with the GB PTFE membrane to produce a membrane which has improved toughness, dimensional stability and reduced tearing in all directions since the JP reference suggests its membrane already exhibits superior strength. The examiner agreed with this position and presented a new motivation as to why the combination would be obvious.

Petitioner argues that this is a new issue that has not been presented prior to final rejection and therefore is improper. Petitioner is correct in that no clear issue with respect to this ground of rejection has been developed between patentees and the examiner. The examiner has not given patentees a fair chance to respond to the outstanding rejection.

Accordingly, because no clear issue has been developed between the examiner and the patentees; and because the final rejection was not necessitated by Applicant's amendments, the finality was improper and the petition is **GRANTED.**

It is also pointed out that while the finality of the office action has been withdrawn, the rejection still stands. Patentee's time for response to the October 10, 2003 continues to run. It is noted that a petition for a two month extension of time to respond to the outstanding office action has been granted to extend the response period to February 10, 2004.

JMStone

Jacqueline M. Stone, Director
Technology Center 1700
Chemical and Materials Engineering

MICHAEL S. MARCUS
MORGAN & FINNEGAN, L.L.P.
1775 EYE STREET, N.W.
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RICHARD A. STEINBERG
PILLSBURY WINTHROP L.L.P.
INTELLECTUAL PROPERTY GRP.,
1600 TYSONS BLVD.
MCLEAN, VA 22102

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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Paper No. 9

Raymond Van Dyke
Jenkens & Gilchrist, P.C.
3200 Fountain Place
1445 Ross Avenue
Dallas, TX 75202-2799

(for patent owner)

APR - 7 2003

Charles C.H. Wu, Esq.
Wu & Cheung, LLP
7700 Irvine Center Drive, Suite 710
Irvine, CA 92618-3043

(for requester)

In re Farrington *et al.*
Reexamination Proceeding
Control Number 90/006,316
Filed: June 27, 2002
For: U.S. Patent No. 6,166,927

DECISION RETURNING
IMPROPER PAPER

The paper, filed December 31, 2002, by the third party requester, entitled "Follow-up Communication after Telephone Interview with Patent Examiner," is before the Group Director of Technology Center 2800.

Under 37 C.F.R. § 1.540:

> 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 paper filed by the third party requester is not a reply under § 1.535. Accordingly, the paper is an improper submission under § 1.540, has not been considered, and is being returned herewith. See MPEP § 2267. This decision will be made of record in the reexamination file.

It is noted that the paper was not served on the patent owner pursuant to 37 CFR 1.550(f). Accordingly, a copy is included herewith for the patent owner.

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

Enclosure for patent owner and third party requester: paper entitled "Follow-up Communication after Telephone Interview with Patent Examiner" filed December 31, 2002.

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. 13

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MAILED

JAN 30 2003

REEXAM UNIT

In re Dahlstrom et al.
Inter partes Reexamination Proceeding
Control No. 95/000,003
Filed: January 8, 2002
For: U.S. Patent No. 6,319,526

In re Dahlstrom et al.
Ex parte Reexamination Proceeding
Control No. 90/006,317
Filed: July 3, 2002
For: U.S. Patent No. 6,319,526

DECISION MERGING REEXAMINATION PROCEEDINGS

The above-identified reexamination proceedings are before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged under 37 C.F.R. § 1.989 at this time.

REVIEW OF FACTS

1. U.S. Patent No. 6,319,526, issued to Dahlstrom et al. on November 20, 2001.

2. A request for *inter partes* reexamination pursuant to 37 C.F.R. § 1.915 was filed on January 8, 2002, by third party requester John W. Behringer, for Leprino Foods Company, and was assigned Control No. 95/000,003.

3. Reexamination was ordered pursuant to 37 C.F.R. § 1.931 in the '003 proceeding on April 4, 2002, and a nonfinal Office action was mailed on the same date pursuant to 37 C.F.R. § 1.935.

4. On June 3, 2002, patent owner's response to the nonfinal Office action pursuant to 37 C.F.R. § 1.945 was received in the '003 proceeding, which included an amendment that was not in compliance with 37 C.F.R. § 1.530(d)-(j). A Notice re: Defective Paper was mailed on June 10, 2002, which provided a time period of one month for patent owner to correct the informality.

5. On July 3, 2002, third party requester's comments pursuant to 37 C.F.R. § 1.947 were received in the '003 proceeding.

6. A request for *ex parte* reexamination pursuant to 37 C.F.R. § 1.510, was also filed on July 3, 2002, by the same third party requester John W. Behringer, for Leprino Foods Company, and was assigned Control No. 90/006,317. The third party requester requests merger of the '6317 proceeding with the '003 proceeding.

7. An amendment was filed by patent owner in the '003 proceeding on July 9, 2002, in response to the Notice re: Defective Paper, which is in compliance with 37 C.F.R. § 1.530(d)-(j).

8. Reexamination was ordered pursuant to 37 C.F.R. § 1.525 in the '6317 proceeding on August 20, 2002.

9. On October 2, 2002, a patent owner statement pursuant to 37 C.F.R. § 1.530 was received in the '6317 proceeding, which included an amendment.

10. On November 27, 2002, a requester's reply pursuant to 37 C.F.R. § 1.535 was received in the '6317 proceeding, in which the request for merger of this proceeding with the '003 proceeding is reiterated.

DISCUSSION REGARDING MERGER

Under 37 C.F.R. § 1.989(a):

> If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

As evidenced by the above review of facts, the *inter partes* reexamination proceeding and the *ex parte* reexamination proceeding are currently pending. Since reexamination has been ordered in both proceedings, and the time periods for filing the appropriate subsequent patent owner and requester papers have expired, a decision under 37 C.F.R. § 1.989(a) is timely.

The general policy of the Office is that examination of *inter partes* reexamination and *ex parte* reexamination proceedings will <u>not</u> 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 both 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.

A review of the prosecution history of the '003 *inter partes* reexamination proceeding reveals that the original specification, drawings and patent claims 1-14, 16-25, 27-35, 37-51, 53-88 and 90-113 are presently in the reexamination file, claims 26, 36, 52 and 89 have been amended, new claims 114-163 have been added, and claim 15 has been cancelled. A nonfinal Office action was mailed along with the order on April 4, 2002, pursuant to 37 C.F.R. § 1.935. A patent owner's response pursuant to 37 C.F.R. § 1.945 and written comments by third party requester pursuant to 37 C.F.R. § 1.947 have been received. The *inter partes* reexamination proceeding is ready for the examiner's consideration of such papers and preparation of the next Office action on the merits.

A review of the prosecution history of the '6317 *ex parte* reexamination proceeding reveals that the original specification,

drawings and patent claims 1-25, 27-35, 37-51, 53-88 and 90-113 are presently in the reexamination file, and claims 26, 36, 52 and 89 have been amended. An owner's statement pursuant to 37 C.F.R. § 1.530 and a third party requester's reply pursuant to 37 C.F.R. § 1.535 have been received. The *ex parte* reexamination proceeding is ready for the examiner's consideration of such papers and preparation of a first Office action on the merits.

Accordingly, the claims are not identical in both proceedings. In order to provide efficient, consistent and prompt handling of both proceedings, it is appropriate that the *inter partes* reexamination proceeding and the *ex parte* reexamination proceeding be merged and a joint examination be conducted. Therefore, the examination of the merged *inter partes* reexamination and *ex parte* reexamination proceeding will be conducted in accordance with the decision set forth below.

DECISION

I. Merger of Proceedings

In accordance with 37 C.F.R. § 1.989 (a), the above-identified *inter partes* reexamination and *ex parte* reexamination proceedings are **merged**. A joint examination of both proceedings will be conducted in accordance with the guidelines and requirements which follow.

II. Requirement for Same Amendments in Both Proceedings

As noted above with regard to the amendments submitted, the claims are NOT the same in both files. Patent owner is required to submit an appropriate "housekeeping amendment" **within one month of this decision** placing the same amendments in both files. The paper should be strictly limited to the bare presentation of the amendments. The housekeeping amendment should be submitted as a single paper, including the identifying data for both files and a signature, and should be filed in duplicate for entry into each reexamination file. Any discussion of the merits or issues of the proceeding would be improper and would result in the return of the paper as an improper submission under 37 C.F.R. § 1.939.

It should be noted that submission of such an appropriate housekeeping amendment will not create a reply right for third party requester. Any comments filed by the requester in response to any such housekeeping amendment would be improper and result

in the return of the paper as an improper submission under 37 C.F.R. § 1.939.

III. Conduct of Merged Proceeding

A. Governing regulations for the merged proceeding:

The present decision merges an *inter partes* reexamination proceeding with an *ex parte* reexamination proceeding. Pursuant to 37 C.F.R. § 1.989 (b), the merged proceeding is governed by 37 C.F.R. § 1.902 through § 1.997, except that the rights of the third party requester of the *ex parte* reexamination are governed by 37 C.F.R. § 1.510 through § 1.560. In the instant proceedings, as noted above in the review of facts, the third party requester is the same for both proceedings.

B. Papers mailed/filed:

Normally, a requirement is made in merged reexamination proceedings for duplicate papers (*e.g.*, Office actions, patent owner responses, requester replies, *etc.*) for placement of papers in both files. Since the third party requester is the same in both of the instant reexamination proceedings, there does not appear to be a benefit in maintaining two separate files with duplicate papers. Therefore, the requirement for duplicate papers will not be made in this merged proceeding[1].

Instead, the *ex parte* reexamination file will become and remain physically dormant after receipt of the "housekeeping amendment," in that no further papers that are mailed/filed will be physically entered into this file[2]. 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 and the third party requester will contain the identifying data for both files and will be physically entered in the *inter partes* reexamination file. All papers filed by the patent owner and the third party requester must consist of a single paper, bearing a signature and including identifying data for both files, for entry into the *inter partes* reexamination file.

---

[1]with the exception of the above-noted "housekeeping amendment," which should be filed in duplicate

[2]with the exception of *e.g.*, a PTO-892 form, as explained in part E. below

All papers filed by the patent owner and the third party requester should be directed:

by Mail to: Attn: "Box *Inter Partes* Reexam"
Central Reexamination Unit
Office of Patent Legal Administration
United States Patent & Trademark Office
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

Patent 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), and every paper filed must reflect that such paper was served on the other party, pursuant to 37 C.F.R. § 1.903. All papers should be addressed to the Central Reexamination Unit as indicated above, and should **not** be sent to the Technology Center.

C. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with the provisions of 37 C.F.R. § 1.530 and the guidelines of MPEP § 2250. Note that 37 C.F.R. § 1.121 does not apply to amendments in reexamination, therefore clean copies of the amended claims are not required and are not to be submitted. Instead, amendments are to be presented via markings pursuant to paragraph 37 C.F.R. § 1.530(f) of this section, except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 C.F.R. § 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the

request for reexamination. Amendments are not to be made relative to previous amendments. In other words, for all amendments, any words not appearing in the patent must be underlined, and only words being deleted from the patent must appear in brackets.

D. Fees:

Where a paper is filed that requires payment of a fee (e.g., petition fee, appeal fee, brief fee, oral hearing fee), only a single fee is required to be paid. For example, only one fee is required to be paid for patent owner's appellant brief (or that of the *inter partes* requester), even though the brief relates to merged multiple proceedings.

E. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications. If the examiner identifies any discrepancies as to such citations, the examiner will cite such documents on a PTO-892 form as part of the next Office action in order to make the same references of record in both files.

F. Reexamination Certificate:

At the conclusion of the examination of the merged reexamination proceeding, copies of any papers (e.g., amendments) needed for publishing the reexamination certificate will be placed in the *ex parte* reexamination file. Both files will be forwarded to the Office of Publications for issuance of a single certificate setting forth the results of the merged proceeding pursuant to 37 C.F.R. § 1.997.

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,003 and *ex parte* Reexamination Control No. 90/006,317 are merged

into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. The merged reexamination files are being stored in the Central Reexamination Unit to await receipt of the housekeeping amendment in accordance with Part II., *supra*.

3. Once the housekeeping amendment is received, or the time for filing such has expired, the merged reexamination files will be forwarded via the Technology Center 1700 Group Director to the examiner for the preparation of an Office action in the merged proceeding.

4. It should be noted that failure to submit an appropriate "housekeeping amendment" **within one month of this decision** placing the same amendments in both files will result in the Office's rejection of any claim that does not contain identical text in both merged proceedings under 35 U.S.C. § 112, second paragraph, as being indefinite as to the content of the claim, and therefore failing to particularly point out the invention.

5. Any questions concerning this communication 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 28, 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

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REEXAM UNIT

In re Dahlstrom et al.
Reexamination Proceeding
Control No. 95/000,003
Filed: January 8, 2002
For: U.S. Patent No. 6,319,526

In re Dahlstrom et al.
Reexamination Proceeding
Control No. 90/006,317
Filed: July 3, 2002
For: U.S. Patent No. 6,319,526

DECISION DISMISSING PETITION

This is a decision on the July 18, 2005, patent owner PETITION UNDER 37 C.F.R. § 1.137(a), for the entry of belated papers based upon unavoidable delay.

The petition fee of $500.00 pursuant to 37 C.F.R. § 1.17(l) for the petition under 37 C.F.R. § 1.137(a) was paid by credit card.

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 the late response is **dismissed as moot** for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 6,319,526 issued to Dahlstrom et al. on November 20, 2001.

2. On January 8, 2002, a request for *inter partes* reexamination of the '526 patent was filed by a third party requester, which proceeding was assigned control no. 95/000,003.

3. Reexamination was ordered and a non-final Office action was mailed in the '003 proceeding on April 4, 2002.

4. On June 3, 2002, patent owner filed a response to the Office action pursuant to 37 C.F.R. § 1.945, including an amendment, in the '003 proceeding.

5. A Notification of Defective paper was mailed on June 10, 2002, indicating that the amendment of April 4, 2002, was not in compliance with 37 C.F.R. § 1.530(d)-(j), and setting a one month response period for the patent owner to file a corrected amendment.

6. On July 3, 2002, third party requester filed comments to patent owner's response, pursuant to 37 C.F.R. § 1.947.

7. Also on July 3, 2002, a request for *ex parte* reexamination of the '526 patent was filed by the same third party requester, which proceeding was assigned control no. 90/006,317.

8. On July 9, 2002, patent owner filed a corrected amendment in compliance with 37 C.F.R. § 1.530(d)-(j), in the '003 proceeding.

9. Reexamination was ordered in the '6317 proceeding on August 20, 2002.

10. The '003 and '6317 proceedings were merged on January 30, 2003.

11. A housekeeping amendment was filed for the merged proceedings on February 28, 2003.

12. A nonfinal Office action was mailed on February 16, 2005 in the merged proceedings.

13. Patent owner filed a response to the nonfinal Office action on April 27, 2005.

14. On May 24, 2005, the third party requester filed comments pursuant to 37 C.F.R. 1.947, in reply to the patent owner response.

15. On June 3, 2005, a "Notice Re Defective Paper in *Inter Partes* Reexamination" was mailed, notifying the patent owner that the amendment of April 27, 2005 was not in compliance with 37 C.F.R. 1.530, and setting a 30 day or 1 month time period for response.

16. Patent owner filed the instant petition on July 18, 2005, accompanied by declarations, and a proposed reply to the "Notice Re Defective Paper in *Inter Partes* Reexamination."

DECISION

The PETITION UNDER 37 C.F.R. § 1.137(a), for the revival of terminated reexamination proceedings based upon unavoidable delay filed by patent owner on July 18, 2005, has been fully considered, but is deemed immaterial to the issue of the late response. It should be noted that the failure to respond to the "Notice Re Defective Paper in *Inter Partes* Reexamination" mailed on June 3, 2005, did **not** cause a lapse in pendency, **nor** result in termination of the instant merged reexamination proceedings. As stated on the "Notice Re Defective Paper in *Inter Partes* Reexamination" (PTOL-2069) a failure to timely correct the informality in response to the Notice of June 3, 2005, will result in the amendment of April 27, 2005, **not** being entered, although the argument will be considered as it applies to the proceeding without the amendment. Therefore, the PETITION UNDER 37 C.F.R. § 1.137(a), for the revival of proceedings based upon unavoidable delay is **dismissed as moot**.

Petitioner asserts that patent owner never received the "Notice Re Defective Paper in *Inter Partes* Reexamination" mailed June 3, 2005. Petitioner states that they were not aware of this Office communication until July 13, 2005, when the third party requester contacted them to inquire as to the status of the patent owner's response to the outstanding Notice of June 3, 2005. Petitioner purports that the entire delay in filing the required reply was unavoidable due to non-receipt of the advisory action.

MPEP 711.03(c)(I.)(A.)states:

> "The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action."

The petition of July 18, 2005, was accompanied by, *inter alia*, declarations of Mr. Sawicki and Ms. Kosloski, a copy of a mail log of June 2005, and a response including a proposed amendment in response to the "Notice Re Defective Paper in *Inter Partes* Reexamination". With regard to the extent that petitioner has attempted to demonstrate the non-receipt of the "Notice Re Defective Paper in *Inter Partes* Reexamination," it should be noted that the requirements set forth in MPEP 711.03(c)(I.)(A.), *i.e.*, the required statement attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received, nor the copy of the docket record where the non-received Office communication would have been entered, were **not** included in the evidence of non-receipt that was filed with the instant petition.

A review of the proposed amendment included with the instant petition reveals that this amendment is also **no**t in compliance with 37 C.F.R. 1.530(4)(f). Specifically, amended claims 26, 36, 52, 62 and 89 do **not** show all changes made (with the appropriate

bracketing and underlining) with respect to the original patent text of the claims, and the new claims 114-163 are not completely underlined, as required. Therefore, the late-filed amendment is **not** effective to overcome the deficiencies of the originally filed amendment of April 27, 2005, set forth in the "Notice Re Defective Paper in *Inter Partes* Reexamination" mailed on June 3, 2005.

Accordingly, even if the delay in filing the response were to be excused, there is no meaningful relief that may be provided to petitioner, because, irrespective of the fact that the response is late, the amendment of July 18, 2005, is also defective for the reasons set forth above. There is no point in excusing the delay in filing the response, because it is no more dispositive of the issue than the former amendment of April 27, 2005. As stated on the "Notice Re Defective Paper in *Inter Partes* Reexamination" (PTOL-2069), the failure to timely correct the informality in response to the Notice of June 3, 2005, will result in the amendment of April 27, 2005, **not** being entered, although the argument will be considered as it applies to the proceeding without the amendment. Since the response to the notice of June 3, 2005, did **not** correct the defects, the submission of July 18, 2005, will **not** be entered (See MPEP 2666.60). Therefore, the petition for the entry of the late response of July 18, 2005, has been fully considered, but is **dismissed as moot**.

CONCLUSION

1. The petition for the entry of the late response of July 18, 2005, is **dismissed as moot**, and the proposed amendment accompanying the petition is **not entered**.

2. Since the patent owner response of July 18, 2005, is **not** entered, no further comments from the third party requester are permitted.

3. The patent owner amendment of April 27, 2005, is **not** entered, although the argument will be considered as it applies to the proceeding without the amendment.

4. Similarly, the third party comments of May 24, 2005, will also be considered as they apply to the proceeding without the patent owner's amendment of April 27, 2005.

5. The instant *inter partes* reexamination proceeding will be forwarded to the Technology Center 1700 examiner to prepare the next appropriate Office action.

6. Any future correspondence with respect to this *inter partes* reexamination proceeding should be addressed as follows:

By mail: Mail Stop *Inter Partes* Reexam
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-9900
Attn: Central Reexam Unit

By hand: Customer Service Window
Attn: Central Reexam Unit
401 Dulany Street
Alexandria, VA 22314

7. 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

September 23, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

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MAILED

OCT 27 2006

CENTRAL REEXAMINATION UNIT

John W. Behringer, Esq. (For Requester)
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In re Dahlstrom et al. Reexamination Proceeding Control No. 95/000,003 Filed: January 8, 2002 For: U.S. Patent No. 6,319,526	**DECISION DISMISSING PETITION and *SUA SPONTE* GRANTING RELIEF**
In re Dahlstrom et al. Reexamination Proceeding Control No. 90/006,317 Filed: July 3, 2002 For: U.S. Patent No. 6,319,526	

This is a decision on the September 19, 2006, patent owner PETITION UNDER 37 C.F.R. § 1.182, taken as a petition requesting the withdrawal of the Notice of Intent to Issue Reexamination Certificate (NIRC) mailed on August 28, 2006, which canceled claims 1-14 and 16-163, and requesting entry and consideration of patent owner's late response and amendment accompanying the instant petition.

The petition fee of $400.00 pursuant to 37 C.F.R. § 1.17(f) for the petition under 37 C.F.R. § 1.182 was paid by credit card.

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

The PETITION UNDER 37 C.F.R. § 1.182 is **dismissed**, but relief is *sua sponte* **granted** for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 6,319,526 issued to Dahlstrom et al. on November 20, 2001.

2. On January 8, 2002, a request for *inter partes* reexamination of the '526 patent was filed by a third party requester, which proceeding was assigned control no. 95/000,003.

3. Reexamination was ordered and a non-final Office action was mailed in the '003 proceeding on April 4, 2002.

4. On June 3, 2002, patent owner filed a response to the Office action pursuant to 37 C.F.R. § 1.945, including an amendment, in the '003 proceeding.

5. A Notification of Defective paper was mailed on June 10, 2002, indicating that the amendment of April 4, 2002, was not in compliance with 37 C.F.R. § 1.530(d)-(j), and setting a one month response period for the patent owner to file a corrected amendment.

6. On July 3, 2002, third party requester filed comments to patent owner's response, pursuant to 37 C.F.R. § 1.947.

7. Also on July 3, 2002, a request for *ex parte* reexamination of the '526 patent was filed by the same third party requester, which proceeding was assigned control no. 90/006,317.

8. On July 9, 2002, patent owner filed a corrected amendment in compliance with 37 C.F.R. § 1.530(d)-(j), in the '003 proceeding.

9. Reexamination was ordered in the '6317 proceeding on August 20, 2002.

10. The '003 and '6317 proceedings were merged on January 30, 2003.

11. A housekeeping amendment was filed for the merged proceedings on February 28, 2003.

12. A nonfinal Office action was mailed on February 16, 2005, in the merged proceedings.

13. Patent owner filed a response to the nonfinal Office action on April 27, 2005.

14. On May 24, 2005, the third party requester filed comments pursuant to 37 C.F.R. § 1.947, in reply to the patent owner response.

15. On June 3, 2005, a "Notice Re Defective Paper in *Inter Partes* Reexamination" was mailed, notifying the patent owner that the amendment of April 27, 2005, was not in compliance with 37 C.F.R. § 1.530, and setting a 30 day or 1 month time period for response. No patent owner response was received.

16. On July 18, 2005, patent owner filed a PETITION UNDER 37 C.F.R. § 1.137(a), for the revival of terminated reexamination proceedings based upon unavoidable delay, accompanied by declarations, and a proposed late response (including an amendment) to the "Notice Re Defective Paper in *Inter Partes* Reexamination."

17. A decision dismissing the PETITION UNDER 37 C.F.R. § 1.137(a) was mailed on September 23, 2005, which decision noted that the late-filed amendment was NOT in compliance with 37 C.F.R. § 1.530.

18. A Notice of Intent to Issue Reexamination Certificate (NIRC) was mailed on August 28, 2006, cancelling claims 1-14 and 16-163.

19. Patent owner filed a PETITION UNDER 37 C.F.R. § 1.182, requesting the withdrawal of cancellation of claims 1-14 and 16-163, and requesting entry and consideration of patent owner's late response and amendment accompanying the instant petition.

DECISION

The present PETITION UNDER 37 C.F.R. § 1.182, taken as a petition requesting the withdrawal of the Notice of Intent to Issue Reexamination Certificate (NIRC) mailed on August 28, 2006, which canceled claims 1-14 and 16-163, and requesting entry and consideration of patent owner's response and amendment accompanying the instant petition, has been fully considered. Petitioner requests that the claims be considered on their merits and not summarily dismissed due to procedural/formatting irregularities. Petitioner contends that since the previously filed petition of July 18, 2005, was dismissed, the previously submitted amendments were not entered for procedural reasons, and patent owner was left with no recourse in having the claims considered on their merits. The petitioner points out that claims 1-14 and 16-163 were canceled by the Examiner's Amendment accompanying the Notice of Intent to Issue Reexamination Certificate (NIRC) mailed on August 28, 2006.

Petitioner's contentions are **NOT** persuasive. A review of the reexamination record reveals that patent owner has had ample time and opportunity to provide an amendment in conformance with the reexamination rules of practice, specifically, 37 C.F.R. § 1.530, but has repeatedly failed to do so. It is noted that the necessary compliance with 37 C.F.R. § 1.530, was first brought to patent owner's attention on June 10, 2002. On July 9, 2002, patent owner did manage to file a proper amendment (and the housekeeping amendment of February 28, 2003, is a duplicate of this amendment). However, it was then necessary on June 3, 2005, to again require patent owner to comply with the reexamination amendment rules of practice, and ever since that time, patent owner has NOT ONCE managed to provide an amendment in compliance with 37 C.F.R. § 1.530. It is also noted that although the previous petition was dismissed more than one (1) year ago, during this time patent owner has apparently never attempted to provide a proper amendment for consideration. It is notable that out of four (4) amendments presented by patent owner in this reexamination proceeding, only one (1) has been found to be in compliance with the rules for reexamination amendment practice. This recurring pattern of providing reexamination amendments which are not in compliance with the rules has resulted in unnecessary delays which are contrary to the statutory requirement for the reexamination proceedings to be conducted

with "special dispatch" pursuant to 35 U.S.C. 305[1]. Petitioner's arguments have been fully considered, but none of these arguments are persuasive.

I. Withdrawal of the NIRC:

Based on a general review by the undersigned, it was noted that the patent owner's failure to respond to the "Notice Re Defective Paper in *Inter Partes* Reexamination" mailed on June 3, 2005, did **not** cause a lapse in pendency, **nor** should it have resulted in termination of the instant merged reexamination proceedings. As stated in the "Notice Re Defective Paper in *Inter Partes* Reexamination" (PTOL-2069), a failure to timely correct the informality in response to the Notice of June 3, 2005, will result in the amendment of April 27, 2005, **not** being entered, **although the argument will be considered as it applies to the proceeding without the amendment** (emphasis added).
The PETITION UNDER 37 C.F.R. § 1.137(a) of July 18, 2005, for the revival of proceedings based upon unavoidable delay was **dismissed** in the decision mailed September 23, 2005, for the reason that the merged reexamination proceeding had not been terminated. It was noted that the proposed late amendment was also **not** in compliance with 37 C.F.R. § 1.530(4)(f), and consequently no more dispositive of the issue than the former amendment of April 27, 2005. The decision dismissing this petition again reiterated that, as stated in the "Notice Re Defective Paper in *Inter Partes* Reexamination" (PTOL-2069), the failure to timely correct the informality in response to the Notice of June 3, 2005, will result in the amendment of April 27, 2005, **not** being entered, **although the argument will be considered as it applies to the proceeding without the amendment** (emphasis added).

A review of the NIRC of August 28, 2006, reveals that the examiner states:

> "Claims 1-14 and 16-163 (all live claims in the proceedings) were subject to rejection in the last Office action mailed 16 February 2005. The patent owner failed to file a timely respond to that Office action. Accordingly, claims 1-14 and 16-163 have been canceled. See 37 CFR 1.5979b) and MPEP 2666.10." (*sic*)

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[1]See also 37 C.F.R. § 10.18(b)(2)(i)

Therefore, although petitioner has failed to rely upon this argument, from the record it is clear that the Office has failed to follow its' own procedures set forth in the "Notice Re Defective Paper in *Inter Partes* Reexamination" of June 3, 2005, and again reiterated in the Decision Dismissing the Petition of September 23, 2005. Specifically, the NIRC canceling the claims for failure to respond should NOT have been mailed in the instant merged reexamination proceeding. Instead, an Office action should have been prepared based on the claims in existence in the merged reexamination proceeding prior to the improper amendment of April 27, 2005, *i.e.*, the claims in the housekeeping amendment of February 28, 2003. Such Office action should have treated the patent owner's response of April 27, 2005, and the third party requester's comments of May 31, 2005, inasmuch as the respective arguments and comments applied to the claims pending in the merged reexamination proceeding as of February 28, 2003.

Accordingly, although petitioner's arguments are not persuasive, the requested relief of the withdrawal of the cancellation of claims 1-14 and 16-163, has been *sua sponte* **granted** in view of the Office's failure to follow its' own procedures. The NIRC of August 28, 2006, is **withdrawn** as of the mailing of this petition decision, and claims 1-14 and 16-163 are restored to a pending status. An appropriate Office action will be prepared in accordance with the above-mentioned procedures, and will be mailed in due course.

II. Entry and consideration of late response and amendment:

Petitioner's assertion that since the previously filed petition of July 18, 2005, was dismissed, the previously submitted amendments were not entered for procedural reasons, and patent owner was left with no recourse in having the claims considered on their merits, has been considered, but is not well-founded and definitely not persuasive. A review of the record reveals that although the previous petition was dismissed over one (1) year ago, during this time patent owner has apparently never attempted to provide a proper amendment for consideration. The petitioner points out that claims 1-14 and 16-163 were canceled by the Examiner's Amendment accompanying the Notice of Intent to Issue Reexamination Certificate (NIRC) mailed on August 28, 2006.

A review of the proposed late amendment included with the instant petition reveals that this amendment is also **not** in compliance with 37 C.F.R. 1.530(4)(f). Specifically, amended patent claim

36 is missing patent text, amended patent claim 52 contains a typographical error, and the new claims 114-163 are completely underlined, but some new claims also include bracketing, which is improper (*e.g.*, claims 124, 146, 155, 160). Therefore, the late-filed amendment of September 19, 2006, is **not** effective to overcome the deficiencies of the originally filed amendment of April 27, 2005, set forth in the "Notice Re Defective Paper in *Inter Partes* Reexamination" mailed on June 3, 2005.

Accordingly, even if the delay in filing the response were to be excused, there is no meaningful relief that may be provided to petitioner, because, irrespective of the fact that the response is late, the amendment of September 19, 2006, is also defective for the reasons set forth above. There is no point in excusing the delay in filing the response, because it is no more dispositive of the issue than the former amendments of April 27, 2005, or July 18, 2005. As stated in the "Notice Re Defective Paper in *Inter Partes* Reexamination" (PTOL-2069), the failure to timely correct the informality in response to the Notice of June 3, 2005, will result in the amendment of April 27, 2005, **not** being entered, although the argument will be considered as it applies to the proceeding without the amendment. Since the late response to the notice of June 3, 2005, still did **not** correct the defects, the submission of September 19, 2006, will **not** be entered (See MPEP 2666.60). Therefore, the petition for the entry of the late response of September 19, 2006, has been fully considered, but is **dismissed**.

CONCLUSION

1. The PETITION UNDER 37 C.F.R. § 1.182 is **dismissed**.

2. The requested relief of the withdrawal of the cancellation of claims 1-14 and 16-163, has been ***sua sponte* granted**.

3. The NIRC of August 28, 2006, is **withdrawn**, and claims 1-14 and 16-163 are restored to a pending status.

4. The petition requesting entry of the late response of September 19, 2006, is **dismissed**, and the proposed late amendment accompanying the petition is **not entered**.

5. Since the patent owner response of September 19, 2006, is **not** entered, no further comments from the third party requester are permitted.

6. The patent owner amendment of April 27, 2005, is **not** entered, although the argument will be considered as it applies to the proceeding without the amendment.

7. Similarly, the third party comments of May 24, 2005, will also be considered as they apply to the proceeding without the patent owner's amendment of April 27, 2005.

8. The merged *inter partes* reexamination proceeding is being returned to the Central Reexamination Unit 3991 examiner to prepare an appropriate Office action in accordance with the above-mentioned procedures, which will be mailed in due course.

9. Any future correspondence with respect to this merged *inter partes* reexamination proceeding should be addressed as follows:

By mail: Mail Stop *Inter Partes* Reexam
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-9900
Attn: Central Reexam Unit

By hand: Customer Service Window
Attn: Central Reexam Unit
401 Dulany Street
Alexandria, VA 22314

10. 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

October 27, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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SEP 27 2007

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In re Dahlstrom et al.
Reexamination Proceeding
Control No. 95/000,003
Filed: January 8, 2002
For: U.S. Patent No. 6,319,526

In re Dahlstrom et al.
Reexamination Proceeding
Control No. 90/006,317
Filed: July 3, 2002
For: U.S. Patent No. 6,319,526

DECISION DISMISSING PETITION

This is a decision on the July 26, 2007, patent owner PETITION UNDER 37 C.F.R. § 1.183, requesting waiver of 37 C.F.R. § 1.951 as to patent owner's one opportunity to file comments. The petition fee of $400.00 pursuant to 37 C.F.R. § 1.17(f) for the petition under 37 C.F.R. § 1.183 was paid by credit card. The petition is before the Office of Patent Legal Administration for decision.

The PETITION UNDER 37 C.F.R. § 1.182 is **dismissed** for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 6,319,526 issued to Dahlstrom et al. on November 20, 2001.

2. On January 8, 2002, a request for *inter partes* reexamination of the '526 patent was filed by a third party requester, which proceeding was assigned control no. 95/000,003.

3. Reexamination was ordered and a non-final Office action was mailed in the '003 proceeding on April 4, 2002.

4. On June 3, 2002, patent owner filed a response to the Office action pursuant to 37 C.F.R. § 1.945, including an amendment, in the '003 proceeding.

5. A Notification of Defective paper was mailed on June 10, 2002, indicating that the amendment of April 4, 2002, was not in compliance with 37 C.F.R. § 1.530(d)-(j), and setting a one month response period for the patent owner to file a corrected amendment.

6. On July 3, 2002, third party requester filed comments to patent owner's response, pursuant to 37 C.F.R. § 1.947.

7. Also on July 3, 2002, a request for *ex parte* reexamination of the '526 patent was filed by the same third party requester, which proceeding was assigned control no. 90/006,317.

8. On July 9, 2002, patent owner filed a corrected amendment in compliance with 37 C.F.R. § 1.530(d)-(j), in the '003 proceeding.

9. Reexamination was ordered in the '6317 proceeding on August 20, 2002.

10. The '003 and '6317 proceedings were merged on January 30, 2003.

11. A housekeeping amendment was filed for the merged proceedings on February 28, 2003.

12. A nonfinal Office action was mailed on February 16, 2005, in the merged proceedings.

13. Patent owner filed a response to the nonfinal Office action on April 27, 2005, which included an amendment.

14. On May 24, 2005, the third party requester filed comments pursuant to 37 C.F.R. § 1.947, in reply to the patent owner response.

15. On June 3, 2005, a "Notice Re Defective Paper in *Inter Partes* Reexamination" was mailed, notifying the patent owner that the amendment of April 27, 2005, was not in compliance with 37 C.F.R. § 1.530, and setting a 30 day or 1 month time period for response. No patent owner response was received.

16. On July 18, 2005, patent owner filed a PETITION UNDER 37 C.F.R. § 1.137(a), for the revival of terminated reexamination proceedings based upon unavoidable delay, accompanied by declarations, and a proposed late response (including an amendment) to the "Notice Re Defective Paper in *Inter Partes* Reexamination."

17. A decision dismissing the PETITION UNDER 37 C.F.R. § 1.137(a) was mailed on September 23, 2005, which decision noted that the late-filed amendment was NOT in compliance with 37 C.F.R. § 1.530.

18. A Notice of Intent to Issue Reexamination Certificate (NIRC) was mailed on August 28, 2006, cancelling claims 1-14 and 16-163.

19. On September 19, 2006, Patent owner filed a PETITION UNDER 37 C.F.R. § 1.182, requesting the withdrawal of cancellation of claims 1-14 and 16-163, and requesting entry and consideration of patent owner's late response and amendment accompanying the instant petition.

20. A decision dismissing the petition was mailed on October 27, 2006, and granting *sua sponte* relief in the form of withdrawing the NIRC in the merged reexamination proceedings. The proposed amendment accompanying the petition was NOT in compliance with 37 C.F.R. § 1.530.

21. On June 23, 2007, an Action Closing Prosecution was mailed.

22. On July 26, 2007, patent owner filed comments after action closing prosecution, accompanied by a proposed amendment.

23. Also on July 26, 2007, patent owner filed a PETITION UNDER 37 C.F.R. § 1.183, requesting waiver of 37 C.F.R. § 1.951 as to patent owner's one opportunity to file comments.

24. Third party requester filed a change of correspondence address on August 1, 2007.

25. On August 24, 2007, third party requester filed comments after Action Closing Prosecution pursuant to 37 C.F.R. § 1.951(b).

DECISION

The present PETITION UNDER 37 C.F.R. § 1.183, requesting waiver of 37 C.F.R. § 1.951 as to patent owner's one opportunity to file comments, has been fully considered. Petitioner asserts that this case includes an extraordinary situation where deleted matter in new claims was bracketed resulting in the amendment of April 27, 2005, not being in compliance with the rules, and therefore not being entered and considered. Petitioner contends that justice requires that a patent owner's amendments and arguments be considered prior to the issuance of the ACP, which could potentially take away patent owner's rights. Petitioner asserts that whether a patent owner's rights are taken away should not be decided on issues of format, but rather on the merits of the case.

Additionally, petitioner contends that the result of the present ACP is contrary to the purpose provided in MPEP 2671.02, which states that before an ACP is in order, a clear issue should be developed. Petitioner purports that in this case the issues being developed include whether a process without vacuum is patentable over the prior art. Petitioner postures that due to formatting errors caused by vagueness in the MPEP, this claim element was not considered, therefore, the issue of whether a process as claimed in the present reexamination proceeding without vacuum is patentable has not been developed. Petitioner further argues that the examiner should not prematurely cut off the prosecution with a patent owner who is seeking to define the invention in the claims that will offer the patent protection to

which the patent owner is entitled, per MPEP 2671.02. Petitioner purports that it is clear that the patent owner is seeking to define the process claimed in the patent to be without vacuum and/or without vacuum and in a dry environment, and asserts that each of these elements distinguishes the claimed invention over the prior art. Petitioner states that the patent owner believes that the claims containing the amended claim language entitle the patent owner to such protection.

37 C.F.R. § 1.183 states in part:

> 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.

37 C.F.R. § 1.951 states in part:

> (a) After an Office action closing prosecution in an *inter partes* reexamination, the patent owner may once file comments limited to the issues raised in the Office action closing prosecution. The comments can include a proposed amendment to the claims, which amendment will be subject to the criteria of § 1.116 as to whether or not it shall be admitted. The comments must be filed within the time set for response in the Office action closing prosecution.

Petitioner's arguments have been fully considered, but such contentions are **NOT** persuasive. Petitioner's assertion that "this case includes an extraordinary situation where deleted matter in new claims was bracketed resulting in the amendment of April 27, 2005, not being in compliance with the rules, and therefore not being entered and considered" is incorrect, and mis-characterizes the situation at hand. A review of the reexamination record reveals that patent owner has had ample time and opportunity to provide an amendment in conformance with the reexamination rules of practice, specifically, 37 C.F.R. § 1.530, but has **repeatedly failed to do so.** It is noted that the necessary compliance with 37 C.F.R. § 1.530, was first brought to patent owner's attention on June 10, 2002. On July 9, 2002, patent owner filed a proper amendment (and the housekeeping

amendment of February 28, 2003, is a duplicate of this amendment). However, it was then necessary on June 3, 2005, to again require patent owner to comply with the reexamination amendment rules of practice, and since that time, patent owner has not provided an amendment in compliance with 37 C.F.R. § 1.530. In summary, on June 3, 2002, a first improper amendment was filed; on April 27, 2005, a second improper amendment was filed; on July 18, 2005, a third improper amendment was filed; and on September 19, 2006, a fourth improper amendment was filed. It is noted that out of five (5) amendments presented by patent owner in this reexamination proceeding, only one (1) amendment has been found to be in compliance with the rules for reexamination amendment practice. It is further noted that although the previous petition was dismissed in October 2006, during the time subsequent to the dismissal, patent owner has not provided a proper amendment for consideration. Such prosecution evidences a **recurring pattern** of patent owner providing reexamination amendments which are **not** in compliance with the rules. This recurring pattern has resulted in unnecessary delays which are contrary to the statutory requirement for the reexamination proceedings to be conducted with "special dispatch" pursuant to 35 U.S.C. 305[1]. Therefore, petitioner's assertions of an "extraordinary situation" are not well-founded.

Fortunately, contrary to Petitioner's assertions, patent owner has not yet lost any rights, as an ACP is not a final Office action (MPEP 2671.02). Patent owner does have an opportunity to provide an amendment in reply to the ACP of June 26, 2007, as noted in the action:

> "(1) Pursuant to 37 C.F.R. 1.951(a), the patent owner may once file written comments limited to the issues raised in the reexamination proceeding and/or present a proposed amendment to the claims which amendment will be subject to the criteria of 37 C.F.R. 1.116 as to whether it shall be entered and considered. Such comments and/or proposed amendments must be filed within <u>a time period of 30 days or one month (whichever is longer) from the mailing date of this action</u>. Where the patent owner files such comments and/or a proposed amendment, the third party requester may once file comments under 37 C.F.R. 1.951(b) responding to the patent owner's submission within <u>30 days from the date of service</u> of the patent owner's submission on the third party requester."

---

[1]See also 37 C.F.R. § 10.18(b)(2)(i)

It is noted that on July 26, 2007, patent owner did submit a response, including a proposed amendment, that was accompanied by the instant petition. To purport that patent owner may have lost certain rights is unfounded, as well as premature, as patent owner has availed itself of the optional reply right to the ACP. Since patent owner has taken advantage of the one opportunity to file a response accompanied by a proposed amendment in reply to the ACP, but patent owner has not yet received the Office's determination on such proposed amendment as to whether it shall be entered and considered pursuant to the provisions of 37 C.F.R. 1.116, the instant petition requesting waiver of 37 C.F.R. § 1.951, as to patent owner's one opportunity to file comments is **dismissed as premature**.

Note that with regard to any potential non-entry of patent owner's amendment filed in reply to the ACP, MPEP 2673.02 states in part:

> In the event that an amendment submitted by the patent owner after the ACP has not been entered because the amendment does not comply with the requirements of 37 CFR 1.116 (see 37 CFR 1.951(a)), the patent owner may file a petition under 37 CFR 1.181 requesting entry of the amendment. The petition under 37 CFR 1.181 must be filed within the time period for filing a notice of appeal or cross appeal, if appropriate (see 37 CFR 1.953(c)). Note that the filing of a petition under 37 CFR 1.181 does **not** toll the time period for filing a notice of appeal or cross appeal, if appropriate. Thus, in addition to the petition under 37 CFR 1.181, the patent owner is encouraged to file (1) a petition under 37 CFR 1.183 requesting waiver of the prohibition of an extension of time for filing an appeal brief (37 CFR 41.66(a)), and (2) a request for an extension of the period to file the appeal brief until after a decision on the petition under 37 CFR 1.181. The third party requester may once file comments responsive to the patent owner's petition under 37 CFR 1.181 within 30 days from the date of service of the patent owner's petition under 37 CFR 1.181 on the third party requester. When rendering a decision on the petition under 37 CFR 1.181, the deciding official should be mindful that a patent owner in an *inter partes* reexamination proceeding may not be able to proceed effectively if the amendment submitted after the ACP is not entered since the patent owner in an *inter partes* reexamination proceeding does not have the right to continue the proceeding by refiling under 37 CFR 1.53(b) or 1.53(d) nor by filing a Request for Continued Examination under 37 CFR 1.114, and the patent owner cannot file an *inter partes* reexamination.

With regard to what justice requires, due to the recurring pattern of providing amendments that are NOT in compliance with 37 C.F.R. § 1.530, the Office's ability to proceed with "special dispatch" in the instant merged reexamination proceeding has been frustrated. In the event critical rights are lost for failure to timely provide an amendment in compliance with 37 C.F.R. § 1.530, it is to be noted that the Office and third party requester have countervailing interests of "special dispatch" which must be weighed in deciding the instant petition under 37 C.F.R. § 1.183. The petitioner's assertion that justice requires granting of this petition is not well-taken, as the repeated failure of patent owner to comply with the amendment rules for reexamination has resulted in prolonged prosecution within the Office.

Concerning petitioner's contentions that the result of the present ACP is contrary to the purpose provided in the MPEP 2671.02, which states that before an ACP is in order, a clear issue should be developed, such argument is not well-founded. A clear issue has been developed, it is based on the one proper amendment that patent owner has provided to the Office. Petitioner postures that the issue of whether a process as claimed in the present reexamination proceeding without vacuum is patentable has not been developed. While this may be unfortunate, the Office is not responsible for patent owner's failure to provide a timely and proper amendment directed to these claim limitations. Petitioner further argues that the examiner should not prematurely cut off the prosecution with a patent owner who is seeking to define the invention in the claims that will offer the patent protection to which the patent owner is entitled, per MPEP 2671.02. However, it should be noted that patent owner was cautioned in the first Office action mailed on April 4, 2002, (i.e., more than 5 years ago) that:

> "In order to ensure full consideration of any amendments, affidavits or declarations, or other documents as evidence of patent ability, such documents must be submitted in response to this Office action. Submissions after the next Office action, which is intended to be an action closing prosecution (ACP), will be governed by the requirements of 37 C.F.R. 1.116, which will be strictly enforced."

Therefore, to contend that the ACP of June 26, 2007, is premature is without merit. Petitioner purports that it is clear that the patent owner is seeking to define the process claimed in the patent to be without vacuum and/or without vacuum and in a dry environment, and asserts that each of these elements

distinguishes the claimed invention over the prior art. Petitioner states that the patent owner believes that the claims containing the amended claim language entitle the patent owner to such protection. However, since a proposed amendment did accompany patent owner's response to the ACP, if the proposed amendment complies with 37 C.F.R. § 1.530, and is found by the examiner to be enter-able based on the criteria of 37 C.F.R. § 1.116, then it shall be entered and considered.

The PETITION UNDER 37 C.F.R. § 1.183 has been fully considered, but is **dismissed as premature**.

CONCLUSION

1. The PETITION UNDER 37 C.F.R. § 1.183 is **dismissed**.

2. The merged *inter partes* reexamination proceeding has been forwarded to the examiner for consideration of the patent owner's and requester's comments in response to the ACP per MPEP 2672, and preparation of the next Office action pursuant to MPEP 2673.

3. Any future correspondence with respect to this merged *inter partes* reexamination proceeding should be addressed as follows:

By mail: Mail Stop *Inter Partes* Reexam
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-9900
Attn: Central Reexam Unit

By hand: Customer Service Window
Attn: Central Reexam Unit
401 Dulany Street
Alexandria, VA 22314

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

September 27, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,317	07/03/2002	6319526	01473.302800	9581

27367 7590 09/03/2008

WESTMAN CHAMPLIN & KELLY, P.A.
SUITE 1400
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/03/2008

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
Eugene J. Bernard
Townsend and Townsend and Crew LLP
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Date: MAILED
SEP 03 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90006317 + 95000003
PATENT NO. : 6319526
ART UNIT : 3900

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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CENTRAL REEXAMINATION UNIT

In re Reexamination Proceeding :
Dahlstrom et al. :
Control No. 95/000,003 :
Filed: January 8, 2002 :
U.S. Patent No. 6,319,526 : **DECISION GRANTING**
: **PETITION**

In re Reexamination Proceeding :
Dahlstrom et al. :
Control No. 90/006,317 :
Filed: July 3, 2002 :
U.S. Patent No. 6,319,526 :

This is a decision on the July 23, 2008 patent owner petition under 37 CFR 1.137(b), entitled "PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)." The petition is being treated as a petition under 37 CFR 1.958(b) to revive *inter partes* reexamination prosecution, and under 37 CFR 1.137(b) to accept an appellant brief as having been unintentionally delayed.

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

DECISION

37 CFR 1.958(b) incorporates the requirements of 37 CFR 1.137(b) for revival of an *inter partes* reexamination prosecution that was terminated (or limited) due to an unintentionally delayed response by patent owner. 37 CFR 1.137(b) states, in part:

> "*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 ...."

The present petition under 37 CFR 1.137(b) includes, *inter alia*:

1) The requisite response (an appellant brief with authorization to charge the $510.00 brief fee) to satisfy item 1;

2) The $1,540.00 petition fee under 37 CFR 1.17(m) (an authorization to charge counsel's credit card for the $1,540.00 petition fee under 37 CFR 1.17(m)) to satisfy item 2; and

3) The requisite statement regarding the delay to satisfy item 3; and

4) A Certificate of Service upon Third Party Requester to satisfy 37 CFR 1.903.

Accordingly, the July 23, 2008 appellant brief is accepted as having been unintentionally delayed.

ADDITIONAL DISCUSSION

37 CFR 41.66 (b) states:

> (b) Once an appellant's brief has been *properly filed*, any brief must be filed by respondent within one month from the date of service of the appellant's brief. The time for filing a respondent's brief or an amended respondent's brief may not be extended.

37 CFR 41.68 states (in part):

> (a) (1) Respondent(s) in an appeal may once, within the time limit for filing set forth in § 41.66, file a respondent brief and serve the brief on all parties in accordance with § 1.903 of this title.

As the petition to revive includes a paper (appellant brief) that triggers a third party requester right to respond, the requester is being provided an opportunity to file a respondent's brief. The appellant brief is not considered "properly filed" in the proceeding until the prosecution is revived; thus, third party requester's time period to file a respondent's brief begins to run from the date of the petition granting revival. Accordingly, any third party requester respondent's brief addressing patent owner's July 23, 2008 appellant brief must be filed **within one month from the issue date of the instant decision to revive the instant proceeding.**

CONCLUSION

1. The petition under 37 CFR 1.958(b) and 37 CFR 1.137(b) is granted.

2. A fee in the amount of $2050.00 (1540.00 + $510.00) has been charged in accordance with petitioner's EFS web submission containing the present petition.

3. A time period for third party requester to file a respondent brief in accordance with 37 CFR 41.68 is set to expire **one (1) month from the issue date of this decision.**

4. Jurisdiction over the reexamination proceeding is being returned to Central Reexamination Unit (CRU) for processing of papers received, and to await receipt of respondent's brief or the expiration of the time for filing same, after which jurisdiction will be returned to CRU Art Unit 3991 for consideration.

5. Any further communications as to the reexamination proceeding should be directed to the supervisor Deborah Jones of CRU Art Unit 3991, who can be reached at 571-272-1535.

6. Telephone inquiries related to this decision should be directed to Joseph F. Weiss at 571-272-7759.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

09-2-08
C:\kiva\kpet-abe\IP\ 95_0003-grant_uninten.doc

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,317	07/03/2002	6319526	01473.302800	9581

27367 7590 10/15/2008

WESTMAN CHAMPLIN & KELLY, P.A.
SUITE 1400
900 SECOND AVENUE SOUTH
MINNEAPOLIS, MN 55402-3244

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/15/2008

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Eugene J. Bernard
Townsend and Townsend and Crew LLP
Two Embarcadero Center, 8th Floor
San Francisco, CA 94111

Date:
MAILED

OCT 15 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90006317
PATENT NO. : 6319526
ART UNIT : 3900

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.
95/000,003	01/08/2002	6319526	01473.302300	4575

27367 7590 10/15/2008

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SUITE 1400
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EXAMINER

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SAN FRANCISCO, CA 94111

Date:

MAILED

OCT 15 2008

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000003
PATENT NO. : 6319526
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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

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

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

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

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CENTRAL REEXAMINATION UNIT

WESTMAN CHAMPLIN & KELLY, P.A.
SUITE 1400
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MINNEAPOLIS MN 55402-3244

(For Patent Owner)

Townsend, Townsend & Crew LLP
Two Embarcadero Center, Eighth Floor
San Francisco, CA 94111-3834

(For Third Party Requester)

In re Reexamination Proceeding Dahlstrom et al. Control No. 95/000,003 Filed: January 8, 2002 U.S. Patent No. 6,319,526	DECISION ON PETITION TO CONTINUE *INTER PARTES* REEXAMINATION PROCEEDINGS AND AS A REQUEST FOR ENTRY OF AN AMENDMENT AFTER FILING FOR APPEAL
In re Reexamination Proceeding Dahlstrom et al. Control No. 90/006,317 Filed: July 3, 2002 U.S. Patent No. 6,319,526	

This is a decision on patent owner's July 23, 2008 "PETITION UNDER 37 CFR 1.183," requesting waiver of 37 CFR 1.953(c) and 37 CFR 41.33 to reopen prosecution in the instant reexamination proceeding for entry of a "STATEMENT OF PATENT OWNER AND AMENDMENT," filed with the petition. The July 23, 2008 petition is being treated as a petition Requesting Continued Reexamination under 37 CFR 1.182 and also as a petition requesting waiver of 37 CFR 41.63(c) under 37 CFR 1.183.

The petition is before the Office of Patent Legal Administration.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.183 was charged to petitioner's credit card on July 23, 2008.

For the reasons set forth below, the petition under 37 CFR 1.183 is dismissed.

REVIEW OF THE FACTS

1. U.S Patent number 6,319,526 (the '526 patent) issued to Dahlstrom et al. on November 20, 2001.

2. On January 8, 2002, a request for *inter partes* reexamination of the '526 patent was filed in the Office by a first third party requester. The request was assigned reexamination proceeding control number 95/000,003 (the '003 reexamination proceeding).

3. On April 4, 2002, the Office issued an order, in the '003 reexamination proceeding, granting inter partes reexamination of the '526 patent. Concurrently with the order the Office issued a non-final Office action.

4. On June 3, 2002, patent owner filed a response to the Office action pursuant to 37 CFR 1.945, including an amendment, in the '003 reexamination proceeding.

5. On June 10, 2002, the Office issued a Notice of Defective paper stating that the June 3, 2002 amendment was not in compliance with 37 CFR 1.530 (d)-(j) and setting a one month time period for patent owner to file a proper amendment.

6. On July 3, 2002, third party requester, pursuant to 37 CFR 1.947, filed comments to patent owner's June 3, 2002 response.

7. Also on July 3, 2002, a request for *ex parte* reexamination for the '526 patent was filed in the Office by a second third party requester. The request was assigned reexamination proceeding control number 90/006,317 (the '6317 reexamination proceeding).

8. On July 9, 2002, patent owner filed a corrected amendment in compliance with 37 CFR 1.530 (d) – (j) in the '003 reexamination proceeding.

9. On August 20, 2002, the Office issued an order, in the '6317 reexamination proceeding, granting *ex parte* reexamination of the '526 patent.

10. On January 30, 2003, the Office issued a decision merging the '003 *inter partes* reexamination proceeding and the '6317 *ex parte* reexamination proceeding (the merged reexamination proceeding).

11. On February 28, 2003, patent owner filed a housekeeping amendment in the merged reexamination proceeding.

12. On February 16, 2005, the Office issued a non-final Office action for the merged reexamination proceeding.

13. On April 27, 2005, the patent owner filed a response to the Office action, including an amendment, in the merged reexamination proceeding.

14. On May 24, 2005, third party requester, pursuant to 37 CFR 1.947, filed comments to patent owner's April 27, 2005 response.

15. On June 3, 2005, the Office issued a Notice of Defective paper stating that the April 27, 2005 amendment was not in compliance with 37 CFR 1.530 (d)-(j) and setting a one

month time period for patent owner to file a proper amendment. A patent owner response to the notice was not received.

16. On July 18, 2005, patent owner filed a petition under 37 CFR 1.137(a), for the revival of a terminated reexamination proceeding based upon unavoidable delay, accompanied by declarations and a proposed late response (including an amendment) to the Notice of Defective paper issued by the Office on June 3, 2005.

17. On September 23, 2005, the Office issued a decision dismissing as moot patent owner's July 18, 2005 petition noting that prosecution of the proceeding had not in fact terminated. The Office also noted that the late filed amendment was NOT in compliance with 37 CFR 1.530.

18. On August 28, 2006, the Office inadvertently issued a Notice of Intent to Issue a Reexamination Certificate (NIRC) canceling claims 1-14 and 16-163.

19. On September 16, 2006, patent owner filed a petition under 37 CFR 1.182, requesting withdrawal of the cancellation of claims 1-14 and 16-163 and requesting entry and consideration of patent owner's response (to include an amendment) concurrently filed with the petition.

20. On October 27, 2006, the Office issued a decision *sua sponte* withdrawing the August 28, 2006 NIRC and reinstating claims 1-14 and 16-163 to a pending status. The decision dismissed patent owner's request for consideration and entry of the amendment to the claims made in the September 16, 2006 petition, because the accompanying amendment did not comply with 37 CFR 1.530. The Office transferred jurisdiction to the Central Reexamination Unit (CRU) for further consideration.

21. On June 23, 2007, the Office issued an Action Closing Prosecution (ACP) in the merged proceeding.

22. On July 26, 2007, patent owner filed a response to the ACP that included an amendment and a petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.951 requesting entry and consideration of the concurrently filed amendment.

23. On August 24, 2007, third party requester filed comments after ACP pursuant to 37 CFR 1.951(b).

24. On September 27, 2007, the Office issued a decision dismissing patent owner's July 26, 2007 petition noting that such petition was premature, as 37 CFR 1.951(a)[1] provide for patent owner to present an amendment in response to an ACP.

25. On January 29, 2008, patent owner filed a reissue application of the '526 patent. The Office assigned the application U.S. Application Serial number 12/011,746.

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[1] However subject to the criteria of § 1.116 as to whether or not it shall be admitted.

26. On April 1, 2008, the Office issued a Right of Appeal Notice (RAN) in the merged proceeding. The RAN noted that patent owner's amendment submitted after ACP was not entered due to a failure to comply with the amendment entry criteria set forth in 37 CFR 1.952 and 1.116.

27. On April 30, 2008, patent owner filed a Notice of Appeal.

28. On July 23, 2008, patent owner filed a petition for petition under 37 CFR 1.137(b), for entry of late papers (an Appeal Brief) based upon unintentional delay. The petition was accompanied by an appeal brief, a certificate of service and payment of fees.

29. Also on July 23, 2008, patent owner submitted a petition under 37 CFR 1.183 requesting entry of an amendment attached to and concurrently filed with the petition.

30. On September 3, 2008 the Office issued a decision granting the revival of the merged reexamination proceeding.

RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

37 CFR 1.182 provides:

> 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 Director, 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(f).

37 CFR 1.183 provides:

> 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).

37 CFR 1.953(c) provides:

> The Right of Appeal Notice shall be a final action, which comprises a final rejection setting forth each ground of rejection and/or final decision favorable to patentability including each determination not to make a proposed rejection, an identification of the status of each claim, and the reasons for decisions favorable to patentability and/or the grounds of rejection for each claim. No amendment can be made in response to the Right of Appeal Notice. The Right of Appeal Notice shall set a one-month time period for either party to appeal. If no notice of appeal is filed, prosecution in the inter partes reexamination proceeding will be terminated, and the Director will proceed to issue and publish a certificate under § 1.997 in accordance with the Right of Appeal Notice.

37 CFR 41.33(c) provides (for *ex parte* appeals):

> (c) All other amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i), 41.50(b)(1) and 41.50(c).

37 CFR 41.63 provides (for *inter partes* reexamination appeals):

> (a) Amendments filed after the date of filing an appeal pursuant to § 41.61 canceling claims may be admitted where such cancellation does not affect the scope of any other pending claim in the proceeding.
>
> (b) All other amendments filed after the date of filing an appeal pursuant to § 41.61 will not be admitted except as permitted by § 41.77(b)(1).
>
> (c) Affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.61 will not be admitted except as permitted by reopening prosecution under § 41.77(b)(1).

MPEP 2672 (VI) ACTION CLOSING PROSECUTION - PREMATURE states:

> If the patent owner is of the opinion that the Office action closing prosecution in the inter partes reexamination proceeding is premature, the patent owner may, in addition to the comments submitted under 37 CFR 1.951(a), file a petition under 37 CFR 1.181 within the time period for filing the comments under 37 CFR 1.951(a). The third party requester may then once file, as a paper separate from any submission under 37 CFR 1.951(b), comments responsive to the patent owner's petition under 37 CFR 1.181 within 30 days from the date of service of the patent owner's petition under 37 CFR 1.181 on the third party requester.

MPEP 2673.02 states (in part):

> In the event that an amendment submitted by the patent owner after the ACP has not been entered because the amendment does not comply with the requirements of 37 CFR 1.116 (see 37 CFR 1.951(a)), the patent owner may file a petition under 37 CFR 1.181 requesting entry of the amendment. The petition under 37 CFR 1.181 must be filed within the time period for filing a notice of appeal or cross appeal, if appropriate (see 37 CFR 1.953(c)). Note that the filing of a petition under 37 CFR 1.181 does not toll the time period for filing a notice of appeal or cross appeal, if appropriate. Thus, in addition to the petition under 37 CFR 1.181, the patent owner is encouraged to file (1) a petition under 37 CFR 1.183 requesting waiver of the prohibition of an extension of time for filing an appeal brief (37 CFR 41.66(a)), and (2) a request for an extension of the period to file the appeal brief until after a decision on the petition under 37 CFR 1.181. The third party requester may once file comments responsive to the patent owner's petition under 37 CFR 1.181 within 30 days from the date of service of the patent owner's petition under 37 CFR 1.181 on the third party requester. When rendering a decision on the petition under 37 CFR 1.181, the deciding official should be mindful that a patent owner in an inter partes reexamination proceeding may not be able to proceed effectively if the amendment submitted after the ACP is not entered since the patent owner in an inter partes reexamination proceeding does not have the right to continue the proceeding by refiling under 37 CFR 1.53(b) or 1.53(d) nor by filing a Request for Continued Examination under 37 CFR 1.114, and the patent owner cannot file an inter partes reexamination.

MPEP 2674 states (in part):

> It should be noted that under 37 CFR 41.63(a), amendments filed after the date of filing an appeal (under 37 CFR 41.61) canceling claims may be admitted, where such cancellation does not affect the scope of any other pending claim in the proceeding. However, as to all other amendments filed after the date of filing an appeal, 37 CFR 41.63(b) states that such amendments will not be admitted except as permitted where the patent owner takes action for reopening prosecution under 37 CFR 41.77(b)(1). Also, under 37 CFR 41.63(c), affidavits, declarations, or exhibits submitted after the date of filing an appeal will not be admitted except as permitted by reopening prosecution under 37 CFR 41.77(b)(1).

DECISION

Petitioner patent owner requests that the Office suspend 37 CFR 1.953(c) and 37 CFR 41.33(c) and reopen prosecution in the merged proceeding to provide consideration of the amendment that was filed on July 23, 2008, after the filing of a notice of appeal and submission of an appeal brief. Patent owner's July 23, 2008 petition will be treated as both a petition under 37 CFR 1.182 as a Request to Continue Reexamination (RCR) and as a petition under 37 CFR 1.183 to suspend 37 CFR 41.63(c).

CONTINUATION OF PROSECUTION UNDER 37 CFR 1.182

In March of 2005, the Office issued a Notice entitled "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."[2] Notice was provided therein that a second (or subsequent) reexamination would no longer be ordered on the basis of a "substantial new question of patentability" (SNQ) that is the same as a SNQ raised in an earlier pending reexamination. Notice was also provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding. By filing such a petition, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding. Accordingly, relief in the form of a continuation of the reexamination prosecution (after a final Office action) was made available by the Office via a 37 CFR 1.182 petition, in appropriate circumstances. This petition will be referred to herein as "the § 1.182 petition."

The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. This is critical in the reexamination setting, where 35 U.S.C. 305 (for *ex parte* reexamination) and 35 U.S.C. 314 (for *inter partes* reexamination) mandate that reexamination proceedings must be conducted "with special dispatch within the Office." Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, because this is a key factor in reducing pendency of a reexamination

[2] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

proceeding. Stated another way, the § 1.182 petition practice includes a requirement that the filing of the § 1.182 petition be accompanied by a submission that provides a *bona fide* effort to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate.

Based on the facts and circumstances of the present case, Petitioner patent owner's response in the form of an amendment and remarks/arguments directed towards continued reexamination of additional issues of patentability is not a *bona fide* effort to advance prosecution and as such, the granting of the present petition is inconsistent with the requirement of 35 USC 305 to conduct reexamination proceedings "with special dispatch within the Office."

Petitioner presents two arguments to justify the granting of the extraordinary relief of request for continued reexamination: (1) An allegation the claims, as amended in the amendment concurrently submitted with the petition for continued reexamination, are patently distinct over the prior art of record; and (2) The denial of entry of previous versions of the amendment concurrently submitted during reexamination in the merged reexamination proceeding due to formal matters should not preclude consideration of the substantive content of the amendment.

Petitioner's first argument that continued reexamination should be granted because the amendments to the claims render the claims patentable is not persuasive. Specifically, petitioner states on page 2 of the instant petition at the beginning of the second full paragraph of the page that, "It is clear that the patent owner is seeking to define the process claimed in the patent to be without vacuum and/or without vacuum and in a dry environment." The presentation of this amendment is not in response to the issue asserted as being raised for the first time in a final Office action. Furthermore, a review of the amendments made indicate that not all the claims contain the negative limitation of "without vacuum." Claims 114-136, 155-161, and 163 set forth the negative limitation "without vacuum." If such a limitation clearly defines over the prior art of record to place the claim in *prima facia* condition for allowance,why is the limitation not in all the claims? Furthermore, petitioner's remarks do not point to express support for the negative limitation of "without vacuum" to resolve any issues of patentability that may arise under 35 USC 112, first paragraph. Instead petitioner makes speculative conclusions as to absence of a vacuum in various examples set forth in the written description, which are unsupported by evidence or legal analysis as to how petitioner arrived at such speculative conclusions. Finally, petitioner also amends all the claims to include a limitation regarding adding emulsifying salts, dairy ingredients, non-dairy ingredients or other generally recognized as safe ingredients to the curd and then a subsequent limitation that requires these same ingredients to not be added, thus creating another issue of patentability (indefiniteness) under 35 USC 112, second paragraph. Therefore, petitioner's amendment actually injects several new issues of patentability that could only be resolved by further prolonging the reexamination proceeding, and not reducing issues in the proceeding. The presentation of new limitations into some of the claims, while alleging the limitation renders all the claims patently distinct, and simultaneously not decisively establishing proper support for the new limitations and creating issues of indefiniteness only adds to the issues of patentability that must be resolved. The current proceeding is a REEXAMINATION PROCEEDING with a statutory mandate of SPECIAL DISPATCH and its current procedural posture is AFTER A FINAL OFFICE ACTION and on APPEAL. The creation of new issues of patentability in the accompanying response is inappropriate, as the limitations only complicate and delay reexamination. Thus the response runs contrary to the statutory mandate of "special

dispatch." Accordingly, continued reexamination is not appropriate here, due to petitioner's creation of issues that are not even prompted by the presentation of information raised for the first time in a final Office action.

Petitioner's second argument that the denial of entry of previous versions of the amendment concurrently submitted during reexamination in the merged reexamination proceeding due to formal matters should not preclude consideration of the substantive content of the amendment is not persuasive. Specifically, petitioner states on page 2 of the instant petition that the issues of patentability regarding the addition of the "without vacuum and/or without vacuum and in a dry environment" limitations have been thwarted by the Office's denial of their entry during prosecution. The Office's basis for denying entry of petitioner's amendments containing the "without vacuum and/or without vacuum and in a dry environment" limitations were based upon a failure of petitioner to comply with 37 CFR 1.530. Petitioner has characterized the requirement of 37 CFR 1.530 as matters of form which should not get in the way of determining the important matters of patent rights to an important invention. The presentation of this amendment is not in response to an issue or information being raised for the first time in a final Office action. Instead, the amendment is presented for the fifth time in response to a rule, of which petitioner should be aware, that governs the foundational manner in which reexamination proceedings are conducted. As noted above in regards to petitioner's assertion as to developing the patentability of the claims with the proposed limitations of "without vacuum and/or without vacuum and in a dry environment," such cannot be dispositive of the case because petitioner has not placed the limitations in all the claims and has not properly proven the existence of the legally necessary support for the limitations to avoid a rejection under 35 USC 112, first paragraph. Further, the record reflects that, in addition to the current submission, petitioner has submitted essentially the same amendment on four different occasions during prosecution of the present proceeding (April 27, 2005, July 18, 2005, September 19, 2006 and July 26, 2007). In response to all of petitioner's submissions, the Office either rejected or noted that the amendments failed to comply with 37 CFR 1.530. Petitioner is essentially arguing that, because the rule is one of "form" petitioner should not be required to comply, or that the statutory requirement of special dispatch should be dispensed with to accommodate patent owner's lack of attentiveness to the rule. The concurrently submitted version continues this non-compliance,[3] Which would further delay special dispatch in spite of the fact that the Office has given petitioner multiple opportunities to comply with 37 CFR 1.530. 37 CFR 1.530 supports special dispatch by allowing the Office to readily examine the merits of the amendment without having to continually revisit previously presented amendments to discern what issues are being further developed. Petitioner has had multiple opportunities to insure their rights are optimally preserved, but has not done so. Accordingly, an continued reexamination is no appropriate.

SUSPENSION OF THE RULES UNDER 37 CFR 1.183

Patent owner's arguments for suspending rule 37 CFR 41.63(c) and enter amendment filed on July 23, 2008 are not persuasive and hence is not be granted. MPEP section 2673.02 of the Manual of Patent Examining Procedure (MPEP) states, "[a]n amendment filed after the RAN will not be entered at all, in the absence of a grantable petition under 37 CFR 1.183, because 37

[3] The concurrent filed amendment, *inter alia*, does not use bracketing to designate deleted text from claim 124.

CFR 1.953(c) prohibits an amendment after the RAN in an *inter partes* reexamination." The provisions of 37 CFR 1.953(c) may be waived under 37 CFR 1.183 where a petitioner demonstrates an extraordinary situation in which justice requires suspension of the rule. However, MPEP section 2674 states, "[a]s to all other amendments filed after the date of filing an appeal, 37 CFR 41.63(b) states that such amendments will not be admitted except as permitted where the patent owner takes action for reopening prosecution under 37 CFR 41.77(b)(1). Also, under 37 CFR 41.63(c), affidavits, declarations, or exhibits submitted after the date of filing an appeal will not be admitted except as permitted by reopening prosecution under 37 CFR 41.77(b)(1)." A notice of appeal was filed on April 30, 2008 and petitioner filed an appeal brief on July 23, 2008. Therefore, the July 23, 2008 amendment has been filed after the date of filing an appeal, and 37 CFR 41.63 now governs the merged proceeding regarding entry of amendments.

In light of the analysis of petitioner's arguments in the previous section regarding continued reexamination relief, even if the petition and amendment were timely filed, patent owner's arguments do not demonstrate an extraordinary situation in which justice requires suspension of the rule prohibiting the filing of an amendment after the date of filing for an appeal in an *inter partes* reexamination. The entry of an amendment after the date of filing for an appeal for the purpose of presenting amended claims so as to merely raise additional new issues of patentability and prolong the reexamination proceeding and not for the purposes of advancing prosecution toward appeal (e.g., by reducing the issues on appeal) is not a situation where justice requires suspension of the rule.

On July 26, 2007, petitioner submitted a response to ACP that included a proposed amendment and a petition under 37 CFR 1.183 requesting suspension of rule 37 CFR 1.951 and entry of the amendment. On September 27, 2007 the Office dismissed petitioner's request for a wavier of 37 CFR 1.951 as being premature because the rule actually gives discretion for entry of amendments after ACP. The September 27, 2007 decision noted that if entry of the amendment after ACP was denied then, in accordance with MPEP 2673.02, patent owner had legal recourse to seek review of the denial of entry. The decision replicated the relevant portion of MPEP 2673.02 and highlighted the fact that patent owner would need to file a petition under 37 CFR 1.181 seeking supervisory review of the denial of entry and, while the filing of a notice of appeal could not be extended, patent owner could simultaneously file a petition under 37 CFR 1.183 seeking an extension of time to file an appeal brief until a decision issued on the 37 CFR 1.181 request for supervisory review of the denial of entry. Petitioner opted not to pursue this alternative legal recourse and instead filed a notice of appeal and subsequently an appeal brief. Accordingly, as petitioner opted to pursue the appeal and declined to pursue the proper legal course of action that did not require a suspension of the rules, the instant petition for entry suspension of 37 CFR 41.63 is not persuasive.

As a final point, the repeated failure to comply with the reexamination amendment rules does not provide an extraordinary situation.

For the reasons set forth above, petitioner's arguments for waiver of 37 CFR 41.63(c) is not persuasive. Petitioner has not presented facts that demonstrate an extraordinary situation in which justice requires suspension of 37 CFR 41.63(c) for entry of the July 23, 2008 amendment

filed after the date of filing for an appeal. Furthermore, as noted above petitioner opted not to avail themselves of the appropriate alternative legal recourse that would have mooted the need to request suspension of 37 CFR 41.63(c).

In view of the above and the fact situation presented by the record, the petition is dismissed, and jurisdiction of the proceeding is returned to the Central Reexamination Unit (CRU) for appeal.

CONCLUSION

1. The petition under 37 CFR 1.182 is dismissed.

2. The petition under 37 CFR 1.183 is dismissed.

3. Prosecution is not being reopened by this decision, and patent owner's amendment will not be entered.

4. The merged reexamination proceeding will continued its current appeal process.

5. Jurisdiction for the merged reexamination proceeding is returned to the Central Reexamination Unit for appeal.

6. Telephone inquiries related to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759, or in his absence, the undersigned at (571) 272-7710.

Kenneth Schor,
Senior Legal Advisor
Office of Patent Legal Administration

UNITED STATES PATENT AND TRADEMARK OFFICE

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27367 7590 11/04/2009

WESTMAN CHAMPLIN & KELLY, P.A.
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MINNEAPOLIS, MN 55402

EXAMINER

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DATE MAILED: 11/04/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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San Francisco, CA 94111

Date: MAILED
NOV 04 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90006317 + 95/000003
PATENT NO. : 6319526
ART UNIT : 3900

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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(For Third Party Requester)

MAILED

NOV 04 2009

CENTRAL REEXAMINATION UNIT

In re Dahlstrom et al.
Inter partes Reexamination Proceeding
Control No.: 95/000,003
Filing Date: January 8, 2002
For: U.S. Patent No. 6,319,526

In re Dahlstrom et al.
Ex parte Reexamination Proceeding
Control No.: 90/006,317
Filing Date: July 3, 2002
For: U.S. Patent No. 6,319,526

DECISION GRANTING PETITION UNDER 37 CFR 1.183

This is a decision on patent owner's August 31, 2009 "PETITION UNDER 37 C.F.R. § 1.183," requesting waiver of 37 CFR §§ 41.63(c) and 41.66(e) to permit entry of a concurrently filed declaration under 37 CFR 1.131, accompanied by attached Exhibits A-P.

The petition is before the Office of Patent Legal Administration.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.183 was charged to petitioner's credit card on September 8, 2009.

For the reasons set forth below, the petition under 37 CFR 1.183 is granted.

Accordingly, the August 31, 2009 declaration under 37 CFR 1.131 and attached Exhibits A-P, will be entered for consideration by the examiner. The third party requester is given a period of fifteen (15) days from the mailing date of the present decision to submit a response solely limited to addressing the Garaoutte declaration and attached Exhibits A-P.

REVIEW OF THE FACTS

1. U.S Patent number 6,319,526 (the '526 patent) issued to Dahlstrom et al. on November 20, 2001.

2. On January 8, 2002, a request for *inter partes* reexamination of the '526 patent was filed in the Office by a third party requester. The request was assigned reexamination proceeding control number 95/000,003 (the '003 reexamination proceeding).

3. On April 4, 2002, the Office issued an order in the '003 reexamination proceeding granting *inter partes* reexamination of the '526 patent. Concurrently with the order, the Office issued a non-final Office action.

4. On June 3, 2002, patent owner filed a response to the Office action pursuant to 37 CFR 1.945, including an amendment, in the '003 reexamination proceeding.

5. On June 10, 2002, the Office issued a Notice of Defective paper stating that the June 3, 2002 amendment was not in compliance with 37 CFR 1.530 (d)-(j) and setting a one month time period for patent owner to file a proper amendment.

6. On July 3, 2002, third party requester, pursuant to 37 CFR 1.947, filed comments to patent owner's June 3, 2002 response.

7. Also on July 3, 2002, a request for *ex parte* reexamination for the '526 patent was filed in the Office by the same third party requester that filed the *inter partes* reexamination request. This request was assigned reexamination proceeding control number 90/006,317 (the '6317 reexamination proceeding).

8. On July 9, 2002, patent owner filed a corrected amendment in compliance with 37 CFR 1.530 (d) - (j) in the '003 reexamination proceeding.

9. On August 20, 2002, the Office issued an order in the '6317 reexamination proceeding granting *ex parte* reexamination of the '526 patent.

10. On January 30, 2003, the Office issued a decision merging the '003 *inter partes* reexamination proceeding and the '6317 *ex parte* reexamination proceeding (the merged reexamination proceeding).

11. On February 28, 2003, patent owner filed a housekeeping amendment in the merged reexamination proceeding.

12. On February 16, 2005, the Office issued a non-final Office action for the merged reexamination proceeding.

13. On April 27, 2005, the patent owner filed a response to the Office action, including an amendment, in the merged reexamination proceeding.

14. On May 24, 2005, third party requester, pursuant to 37 CFR 1.947, filed comments to patent owner's April 27, 2005 response.

15. On June 3, 2005, the Office issued a Notice of Defective paper stating that the April 27, 2005 amendment was not in compliance with 37 CFR 1.530 (d)-(j) and setting a one month time period for patent owner to file a proper amendment. A patent owner response to the notice was not received.

16. On July 18, 2005, patent owner filed a petition under 37 CFR 1.137(a), for the revival of a terminated reexamination proceeding based upon unavoidable delay, accompanied by declarations and a proposed late response (including an amendment) to the Notice of Defective paper issued by the Office on June 3, 2005.

17. On September 23, 2005, the Office issued a decision dismissing as moot patent owner's July 18, 2005 petition noting that prosecution of the proceeding had not in fact terminated. The Office also noted that the late filed amendment was NOT in compliance with 37 CFR 1.530.

18. On August 28, 2006, the Office inadvertently issued a Notice of Intent to Issue a Reexamination Certificate (NIRC) canceling claims 1 - 14 and 16-163.

19. On September 19, 2006, patent owner filed a petition under 37 CFR 1.182, requesting withdrawal of the cancellation of claims 1-14 and 16-163 and requesting entry and consideration of patent owner's response (to include an amendment) concurrently filed with the petition.

20. On October 27, 2006, the Office issued a decision *sua sponte* withdrawing the August 28, 2006 NIRC and reinstating claims 1-14 and 16-163 to a pending status. The decision dismissed patent owner's request for consideration and entry of the amendment to the claims made in the September 16, 2006 petition, because the accompanying amendment did not comply with 37 CFR 1.530.

21. On June 26, 2007, the Office issued an Action Closing Prosecution (ACP) in the merged proceeding.

22. On July 26, 2007, patent owner filed a response to the ACP that included an amendment and a petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.951 and entry and consideration of the concurrently filed amendment.

23. On August 24, 2007, third party requester filed comments after ACP pursuant to 37 CFR 1.951(b).

24. On September 27, 2007, the Office issued a decision dismissing patent owner's July 26, 2007 petition noting that such petition was premature, as 37 CFR 1.951(a)[1] provided for patent owner to present an amendment in response to an ACP.

---

[1] However subject to the criteria of § 1.116 as to whether or not it shall be admitted.

25. On January 29, 2008, patent owner filed a reissue application of the '526 patent. The Office assigned the application U.S. Application Serial number 12/011,746.

26. On April 1, 2008, the Office issued a Right of Appeal Notice (RAN) in the merged proceeding. The RAN noted that patent owner's amendment submitted after ACP was not entered due to a failure to comply with the amendment entry criteria set forth in 37 CFR 1.953 and 1.116.

27. On April 30, 2008, patent owner filed a Notice of Appeal.

28. On July 23, 2008, patent owner filed a petition under 37 CFR 1.137(b), for entry of late papers (an appellant brief) based upon unintentional delay. The petition was accompanied by an appeal brief, a certificate of service and payment of fees.

29. Also on July 23, 2008, patent owner submitted a petition under 37 CFR 1.183 requesting entry of an amendment attached to and concurrently filed with the petition.

30. On September 3, 2008 the Office issued a decision granting the revival of the merged reexamination proceeding.

31. On October 3, 2008, third party requester filed a respondent brief.

32. On October 15, 2008, the Office issued a decision dismissing patent owner's July 23, 2008 petition.

33. On February 23, 2009, the Office issued an Examiner's Answer.

34. On March 23, 2009, patent owner filed a rebuttal brief in response to the Examiner's Answer.

35. On April 8, 2009, the Office issued a Notice of Defective paper stating that the July 23, 2008 appellant brief was improper because it was 33 pages in length, with no word count provided. The Notice also stated that the October 3, 2008 respondent's brief was in response to the improper appellant brief, and thus the requester's respondent brief was moot and would not be considered.

36. On April 22, 2009, patent owner resubmitted appellant brief.

37. On May 12, 2009, third party requester resubmitted respondent brief.

38. On July 8, 2009, the Office issued a Notice of Defective paper stating that the April 22, 2009 appellant brief was defective because appellant failed to argue the rejections of all of the pending claims 1-14 and 16-163, which contradicted the appellant's statement under "Status of Claims" in the brief that pending claims 1-14 and 16-163 were rejected and were on appeal.

39. On August 6, 2009, patent owner resubmitted appellant brief.

40. On August 10, 2009, patent owner filed an amendment after an appeal pursuant to 37 CFR 41.63(a) to cancel claims 104-113, 124, and 137-163.

41. On August 20, 2009, third party requester resubmitted a respondent brief.

42. On August 31, 2009, patent owner filed the present petition under 37 CFR 1.183 to request waiver of 37 CFR §§ 41.63(c) and 41.66(e) to permit entry of a concurrently filed declaration under 37 CFR 1.131.

43. On September 28, 2009, the Office issued an Examiner's Answer in response to the August 6, 2009 resubmitted appellant brief and the August 20, 2009 resubmitted respondent brief.

44. On October 13, 2009, patent owner filed a rebuttal brief.

45. On October 29, 2009, the Office issued a Notice of Defective rebuttal brief.

RELEVANT REGULATIONS AND EXAMINING PROCEDURE

37 CFR 1.183 provides:

> 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).

37 CFR 41.63(c) provides (for *inter partes* reexamination appeals):

> Affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.61 will not be admitted except as permitted by reopening prosecution under § 41.77(b)(1).

37 CFR 41.66(e) provides (for *inter partes* reexamination appeals):

> No further submission will be considered and any such submission will be treated in accordance with § 1.939 of this title.

MPEP 2674 states (in part):

> It should be noted that under 37 CFR 41.63(a), amendments filed after the date of filing an appeal (under 37 CFR 41.61) canceling claims may be admitted, where such cancellation does not affect the scope of any other pending claim in the proceeding. However, as to <u>all other amendments filed after the date of filing an appeal</u>, 37 CFR 41.63(b) states that such amendments will not be admitted except as permitted where the patent

owner takes action for reopening prosecution under 37 CFR 41.77(b)(1). Also, under 37 CFR 41.63(c), affidavits, declarations, or exhibits submitted after the date of filing an appeal will not be admitted except as permitted by reopening prosecution under 37 CFR 41.77(b)(1).

DECISION

In the present petition under 37 CFR 1.183, petitioner patent owner requests that the Office waive 37 CFR §§ 41.63(c) and 41.66(e) and permit entry of the concurrently filed declaration of Garaoutte under 37 CFR 1.131 (hereinafter "the Garaoutte declaration"), accompanied by attached Exhibits A-P. The patent owner alleges that the Garaoutte declaration provides evidence of prior invention with respect to U.S. Patent No. 6,120,809 to Rhodes ("Rhodes '809). Patent owner asserts that he did not discover the existence of the documentary evidence until after the Action Closing Prosecution was issued, and therefore was procedurally prevented from submitting the evidence of prior invention that would eliminate Rhodes '809 as prior art during the present reexamination proceeding. Patent owner explains that he has spent a significant amount of time and effort locating the evidence of prior invention, that each of the three inventors listed in the patent that is the subject of the present reexamination proceeding had ceased employment with patent owner prior to the institution of the instant present proceeding, and that the existence and location of these documents were unknown to the patent owner until after the Action Closing Prosecution was mailed.[2] Patent owner asserts that the evidence submitted conclusively proves actual reduction to practice of the claimed methods prior to the filing date of Rhodes '809.[3] With the submission of the Garaoutte declaration, patent owner argues that it has traversed each and every prior art rejection of the claims.[4] Patent owner states that if the present petition is not granted, patent owner may lose all patent rights to an important invention.[5] The examiner and the examiner's supervisor have been consulted, and they have agreed to enter the Garaoutte declaration and accompanied exhibits.

Based on the facts and circumstances of the present case, the petition under 37 CFR 1.183 is granted, and the Garaoutte declaration and accompanied exhibits will be entered for consideration by the examiner, in the interest of resolving the issues of the present proceeding with special dispatch, pursuant to the requirement of 35 U.S.C. 305 to conduct reexamination proceedings "with special dispatch within the Office."

THIRD PARTY REQUESTER OPTION

In order to address the equities of the present situation, the requirements of 37 CFR 41.66(e) and 37 CFR 41.63(c) are *sua sponte* waived to the extent that third party requester is provided with one opportunity to file a response to the newly entered evidence – the Garaoutte declaration and accompanied exhibits - which is granted entry by the present petition. Any such requester response must be filed within fifteen (15) days from the mailing date of the present decision. If a

[2] Petition at page 2.
[3] Petition at page 2.
[4] Petition at page 2.
[5] Petition at page 3.

response to the Garaoutte declaration and accompanied exhibits is filed and it goes beyond this limitation, the response will be returned, or expunged if entered before discovery of such defect.

CONCLUSION

1. The present petition under 37 CFR 1.183 is granted. Accordingly, the August 31, 2009 Garaoutte declaration and attached Exhibits A-P are entered.

2. The third party requester is given a period of fifteen (15) days from the mailing date of the present decision to submit a response solely limited to addressing the Garaoutte declaration and attached Exhibits A-P .

3. Jurisdiction over the proceeding is returned to the Central Reexamination Unit, to await the filing of a response to the Garaoutte declaration and accompanied exhibits or the expiration of time for same, after which the examiner will take appropriate action.

4. Telephone inquiries related to the present decision should be directed to the Susy Tsang-Foster, Legal Advisor, at 571-272-7711, or, in her absence, to the undersigned at 571-272-7711.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,317	07/03/2002	6319526	01473.302800	9581

27367 7590 03/25/2010

WESTMAN CHAMPLIN & KELLY, P.A.
SUITE 1400
900 SECOND AVENUE SOUTH
MINNEAPOLIS, MN 55402

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/25/2010

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

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San Francisco, CA 94111

Date:
MAILED

MAR 25 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90006317
PATENT NO. : 6319526
ART UNIT : 3900

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.
95/000,003	01/08/2002	6319526	01473.302300	4575

27367 7590 03/25/2010

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/25/2010

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Date:
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MAR 25 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000003
PATENT NO. : 6319526
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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

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

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

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

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MAILED

MAR 25 2010

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In re Dahlstrom et al.	:	
Merged *Inter Partes* Reexamination	:	
Proceeding 95/000,003 &	:	**DECISION**
Ex Parte Reexamination	:	**DISMISSING**
Proceeding 90/006,317	:	**PETITION**
Filed: January 8, 2002 & July 3, 2002	:	
For: U.S. Patent No. 6,319,526	:	

This is a decision on the patent owner petition, filed January 12, 2010, denominated "Petition Under 37 CFR § 1.183" requesting waiver of the signature of an unwilling inventor on a declaration under 37 CFR 1.131.

The proceeding and the petition are before the Office of Patent Legal Administration for decision.

The petition fee required under 37 CFR 1.17(f) has been received, but is being refunded for the reasons explained below.

The petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.131 is **dismissed**.

REVIEW OF FACTS

1. U.S. Patent No. 6,319,526 (the '526 patent) issued to Dahlstrom et al. on November 20, 2001.

2. On January 8, 2002, a request for *inter partes* reexamination of the '526 patent was filed by a third party requester, which proceeding was assigned control no. 95/000,003 (the '003 proceeding).

3. On April 4, 2002, reexamination was ordered and a non-final Office action was mailed in the '003 proceeding.

4. On July 3, 2002, a request for *ex parte* reexamination of the '526 patent was filed by the *inter partes* third party requester, which proceeding was assigned control no. 90/006,317 (the '6317 proceeding).

5. On August 20, 2002 reexamination was ordered in the '6317 proceeding, granting *ex parte* reexamination of the '526 patent.

6. On January 30, 2003, the '003 and '6317 proceedings were merged.

7. The merged proceeding progressed to the point of appeal, with the patent owner filing a Notice of Appeal on April 30, 2008.

8. Following filings of the patent owner's appeal brief, respondent's brief, examiner's answer, and rebuttal brief, patent owner petitioned on August 31, 2009 for the opportunity to file arguments after the issuance of the Right of Appeal Notice and filing the Appeal in order to submit evidence of prior invention in the form of a declaration under 37 CFR 1.131(a).

9. Patent owner's August 31, 2009 petition was granted on November 4, 2009 to permit entry of the declaration under 37 CFR 1.131 and attached Exhibits A-P for consideration by the examiner.

10. On December 17, 2009, a second Action Closing the Prosecution (ACP) was mailed stating that reexamination was reopened solely for the purpose of entering the declaration under 37 CFR 1.131 and that the rejections set forth in the ACP dated June 26, 2007 and the Right of Appeal Notice dated April 1, 2008 are maintained. The declaration filed under 37 CFR 1.131 was found by the examiner to fail to demonstrate that any of the inventors of the '526 patent reduced the claimed invention to practice. The second ACP also stated that the patent owner failed to follow the procedure of MPEP 715.04, Part I, by failing to file a petition to request a waiver to permit entry of a declaration without all of the inventors' signatures.

11. After requesting and receiving an extension of time, patent owner filed comments to the second ACP on January 29, 2010 along with a second declaration under 37 CFR 1.131 executed by two of the three inventors and a petition under 37 CFR 1.183 requesting that the requirement that all the inventors sign the declaration be waived. The petition is the subject of this decision.

12. The third party requester filed comments following patent owners comments to the second ACP on February 25, 2010.

DECISION

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR 1.131(a) provides, in pertinent part (emphasis added):

> When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, **the owner of the patent under reexamination**, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. [Emphasis added.]

37 CFR 1.183 provides, in pertinent part:

> 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).

MPEP 715.04 I. provides, in pertinent part (emphasis added):

> The following parties may make an affidavit or declaration under 37 CFR 1.131:
>
> (A) All the inventors of the subject matter claimed.
>
> (B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.
>
> (C) If a petition under 37 CFR 1.47 was granted or the application was accepted under 37 CFR 1.42 or 1.43, the affidavit or declaration may be signed by the 37 CFR 1.47 applicant or the legal representative, where appropriate.
>
> (D) The assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor. *Ex parte Foster*, 1903 C.D. 213, 105 O.G. 261 (Comm'r Pat. 1903).
>
> Affidavits or declarations to overcome a rejection of a claim or claims must be made by the inventor or inventors of the subject matter of the rejected claim(s), a party qualified under 37 CFR 1.42, 1.43, or 1.47, **or the assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor(s)**. Thus, where all of the named inventors of a pending application are not inventors of every claim of the application, any affidavit under 37 CFR 1.131 could be signed by only the inventor(s) of the subject matter of the rejected claims. [Emphasis added.]

37 CFR § 3.73 Establishing right of assignee to take action:

> (a) The inventor is presumed to be the owner of a patent application, and any patent that may issue therefrom, unless there is an assignment. The original applicant is presumed to be the owner of a trademark application or registration, unless there is an assignment.
> (b) (1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:
>
> (i) Documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment). For trademark matters only, the documents submitted to establish ownership may be required to be recorded pursuant to § **3.11** in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office. For patent matters only, the submission of the documentary evidence must be accompanied by a statement affirming that the

documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § **3.11**; or

(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

(2) The submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

(i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or

(ii) Being signed by a person having apparent authority to sign on behalf of the assignee, *e.g.*, an officer of the assignee.

(c) For patent matters only:

(1) Establishment of ownership by the assignee must be submitted prior to, or at the same time as, the paper requesting or taking action is submitted.

(2) If the submission under this section is by an assignee of less than the entire right, title and interest, such assignee must indicate the extent (by percentage) of its ownership interest, or the Office may refuse to accept the submission as an establishment of ownership.

ANALYSIS AND FINDINGS

Patent owner requests that the requirement for the signature of one of the inventors, William Aimutis, be waived for a declaration under 37 CFR 1.131, which has been submitted with signatures of the other two inventors, James Wiegand and Donald Dahlstrom. Addressing the substance of the petition, it is pointed out that the extraordinary relief of waiving a rule is not granted if the rules provide an alternative avenue for obtaining the relief sought. See, *Cantello v. Rasmussen*, 220 USPQ 664 (Comr. 1982). In this instance, it would appear that, even if the petition is not granted, an alternative avenue that complies with the rules is available to obtain the requested relief.

37 CFR 1.131 specifically provides that " . . . *the owner of the patent under reexamination. . .* may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based" (emphasis added). As pointed out in MPEP 715.04 I.(D), an assignee, or other party in interest is permitted to make a declaration under 37 CFR 1.131 "when it is not possible to produce the declaration of the inventor," as is asserted in the case here. In accordance with the language of 37 CFR 1.131, the assignee may make the declaration for a patent under reexamination, even if the inventors are available to sign a declaration. In this case, the inventors, rather than the patent owner, have attempted to submit a declaration under 37 CFR 1.131. However, waiver of the rule is not required, since the patent owner (assignee) can sign the declaration.

It is acknowledged that the second Action Closing Prosecution incorrectly stated that the patent owner failed to follow the proper procedure for making a Rule 131 declaration by not petitioning to request waiver. However, the owner of a patent under reexamination has the ability to make the declaration under 37 CFR 1.131(a) without a petition. Due to this inadvertent error that may have led the patent owner to file the subject petition, the petition fee is being refunded to patent owner.

Patent owner is reminded that, in order to file a declaration under 37 CFR 1.131(a), the right of the assignee to take action must be established in the reexamination proceeding by filing a proper statement under 37 CFR 3.73(b). To date, no such paper has been filed establishing the authority of the assignee to act in this proceeding.

In summary, the petitioner has not shown the present situation to be one warranting extraordinary relief. Patent owner has an available remedy in which (1) the right to act in this proceeding may be established and then (2) a declaration under 37 CFR 1.131 signed by patent owner may be filed. For that reason, the petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.131 is dismissed.

CONCLUSION

1. For the reasons set forth above, the petition under 37 CFR 1.183 to waive 37 CFR 1.131 as to its requirement for signature of an oath or declaration is **dismissed**.

2. The $400.00 petition fee paid under 37 CFR 1.17(f) is being refunded.

3. This decision does not address the merits of the patent owner's response or the substance of the declaration, which are determinations within the jurisdiction of the examiner of record.

4. Jurisdiction over the reexamination proceeding is being returned to the Central Reexamination Unit (CRU) for any further examination as appropriate.

5. Any inquiry concerning this communication should be directed to Caroline D. Dennison, Legal Advisor, at (571) 272-7729.

/Kenneth M. Schor/

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

March 24, 2010

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.
90/006,317	07/03/2002	6319526	01473.302800	9581

27367 7590 06/02/2010

WESTMAN CHAMPLIN & KELLY, P.A.
SUITE 1400
900 SECOND AVENUE SOUTH
MINNEAPOLIS, MN 55402

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/02/2010

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

Eugene J. Bernard
Townsend and Townsend and Crew LLP
Two Embarcadero Center, 8th Floor
San Francisco, CA 94111

Date:

MAILED

JUN 0 2 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90006317
PATENT NO. : 6319526
ART UNIT : 3900

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.
95/000,003	01/08/2002	6319526	01473.302300	4575

27367 7590 06/02/2010

WESTMAN CHAMPLIN & KELLY, P.A.
SUITE 1400
900 SECOND AVENUE SOUTH
MINNEAPOLIS, MN 55402

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/02/2010

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
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
EUGENE J. BERNARD
TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER, 8TH FLOOR
SAN FRANCISCO, CA 94111

Date:
MAILED

JUN 0 2 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000003
PATENT NO. : 6319526
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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

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

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

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

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

Z. Peter Sawicki (For Patent Owner)
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Suite 1400 – International Centre
900 Second Avenue South
Minneapolis, MN 55402-3319

MAILED

JUN 0 2 2010

CENTRAL REEXAMINATION UNIT

Eugene J. Bernard (For Requester)
Townsend & Townsend & Crew LLP
Two Embarcadero Center, 8th Floor
San Francisco, CA 94111

In re Dahlstrom et al.	:	
Merged *Inter Partes* Reexamination	:	
Proceeding 95/000,003 &	:	**DECISION**
Ex Parte Reexamination	:	**DISMISSING**
Proceeding 90/006,317	:	**PETITION**
Filed: January 8, 2002 & July 3, 2002	:	
For: U.S. Patent No. 6,319,526	:	

This is a decision on the patent owner petition, filed May 24, 2010, denominated "Request for Reconsideration of Denial of Petition Under 37 CFR § 1.183," requesting reconsideration of the March 25, 2010 decision dismissing patent owner's petition under 37 CFR 1.183 to waive the requirement that all inventors sign a declaration under 37 CFR 1.131.

The proceeding and the petition are before the Office of Patent Legal Administration for decision.

The petition under 37 CFR 1.183 for reconsideration is **dismissed** as premature. Petitioner has not shown that this is an extraordinary situation such that relief under the rules has been exhausted and is not available. 37 CFR 1.183 provides (in pertinent part) that:

> 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).

Extraordinary relief of waiving a rule is not granted if the rules provide an alternative avenue for obtaining the relief sought. See, *Cantello v. Rasmussen*, 220 USPQ 664 (Comr. 1982). In this instance, the patent owner has pursued alternative relief via a 37 CFR 1.181 petition to request entry of the declaration. If the relief requested in the petition under 37 CFR 1.181 is granted, the relief requested in the present petition would be rendered moot. Since the entry of the declaration is currently in the process of being addressed through 37 CFR 1.181, consideration of this situation under 37 CFR 1.183 would be

premature. Patent owner retains the option of filing a renewed petition under 37 CFR 1.183, if at some future date relief has not been granted under 37 CFR 1.181 or through another section. Until such time, the issue is not ripe for consideration by the Office under 37 CFR 1.183.

In view of the above, the petition is **dismissed** as premature.

It is additionally noted that a declaration under 37 CFR 1.131 signed by **the patent owner** has not been submitted in this proceeding; thus, there does not appear to be a properly signed 37 CFR 1.131 declaration of record for consideration of entry.

Jurisdiction over the reexamination proceeding is being returned to the Central Reexamination Unit (CRU) for any further examination as appropriate.

Any inquiry concerning this communication should be directed to Caroline D. Dennison, Legal Advisor, at (571) 272-7729.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

June 1, 2010
Kenaffidavit/waiver

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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Paper No. 10

ROBERT BERLINER
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LOS ANGELES CA 90017

FOR PATENT OWNER

LAW OFFICES OF LEONA L. LAUDER
465 CALIFORNIA STREET, SUITE 450
SAN FRANCISCO, CA 94104-1840

FOR REQUESTER 1

In re Liao et al
Reexamination Proceeding
Control No.: 90/006,318
Filed: July 3, 2002
For: U.S.Patent No. 6,379,907

In re Liao et al
Reexamination Proceeding
Control No.: 90/006,667
Filed: June 12, 2003
For: U.S.Patent No. 6,379,907

: 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.6,379,907 issued April 30, 2002.

2. A first request for reexamination, Control No. 90/006,318, was filed by Patent Owner on July 3, 2002.

3. Reexamination was ordered in the '318 reexamination proceeding on September 19, 2002.

4. A second request for reexamination, Control No. 90/006,667, was filed by third party Requester on June 12, 2003.

5. Reexamination was ordered in the '667 reexamination proceeding on August 8, 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 both of the above noted reexamination proceedings. Accordingly, merger of the proceedings under 37 CFR 1.565(c) is appropriate.

DECISION

Merger of Proceedings.

In accordance with 37 CFR 1.565(c), the '318 and '667 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

Requirement for Same Amendments in Both Proceedings.

Patent Owner is required to maintain the same claims and specification in both files. No amendments have as yet been filed in either reexamination proceeding.

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 Patent Owner must consist of a single response, filed in duplicate, each bearing an original signature, for entry in each file. All papers filed by the Patent Owner must be served on the third party Requester and Requester will be sent copies of all papers mailed by the Office.

CONCLUSION

Reexamination Control Nos. 90/006,318 and 90/006,667 are merged. A statement by third party Requester in the '667 proceeding has been received and entered and the merged files will be forwarded to the examiner for further action.

Jasemine C. Chambers
Director, Technology Center 1600

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MAILED
DEC 22 2005
REEXAM UNIT

John A. Molnar, Jr.
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Cleveland, OH 44124-4141

(For Patent Owner)

Gerald Levy
Pitney, Hardin, Kipp & Szuch LLP
7 Times Square
New York, NY 10036-7311

(For Third Party Requester)

In re Kai Zhang	:
Reexamination Proceeding	: **DECISION**
Control No.: 90/006,324	: **DISMISSING**
Filed: July 9, 2002	: **PETITION**
For: U.S. Patent No.: 6,075,205	:

This is a decision on the October 26, 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. 16-0325, in accordance with petitioner's authorization on page four of the petition sent via facsimile on October 26,2005.

The petition under 37 CFR 1.137(b) is granted.

DECISION ON PETITION UNDER 37 CFR 1.137(b)

The petition under 37 CFR 1.137(b) is accompanied by the appropriate statement pursuant to 37 CFR 1.137(b)(3). In addition, the petition identifies the response as an Amendment filed previously on July 29, 2005. This Amendment, in combination with the Remarks previously submitted in an Amendment filed on November 3, 2004,[1] 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 four 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 under 37 CFR 1.137(b) is granted.

[1] The Amendment submitted on November 3, 2004 was held "defective" because the claim amendments did not comply with 37 CFR 1.530(d)-(j); petitioner resubmitted these claim amendments in proper form in the Amendment filed on July 29, 2005.

CONCLUSION

1. The petition under 37 CFR 1.137(b) is granted.

2. Jurisdiction over the reexamination proceeding is being returned to Technology Center 2800 for consideration, in due course, of the Amendment filed July 29, 2005, and the corresponding Remarks filed November 3, 2004.

3. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Adolfo Nino, in Art Unit 2831, who can be reached at (571) 272-1981.

4. 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
12/20/05

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12/21/05

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.
90/006,327	07/17/2002	6379190	103185-46664	4546

26568 7590 11/22/2002
COOK, ALEX, MCFARRON, MANZO, CUMMINGS & MEHLER LTD
SUITE 2850
200 WEST ADAMS STREET
CHICAGO, IL 60606

EXAMINER
T. PATEL

ART UNIT	PAPER NUMBER
	#8

DATE MAILED: 11/22/2002

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 8

23 NOV 2002

Edward D. Manzo
Cook, Alex, McFarron, Manzo,
Cummings & Mehler, Ltd.
200 West Adams Street, Suite 2850
Chicago, IL 60606

(for patent owner)

MAILED

23 NOV 2002

OFFICE OF THE SPECIAL PROGRAMS EXAMINER

Peter T. Corbin
Gibbons, Del Deo, Dolan, Griffinger
& Vecchione
750 Lexington Avenue
New York, NY 10022

(for first requester)

John James McGlew
McGlew and Tuttle
Scarborough Station
Scarborough, NY 10510-0827

(for second requester)

In re Prazoff
Reexamination Proceeding
Control Number 90/006,327
Filed: July 17, 2002
For: U.S. Patent No. 6,379,190
Title: Ropelight Connector

DECISION MERGING
REEXAMINATION PROCEEDINGS

In re Prazoff
Reexamination Proceeding
Control Number 90/006,328
Filed: July 18, 2002
For: U.S. Patent No. 6,379,190
Title: Ropelight Connector

In re Prazoff
Reexamination Proceeding
Control Number 90/006,344
Filed: August 01, 2002
For: U.S. Patent No. 6,379,190
Title: Ropelight Connector

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. 6,379,190 issued on April 30, 2002.

2. A first request for reexamination, Reexamination Control No. 90/006,327, was filed by a first third party requester on July 17, 2002.

3. Reexamination was ordered in the '327 reexamination proceeding on September 06, 2002.

4. A second request for reexamination, Reexamination Control No. 90/006,328, was filed by the patent owner on July 18, 2002.

5. Reexamination was ordered in the '328 reexamination proceeding on September 06, 2002.

6. A third request for reexamination, Reexamination Control No. 90/006,344, was filed by a second third party requester on August 01, 2002.

7. Reexamination was ordered in the '344 reexamination proceeding on September 06, 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* 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. <u>Merger of Proceedings</u>.

In accordance with 37 C.F.R. § 1.565(c), the '327, '328 and '344 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 all 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 files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in triplicate, each bearing an original signature, for entry in each file. All papers filed by the patent owner must be served on the requesters and requesters will be sent copies of all papers mailed by the Office.

CONCLUSION

Reexamination Control Nos. 90/006,327, 90/006,328 and 90/006,344 are merged. The reexamination files are being forwarded to the examiner for issuing a first Office action.

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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Washington, D C 20231
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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,328	07/18/2002	6379190	0573-0007.01	6433

26568 7590 11/22/2002
COOK, ALEX, MCFARRON, MANZO, CUMMINGS & MEHLER LTD
SUITE 2850
200 WEST ADAMS STREET
CHICAGO, IL 60606

EXAMINER
T. PATEL

ART UNIT	PAPER NUMBER
	#10

DATE MAILED: 11/22/2002

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

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. 10

23 NOV 2002

Edward D. Manzo :
Cook, Alex, McFarron, Manzo, : (for patent owner)
Cummings & Mehler, Ltd. :
200 West Adams Street, Suite 2850 :
Chicago, IL 60606 :

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OFFICE OF THE SPECIAL PROGRAMS EXAMINER

Peter T. Corbin :
Gibbons, Del Deo, Dolan, Griffinger : (for first requester)
& Vecchione :
750 Lexington Avenue :
New York, NY 10022 :

John James McGlew :
McGlew and Tuttle : (for second requester)
Scarborough Station :
Scarborough, NY 10510-0827 :

In re Prazoff :
Reexamination Proceeding :
Control Number 90/006,327 : DECISION MERGING
Filed: July 17, 2002 : REEXAMINATION PROCEEDINGS
For: U.S. Patent No. 6,379,190 :
Title: Ropelight Connector :

In re Prazoff :
Reexamination Proceeding :
Control Number 90/006,328 :
Filed: July 18, 2002 :
For: U.S. Patent No. 6,379,190 :
Title: Ropelight Connector :

In re Prazoff :
Reexamination Proceeding :
Control Number 90/006,344 :
Filed: August 01, 2002 :
For: U.S. Patent No. 6,379,190 :
Title: Ropelight Connector :

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. 6,379,190 issued on April 30, 2002.

2. A first request for reexamination, Reexamination Control No. 90/006,327, was filed by a first third party requester on July 17, 2002.

3. Reexamination was ordered in the '327 reexamination proceeding on September 06, 2002.

4. A second request for reexamination, Reexamination Control No. 90/006,328, was filed by the patent owner on July 18, 2002.

5. Reexamination was ordered in the '328 reexamination proceeding on September 06, 2002.

6. A third request for reexamination, Reexamination Control No. 90/006,344, was filed by a second third party requester on August 01, 2002.

7. Reexamination was ordered in the '344 reexamination proceeding on September 06, 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* 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. <u>Merger of Proceedings</u>.

In accordance with 37 C.F.R. § 1.565(c), the '327, '328 and '344 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 all 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 files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in triplicate, each bearing an original signature, for entry in each file. All papers filed by the patent owner must be served on the requesters and requesters will be sent copies of all papers mailed by the Office.

CONCLUSION

Reexamination Control Nos. 90/006,327, 90/006,328 and 90/006,344 are merged. The reexamination files are being forwarded to the examiner for issuing a first Office action.

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

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UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
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Jim H. Salter (For *Inter Partes* Requester)
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Suite 700
Los Angeles, CA 90025

MAILED
DEC 13 2002
REEXAM UNIT

In re Tarbox et al
Ex parte Reexamination Proceeding
Control No. 90/006,330
Filed: July 16, 2002
For: U.S. Patent No. 6,328,260

In re Tarbox et al
Inter partes Reexamination Proceeding
Control No. 95/000,005
Filed: July 15, 2002
For: U.S. Patent No. 6,328,260

DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.989 at this time.

REVIEW OF FACTS

1. United States Patent Number 6,328,260, issued December 11, 2001, is the subject of both *inter partes* Reexamination Control Number 95/000,005 and *ex parte* Reexamination Control Number 90/006,330.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,005 ('005), was filed July 15, 2002, by third party requester Harry Shannon.

3. A request for *ex parte* reexamination, assigned Reexamination Control No. 90/006,330 ('330), was filed July 16, 2002, by third party requester Aircraft Owners and Pilots Association.

4. An order granting reexamination was mailed for both proceedings on September 13, 2002.

5. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '330 *ex parte* reexamination expired after November 13, 2002.[1]

DECISION

I. MERGER OF PROCEEDINGS

Under 37 CFR 1.989(a):

> If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

In accordance with 37 CFR 1.989 (a), the 95/000,005 and 90/006,330 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

---

[1] There is no provision for filing a patent owner's statement in *inter partes* reexamination; rather, an Office action is issued prior to any input from parties.

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.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with an *inter partes* reexamination. Pursuant to 37 CFR 1.989 (b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the third party requester of the *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560.

B. Papers mailed/filed:

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 and the third party requester(s) will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner and the third party requester(s) must consist of a single paper, **filed in duplicate**, each bearing a signature and identifying data for both files, for entry into each file.

All papers filed by the patent owner and the third party requester(s) should be directed:

by Mail to: Attn: "Box *Inter Partes* Reexam"
Central Reexamination Unit
Office of Patent Legal Administration
United States Patent & Trademark Office
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

Patent owner and requester(s) are reminded that every paper filed in the merged proceeding subsequent to this Decision must be

served on the other parties, including papers filed *via* facsimile transmission.

C. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2250. 37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f) of this section, except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. Amendments are not to be made relative to previous amendments. Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

D. Fees:

Where a paper is filed which requires payment of a fee (e.g., petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appellant brief (or that of the *inter partes* requester), even though the brief relates to merged multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding.

E. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to insure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,005 and *ex parte* Reexamination Control No. 90/006,330 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. The merged reexamination files are being forwarded via the Technology Center Group Director to the examiner for the preparation of an Office action, to be issued in due course.

3. Any questions concerning this communication should be directed to the undersigned, at (703)308-6710.

Kenneth M. Schor

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

December 13, 2002
C:\KIVA\KENPET3\95-0005IP.MRG

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Dougherty, Clements & Hofer LLP (For *Ex Parte* Requester)
6230 Fairview Road
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Blakley, Sokoloff, Taylor
& Zafman
12400 Wilshire Blvd.
Suite 700
Los Angeles, CA 90025

MAILED

AUG 13 2004

REEXAM UNIT

In re Tarbox et al
Ex parte Reexamination Proceeding
Control No. 90/006,330
Filed: July 16, 2002
For: U.S. Patent No. 6,328,260

In re Tarbox et al
Inter Partes Reexamination Proceeding
Control No. 95/000,005
Filed: July 15, 2002
For: U.S. Patent No. 6,328,260

DECISION AS TO
LATE REQUESTER
COMMENTS

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration regarding the April 23, 2004, *inter partes* reexamination requester comments filed after the patent owner's supplemental response to the Office action of January 16, 2004.

For the reasons set forth below, the April 23, 2004, *inter partes* reexamination requester comments are not timely filed, and, as such, the comments will be refused consideration. 37 CFR 1.957(a).

REVIEW OF FACTS

1. United States Patent Number 6,328,260, issued December 11, 2001, is the subject of both *inter partes* Reexamination Control Number 95/000,005 and *ex parte* Reexamination Control Number 90/006,330.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,005 ('005), was filed July 15, 2002, by third party requester Harry Shannon (hereinafter, "the *inter partes* requester").

3. A request for *ex parte* reexamination, assigned Reexamination Control No. 90/006,330 ('330), was filed July 16, 2002, by third party requester Aircraft Owners and Pilots Association (hereinafter, "the *ex parte* requester").

4. An order granting reexamination was mailed for both proceedings on September 13, 2002.

5. On December 13, 2002, the '005 and '330 reexamination proceedings were merged into a single proceeding, by a decision of the Senior Legal Advisor of the Office of Patent Legal Administration.

6. On January 16, 2004, the examiner issued a first Office action on the merits for the merged proceeding.

7. The patent owner filed a response to the first Office action on March 17, 2004, and then supplemented that response of March 22, 2004. The Certificate of Service for the March 17, 2004, response states a date of service upon the requesters (pursuant to 37 CFR 1.248) of March 11, 2004. The Certificate of Service for the March 22, 2004, supplemental response states a date of service upon the requesters of March 15, 2004. The service is stated to be made at the correct addresses of record for the two requesters.

8. On April 23, 2004, the *inter partes* requester filed comments "in response to" the patent owner's responses. The Certificate of Service for requester's comments states a date of service upon the patent owner and *ex parte* requester (pursuant to 37 CFR 1.248) of April 16, 2004.

DECISION

The requester comments of April 23, 2004, were not timely filed.

Pursuant to 35 U.S.C. 314(b)(3):

> "Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, **if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.**" [Emphasis added]

In the present instance, (1) the Certificate of Service for the March 22, 2004, supplemental patent owner response states a date of service upon the *inter partes* requester of March 15, 2004, (2) the service is stated to be made at the correct *inter partes* requester address of record. Thus, the last possible date [1] for timely requester comments under 35 U.S.C. 314(b) was April 14, 2004. The present requester comments were filed on April 23, 2004, and as such were not timely.

It is noted that 37 CFR 1.947 provides:

> "For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8."

In the present instance, however, the requester comments have not been found to include a certificate under 37 CFR 1.8. There is a Certificate of Service on the other parties to the merged proceeding stating a date of service upon the patent owner and *ex parte* requester of April 16, 2004. However, a Certificate of Service on parties is not a certificate under 37 CFR 1.8. Further, the April 16, 2004, date of the Certificate of Service is still after the April 14, 2004, due date for the comments.

---

[1] The Certificate of Service for the March 17, 2004, original patent owner response states a date of service upon the requester of March 11, 2004. Based on that Certificate, the requester comments were due by April 10, 2004. In the last sentence of MPEP 2666.40, however, it is stated (for a patent owenr response curing a defect in an original response) that "if the patent owner's response is not limited to the bare submission of the fee, i.e., if the response also includes argument, then the third party can comment since the patent owner has addressed the merits of the case." Even if the correction of the District Court citation which is the entirety of the supplemental response could be considered as being "addressed the merits of the case," the requester comments were due by April 14, 2004.

In view of the above, the requester comments of April 23, 2004, are not timely filed.

Under 37 CFR 1.957(a), "[i]f the third party requester files an untimely or inappropriate comment... in an *inter partes* reexamination, the paper will be refused consideration." In addition, pursuant to MPEP 2667, part II.B.3:

> "Any third party requester submission following a patent owner's submission, where the third party requester submission is filed subsequent to the permitted time from the date of service of the patent owner's submission, will be retained in the file, but will not be considered."

Since the *inter partes* requester comments were not timely filed, they will not be considered, but will be retained in the file of the merged proceeding.

CONCLUSION

1. For the reasons set forth below, the April 23, 2004, requester comments are not timely filed, and will be refused consideration. The comments will, however, be retained in the file.

2. The merged reexamination file is being forwarded via the Technology Center 3600 Group Director to the examiner for the preparation of an Office action, to be issued in due course. The examiner's action will address the patent owner response of March 17, 2004, and supplemental response of March 22, 2004, but will not address the April 23, 2004, requester comments.

3. Any questions concerning this communication should be directed to the undersigned, at (703)308-6710.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

August 11, 2004
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UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 20

Mark A. Haynes, Esquire Haynes, Beffel & Wolfield, LLP P.O. Box 336 Half Moon Bay, California 94109	))))	**FOR PATENT OWNER**
John C. Phillips Fish and Richardson, P.C. 4350 La Jolla Village Drive Suite 500 San Diego, California 92122	)))))	**FOR THIRD PARTY REQUESTOR**
In re Reexamination of: U.S. Patent No. 5,878,053 Reexamination Control No. 90/006,331 For: HIERARCHICAL POWER NETWORK SIMULATION AND ANALYSIS TOOL FOR RELIABILITY TESTING OF DEEP SUBMICRON DESIGNS	)))))))))	**RESPONSE TO PETITION UNDER 37 CFR §1.59**

This is a response to the petition under 37 CFR 1.59(b), filed February 27, 2003, to expunge information from the above identified application.

The decision on the petition will be held in abeyance until final resolution of patentability of the claims under Reexamination, at which time the petition will be decided.

Petitioner requests that documents submitted which are subject to protective order, filed February 27, 2003, 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(h) 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 applicant.

Pinchus M. Laufer

Pinchus M. Laufer
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security
(703) 306-4160

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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,331	07/16/2002	5878053	13208-007001	9914

7590 03/05/2004

MARK A. HAYNES, ESQ.
HAYNES BEFFEL & WOLFELD, LLP
P.O. BOX 366
HALF MOON BAY, CA 94019

EXAMINER
H. JONES

ART UNIT	PAPER NUMBER
2123	33

DATE MAILED. 03/05/2004

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

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Paper No. 33

Mark A. Haynes, Esquire Haynes, Beffel & Wolfield, LLP P.O. Box 336 Half Moon Bay, California 94109	))))	**FOR PATENT OWNER**
John C. Phillips Fish and Richardson, P.C. 4350 La Jolla Village Drive Suite 500 San Diego, California 92122	)))))	**FOR THIRD PARTY REQUESTOR**
In re Reexamination of: U.S. Patent No. 5,878,053 Reexamination Control No. 90/006,331 For: HIERARCHICAL POWER NETWORK SIMULATION AND ANALYSIS TOOL FOR RELIABILITY TESTING OF DEEP SUBMICRON DESIGNS	))))))))	**RESPONSE TO PETITION UNDER 37 CFR §1.59**

This is a response to the petition under 37 CFR 1.59(b), filed March 4, 2004, to expunge information from the above identified application.

Petitioner requests that documents submitted which are proprietary and considered to be trade secrets, filed March 4, 2004, be expunged from the record. The petition fee set forth in 37 CFR 1.17(h) has been charged to Deposit account No. 50-0869.

The petition is **DISMISSED**.

Relevant parts of the M.P.E.P. which relate to this petition are reproduced below.

724.05 Petition To Expunge Information or Copy of Papers in Application File

I. INFORMATION SUBMITTED UNDER MPEP § 724.02

A petition under 37 CFR 1.59(b) to expunge information ... If the information is found to be important to a reasonable examiner in deciding on patentability, any petition to expunge the information will be denied. Any such petition to expunge information submitted under MPEP § 724.02 should be submitted at the time of filing the information under MPEP § 724.02 and directed to the Technology Center (TC) to which the application is assigned. Such petition must contain:

...

(B) a clear statement that the information to be expunged is trade secret material, proprietary material, and/or subject to a protective order, and that the information has not been otherwise made public;

(C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;

... it is important that both the submission of any material under MPEP § 724.02 and the submission of any petition to expunge occur as early as possible during the examination process.

A decision on the petition is ***premature*** 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 petition to expunge must be dismissed at this time.

During prosecution on the merits, the examiner will determine whether or not the identified document is considered to be "material." ***Once prosecution on the merits is closed, applicant may re-submit a petition to expunge the information.*** No further fee is required for such a second submission of a petition under 37 CFR 1.59 to expunge information. If the information is <u>not</u> considered by the examiner to be material, the information will be expunged from the file.

Inquiries with respect to this decision may be directed to Pinchus M. Laufer at (703) 306-4160.

Pinchus M. Laufer

Pinchus M. Laufer
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security
(703) 306-4160

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 20

Mark A. Haynes, Esquire Haynes, Beffel & Wolfield, LLP P.O. Box 336 Half Moon Bay, California 94109	))))	**FOR PATENT OWNER**
John C. Phillips Fish and Richardson, P.C. 4350 La Jolla Village Drive Suite 500 San Diego, California 92122	)))))	**FOR THIRD PARTY REQUESTOR**
In re Reexamination of: U.S. Patent No. 5,878,053 Reexamination Control No. 90/006,331 For: HIERARCHICAL POWER NETWORK SIMULATION AND ANALYSIS TOOL FOR RELIABILITY TESTING OF DEEP SUBMICRON DESIGNS	)))))))))	**RESPONSE TO PETITION UNDER 37 CFR §1.59**

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Petitioner requests that documents submitted which are subject to protective order, filed February 27, 2003, 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(h) 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.

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Pinchus M. Laufer

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,331	07/16/2002	5878053	13208-007001	9914

7590 03/05/2004

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EXAMINER
H. JONES

ART UNIT	PAPER NUMBER
2123	33

DATE MAILED. 03/05/2004

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Paper No. 33

Mark A. Haynes, Esquire Haynes, Beffel & Wolfield, LLP P.O. Box 336 Half Moon Bay, California 94109	))))	**FOR PATENT OWNER**
John C. Phillips Fish and Richardson, P.C. 4350 La Jolla Village Drive Suite 500 San Diego, California 92122	)))))	**FOR THIRD PARTY REQUESTOR**
In re Reexamination of: U.S. Patent No. 5,878,053 Reexamination Control No. 90/006,331 For: HIERARCHICAL POWER NETWORK SIMULATION AND ANALYSIS TOOL FOR RELIABILITY TESTING OF DEEP SUBMICRON DESIGNS	))))))))	**RESPONSE TO PETITION UNDER 37 CFR §1.59**

This is a response to the petition under 37 CFR 1.59(b), filed March 4, 2004, to expunge information from the above identified application.

Petitioner requests that documents submitted which are proprietary and considered to be trade secrets, filed March 4, 2004, be expunged from the record. The petition fee set forth in 37 CFR 1.17(h) has been charged to Deposit account No. 50-0869.

The petition is **DISMISSED**.

Relevant parts of the M.P.E.P. which relate to this petition are reproduced below.

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...

(B) a clear statement that the information to be expunged is trade secret material, proprietary material, and/or subject to a protective order, and that the information has not been otherwise made public;

(C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;

... it is important that both the submission of any material under MPEP § 724.02 and the submission of any petition to expunge occur as early as possible during the examination process.

A decision on the petition is ***premature*** 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 petition to expunge must be dismissed at this time.

During prosecution on the merits, the examiner will determine whether or not the identified document is considered to be "material." ***Once prosecution on the merits is closed, applicant may re-submit a petition to expunge the information.*** No further fee is required for such a second submission of a petition under 37 CFR 1.59 to expunge information. If the information is <u>not</u> considered by the examiner to be material, the information will be expunged from the file.

Inquiries with respect to this decision may be directed to Pinchus M. Laufer at (703) 306-4160.

Pinchus M. Laufer

Pinchus M. Laufer
Special Programs Examiner
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Mark A. Haynes, Esquire Haynes, Beffel & Wolfield, LLP P.O. Box 336 Half Moon Bay, California 94109	))))	**FOR PATENT OWNER**
John C. Phillips Fish and Richardson, P.C. 12390 El Camino Real San Diego, California 92130-3081	))))	**FOR THIRD PARTY REQUESTOR**
In re Reexamination of: U.S. Patent No. 5,878,053 Reexamination Control No. 90/006,331 For: HIERARCHICAL POWER NETWORK SIMULATION AND ANALYSIS TOOL FOR RELIABILITY TESTING OF DEEP SUBMICRON DESIGNS	)))))))))	**RESPONSE TO PETITION UNDER 37 CFR §1.181**

This is a response to the petition under 37 CFR 1.181, filed January 6, 2005 (originally filed October 7, 2004) to invoke supervisory review with respect to a requirement to label drawings as prior art.

In an Office action mailed August 17, 2004, the Examiner maintained a requirement for Patent Owner to label original patent drawings 4, 5, and 7 as "Prior Art". This requirement was previously made and Patent Owner timely requested reconsideration from the Examiner.

37 CFR §1.552 which details the scope of reexamination in ex parte reexamination proceeding provides in relevant part:

> (a) Claims in an ex parte reexamination proceeding will be examined ***on the basis of patents or printed publications*** and, with respect to subject matter added or deleted in the reexamination proceeding, on the basis of the requirements of 35 U.S.C. 112.

(b) Claims in an ex parte reexamination proceeding will not be permitted to enlarge the scope of the claims of the patent.

(c) ***Issues other than those indicated in paragraphs (a) and (b) of this section will not be resolved in a reexamination proceeding.*** ...

Accordingly, the proper labeling of a figure is not within the scope of the reexamination proceeding. The examiner may not raise such issues nor require Patent Owner to respond to such a requirement.

The petition is **GRANTED**. The requirement to label the figures is **WITHDRAWN.** The Examiner is directed to acknowledge this in the next Office communication.

Inquiries with respect to this decision may be directed to Pinchus M. Laufer at (571) 272-3599.

Pinchus M. Laufer

Pinchus M. Laufer
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security
(571) 272-3599

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JAN 11 2005

REEXAM UNIT

Mark A. Haynes, Esq.
HAYNES BEFFEL & WOLFELD, LLP
P.O. BOX 366
Half Moon Bay, CA 94019

(For Patent Owner)

John C. Phillips, Esq.
FISH & RICHARDSON, P.C.
12390 El Camino Real
San Diego, CA 92130

(For Requester)

In re Koh et al.
Reexamination Proceeding
Control No. 90/006,331
Filed: July 16, 2002
For: U.S. Patent No. 5,878,053

DECISION GRANTING PETITION

This is a decision on the September 30, 2004, 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 $1330.00 pursuant to 37 C.F.R. § 1.17(m) for the petition under 37 C.F.R. § 1.137(b) has been charged to a credit card, per the instructions on page 2 of the instant petition.

The petition for revival under 37 C.F.R. § 1.137(b) based upon unintentional delay is **granted** for the reasons indicated below.

DECISION

A grantable petition under 37 C.F.R. § 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed;

(2) the petition fee required by 37 C.F.R. § 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional.

Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 C.F.R. § 1.137(b) was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(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 statement from the due date until the filing of the present petition 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, and was accompanied by a statement in response to the interview of July 29, 2004, which meets the criteria of 37 C.F.R. § 1.137(b)(1). It is also noted that a Notice of Appeal was filed on September 8, 2004, and an Appeal Brief was filed on October 22, 2004.

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 returned to Technology Center 2100, for consideration of the statement, as well as all other subsequently filed papers (i.e., appeal brief of 10/22/04 and petition of 1/5/05).

3. Any inquiries with regard to the merits of this proceeding should be directed to Examiner Hugh Jones, of Group Art Unit 2128.

4. Any telephone inquiries with regard to this decision should be directed to the undersigned at (571) 272-7722.

Lynn M. Kryza

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

January 11, 2005

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Half Moon Bay, CA 94019

(For Patent Owner)

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FISH & RICHARDSON, P.C.
12390 El Camino Real
San Diego, CA 92130

(For Requester)

In re Koh et al.
Reexamination Proceeding
Control No. 90/006,331
Filed: July 16, 2002
For: U.S. Patent No. 5,878,053

DECISION GRANTING PETITION

This is a decision on the September 30, 2004, 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 $1330.00 pursuant to 37 C.F.R. § 1.17(m) for the petition under 37 C.F.R. § 1.137(b) has been charged to a credit card, per the instructions on page 2 of the instant petition.

The petition for revival under 37 C.F.R. § 1.137(b) based upon unintentional delay is **granted** for the reasons indicated below.

DECISION

A grantable petition under 37 C.F.R. § 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed;

(2) the petition fee required by 37 C.F.R. § 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional.

Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 C.F.R. § 1.137(b) was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(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 statement from the due date until the filing of the present petition 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, and was accompanied by a statement in response to the interview of July 29, 2004, which meets the criteria of 37 C.F.R. § 1.137(b)(1). It is also noted that a Notice of Appeal was filed on September 8, 2004, and an Appeal Brief was filed on October 22, 2004.

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 returned to Technology Center 2100, for consideration of the statement, as well as all other subsequently filed papers (i.e., appeal brief of 10/22/04 and petition of 1/5/05).

3. Any inquiries with regard to the merits of this proceeding should be directed to Examiner Hugh Jones, of Group Art Unit 2128.

4. Any telephone inquiries with regard to this decision should be directed to the undersigned at (571) 272-7722.

Lynn M. Kryza

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

January 11, 2005

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,331	07/16/2002	5878053	13208-007001	9914

7590 06/28/2005

MARK A. HAYNES, ESQ.
HAYNES BEFFEL & WOLFELD, LLP
P.O. BOX 366
HALF MOON BAY, CA 94019

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/28/2005

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

John C. Phillips
FISH and RICHARDSON, P.C.
12390 El Camino Real
San Diego, California 92130

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/006,331*.

PATENT NO. *5878053*.

ART UNIT *2128*.

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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Half Moon Bay, CA 94019

FOR PATENT OWNER

John C. Phillips
FISH and RICHARDSON, P.C.
12390 El Camino Real
San Diego, California 92130

FOR THIRD PARTY RREQUESTER

In re Reexamination of:
U.S. Patent No. 5,878,053
Reexamination Control No. 90/006,331
Filed: July 16, 2002
For: HIERARCHICAL POWER NETWORK SIMULATION AND ANALYSIS FOR RELIABILITY TESTING OF DEEP SUBMICRON IC DESIGN

DECISION ON PETITION UNDER 37 § CFR 1.59

This is a decision on the petition under 37 CFR § 1.59(b), filed June 17, 2005 to expunge information submitted pursuant to MPEP § 724.02.

The petition is **GRANTED**.

Petitioner requests that the twenty one (21) documents submitted on 04 March 2004 and fourteen (14) documents submitted on 25 February 2003 be expunged from the record. Petitioner states that the information contains materials that are subject to secret, proprietary and protective order which have not been made public. The petition fee set forth in 37 CFR 1.17(h) has been paid.

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

Patent Owner is required to retain the expunged material(s) for the life of the patent.

Vincent N. Trans
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
(571) 272-3613

UNITED STATES PATENT AND TRADEMARK OFFICE

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Washington, D.C. 20231
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#25

RICHARD S. MYERS, JR. (For Patent Owner)
STITES AND HARBISON PLLC
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TIMOTHY R. KROBOTH (For Requester)
KROBOTH LAW OFFICE
5501 PROVIDENCE COUNTRY CLUB DRIVE
CHARLOTTE, NC 28277-2636

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OFFICE OF PETITIONS

In re Simpson et al
Reexamination Proceeding
Control No. 90/006,336
Filed: July 26, 2002
For: U.S. Patent No. 6,265,055

DECISION GRANTING PETITION

This is also a decision on the December 21, 2004, third party requester "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 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, the third party requester's Appeal Brief was filed on December 13, 2004, thereby providing the "reply required to the outstanding Office action or notice" pursuant to 37 CFR 1.137(b)(1). Further, the required petition fee of $750 has been received, thereby providing the "petition fee as set forth in 37 CFR 1.17(m)" pursuant to 37 CFR 1.137(b)(2). Accordingly, the petition under 37 CFR 1.137(b) is granted.

PETITION FOR EXTENSION OF TIME

A final Office action was mailed on June 8, 2004, which set a two month period for filing a reply. On August 12, 2004, a Notice of Appeal bearing a certificate of mailing date of August 9, 2004 (August 8, 2004, the due date, was a Sunday) was timely filed. The filing of an Appeal Brief was due on or before October 12, 2004. On December 13, 2004, an Appeal Brief, a petition for an extension of time, and two declarations under 37 CFR 1.132 (bearing a certificate of mailing date of December 9, 2004) were filed.

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 filing an Appeal Brief was due two months from the August 12, 2004 filing date of the Notice of Appeal. Therefore, the period for filing the Appeal Brief expired after October 12, 2004; thus, the December 13, 2004 petition for extension of time was not timely filed. Further, there was no showing of "sufficient cause" for the extension. Accordingly, the December 13, 2004 petition for extension of time could not be granted.

Additionally, since the $225 extension of time fee submitted with the petition for extension of time on December 13, 2004, 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 50-2752 in due course.

CONCLUSION

1. The petition under 37 CFR 1.137(b) is **granted**.

2. The reexamination file is being returned to Technology Center AU 1773 for action, in due course, on the Appeal Brief and Declarations under 37 CFR 1.132 filed December 13, 2004.

3. Any further communications as to the merits of the reexamination proceeding should be directed to Examiner Dhirajlal S. Nakarani, in Technology Center AU 1773, who can be reached at (571) 272-1512.

4. Telephone inquiries related to this decision should be directed to Frances Hicks at (571) 272-3218.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,340	07/31/2002	5119382	2500.507	7350

7590 03/26/2004

EXAMINER

Henry G. Kohlman
The Boeing Company
15480 Laguna Canyon Rd., MC1650-7003
Irvine, CA 92618

ART UNIT	PAPER NUMBER

DATE MAILED: 03/26/2004 11

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Paper No. 11

Henry G. Kohlman (For Patent Owner)
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Irvine, CA 92618

Geoffrey R. Myers (For Requester)
Hall, Priddy, Myers, and Vande Sande
10220 River Road, Suite 200
Potomac, MD 20854

In re Kennedy et al.	:	
Reexamination Proceeding	:	DECISION GRANTING
Control No. 90/006,340	:	REQUEST FOR
Filed: July 21, 2002	:	REEXAMINATION
For: U.S. Patent No. 5,119,382	:	
	:	

This is a decision on the petition under 37 CFR 1.515(c), filed October 30, 2002[1], requesting that the Order Denying Request for Reexamination dated September 30, 2002 be reversed and the request for reexamination of the above-identified patent be granted.

The petition is **GRANTED.**

The file record reveals that the examiner denied the request for reexamination based on the examiner's determination that 1) the teachings of the 4,796,262 patent to Michelangeli et al. are merely cumulative to those already considered during prosecution of the 5,119,382 patent, 2) the teaching that the passive Q-switch being an absorption dye-type as disclosed by the 4,796,262 patent was admitted prior art, 3) the teaching of the Stokowski et al paper is merely cumulative to those already considered during prosecution of the 5,119,382 patent and 4) the

[1]There is no indication that the petition was served to the patent owner. The petition is hereby accepted and a copy thereof is attached to this decision for the patent owner.

teaching that the tetravalent chromium doped laser active medium was taught by 4,987,575 to Alfano et al which was considered during the prosecution of the 5,119,382 patent.

The petitioner argues that the decision of the examiner improperly applied the case law of In re Portola Packaging, 110 F.3d 786 (Fed. Cir. 1997) and improperly interpreted the scope and content of the prior art references. Petitioner further argues that In re Portola Packaging does not bar a printed publication from being considered and applied in reexamination because it is substantially cumulative to that which has already been considered by the examiner.

MPEP §2243, Criteria for Deciding Request and (5) Application of Portola Packaging to Unusual Fact Patterns recognizes that unusual fact patterns will occur and gives the following example involving cumulative references.

> To the extent that a cumulative reference is repetitive of a prior art reference that was previously applied or discussed, Portola Packaging may prohibit reexamination of the patent claims based only on the repetitive reference. For purposes of reexamination, a cumulative reference that is repetitive is one that substantially reiterates verbatim the teachings of a reference that was either previously relied upon or discussed in a prior Office proceeding even though the title or the citation of the reference may be different. However, it is expected that a repetitive reference which cannot be considered by the Office during reexamination will be a rare occurrence since most references teach additional information or present information in a different way than other references, even though the references might address the same general subject matter.

A review of the patents applied or discussed during the prosecution of the 5,119,382 patent was made. Patent No. 4,987,575 to Alfano is directed to tetravalent chromium as a laser-active ion for turntable solid-state lasers. Patent No. 4,723,248 to Harter et al is directed to an optical limiter comprising Cr-dopant ions. To be cumulative, the prior art cited by the petitioner must substantially reiterate verbatim the teachings of either the Alfano or the Harter et al patents.

Patent No. 4,976,262 to Michelangeli et al do not substantially reiterate verbatim the teachings of either Alfano or Harter et al. Michelangeli et al do teach lasers, but do not teach tetravalent chromium nor Cr-dopant ion as laser-active ions. Further, Michelangeli et al teach additional information not taught by either Alfano or Harter et al.

The Stokowski et al paper does not substantially reiterate verbatim the teachings of either Alfano or Harter et al. The Stokowski et al paper teaches tetravalent chromium ion as laser-active ions, however, it also teaches the efficiencies obtained when the size and the weight of the material is optimized. This teaching provides additional information not taught by either Alfano or Harter et al.

The prior art references of Patent No. 4,976,262 to Michelangeli et al and the Stokowski et al paper cited by the petitioner are not cumulative. The references do not substantially reiterate verbatim the teachings of a reference that was either previously relied upon or discussed in a prior Office proceeding even though the title or the citation of the reference may be different. Further, the examiner improperly interpreted the scope and content of the references by not recognizing that the references teach additional information.

Based upon a *de novo* review of the request for reexamination, it is determined that a substantial new question of patentability affecting claims 1, 2 or 18 of Patent No. 5,119,382 to Kennedy et al is raised.

The consideration of Michelangeli et al and Stokowski et al raises a substantial new question of patentability as to the claims of the Kennedy et al patent. The teaching of Stokowski et al that suggest possibly using tetravalent chromium center as a passive Q-switch was not present during the prosecution of the application that became the Kennedy et al patent.

For the above reasons, reexamination of claims 1-29 of U.S. Patent No. 5,119,382 to Kennedy et al is hereby ordered.

This decision is final and nonappealable. 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

The patent owner has the option to file a Patent Owner's Statement within 2 (two) months from the mailing date of this decision pursuant to 37 CFR § 1.530(b). Extensions of time are governed by 37 CFR § 1.550(c).

If a Patent Owner's Statement under 37 CFR § 1.530(b) is submitted, the requester/petitioner has the option of filing a Requester's Reply within 2 (two) months from the date of service of the Patent Owner's Statement pursuant to 37 CFR § 1.535. No extension of time is permitted for filing a Requester's Reply. Without a Patent Owner's Statement, a reply by the requester/petitioner is permitted.

James L. Dwyer, Director
Technology Center 2800
Semiconductor, Electrical and Optical
Systems and Components

Enclosure: copy of the petition for the patent owner

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,340	07/31/2002	5119382	2500.507	7350

20995 7590 06/15/2005

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/15/2005

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Knobbe Martens Olson & Bear LLP (Patent Owner)
2040 Main Street
Fourteenth Floor
Irvine CA 92614

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JUN 15 2005
REEXAM UNIT

Enclosure: Copy of Requester petition filed April 2, 2005

Matthew A. Pequignot (For Third Party Requester)
Hall, Myers, Vande Sande,
and Pequignot, LLP
10220 River Road, Suite 200
Potomac, Maryland 20854

Enclosure: Requester petition filed April 2, 2005

Kennedy et al.	
Reexamination Proceeding	DECISION
Control No. 90/006,340	RETURNING
Filed: July 21, 2002	PETITION
For: U.S. Patent No. 5,119,382	

This is a decision on the April 29, 2005 requester petition under 37 CFR 1.183, titled "PROTEST/PETITION PURSUANT TO 37 C.F.R. 1.183."

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

The fee set forth in 37 CFR 1.17(f) for a 37 CFR 1.183 petition is $400. The $400 fee is being charged to petitioner's Deposit Account 50-1465 pursuant to the authorization for same in the last paragraph of the petition.

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:

> "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 citation under 37 CFR 1.501.

Accordingly, the present petition does not have an entry right under the rules.

It is requested, however, that the rules be waived pursuant to 37 CFR 1.183 to permit entry and consideration of the petition.

At page 1 of the petition, it is stated:

> "Although it is acknowledged that a third-party, *ex parte* Reexamination Requester does not have an explicit right to file a reply to a patentee's response to an Office Action, certain **extenuating circumstances are believed to exist in this case which are believed to warrant special consideration.** Specifically, it is submitted that patentee's characterization of the prior art as well as the proposed interpretation of the relevant claim language is so conspicuously flawed as to merit third pmy attention. Moreover, in view of the substantial **public interest** in preventing the issuance of invalid patents, **a suspension of the relevant rules and entry and consideration of this paper is respectfully requested.**" [Emphasis Added]"

This request for waiver of the rules will now be addressed.

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 and merits of the reexamination proceeding. *In re Amp*, 212 USPQ 826 (Comr. Pats. 1981). The statute and its intent are clear that the examination and prosecution in a reexamination proceeding requested under 35 U.S.C. 302 must be *ex parte*. In the present instance, the third party requester has filed a "a reply to a patentee's response to an Office Action" (as stated in the second paragraph of the petition) which discusses the prior art, at pages 1-3 of the petition. The discussion addresses the combination of the art, as well as interpretation of the scope of the claims. Such is directed to the merits of the reexamination proceeding, and addressing the issues raised would be contrary to the intent and content of the *ex parte* reexamination statute.

The proffered comments by the third party requester 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 37 CFR §§ 1.530 and 1.535). The waiver/suspension of the rules requested in the present instance to permit the third party submission via the petition would not be justified in view of the legislation and implementing rules which 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, 1868-1869 (Fed. Cir. 1989) (third parties do not participate before the USPTO). In *Syntex*, the Court said (paragraph bridging pages 1868 & 1869):

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

37 CFR 1.183 provides for waiver of a "requirement of the regulations... which is not a requirement of the statutes." In the present instance, the waiver requested would contravene the intent and content of the statute. Thus, the petition under 37 CFR 1.183 cannot be granted.

Based on the above, the third party requester petition of April 2, 2005, is an improper submission under 37 CFR 1.550(g), and it is being returned to the third party requester. Any copy of the petition papers appearing in the electronic Image File Wrapper for the present reexamination proceeding will be closed by the Central Reeaxamination Unit. A copy of this decision will be placed in the file.

LACK OF SERVICE

At the first page of the petition, it is stated as to the petition:

> "A copy is being served on patentee's counsel pursuant to 37 C.F.R. 1.550(f)." [The text is in bold underline in the petition.]

The requisite proof of service (of the petition) by third party requester on the patent owner, however, 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]

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 to be present.

Accordingly, a copy of the petition is being forwarded to the patent owner. Any future communications filed by the third party requester in the present proceeding must appropriately include proof of service on the patent owner.

CONCLUSION

1. The third party requester petition filed April 2, 2005, is dismissed and is being returned to the third party requester.

2. Any copy of the petition papers appearing in the electronic Image File Wrapper for the present proceeding will be closed by the Central Reeaxamination Unit (CRU).

3. A copy of the petition papers is being forwarded, with the instant decision, to the patent owner.

4. A copy of this decision will be made of record in the reexamination file.

5. The reexamination proceeding is being forwarded to the CRU for processing, after which it will be returned to Technology Center 2800.

6. Telephone inquiries related to the present decision should be directed to the undersigned, at 571-272-7710.

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

June 15, 2005
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UNITED STATES PATENT AND TRADEMARK OFFICE

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#9

Madson & Metcalf
15 West South Temple
Suite 900
Salt Lake City, UT 84101

(Patent Owner)

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REEXAM UNIT

MARCUS P. DOLCE
PRICE, HENEVELD, COOPER, DEWITT &
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695 KENMOOR, S.E.
POST OFFICE BOX 2567
GRAND RAPIDS, MI 49501

(Requester)

(Enclosure: Copy of Order Denying Request for Reexamination mailed October 3, 2002.

In re Baker Reexamination Proceeding Control No. 90/006,341 Filed: July 30, 2002 For: U.S. Patent No. D448,058	DECISION DISMISSING IN PART AND GRANTING IN PART PETITION

This is a decision on the December 17, 2002, third party requester petition under 37 CFR 1.181, requesting (1) that the Order denying the request for reexamination mailed October 3, 2002 ("the Order") be remailed, and (2) that the one month time period to seek (pursuant to 37 CFR 1.515(c)) review of the Order be restarted, due to failure to receive the Order by the third party requester.

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 as to the request for "remailing," but is granted as to extending the time within which requester may seek review by a petition under CFR 1.181 pursuant to 37 CFR 1.515(c).

REVIEW OF FACTS

1. U.S. Patent No. D448,058 issued on September 18, 2001.

2. On July 30, 2002, a request for reexamination of the '058 patent was filed by the third party requester, and it was assigned Control No. 90/006,341.

3. An Order Denying the Request for Reexamination was mailed on October 3, 2002.

4. On November 18, 2002, a telephone call was made by James Gandy, Design Patent Practice Specialist, to Mr. Dolce, attorney for third party requester, in order to determine whether a petition seeking review of the Order had been filed. Mr. Dolce stated that he never received the Order mailed October 3, 2002, which denied the request for reexamination.

5. An *ex parte* reexamination interview summary form was mailed November 18, 2002, indicating that a petition under 37 CFR 1.181 must be filed in order to preserve requester's right to petition under 37 CFR 1.515(c).

6. On December 17, 2002, the third party requester filed the present petition under 37 CFR 1.181, requesting (1) that the Order Denying the Request for Reexamination be remailed, and (2) that the one month time period to seek review of the Order be restarted, due to failure to receive the Order by third party requester.

DECISION

I. 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 has submitted both items, the above requirements are considered satisfied. The Order cannot, however, be "remailed" because re-issuance of the Order would violate the statutory requirement that "[w]ithin three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications." 35 U.S.C. 303. The instant request was filed July 30, 2002, and the "three month" statutory period expired after October 30, 2002. Any remailed Order would thus be mailed after "three months following the filing of a request for reexamination" and be in violation of the statute. Alternative relief is, however, provided to requester as follows:

(1) A copy of the Order mailed on October 3, 2002, is being supplied to requester with this decision.

(2) The one month period for the filing of a timely petition under CFR 1.181 (pursuant to 37 CFR 1.515(c)) seeking review of the examiner's determination refusing *ex parte* reexamination is hereby extended to run *one month from the date of mailing of the instant decision.*

Accordingly the petition is granted-in-part to the extent that requester's period for seeking review of the Order runs one month from the instant decision, and requester has now been provided with a copy of the Order.

II. In the present petition, it is urged that the Order denying reexamination should be withdrawn in view of the recent amendment to 35 U.S.C. 303(a). On November 2, 2002, the "Patent and Trademark Office Authorization Act of 2002" was enacted and revised the reexamination statute by adding the following new last sentence to 35 U.S.C. 303(a) and 312(a):

> "The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office." [1]

---

[1] See the 21st Century Department of Justice Appropriations Authorization Act, TITLE III- INTELLECTUAL PROPERTY, Subtitle A - Patent and Trademark Office, Section 13105, part (a), of the "Patent and Trademark Office Authorization Act of 2002" - Enacted as part of Public Law 107-273 on November 2, 2002.

The effective date of this provision is stated in the Act as follows:

> "The amendments made by this section shall apply with respect to **any determination** of the Director of the United States Patent and Trademark Office that is made under section 303(a) or 312(a) of title 35, United States Code, **on or after the date of enactment** of this Act." [2] [Emphasis added in bold]

Petitioner urges that the November 2, 2002, revision of the statute "would be effective during the date of the remailing of the Order Denying Request for Reexamination. Accordingly, if the Order Denying Request for Reexamination was denied based on *In re Portola Packaging Inc.*,[3] the Order Denying Request for Reexamination would be a determination by the Director and subject to the amendment to §303(a) and should be with drawn."

As pointed out by petitioner, a patent and/or printed publication previously cited by or to the Office, or considered by the Office, is available, as a sole basis for reexamination, in a reexamination proceeding for which **the determination** of the Director granting reexamination is made on or after the date of enactment, i.e., November 2, 2002. This is so, even if a reexamination proceeding is already pending as of the date of enactment, as long as the Order granting reexamination issues on or after November 2, 2002.

Further, in the Order Denying Request for Reexamination mailed October 3, 2002, it is stated that "This reexamination request is denied based on *In re Portola Packaging, Inc., supra*. No patentability determination has been made in this reexamination proceeding."

The Order Denying Request for Reexamination mailed October 3, 2002, is not, however, being "remailed" (i.e., not being re-issued) for the reasons pointed out above. Nevertheless, a petition under 37 CFR 1.515(c) seeking review of the examiner's determination refusing reexamination could be timely filed by the requester. If such a petition is filed, the petition would be

---

[2] See part (b) of Section 13105 of the Act.

[3] *See In re Portola Packaging Inc.*, 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997).

decided by the Technology Center Group Director based on a *de novo* review of the case pursuant to MPEP 2248, and it would be a decision of whether to grant or deny reexamination. Thus, the Group Director's decision would be a determination made under section 35 U.S.C. 303(a) **on or after the date of enactment** of the "Patent and Trademark Office Authorization Act of 2002." As such, the "the amendment to §303(a)" would be effective as to the decision, and the statement made in the October 3, 2002, Order that the reexamination request is barred by *In re Portola Packaging, Inc.*, would no longer apply.

This issue must, however, be placed before the Office by way of a timely petition under 37 CFR 1.181 filed pursuant to 37 CFR 1.515(c), and a one month period to do so is being provided by the instant decision for that purpose. It is to be noted that any such petition under CFR 1.181 which is filed **must establish** that the art stated in the October 3, 2002, Order to have been barred by *In re Portola Packaging, Inc.* provides a "new" question (i.e., a substantial new question of patentability), such as where at least one of the following fact situations exist:

A) **Different Claimed Subject Matter:** The current claimed subject matter is different than the claimed subject matter that the old art was applied against.

B) **Different Statutory Basis:** The old art is being applied under a different statutory basis (for the rejection) than was employed in the earlier concluded examination(s) of the patent.

C) **Statutory Basis Does Not Change, But Different Art Combination:** The old art is still being applied in an "obviousness" rejection (35 U.S.C. 103 or obvious type double patenting), but in a different combination of the art (for the rejection) than was employed in the earlier concluded examination(s) of the patent.

D) **Same Art, But Art Viewed in New Light:** The old art is being presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request. In this regard, see *Ex parte Chicago Rawhide,* 223 USPQ 351 (Bd. Pat. App. & Inter., 1984)

CONCLUSION

1. The petition is dismissed as to the request for "remailing," and is granted as to extending the time within which requester may seek review by a petition under 37 CFR 1.181 pursuant to 37 CFR 1.515(c).

2. The period for filing a petition under CFR 1.181 (pursuant to 37 CFR 1.515(c)) seeking review of the examiner's October 3, 2002, determination is extended to run **one month from the date of mailing of the instant decision.**

3. The reexamination file is being returned to Technology Center 2900 for storage, to await further action by requester, or the expiration of the time for taking such action.

4. 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

C:\KIVA\KENPET4\6341por.WPD
2-13-03

UNITED STATES PATENT AND TRADEMARK OFFICE

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WASHINGTON, D.C. 20231
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MAY 7 2003

Paper No. 11

Madson & Metcalf
Gateway Tower West
Suite 900
15 West South Temple
Salt Lake City, UT 84101

(Patent Owner)

MARCUS P. DOLCE
PRICE, HENEVELD, COOPER, DEWITT &
LITTON
695 KENMOOR, S.E.
POST OFFICE BOX 2567
GRAND RAPIDS, MI 49501

(Requester)

(Enclosure: Form PTO-892 NOTICE OF REFERENCES CITED and copies of references)

In re Baker	:
Reexamination Proceeding	: DECISION GRANTING PETITION
Control No. 90/006,341	: UNDER 37 CFR 1.181
Filed: July 30, 2002	:
For: U.S. Patent No. D448,058	:

This is a decision on the March 13, 2003, third party requester petition under 37 CFR 1.181, requesting review of the order denying request for reexamination pursuant to 37 CFR 1.515(c).

The petition is **GRANTED**.

A review of the file shows that an Order Denying the Request for Reexamination was mailed on October 3, 2002. On November 18, 2002, a telephone call was made to Mr. Dolce, attorney for third party requester, to determine whether a petition seeking review of the Order had been filed. Mr. Dolce stated that he never received the Order mailed October 3, 2002. An ex parte reexamination interview summary form was mailed November 18, 2002, indicating that a petition under 37 CFR

1.181 must be filed in order to preserve requester's right to petition under 37 CFR 1.515(c). On December 17, 2002, the third party requester filed a petition under 37 CFR 1.181, requesting that the Order Denying the Request for Reexamination be remailed, and that the one month time period to seek review thereof be restarted. A decision was mailed on February 13, 2003, from the Office of Patent Legal Administration, dismissing the request for remailing the Order, but granting the request to extend the time for seeking review by way of petition under 37 CFR 1.181 pursuant to 37 CFR 1.515(c). This petition followed.

Petitioner requests reconsideration and withdrawal of the Order denying reexamination because the law cited to deny the request for reexamination no longer applies. Specifically, petitioner refers to the amendment to 35 U.S.C. 303(a), effective November 2, 2002, which added the following new last sentence thereto:

> "The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office."

In the decision mailed February 13, 2003, from the Office of Patent Legal Administration, it was stated that if a petition under 37 CFR 1.181 is filed pursuant to 37 CFR 1.515(c) the Group Director's decision would be a determination made under section 35 U.S.C. 303(a) on or after the date of enactment of the "Patent and Trademark Office Authorization Act of 2002." As such, the amendment to 35 U.S.C. 303(a) would be effective as to the decision, and the statement made in the October 3, 2002, Order that the reexamination request is barred by *In re Portola packaging, Inc.*, would no longer apply. The decision further stated that any petition filed under 37 CFR 1.181 must establish that the art stated in the October 3, 2002, Order to have been barred by *In re Portola packaging, Inc.* provides a substantial new question of patentability, such as where at least one of the following fact situations exist:

A) **Different Claimed Subject Matter:** The current claimed subject matter is different than the claimed subject matter in the earlier concluded examination of the patent that the "old art" was applied against.

B) **Different Statutory Basis:** The "old art" is being applied under a different statutory basis than was employed in the earlier concluded examination of the patent. Stated another way, the rejection that <u>would be</u> based solely on this "old art" <u>in the examination stage</u> of the reexamination proceeding would be based on a different statutory basis than the rejection(s) made in the earlier concluded examination of the patent. This category includes art that was cited in the earlier concluded examination of the patent, but was not previously applied against the claims in a rejection.

C) **Statutory Basis Does Not Change, But Different Art Combination:** The "old art" used in the order granting reexamination would be applied (during the examination stage of the proceeding) in an "obviousness" rejection (35 U.S.C. 103 or obvious type double patenting), but now in a <u>different combination</u> of the art (for the rejection) than was used in the earlier concluded examination of the patent.

D) **Same Art, But Art Viewed in New Light:** The "old art" is being presented/viewed in a <u>new light</u>, or in a different way, as compared with its use in the earlier concluded examination(s).

This new light would be provided, for example, by a material new argument or interpretation presented in the request for reexamination. In this regard, see *Ex parte Chicago Rawhide*, 223 USPQ 351 (Bd. Pat. App. & Inter., 1984).

The present petition establishes that the fact situation in "C)" above exists. Therefore, since the requirements set forth in the decision mailed February 13, 2003 have been satisfied, the petition is **granted**.

In addition to granting the present petition, new art has been cited on the attached form PTO-892 that is considered to raise a substantial new question of patentability. Specifically, the patent to Porter, 3,521,847, discloses a billiard table in Fig. 1 having an arched side panel as in the patented design D448,058. In addition, the tables 504, 511 and 584 shown in the Stickley Craftsman Furniture Catalog include arched side and end panels directly under the tabletop similar to those in the patented design. Furthermore, tables 504 and 511 also include a horizontal panel that extends through the horizontal brace that connects the legs at each end thereof as in the patented design. Also, tables 530 and 533 shown in the Stickley catalog include two pegs or stakes at the end to secure the horizontal panel that extends through the horizontal brace connecting the legs as in the patented design.

A two month time period from the mailing of this decision is set for filing a Patent Owner's Statement (Optional), pursuant to 37 CFR 1.530(b). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(C).** Upon expiration of this time period if no statement pursuant to 37 CFR 1.530(b) is filed the reexamination will be assigned to another examiner for further action.

Should there be any questions with regard to this letter please contact James Gandy, by letter addressed to the Director, Technology Center 3700/2900, P.O. Box 1450 Alexandria, VA 22313-1450, or by telephone at (703) 305-3264.

John Kittle
Director, Technology Center 3700/2900

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OCT 28 2003

Paper No. 17

Seyfarth Shaw 55 East Monroe Street Suite 4200 Chicago, IL 60603-5803 Milwaukee, WI 53202	: For Patent Owner
In re Reexamination Control No. 90/006,343 U.S. Patent No. 5,279,189 Issued: January 18, 1994 Patent Owner: Francis K. Marino Request Filed: July 30, 2002	: DECISION ON PETITION

This is a decision on the paper styled as "Petition for Withdrawal from Issue", filed by facsimile transmission on October 22, 2003. Petitioner requests that a copy of an amendment filed on July 7, 2003 be entered and considered prior to publication of the reexamination certificate, because the amendment was previously timely filed.

The petition is dismissed as moot.

The record shows that a final rejection was mailed on May 1, 2003. See paper No. 12. This proceeding was submitted for publication of the reexamination certificate based upon the record as it stood after the final rejection dated May 1, 2003, and subsequent interview summary dated May 27, 2003 which is of record as paper No. 13, because no reply to the final rejection had been received in the Office within the two month shortened statutory period set in the final rejection. Petitioner alleges that a timely reply to the final rejection was in fact filed.

While there is no formal issue procedure with respect to reexamination proceedings, the ultimate relief requested by petitioner, namely entry and consideration of a timely filed amendment that did not reach the reexamination file prior to submission of the file for publication of the reexamination certificate would typically be granted upon a showing of evidence supporting the conclusion that petitioner timely filed a reply to the outstanding Office action. However, the originally filed amendment that is the subject of the petition was recently located and associated with the reexamination file. Therefore, petitioner is entitled to consideration of that amendment, which was actually received in the Office on July 7, 2003 and has affixed thereto a 37 CFR 1.8(a) certificate of mailing dated July 1, 2003, without recourse to a petition.

Accordingly, the reply filed on July 7, 2003 has been entered in the reexamination proceeding as paper No. 18 and submitted to the examiner for consideration. The examiner has prepared an Advisory Action which will be entered as paper No. 19, and will be mailed to petitioner in due course.

PETITION DISMISSED.

E. Rollins-Cross

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

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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
90/006,344	08/01/2002	6379190		3468

26568 7590 11/22/2002

COOK, ALEX, MCFARRON, MANZO, CUMMINGS & MEHLER LTD
SUITE 2850
200 WEST ADAMS STREET
CHICAGO, IL 60606

EXAMINER
T. PATEL

ART UNIT	PAPER NUMBER

DATE MAILED: 11/22/2002 #9

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 PATENT AND TRADEMARK OFFIC
WASHINGTON, D.C 20231
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Paper No. 9

23 NOV 2002

Edward D. Manzo
Cook, Alex, McFarron, Manzo,
Cummings & Mehler, Ltd.
200 West Adams Street, Suite 2850
Chicago, IL 60606

(for patent owner)

MAILED

NOV 22 2002

OFFICE OF THE SPECIAL PROGRAMS EXAMINER

Peter T. Corbin
Gibbons, Del Deo, Dolan, Griffinger
& Vecchione
750 Lexington Avenue
New York, NY 10022

(for first requester)

John James McGlew
McGlew and Tuttle
Scarborough Station
Scarborough, NY 10510-0827

(for second requester)

In re Prazoff
Reexamination Proceeding
Control Number 90/006,327
Filed: July 17, 2002
For: U.S. Patent No. 6,379,190
Title: Ropelight Connector

DECISION MERGING
REEXAMINATION PROCEEDINGS

In re Prazoff
Reexamination Proceeding
Control Number 90/006,328
Filed: July 18, 2002
For: U.S. Patent No. 6,379,190
Title: Ropelight Connector

In re Prazoff
Reexamination Proceeding
Control Number 90/006,344
Filed: August 01, 2002
For: U.S. Patent No. 6,379,190
Title: Ropelight Connector

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. 6,379,190 issued on April 30, 2002.

2. A first request for reexamination, Reexamination Control No. 90/006,327, was filed by a first third party requester on July 17, 2002.

3. Reexamination was ordered in the '327 reexamination proceeding on September 06, 2002.

4. A second request for reexamination, Reexamination Control No. 90/006,328, was filed by the patent owner on July 18, 2002.

5. Reexamination was ordered in the '328 reexamination proceeding on September 06, 2002.

6. A third request for reexamination, Reexamination Control No. 90/006,344, was filed by a second third party requester on August 01, 2002.

7. Reexamination was ordered in the '344 reexamination proceeding on September 06, 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* 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. <u>Merger of Proceedings</u>.

In accordance with 37 C.F.R. § 1.565(c), the '327, '328 and '344 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 all 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 files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in triplicate, each bearing an original signature, for entry in each file. All papers filed by the patent owner must be served on the requesters and requesters will be sent copies of all papers mailed by the Office.

CONCLUSION

Reexamination Control Nos. 90/006,327, 90/006,328 and 90/006,344 are merged. The reexamination files are being forwarded to the examiner for issuing a first Office action.

Richard K. Seidel, 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.
90/006,350; 90/006,083	08/08/2002	6126697	11392.0201	6638

7590 01/14/2003

James F. Harvey, III
Harvey & Associates, P. C.
3750 West Main Street, Suite 130
Norman, OK 73032-4645

EXAMINER

ART UNIT	PAPER NUMBER
	8

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
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. 8

James F. Harvey, III Harvey & Associates, P.C. 3750 West Main Street, Suite 130 Norman, OK 73032-4645	(for Patent Owner)
M. Wayne Western Thorpe, North & Western, LLP 8180 South 700 East, Suite 200 Sandy, Utah 84070	(for Third Party)
Michael W. Starkweather Jones, Waldo, Holbrook & McDonough 170 South Main Street, Suite 1500 Salt Lake City, Utah 84101	(for Third Party)
In re Ebberts Reexamination Proceeding Control No. 90/006,083 Filed: August 14, 2001 For: U.S. Patent 6,126,697	**DECISION MERGING REEXAMINATION PROCEEDINGS**
In re Ebberts Reexamination Proceeding Control No. 90/006,350 Filed: August 8, 2002 For: U.S. Patent 6,126,697	

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 6,126,697, issued October 3, 2002, is the subject of Reexamination Control Nos. 90/006,083 and 90/006,350.

2. A first request for reexamination, assigned Reexamination Control No. 90/006,083 ('083) was filed August 14, 2001 by M. Wayne Western of Thorpe, North & Western, LLP. The request urged that a substantial new question of patentability was raised by the teachings of (a) U.S. patent 5,718,729 to Harris, in view of Bolkan, "New Technologies: Carbonate/bicarbonate-based systems provide numerous applications across surface substrate and soil type," Precision Cleaning Magazine, January/February, 1996; or (b) U.S. patent 5,718,729 to Harris and U.S. patent 5,244,468 to Harris et al, in view of Bolkan, "New Technologies: Carbonate/bicarbonate-based systems provide numerous applications across surface substrate and soil type," Precision Cleaning Magazine, January/February, 1996.

3. The request for reexamination was denied for '083 on October 31, 2001.

4. A Petition Under 37 C.F.R. 1.181 Seeking Review of Order Denying Request for *Ex Parte* Reexamination was received on December 11, 2001 (certificate of mailing November 30, 2001).

5. The Petition Under 37 C.F.R. 1.181 Seeking Review of Order Denying Request for *Ex Parte* Reexamination was granted on March 11, 2002. In this decision, it was set forth that reexamination was ordered for '083.

6. A second request for reexamination, assigned Reexamination Control No. 90/006,350 ('350), was filed August 8, 2002 by Michael W. Starkweather of Jones, Waldo, Holbrook & McDonough. The request urged that a substantial new question of patentability was raised by the teachings of U.S. patent 5,718,729 to Harris and U.S. patent 5,244,468 to Harris et al, in view of WO 98/46716 to Spadoni et al.

7. Reexamination was ordered for '350 on October 9, 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 90/006,083 and 90/006,350 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 files shall be forwarded to the examiner for preparation of an Office action.

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 <u>both</u> 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 <u>both</u> 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. 90/006,083 and 90/006,350 as:

James F. Harvey, III
Harvey & Associates, P.C.
3750 West Main Street, Suite 130
Norman, OK 73032-4645

CONCLUSION

Reexamination Control Nos. 90/006,083 and 90/006,350 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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,351	08/09/2002	5671364	01929-P0014A	4209

7590 04/18/2008

Stephen E. McNamara
St. Onge Steward Johnston & Reens LLC
986 Bedford Street
Stamford, CT 06905

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/18/2008

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
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Alexandria, VA 22313-1450
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Stephen P. McNamara ST. ONGE STEWARD JOHNSTON & REENS LLC 986 Bedford Street Stamford, CT 06905-5619	: : : : :	(For Patent Owner)
In re Turk *Ex Parte* Reexamination Proceeding Control No. 90/006,351 Filed: August 9, 2002 For: U.S. Patent No. 5,671,364	: : : : :	DECISION ON PETITION UNDER 37 CFR 1.181

The paper filed by requester on March 25, 2008 entitled "Petition under 37 CFR 1.181 Requesting Entry of Amendment Filed January 9, 2008" (hereinafter the Petition) is before the Director of the Central Reexamination Unit (CRU). Petitioner, the patent owner, seeks review of the *Ex Parte* Reexamination Advisory Action mailed January 18, 2008 denying entry of the amendment to the claims filed January 9, 2008.

The Petition is **DENIED**.

PARTIAL REVIEW OF FACTS[1]

1. A decision reversing the rejections of the examiner was rendered by the Board of Patent Appeals and Interferences in *Ex Parte* Reexamination Control No. 90/006,351 on December 27, 2006.

2. A non-final Office action was mailed on April 24, 2007.

3. A response to the non-final Office action was filed on June 28, 2007.

4. The June 28th response extensively amended the pending claims.

5. A final Office action was mailed on September 18, 2007.

6. An interview with the examiner in charge of the application, her supervisor, another examiner in the Central Reexamination Unit (CRU), the inventor and his counsel was held on December 7, 2007. No agreement was reached at this interview.

7. A response after final Office action was filed on January 9, 2008.

8. An advisory action, denying entry of the after final response was mailed on January 18, 2008.

9. The instant petition under 37 CFR 1.181 was filed on March 25, 2008.

Petitioner's Grounds in Support of the Requested Relief

Petitioner alleges that the September 18, 2007 Office action was prematurely made final because it contained a new grounds of rejection.

[1] Given the extensive prosecution in this case and the fact that prosecution prior to the decision by the Patent Board of Appeals and Interferences is not germane to the facts at issue, a partial review of the facts is presented starting with that decision.

DECISION

I. Standard of Review

37 CFR 1.181 provides for the filing of a petition to review the taking of any action by the examiner during *ex parte* reexamination. The CRU Director's review on petition is *de novo*. Therefore, the review will determine whether the examiner's refusal to enter the amendment filed January 9, 2008, was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of entry of the amendment.

II. The Legal Standard for Making a Rejection Final

MPEP 2271 states in relevant part:

> It is intended that the second Office action in the reexamination proceeding following the decision ordering reexamination will be made final in accordance with the guidelines set forth in MPEP § 706.07(a). The examiner should not prematurely cut off the prosecution with a patent owner who is seeking to define the invention in claims that will offer the patent protection to which the patent owner is entitled. However, both the patent owner and the examiner should recognize that a reexamination proceeding may result in the final cancellation of claims from the patent and that the patent owner does not have the right to renew or continue the proceedings by refiling under 37 CFR 1.53(b) or 1.53(d) or former 37 CFR 1.60 or 1.62, nor by filing a request for continued examination under 37 CFR 1.114. Complete and thorough actions by the examiner coupled with complete responses by the patent owner, including early presentation of evidence under 37 CFR 1.131 or 1.132, will go far in avoiding such problems and reaching a desirable early termination of the reexamination prosecution.
>
> In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed and any grounds or rejection relied on should be reiterated. The grounds of rejection must (in the final rejection) be clearly developed to such an extent that the patent owner may readily judge the advisability of an appeal. However, where a single previous Office action contains a complete statement of a ground of rejection, the final rejection may refer to such a statement and also should include a rebuttal of any arguments raised in the patent owner's response.

III. The Legal Standard for Denial of An Amendment Filed After Proper Final Office Action

MPEP 2272 states in relevant part:

> It is intended that prosecution before the examiner in a reexamination proceeding will be concluded with the final action. Once a final rejection that is not premature has been entered in a reexamination proceeding, the patent owner no longer has any right to unrestricted further prosecution. Consideration of amendments submitted after final rejection >and prior to, or with, the appeal< will be governed by the strict standards of 37 CFR 1.116. >Further, consideration of amendments submitted after appeal will be governed by the strict standards of 37 CFR 41.33.< Both the examiner and the patent owner should recognize that substantial patent rights will be at issue with no opportunity for the patent owner to refile under 37 CFR 1.53(b), >or< 1.53(d), ** and with no opportunity to file a request for continued examination under 37 CFR 1.114. Accordingly, both the examiner and the patent owner should identify and develop all issues prior to the final Office action, including the presentation of evidence under 37 CFR 1.131 and 1.132.

IV. Analysis of the Request for Entry of the Amendment Filed January 9, 2008:

In accordance with MPEP 2272 and 37 CFR 1.116, a proper final Office action closes prosecution in a reexamination proceeding and the patent owner no longer has any right to unrestricted prosecution (e.g. the entry of an amendment). Thus, in order to resolve the question of whether or not the examiner properly denied entry of the amendment filed January 9, 2008, the question of whether or not the Office action mailed September 18, 2007, was properly made final must first be answered.

Turning to the finality of the Office action mailed September 18, 2007: review of the prosecution history indicates that the primary reference in the September final Office action was the same reference as that used as the primary reference in the non-final Office action of April 24, 2007. Moreover, the additional references included in the September final Office action were included in response to patent owner's challenge of the examiner's taking of Official Notice in the April non-final Office action. In addition, the issues in the reexamination were fully developed via the extensive prosecution in the instant reexamination, as well as by these two Office actions[2]. Accordingly, the Office action of September 18, 2007 was properly made final.

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[2] It is further noted that a panel of examiners in the CRU, including a supervisory patent examiner

Given that the Office action of September 18, 2007 was properly made final, the question of whether or not the examiner improperly denied entry of the amendment filed January 9, 2008 can now be considered.

MPEP 2272 requires that 37 CFR 1.116 (which governs the entry of amendments after final Office action) be strictly applied. 37 CFR 1.116 states in relevant part:

> (b)After a final rejection or other final action (§ 1.113) in an application or in an *ex parte* reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):
>
> (1)An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;
>
> (2)An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or
>
> (3)An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

The amendment filed January 9, 2008 does not meet any of the criteria set forth in 37 CFR 1.116. The amendment does not merely cancel rejected claims or comply with formal requirements. It does not present the claims in better form for appeal. And, good and sufficient reasons were not presented to establish that the amendment why the amendment was not earlier presented.

CONCLUSION

Accordingly, given the facts outlined above, the examiner's denial of entry of the amendment filed January 8, 2008 was proper. The PETITION is **DENIED**.

Telephone inquiries related to this decision should be directed to Lynne Browne, Acting Supervisory Patent Examiner, at (571) 272-3670, or in her absence to the undersigned at (571) 272-1596.

Lissi Mojica Marquis, Director
Central Reexamination Unit

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considered the issue of finality at the time the Office action was drafted and concluded that the Office action could properly be made final.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte GM Network Limited

Appeal 2008-006317
Reexamination Control 90/006,351
Patent 5,671,364
Technology Center 3900

Decided: November 16, 2009

DECISION ON PETITION

This is a decision on the "Petition for Time Extension to File a Request for Rehearing and/or a Notice of Appeal (37 CFR § 1.550(c) and 37 CFR § 1.304)" (Petition), filed October 26, 2009. The Petition seeks "an extension of time for a total period of three (3) months to file a Request for Rehearing and/or a Notice of Appeal."

FINDINGS of FACT

1. In this proceeding, on September 17, 2009, a panel of the Board of Patent Appeals and Interferences (Board) issued a Decision on Appeal affirming the Examiner's rejection of claims 1-12 under § 103.

2. The reason given for seeking an extension of time to file a request for rehearing is "to allow time for the Appellant and Patent Owner . . . to review the Decision on Appeal . . . at it's regularly scheduled January 20, 2010 Board of Directors meeting."

3. The Board has authority to grant or deny petitions for an extension of time to file a request for rehearing. However, the Board has no authority to grant or deny petitions for an extension of time to file a Notice of Appeal under 37 C.F.R. § 1.304(a). The latter petitions should be addressed to the Office of the Solicitor.

4. With respect to extensions of time on matters under the jurisdiction of the Board, 37 C.F.R. § 41.4(a) provides that "Extensions of time will be granted only on a showing of good cause."

DISCUSSION

Patent Owner has not presented a sufficient showing of good cause for granting an extension of time to file a request for rehearing.

DECISION

Accordingly, the Petition is denied with respect to an extension of time to file a request for rehearing.

Michael R. Fleming
Chief Administrative Patent Judge

Attorney for Patent Owner

Stephen P. McNamara
St. Onge Steward Johnston & Reens LLC
986 Bedford Street
Stamford, CT 06905-5619

Tel.: 203-324-6155

UNITED STATES PATENT AND TRADEMARK OFFICE

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OFFICE OF THE DIRECTOR
TC 3600

Stephen P. McNamara
St. Onge, Steward, Johnston & Reems LLC
986 Bedford Street
Stamford, CT 06905

In re Reexamination Proceeding No. 90/006,352
Filed: August 9, 2002
For: U.S. Patent No. 5,983,207

PETITION FOR ACCEPTACE OF LATE PAPERS AND REQUEST FOR EXTENSION OF TIME

This is in response to Patent Owner's petition filed via facsimile transmission on March 11, 2005. These papers will be treated as a petition to accept late filed papers. Included with the petition and other papers are two requests for extensions of time to respond to the Office action dated January 20, 2004. There is no fee for this petition or for the extensions of time.

The petition is **GRANTED** and the requests for extension of time to respond to the Office action are also **GRANTED**.

A review of the reexamination file indicates that an Office action on the merits was mailed to Patent Owner's attorney on January 20, 2004. Since no response was received on or before March 22, 2004 (March 20th being a Saturday), a routine telephone call was made by the examiner to inquire as to whether or not a response had been filed. In response to that telephone inquiry, on March 11, 2005 Patent Owner's attorney submitted by facsimile transmission a copy of the two extension of time requests, a copy of Patent Owner's record of a personal interview conducted with the examiner, and a copy of the response to the Office action.

The first request for extension of time submitted on March 19, 2004 (USPTO Auto-Reply Facsimile Transmission date) was within the period for response to the Office action and requested an extension of one month to respond. The reason for the request was that additional time was needed for Patent Owner's attorney to complete a draft response and to confer with Patent Owner regarding the response. Due to conflicting matters, this necessary conference could not be scheduled during the period for response. Additionally, a coordinated response with Reexamination No. 90/006,351 involving the same inventor and related subject matter is desirable and such additional time would allow for this to happen. The reasons presented in this timely request are sufficient for granting an extension of time for a period of one month, making a response due on or before April 20, 2004.

The second request for extension of time submitted on April 20, 2004 (USPTO Auto-Reply Facsimile Transmission date) was within the extended time period for response and requested a further extension of ten days to allow the Patent Owner to complete the review of the draft

response. This is deemed to be a sufficient reason for granting the additional ten day extension request, making a response due on or before April 30, 2004.

On April 30, 2004, as evidenced by the copy of the date stamped post card submitted by Patent Owner, a timely response to the Office action was submitted. This response included the response to the Office action, an interview summary of a personal interview conducted on February 5, 2004, a declaration of James J. Turk, one of the inventors of the patent under reexamination, and Exhibits A-F associated with the declaration. The return post card with a USPTO date stamp of April 30, 2004 is sufficient proof of timely filing.

The reexamination file will be forwarded to the Supervisory Legal Instruments Examiner for entry of the requests for extension of time and the response to the Office action and then to the examiner for prompt consideration of Patent Owner's response.

John J. Love
Director
Technology Center 3600

JJL:rar: 3/28/05

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.
90/006,143	11/26/2001	6164444		2508

23363 7590 01/28/2003

CHRISTIE, PARKER & HALE, LLP
350 WEST COLORADO BOULEVARD
SUITE 500
PASADENA, CA 91105

EXAMINER

ART UNIT	PAPER NUMBER
	9

DATE MAILED: 01/28/2003

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
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. 9

John D. Carpenter Christie, Parker & Hale, LLP 350 W. Colorado Boulevard, Suite 500 Pasadena, CA 91105	(for Patent Owner)
Professor Chen-Yen Cheng c/o Barbara Hendley 2121 Crystal Drive, Suite 703E Arlington, VA 22202	(for Third Party)
Irah H. Donner Hale and Dorr LLP 1455 Pennsylvania Avenue, NW Washington, DC 20004	(for Third Party)
In re Bernard Reexamination Proceeding Control No. 90/006,143 Filed: November 26, 2001 For: U.S. Patent 5,164,444 In re Bernard Reexamination Proceeding Control No. 90/006,354 Filed: August 8, 2002 For: U.S. Patent 5,164,444	**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 5,164,444, issued November 17, 1992, is the subject of Reexamination Control Nos. 90/006,143 and 90/006,354. Reexamination Certificate 5,164,444 C1 issued on October 16, 2001

2. A first request for reexamination, assigned Reexamination Control No. 90/006,143 ('143) was filed November 26, 2001 by Professor Chen-Yen Cheng. The request urged that a substantial new question of patentability was raised by the teachings of Japanese patent 51-21811, in view of U.S. patent 4,725,639 to Lenney, U.S. patents 2,884,126 and RE 24,906 to Ulrich, U.S. patent 3,971,766 to Ono et al, U.S. patent 4,822,676 to Mudge and/or the printed publications of Blackley, Ceska and Feast.

3. Reexamination was ordered for '143 on February 13, 2002.

4. A second request for reexamination, assigned Reexamination Control No. 90/006,354 ('354), was filed August 8, 2002 by Irah H. Donner of Hale and Dorr, LLP. The request urged that a substantial new question of patentability was raised by the teachings of (a) U.S. patent 4,507,429 to Lenney; (b) JP 51-21811, in view of U.S. patent 3,971,766 to Ono et al; (c) JP 51-21811, in view of U.S. patent 4,822,676 to Mudge; (d) JP 51-21811, in view of U.S. patent RE 24,906 to Ulrich; (e) JP 51-21811, in view of U.S. patent RE 24,906 to Ulrich and U.S. patent 4,822,676 to Mudge; (f) U.S. patent 4,507,429 to Lenney, in view of JP 51-21811 and U.S. patent 4,822,676 to Mudge; (g) JP 51-21811, in view of U.S. patent 4,507,429 to Lenney and U.S. patent 4,822,676 to Mudge; (h) U.S. patent 4,185,050 to Lazear, in view of U.S. patent 4,507,429 to Lenney; (i) U.S. patent 4,185,050 to Lazear, in view of JP 51-21811 or JP 51-21811, in view of U.S. patent 4,185,050 to Lazear; (j) U.S. patent 3,275,589 to Alexander, in view of U.S. patent 4,822,676 to Mudge.

5. Reexamination was ordered for '354 on October 24, 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 90/006,143 and 90/006,354 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 files shall be forwarded to the examiner for preparation of an Office action.

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. 90/006,143 and 90/006,354 as:

John D. Carpenter
Christie, Parker & Hale, LLP
350 W. Colorado Boulevard, Suite 500
Pasadena, CA 91105

CONCLUSION

Reexamination Control Nos. 90/006,143 and 90/006,354 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
Director, Technology Center 1700
High Polymer Chemistry, Plastics,
Stock Materials and Compositions

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REEXAM UNIT

Thomas E. Anderson
GIFFORD, KRASS, GROH, SPRINKLE,
ANDERSON & CITKOWSKI, P.C.
280 North Old Woodward
Suite 400
Birmingham, MI 48809

(For Patent Owner)

Samuel J. Haidle
HOWARD & HOWARD ATTORNEYS, P.C.
39400 Woodward Avenue
Suite 101
Bloomfield Hills, MI 48304-5151

(For Requester)

In re Larry G. Willemsen
Reexamination Proceeding
Control No.: 90/006,356
Filed: August 14, 2002
For: U.S. Patent No.: 6,389,927

: DECISION ON PETITION
: TO CONTINUE
: *EX PARTE*
: REEXAMINATION
: PROCEEDINGS

This is a decision on the September 15, 2005 patent owner petition titled PETITION UNDER 37 C.F.R. § 1.182 accompanied by a paper entitled REQUEST FOR CONTINUED REEXAMINATION (RCR).

The petition is before the Office of Patent Legal Administration.

The fee set forth in 37 CFR 1.17(f) for a under 37 CFR 1.182 is $400, The petition fee will be charged to the petitioner's deposit account No. 07-1180 as authorized by the petitioner on p. 1 of the petition.

For the reasons set forth below, the petition is dismissed, without prejudice to patent owner's completion of the petition.

REVIEW OF FACTS

1) U.S. Patent No. 6,389,927 (the '927 patent) issued on May 21, 2002.
2) The present request for reexamination, assigned control No. 90/006,356, was filed by a third party requester on August 14, 2002.
3) Reexamination was ordered for the '6356 reexamination proceeding on October 29, 2002.
4) A patent owner's statement under 37 CFR 1.530 was received in the '6356 reexamination proceeding on December 30, 2002.
5) A requester's reply to the patent owner's statement under 37 CFR 1.535 was received on March 4, 2003.
6) A preliminary amendment was received from the patent owner on July 3, 2003.
7) A non-final Office action was mailed in the '6356 reexamination proceeding on October 13, 2004.
8) A response from the patent owner to the non-final Office action was received in the Office on December 13, 2004.
9) A notice of informal or non-responsive amendment was mailed to the patent owner on March 11, 2005.
10) A second response from the patent owner to the non-final Office action was received in the Office on April 11, 2005.
11) A final rejection was mailed on June 13, 2005.
12) A Notice of Appeal was received in the Office on August 15, 2005.
13) The present petition under 37 C.F.R. 1.182 with a request for continued reexamination was received in the Office on September 15, 2005.

DECISION

In the present petition, it is requested that the Office continue the prosecution of the instant reexamination proceeding to provide consideration of an amendment to be submitted upon approval of the petition.

In March of 2005, the Office issued a Notice titled "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."[1] Notice was provided therein that a second (or subsequent) reexamination will no longer be ordered on the basis of a "substantial new question of patentability" (SNQ) that is the same as a SNQ raised in an earlier pending reexamination. The Notice stated that:

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[1] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005

> "a patent owner will now be prevented from obtaining entry of an amendment and/or evidence not entered after final rejection in an *ex parte* reexamination proceeding by filing another request for reexamination based on the same substantial question of patentability raised/existing in the pending reexamination proceeding. In order to provide relief to the patent owner, the Office plans to propose a revision to the patent rules to provide for the filing of a request for continued reexamination (RCR) which would be similar to the request for continued examination (RCE) practice for applications. If the RCR practice is implemented, the patent owner, by filing an RCR, could obtain continued prosecution on the merits in the reexamination proceeding, including entry of an amendment and/or evidence that was denied entry after a final rejection in an ex parte reexamination proceeding or after an action closing prosecution in an inter partes reexamination proceeding.
>
> Until these new rules become effective, however, patent owners are advised to use either: (1) the petition procedure under 37 CFR 1.181 to seek review of a denial of entry of an amendment submitted after final rejection in an ex parte reexamination proceeding or after an action closing prosecution in an inter partes reexamination proceeding; or (2) the petition procedure under 37 CFR 1.182 to seek relief that is not currently provided by an existing rule, but that would be provided when a new request for continued reexamination (RCR) practice is in effect."

Accordingly, relief in the form of a continuation of the reexamination prosecution (after a final rejection) is now available via a 37 CFR 1.182 petition in appropriate circumstances.

As with a Request for Continued Examination (RCE) in an application, a RCR must be filed to further the prosecution of the reexamination proceeding, rather than to delay it. Thus, the patent owner must make a *bona fide* effort to define the issues for appeal, or the issuance of a reexamination certificate, when filing a request for continued reexamination, since this is a key factor in reducing pendency of a reexamination proceeding. Stated another way, the proposed RCR practice includes a requirement that the filing of a RCR be accompanied by a submission that provides a *bona fide* effort to advance the prosecution toward appeal, or the issuance of a reexamination certificate.

The patent owner's petition notes that an amendment that furthers the prosecution of the reexamination proceeding rather than delaying <u>will be submitted</u> in the instant proceeding. However, the filing of a RCR must actually be accompanied by the submission that provides a *bona fide* effort to advance the prosecution toward appeal, or the issuance of a reexamination certificate. In absence of the actual submission of the proposed amendment, it cannot be evaluated as to whether the amendment does in fact provide the requisite *bona fide* effort to advance the prosecution.

In view of the above, the petition must be dismissed as incomplete.

CONCLUSION

1) The petition under 37 CFR 1.182 is dismissed without prejudice to patent owner's completion of the petition.

2) In order to complete the petition, petitioner must provide a submission (e.g., the amendment referred to in the petition) that provides a *bona fide* effort to advance the prosecution of this proceeding toward appeal, or the issuance of a reexamination certificate. Such submission would be provided as part of a renewed petition under 37 CFR 1.182, and must be provided within one month from the date of this decision.

3) Any renewed petition under 37 CFR 1.182 should be directed:

By U.S. Postal Service Mail:	Mail Stop *Ex Parte* Reexam Central Reexamination Unit Patent & Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450
By FAX to:	(571) 273-9900 Central Reexamination Unit
By hand (or delivery service):	Customer Service Window Randolph Building 401 Dulany St. Alexandria, VA 22314

4) Jurisdiction over the instant reexamination proceeding is being retained by the Office of Patent Legal Administration. If no renewed petition is received within a month of the mailing date of this decision, then jurisdiction will be forwarded to the Technology Center for further handling and examination of the proceeding.

5) As pointed out above, a Notice of Appeal was received in the Office on August 15, 2005. Thus, the filing of Patent Owner's appeal brief is due by October 17, 2005. [2] The time for filing Patent Owner's appeal brief is hereby extended by one month to October 15, 2005, to permit the submission and evaluation of the proposed amendment that petitioner has referred to in the petition (or any other appropriate submission to complete the petition). No further extensions of time will be permitted for this matter.

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[2] See 37 CFR 41.37(a)(1). October 15th is a Saturday.

6) Telephone inquiries related to this decision should be directed to Anton W. Fetting, Senior Legal Advisor, at (571) 272-7717, or in his absence, to the undersigned at (571) 272-7710.

Kenneth Schor, Senior Legal Advisor
Office of Patent Legal Administration
Office of Patent Examination Policy

10-10-05
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Birmingham, MI 48809

(For Patent Owner)

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REEXAM UNIT

Samuel J. Haidle
HOWARD & HOWARD ATTORNEYS, P.C.
39400 Woodward Avenue
Suite 101
Bloomfield Hills, MI 48304-5151

(For Requester)

In re Larry G. Willemsen
Reexamination Proceeding
Control No.: 90/006,356
Filed: August 14, 2002
For: U.S. Patent No.: 6,389,927

: DECISION ON PETITION
: TO CONTINUE
: *EX PARTE*
: REEXAMINATION
: PROCEEDINGS

This is a decision on the November 14, 2005 patent owner petition titled RENEWED PETITION UNDER 37 C.F.R. § 1.182 accompanied by a paper entitled REQUEST FOR CONTINUED REEXAMINATION (RCR).

The petition is before the Office of Patent Legal Administration.

The fee set forth in 37 CFR 1.17(f) for a under 37 CFR 1.182 is $400, The petition fee will be charged to the petitioner's deposit account No. 07-1180 as authorized by the petitioner on page 1 of the renewed petition.

For the reasons set forth below, the petition is granted. Prosecution of the proceeding is reopened, and the reexamination prosecution is hereby continued to the extent set forth below.

REVIEW OF FACTS

1) U.S. Patent No. 6,389,927 (the '927 patent) issued on May 21, 2002.
2) The present request for reexamination, assigned control No. 90/006,356, was filed by a third party requester on August 14, 2002.
3) Reexamination was ordered for the '6356 reexamination proceeding on October 29, 2002.
4) A patent owner's statement under 37 CFR 1.530 was received in the '6356 reexamination proceeding on December 30, 2002.
5) A requester's reply to the patent owner's statement under 37 CFR 1.535 was received on March 4, 2003.
6) A preliminary amendment was received from the patent owner on July 3, 2003.
7) A non-final Office action was mailed in the '6356 reexamination proceeding on October 13, 2004.
8) A response from the patent owner to the non-final Office action was received in the Office on December 13, 2004.
9) A notice of informal or non-responsive amendment was mailed to the patent owner on March 11, 2005.
10) A second response from the patent owner to the non-final Office action was received in the Office on April 11, 2005.
11) A final rejection was mailed on June 13, 2005.
12) A Notice of Appeal was received in the Office on August 15, 2005.
13) A petition under 37 C.F.R. 1.182 with a request for continued reexamination was received in the Office on September 15, 2005.
14) A decision dismissing the September 15, 2005 petition without prejudice was mailed to the petitioner on October 11, 2005.
15) The present petition under 37 C.F.R. 1.182 with a request for continued reexamination and an amendment was received in the Office on November 14, 2005.

DECISION

In the present renewed petition, it is requested that the Office continue the prosecution of the instant reexamination proceeding to provide consideration of an amendment to be submitted upon approval of the petition.

In March of 2005, the Office issued a Notice titled "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."[1] Notice was provided therein that a second (or subsequent) reexamination will no longer be ordered on the basis of a "substantial new question of patentability" (SNQ) that is the same as a SNQ raised in an earlier pending reexamination. The Notice stated that:

> "a patent owner will now be prevented from obtaining entry of an amendment and/or evidence not entered after final rejection in an *ex parte* reexamination proceeding by filing another request for reexamination based on the same substantial question of patentability raised/existing in the pending reexamination proceeding. In order to provide relief to the patent owner, the Office plans to propose a revision to the patent rules to provide for the filing of a request for continued reexamination (RCR) which would be similar to the request for continued examination (RCE) practice for applications. If the RCR practice is implemented, the patent owner, by filing an RCR, could obtain continued prosecution on the merits in the reexamination proceeding, including entry of an amendment and/or evidence that was denied entry after a final rejection in an ex parte reexamination proceeding or after an action closing prosecution in an inter partes reexamination proceeding.
>
> Until these new rules become effective, however, patent owners are advised to use either: (1) the petition procedure under 37 CFR 1.181 to seek review of a denial of entry of an amendment submitted after final rejection in an ex parte reexamination proceeding or after an action closing prosecution in an inter partes reexamination proceeding; or (2) the petition procedure under 37 CFR 1.182 to seek relief that is not currently provided by an existing rule, but that would be provided when a new request for continued reexamination (RCR) practice is in effect."

Accordingly, relief in the form of a continuation of the reexamination prosecution (after a final rejection) is now available via a 37 CFR 1.182 petition in appropriate circumstances.

As with a Request for Continued Examination (RCE) in an application, a RCR must be filed to further the prosecution of the reexamination proceeding, rather than to delay it. Thus, the patent owner must make a *bona fide* effort to define the issues for appeal, or the issuance of a reexamination certificate, when filing a request for continued reexamination, since this is a key factor in reducing pendency of a reexamination proceeding. Stated another way, the proposed RCR practice includes a requirement that the filing of a RCR be accompanied by a submission that provides a *bona fide* effort to advance the prosecution toward appeal, or the issuance of a reexamination certificate.

The patent owner's renewed petition is accompanied by an amendment that facially furthers the prosecution of the reexamination proceeding.

[1] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005

In view of the above, the petition is granted, and the prosecution in the above-noted reexamination proceeding is hereby continued. The finality of the June 13, 2005 Office action is withdrawn, and the prosecution is reopened for consideration of the amendment dated November 14, 2005. The November 14, 2005 amendment will be entered in the reexamination proceeding, and the proceeding will be forwarded to the examiner for action on the amendment. The examiner will consider the amendment and then issue an Office action treating the amendment as a response received after a first Office action.

CONCLUSION

1) The petition under 37 CFR 1.182 is granted.

2) The prosecution of the present '6356 reexamination proceeding is continued.

3) The finality of the June 13, 2005 Office action is withdrawn, and prosecution of the proceeding is reopened.

4) The amendment will be entered by the Technology Center, and then considered by the examiner. The amendment will be addressed and treated as a response received after a first Office action

5) The reexamination proceeding is being forwarded to the Technology Center for further handling and examination not inconsistent with this decision.

6) Telephone inquiries related to this decision should be directed to Anton W. Fetting, Senior Legal Advisor, at (571) 272-7717, or in his absence, to the undersigned at (571) 272-7710.

Kenneth Schor, Senior Legal Advisor
Office of Patent Legal Administration
Office of Patent Examination Policy

C:\Kiva\Kenpet6\SO\ 6356_ren_1.182_RCR_grant.doc
12-20-05

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.
90/006,356	08/14/2002	6389927	65,748-776	9360

25006 7590 09/12/2006

GIFFORD, KRASS, GROH, SPRINKLE & CITKOWSKI, P.C
PO BOX 7021
TROY, MI 48007-7021

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/12/2006

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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9/12/06

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Samuel J. Haidle

Howard & Howard Attorneys, P.C.

39400 Woodward Avenue, Suite 101

Bloomfield Hills, MI 48304-5151

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/006356

PATENT NO. 6,389,927

ART UNI 3993

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 replly 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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SEP 12 2006

CENTRAL REEXAMINATION UNIT

Gifford, Krass, Groh, Sprinkle, Anderson & Citkowski, P.C. (For Patent Owner)
PO Box 7021
Troy, MI 48007-7021

Samuel J. Haidle (For Third Party Requester)
Howard & Howard Attorneys, P.C.
39400 Woodward Avenue
Suite 101
Bloomfield Hills, MI 48304-5151

In re Reexamination Proceeding	:
Larry G. Willemsen	:
Control No. 90/006,356	: DECISION GRANTING PETITION
Filed: August 14, 2002	:
U.S. Patent No. 6,389,927	:
Attorney Docket No. KSR-10384/08	:

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on August 8, 2006, for entry of late papers based upon unintentional delay.

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

37 CFR 1.137(b) states:

> "*Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by: (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in § 1.17(m); (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section."

On August 8, inter alia, the present petition and the $1,500.00 petition fee, a Notice of Appeal and the $500.00 Notice of Appeal fee, a Change Of Correspondence Address, Certificate Of Service, a Petition Under 37 CFR 1.182, a Request For Continued Reexamination (RCR) and a Patent Owner's Statement were filed.

The Change Of Correspondence Address filed August 8, 2006, has been entered.

The present petition under 37 CFR 1.137(b) includes the requisite response (Notice of Appeal and fee - item 1), a $1,500.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3).

The petition for entry of the late papers is granted.

A separate Petition Under 37 CFR 1.182 requesting continued reexamination supported by a "Patent Owner's Statement" (a response amending claims) filed August 8, 2006, has been concurrently considered. The 37 CFR 1.182 petition has been granted in a decision mailed on even date with the present petition granting the petition to revive.

Jurisdiction over the reexamination proceeding is being returned to Technology Center Art Unit 3682.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Chong Kim, in Technology Center Art Unit 3682, who can be reached at 571-272-7108.

Telephone inquiries related to this decision should be directed to Fred A. Silverberg at 571-272-7719.

Fred A. Silverberg
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy

Conferee: Kenneth M. Schor, Senior Legal Advisor

UNITED STATES PATENT AND TRADEMARK OFFICE

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Thomas E. Anderson
Gifford, Krass, Groh, Sprinkle,
Anderson & Citkowski, PC
P.O. Box 7021
Troy, MI 48007-7021

(For Patent Owner)

MAILED

SEP 12 2006

CENTRAL REEXAMINATION UNIT

Samuel J. Haidle
Howard & Howard Attorneys, PC
39400 Woodward Avenue
Suite 101
Bloomfield Hills, MI 48304-5151

(For Third Party Requester)

In re Larry G. Willemsen
Reexamination Proceeding
Control No.: 90/006,356
Filed: August 14, 2002
For: U.S. Patent No. 6,389,927

DECISION
GRANTING
PETITION

This is a decision on patent owner's "Petition Under 37 CFR 1.182" filed on August 8, 2006. Patent owner seeks relief pursuant 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" published in the *Official Gazette* on March 1, 2005. [1]

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

The petition is granted.

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 6,389,927 (the '927 patent) issued on May 21, 2002.

2. The present request for reexamination was filed by a third party requester on August 14, 2002, was assigned control No. 90/006,356, and is hereinafter referred to as the '356 reexamination proceeding.

3. Reexamination was ordered in the '356 reexamination proceeding on October 29, 2002.

4. A patent owner's statement under 37 CFR 1.530 was received in the '356 reexamination proceeding on December 30, 2002.

[1] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005

5. A requester's reply to the patent owner's statement under 37 CR 1.534 was received on March 4, 2003.

6. A preliminary amendment was received from the patent owner on July 3, 2003.

7. A non-final Office action was mailed in the '356 reexamination proceeding on October 13, 2004.

8. A timely response from the patent owner to the non-final Office action was received in the Office on December 13, 2004.

9. A notice of informal or non-responsive amendment was mailed to the patent owner on March 11, 2005.

10. A second response from the patent owner to the non-final Office action was received in the Office on April 11, 2005.

11. A final rejection was mailed in the '356 reexamination proceeding on June 13, 2005.

12. On August 15, 2005, a Notice of Appeal was timely filed in the '356 reexamination proceeding.

13. On September 15, 2005, patent owner filed a petition under 1.182 for relief in the form of a request for continued examination (RCR) of the '356 reexamination proceeding, together with the fee therefor.

14. On October 11, 2005, a decision dismissing the September 15, 2005 petition was mailed to petitioner patent owner.

15. On November 14, 2005, patent owner filed a renewed petition under 37 CF4 1.182 with a request for RCR and an amendment.

16. On December 22, 2005, a decision granting the November 14, 2005 patent owner renewed petition was mailed to petitioner patent owner, whereby the November 14, 2005 amendment was entered and prosecution of the '356 reexamination proceeding was continued.

17. On February 8, 2006, a final rejection was mailed in the '356 reexamination proceeding directed to the record as amended by the November 14, 2005 amendment.

18. On August 8, 2006, patent owner filed the present petition under 37 CFR 1.182 for relief in the form of a request for continued examination (RCR) of the '356 reexamination proceeding, together with the petition fee, a Notice of Appeal, an amendment and a change of correspondence address.

19. On August 8, 2006, patent owner also filed a petition under 37 CFR 1.137(b) for entry of late papers based upon unintentional delay, together with the petition fee.

DECISION

A. Petition For Entry Of Late Papers

It is noted that a response to the final rejection dated February 8, 2006 was due on or before April 8, 2006. No response to the final rejection was filed prior to the filing of the present patent owner petition under 37 CFR 1.182. Therefore, as a necessary predicate to the present patent owner petition under 37 CFR 1.182, patent owner has concurrently filed a petition for entry of late papers based upon unintentional delay, and the petition fee, together with an appropriate response in the form of a notice of appeal and the appeal fee. The petition for entry of late papers has been granted, and a decision so indicating is being mailed concurrently with the mailing of the present decision on the patent owner petition under 37 CFR 1.182.

B. Petition To Continue Reexamination Proceedings

In the present patent owner petition under 37 CFR 1.182, it is requested that the Office continue the prosecution of the '356 reexamination proceeding to provide consideration of the amendment dated August 8, 2006.

In March of 2005, the Office issued a Notice titled "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." Notice was provided therein that a second (or subsequent) reexamination will no longer be ordered on the basis of a "substantial new question of patentability" (SNQ) that is the same as a SNQ raised in an earlier pending reexamination. The Notice stated that:

> "a patent owner will now be prevented from obtaining entry of an amendment and/or evidence not entered after final rejection in an ex parte reexamination proceeding by filing another request for reexamination based on the same substantial question of patentability raised/existing in the pending reexamination proceeding. In order to provide relief to the patent owner, the Office plans to propose a revision to the patent rules to provide for the filing of a request for continued reexamination (RCR) which would be similar to the request for continued examination (RCE) practice for applications. If the RCR practice is implemented, the patent owner, by filing an RCR, could obtain continued prosecution on the merits in the reexamination proceeding, including entry of an amendment and/or evidence that was denied entry after a final rejection in an ex parte reexamination proceeding or after an action closing prosecution in an inter partes reexamination proceeding.
>
> Until these new rules become effective, however, patent owners are advised to use either: (1) the petition procedure under 37 CFR 1.181 to seek review of a denial of entry of an amendment submitted after final rejection in an ex parte reexamination proceeding or after an action closing prosecution in an inter partes reexamination proceeding; or (2) the petition procedure under 37 CFR 1.182 to seek relief that is not currently provided by an existing rule, but that would be provided when a new request for continued reexamination (RCR) practice is in effect."

Accordingly, relief in the form of a continuation of the reexamination prosecution (after a final rejection) is available via a 37 CFR 1.182 petition in appropriate circumstances.

As with a Request for Continued Examination (RCE) in an application, a RCR must be filed to further the prosecution of the reexamination proceeding, rather than to delay it. Thus, the patent owner must make a *bona fide* effort to define the issues for appeal, or for the issuance of a reexamination certificate, when filing a request for continued reexamination, since this is a key

factor in reducing pendency of a reexamination proceeding. Stated another way, the RCR practice includes a requirement that the filing of a RCR be accompanied by a submission that provides a *bona fide* effort to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate.

To support the present petition, patent owner has concurrently submitted a paper styled as "Patent Owner's Statement" which is in reality an amendment addressed to the claims as finally rejected on August 8, 2006. Patent owner's amendment amends the only two independent claims present in the '356 reexamination proceeding. Patent owner believes that the amendment in response to the February 8, 2006 final Office action will further the prosecution of the reexamination proceeding rather than delay it.

Based on the present facts and circumstances, the petition is granted, and the prosecution in the above-noted reexamination proceeding is hereby continued. The finality of the February 8, 2006 Office action is withdrawn, and the prosecution is reopened for entry into the record of the amendment filed on August 8,2006. The proceeding will be forwarded to the examiner for consideration of the amended claims. The examiner will then issue an Office action treating the amendment as a response received after a first Office action. In the event that the patent owner again appeals from a new final rejection, patent owner would be required to submit a new notice of appeal. Since the fee for filing a notice of appeal has already been paid, the appeal fee would not need to be paid again; however, patent owner would be required to pay the difference between the appeal fee that has been paid and any increased fee at the time of such a second appeal. [2]

It is noted that this is the second time that Continued Reexamination relief has been granted in the present proceeding. Any further relief via a Request for Continued Reexamination is barred, absent a showing of an extraordinary situation where justice would requires such further relief, despite the statutory mandate for special dispatch in reexamination proceedings.[3]

CONCLUSION

1. The petition under 37 CFR 1.182 is granted.

2. The prosecution of the present '356 reexamination proceeding is continued.

3. The finality of the November 22, 2005 Office action is withdrawn, and prosecution of the proceeding is reopened to the extent that the response submitted with the petition under 37 CFR 1.182 will be addressed and treated as a response received after a first, non-final Office action.

---

[2] See MPEP § 1207.04

[3] Pursuant to 35 U.S.C. 305 - "All reexamination proceedings under this section... will be conducted with special dispatch within the Office."

4. The response filed with the present petition, including the Badmaev 37 CFR 1.132 declaration, will be entered by the Technology Center, and then considered by the examiner.

5. **Any further relief via a Request for Continued Reexamination is barred, absent a showing of an extraordinary situation where justice requires further such relief.**

6. A decision granting the August 8, 2006 petition to accept the delayed filing of the notice of appeal is being mailed concurrently with the present decision.

7. Jurisdiction over the present '356 reexamination proceeding is being forwarded to Technology Center Art Unit 3682 for further handling and examination not inconsistent with this decision.

8. Telephone inquiries related to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or in his absence, Kenneth Schor, Senior Legal Advisor, at (571) 272-7710.

9. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Chong Kim, in Technology Center Art Unit 3682, who can be reached at 571-272-7108.

Kenneth Schor,
Senior Legal Advisor
Office of Patent Legal Administration

sm
September 6, 2006

C:\kiva\kenpet6\RCR\ 6356 2nd RCR grnt(notice of appeal & amdt)concurrent separate 137(b) grnt.doc
September 11, 2006

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.
90/006,360	08/20/2002	5779400	2824

CUMMINGS AND LOCKWOOD
GRANITE SQUARE
700 STATE STREET
P O BOX 1960
NEW HAVEN, CT 06509-1960

EXAMINER
TSAI, H.

ART UNIT	PAPER
2183	12

DATE MAILED: 07/31/03

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

Commissioner of Patents and Trademarks

cc: JENIFER E. HAECKL
MIRICK, O'CONNELL, DEMALLE & LOUGEE, LLP
1700 WEST PARK DRIVE
WESTBOROUGH, MA 01581-3941

UNITED STATES PATENT AND TRADEMARK OFFICE

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WASHINGTON, D C. 2023
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Paper No. 12

JUL 3 1 2003

Cummings and Lockwood Granite Square 700 State Street P. O. Box 1960 New Haven, Connecticut 06509-1960	)))))	**FOR PATENT OWNER**
Jenifer E. Haeckl Mirick, O'Connell, DeMallie & Lougee, LLP 1700 West Park Drive Westborough, Massachusetts 01581-3941	))))	**FOR THIRD PARTY REQUESTOR**
In re Reexamination of: U.S. Patent No. 5,779,400 Reexamination Control No. 90/006,360 For: SMALL SHANK TOOL FOR AUTOMATIC LATHES	))))))	**DECISION ON PETITION UNDER 37 C.F.R. §1.10(e) TO ACCEPT PAPERS AS TIMELY FILED**

This is a decision on the petition filed by facsimile, July 30, 2003, under 37 C.F.R. § 1.8(b) to accept papers as timely filed and thereby prevent premature termination of this reexamination proceeding. A copy of the papers which Patent Owner seeks to have accepted was hand-delivered to the undersigned on July 30, 2003.

The petition is **GRANTED**.

BACKGROUND

An Office action setting a 2 month shortened statutory period for response was mailed on May 1, 2003. As of July 16, 2003 no response had been received. The undersigned called Patent Owner's representative to inquire as to the status and was informed that a response had been submitted on July 1, 2003.

DECISION

In support of the petition, Petitioner provides a copy of a submission[1] filed in response to the Office action of mail date May 1, 2003, showing the Express Mail mailing number thereon, with an express mailing date of July 1, 2003; a copy of the post card with a PTO stamp indicating receipt at the USPTO of the aforementioned submission on July 1, 2003[2]; a copy of the U.S. Express Mail label, number EV335596153US; a copy of the USPS Express Mail Delivery Status via the USPS Internet web site indicating delivery to the USPTO at 10:10 AM on July 2, 2003; and a statement by Eric E. Grondahl attesting on a personal knowledge basis to the deposit of the papers with the USPS.

Petitioner's submission meets the requirements of 37 C.F.R. §1.10(e) and establishes that a response was timely filed on July 1, 2003. Accordingly, the papers will be entered in the file which will then be forwarded to the Examiner for appropriate action.

Pinchus M. Laufer
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security
(703) 306-4160

[1] This paper (hand-delivered July 30, 2003) included a Response to Office Action, Declaration of Joy Whitney, with attached Exhibits A and B.

[2] The PTO stamp carries the date granted on the date in field of the Express mail label.

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Paper No. 16

Mark D. Giarratana
CUMMINGS & LOCKWOOD
Granite Square
700 State Street
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(For Patent Owner)

Jenifer E. Haeckl
MIRICK, O'CONNELL, DEMALLE & LOUGEE, LLP
1700 West Park Drive
Westborough, MA 01581-3941

(For Requester)

MAILED

SEP 2 4 2003

REEXAM UNIT

In re Fountaine
Reexamination Proceeding
Control No. 90/006,360
Filed: August 20, 2002
For: U.S. Patent No. 5,779,400

DECISION GRANTING PETITION

This is a decision on the August 20, 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 **granted** for the reasons indicated below.

DECISION

A grantable petition under 37 C.F.R. § 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed;

(2) the petition fee required by 37 C.F.R. § 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional.

Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 C.F.R. § 1.137(b) was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D).

The petition is accompanied by the petition fee. It should be noted that 37 C.F.R. § 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional. The statement contained in the present petition varies from the language required by 37 C.F.R. § 1.137(b)(3); however, the statement contained in the present petition is being construed as the statement required by 37 C.F.R. § 1.137(b)(3). Petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

The required reply to the Interview of July 1, 2003, has been received.

In view of the above, the petition for the entry of late papers is sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

The petition is **granted**.

CONCLUSION

1. The petition is **granted**.

2. The reexamination file will be forwarded to Technology Center 2100 for consideration of the response to the Interview of July 1, 2003.

3. Further inquiries with regard to this reexamination proceeding should be directed to the examiner, Henry Tsai, of Group Art Unit 2183.

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

September 17, 2003

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.
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EXAMINER
TSAI, H.

ART UNIT	PAPER
2183	12

DATE MAILED: 07/31/03

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Commissioner of Patents and Trademarks

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MIRICK, O'CONNELL, DEMALLE & LOUGEE, LLP
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WESTBOROUGH, MA 01581-3941

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 12

JUL 3 1 2003

Cummings and Lockwood Granite Square 700 State Street P. O. Box 1960 New Haven, Connecticut 06509-1960	)))))	**FOR PATENT OWNER**
Jenifer E. Haeckl Mirick, O'Connell, DeMallie & Lougee, LLP 1700 West Park Drive Westborough, Massachusetts 01581-3941	))))	**FOR THIRD PARTY REQUESTOR**
In re Reexamination of: U.S. Patent No. 5,779,400 Reexamination Control No. 90/006,360 For: SMALL SHANK TOOL FOR AUTOMATIC LATHES	))))))	**DECISION ON PETITION UNDER 37 C.F.R. §1.10(e) TO ACCEPT PAPERS AS TIMELY FILED**

This is a decision on the petition filed by facsimile, July 30, 2003, under 37 C.F.R. § 1.8(b) to accept papers as timely filed and thereby prevent premature termination of this reexamination proceeding. A copy of the papers which Patent Owner seeks to have accepted was hand-delivered to the undersigned on July 30, 2003.

The petition is **GRANTED**.

BACKGROUND

An Office action setting a 2 month shortened statutory period for response was mailed on May 1, 2003. As of July 16, 2003 no response had been received. The undersigned called Patent Owner's representative to inquire as to the status and was informed that a response had been submitted on July 1, 2003.

DECISION

In support of the petition, Petitioner provides a copy of a submission[1] filed in response to the Office action of mail date May 1, 2003, showing the Express Mail mailing number thereon, with an express mailing date of July 1, 2003; a copy of the post card with a PTO stamp indicating receipt at the USPTO of the aforementioned submission on July 1, 2003[2]; a copy of the U.S. Express Mail label, number EV335596153US; a copy of the USPS Express Mail Delivery Status via the USPS Internet web site indicating delivery to the USPTO at 10:10 AM on July 2, 2003; and a statement by Eric E. Grondahl attesting on a personal knowledge basis to the deposit of the papers with the USPS.

Petitioner's submission meets the requirements of 37 C.F.R. §1.10(e) and establishes that a response was timely filed on July 1, 2003. Accordingly, the papers will be entered in the file which will then be forwarded to the Examiner for appropriate action.

Pinchus M. Laufer
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security
(703) 306-4160

[1] This paper (hand-delivered July 30, 2003) included a Response to Office Action, Declaration of Joy Whitney, with attached Exhibits A and B.

[2] The PTO stamp carries the date granted on the date in field of the Express mail label.

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Paper No. 16

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Westborough, MA 01581-3941

(For Requester)

MAILED

SEP 2 4 2003

REEXAM UNIT

In re Fountaine
Reexamination Proceeding
Control No. 90/006,360
Filed: August 20, 2002
For: U.S. Patent No. 5,779,400

DECISION GRANTING PETITION

This is a decision on the August 20, 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 **granted** for the reasons indicated below.

DECISION

A grantable petition under 37 C.F.R. § 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed;

(2) the petition fee required by 37 C.F.R. § 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional.

Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 C.F.R. § 1.137(b) was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D).

The petition is accompanied by the petition fee. It should be noted that 37 C.F.R. § 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional. The statement contained in the present petition varies from the language required by 37 C.F.R. § 1.137(b)(3); however, the statement contained in the present petition is being construed as the statement required by 37 C.F.R. § 1.137(b)(3). Petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

The required reply to the Interview of July 1, 2003, has been received.

In view of the above, the petition for the entry of late papers is sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

The petition is **granted**.

CONCLUSION

1. The petition is **granted**.

2. The reexamination file will be forwarded to Technology Center 2100 for consideration of the response to the Interview of July 1, 2003.

3. Further inquiries with regard to this reexamination proceeding should be directed to the examiner, Henry Tsai, of Group Art Unit 2183.

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

September 17, 2003

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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,360	08/20/2002	5779400	18018-00001	2824

21832 7590 12/15/2005

MCCARTER & ENGLISH LLP
CITYPLACE I
185 ASYLUM STREET
HARTFORD, CT 06103

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/15/2005

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

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DEC 15 2005

REEXAM UNIT

McCarter & English, LLP (For Patent Owner)
City Place I
185 Asylum Street
Hartford, CT 06103

Merick, O'Connell, DeMalle & Lougee, LLP (For Third Party Requester)
1700 West Park Drive
Westborough, MA 01581-3941

In re Reexamination Proceeding	:
W. Fountaine	:
Control No. 90/006,360	: DECISION GRANTING PETITION
Filed: August 20, 2002	:
U.S. Patent No. 5,779,400	:
Attorney Docket No. 97580.00003	:

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on November 11, 2005, by facsimile transmission, for entry of late papers based upon unintentional delay.

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

37 CFR 1.137(b) states:

> "*Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by: (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in § 1.17(m); (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section."

The present petition under 37 CFR 1.137(b) includes the requisite response (item 1), an authorization to charge the $750.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3).

The petition for entry of the late papers is granted.

The $750.00 small entity petition fee has been charged to counsel's deposit account No. 50-3569.

The reexamination proceeding is being returned to Technology Center Art Unit 2181 for further examination and consideration of the Appeal Brief filed November 11, 2005, by facsimile transmission, 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, Henry Tsai, in Technology Center Art Unit 2181, who can be reached at 571-272-4176.

Telephone inquiries related to this decision should be directed to Fred A. Silverberg at 571-272-7719.

Fred A. Silverberg

Fred A. Silverberg
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy

Kenneth M. Schor

Conferee: Kenneth M. Schor

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,361	08/20/2002	6033158	18018-00001	2825

21832 7590 07/01/2003

CUMMINGS AND LOCKWOOD
GRANITE SQUARE
700 STATE STREET
P O BOX 1960
NEW HAVEN, CT 06509-1960

EXAMINER
TSAI

ART UNIT	PAPER NUMBER
2183	10

DATE MAILED: 07/01/2003

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 PATEN
UNITED STATES PATENT AND TRADEMARK OFFI
WASHINGTON, D C 2023
www uspto g

Paper No. 10

Cummings and Lockwood Granite Square 700 State Street P. O. Box 1960 New Haven, Connecticut 06509-1960	)))))	**FOR PATENT OWNER**
Jenifer E. Haeckl Mirick, O'Connell, DeMallie & Lougee, LLP 1700 West Park Drive Westborough, Massachusetts 01581-3941	))))	**FOR THIRD PARTY REQUESTOR**
In re Reexamination of: U.S. Patent No. 6,033,158 Reexamination Control No. 90/006,361 For: SMALL SHANK TOOL FOR AUTOMATIC LATHES	))))))	**DECISION ON PETITION UNDER 37 C.F.R. §1.10(e) TO ACCEPT PAPERS AS TIMELY FILED**

This is a decision on the petition filed by facsimile, July 1, 2003, under 37 C.F.R. § 1.8(b) to accept papers as timely filed and thereby prevent premature termination of this reexamination proceeding. A copy of the papers which Patent Owner seeks to have accepted was hand-delivered to the undersigned on June 30, 2003.

The petition is **GRANTED**.

BACKGROUND

An Office action setting a 2 month shortened statutory period for response was mailed on April 4, 2003. As of June 11, 2003 no response had been received. The undersigned called Patent Owner's representative to inquire as to the status and was informed that a response had been submitted on June 4, 2003.

DECISION

In support of the petition, Petitioner provides a copy of a submission[1] filed in response to the Office action of mail date April 4, 2003, showing the Express Mail mailing number thereon, with an express mailing date of June 4, 2003; a copy of the post card with a PTO stamp indicating receipt at the USPTO of the aforementioned submission on June 4, 2003[2]; a copy of the U.S. Express Mail label, number EV335595895US; a copy of the USPS Express Mail Delivery Status via the USPS Internet web site indicating delivery to the USPTO at 10;00 AM on June 6, 2003; and a statement by Eric E. Grondahl attesting on a personal knowledge basis to the deposit of the papers with the USPS.

Petitioner's submission meets the requirements of 37 C.F.R. §1.10(e) and establishes that a response was timely filed on June 4, 2003. Accordingly, the papers will be entered in the file which will then be forwarded to the Examiner for appropriate action.

Pinchus M. Laufer
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security
(703) 306-4160

[1] This paper (hand-delivered June 30, 2003) included a Response to Office Action, Declaration of Joy Whitney, with attached Exhibits A and B.

[2] The PTO stamp carries the date granted on the date in field of the Express mail label.

Mailed 7-1-03

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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#10

DO NOT USE IN PALM PRINTER
(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Jenifer E. Haeckl
Mirick, O'Connell, DeMaillie & Lougee, LLP
1700 West Park Drive
Westborough, MA 01581-3941

REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/006,361

PATENT NO. 6,033,158

ART UNIT [redacted] 2183

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).

PTOL-465 (5-00)

#20

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

JENIFER E. HAECKL
MIRICK, O'CONNEL, DEMALLIE & LOUGEE LLP
1700 WEST PARK DRIVE
WESTBOROUGH, MA 01581-3941

REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/006,361

PATENT NO. 6,033,158

ART UNIT 2183

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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,361	08/20/2002	6033158	18018-00001	2825

21832 7590 11/04/2004

MCCARTER & ENGLISH LLP
CITYPLACE I
185 ASYLUM STREET
HARTFORD, CT 06103

EXAMINER
TSAI

ART UNIT	PAPER NUMBER
2183	20

DATE MAILED: 11/04/2004

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Paper No. 20

Eric E. Grondahl McCarter & English LLP Cityplace I 185 Asylum Street Hartford, Connecticut 06103	)	**FOR PATENT OWNER**
Jenifer E. Haeckl Mirick, O'Connell, DeMallie & Lougee, LLP 1700 West Park Drive Westborough, Massachusetts 01581-3941	)	**FOR THIRD PARTY REQUESTOR**
In re Reexamination of: U.S. Patent No. 6,033,158 Reexamination Control No. 90/006,361 For: SMALL SHANK TOOL FOR AUTOMATIC LATHES	)	**DECISION ON PETITION UNDER 37 C.F.R. §1.10(e) TO ACCEPT PAPERS AS TIMELY FILED**

This is a decision on the petition filed November 3, 2004, under 37 C.F.R. § 1.10(e) to accept papers as timely filed and thereby prevent premature termination of this reexamination proceeding. A copy of the papers which Patent Owner seeks to have accepted was hand-delivered to the undersigned on November 3, 2004.

The petition is **GRANTED**.

BACKGROUND

An Office action setting a 2 month shortened statutory period for response was mailed on August 6, 2004. As of November 1, 2004 no response had been received. The undersigned called Patent Owner's representative to inquire as to the status and was informed that a response had been submitted on October 6, 2004.

DECISION

In support of the petition, Petitioner provides a copy of a submission[1] filed in response to the Office action of mail date August 6, 2004, showing the Express Mail mailing number thereon, with an express mailing date of October 6, 2004; a copy of the post card with a PTO stamp indicating receipt at the USPTO of the aforementioned submission on October 6, 2004[2]; a copy of the U.S. Express Mail label, number EV482046223US; a copy of the USPS Express Mail Delivery Status via the USPS Internet web site indicating delivery to the USPTO at 9;25 AM on October 7, 2004; and a statement by Nancy Tralongo attesting on a personal knowledge basis to the deposit of the papers with the USPS.

Petitioner's submission meets the requirements of 37 C.F.R. §1.10(e) and establishes that a response was timely filed on October 6, 2004. Accordingly, the papers will be entered in the file which will then be forwarded to the Examiner for appropriate action.

Pinchus M. Laufer

Pinchus M. Laufer
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security
(571) 272-3599

[1] This paper (hand-delivered November 3, 2004) included a Response to Office Action and a Declaration of William R. Fountaine.

[2] The PTO stamp carries the date granted on the date in field of the Express mail label.

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Russell D. Orkin
Webb Ziesenheim Logsdon Orkin & Hanson PC
700 Koppers Building
400 Seventh Avenue
Pittsburgh PA 15219-1818

(For Patent Owner)

MAILED

JUN 02 2005

REEXAM UNIT

In re Reexamination Proceeding
Calandra, Jr. et al.
Control No. 90/006,362
Filed: August 23, 2002
U.S. Patent No. RE 35,902
Attorney Docket No. 22202-021634

: DECISION GRANTING PETITION

This is a decision on the communication filed March 17, 2005, and the petition under 37 CFR 1.137(b), filed by the patent owner filed with a certificate of mailing under 37 CFR 1.8 by first class mail of October 13, 2004, 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, *inter alia*, a response (a copy of a Revised Amendment after Final Rejection), a petition fee of $685.00 (item 2) and the requisite statement (item 3). Further, a copy of a postcard receipt for papers submitted October 18, 2004, was also submitted.

A review of the record reveals that while a copy of a Revised Amendment after Final Rejection was submitted along with the present petition, has not been shown to satisfy the item (1) requirement for a response to the final Office action. Further, no revised Amendment after Final Rejection filed on or about October 13, 2004, has been located in the application file. However, in view of the copy of the postcard receipt submitted along with the present petition, the evidence

is convincing that the papers deposited on October 18, 2004, included a revised Amendment after Final Rejection containing a certificate of mailing of October 13, 2004,, which was subsequently misplaced in the USPTO.

In a telephone communication between counsel's law firm, in particular, counsel Julie Meder, Reg. No. 36,216, and Senior Legal Advisor Fred Silverberg, on May 18, 2005, counsel was informed that a Notice of Appeal and the requisite fee would be a proper reply to the final office action.

In response, on May 27, 2005, a Notice of Appeal and an authorization to charge $250.00 to counsel's deposit account for the requisite fee (item 1) were submitted by facsimile transmission.

The petition is granted.

The copy of the revised Amendment after Final Rejection submitted with the present petition will be used for examination purposes.

The $250.00 small entity notice of appeal fee will be charged to counsel's deposit account No. 23-0650 in accordance with the present Notice of Appeal filed May 27, 2005.

Thereafter, the reexamination file will be returned to Technology Center Art Unit 3673 for further prompt examination and consideration by the examiner of the amendment filed March 15, 2004, and the Revised Amendment after Final Rejection filed with a certificate of mailing of October 13, 2004, submitted 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, Michael Safavi, in Technology Center Art Unit 3673, who can be reached at 571-272-7046.

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
90/006,363	08/22/2002	6114015		2830

7590 10/14/2003

Lisa M. Caldwell
Klarquist Sparkman LLP
One World Trade Center, Suite 1600
121 S. W. Salmon Street
Portland, OR 97204

EXAMINER

ART UNIT	PAPER NUMBER
	12

DATE MAILED. 10/14/2003

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

90006363 .101403

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CST

Paper No. 12

Lisa M. Caldwell Klarquist Sparkman LLP One World Trade Center, Suite 1600 121 SW Salmon Street Portland, OR 97204	(for Patent Owner)
Martin M. Zoltick Rothwell Figg Ernst & Manbeck, PC Suite 800, 1425 K Street, NW Washington, DC 20005	(for Third Party)
In re Fillion et al Reexamination Proceeding Control No. 90/006,363 Filed: August 22, 2002 For: U.S. Patent 6,114,015 In re Fillion et al Reexamination Proceeding Control No. 90/006,662 Filed: June 10, 2003 For: U.S. Patent 6,114,015	**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 6,114,015, issued September 5, 2000, is the subject of Reexamination Control Nos. 90/006,363 and 90/006,662.

2. A first request for reexamination, assigned Reexamination Control No. 90/006,363 ('6363) was filed August 22, 2002 by Martin M. Zoltick of Rothwell, Figg, Ernst & Manbeck, PC. The request urged that a substantial new question of patentability was raised by the teachings of published Japanese patent application 05-229059 and the Printed Circuits Handbook, 4th Edition.

3. Reexamination was ordered for '6363 on October 25, 2002.

4. A first Office action for '6363 was mailed on March 4, 2003 and contained the rejection of claims 1-17 under 35 U.S.C. 102(b) as being anticipated by Japanese patent application 40229059 to Nakayama et al.

5. Patent owner responded to the first Office action on March 11, 2003.

6. A "Notice of Intent to Issue Reexamination Certificate" was mailed on July 21, 2003 confirming the patentability of claims 1-17. 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. 90/006,662 ('6662), was filed June 10, 2003 by Martin M. Zoltick of Rothwell, Figg, Ernst & Manbeck, PC. The request urged that a substantial new question of patentability was raised by the teachings of published Japanese patent application 05-229059 and the Printed Circuits Handbook, 4th Edition.

8. Reexamination was ordered for '6662 on August 8, 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 90/006,363 and 90/006,662 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 files shall be forwarded to the examiner for preparation of an Office action.

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. 90/006,363 and 90/006,662 as:

Lisa Caldwell
Klarquist Sparkman LLP
One World Trade Center, Suite 1600
121 SW Salmon Street
Portland, OR 97204

CONCLUSION

Reexamination Control Nos. 90/006,363 and 90/006,662 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
Director, Technology Center 1700
High Polymer Chemistry, Plastics,
Stock Materials and Compositions

90006363.101403

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,369	08/30/2002	08934396	Q62958	2264

23373 7590 09/16/2005

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/16/2005

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CST

Sughrue Mion, PLLC 2100 Pennsylvania Avenue, NW Suite 800 Washington, DC 20037	:	(for Patent Owner)
In re Araki et al Reexamination Proceeding Control No. 90/006,369 Filed: August 30, 2002 For: U.S. Patent 6,096,833	:	**DECISION ON PETITION** **PETITION**

This is a decision on the PETITION FOR ENTRY OF AMENDMENT filed July 22, 2005. Petitioner requests that the Amendment after final rejection submitted on June 24, 2005 be entered and considered by the examiner because this amendment puts the claims in obvious patentable condition.

Note that MPEP 2272 sets forth:

> Any second or subsequent amendment after final will be considered only to the extent that it removes issues for appeal or puts a claim in obvious patentable condition.

The amendment submitted June 24, 2005 is the second amendment after final.

In the amendment after final submitted June 24, 2005, patent owner proposed to limit independent claim 1 to a trisulfide silane content of about 44.14% or more. In patent owner's remarks, it was noted that the silane coupling agent of US patent 5,674,932 to Agostini et al has a sulfur distribution which differs from that of the amended claims in that Agostini et al disclose a sulfur distribution S2 of 55-75%, S3 of 15-35%, S4 of 2-10% and larger than S4 of less than 10%. Thus, patent owner has argued that Agostini does not disclose or suggest a trisulfide silane (S3) content of 44.14% or more as required by the present claims.

A review of US patent 5,674,932 to Agostini et al reveals that while a trisulfide silane content of 15-35% is taught, there is no teaching of a trisulfide silane content of 44.14% or more as required by the proposed amendment of claim 1. Accordingly, as the

proposed amendment submitted June 25, 2005 appears to put claim 1 in obvious patentable condition, this reexamination proceeding shall be returned to the examiner for prompt entry and consideration of the amendment of June 24, 2005.

The petition is **GRANTED**.

JMStone

Jacqueline M. Stone
Director, Technology Center 1700
High Polymer Chemistry, Plastics,
Stock Materials and Compositions

#11
DW

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OCT 26 2004

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OCT 26 2004

OFFICE OF THE DIRECTOR
TC 3600

For the Patent Owner:

Calfee, Halter & Griswold, LLP
800 Superior Avenue
Cleveland, OH 44114

In re Reexamination proceeding 90/006,374
Filed: September 3, 2002
For: APPARATUS FOR TRANSPORTING POWDER COATING MATERIAL FROM A BOX-SHAPED CONTAINER

DECISION ON PETITION FOR THE ACCEPTANCE OF LATE PAPERS

This is in reply to petitioner's communication filed May 7, 2004, which will be treated as a Petition To Accept Late Filed Papers. There is no fee required for this petition.

The petition is **DISMISSED**.

Preliminary amendments were submitted on September 3, 2002 and April 1, 2003. Both amendments were deemed Non-compliant and a notice to that effect was sent to the Patent Owner on May 7, 2003 setting a one month period for correction. No response was received at the USPTO prior to this instant petition. The petition alleges that a timely response was made by facsimile on May 15, 2003.

Any petition to accept late papers based upon a Certificate of Transmission must include the following requirements:
(1) A copy of a response bearing a signed Certificate of Transmission which includes the date of signing; and
(2) A statement attesting to the personal knowledge of transmitting the response on the date indicated on the Certificate of Transmission (see 37 CFR 1.8 and MPEP 512).

This petition includes a copy of the May 15, 2003 submission which includes a Certificate of Transmission. However, a statement under 37 CFR 1.8(b)(3) attesting to the personal knowledge of transmitting the response on the date indicated on the certificate, by the person who signed the certificate, in this case Lori Yanoff, is required.

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(b) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition to Accept Late Paper Under 37 CFR 1.81."

Steven N. Meyers, Special Program Examiner
Patent Technology Center 3600
(703) 308-3868

SM/SM: 10/23/04

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
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Banner & Witcoff, Ltd.
10 South Wacker Drive
Suite 3000
Chicago, IL 60606

(For Patent Owner) #6

MAILED

DEC 20 2002

REEXAM UNIT

Jerry Cohen
Perkins, Smith & Cohen
One Beacon Street
Boston, MA 02108

(For Third Party Requester)

Mongia et al
Reexamination Proceeding
Control No. 90/006,379
Filed: September 6, 2002
For: U.S. Patent No. 5,020,587

DECISION
DISMISSING
REQUEST

This is a decision on the September 6, 2002, third party requester's request that:

(1) The instant proceeding be consolidated with reexamination Control Number 90/006,380, and

(2) Requester be refunded one of the $2,520 reexamination fees paid for the 90/006,380 proceeding and the instant proceeding.

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

The request is dismissed for the reasons pointed out below.

REVIEW OF FACTS

1. U.S. Patent Number 5,020,587 (the '587 patent) issued June 4, 1991.

2. U.S. Patent Number 5,158,134 (the '134 patent) issued October 27, 1992, and is a continuation of the '587 patent.

3. A request for *ex parte* reexamination of **the '587 patent** was filed September 6, 2002, by a third party requester and was assigned reexamination Control No. 90/006,379 ('379). This is the present proceeding.

4. A request for *ex parte* reexamination of **the '134 patent** was also filed September 6, 2002, by the same third party requester that filed the '379 request. This request for reexamination of the '134 patent was assigned reexamination Control No.90/006,380 ('380).

5. Included within the body of each of the two requests for reexamination is a request to consolidate the two proceedings and a request for a refund of one of the $2,520 reexamination fees that were paid by requester for the two proceedings, "if a consolidation is granted."

6. An order granting reexamination was mailed in the present '379 proceeding on November 13, 2002. An order granting reexamination was mailed in the '380 proceeding on the same date. The two proceedings were then forwarded to the Office of Patent Legal Administration for decision on the requests in both proceedings that the instant proceeding be consolidated with a refund of $2,520.

DECISION

Pursuant to the second sentence of 37 CFR 1.4(c):

> "(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." [Emphasis added]

In this instance, (1) the present request for reexamination of the '587 patent and (2) the request to consolidate this

proceeding with the proceeding for the reexamination of the '134 patent *are both bodily contained within one paper.* It is to be noted that a request for reexamination is decided in the Patent Examining Technology Centers of the Office, while the request to consolidate is decided in the Office of Patent Legal Administration. Accordingly, the request to consolidate the instant proceeding with the '380 proceeding is dismissed.

Further, a refund of $2,520 was requested "if a consolidation is granted." Since the request for consolidation has not been granted, the request for a refund is moot, and is dismissed as such.

ADVISORY INFORMATION

The following information is provided to the third party requester with respect to any renewal of the request for consolidation that might be considered by the third party requester.

1. A request for consolidation of proceedings for reexamination of different patents is a situation not specifically provided for in the regulations. Accordingly, if a renewal of the request for consolidation is made, it must be submitted as a petition under 37 CFR 1.182 accompanied by the petition fee set forth in 37 CFR 1.17(h).

2. In addition, the second sentence of 37 CFR 1.540 states that "[n]o 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." Further, 37 CFR 1.550(g) points out that "[t]he 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." Accordingly, the entry of any renewal of the request for consolidation would require a waiver of the regulations. Thus, any petition filed must satisfy the requirements of 37 CFR 1.183 to show that an extraordinary situation exists, such that justice requires waiver of the regulations to enter and consider the petition.

3. Further, it is to be noted that pursuant to 35 U.S.C. 302:

> "Any person at any time may file **a request for reexamination** by the Office of any claim of **a patent**..." [Emphasis added]

Accordingly, a reexamination can be requested for only "a patent," i.e., **only one patent**. The reexamination statute **does not provide for merging/consolidating two patents into one reexamination proceeding**.

CONCLUSION

1. The request to consolidate the instant proceeding with the '380 proceeding is dismissed.

2. The requested refund of $2,520 is dismissed at moot, since the proceedings are not being consolidated.

3. The reexamination file is being forwarded to the examiner via the Group Director of Technology Center 3700, 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, Leonard R. Leo (703-308-2611), of Technology Center Art Unit 3743.

5. Telephone inquiries with regard to this decision should be directed to the undersigned at 703-308-6710.

Kenneth M. Schor

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

December 20, 2002
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Chicago, IL 60606

(For Patent Owner) #6

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DEC 20 2002

REEXAM UNIT

Jerry Cohen
Perkins, Smith & Cohen
One Beacon Street
Boston, MA 02108

(For Third Party Requester)

Mongia et al
Reexamination Proceeding
Control No. 90/006,380
Filed: September 6, 2002
For: U.S. Patent No. 5,158,134

: DECISION
: DISMISSING
: REQUEST

This is a decision on the September 6, 2002, third party requester's request that:

(1) The instant proceeding be consolidated with reexamination Control Number 90/006,379, and

(2) Requester be refunded one of the $2,520 reexamination fees paid for the 90/006,379 proceeding and the instant proceeding.

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

The request is <u>dismissed</u> for the reasons pointed out below.

REVIEW OF FACTS

1. U.S. Patent Number 5,020,587 (the '587 patent) issued June 4, 1991.

2. U.S. Patent Number 5,158,134 (the '134 patent) issued October 27, 1992, and is a continuation of the '587 patent.

3. A request for *ex parte* reexamination of **the '587 patent** was filed September 6, 2002, by a third party requester and was assigned reexamination Control No. 90/006,379 ('379).

4. A request for *ex parte* reexamination of **the '134 patent** was also filed September 6, 2002, by the same third party requester that filed the '379 request. This request for reexamination of the '134 patent was assigned reexamination Control No.90/006,380 ('380). This is the present proceeding.

5. Included within the body of each of the two requests for reexamination is a request to consolidate the two proceedings and a request for a refund of one of the $2,520 reexamination fees that were paid by requester for the two proceedings, "if a consolidation is granted."

6. An order granting reexamination was mailed in the '379 proceeding on November 13, 2002. An order granting reexamination was mailed in the present '380 proceeding on the same date. The two proceedings were then forwarded to the Office of Patent Legal Administration for decision on the requests in both proceedings that the instant proceeding be consolidated with a refund of $2,520.

DECISION

Pursuant to the second sentence of 37 CFR 1.4(c):

> "(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." [Emphasis added]

In this instance, (1) the present request for reexamination of the '134 patent and (2) the request to consolidate this

proceeding with the proceeding for the reexamination of the '587 patent *are both bodily contained within one paper*. It is to be noted that a request for reexamination is decided in the Patent Examining Technology Centers of the Office, while the request to consolidate is decided in the Office of Patent Legal Administration. Accordingly, the request to consolidate the instant proceeding with the '379 proceeding is dismissed.

Further, a refund of $2,520 was requested "if a consolidation is granted." Since the request for consolidation has not been granted, the request for a refund is moot, and is dismissed as such.

ADVISORY INFORMATION

The following information is provided to the third party requester with respect to any renewal of the request for consolidation that might be considered by the third party requester.

1. A request for consolidation of proceedings for reexamination of different patents is a situation not specifically provided for in the regulations. Accordingly, if a renewal of the request for consolidation is made, it must be submitted as a petition under 37 CFR 1.182 accompanied by the petition fee set forth in 37 CFR 1.17(h).

2. In addition, the second sentence of 37 CFR 1.540 states that "[n]o 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." Further, 37 CFR 1.550(g) points out that "[t]he 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." Accordingly, the entry of any renewal of the request for consolidation would require a waiver of the regulations. Thus, any petition filed must satisfy the requirements of 37 CFR 1.183 to show that an extraordinary situation exists, such that justice requires waiver of the regulations to enter and consider the petition.

3. Further, it is to be noted that pursuant to 35 U.S.C. 302:

> "Any person at any time may file **a request for reexamination** by the Office of any claim of **a patent**..." [Emphasis added]

Accordingly, a reexamination can be requested for only "a patent," i.e., **only one patent**. The reexamination statute **does not provide for merging/consolidating two patents into one reexamination proceeding.**

CONCLUSION

1. The request to consolidate the instant proceeding with the '379 proceeding is dismissed.

2. The requested refund of $2,520 is dismissed at moot, since the proceedings are not being consolidated.

3. The reexamination file is being forwarded to the examiner via the Group Director of Technology Center 3700, 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, Leonard R. Leo (703-308-2611), of Technology Center Art Unit 3743.

5. Telephone inquiries with regard to this decision should be directed to the undersigned at 703-308-6710.

Kenneth M. Schor

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

December 19, 2002
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UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Paper No. 14
Mailed: August 19, 2004

MERCK AND CO., INC P O BOX 2000 RAHWAY NJ 07065-0907	FOR PATENT OWNER
MITCHELL B. WASSON HOFFMAN, WASSON & GITLER, PC 2361 JEFFERSON DAVIS HIGHWAY SUITE 522 ARLINGTON, VA 22202	FOR THRID PARTY REQUESTER
In re Pineiro Reexamination Proceeding Control No.: 90/006,381 Filed: September 13, 2002 For: U.S.Patent No. 6,187,805	PETITION DECISION

This is in reply to the petition under 37 CFR 1.181, filed March 25, 2005, requesting remailing of a non-received Office action in a reexamination proceeding.

A review of the file history shows that the examiner mailed a Final Office action to Patent Owner (copy to third party Requester) on September 21, 2004, setting a two month shortened statutory response period. In view of the Office action being returned, the Office action was remailed to Patent Owner (and Requester) on October 14, 2004, the response period being reset with the remailing of the Office action. Upon failure to receive a reply within the time period set and in view of no requests for extension of time being filed, the examiner, on March 22, 2005, inquired of Patent Owner whether a reply had been filed. Patent Owner indicated that the Office action had never been received. Upon advice of the Office Patent Owner immediately filed this petition to prevent issuance of an improper NIRC. Patent Owner provides copies of docket reports and records and statements establishing that the Office action was never received. In view of the evidence presented it is concluded that the Office action was not received and an NIRC for failure of Patent Owner to reply to an Office action should not be issued.

Patent Owner's petition is **GRANTED**.

The Office action is being remailed to Patent Owner with this petition decision.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 703-308-3824 or by facsimile sent to the general Office facsimile number, 571-273-8300.

Bruce M. Kisliuk
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

Paper No. 12

COMMISSIONER FOR PATENTS
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James W. Anable, Esq. (For Patent Owner)
CHRISTENSEN, O'CONNOR, JOHNSON
& KINDNESS PLLC
1420 Fifth Avenue, Suite 2800
Seattle, WA 98101-2347

enclosure: Advisory Action of May 5, 2004

KOLISCH HARTWELL, PC (For Requester)
520 S.W. Yamhill Street
200 Pacific Building
Portland, OR 97204

enclosure: Advisory Action of May 5, 2004

MAILED

APR 0 5 2005

REEXAM UNIT

In re Hansen	:	
Reexamination Proceeding	:	**DECISION**
Control No. 90/006,382	:	**DISMISSING**
Filed: September 16, 2002	:	**PETITION**
For: U.S. Patent No. 5,282,436	:	
	:	

This is a decision on the August 19, 2004, patent owner PETITION UNDER 37 C.F.R. § 1.137(a), for the entry of belated papers based upon unavoidable delay. The petition was originally filed June 14, 2004, as evidenced by the stamped postcard receipt.

The petition fee of $55.00 pursuant to 37 C.F.R. § 1.17(l) for the petition under 37 C.F.R. § 1.137(a) was paid by check.

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

The petition for revival under 37 C.F.R. § 1.137(a) based upon unavoidable delay is **dismissed** for the reasons indicated below.

Any request for reconsideration of this decision must be submitted within **ONE (1) MONTH** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are **not**

permitted. The reconsideration request should include a cover letter entitled either "Renewed Petition under 37 C.F.R. § 1.137(a)" or "Renewed Petition under 37 C.F.R. § 1.137(b)."

DECISION

A grantable petition under 37 C.F.R. § 1.137(a) must be accompanied by:

(1) the required reply, unless previously filed;

(2) the petition fee as set forth in 37 C.F.R. § 1.17(l);

(3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(a) was unavoidable.

The instant petition lacks item (3) above.

This reexamination proceeding terminated after March 3, 2004, for failure to timely file the required reply to the outstanding final rejection of December 3, 2003. The "required reply" is the reply sufficient to have avoided abandonment, had such reply been timely filed. A reply to a final action must include cancellation of, or appeal from, the rejection of each claim so rejected.

The petition fee of $55.00 was paid (Check No. 156062), and was accompanied by, *inter alia*, a copy of petitioner's docket report dated May 27, 2004 - June 3, 2004, a corrected response after final rejection, a notice of appeal, an appeal fee of $165.00 (Check No. 156059) and a stamped postcard receipt showing that the instant petition was received by the Office on June 14, 2004.

Petitioner asserts that patent owner never received the advisory action mailed May 5, 2004. Petitioner states that no copy of this Office action was received until June 10, 2004, when the examiner, in response to a telephone call, sent via facsimile transmission (FAX) a copy of the advisory action to petitioner. Petitioner concludes that the entire delay in filing the required reply was unavoidable due to non-receipt of the advisory action.

The instant petition has been fully considered, but is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 35 U.S.C. § 133 and 37 C.F.R. § 1.137(a).

A showing of unavoidable delay requires:

(1) evidence concerning the procedures in place that should have avoided the error resulting in the delay;

(2) evidence concerning the training and experience of the persons responsible for the error; and

(3) copies of any applicable docketing records to show that the error was in fact the cause of the delay.

See MPEP 711.03(c)(III)(C)(2). In addition, a petition under 37 C.F.R. § 1.137(a) must establish that the delay was unavoidable, and not just that it was unintentional.

Petitioner asserts that the advisory action mailed on May 5, 2004, was not received. It is noted that 3 copies of the advisory action were found to be present in the reexamination file, therefore it appears that the advisory action may inadvertently never have been mailed by the Office[1]. While what appears may be an inadvertent error on the part of the Office is regretted, it nonetheless does **not** render patent owner's delay in filing the required reply in response to the outstanding final rejection "unavoidable" for the reasons explained below.

Petitioner may not rely upon non-receipt of an advisory action to establish that the delay was unavoidable. Delay resulting from the lack of knowledge or improper application of the patent statute, rules of 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 example, 37 C.F.R. §§ 1.116 and 1.135(b) are manifest that proceedings concerning an amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper appeal. A delay is not "unavoidable" when an applicant simply permits the maximum extendable statutory period for reply to a final Office action to expire while awaiting a notice of allowance or other

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[1]A copy of the Advisory Action is enclosed with the instant decision on petition.

action. See MPEP 711.03(c)(III)(C)(2). A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (A) the applicant's reliance upon oral advice from USPTO employees; or (B) the USPTO's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. See *In re Sivertz*, 227 USPQ 255, 256 (Comm'r Pat. 1985).

A review of the reexamination file reveals that the final rejection was mailed on December 3, 2003, and set a 2 month shortened statutory period for response. It is noted that both the Office action, as well as the cover sheet, clearly reminded patent owner (in bold text) that **extensions of time in reexamination proceedings are governed by 37 C.F.R. § 1.550(c).** On February 5, 2004, patent owner filed a proposed response to the outstanding final rejection. Note that MPEP 2272 states (in part):

> " . . . If a response to the final rejection is filed, the time period set in the final rejection continues to run. The time period is automatically extended by 1 month (in accordance with the guidelines set forth in MPEP § 2265) if the response is the first response after the final rejection. Any advisory Office action (form PTOL-467) issued in reply to patent owner's response after final rejection will inform the patent owner of the automatic 1 month extension of time. It should be noted that the filing of any timely first response to a final rejection (even an informal response or even a response that is not signed) will automatically result in the extension of the shortened statutory period for an additional month. . . . The period for response may not, however, be extended to run past 6 months from the date of the final rejection."

Since patent owner filed a first proposed response to the final rejection on February 5, 2004, the shortened statutory time period for response was automatically extended by 1 month (*i.e.*, from February 3, 2004 to March 3, 2004). This means that the required reply, i.e., either a Notice of Appeal and appeal fee, or an amendment under 37 C.F.R. § 1.116 that cancels all the rejected claims or otherwise *prima facie* places the proceeding in condition for "allowance," should have been filed on or before March 3, 2004, unless an extension of time for doing so was requested and granted. Since patent owner did not file the required reply to the final Office action within this 3 month shortened statutory time period, and extensions of time to file such are governed by 37 C.F.R. § 1.550(c), but patent owner did

not request any extensions of time, the patent owner failed to keep the instant reexamination proceeding in a "pending" status[2].

In support of petitioner's assertion that the entire delay in filing the required reply was unavoidable due to non-receipt of the advisory action, petitioner has provided evidence in the form of copies of docket records (Exhibit A) for the time period of May 27, 2004-June 3, 2004. These docket records appear to show on page 11 that the instant reexamination proceeding was entered on the docket report with a "Date Due" of June 3, 2004, for the "Action" indicated as "Respond Final Office Action Ex Parte Quayle 4th Extension/Drop Dead (Advisor Action Rec'd?)". It is unclear what this is intended to mean, but what appears to be evident from this document is that petitioner is not familiar with the reexamination rules of practice, and in particular, that a shortened statutory time period was set in the final rejection, and any requests for extensions of time are governed by 37 C.F.R. § 1.550(c), and **not** 37 C.F.R. § 1.136(a). However, a delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP, does **not** constitute "unavoidable" delay within the meaning of 35 U.S.C. § 133 and 37 C.F.R. § 1.137(a). The docket records also provide evidence that the patent owner has simply permitted the maximum extendable statutory period for reply to a final Office action to expire while awaiting receipt of an advisory action, which, as also discussed above, does **not** constitute "unavoidable" delay within the meaning of 35 U.S.C. § 133 and 37 C.F.R. § 1.137(a). Further evidence of this latter point is provided wherein petitioner indicates that "On June 9, 2004, counsel for patentee checked the status of the application on the Patent Application Information Retrieval ("PAIR") system and discovered that the PAIR system indicated that an Advisory Action ("Advisory Action") in this matter had been mailed on May 5, 2005." Of note is that this date of monitoring the reexamination proceeding is clearly outside of the 6 month statutory period for response. While petitioner has provided copies of docketing records, presumably in an attempt to show that the docketing error was in fact the cause of the delay, petitioner has failed to provide any evidence concerning the procedures in place that should have avoided the error resulting in the delay; nor any evidence

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[2]While it is noted that the advisory action extended the time period for response to 6 months from the final rejection, the actual date of abandonment is immaterial to the instant petition decision, as patent owner took no action until after the expiration of the statutory period for response.

concerning the training and experience of the persons responsible for the error. 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).

While the docketing error may have been the cause of the delay in responding to the final rejection in the instant reexamination proceeding, with regard to items (B) and (C) above, petitioner has not provided a showing that there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; nor a showing that the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care. In fact, the evidence provided actually appears to indicate the opposite, i.e., that the employee is not trained and experienced in docketing reexamination proceedings, and that there may not have been procedures in place for properly docketing reexamination proceedings. Note that the pertinent docket records would include those for the time period before, after, and including March 3, 2004, *i.e.*, the 3 months shortened statutory period for response to the final rejection.

In view of the above, the petition for the entry of late papers is not sufficient to meet the criteria for establishing unavoidable delay. The petition for revival under 37 C.F.R. § 1.137(a) 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 Notice of Appeal of June 14, 2004, 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).

It should be noted that some additional papers were received on August 16, 2004, which include a petition for an extension of time of one month to file an appeal brief, and a response including a proposed amendment. The August 16, 2004, petition is not timely, and is moot, since the instant reexamination proceeding is not currently pending. If patent owner is successful in restoring the instant reexamination proceeding to a pending status by filing a renewed petition that is grantable, then any such decision granting a petition to revive would set a time period for patent owner to file their appeal brief.

CONCLUSION

1. The petition under 37 C.F.R. § 1.137(a) is **dismissed**.

2. Any renewed petition must be filed within **ONE (1) MONTH** of the mailing date of this decision.

3. Failure to reply within this time period will result in termination of the instant reexamination proceeding.

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

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

By FAX: (571) 272-0100
Attn: Office of Patent Legal Administration

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

5. 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

April 5, 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.
90/006,382	09/16/2002	5282436	WIF 224A	2166

7590 05/16/2005

EXAMINER

James W. Anable, Esq.
Christensen, O'Connor, Johnson & Kindness PLLC
1420 Fifth Avenue, Suite 2800
Seattle, WA 98101-2347

ART UNIT	PAPER NUMBER

DATE MAILED: 05/16/2005

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

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KOLISCH HARTWELL, PC (For Requester)
520 S.W. Yamhill Street
200 Pacific Building
Portland, OR 97204

MAILED
MAY 1 6 2005
REEXAM UNIT

In re Hansen
Reexamination Proceeding
Control No. 90/006,382
Filed: September 16, 2002
For: U.S. Patent No. 5,282,436

DECISION GRANTING PETITION

This is a decision on patent owner's May 3, 2005, RENEWED PETITION UNDER 37 CFR 1.137(b), 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 **granted**.

DECISION

In the April 5, 2005, decision dismissing the patent owner's August 19, 2004 PETITION UNDER 37 C.F.R. § 1.137(a), it was suggested to petitioner, as a alternative option, that a petition under 37 CFR 1.137(b) could be filed to achieve the relief requested by petitioner. Petitioner has filed the present petition under 37 CFR 1.137(b), and this petition is granted in view of the following discussion:

The instant petition under 37 CFR 1.137(b) is accompanied by the appropriate statement pursuant to 37 CFR 1.137(b)(3). (Petition at page 3.) In addition, a Notice of Appeal and appeal fee were filed with patent owner's August 19, 2004 PETITION UNDER 37 C.F.R. § 1.137(a), 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 has been paid via check, and has been applied to provide the "petition fee as set forth in 37 CFR 1.17(m)" pursuant to 37 CFR 1.137(b)(2). Accordingly, the present petition under 37 CFR 1.137(b) is granted

CONCLUSION

1. The petition under 37 CFR 1.137(b) is **granted**.

2. The patent owner must file a brief under 37 CFR 41.37 within **TWO MONTHS** from the date of mailing of this decision. Pursuant to 37 CFR 41.37(e), this time period is extendable only under the provisions of 37 CFR 1.550(c), directed to an extension of time in an *ex parte* reexamination proceeding.

3. The reexamination file is being returned to Technology Center 1700 for prompt consideration of the "Corrected Response After Final Rejection submitted with the petition.

4. Any further communication as to the merits of this reexamination proceeding should be directed to the examiner, J.D. Sotelo.

5. 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

May 15, 2005
C:\KIVA\KPET-ABE\6382UNIN.GRT

#10

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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Howard & Howard Attorneys, P.C.
The Pinehurst Office Center, Suite 101
39400 Woodard Avenue
Bloomfield Hills, MI 48304-5151 (For Patent Owner)

MAR 29 2005

Collard & Roe, P.C.
1077 Northern Boulevard
Roslyn, NY 11576 (For Requester)

Young & Basile, P.C.
3001 West Big Beaver Road, Suite 624
Troy, MI 48084-3107 (For Requester)

In Re Xiluo et al. Reexamination Proceeding Control No. 90/006,284 Filed: May 8, 2002 For: US Patent Number 6,260,472	DECISION, *SUA SPONTE*, MERGING REEXAMINATION PROCEEDINGS
In Re Xiluo et al. Reexamination Proceeding Control No. 90/006,384 Filed: September 16, 2002 For: US Patent Number 6,260,472	

The above noted reexamination files are now before the Director of Technology Center 3700 for consideration of merger of the proceedings under 37 CFR 1.565(c), in accordance with the practice set forth at MPEP § 2283. It is noted that Requester Collard & Roe, P.C. has filed the '284 proceeding and Requestor Young & Basile, P.C. has filed the '384 proceeding.

I. Merger of Proceedings

As required by the practice pursuant to MPEP § 2283, and under the authority of 37 CFR § 1.565(c), the '284 and '384 reexamination proceedings are hereby MERGED. The merged proceedings 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. Currently, no amendments have been made. All future submissions by Owner must continue to be served on both Requesters. The contents of each file will thereafter be maintained identically. The request for a certificate of correction and director's report were processed in Control No. 90/006,284. A copy of these papers has been placed in Control No. 90/006,384.

III. Conduct of Merged Proceedings

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. The Requesters 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 Requesters, even papers filed *via* facsimile transmission.

An office Action by the examiner will follow. 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. 90/006,284 and 90/006,384 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.

Owner has filed a request to combine dual Reexaminations and a Change of Address. It is noted that these papers were not served on the Requesters. A copy of these papers will be provided to the Requesters and will act as the certificate of service. Owner should not expect the Office to serve papers in the future.

Richard A Bertsch

Richard Bertsch, Director
Technology Center 3700

Attachments for third party requesters only:
Request for certificate of correction
Director's Report
Request to combine dual Reexaminations
Change of Address

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.
09/833,269	04/05/01	Joey F. Boatman	

PATENT NUMBER	DATE OF THIS NOTICE	PAPER NUMBER
5,892,690	04/14/03	14

NOTICE OF MERGED REEXAM - REISSUE PROCEEDING

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

Control No. 90/006,386 Filing Date: 09/18/02

Requester (name, address)
James J. Lynch
ZARLEY LAW FIRM
Capital Square
400 Locust Street Suite 200
Des Moines IA 50309-2350

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

REEXAMINATION RESULTS

The questions raised in reexamination request No. 90/006,386, filed 09/18/02, have been considered and the results thereof are reflected in this reissue patent which constitutes the reexamination certificate required by 35 U.S.C. 307 as provided in 37 CFR 1.570(e).

FORM PTO-1527
(3-84)

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. 13

FAEGRE & BENSON LLP
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(For Patent Owner)

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Des Moines, IA 50309-2350

(For Requester)

MAILED

APR 14 2003

REEXAM UNIT

In re reissue application of
Boatman, et al.,
Application No. 09/833,269
Filed: April 5, 2001
For: U.S. Patent No. 5,892,690

In re Boatman, et al.,
Reexamination Proceeding
Control No. 90/006,386
Filed: September 18, 2002
For: U.S. Patent No. 5,892,690

DECISION *SUA SPONTE* MERGING REEXAMINATION AND REISSUE PROCEEDINGS

The above-identified reissue application and reexamination proceeding are before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged at this time.

REVIEW OF FACTS

1. U.S. Patent No. 5,892,690 issued to Boatman, et al., on April 6, 1999.

2. Patent owner filed a reissue application based on the '690 patent, on April 5, 2001, which was assigned Application No. 09/833,269. Claims 21-76 were added.

3. Notice of the filing of the reissue application was published in the *Official Gazette* on July 17, 2001.

4. On November 27, 2001, a non-final Office action was mailed in the reissue application.

5. A response to the Office action was filed on January 17, 2002.

6. A request for reexamination of the '690 patent was filed by a third party requester on September 18, 2002, and the resulting reexamination proceeding was assigned Control No. 90/006,386.

7. On September 23, 2002, a non-final Office action was mailed in the reissue application.

8. On December 2, 2002, reexamination was ordered in the '6386 proceeding.

9. A response, including an amendment of claims 1, 16, 27, 32 and 53, was filed on January 14, 2003, in the reissue application.

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 '6386 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 '6386 reexamination file shows that no amendments were made in the reexamination file.

A review of the reissue (Application No. 09/833,269) prosecution history shows that the reissue application was published in the *Official Gazette* on July 17, 2001. A non-final Office action was mailed on September 23, 2002, and a response was filed on January 14, 2003. In the reissue application, patent owner has added claims 21-76. Therefore, the claims are **not** identical in both proceedings. It should be noted that the amendment of claims 1, 16, 27, 32 and 53, filed on January 14, 2003, in the reissue application, is **not** in the proper format for reissue applications, pursuant to 37 C.F.R. § 1.173(b)(2), (c), (d), and

(g), and therefore has **not** been entered. Note that the claim changes need to be made with regard to the original patent text, all new claims must be completely underlined, and the status of all patent claims and all added claims, as well as the support for all claim changes must be indicated on pages separate from the amendment pages. **Note that amendment practice pursuant to 37 C.F.R. § 1.121 does not apply to reissue applications, as specifically indicated in 37 C.F.R. § 1.121(a) and (h).** In order to provide efficient and prompt handling of both proceedings, and to prevent inconsistent and possibly conflicting amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexamination proceeding will be conducted in accordance with the decision set forth below.

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-identified reissue and reexamination proceedings are merged. A joint examination will be conducted in accordance with the guidelines and requirements which follow.

II. Requirement for Same Amendments in Both Proceedings

The patent owner is required to maintain identical amendments in the reissue application and the reexamination file for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the proceedings remain merged. See 37 C.F.R. § 1.565(d). As noted above with regard to the amendments submitted, the claims are NOT the same in both files. **An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both cases**, specifically, Application No. 09/833,269, and Control Number 90/006,386. The response to the requirement must be limited to placing the same amendments in both cases, and patent owner must **not** address the issues of either of the proceedings in the housekeeping amendment. The housekeeping amendment should be submitted as a single paper, including the identifying data for both files (*i.e*, the reissue Application No.

and the reexamination proceeding Control No.) and a signature, and should be filed in duplicate for entry into each of the reissue and reexamination files. The amendment must be in compliance with 37 C.F.R. § 1.173. Note that a "clean copy" of the amendment is **not** required by this rule.

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, and containing identifying data for both of the cases (*i.e*, the reissue Application No. and the reexamination proceeding Control No.).

If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be terminated by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 C.F.R. § 1.570. See MPEP 2285.

If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated as follows. The reissue application will be held abandoned, and the merger will be dissolved. With respect to the reexamination proceeding, the Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office, unless further action is clearly needed as a result of the difference in rules relating to reexamination and reissue proceedings.

If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 C.F.R. § 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue examination as to the reexamination proceeding. Any grounds of rejection which are not applicable under reexamination would be withdrawn (*e.g.*, based on public use or sale), and any new grounds of rejection which are applicable under reexamination (*e.g.*, improperly broadened claims) would be made by the examiner upon dissolution of the merged proceeding. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 C.F.R. § 1.552(c).

CONCLUSION

1. The 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 2800.

3. The examiner should immediately issue an Office action for the present merged proceeding of the reissue application and reexamination proceeding. All further examination should be conducted in accordance with Parts II and III of this decision.

4. Telephone inquiries related 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

April 10, 2003

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

90/005,881
90/006,051
90/005,623

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.

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
ARTEN AND HARDEN
1100 Huntington Building
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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)

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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,392	09/27/2002	5162666	TTI666RES	2026

24197 7590 04/24/2009

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/24/2009

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
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ALAN R. LOUDERMILK
LOUDERMILK & ASSOCIATES
P.O. BOX 3607
LOS ALTOS, CA 94024-0607

Date:

MAILED

APR 24 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90006392
PATENT NO. : 5162666
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

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.
90/005,384	06/04/1999			7780

24197 7590 04/24/2009

KLARQUIST SPARKMAN, LLP
121 SW SALMON STREET
SUITE 1600
PORTLAND, OR 97204

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/24/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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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)).

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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.

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United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

ALAN R. LOUDERMILK
LOUDERMILK & ASSOCIATES
P.O. BOX 3607
LOS ALTOS, CA 94024-0607

Date:

MAILED

APR 24 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90005823
PATENT NO. : 5162666
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/005,881	12/08/2000	5162666		5515

24197 7590 04/24/2009

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
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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. : 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)).

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United States Patent and Trademark Office
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P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,051	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

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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Klarquist Sparkman LLP
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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

<u>35 U.S.C. 307 Certificate of patentability, unpatentability, and claim cancellation</u>.

(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 PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Paper No. 13/7

JUL 31 2003

Seyfarth Shaw
55 East Monroe Street
Suite 4200
Chicago, IL 60603-5803

(For Patent Owner)

E. Thomas Wheelock
Morrison & Foerster LLP
755 Page Mill Road
Palo Alto, CA 94304

(For Third Party Requester)

In re Larry F. Weber et al.
Reexamination Proceeding
Control No. 90/006,395
Filed: October 11, 2002
For U.S. Patent No. 4,866,349

In re Larry F. Weber et al.
Reexamination Proceeding
Control No. 90/006,609
Filed: April 18, 2003
For U.S. Patent No. 4,866,349

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above-identified reexamination files are before the Director of Examining Group 2810, Technology Center 2800, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. U.S. Patent No. 4,866,349 issued on September 12, 1989.

2. Reexamination Control No. 90/006,395 was filed by the patent owner on October 11, 2002.

3. Reexamination was ordered in the '395 reexamination proceeding on December 19, 2002.

4. An amendment was filed in the '395 reexamination proceeding on March 20, 2003 which amended claim 8 and column 11 of the specification, and added claim 30.

5. Reexamination Control No. 90/006,609 was filed by a third party requester on April 18, 2003.

6. Reexamination was ordered in the '609 reexamination proceeding on July 14, 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* 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 '395 and '609 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 '395 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 than 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. '395 and '609 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.

Arthur T. Grimley, Acting 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.
90/006,395	10/11/2002	4866349	400100	3307

490/006,609

27717 7590 04/22/2004

SEYFARTH SHAW
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CHICAGO, IL 60603-5803

EXAMINER

ART UNIT	PAPER NUMBER
	20

DATE MAILED: 04/22/2004

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Paper No. 20

Seyfarth Shaw
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Chicago, IL 60603-5803

(For Patent Owner)

E. Thomas Wheelock
Morrison & Foerster LLP
755 Page Mill Road
Palo Alto, CA 94304

(For Third Party Requester)

In re Larry F. Weber et al.	:	
Merged Reexamination Proceeding	:	DECISION
Control Nos. 90/006,395 & 90/006,609	:	ACCEPTING PAPERS
For: U.S. Patent No. 4,866,349	:	
Issued: September 12, 1989	:	

This is a decision accepting the papers filed on March 17, 2004 as being timely filed in response to the Office action entitled "Notice of Defective Paper in Ex Parte Reexamination" mailed on October 17, 2003.

The Office action mailed on October 17, 2003 set a 1 month time period to respond. The papers filed on March 17, 2004 include a response to the Office action and a copy of a receipt bearing a PTO stamp indicating a November 3, 2003 date of receipt. If the original of the response was filed on November 3, 2003 it would have been a timely response to the Office action mailed on October 17, 2003.

The original of the response is not in either file record and cannot be located. However, M.P.E.P. § 503 states that "A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO." Accordingly, it is concluded that the original response was timely filed but was lost or misplaced after receipt thereof.

The copy of the response is hereby accepted as being timely filed and accepted for entry in

the file records. It is noted that the copy of the response for Reexam Control No. 09/006,395 is not exactly the same as the copy of the response for Reexam Control No. 09/006,609. Besides the different Reexam Control No. written on top of the respective cover sheets, the texts of the cover letters are not exactly the same. In addition, the copy of the response with Reexam Control No. 90/006,395 includes 8 pages of remarks while the copy of the response with Reexam Control No. 90/006,609 includes no remarks. The amendments requested in the respective responses are the same.

Patent owner is reminded that all papers filed by the patent owner must consist of a single response **containing the identifying data for both files**, filed in duplicate. With this in mind, the other Reexam Control Number will be handwritten on each of the papers and each paper will be kept in the respective files. But since the copy of the response meant for Reexam Contol No. 90/006,609 did not include remarks, the copy of the response that was meant for Reexam Control No. 90/006,395 (with Reexam Control No. 90/006,609 handwritten on it) will be copied and used as the response in Reexam Control 90/006,609. The copy of the response that was meant for Reexam Control No. 90/006,609 will merely be kept in that file and indicated to be a partial copy of the reponse.

In addition to the response, the papers filed on March 17, 2004 included: a Supplemental Information Disclosure Statement with a copy of a receipt indicating receipt by the PTO on December 16, 2003; a "Communication by Third Party Requestor" asserted to be filed about August 6, 2003; and a "Patent Owner's Request to Strike "Communication by Third-Party Requestor"" indicated to be filed for the first time on March 17, 2004.

The original of the Supplemental Information Disclosure Statement filed on December 16, 2003 with Reexam Control No. 90/006,395 listed on the cover sheet (and on the PTO-1449) was received and will be kept in the file of Reexam Control No. 90/006,395. The copy of the Supplemental Disclosure Statement filed on March 17, 2004 with Reexam Control No. 90/006,609 listed on the cover sheet (and on the PTO-1449) will be kept in the file of Reexam Control No. 90/006,609 since the original cannot be located. Except for the different Reexam Control Numbers, the Supplemental Information Disclosure Statements are the same. The other Reexam Control Number will merely be handwritten on each of the papers.

The original of the "Communication by Third Party Requestor" asserted to be filed about August 6, 2003 was actually received at the PTO on August 11, 2003. The communication includes the same District Court decision that was filed by the patent owner on August 7, 2003. Patent owner's statement in "Patent Owner's Request to Strike "Communication by Third-Party Requestor"" that the third party requester's communication "enclosed (1) "Scheduling Order" from the court and (2) a 59 page document prepared by the patent owner and served upon counsel for third-party requestor **but not filed in court**" is not understood. The communication from the third party includes only the 62 page decision from the District Court, a 2 page cover letter, a Certificate of Mailing dated August 6, 2003, a Certificate of Service, and a transmittal form.

Regarding the cover letter from the third party requester that accompanied the copy of the decision, although it does contain a little more than bare notice, it does not contain anything that is considered to be arguments or misleading information as asserted in "Patent Owner's Request to Strike "Communication by Third-Party Requestor."" In order to keep a clear record as to exactly what was submitted by the third party, it is appropriate to allow the cover letter to remain in the file record. Accordingly, the patent owner's request to strike the third party's communication is **denied**.

The communication from the third party requester that was received at the PTO on August 11, 2003 and the copy of it provided by the patent owner included only Reexam Control No. 90/006,609 on the cover letter. If a separate copy of the communication was submitted for Reexam Control No. 90/006,395, it was not matched with the file. The proceedings in Reexam Control No. 90/006,395 and 90/006,609 were merged on July 31, 2003. In order to maintain consistent files, Reexam Control No. "90/006,395" is being handwritten on both the original copy of the third party communication and on the copy of it that was filed by the patent owner on March 17, 2004. The copy that was filed on March 17, 2004 will be placed into the file of Reexam Control No. 90/006,395. Similarly, "90/006,395" is being handwritten on the "Patent Owner's Request to Strike "Communication by Third-Party Requestor"" and a copy of it will be made and inserted into the file of Reexam Control No. 90/006,395.

Any inquiries concerning this decision should be directed to Edward Westin at (571) 272-1638.

Edward Westin

Edward P. Westin, Special Programs Examiner
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
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Paper No. 13/7

JUL 31 2003

Seyfarth Shaw
55 East Monroe Street
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Chicago, IL 60603-5803

(For Patent Owner)

E. Thomas Wheelock
Morrison & Foerster LLP
755 Page Mill Road
Palo Alto, CA 94304

(For Third Party Requester)

In re Larry F. Weber et al.
Reexamination Proceeding
Control No. 90/006,396
Filed: October 11, 2002
For U.S. Patent No. 5,081,400

In re Larry F. Weber et al.
Reexamination Proceeding
Control No. 90/006,610
Filed: April 18, 2003
For U.S. Patent No. 5,081,400

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above-identified reexamination files are before the Director of Examining Group 2810, Technology Center 2800, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. U.S. Patent No. 5,081,400 issued on January 14, 1992.

2. Reexamination Control No. 90/006,396 was filed by the patent owner on October 11, 2002.

3. Reexamination was ordered in the '396 reexamination proceeding on December 19, 2002.

4. An amendment was filed in the '396 reexamination proceeding on March 20, 2003 which amended claims 32 and 40 and column 11 of the specification, and added claims 42-45.

5. Reexamination Control No. 90/006,610 was filed by a third party requester on April 18, 2003.

6. Reexamination was ordered in the '610 reexamination proceeding on July 8, 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* 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 '396 and '610 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 '396 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 than 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. '396 and '610 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.

Arthur T. Grimley, Acting Group Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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JOHN R. LASTOVA
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1100 NORTH GLEBE ROAD, 8TH FLOOR
ARLINGTON, VA 22201

(For Patent Owner)

COPY MAILED

FEB 11 2005

OFFICE OF PETITIONS

In re Dean	:
Reexamination Proceeding	:
Control No. 90/006,399	: DECISION DISMISSING
Filed: October 10, 2002	: PETITION AS MOOT
For: U.S. Patent No. 6,054,948	:

This is a decision on the January 31, 2005 patent owner's "Petition to Accept Response Filed March 20 [sic, March 30], 2004," which is being treated as a petition under 37 CFR 1.181.

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

The petition under 37 CFR 1.181 is **dismissed as moot** for the reasons stated below.

ISSUE

Petitioner herein (Mr. John R. Lastova) requests that the response filed in response to the March 1, 2004 Office action be accepted as having been filed on March 30, 2004. In support, petitioner has proffered a copy of a stamped postcard which acknowledges receipt by the U.S. Patent and Trademark Office (USPTO) of a "Response to the Official Action in Reexam Proceedings and Transmittal letter" on March 30, 2004. The instant request was filed on the alleged recommendation of the Examiner, who advised petitioner that the March 30, 2004 response had not yet been matched with the file or entered into the USPTO's docketing system.

DECISION ON PETITION

In reviewing the records of the USPTO, it is noted that a response dated March 30, 2004 has been received and scanned into IFW for this reexamination proceeding. Thus, the filing of the response to the Office action was timely. Accordingly, the

filing of the instant petition is unnecessary and is dismissed as involving a moot issue.

CONCLUSION

1. The petition under 37 CFR 1.181 is **dismissed** as involving a moot issue.

2. The reexamination matter is being returned to Technology Center AU 3662 for action, in due course, on the response filed March 30, 2004.

3. Any further communications as to the merits of the reexamination proceeding should be directed to Examiner Gregory C. Issing, in Technology Center AU 3662, who can be reached at (571) 272-6973.

4. Telephone inquiries related to this decision should be directed to Frances Hicks at (571) 272-3218.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

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.
90/006,406	10/01/2002	6333019	2402.023	7190

7590 09/03/2004

Charles L. Gagnebin III
Weingarten Schurgin Gagnebin & Hayes LLP
Ten Post Office Square
Boston, MA 02109

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED. 09/03/2004 #20

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.

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Lawrence B. Bond (For Requester)
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In re Coppens
Reexamination Proceeding
Control No. 90/006,406
Filed: October 1, 2002
For: U.S. Patent No. 6,333,019

DECISION DISMISSING PETITION

This is a decision on the April 29, 2004, 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 $655.00 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. 23-0804, as instructed on page 4 of the instant 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)(II)(C) and (D).

The instant petition is accompanied by the petition fee, as well as a proposed response to the final Office action of October 22, 2003, and a Notice of Appeal along with authorization to charge the Notice of Appeal 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 instant petition lacks item (3) above.

The petition includes a statement that the "entire delay in filing a compliant response to final Office action in Reexamination dated October 22, 2003, from the due date with one month extension of January 22, 2004, until the filing of this petition was unintentional." 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 final Office action was filed on April 29, 2004, 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 C.F.R. § 1.530. Specifically, the amendment is **not** in compliance with 37 C.F.R. § 1.530, because the amendment of claim 9 does not show **all deletions being made with bracketing with regard to the original patent text** of this claim (for one example, in line 9 "[through]" should be shown in brackets, and note that there are other similar errors as well). **Any and all text being deleted from the original patent must be shown in brackets**. 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).

However, since a Notice of Appeal and the Notice of Appeal fee were also filed, item (1) is considered to have been complied with, per MPEP 711.03(c)II. A. 2.(b)(A).

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. No appeal brief should be filed at this time. The time period for filing the appeal brief will be set in any decision granting a renewed petition.

4. Should patent owner desire that the examiner consider the proposed amendment to the claims at this time, an appropriate amendment in compliance with 37 C.F.R. § 1.530 should be

submitted along with any request for reconsideration of this decision.

5. 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).

6. 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
Attn: Office of Patent Legal Administration

By hand: Crystal Plaza Three-Four, Suite 3D68
2100 Crystal Drive
Arlington, VA

7. 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 3, 2004

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COMMISSIONER FOR PATENTS
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Paper No. 24

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Lawrence B. Bond (For Requester)
TRASK BRITT
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Salt Lake City, UT 84110-2550

MAILED
DEC 07 2004
REEXAM UNIT

In re Coppens
Reexamination Proceeding
Control No. 90/006,406
Filed: October 1, 2002
For: U.S. Patent No. 6,333,019

DECISION GRANTING PETITION

This is a decision on the September 20, 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 of $655.00 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 renewed 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 renewed petition includes a statement that the "entire delay in filing the required reply to the final Office action in Reexamination dated October 22, 2003, from the due date with one month extension of January 22, 2004, until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional." The statement contained in the renewed petition varies from the language required by 37 C.F.R. § 1.137(b)(3); however, the statement contained in the renewed 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, and was accompanied by a Notice of Appeal along with authorization to charge the Notice of Appeal fee. As indicated in the previous petition decision the Notice of Appeal 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 renewed petition is **granted**.

It is noted with regard to item (1), that the renewed petition includes a corrected proposed response to the outstanding final Office action which is in compliance with 37 C.F.R. § 1.530. This proposed response was not necessary to revive the proceeding due to the filing of the notice of appeal. A showing under 37 C.F.R. § 1.116(b) is required and will be evaluated by the examiner for all proposed amendments after final rejection except where an amendment merely cancels claims, adopts examiner's suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner. An amendment filed at any time after final rejection but before an appeal brief is filed, may be entered upon or after filing of an appeal provided the total effect of the amendment is to (A) remove issues for appeal, and/or (B) adopt examiner suggestions. The examiner will immediately consider the proposed response to the final rejection, and will promptly notify the appellant via mailing of an advisory action as to whether or not the proposed amendment after final will be entered for purposes of removing issues on appeal, as this decision may affect the contents required for the appeal brief.

CONCLUSION

1. The renewed petition is **granted**.

2. Appellant's brief is due within **two (2) months** of the mailing date of this petition decision. The appeal brief should be directed to Technology Center 1700, Group Art Unit 1754, to the attention of examiner Steven Bos.

3. The reexamination file will be returned to Technology Center 1700 for the examiner's immediate consideration of the proposed amendment after final of September 20, 2004, as well as to await receipt of the appeal brief. The examiner will promptly notify the appellant via mailing of an advisory action as to whether or not the proposed amendment after final will be entered for purposes of removing issues on appeal, as this decision may affect the contents required for the appeal brief.

4. Any inquiries with regard to the merits of this proceeding should be directed to Examiner Steven Bos, of Group Art Unit 1754.

5. 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

December 6, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
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Paper No. 9

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(For Requester)

MAILED
SEP 25 2003
REEXAM UNIT

In re Silvestre
Reexamination Proceeding
Control No. 90/006,407
Filed: October 3, 2002
For: U.S. Patent No. 5,260,097

DECISION GRANTING PETITION

This is a decision on the May 30, 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 $1300.00 pursuant to 37 C.F.R. § 1.17(m) for the petition under 37 C.F.R. § 1.137(b) has been received.

The petition for revival under 37 C.F.R. § 1.137(b) based upon unintentional delay is **granted** for the reasons indicated below.

DECISION

A grantable petition under 37 C.F.R. § 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed;

(2) the petition fee required by 37 C.F.R. § 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional.

Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 C.F.R. § 1.137(b) was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D).

The petition is accompanied by the petition fee. It should be noted that 37 C.F.R. § 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional. The statement contained in the present petition varies from the language required by 37 C.F.R. § 1.137(b)(3); however, the statement contained in the present petition is being construed as the statement required by 37 C.F.R. § 1.137(b)(3). Petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

The required reply to the non-final Office action of March 21, 2003, has been received.

In view of the above, the petition for the entry of late papers is sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

The petition is **granted**.

CONCLUSION

1. The petition is **granted**.

2. The reexamination file will be forwarded to Technology Center 1700 for consideration of the response to the non-final Office action of March 21, 2003.

3. Further inquiries with regard to this reexamination proceeding should be directed to the examiner, Frederick Parker, of Group Art Unit 1762.

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

September 23, 2003

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MAILED
SEP 25 2003
REEXAM UNIT

In re Silvestre
Reexamination Proceeding
Control No. 90/006,407
Filed: October 3, 2002
For: U.S. Patent No. 5,260,097

DECISION GRANTING PETITION

This is a decision on the May 30, 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 $1300.00 pursuant to 37 C.F.R. § 1.17(m) for the petition under 37 C.F.R. § 1.137(b) has been received.

The petition for revival under 37 C.F.R. § 1.137(b) based upon unintentional delay is **granted** for the reasons indicated below.

DECISION

A grantable petition under 37 C.F.R. § 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed;

(2) the petition fee required by 37 C.F.R. § 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional.

Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 C.F.R. § 1.137(b) was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D).

The petition is accompanied by the petition fee. It should be noted that 37 C.F.R. § 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional. The statement contained in the present petition varies from the language required by 37 C.F.R. § 1.137(b)(3); however, the statement contained in the present petition is being construed as the statement required by 37 C.F.R. § 1.137(b)(3). Petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

The required reply to the non-final Office action of March 21, 2003, has been received.

In view of the above, the petition for the entry of late papers is sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

The petition is **granted**.

CONCLUSION

1. The petition is **granted**.

2. The reexamination file will be forwarded to Technology Center 1700 for consideration of the response to the non-final Office action of March 21, 2003.

3. Further inquiries with regard to this reexamination proceeding should be directed to the examiner, Frederick Parker, of Group Art Unit 1762.

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

September 23, 2003

mJ

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Geoffrey R. Myers
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(For Patent Owner)

MAILED

JUN 28 2006

CENTRAL REEXAMINATION UNIT

George Quadrino
Manelli, Denison & Selter, PLC
2000 M Street, N.W., Ste. 700
Washington, DC 20036-3307

(For Third Party Requester)

In re Reexamination Proceeding
Jing-Jong Pan
Control No. 90/006,408
Filed: October 4, 2002
U.S. Patent No. RE35,575
Attorney Docket No. 2500.330

: DECISION GRANTING PETITION

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on May 2, 2006, by facsimile transmission, for entry of late papers based upon unintentional delay.

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

37 CFR 1.137(b) states:

> "*Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by: (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in § 1.17(m); (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section."

On June 15, 2006, in response to a telephone communication between Counsel, Matthew Pequignot and Senior Legal Advisor, Fred Silverberg, a Notice of Appeal along with an authorization to charge counsel's deposit account for the requisite Notice of Appeal fee was filed by facsimile transmission.

The present petition under 37 CFR 1.137(b) includes the requisite response (Notice of Appeal and fee) (item 1), a $1500.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3).

The petition for entry of the late papers is granted.

$500.00 for the Notice of Appeal Fee has been charged to counsel's deposit account no. 50-1465.

Jurisdiction over the reexamination proceeding is being returned to Technology Center Art Unit 3992 for further examination and consideration of the Notice of Appeal filed June 14, 2006 and the amendment filed May 2, 2006, 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, Kwang Yao, in Technology Center Art Unit 3992, who can be reached at 571-272-3182.

Telephone inquiries related to this decision should be directed to Fred A. Silverberg at 571-272-7719.

Fred A. Silverberg

Fred A. Silverberg
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy

Kenneth M. Schor

Conferee: Kenneth M. Schor

UNITED STATES PATENT AND TRADEMARK OFFICE

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MAILED

OCT 19 2006

CENTRAL REEXAMINATION UNIT

In re Reexamination Proceeding
Jing-Jong Pan
Control No. 90/006,408
Filed: October 4, 2002
U.S. Patent No. RE35,575
Attorney Docket No. 2500.330

: SUPPLEMENTAL DECISION
: GRANTING PETITION

This is a supplemental decision on the petition under 37 CFR 1.137(b) filed by the patent owner on May 2, 2006, by facsimile transmission, for entry of late papers based upon unintentional delay. This supplemental decision sets the time period for filing an appeal brief and the appeal brief fee as two (2) months from the date of this decision.

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."

On June 15, 2006, in response to a telephone communication between Counsel, Matthew Pequignot and Senior Legal Advisor, Fred Silverberg, a Notice of Appeal along with an authorization to charge counsel's deposit account for the requisite Notice of Appeal fee was filed by facsimile transmission.

The present petition under 37 CFR 1.137(b) includes the requisite response (Notice of Appeal

and fee) (item 1), a $1500.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3).

The petition for entry of the late papers is granted.

$500.00 for the Notice of Appeal Fee has been charged to counsel's deposit account no. 50-1465.

The time period for filing an appeal brief and the appeal brief fee in response to the Notice of Appeal filed as a response to the outstanding Office action is two (2) months from the date of this decision, MPEP 711.03(c).

Jurisdiction over the reexamination proceeding is being returned to Technology Center Art Unit 3992 for further examination and consideration of the Notice of Appeal filed June 14, 2006 and the amendment filed May 2, 2006, 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, Kwang Yao, in Technology Center Art Unit 3992, who can be reached at 571-272-3182.

Telephone inquiries related to this decision should be directed to Fred A. Silverberg at 571-272-7719.

Fred A. Silverberg

Fred A. Silverberg
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy

Kenneth M. Schor

Conferee: Kenneth M. Schor

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,411	10/11/2002	6412628	13345.55USAA	3298

7590 05/11/2004

Thomas C. Wettach
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11 Stanwix Street, 15th Floor
Pittsburgh, PA 15222

EXAMINER
LUONG

ART UNIT	PAPER NUMBER
3728	19

DATE MAILED: 05/11/2004

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. 19

Cohen & Grigsby, P.C. 11 Stanwix Street, 15th Floor Pittsburgh, PA 15222	For Patent Owner
Kate DeVries Smith Merchant & Gould, P.C. P.O. Box 2903 Minneapolis, MN 55402-0902	For Requester
Natalie D. Kadievitch Fredrikson & Byron, P.A. 4000 Pillsbury Ctr. 200 S. 6th Street Minneapolis, MN 55402-1425	
In re Reexamination Control No. 90/006,411 Request Filed: October 11, 2002 U.S. Patent No. 6,412,628 Issued: July 2, 2002 Patentee: Tramposch	CORRECTED DECISION, *SUA SPONTE*, MERGING REEXAMINATION PROCEEDINGS
In re Reexamination Control No. 90/006,881 Request Filed: December 5, 2003 For: U.S. Patent No. 6,412,628 Issued: July 2, 2002 Patentee: Tramposch	

The above noted reexamination files are before the Director of Patent Examining Group 3700 for consideration of merger of the proceedings under 37 CFR 1.565(c), in accordance with the practice set forth at MPEP § 2283.

Preliminary Matters

On March 18, 2004, in the '411 proceeding, the examiner promulgated a non-final Office action in which a two month shortened statutory period for filing a reply was set and continues to run. Extensions of time to that action can only be obtained pursuant to 37 CFR 1.550(c). On January 22, 2004, the examiner issued an Order granting the request for reexamination in the '881 proceeding. The time for filing a patent owner's statement in the '881 proceeding was set at two months pursuant to 37 CFR 1.535, and the time for filing the owner's statement has expired.

Merger of Copending Reexamination Proceedings

I. Merger of Proceedings

As required by the practice pursuant to MPEP § 2283, and under the authority of 37 CFR 1.565(c), the 90/006,411 reexamination proceeding and the 90/006,881 reexamination proceeding are hereby MERGED. The merged proceeding will be conducted in accordance with the following guidelines and requirements. This Corrected Decision replaces paper No. 18, the Decision mailed on May 5, 2004.

II. Requirement for Same Amendments in Both Proceedings

Patent owner is required to maintain identical claims, drawings and specifications in both files. The contents of each file will hereafter be maintained identically, and all actions promulgated and papers filed subsequent to this Corrected Decision will bear the same paper number. This Corrected Decision is paper No. 19 in both files. There will be no paper Nos. 9-17 in Control No. 90/006,881.

III. Housekeeping Amendment

As discussed above, owner is required to file a reply to the outstanding Office action in the '411 proceeding. The period for filing that reply remains as set therein, and may only be extended pursuant to 37 CFR 1.550(c). Owner is **required** to file a housekeeping amendment in control No. 90/006,881 making the claims therein identical to the claims in the '881 proceeding, as well as making the specification and drawings in the '881 proceeding identical to the specification and drawings in the '411 proceeding if amendments to these items have also been made during the prosecution to date.

If patent owner files the reply in the '411 proceeding without requesting an extension of time, that paper will be paper No. 20 in the '411 proceeding. In the '881 proceeding, Owner should then file a housekeeping amendment as discussed in the immediately proceeding paragraph, which incorporates the changes (if any) made in the reply filed in the '411 proceeding together with any other changes necessary to make the specification, claims and drawings identical in both proceedings. The housekeeping amendment will then be paper No. 20 in the '881 proceeding.

If patent owner requests an extension of time in the '411 proceeding, then a duplicate copy of the request must be filed in the '881 proceeding. The request for extension of time will be entered as paper No. 20 in each proceeding, and if granted, the Decision granting the request will set a period of time in which the reply in the '411 proceeding and the housekeeping amendment in the '881 proceeding must both be filed. **In the absence of a granted request for extension of time in the '411 proceeding, owner is required to file the housekeeping amendment not later than ONE MONTH from the date of this decision.** Attention is invited to MPEP § 2282, subsection entitled "Merger of Reexaminations", last paragraph.

IV. Conduct of Merged Proceeding

All letters mailed by the Office will take the form of a single combined action which applies to both proceedings, and which will cross-reference the two proceedings. A separate action cover form for each proceeding will be printed by the PALM printer for each of the two reexamination control numbers. Owner will receive one copy of the body of the action, and a copy of the cover sheet (*e.g.* Form PTO-466) for the action from both proceedings. Each requester will receive a copy of the body of the action and a copy of the cover sheet for the proceeding filed by that requester. All papers filed by owner **subsequent to** the items in Section III above will contain the identifying data for **both** files and will be physically entered in each reexamination file. All such papers **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" claims and paragraphs in which specification amendments are requested are to be filed, together with material satisfying the requirements of 37 CFR 1.530(e).** All words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets. New drawing figures must be labeled "New", while amended drawing figures must be labeled "Amended".

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. 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 papers. Unless an extension of time is requested and granted in both proceedings, the reply in the '411 proceeding must be filed not later than May 18, 2004, and the housekeeping amendment **must** be filed **not later than one month from the date of this Corrected Decision.**

E. Rollins-Cross, Director
Technology Center 3700

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,411	10/11/2002	6412628	13345.55USAA	3298

7590 05/05/2004

Thomas C. Wettach
Cohen & Grigsby, P. C.
11 Stanwix Street, 15th Floor
Pittsburgh, PA 15222

EXAMINER
LUONG

ART UNIT	PAPER NUMBER
3728	18

DATE MAILED: 05/05/2004

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

UNITED STATES PATENT AND TRADEMARK OFFICE

MAY 15 2004

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No. 18

Cohen & Grigsby, P.C. 11 Stanwix Street, 15th Floor Pittsburgh, PA 15222	For Patent Owner
Kate DeVries Smith Merchant & Gould, P.C. P.O. Box 2903 Minneapolis, MN 55402-0902	For Requester
Natalie D. Kadievitch Fredrikson & Byron, P.A. 4000 Pillsbury Ctr. 200 S. 6th Street Minneapolis, MN 55402-1425	
In re Reexamination Control No. 90/006,411 Request Filed: October 11, 2002 U.S. Patent No. 6,412,628 Issued: July 2, 2002 Patentee: Tramposch	DECISION, *SUA SPONTE*, MERGING REEXAMINATION PROCEEDINGS
In re Reexamination Control No. 90/006,881 Request Filed: December 5, 2003 For: U.S. Patent No. 6,412,628 Issued: July 2, 2002 Patentee: Tramposch	

The above noted reexamination files are before the Director of Patent Examining Group 3700 for consideration of merger of the proceedings under 37 CFR 1.565(c), in accordance with the practice set forth at MPEP § 2283.

Preliminary Matters

On January 13, 2004, in the '411 proceeding, the examiner promulgated a non-final Office action in which a two month shortened statutory period for filing a reply was set and continues to run.. Extensions of time to that action can only be obtained pursuant to 37 CFR 1.550(c). On January 22, 2004, the examiner issued an Order granting the request for reexamination in the '881 proceeding. The time for filing a patent owner's statement in the '881 proceeding was set at two months pursuant to 37 CFR 1.535, and the time for filing the owner's statement has expired.

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II. Requirement for Same Amendments in Both Proceedings

Patent owner is required to maintain identical claims, drawings and specifications in both files. The contents of each file will 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. 18 in both files. There will be no paper Nos. 9-17 in Control No. 90/006,881.

III. Housekeeping Amendment

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If patent owner files the reply in the '411 proceeding without requesting an extension of time, that paper will be paper No. 19 in the '411 proceeding. In the '881 proceeding, Owner should then file a housekeeping amendment as discussed in the immediately proceeding paragraph, which incorporates the changes (if any) made in the reply filed in the '411 proceeding together with any other changes necessary to make the specification, claims and drawings identical in both proceedings. The housekeeping amendment will then be paper No. 19 in the '881 proceeding.

If patent owner requests an extension of time in the '411 proceeding, then a duplicate copy of the request must be filed in the '881 proceeding. The request for extension of time will be entered as paper No. 19 in each proceeding, and if granted, the Decision granting the request will set a period of time in which the reply in the '411 proceeding and the housekeeping amendment in the '881 proceeding must both be filed. **In the absence of a granted request for extension of time in the '411 proceeding, owner is required to file the housekeeping amendment not later than ONE MONTH from the date of this decision.** Attention is invited to MPEP § 2282, subsection entitled "Merger of Reexaminations", last paragraph.

IV. Conduct of Merged Proceeding

All letters mailed by the Office will take the form of a single combined action which applies to both proceedings, and which will cross-reference the two proceedings. A separate action cover form for each proceeding will be printed by the PALM printer for each of the two reexamination control numbers. Owner will receive one copy of the body of the action, and a copy of the cover sheet (*e.g.* Form PTO-466) for the action from both proceedings. Each requester will receive a copy of the body of the action and a copy of the cover sheet for the proceeding filed by that requester. All papers filed by owner **subsequent to** the items in Section III above will contain the identifying data for **both** files and will be physically entered in each reexamination file. All such papers **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" claims and paragraphs in which specification amendments are requested are to be filed, together with material satisfying the requirements of 37 CFR 1.530(e).** All words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets. New drawing figures must be labeled "New", while amended drawing figures must be labeled "Amended".

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. 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 papers. Unless an extension of time is requested and granted in both proceedings, the reply in the '411 proceeding must be filed not later than March 18, 2004, and the housekeeping amendment **must** be filed **not later than one month from the date of this decision.**

E. Rollins Cross, Director
Technology Center 3700

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.
90/006,415	10/15/2002	6375937		4690

23909 7590 03/04/2003

COLGATE-PALMOLIVE COMPANY
909 RIVER ROAD
PISCATAWAY, NJ 08855

EXAMINER

ART UNIT	PAPER NUMBER
	8

DATE MAILED: 03/04/2003

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

COLGATE-PALMOLIVE COMPANY
909 RIVER ROAD
PISCATAWAY NJ 08855

FOR PATENT OWNER

LAWRENCE P. HOBBES
ROBERTS, MLOTKOWSKI & HOBBES
3911 OLD LEE HIGHWAY, SUITE 43B
FAIRFAX, VA 22030

FOR REQUESTER

In re Chopra et al
Reexamination Proceeding
Control No.: 90/006,415
Filed: October 15, 2002
Patent No.: 6,375,937

: DECISION ON PETITION

This is a decision on Patent Owner's Request for a one month Extension of Time filed January 15, 2003.

The Request is **DISMISSED**.

Patent Owner's statement subsequent to the Order granting reexamination was received on February 5, 2003, which is within the two month time period set in the Order.

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.
90/006,415	10/15/2002	6375937		4690

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WASHINGTON, D.C. 20231
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COLGATE-PALMOLIVE COMPANY
909 RIVER ROAD
PISCATAWAY NJ 08855

FOR PATENT OWNER

LAWRENCE P. HOBBES
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John Doll
Director, Technology Center 1600

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Technology Center 2100

Paper No. 25

Mark A. Haynes, Esquire Haynes, Beffel & Wolfield, LLP P.O. Box 336 Half Moon Bay, California 94109	)	**FOR PATENT OWNER**
John C. Phillips Fish and Richardson, P.C. 4350 La Jolla Village Drive Suite 500 San Diego, California 92122	)	**FOR THIRD PARTY REQUESTOR**
In re Reexamination of: U.S. Patent No. 5,872,952 Reexamination Control No. 90/006,431 For: HIERARCHICAL POWER NETWORK SIMULATION AND ANALYSIS TOOL FOR RELIABILITY TESTING OF DEEP SUBMICRON DESIGNS	)	**RESPONSE TO PETITION UNDER 37 CFR §1.59**

This is a response to the petition under 37 CFR 1.181, filed March 31, 2004, requesting supervisory review of the "Requirement for Information under 37 CFR 1.105" of March 8, 2004. Petitioner requests relief in the form of clarification or withdrawal of the requirement.

Patent Owner bases the request for withdrawal of the requirement for information on two lines of argument: (1) requests for information should be limited to information material to patentability as defined in 37 C.F.R. §1.555 and (2) that the information requested is not reasonably necessary to examination of the issues presented, because the scope of a reexamination proceeding is limited to prior art patents and publications.

The petition is **GRANTED** to the extent that the requirement under 37 CFR §1.105 is **modified** and clarified below. Patent Owner is required to file a response on or before July 8, 2004, commensurate with the modified requirement, in compliance with 37 CFR §1.105 and MPEP §704.12.

RECENT RELEVANT PROSECUTION HISTORY

August 25, 2003	-	Examiner issues an Office action rejecting all pending claims. The Office action is accompanied with a Requirement for Information under 37 C.F.R. §1.105. [Paper No. 14]
October 24, 2003	-	Patent Owner files amendment and response. Included therein is a request for reconsideration of the requirement under 37 C.F.R. §1.105 contending that "such information is beyond the proper scope of reexamination." [Paper No. 17]
March 8, 2004	-	New Non-final rejection mailed. Responds to request for reconsideration of the 1.105 requirement for information by characterizing the previous response as not bona-fide and elaborating and clarifying the requirement and the basis for each class of information requested. [Paper No. 21]
March 30, 2004	-	Patent Owner files a petition under 37 C.F.R. §1.181 requesting that the requirement for information under 37 C.F.R. §1.105 be either withdrawn or clarified. [Paper No. 22]

ANALYSIS

A. Relationship of Requirement for Information to Duty of Disclosure

Patent Owner contends that the "requirement for information should be limited to information material to patentability as defined in 37 C.F.R. §1.555" (page 8 of Petition) and states that

> In accordance with the duty of candor, Patent Owner has supplied to the Examiner all information material to the reexamination of which he is aware. The Examiner seeks information beyond the scope of section 1.555(b)...

MPEP 714.12 (a) which addresses the relationship of a requirement for information under 37 CFR §1.105 and applicant's duty of disclosure under 37 CFR § 1.56 states:

> ***In contrast with the applicant's duty to disclose on his or her own initiative information material to patentability under 37 CFR 1.56, the Office has the authority to require information reasonably necessary to the examination or treatment of a matter in an application. Such information may not be considered material to patentability by applicant, hence applicant would not be required to provide the information under 37 CFR 1.56.***

The duty of disclosure thus is seen not to be commensurate with the information an Examiner may require under 37 CFR §1.105. The only substantive difference between the duty of disclosure for examination of patent applications (under rule 56) and the duty of disclosure in reexamination proceedings (under rule 555) is that in reexamination information which might establish *prima facie* unpatentability but is not a printed publication is not subject to the duty of disclosure. (Compare 37 CFR 1.56(b)(1) and 37 CFR 1.555(b)(1).).

Therefore, the discussion in MPEP 704.12(a) cited above applies to reexamination as well and the Examiner may request information under 37 CFR 1.105 beyond that which applicant is required to disclose voluntarily under 37 CFR 1.555.

In the specific objections to the individual requirements made by the Examiner, Patent Owner repeatedly relies on assertions that the information requested is not material to examination because it meets neither 1.555(b)(1) or 1.555(b)(2). These arguments are not persuasive as they seek to apply a more restrictive standard than is appropriate in the context of 37 CFR 1.105.

B. Scope of Reexamination

Patent Owner argues that the scope of the requirement for information should be restricted to the issues that fall within the scope of the reexamination. (Page 9 of petition)

37 CFR 1.105 states that the Examiner "may require the submission, from individuals identified under §1.56(c), or any assignee, ***of such information as may be reasonably necessary to properly examine or treat the matter***" [Emphasis added]. Thus, by implication, the Examiner may not require information which is ***not reasonably necessary***. To the extent that the information requested can not reasonably lead to information which can be considered in a reexamination proceeding, the request is improper.

This does not mean that only prior art publications may be requested. A simple review of the categories of information catalogued in the rule reveals that the rule is not directed solely to developing the basis of rejections but to information which is of material assistance to the Examiner in examining the application. Thus, for example information on whether a search was made and materials used in drafting the application may be requested despite the fact that neither may qualify as prior art or otherwise be usable to reject a claim.

OPINION

For convenience and consistency, this communication adopts Patent Owner's numbering of the elements of the request for information.

i. **Items 1-3: Inventorship and Ownership**

The affidavit under 37 CFR §1.132 does not adequately address derivation [See MPEP 715.01(c)] or attribution [See MPEP 716.10] : it says "it describes our invention" but does not indicate whether he (and his co-inventor) were the source of the documents.

The declaration makes the following assertions:

(a) The invention was made when applicants were at Epic Design;

(b) Declarant and co-inventor created Railmill and integrated Railmill and ChipViewer;

and

(c) Arcadia manual produced by Archer systems. " to the extent these documents describe [refer to] Railmill and the use of ChipViewer to display the outputs from Railmill, they [it] describe[s] our invention, and the work of our team at Epic...".

Note that statement (c) is conclusory in nature with no evidence or statement of facts to support it. Furthermore, there is no claim or explanation of derivation or attribution on the part of the authors/publishers of the references. This is of particular concern because there is no indication that declarant is a co-author of any of the references.

In any event, Patrick Ho has admitted that ChipViewer was not his invention and that he is not the author of the Arcadia Manual or the Railmill documents. Patent Owner amended the claims to be limited to(1) ***Railmill*** and the (2) **integration of Railmill and ChipViewer,** which is what Patrick Ho identifies in the declaration as his invention.

Which companies developed which products is not relevant to the Reexamination. The ability to remove art available under 102(e), (f), or (g) by a statement of common ownership at the time of invention is not available in this reexamination because the application was filed prior to November 29, 1999. This is reflected in the modified requirement under 37 CFR §1.105 presented below.

Therefore, insofar as any of the Arcadia, Railmill, ChipViewer, PathMill, PowerMill or TimeMill documents qualify as prior art printed publications they are available to the Examiner as the bases of rejections under 35 U.S.C. §§102 and 103. The Examiner must explain the basis for treating any of these documents as prior art printed publications. Should Patent Owner successfully controvert the Examiner's conclusion that any of the individual references is a prior art printed publication or attribute any of these references to the inventors of the '952 patent, the Examiner would be required to forego the use of the particular reference.

ii. **Items 4-7: Software Implementations and Documentation**

Patent Owner states " .. The examiner has no authority to engage in a fact-finding endeavor to establish the existence of a public use under 35 U.S.C. 102(b) during a reexamination proceeding".

This is correct. To the extent that the original requirement could be interpreted to request materials solely related to public use the requirement is **withdrawn**.

The requirement, as modified herein, is not directed to uncovering possible public use. The requirement is limited to printed publications. This includes promotional materials in the appropriate date range. The examiner makes the initial determination as to whether a document qualifies as a ***prior art printed publication***. Patent Owner can then traverse any holding by the Examiner with which he disagrees. Patent Owner is not entitled to unilaterally decide that such written materials do not qualify as printed publications and refuse to provide such papers in response to the requirement for information.

DECISION

The petition is **GRANTED** to the extent that the requirement under 37 CFR §1.105 is **modified** and clarified below. Patent Owner is required to file a response on or before July 8, 2004, commensurate with the modified requirement, in compliance with 37 CFR §1.105 and MPEP §704.12.

D. Requirement for Information under 37 CFR §1.105

I. The requirements for (1) identification of which inventor is responsible for which claims, (2) a listing of all persons responsible for the development of Arcadia, Railmill, PowerMill, TimeMill and ChipViewer, and (3) when Archer and Epic were acquired by Synopsis are **WITHDRAWN.**

II. Patent Owner is required to provide all printed matter containing information on PathMill, PowerMill, Railmill, TimeMill, and ChipViewer which were disclosed prior to February 1995. This includes user manuals and tutorials which may have been distributed product CDS. [This combines and modifies items 4-7 of the requirement being petitioned] ***Versions of the actual software are not part of the requirement.***

CONCLUSION

The undersigned notes that Patent Owner's previous responses to the requirements were deficient. In response to the first request Patent Owner stated " To the extent we are aware of **material** patents and printed publications, they have already been provided." [Emphasis added. Page 12 of the response filed 24 October 2003, Paper 17] Because it was not clear precisely what Patent Owner meant to exclude (if anything) by the use of the word "material" the Examiner issued a further clarified requirement in the next Office action of mail date March 8, 2004. The instant petition filed in response to the repeated requirement for information makes it clear that patent Owner is using "material" as

understood in the duty of disclosure requirement. The patent Owner is hereby advised any future response which restricts itself to information required to be disclosed under 37 CFR §1.555 will be held not to be compliant with 37 CFR §1.105(a)(3).

Any inquiry with respect to this decision may be directed to Special Programs Examiner Pinchus M. Laufer at (703) 306-4160

Peter S. Wong, Group Director
Technology Center 2100
Computer Architecture, Software, and Information Security

BASIS OF THE DECISION

The relevant sections of M.P.E.P. §704 and of 37 C.F.R. §1.105 which relate to this petition are reproduced below. Emphasis is added to draw attention to the critical phrases.

37 C.F.R. § 1.105 Requirements for information.

(a) (1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee ***may require the submission***, from individuals identified under § 1.56(c), or any assignee, ***of such information as may be reasonably necessary to properly examine or treat the matter***, for example:

(i) *Commercial databases* : The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.

(ii) *Search :* Whether a search of the prior art was made, and if so, what was searched.

(iii) *Related information :* A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.

(iv) *Information used to draft application :* A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

(v) *Information used in invention process :* A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) *Improvements :* Where the claimed invention is an improvement, identification of what is being improved.

(vii) *In Use :* Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(i), (iii), and (vii) of this section may also be applied to such assignee.

(3) Any reply that states that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested will be accepted as a complete reply.

(b) The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

(c) A reply, or a failure to reply, to a requirement for information under this section will be governed by §§ 1.135 and 1.136.

[Removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec.1, 1997; added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

MPEP § 704.11 What Information May Be Required

...

There must be a ***reasonable basis*** for the information required that would aid in the examination of an application or treatment of some matter. A requirement for information under 37 CFR §1.105 places a substantial burden on the applicant that is to be minimized by clearly focusing the reason for the requirement and the scope of the expected response. Thus, the scope of the requirement should be narrowly defined, and a requirement under 37 CFR§1.105 may only be made when the examiner has a reasonable basis for requiring information.

MPEP § 704.12 Replies to a Requirement for Information

Replies to requirements for information must be complete and filed within the time period set including any extensions. Failure to reply within the time period set will result in the abandonment of the application. All replies for a request for information should be checked for completeness. Any incomplete reply can be completed within the original time period set including any extensions. Supplemental replies filed after the expiration of the original period for reply including any extensions of time must comply with all other rules for submissions of information.

MPEP § 704.12(a) Relationship of Requirement for Information to Duty of Disclosure

The duty of candor and good faith under 37 CFR 1.56 applies to the applicant's reply to a requirement for information under 37 CFR 1.105, and requires that the applicant reply to a requirement under 37 CFR 1.105 with information reasonably and readily available.

37 CFR §1.56 requires parties identified in 37 CFR 1.56(c) to disclose to the Office information material to the patentability of the claimed subject matter. This threshold is substantially higher than that for requiring information under 37 CFR 1.105, which is reasonable necessity to the examination of the application.

In contrast with the applicant's duty to disclose on his or her own initiative information material to patentability under 37 CFR 1.56, the Office has the authority to require information reasonably necessary to the examination or treatment of a matter in an application. Such information may not

be considered material to patentability by applicant, hence applicant would not be required to provide the information under 37 CFR 1.56. The information is instead reasonably necessary to determine the state of the art, the context in which the invention is practiced, the directions in which the relevant art are advancing, the similarity between the claimed subject matter and other art worked on by the applicants and their assignees or to otherwise proceed in the examination and treatment of matters in an application.

Similar to 37 CFR 1.56, applicant is required by 37 CFR 1.105 to submit information already known, but there is no requirement to search for information that is unknown. Unlike 37 CFR 1.56, applicant is required by 37 CFR 1.105 to submit information that may not be material to patentability in itself, but that is necessary to obtain a complete record from which a determination of patentability may be determined.

MPEP § 704.12(b) What Constitutes a Complete Reply

A complete reply to a 37 CFR 1.105 requirement is a reply to each enumerated requirement for information giving either the information required or a statement that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested. There is no requirement for the applicant to show that the required information was not, in fact, readily attainable, but applicant is required to make a good faith attempt to obtain the information and to make a reasonable inquiry once the information is requested.

A reply stating that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested will generally be sufficient unless, for example, it is clear the applicant did not understand the requirement, or the reply was ambiguous and a more specific answer is possible.

MPEP § 704.14 Making a Requirement for Information

A requirement for information under 37 CFR 1.105 ***should be narrowly specified and limited in scope.*** It is a significant burden on both the applicant and the Office since the applicant must collect and submit the required information and the examiner must consider all the information that is submitted. A requirement for information is only warranted where the benefit from the information exceeds the burden in obtaining information.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,431	10/30/2002	5872952	13208-009001	9825

22470 7590 07/08/2004

HAYNES BEFFEL & WOLFELD LLP
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EXAMINER
JONES, HUGH

ART UNIT	PAPER NUMBER
2128	28

DATE MAILED: 07/08/2004

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Paper No. 28

Mark A. Haynes, Esquire Haynes, Beffel & Wolfield, LLP P.O. Box 336 Half Moon Bay, California 94109	))))	**FOR PATENT OWNER**
John C. Phillips Fish and Richardson, P.C. 4350 La Jolla Village Drive Suite 500 San Diego, California 92122	)))))	**FOR THIRD PARTY REQUESTOR**
In re Reexamination of: U.S. Patent No. 5,872,952 Reexamination Control No. 90/006,431 For: INTEGRATED CIRCUIT POWER NET ANALYSIS THROUGH SIMULATION	)))))))	**RESPONSE TO PETITION UNDER 37 CFR §1.59**

This is a response to the petition under 37 CFR 1.59(b), filed July 8, 2004, to expunge information from the above identified application.

Petitioner requests that documents submitted which are proprietary and considered to be trade secrets, filed July 8, 2004, be expunged from the record. The petition fee set forth in 37 CFR 1.17(h) has been charged to Deposit account No. 50-0869 as directed by Mark A. Haynes in a telephone call with the undersigned on July 8, 2004.

The petition is **DISMISSED**.

Relevant parts of the M.P.E.P. which relate to this petition are reproduced below.

724.05 Petition To Expunge Information or Copy of Papers in Application File

I. INFORMATION SUBMITTED UNDER MPEP § 724.02

A petition under 37 CFR 1.59(b) to expunge information ... If the information is found to be important to a reasonable examiner in deciding on patentability, any petition to expunge the information will be denied. Any such petition to expunge information submitted under MPEP § 724.02 should be submitted at the time of filing the information under MPEP § 724.02 and directed to the Technology Center (TC) to which the application is assigned. Such petition must contain:

...

(B) a clear statement that the information to be expunged is trade secret material, proprietary material, and/or subject to a protective order, and that the information has not been otherwise made public;

(C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;

... it is important that both the submission of any material under MPEP § 724.02 and the submission of any petition to expunge occur as early as possible during the examination process.

A decision on the petition is ***premature*** 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 petition to expunge must be dismissed at this time.

During prosecution on the merits, the examiner will determine whether or not the identified document is considered to be "material." ***Once prosecution on the merits is closed, applicant may re-submit a petition to expunge the information.*** No further fee is required for such a second submission of a petition under 37 CFR 1.59 to expunge information. If the information is <u>not</u> considered by the examiner to be material, the information will be expunged from the file.

Inquiries with respect to this decision may be directed to Pinchus M. Laufer at (703) 306-4160.

Pinchus M. Laufer

Pinchus M. Laufer
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security
(703) 306-4160

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JUN 0 4 2004

Technology Center 2100

Paper No. 25

Mark A. Haynes, Esquire Haynes, Beffel & Wolfield, LLP P.O. Box 336 Half Moon Bay, California 94109	)	**FOR PATENT OWNER**
John C. Phillips Fish and Richardson, P.C. 4350 La Jolla Village Drive Suite 500 San Diego, California 92122	)	**FOR THIRD PARTY REQUESTOR**
In re Reexamination of: U.S. Patent No. 5,872,952 Reexamination Control No. 90/006,431 For: HIERARCHICAL POWER NETWORK SIMULATION AND ANALYSIS TOOL FOR RELIABILITY TESTING OF DEEP SUBMICRON DESIGNS	)	**RESPONSE TO PETITION UNDER 37 CFR §1.59**

This is a response to the petition under 37 CFR 1.181, filed March 31, 2004, requesting supervisory review of the "Requirement for Information under 37 CFR 1.105" of March 8, 2004. Petitioner requests relief in the form of clarification or withdrawal of the requirement.

Patent Owner bases the request for withdrawal of the requirement for information on two lines of argument: (1) requests for information should be limited to information material to patentability as defined in 37 C.F.R. §1.555 and (2) that the information requested is not reasonably necessary to examination of the issues presented, because the scope of a reexamination proceeding is limited to prior art patents and publications.

The petition is **GRANTED** to the extent that the requirement under 37 CFR §1.105 is **modified** and clarified below. Patent Owner is required to file a response on or before July 8, 2004, commensurate with the modified requirement, in compliance with 37 CFR §1.105 and MPEP §704.12.

RECENT RELEVANT PROSECUTION HISTORY

August 25, 2003	-	Examiner issues an Office action rejecting all pending claims. The Office action is accompanied with a Requirement for Information under 37 C.F.R. §1.105. [Paper No. 14]
October 24, 2003	-	Patent Owner files amendment and response. Included therein is a request for reconsideration of the requirement under 37 C.F.R. §1.105 contending that "such information is beyond the proper scope of reexamination." [Paper No. 17]
March 8, 2004	-	New Non-final rejection mailed. Responds to request for reconsideration of the 1.105 requirement for information by characterizing the previous response as not bona-fide and elaborating and clarifying the requirement and the basis for each class of information requested. [Paper No. 21]
March 30, 2004	-	Patent Owner files a petition under 37 C.F.R. §1.181 requesting that the requirement for information under 37 C.F.R. §1.105 be either withdrawn or clarified. [Paper No. 22]

ANALYSIS

A. Relationship of Requirement for Information to Duty of Disclosure

Patent Owner contends that the "requirement for information should be limited to information material to patentability as defined in 37 C.F.R. §1.555" (page 8 of Petition) and states that

> In accordance with the duty of candor, Patent Owner has supplied to the Examiner all information material to the reexamination of which he is aware. The Examiner seeks information beyond the scope of section 1.555(b)...

MPEP 714.12 (a) which addresses the relationship of a requirement for information under 37 CFR §1.105 and applicant's duty of disclosure under 37 CFR § 1.56 states:

> ***In contrast with the applicant's duty to disclose on his or her own initiative information material to patentability under 37 CFR 1.56, the Office has the authority to require information reasonably necessary to the examination or treatment of a matter in an application. Such information may not be considered material to patentability by applicant, hence applicant would not be required to provide the information under 37 CFR 1.56.***

The duty of disclosure thus is seen not to be commensurate with the information an Examiner may require under 37 CFR §1.105. The only substantive difference between the duty of disclosure for examination of patent applications (under rule 56) and the duty of disclosure in reexamination proceedings (under rule 555) is that in reexamination information which might establish *prima facie* unpatentability but is not a printed publication is not subject to the duty of disclosure. (Compare 37 CFR 1.56(b)(1) and 37 CFR 1.555(b)(1).).

Therefore, the discussion in MPEP 704.12(a) cited above applies to reexamination as well and the Examiner may request information under 37 CFR 1.105 beyond that which applicant is required to disclose voluntarily under 37 CFR 1.555.

In the specific objections to the individual requirements made by the Examiner, Patent Owner repeatedly relies on assertions that the information requested is not material to examination because it meets neither 1.555(b)(1) or 1.555(b)(2). These arguments are not persuasive as they seek to apply a more restrictive standard than is appropriate in the context of 37 CFR 1.105.

B. Scope of Reexamination

Patent Owner argues that the scope of the requirement for information should be restricted to the issues that fall within the scope of the reexamination. (Page 9 of petition)

37 CFR 1.105 states that the Examiner "may require the submission, from individuals identified under §1.56(c), or any assignee, ***of such information as may be reasonably necessary to properly examine or treat the matter***" [Emphasis added]. Thus, by implication, the Examiner may not require information which is ***not reasonably necessary***. To the extent that the information requested can not reasonably lead to information which can be considered in a reexamination proceeding, the request is improper.

This does not mean that only prior art publications may be requested. A simple review of the categories of information catalogued in the rule reveals that the rule is not directed solely to developing the basis of rejections but to information which is of material assistance to the Examiner in examining the application. Thus, for example information on whether a search was made and materials used in drafting the application may be requested despite the fact that neither may qualify as prior art or otherwise be usable to reject a claim.

OPINION

For convenience and consistency, this communication adopts Patent Owner's numbering of the elements of the request for information.

i. **Items 1-3: Inventorship and Ownership**

The affidavit under 37 CFR §1.132 does not adequately address derivation [See MPEP 715.01(c)] or attribution [See MPEP 716.10] : it says "it describes our invention" but does not indicate whether he (and his co-inventor) were the source of the documents.

The declaration makes the following assertions:

(a) The invention was made when applicants were at Epic Design;

(b) Declarant and co-inventor created Railmill and integrated Railmill and ChipViewer;

and

(c) Arcadia manual produced by Archer systems. " to the extent these documents describe [refer to] Railmill and the use of ChipViewer to display the outputs from Railmill, they [it] describe[s] our invention, and the work of our team at Epic...".

Note that statement (c) is conclusory in nature with no evidence or statement of facts to support it. Furthermore, there is no claim or explanation of derivation or attribution on the part of the authors/publishers of the references. This is of particular concern because there is no indication that declarant is a co-author of any of the references.

In any event, Patrick Ho has admitted that ChipViewer was not his invention and that he is not the author of the Arcadia Manual or the Railmill documents. Patent Owner amended the claims to be limited to(1) ***Railmill*** and the (2) **integration of Railmill and ChipViewer,** which is what Patrick Ho identifies in the declaration as his invention.

Which companies developed which products is not relevant to the Reexamination. The ability to remove art available under 102(e), (f), or (g) by a statement of common ownership at the time of invention is not available in this reexamination because the application was filed prior to November 29, 1999. This is reflected in the modified requirement under 37 CFR §1.105 presented below.

Therefore, insofar as any of the Arcadia, Railmill, ChipViewer, PathMill, PowerMill or TimeMill documents qualify as prior art printed publications they are available to the Examiner as the bases of rejections under 35 U.S.C. §§102 and 103. The Examiner must explain the basis for treating any of these documents as prior art printed publications. Should Patent Owner successfully controvert the Examiner's conclusion that any of the individual references is a prior art printed publication or attribute any of these references to the inventors of the '952 patent, the Examiner would be required to forego the use of the particular reference.

ii. **Items 4-7: Software Implementations and Documentation**

Patent Owner states " .. The examiner has no authority to engage in a fact-finding endeavor to establish the existence of a public use under 35 U.S.C. 102(b) during a reexamination proceeding".

This is correct. To the extent that the original requirement could be interpreted to request materials solely related to public use the requirement is **withdrawn**.

The requirement, as modified herein, is not directed to uncovering possible public use. The requirement is limited to printed publications. This includes promotional materials in the appropriate date range. The examiner makes the initial determination as to whether a document qualifies as a ***prior art printed publication***. Patent Owner can then traverse any holding by the Examiner with which he disagrees. Patent Owner is not entitled to unilaterally decide that such written materials do not qualify as printed publications and refuse to provide such papers in response to the requirement for information.

DECISION

The petition is **GRANTED** to the extent that the requirement under 37 CFR §1.105 is **modified** and clarified below. Patent Owner is required to file a response on or before July 8, 2004, commensurate with the modified requirement, in compliance with 37 CFR §1.105 and MPEP §704.12.

D. Requirement for Information under 37 CFR §1.105

I. The requirements for (1) identification of which inventor is responsible for which claims, (2) a listing of all persons responsible for the development of Arcadia, Railmill, PowerMill, TimeMill and ChipViewer, and (3) when Archer and Epic were acquired by Synopsis are **WITHDRAWN.**

II. Patent Owner is required to provide all printed matter containing information on PathMill, PowerMill, Railmill, TimeMill, and ChipViewer which were disclosed prior to February 1995. This includes user manuals and tutorials which may have been distributed product CDS. [This combines and modifies items 4-7 of the requirement being petitioned] ***Versions of the actual software are not part of the requirement.***

CONCLUSION

The undersigned notes that Patent Owner's previous responses to the requirements were deficient. In response to the first request Patent Owner stated " To the extent we are aware of **material** patents and printed publications, they have already been provided." [Emphasis added. Page 12 of the response filed 24 October 2003, Paper 17] Because it was not clear precisely what Patent Owner meant to exclude (if anything) by the use of the word "material" the Examiner issued a further clarified requirement in the next Office action of mail date March 8, 2004. The instant petition filed in response to the repeated requirement for information makes it clear that patent Owner is using "material" as

understood in the duty of disclosure requirement. The patent Owner is hereby advised any future response which restricts itself to information required to be disclosed under 37 CFR §1.555 will be held not to be compliant with 37 CFR §1.105(a)(3).

Any inquiry with respect to this decision may be directed to Special Programs Examiner Pinchus M. Laufer at (703) 306-4160

Peter S. Wong, Group Director
Technology Center 2100
Computer Architecture, Software, and Information Security

BASIS OF THE DECISION

The relevant sections of M.P.E.P. §704 and of 37 C.F.R. §1.105 which relate to this petition are reproduced below. Emphasis is added to draw attention to the critical phrases.

37 C.F.R. § 1.105 Requirements for information.

(a) (1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee ***may require the submission***, from individuals identified under § 1.56(c), or any assignee, ***of such information as may be reasonably necessary to properly examine or treat the matter***, for example:

(i) *Commercial databases* : The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.

(ii) *Search :* Whether a search of the prior art was made, and if so, what was searched.

(iii) *Related information :* A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.

(iv) *Information used to draft application :* A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

(v) *Information used in invention process :* A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) *Improvements :* Where the claimed invention is an improvement, identification of what is being improved.

(vii) *In Use :* Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(i), (iii), and (vii) of this section may also be applied to such assignee.

(3) Any reply that states that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested will be accepted as a complete reply.

(b) The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

(c) A reply, or a failure to reply, to a requirement for information under this section will be governed by §§ 1.135 and 1.136.

[Removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec.1, 1997; added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

MPEP § 704.11 What Information May Be Required

...

There must be a ***reasonable basis*** for the information required that would aid in the examination of an application or treatment of some matter. A requirement for information under 37 CFR §1.105 places a substantial burden on the applicant that is to be minimized by clearly focusing the reason for the requirement and the scope of the expected response. Thus, the scope of the requirement should be narrowly defined, and a requirement under 37 CFR§1.105 may only be made when the examiner has a reasonable basis for requiring information.

MPEP § 704.12 Replies to a Requirement for Information

Replies to requirements for information must be complete and filed within the time period set including any extensions. Failure to reply within the time period set will result in the abandonment of the application. All replies for a request for information should be checked for completeness. Any incomplete reply can be completed within the original time period set including any extensions. Supplemental replies filed after the expiration of the original period for reply including any extensions of time must comply with all other rules for submissions of information.

MPEP § 704.12(a) Relationship of Requirement for Information to Duty of Disclosure

The duty of candor and good faith under 37 CFR 1.56 applies to the applicant's reply to a requirement for information under 37 CFR 1.105, and requires that the applicant reply to a requirement under 37 CFR 1.105 with information reasonably and readily available.

37 CFR §1.56 requires parties identified in 37 CFR 1.56(c) to disclose to the Office information material to the patentability of the claimed subject matter. This threshold is substantially higher than that for requiring information under 37 CFR 1.105, which is reasonable necessity to the examination of the application.

In contrast with the applicant's duty to disclose on his or her own initiative information material to patentability under 37 CFR 1.56, the Office has the authority to require information reasonably necessary to the examination or treatment of a matter in an application. Such information may not

be considered material to patentability by applicant, hence applicant would not be required to provide the information under 37 CFR 1.56. The information is instead reasonably necessary to determine the state of the art, the context in which the invention is practiced, the directions in which the relevant art are advancing, the similarity between the claimed subject matter and other art worked on by the applicants and their assignees or to otherwise proceed in the examination and treatment of matters in an application.

Similar to 37 CFR 1.56, applicant is required by 37 CFR 1.105 to submit information already known, but there is no requirement to search for information that is unknown. Unlike 37 CFR 1.56, applicant is required by 37 CFR 1.105 to submit information that may not be material to patentability in itself, but that is necessary to obtain a complete record from which a determination of patentability may be determined.

MPEP § 704.12(b) What Constitutes a Complete Reply

A complete reply to a 37 CFR 1.105 requirement is a reply to each enumerated requirement for information giving either the information required or a statement that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested. There is no requirement for the applicant to show that the required information was not, in fact, readily attainable, but applicant is required to make a good faith attempt to obtain the information and to make a reasonable inquiry once the information is requested.

A reply stating that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested will generally be sufficient unless, for example, it is clear the applicant did not understand the requirement, or the reply was ambiguous and a more specific answer is possible.

MPEP § 704.14 Making a Requirement for Information

A requirement for information under 37 CFR 1.105 ***should be narrowly specified and limited in scope.*** It is a significant burden on both the applicant and the Office since the applicant must collect and submit the required information and the examiner must consider all the information that is submitted. A requirement for information is only warranted where the benefit from the information exceeds the burden in obtaining information.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,431	10/30/2002	5872952	13208-009001	9825

22470 7590 06/28/2005

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/28/2005

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John C. Phillips
FISH and RICHARDSON, P.C.
12390 El Camino Real
San Diego, California 92130

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/006,431*.

PATENT NO. *5,872,953*.

ART UNIT *2128*.

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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FOR PATENT OWNER

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FOR THIRD PARTY RREQUESTER

In re Reexamination of:
U.S. Patent No. 5,872,953
Reexamination Control No. 90/006,431
Filed: October 30, 2002
For: INTEGRATED POWER NET ANALYSIS THROUGH SIMULATION

DECISION ON PETITION UNDER 37 § CFR 1.59

This is a decision on the petition under 37 CFR § 1.59(b), filed June 24, 2005 to expunge information submitted pursuant to MPEP § 724.02.

The petition is **GRANTED**.

Petitioner requests that the documents entitled "EPIC Tools User Manual 3.1", "PathMill User Manual 3.1", "PowerMill Quick Reference Guide 3.1", "PowerMill User Manual, Version 3.1", "TimeMill Reference Manual 2.7", "TimeMill Quick Reference Guide 3.1" and "TimeMill User Manual 3.1"submitted on 08 July 2004 be expunged from the record. Petitioner states that the information contains materials that are subject to a proprietary and trade secret which have not been made public. The petition fee set forth in 37 CFR 1.17(h) has been paid.

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

Patent Owner is required to retain the expunged material(s) for the life of the patent.

Vincent N. Trans
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security
(571) 272-3613

UNITED STATES PATENT AND TRADEMARK OFFICE

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Mark A. Haynes, Esquire Haynes, Beffel & Wolfield, LLP P.O. Box 336 Half Moon Bay, California 94109	))))	**FOR PATENT OWNER**
John C. Phillips Fish and Richardson, P.C. 12390 El Camino Real San Diego, California 92130-3081	))))	**FOR THIRD PARTY REQUESTOR**
In re Reexamination of: U.S. Patent No. 5,872,952 Reexamination Control No. 90/006,~~331~~ 431 For: INTEGRATED CIRCUIT POWER NET ANALYSIS THROUGH SIMULATION	)))))))	**RESPONSE TO PETITION UNDER 37 CFR §1.181**

This is a response to the petition under 37 CFR 1.181, filed January 5, 2005 to invoke supervisory review with respect to a requirement to label drawings as prior art.

In an Office action mailed September 15, 2004, the Examiner maintained a requirement for Patent Owner to label various original patent drawings as "Prior Art". This requirement was previously made and Patent Owner timely requested reconsideration from the Examiner.

37 CFR §1.552 which details the scope of reexamination in ex parte reexamination proceeding provides in relevant part:

> (a) Claims in an ex parte reexamination proceeding will be examined ***on the basis of patents or printed publications*** and, with respect to subject matter added or deleted in the reexamination proceeding, on the basis of the requirements of 35 U.S.C. 112.
>
> (b) Claims in an ex parte reexamination proceeding will not be permitted to enlarge

the scope of the claims of the patent.

(c) ***Issues other than those indicated in paragraphs (a) and (b) of this section will not be resolved in a reexamination proceeding. ...***

Accordingly, the proper labeling of a figure is not within the scope of the reexamination proceeding. The examiner may not raise such issues nor require Patent Owner to respond to such a requirement.

The petition is **GRANTED**. The requirement to label the figures is **WITHDRAWN**. The Examiner is directed to acknowledge this in the next Office communication.

Inquiries with respect to this decision may be directed to Pinchus M. Laufer at (571) 272-3599.

Pinchus M. Laufer
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security
(571) 272-3599

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,433	10/31/2002		31522-01	1118

55268 7590 02/07/2008
THE ADAMS LAW FIRM
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ALBUQUERQUE, NM 87104

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ART UNIT	PAPER NUMBER
3633	

MAIL DATE	DELIVERY MODE
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The time period for reply, if any, is set in the attached communication.

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Reexamination Control No. 90/006,433

FEB 07 2008

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Albuquerque, NM 87104

DECISION ON PETITION TO MAKE APPLICATION SPECIAL UNDER 37 CFR 1.102

This is a decision on the petition filed on August 20, 2007 to make the above-identified Reexamination proceeding special for Infringement under 37 C.F.R. § 1.102(d).

The petition to make the Reexamination proceeding special is **DENIED**.

REGULATION AND PRACTICE

To be eligible for accelerated examination under 37 C.F.R. § 1.102(d) and pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published in the Federal Register on June 26, 2006 (71 Fed. Reg. 36323), the following conditions must be satisfied:

1. The application must be a non-reissue utility or design application filed under 37 CFR 1.111(a);
2. The application, the petition and the required fees must be filed electronically using the USPTO's electronic filing system (EFS), or EFS-web; if not filed electronically, a statement asserting that EFS and EFS-web were not available during the normal business hours;
3. The application, at the time of filing, must be complete under 37 CFR 1.51 and in condition for examination;
4. The application must contain three or fewer independent claims and twenty or fewer total claims and the claims must be directed to a single invention.

The petition to make special for Infringement under 37 C.F.R. § 1.102(d) is not acceptable at least because it was not filed with an application as required in the above Federal Register Notice of June 26, 2006. A Reexamination proceeding is not considered to be an "application" and thus does not qualify under 37 CFR 1.102. Furthermore, it appears that the petition was filed under the guidelines for making an application special that were in effect prior to August 25, 2006. As of August 25, 2006 the new guidelines replaced the old guidelines. Since applicant's petition was received on August 20, 2007, the petition would also have to be considered under the new guidelines and thus would be properly **DENIED**.

For the above-stated reasons, the petition is denied. However, since Reexamination proceedings are intended to be handled special without a granting of a petition, the examiner is reminded to treat this Reexamination proceeding as such.

Any inquiry regarding this decision should be directed to Steven N. Meyers, Quality Assurance Specialist, at (571) 272-6611.

Steven N. Meyers,
Quality Assurance Specialist
Technology Center 3600

Sm/sm: 2/4/08

mat

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Paper No. 13

Gordon Harris, Jr.
Harness Dickey & Pierce
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Suite 400
Troy, MI 48098

For Patent Owner

MAILED
DEC 21 2004
REEXAM UNIT

Lerner, David, Littenberg,
Krumholz & Mentlik
600 South Avenue West
Westfield, NJ 00530

For Third Party Requester

In re Roberts et al.
Reexamination Proceeding
Control No.: 90/006,435
Filed: October 28, 2002
For: U.S. Patent Number: 5,138,459

: **DECISION GRANTING REQUEST**
: **FOR RECONSIDERATION AND**
: **REQUIRING INFORMATION**
: **PURSUANT TO 37 CFR 1.105**

This is a decision on the patent owner's April 30, 2004, request for reconsideration, entitled "Response to Notification *Re* Defective Information Disclosure Statements and Show Cause Why the Submitted Information Disclosure Statements Should Be Retained and Considered."

This is also a requirement for information pursuant to 37 CFR 1.105.

The instant reexamination proceeding is before the Director of the Office of Patent Legal Administration for decision on the request for reconsideration, and other consideration as the proceeding may warrant.

The request for reconsideration is granted.

Pursuant to 37 CFR 1.105, the patent owner is required to supply, to the extent stated hereinafter, whatever *actual knowledge* that the patent owner, or any other party associated with the patent owner as defined within 37 CFR 1.555(a)[1], may have regarding material information relating to the prior art cited by the patent owner in this proceeding.

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[1] 37 CFR 1.555(a) provides, in pertinent part: ". . . The individuals who have a duty to disclose to the Office all information known to them to be material to patentability in a reexamination proceeding are the patent owner, each attorney or agent who represents the patent owner, and every other individual who is substantively involved on behalf of the patent owner in a reexamination proceeding . . ."

BACKGROUND

- U.S. Patent No. 5,138,459 (the '459 patent) was issued to Roberts et al, on August 11, 1992.
- On October 28, 2002, a request for reexamination of the '459 patent was filed by a third party requester and was assigned Control No. 90/006,435 (the '6435 proceeding).
- On January 8, 2003, reexamination was ordered in the '6435 proceeding.
- The time period for filing a patent owner's statement under 37 CFR 1.530 has expired, and no patent owner's statement has been received for the '6435 proceeding.
- On December 11, 2003, a petition under 37 CFR 1.181(a)(3)and 1.182 to the Director was filed by a third party who was not the third party requester. The petition was returned as an improper submission in a decision of the Director of Technology Center 2600 dated March 9, 2004.
- In each of four companion reexamination proceedings including the present proceeding (the '6435, '6436, '6437, and '6438 proceedings), the patent owner has filed seven information disclosure statement (IDS) submissions containing numerous citations on March 10, 2003 (IDS #1), September 8, 2003 (IDS #2), October 8, 2003 (IDS #3), December 29, 2003 (IDS #4), January 19, 2004 (IDS #5), and March 9, 2004 (IDS #6), and August 11, 2004 (IDS #7). [2]
- The content of the seven IDS submissions is as follows:

IDS #1, filed 3/10/03 - 20 sheets listing:

95 U.S. patents, 30 foreign patent documents, and 183 "other documents."

IDS #2, filed 9/8/03 - 2 sheets listing:

22 other documents.

IDS #3, filed 10/8/03 - 1 sheet listing:

1 U.S. patent

IDS #4, filed 12/29/03 - 26 sheets listing:

373 US patents, 78 foreign patent documents, and 34 other documents.

IDS #5, filed 1/19/04 - 1 sheet listing:

2 attached fax messages comprising listings of -

fax # (1) 41 pages including 512 total documents, and

fax # (2) 10 pages of documents (137 US patents, 47 foreign patents, and 97 other documents).

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[2] The numbering of the IDS submissions is for purposes of this decision only, and does not reflect the total number of such submissions in the proceeding.

IDS #6, filed 3/9/04 - 6 sheets listing:

19 US patents, 42 foreign patent documents, and 86 other documents.

IDS #7, filed 8/11/04 - 1 sheet listing:

5 foreign patent documents and 1 other document.

- The IDS submissions of March 10, 2003, September 8, 2003, and October 8, 2003, have been entered into the record as papers of the record. The IDS submissions of December 29, 2003, January 19, 2004, March 9, 2004, and August 11, 2004 have not yet been entered into the record as papers. Nothing has been indicated yet on the record as to whether any of the submitted citations will be considered.

- On April 1, 2004, a Notification *Re* Defective Information Disclosure Statements was mailed. The patent owner was given one month (from the date of mailing the notification) to either:

  (A) Show cause why the IDS submissions should be retained and considered, or

  (B) Make arrangements to pick up the boxes of IDS submissions from the Technology Center.

  The patent owner was informed that the failure of the patent owner to carry out either (9)(A) or (9)(B) would result in the IDS documents being discarded.

- On April 30, 2004, the present request for reconsideration, entitled "Response to Notification *Re* Defective Information Disclosure Statements And Show Cause Why the Submitted Information Disclosure Statements Should Be Retained and Considered," was received.

- On September 10, 2004, a "Submission of Court Papers from Litigation Involving Patent in Reexamination" was filed, reiterating information previously made known to the Office, and advising the Office of new developments in concurrent litigation.

- A first Office action on the merits has not yet been issued.

REQUEST FOR RECONSIDERATION

Upon review of patent owner's request for reconsideration received on April 30, 2004, the request for reconsideration has been **granted**. The Notification *Re* Defective Information Disclosure Statements, mailed on April 1, 2004, has been **withdrawn**.

The IDS submissions of December 29, 2003, January 19, 2004, March 9, 2004, and August 11, 2004, will be entered into the official record of the present reexamination proceeding as papers of record. The IDS submissions of March 10, 2003, September 8, 2003, and October 8, 2003, have already been entered into the record as papers of record as noted above.

If the patent owner submits an appropriate reply to the requirement for information under 37 CFR 1.105 set forth in this decision, the references will be considered. While the examiner has an obligation to consider the references cited in the information disclosure statements once the

minimum requirements of 37 CFR 1.97 and 1.98 have been met,[3] this obligation will be withdrawn if the patent owner fails to reply to the requirement for information under 37 CFR 1.105 set forth in this decision. The requirement for information under 37 CFR 1.105 is reasonably necessary for the reasons given below.

REQUIREMENT FOR INFORMATION PURSUANT TO 37 CFR 1.105

Reexamination proceedings must be conducted with "special dispatch", pursuant to 35 U.S.C. 305.[4] At the same time, there is a public interest that any material prior art that may have been previously overlooked in the issuance of the patent be reviewed in a reexamination proceeding.

This interest is especially significant in the present reexamination proceeding, given the current litigation involving the instant patent. In this instance, the totality of the submissions to be reviewed make up numerous boxes of unsorted prior art copies that are listed in approximately 100 pages of citations. There is no guidance as to the pertinency of the information contained in the boxes. The extensive amount of prior art that the patent owner is requiring the Office to review, coupled with the lack of meaningful guidance as to their pertinency, not only increases the possibility that a material teaching may continue to be inadvertently overlooked by the Office[5], it also causes a substantial delay in the prosecution of this reexamination proceeding. This delay clearly hinders the Office in carrying out its statutory mandate to conduct reexamination proceedings with "special dispatch."

It is therefore reasonably necessary that the patent owner be required to supply whatever *actual knowledge* that the patent owner, or any other party associated with the patent owner as defined in 37 CFR 1.555(a)[6], may have regarding material information relating to the cited prior art. An example of "material information" would include information regarding the pertinency of the prior art to at least one claim of the patent.

It is possible that the patent owner has never reviewed at least some of the cited prior art. For example, many of the documents were apparently submitted to the patent owner during litigation of the patent. The patent owner, therefore, may not have actual knowledge of at least some of the information, or of the material nature of at least some of the information, presented in the submissions. If this is the case, the patent owner may so state, identifying the documents of which he has no actual knowledge, or of which he has no actual knowledge of any material information contained therein. This statement will be considered a complete reply to the instant

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[3]MPEP 609 provides, in pertinent part: ". . . Once the minimum requirements of 37 CFR 1.97 and 37 CFR 1.98 are met, the examiner has an obligation to consider the information. Consideration by the examiner of the information submitted in an IDS means nothing more than considering the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search . . ."

[4]35 U.S.C. 305 provides, in pertinent part: " . . . All reexamination proceedings . . . will be conducted with special dispatch within the Office . . ."

[5]See MPEP 2004, paragraph no. 13, which states: "It is desirable to avoid the submission of long lists of documents if it can be avoided. Eliminate clearly irrelevant and marginally pertinent cumulative information. If a long list is submitted, highlight those documents which have been specifically brought to applicant's attention and/or are known to be of most significance."

[6]See footnote #1.

requirement for information, as it pertains to those documents so identified by the patent owner. The patent owner is not required to newly review any submissions.

If, however, **the patent owner has in fact reviewed** one or more of the submissions, or has a recollection of information from a previous review of one or more of the submissions not related to the litigation, or has otherwise obtained information regarding one or more of the submissions, the patent owner **must** reply to the questions presented below. **This is the actual knowledge to which the instant requirement for information is addressed.**

Based upon the above, should the patent owner be able to supply any of the requested information about any of the cited prior art, the patent owner is required to supply with such information:

(1) A list of all of the prior art represented by the discussion citations. Each page of the list must include:

(i) The reexamination proceeding control number (in the instant case, the reexamination proceeding control number is 90/006,435), and the patent number, issue date, and first-named inventor of the patent for which reexamination is requested; and

(ii) A column that provides a space, next to each document to be considered, for the examiner's initials.

(2) A legible copy of:

(i) Each foreign patent, and each printed publication, other than U.S. patents and U.S. patent application publications, that is represented by the discussed citations, with appropriate portions underlined or otherwise marked; and

(ii) An English language translation of all the necessary and pertinent parts of any non-English language patent or printed publication that is represented by the discussed citations, with appropriate portions underlined or otherwise marked.

Where there are more than five citations discussed, the copies of the prior art represented by the discussed citations are to be separated by type of citation (e.g., foreign patents, nonpatent literature) and are to be placed in numerical order.

Questions:

1. Identify each listed citation for which the corresponding piece of prior art was reviewed in any way in the context of the subject matter of this proceeding. Identify who reviewed the citation and the extent of the review.

2. For each citation identified in Question 1, set forth whatever actual knowledge (e.g., of the pertinency of the prior art) was obtained from reviewing the piece of prior art, and in particular, how that actual knowledge relates to any element of any claim in the reexamination proceeding. Duplicative knowledge should NOT be supplied.

3. For each citation where actual knowledge thereof was obtained in a manner other than reviewing the corresponding piece of prior art, such as where knowledge arose from communication from an adverse party, set forth that knowledge as it relates to any element of any claim in reexamination. Duplicative knowledge should be supplied.

4. For each piece of actual knowledge provided in answer to either Questions #2 or #3, identify each claim element in the reexamination to which it would apply, as well as where that actual knowledge appears in a piece of cited prior art.

5. Whenever the litigation involving the patent being reexamined identified a subset of the citations submitted in the information disclosure statements, identify the subset. For example, if, during litigation, a subset of references which were particularly pertinent to one of the patented claims was identified, then the patent owner must identify that subset, and the pertinency of the information contained in that subset of references.

The reply must be a complete reply. All of the references cited in the currently submitted information disclosure statements must be identified in the reply, either as documents of which the patent owner has not reviewed and has no actual knowledge of any material information contained therein, or as documents which the patent owner has reviewed. **Any reply which fails to identify all of the documents cited in the currently submitted information disclosure statements will be considered to be an incomplete reply.**

After the patent owner responds to this requirement for information, there may or may not be a need for further information from the patent owner.

Continuing Duty

The patent owner is reminded that the duty to disclose material information and the information requested by the instant requirement for information is a continuous duty and exists with respect to each claim until the claim is cancelled. As stated in 37 CFR 1.555(a):

> "The duty to disclose the information exists with respect to each claim pending in the reexamination proceeding **until the claim is cancelled....** The duty to disclose all information known to be material to patentability in a reexamination proceeding is deemed to be satisfied if **all** information known to be material to patentability of any claim in the patent **after issuance of the reexamination certificate** was cited by the Office or submitted to the Office in an information disclosure statement." [Emphasis added.]

For example, the patent owner is asked whether any of the prior art documents represented by the citations have been reviewed. If the patent owner first reviews any of these documents subsequent to the filing of a reply to the instant requirement for information, a supplemental reply must be submitted supplying the updated information.

CONCLUSION

The request for reconsideration has been considered, and is **granted**.

Pursuant to 37 CFR 1.105, **the patent owner is required to supply**, in accordance with the above, whatever *actual knowledge* that the patent owner, or any other party associated with the patent owner as defined in 37 CFR 1.555(a), may have regarding material information relating to the prior art cited by the patent owner in this proceeding.

The patent owner is given a shortened statutory period of **thirty (30) days** from the date of this decision to reply to the requirement for information. Extensions of time, **for sufficient cause only,** are available pursuant to 37 CFR 1.550(c).

The **failure to file a complete reply** to the instant requirement for information will be construed as a request to withdraw all currently submitted information disclosure statements from

consideration by the examiner. While the information disclosure statements have been entered into the official file, the examiner will not be required to consider any of the references submitted with the information disclosure statements. The Office will then proceed with the reexamination.

This file is being returned to the Office of the Special Programs Examiner of Technology Center 2600. The Technology Center will await a reply to the requirement for information, or the expiration of the time for a reply, after which an Office action will be issued in a manner not inconsistent with this decision.

Telephone inquiries with regard to this decision should be directed to either Kenneth Schor, Senior Legal Advisor at 571-272-7710, or Cynthia L. Nessler, Legal Advisor, at 571-272-7724.

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

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CENTRAL REEXAMINATION UNIT

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(Patent Owner)

Lerner David Littenberg
Krumholz & Mentlik
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(Third Part Requester)

In re Roberts et al.
Reexamination Proceeding
Control No.: 90/006,435
Filed: October 28, 2002
For: U.S. Patent No.: 5,138,459

DECISION ON PETITION UNDER 37 CFR 1.182

This is a decision on the August 28, 2006 patent owner petition under 37 CFR 1.182 to enter, and to have the examiner consider, an information disclosure statement (IDS) filed after the termination of the prosecution in this reexamination proceeding.

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

The petition is dismissed for the reasons set forth below.

REVIEW OF SALIENT FACTS

1. Patent number 5,138,459 issued on August 11, 1992 with 18 claims.
2. A request for reexamination, assigned control No. 90/006,435 (the '435 proceeding), was filed on October 28, 2002, by the patent owner.
3. An order granting the reexamination request was mailed January 8, 2003.
4. A Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the '435 proceeding on August 10, 2005.
5. Two Information Disclosure Statements (IDSs) were filed by the patent owner on February 3, 2006 and June 2, 2006, respectively.
6. The Office mailed a communication for the '435 proceeding on June 21, 2006 stating that the IDSs filed on February 3, 2006 and June 2, 2006 were not considered because they lacked an entry right.

7. The instant petition was filed on August 28, 2006, accompanied by a new IDS (i.e. a resubmission of the information in the February 3, 2006 and June 2, 2006 IDSs), which the patent owner requests the Office to consider.

8. The reexamination proceeding is in the final phase of being prepared for printing of the reexamination certificate (it is in the printing cycle).

RELEVANT LAW AND PROCEDURE

35 U.S.C. 305 Conduct of reexamination proceedings.

... All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with **special dispatch** within the Office. (Emphasis added.)

MPEP 2656 (Rev. 5, Aug. 2006)

.....Once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC.

Once the reexamination has entered the Reexamination Certificate publication process, pulling the proceeding from that process provides an even greater measure of delay. 37 CFR 1.313 states for an application (emphasis added):

> "(c) Once the issue fee has been paid, **the application will not be withdrawn from issue upon petition by the applicant for any reason except:**
> (1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;"

The publication process for an application occurs after the payment of the issue fee (there is no issue fee in reexamination), and thus 37 CFR 1.313(c) applies during the publication cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its publication cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). **Accordingly, where a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), is made while a proceeding is in its publication cycle, the patent owner must provide an unequivocal statement as to why the art submitted makes at least one claim unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable. This is in addition to** the above-discussed (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier. The submission of patents and printed publications must be accompanied by a petition under 37 CFR 1.182 (with petition fee) for withdrawal of the reexamination proceeding from the publication process for entry and consideration of the information submitted by patent owner. A grantable petition must provide the requisite showing discussed in this paragraph. (Emphasis added)

DECISION

There is no issue fee in reexamination, and the present reexamination proceeding has entered the final phase of the publication process (the "printing cycle"). In a reexamination proceeding, there is no withdrawal under 37 CFR 1.313 of the proceeding from the publication process for consideration of an Information Disclosure Statement (IDS), because 37 CFR 1.313(a) applies to applications and not to reexamination proceedings. Accordingly, in this instance the petition for withdrawal of the proceeding from the publication process for consideration of the accompanying IDS papers has been filed under 37 C.F.R. 1.182.

While there is no regulatory provision for withdrawal of a reexamination proceeding from the publication process for consideration of an IDS, 37 CFR 1.313 provides such a mechanism for an application. Accordingly, the requirements of 37 CFR 1.313 for withdrawal of an application from the printing cycle (after the issue fee has been paid) have historically been applied analogously to the requirements for withdrawal of reexamination proceedings from the printing cycle. This policy is explicitly set forth in the latest revision of MPEP 2656 as follows:

> ... The publication process for an application occurs after the payment of the issue fee (there is no issue fee in reexamination), and thus 37 CFR 1.313(c) applies during the publication cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its publication cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its publication cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). **Accordingly, where a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), is made while a proceeding is in its publication cycle, the patent owner must provide an unequivocal statement as to why the art submitted makes at least one claim unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable. This is in addition to** the above-discussed (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier. The submission of patents and printed publications must be accompanied by a petition under 37 CFR 1.182 (with petition fee) for withdrawal of the reexamination proceeding from the publication process for entry and consideration of the information submitted by patent owner. A grantable petition must provide the requisite showing discussed in this paragraph. (Emphasis added)

In the present instance, the fact situation fails to satisfy any grounds that would be analogous to those of 37 CFR 1.313(c). The instant petition was filed very late in the examination of the reexamination, and it fails to provide a statement as to why the submitted IDS items of information (art citations) make at least one claim unpatentable. To the contrary, patent owner merely states that the items of information were either "not available" or were not submitted earlier because of "inadvertent and unintentional misplacement." Patent owner does not provide a discussion of the substance of any of the items of information, and has not applied the teachings of the same to the claim limitations in the present reexamination proceeding.

For *ex parte* reexamination, there is a statutory requirement pursuant to 35 U.S.C. 305 that all *ex parte* reexamination proceedings "will be conducted with special dispatch within the Office." It is required that the withdrawal criteria of 37 CFR 1.313(c) be complied with for an application, in which there is no statutory requirement for special dispatch, and such criteria must certainly be complied with for a reexamination proceeding where there is a statutory requirement for special dispatch. This is explicitly set forth in the latest revision of the MPEP as set forth above.

A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on August 10, 2005, and the proceeding has now entered the final stages of the publication process. The proceeding is not scheduled to come up for further action on the merits. In this instance, the present proceeding would need to be withdrawn from the publication process, thus regressing the processing of the proceeding. This would run contrary to the statutory requirement of 35 U.S.C. 305 that "[a]ll reexamination proceedings under this section...will be conducted with special dispatch within the Office." The statutory mandate of special dispatch is based upon the public interest in providing certainty and finality as to the question of patentability raised by the request for reexamination. In view of the fact that the information submitted was submitted after termination of the prosecution in this reexamination proceeding, is not asserted as raising a question of patentability of the claims, and it is not in any way discussed in detail, it is proper that the reexamination proceeding should not be reopened at this late date to consider the proffered IDS papers. Accordingly the petition is dismissed as to the request for consideration of the IDS papers. The proceeding will not be withdrawn from the publication process.

If, however, the patent owner in fact believes that one or more references submitted raises a substantial question of patentability as to at least one claim of the patent different than raised in this proceeding, the patent owner can always file a new request for reexamination for consideration of such references.

The IDS submitted by patent owner will be placed in the file, and will remain of record. However, since prosecution has been terminated for this reexamination proceeding, the IDS will not be considered by the examiner.

In view of the above, the petition is dismissed.

CONCLUSION

1. The petition is dismissed as to the request for consideration of the IDS filed on August 28, 2006.

2. The IDS papers will be entered into the file, but will not be considered by the examiner.

3. The present proceeding will continue in the publication process, toward issuance of a reexamination certificate.

4. Telephone inquiries related to this decision should be directed to Karen M. Hastings, Legal Advisor, at (571) 272-7717.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

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Paper No. 13

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For Third Party Requester

MAILED
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REEXAM UNIT

In re Roberts et al.
Reexamination Proceeding
Control No.: 90/006,436
Filed: October 28, 2002
For: U.S. Patent Number: 6,094,219

: DECISION GRANTING REQUEST
: FOR RECONSIDERATION AND
: REQUIRING INFORMATION
: PURSUANT TO 37 CFR 1.105

This is a decision on the patent owner's April 30, 2004, request for reconsideration, entitled "Response to Notification *Re* Defective Information Disclosure Statements and Show Cause Why the Submitted Information Disclosure Statements Should Be Retained and Considered."

This is also a requirement for information pursuant to 37 CFR 1.105.

The instant reexamination proceeding is before the Director of the Office of Patent Legal Administration for decision on the request for reconsideration, and other consideration as the proceeding may warrant.

The request for reconsideration is granted.

Pursuant to 37 CFR 1.105, the patent owner is required to supply, to the extent stated hereinafter, whatever *actual knowledge* that the patent owner, or any other party associated with the patent owner as defined within 37 CFR 1.555(a)[1], may have regarding material information relating to the prior art cited by the patent owner in this proceeding.

---

[1] 37 CFR 1.555(a) provides, in pertinent part: ". . . The individuals who have a duty to disclose to the Office all information known to them to be material to patentability in a reexamination proceeding are the patent owner, each attorney or agent who represents the patent owner, and every other individual who is substantively involved on behalf of the patent owner in a reexamination proceeding . . ."

BACKGROUND

- U.S. Patent No. 6,094,219 (the '219 patent) was issued to Roberts et al, on July 25, 2000.
- On October 28, 2002, a request for reexamination of the '219 patent was filed by a third party requester and was assigned Control No. 90/006,436 (the '6436 proceeding).
- On January 8, 2003, reexamination was ordered in the '6436 proceeding.
- The time period for filing a patent owner's statement under 37 CFR 1.530 has expired, and no patent owner's statement has been received for the '6436 proceeding.
- On December 11, 2003, a petition under 37 CFR 1.181(a)(3)and 1.182 to the Director was filed by a third party who was not the third party requester. The petition was returned as an improper submission in a decision of the Director of Technology Center 2600 dated March 9, 2004.
- In each of four companion reexamination proceedings including the present proceeding (the '6435, '6436, '6437, and '6438 proceedings), the patent owner has filed seven information disclosure statement (IDS) submissions containing numerous citations on March 10, 2003 (IDS #1), September 8, 2003 (IDS #2), October 8, 2003 (IDS #3), December 29, 2003 (IDS #4), January 19, 2004 (IDS #5), and March 9, 2004 (IDS #6), and August 11, 2004 (IDS #7). [2]
- The content of the seven IDS submissions is as follows:

IDS #1, filed 3/10/03 - 20 sheets listing:

95 U.S. patents, 30 foreign patent documents, and 183 "other documents."

IDS #2, filed 9/8/03 - 2 sheets listing:

22 other documents.

IDS #3, filed 10/8/03 - 1 sheet listing:

1 U.S. patent

IDS #4, filed 12/29/03 - 26 sheets listing:

373 US patents, 78 foreign patent documents, and 34 other documents.

IDS #5, filed 1/19/04 - 1 sheet listing:

2 attached fax messages comprising listings of -

fax # (1) 41 pages including 512 total documents, and

fax # (2) 10 pages of documents (137 US patents, 47 foreign patents, and 97 other documents).

IDS #6, filed 3/9/04 - 6 sheets listing:

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[2] The numbering of the IDS submissions is for purposes of this decision only, and does not reflect the total number of such submissions in the proceeding.

19 US patents, 42 foreign patent documents, and 86 other documents.

IDS #7, filed 8/11/04 - 1 sheet listing:

5 foreign patent documents and 1 other document.

- The IDS submissions of March 10, 2003, September 8, 2003, and October 8, 2003, have been entered into the record as papers of the record. The IDS submissions of December 29, 2003, January 19, 2004, March 9, 2004, and August 11, 2004 have not yet been entered into the record as papers. Nothing has been indicated yet on the record as to whether any of the submitted citations will be considered.

- On April 1, 2004, a Notification *Re* Defective Information Disclosure Statements was mailed. The patent owner was given one month (from the date of mailing the notification) to either:

  (A) Show cause why the IDS submissions should be retained and considered, or

  (B) Make arrangements to pick up the boxes of IDS submissions from the Technology Center.

  The patent owner was informed that the failure of the patent owner to carry out either (9)(A) or (9)(B) would result in the IDS documents being discarded.

- On April 30, 2004, the present request for reconsideration, entitled "Response to Notification *Re* Defective Information Disclosure Statements And Show Cause Why the Submitted Information Disclosure Statements Should Be Retained and Considered," was received.

- On September 10, 2004, a "Submission of Court Papers from Litigation Involving Patent in Reexamination" was filed, reiterating information previously made known to the Office, and advising the Office of new developments in concurrent litigation.

- A first Office action on the merits has not yet been issued.

REQUEST FOR RECONSIDERATION

Upon review of patent owner's request for reconsideration received on April 30, 2004, the request for reconsideration has been **granted**. The Notification *Re* Defective Information Disclosure Statements, mailed on April 1, 2004, has been **withdrawn**.

The IDS submissions of December 29, 2003, January 19, 2004, March 9, 2004, and August 11, 2004, will be entered into the official record of the present reexamination proceeding as papers of record. The IDS submissions of March 10, 2003, September 8, 2003, and October 8, 2003, have already been entered into the record as papers of record as noted above.

If the patent owner submits an appropriate reply to the requirement for information under 37 CFR 1.105 set forth in this decision, the references will be considered. While the examiner has an obligation to consider the references cited in the information disclosure statements once the

minimum requirements of 37 CFR 1.97 and 1.98 have been met,[3] this obligation will be withdrawn if the patent owner fails to reply to the requirement for information under 37 CFR 1.105 set forth in this decision. The requirement for information under 37 CFR 1.105 is reasonably necessary for the reasons given below.

REQUIREMENT FOR INFORMATION PURSUANT TO 37 CFR 1.105

Reexamination proceedings must be conducted with "special dispatch", pursuant to 35 U.S.C. 305.[4] At the same time, there is a public interest that any material prior art that may have been previously overlooked in the issuance of the patent be reviewed in a reexamination proceeding.

This interest is especially significant in the present reexamination proceeding, given the current litigation involving the instant patent. In this instance, the totality of the submissions to be reviewed make up numerous boxes of unsorted prior art copies that are listed in approximately 100 pages of citations. There is no guidance as to the pertinency of the information contained in the boxes. The extensive amount of prior art that the patent owner is requiring the Office to review, coupled with the lack of meaningful guidance as to their pertinency, not only increases the possibility that a material teaching may continue to be inadvertently overlooked by the Office[5], it also causes a substantial delay in the prosecution of this reexamination proceeding. This delay clearly hinders the Office in carrying out its statutory mandate to conduct reexamination proceedings with "special dispatch."

It is therefore reasonably necessary that the patent owner be required to supply whatever *actual knowledge* that the patent owner, or any other party associated with the patent owner as defined in 37 CFR 1.555(a)[6], may have regarding material information relating to the cited prior art. An example of "material information" would include information regarding the pertinency of the prior art to at least one claim of the patent.

It is possible that the patent owner has never reviewed at least some of the cited prior art. For example, many of the documents were apparently submitted to the patent owner during litigation of the patent. The patent owner, therefore, may not have actual knowledge of at least some of the information, or of the material nature of at least some of the information, presented in the submissions. If this is the case, the patent owner may so state, identifying the documents of which he has no actual knowledge, or of which he has no actual knowledge of any material information contained therein. This statement will be considered a complete reply to the instant

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[3]MPEP 609 provides, in pertinent part: ". . . Once the minimum requirements of 37 CFR 1.97 and 37 CFR 1.98 are met, the examiner has an obligation to consider the information. Consideration by the examiner of the information submitted in an IDS means nothing more than considering the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search . . ."

[4]35 U.S.C. 305 provides, in pertinent part: " . . . All reexamination proceedings . . . will be conducted with special dispatch within the Office . . ."

[5]See MPEP 2004, paragraph no. 13, which states: "It is desirable to avoid the submission of long lists of documents if it can be avoided. Eliminate clearly irrelevant and marginally pertinent cumulative information. If a long list is submitted, highlight those documents which have been specifically brought to applicant's attention and/or are known to be of most significance."

[6]See footnote #1.

requirement for information, as it pertains to those documents so identified by the patent owner. The patent owner is not required to newly review any submissions.

If, however, **the patent owner has in fact reviewed** one or more of the submissions, or has a recollection of information from a previous review of one or more of the submissions not related to the litigation, or has otherwise obtained information regarding one or more of the submissions, the patent owner **must** reply to the questions presented below. **This is the actual knowledge to which the instant requirement for information is addressed.**

Based upon the above, should the patent owner be able to supply any of the requested information about any of the cited prior art, the patent owner is required to supply with such information:

(1) A list of all of the prior art represented by the discussion citations. Each page of the list must include:

(i) The reexamination proceeding control number (in the instant case, the reexamination proceeding control number is 90/006,436), and the patent number, issue date, and first-named inventor of the patent for which reexamination is requested; and

(ii) A column that provides a space, next to each document to be considered, for the examiner's initials.

(2) A legible copy of:

(i) Each foreign patent, and each printed publication, other than U.S. patents and U.S. patent application publications, that is represented by the discussed citations, with appropriate portions underlined or otherwise marked; and

(ii) An English language translation of all the necessary and pertinent parts of any non-English language patent or printed publication that is represented by the discussed citations, with appropriate portions underlined or otherwise marked.

Where there are more than five citations discussed, the copies of the prior art represented by the discussed citations are to be separated by type of citation (e.g., foreign patents, nonpatent literature) and are to be placed in numerical order.

Questions:

1. Identify each listed citation for which the corresponding piece of prior art was reviewed in any way in the context of the subject matter of this proceeding. Identify who reviewed the citation and the extent of the review.

2. For each citation identified in Question 1, set forth whatever actual knowledge (e.g., of the pertinency of the prior art) was obtained from reviewing the piece of prior art, and in particular, how that actual knowledge relates to any element of any claim in the reexamination proceeding. Duplicative knowledge should NOT be supplied.

3. For each citation where actual knowledge thereof was obtained in a manner other than reviewing the corresponding piece of prior art, such as where knowledge arose from communication from an adverse party, set forth that knowledge as it relates to any element of any claim in reexamination. Duplicative knowledge should be supplied.

4. For each piece of actual knowledge provided in answer to either Questions #2 or #3, identify each claim element in the reexamination to which it would apply, as well as where that actual knowledge appears in a piece of cited prior art.

5. Whenever the litigation involving the patent being reexamined identified a subset of the citations submitted in the information disclosure statements, identify the subset. For example, if, during litigation, a subset of references which were particularly pertinent to one of the patented claims was identified, then the patent owner must identify that subset, and the pertinency of the information contained in that subset of references.

The reply must be a complete reply. All of the references cited in the currently submitted information disclosure statements must be identified in the reply, either as documents of which the patent owner has not reviewed and has no actual knowledge of any material information contained therein, or as documents which the patent owner has reviewed. **Any reply which fails to identify all of the documents cited in the currently submitted information disclosure statements will be considered to be an incomplete reply.**

After the patent owner responds to this requirement for information, there may or may not be a need for further information from the patent owner.

Continuing Duty

The patent owner is reminded that the duty to disclose material information and the information requested by the instant requirement for information is a continuous duty and exists with respect to each claim until the claim is cancelled. As stated in 37 CFR 1.555(a):

> "The duty to disclose the information exists with respect to each claim pending in the reexamination proceeding **until the claim is cancelled**.... The duty to disclose all information known to be material to patentability in a reexamination proceeding is deemed to be satisfied if **all** information known to be material to patentability of any claim in the patent **after issuance of the reexamination certificate** was cited by the Office or submitted to the Office in an information disclosure statement." [Emphasis added.]

For example, the patent owner is asked whether any of the prior art documents represented by the citations have been reviewed. If the patent owner first reviews any of these documents subsequent to the filing of a reply to the instant requirement for information, a supplemental reply must be submitted supplying the updated information.

CONCLUSION

The request for reconsideration has been considered, and is **granted**.

Pursuant to 37 CFR 1.105, **the patent owner is required to supply**, in accordance with the above, whatever *actual knowledge* that the patent owner, or any other party associated with the patent owner as defined in 37 CFR 1.555(a), may have regarding material information relating to the prior art cited by the patent owner in this proceeding.

The patent owner is given a shortened statutory period of **thirty (30) days** from the date of this decision to reply to the requirement for information. Extensions of time, **for sufficient cause only,** are available pursuant to 37 CFR 1.550(c).

The **failure to file a complete reply** to the instant requirement for information will be construed as a request to withdraw all currently submitted information disclosure statements from

consideration by the examiner. While the information disclosure statements have been entered into the official file, the examiner will not be required to consider any of the references submitted with the information disclosure statements. The Office will then proceed with the reexamination.

This file is being returned to the Office of the Special Programs Examiner of Technology Center 2600. The Technology Center will await a reply to the requirement for information, or the expiration of the time for a reply, after which an Office action will be issued in a manner not inconsistent with this decision.

Telephone inquiries with regard to this decision should be directed to either Kenneth Schor, Senior Legal Advisor at 571-272-7710, or Cynthia L. Nessler, Legal Advisor, at 571-272-7724.

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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(Patent Owner)

MAILED

SEP 29 2006

CENTRAL REEXAMINATION UNIT

Lerner David Littenberg
Krumholz & Mentlik
600 South Avenue West
Westfield, NJ 07090

(Third Part Requester)

In re Roberts et al.	:
Reexamination Proceeding	: **DECISION**
Control No.: 90/006,436	: **ON PETITION**
Filed: October 28, 2002	: **UNDER 37 CFR 1.182**
For: U.S. Patent No.: 6,094,219	:

This is a decision on the August 28, 2006 patent owner petition under 37 CFR 1.182 to enter, and to have the examiner consider, an information disclosure statement (IDS) filed after the termination of the prosecution in this reexamination proceeding.

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

The petition is dismissed for the reasons set forth below.

REVIEW OF SALIENT FACTS

1. Patent number 6,094,219 issued on July 25, 2000 with 26 claims.
2. A request for reexamination, assigned control No. 90/006,436 (the '436 proceeding), was filed on October 28, 2002, by the patent owner.
3. An order granting the reexamination request was mailed January 8, 2003.
4. A Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the '436 proceeding on August 10, 2005.
5. Two Information Disclosure Statements (IDSs) were filed by the patent owner on February 3, 2006 and June 2, 2006, respectively.
6. The Office mailed a communication for the '436 proceeding on June 21, 2006 stating that the IDSs filed on February 3, 2006 and June 2, 2006 were not considered because they lacked an entry right.

7. The instant petition was filed on August 28, 2006, accompanied by a new IDS (i.e. a resubmission of the information in the February 3, 2006 and June 2, 2006 IDSs), which the patent owner requests the Office to consider.

8. The reexamination proceeding is in the final phase of being prepared for printing of the reexamination certificate (it is in the printing cycle).

RELEVANT LAW AND PROCEDURE

35 U.S.C. 305 Conduct of reexamination proceedings.

... All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with **special dispatch** within the Office. (Emphasis added.)

MPEP 2656 (Rev. 5, Aug. 2006)

.....Once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC.

Once the reexamination has entered the Reexamination Certificate publication process, pulling the proceeding from that process provides an even greater measure of delay. 37 CFR 1.313 states for an application (emphasis added):

> "(c) Once the issue fee has been paid, **the application will not be withdrawn from issue upon petition by the applicant for any reason except:**
> (1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;"

The publication process for an application occurs after the payment of the issue fee (there is no issue fee in reexamination), and thus 37 CFR 1.313(c) applies during the publication cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its publication cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). **Accordingly, where a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), is made while a proceeding is in its publication cycle, the patent owner must provide an unequivocal statement as to why the art submitted makes at least one claim unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable. This is in addition to** the above-discussed (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier. The submission of patents and printed publications must be accompanied by a petition under 37 CFR 1.182 (with petition fee) for withdrawal of the reexamination proceeding from the publication process for entry and consideration of the information submitted by patent owner. A grantable petition must provide the requisite showing discussed in this paragraph. (Emphasis added)

DECISION

There is no issue fee in reexamination, and the present reexamination proceeding has entered the final phase of the publication process (the "printing cycle"). In a reexamination proceeding, there is no withdrawal under 37 CFR 1.313 of the proceeding from the publication process for consideration of an Information Disclosure Statement (IDS), because 37 CFR 1.313(a) applies to applications and not to reexamination proceedings. Accordingly, in this instance the petition for withdrawal of the proceeding from the publication process for consideration of the accompanying IDS papers has been filed under 37 C.F.R. 1.182.

While there is no regulatory provision for withdrawal of a reexamination proceeding from the publication process for consideration of an IDS, 37 CFR 1.313 provides such a mechanism for an application. Accordingly, the requirements of 37 CFR 1.313 for withdrawal of an application from the printing cycle (after the issue fee has been paid) have historically been applied analogously to the requirements for withdrawal of reexamination proceedings from the printing cycle. This policy is explicitly set forth in the latest revision of MPEP 2656 as follows:

> ... The publication process for an application occurs after the payment of the issue fee (there is no issue fee in reexamination), and thus 37 CFR 1.313(c) applies during the publication cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its publication cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its publication cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). **Accordingly, where a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), is made while a proceeding is in its publication cycle, the patent owner must provide an unequivocal statement as to why the art submitted makes at least one claim unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable. This is in addition to** the above-discussed (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier. The submission of patents and printed publications must be accompanied by a petition under 37 CFR 1.182 (with petition fee) for withdrawal of the reexamination proceeding from the publication process for entry and consideration of the information submitted by patent owner. A grantable petition must provide the requisite showing discussed in this paragraph. (Emphasis added)

In the present instance, the fact situation fails to satisfy any grounds that would be analogous to those of 37 CFR 1.313(c). The instant petition was filed very late in the examination of the reexamination, and it fails to provide a statement as to why the submitted IDS items of information (art citations) make at least one claim unpatentable. To the contrary, patent owner merely states that the items of information were either "not available" or were not submitted earlier because of "inadvertent and unintentional misplacement." Patent owner does not provide a discussion of the substance of any of the items of information, and has not applied the teachings of the same to the claim limitations in the present reexamination proceeding.

For *ex parte* reexamination, there is a statutory requirement pursuant to 35 U.S.C. 305 that all *ex parte* reexamination proceedings "will be conducted with special dispatch within the Office." It is required that the withdrawal criteria of 37 CFR 1.313(c) be complied with for an application, in which there is no statutory requirement for special dispatch, and such criteria must certainly be complied with for a reexamination proceeding where there is a statutory requirement for special dispatch. This is explicitly set forth in the latest revision of the MPEP as set forth above.

A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on August 10, 2005, and the proceeding has now entered the final stages of the publication process. The proceeding is not scheduled to come up for further action on the merits. In this instance, the present proceeding would need to be withdrawn from the publication process, thus regressing the processing of the proceeding. This would run contrary to the statutory requirement of 35 U.S.C. 305 that "[a]ll reexamination proceedings under this section...will be conducted with special dispatch within the Office." The statutory mandate of special dispatch is based upon the public interest in providing certainty and finality as to the question of patentability raised by the request for reexamination. In view of the fact that the information submitted was submitted after termination of the prosecution in this reexamination proceeding, is not asserted as raising a question of patentability of the claims, and it is not in any way discussed in detail, it is proper that the reexamination proceeding should not be reopened at this late date to consider the proffered IDS papers. Accordingly the petition is dismissed as to the request for consideration of the IDS papers. The proceeding will not be withdrawn from the publication process.

If, however, the patent owner in fact believes that one or more references submitted raises a substantial question of patentability as to at least one claim of the patent different than raised in this proceeding, the patent owner can always file a new request for reexamination for consideration of such references.

The IDS submitted by patent owner will be placed in the file, and will remain of record. However, since prosecution has been terminated for this reexamination proceeding, the IDS will not be considered by the examiner.

In view of the above, the petition is dismissed.

CONCLUSION

1. The petition is dismissed as to the request for consideration of the IDS filed on August 28, 2006.

2. The IDS papers will be entered into the file, but will not be considered by the examiner.

3. The present proceeding will continue in the publication process, toward issuance of a reexamination certificate.

4. Telephone inquiries related to this decision should be directed to Karen M. Hastings, Legal Advisor, at (571) 272-7717.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

kmh
9/27/06

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Paper No. 13

Gordon Harris, Jr.
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For Patent Owner

MAILED
DEC 21 2004
REEXAM UNIT

Lerner, David, Littenberg,
Krumholz & Mentlik
600 South Avenue West
Westfield, NJ 00530

For Third Party Requester

In re Roberts et al.
Reexamination Proceeding
Control No.: 90/006,437
Filed: October 28, 2002
For: U.S. Patent Number: 6,233,010

: **DECISION GRANTING REQUEST**
: **FOR RECONSIDERATION AND**
: **REQUIRING INFORMATION**
: **PURSUANT TO 37 CFR 1.105**

This is a decision on the patent owner's April 30, 2004, request for reconsideration, entitled "Response to Notification *Re* Defective Information Disclosure Statements and Show Cause Why the Submitted Information Disclosure Statements Should Be Retained and Considered."

This is also a requirement for information pursuant to 37 CFR 1.105.

The instant reexamination proceeding is before the Director of the Office of Patent Legal Administration for decision on the request for reconsideration, and other consideration as the proceeding may warrant.

The request for reconsideration is granted.

Pursuant to 37 CFR 1.105, the patent owner is required to supply, to the extent stated hereinafter, whatever *actual knowledge* that the patent owner, or any other party associated with the patent owner as defined within 37 CFR 1.555(a)[1], may have regarding material information relating to the prior art cited by the patent owner in this proceeding.

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[1] 37 CFR 1.555(a) provides, in pertinent part: ". . . The individuals who have a duty to disclose to the Office all information known to them to be material to patentability in a reexamination proceeding are the patent owner, each attorney or agent who represents the patent owner, and every other individual who is substantively involved on behalf of the patent owner in a reexamination proceeding . . ."

BACKGROUND

- U.S. Patent No. 6,233,010 (the '010 patent) was issued to Roberts et al, on May 15, 2001.
- On October 28, 2002, a request for reexamination of the '010 patent was filed by a third party requester and was assigned Control No. 90/006,437 (the '6437 proceeding).
- On January 8, 2003, reexamination was ordered in the '6437 proceeding.
- The time period for filing a patent owner's statement under 37 CFR 1.530 has expired, and no patent owner's statement has been received for the '6437 proceeding.
- On December 11, 2003, a petition under 37 CFR 1.181(a)(3)and 1.182 to the Director was filed by a third party who was not the third party requester. The petition was returned as an improper submission in a decision of the Director of Technology Center 2600 dated March 9, 2004.
- In each of four companion reexamination proceedings including the present proceeding (the '6435, '6436, '6437, and '6438 proceedings), the patent owner has filed seven information disclosure statement (IDS) submissions containing numerous citations on March 10, 2003 (IDS #1), September 8, 2003 (IDS #2), October 8, 2003 (IDS #3), December 29, 2003 (IDS #4), January 19, 2004 (IDS #5), and March 9, 2004 (IDS #6), and August 11, 2004 (IDS #7). [2]
- The content of the seven IDS submissions is as follows:

IDS #1, filed 3/10/03 - 20 sheets listing:

95 U.S. patents, 30 foreign patent documents, and 183 "other documents."

IDS #2, filed 9/8/03 - 2 sheets listing:

22 other documents.

IDS #3, filed 10/8/03 - 1 sheet listing:

1 U.S. patent

IDS #4, filed 12/29/03 - 26 sheets listing:

373 US patents, 78 foreign patent documents, and 34 other documents.

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2 attached fax messages comprising listings of -

fax # (1) 41 pages including 512 total documents, and

fax # (2) 10 pages of documents (137 US patents, 47 foreign patents, and 97 other documents).

IDS #6, filed 3/9/04 - 6 sheets listing:

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[2] The numbering of the IDS submissions is for purposes of this decision only, and does not reflect the total number of such submissions in the proceeding.

19 US patents, 42 foreign patent documents, and 86 other documents.

IDS #7, filed 8/11/04 - 1 sheet listing:

5 foreign patent documents and 1 other document.

- The IDS submissions of March 10, 2003, September 8, 2003, and October 8, 2003, have been entered into the record as papers of the record. The IDS submissions of December 29, 2003, January 19, 2004, March 9, 2004, and August 11, 2004 have not yet been entered into the record as papers. Nothing has been indicated yet on the record as to whether any of the submitted citations will be considered.

- On April 1, 2004, a Notification *Re* Defective Information Disclosure Statements was mailed. The patent owner was given one month (from the date of mailing the notification) to either:

  (A) Show cause why the IDS submissions should be retained and considered, or

  (B) Make arrangements to pick up the boxes of IDS submissions from the Technology Center.

  The patent owner was informed that the failure of the patent owner to carry out either (9)(A) or (9)(B) would result in the IDS documents being discarded.

- On April 30, 2004, the present request for reconsideration, entitled "Response to Notification *Re* Defective Information Disclosure Statements And Show Cause Why the Submitted Information Disclosure Statements Should Be Retained and Considered," was received.

- On September 10, 2004, a "Submission of Court Papers from Litigation Involving Patent in Reexamination" was filed, reiterating information previously made known to the Office, and advising the Office of new developments in concurrent litigation.

- A first Office action on the merits has not yet been issued.

REQUEST FOR RECONSIDERATION

Upon review of patent owner's request for reconsideration received on April 30, 2004, the request for reconsideration has been **granted**. The Notification *Re* Defective Information Disclosure Statements, mailed on April 1, 2004, has been **withdrawn**.

The IDS submissions of December 29, 2003, January 19, 2004, March 9, 2004, and August 11, 2004, will be entered into the official record of the present reexamination proceeding as papers of record. The IDS submissions of March 10, 2003, September 8, 2003, and October 8, 2003, have already been entered into the record as papers of record as noted above.

If the patent owner submits an appropriate reply to the requirement for information under 37 CFR 1.105 set forth in this decision, the references will be considered. While the examiner has an obligation to consider the references cited in the information disclosure statements once the

minimum requirements of 37 CFR 1.97 and 1.98 have been met,[3] this obligation will be withdrawn if the patent owner fails to reply to the requirement for information under 37 CFR 1.105 set forth in this decision. The requirement for information under 37 CFR 1.105 is reasonably necessary for the reasons given below.

REQUIREMENT FOR INFORMATION PURSUANT TO 37 CFR 1.105

Reexamination proceedings must be conducted with "special dispatch", pursuant to 35 U.S.C. 305.[4] At the same time, there is a public interest that any material prior art that may have been previously overlooked in the issuance of the patent be reviewed in a reexamination proceeding.

This interest is especially significant in the present reexamination proceeding, given the current litigation involving the instant patent. In this instance, the totality of the submissions to be reviewed make up numerous boxes of unsorted prior art copies that are listed in approximately 100 pages of citations. There is no guidance as to the pertinency of the information contained in the boxes. The extensive amount of prior art that the patent owner is requiring the Office to review, coupled with the lack of meaningful guidance as to their pertinency, not only increases the possibility that a material teaching may continue to be inadvertently overlooked by the Office[5], it also causes a substantial delay in the prosecution of this reexamination proceeding. This delay clearly hinders the Office in carrying out its statutory mandate to conduct reexamination proceedings with "special dispatch."

It is therefore reasonably necessary that the patent owner be required to supply whatever *actual knowledge* that the patent owner, or any other party associated with the patent owner as defined in 37 CFR 1.555(a)[6], may have regarding material information relating to the cited prior art. An example of "material information" would include information regarding the pertinency of the prior art to at least one claim of the patent.

It is possible that the patent owner has never reviewed at least some of the cited prior art. For example, many of the documents were apparently submitted to the patent owner during litigation of the patent. The patent owner, therefore, may not have actual knowledge of at least some of the information, or of the material nature of at least some of the information, presented in the submissions. If this is the case, the patent owner may so state, identifying the documents of which he has no actual knowledge, or of which he has no actual knowledge of any material information contained therein. This statement will be considered a complete reply to the instant

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[3]MPEP 609 provides, in pertinent part: ". . . Once the minimum requirements of 37 CFR 1.97 and 37 CFR 1.98 are met, the examiner has an obligation to consider the information. Consideration by the examiner of the information submitted in an IDS means nothing more than considering the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search . . ."

[4]35 U.S.C. 305 provides, in pertinent part: " . . . All reexamination proceedings . . . will be conducted with special dispatch within the Office . . ."

[5]See MPEP 2004, paragraph no. 13, which states: "It is desirable to avoid the submission of long lists of documents if it can be avoided. Eliminate clearly irrelevant and marginally pertinent cumulative information. If a long list is submitted, highlight those documents which have been specifically brought to applicant's attention and/or are known to be of most significance."

[6]See footnote #1.

requirement for information, as it pertains to those documents so identified by the patent owner. The patent owner is not required to newly review any submissions.

If, however, **the patent owner has in fact reviewed** one or more of the submissions, or has a recollection of information from a previous review of one or more of the submissions not related to the litigation, or has otherwise obtained information regarding one or more of the submissions, the patent owner **must** reply to the questions presented below. **This is the actual knowledge to which the instant requirement for information is addressed.**

Based upon the above, should the patent owner be able to supply any of the requested information about any of the cited prior art, the patent owner is required to supply with such information:

(1) A list of all of the prior art represented by the discussion citations. Each page of the list must include:

(i) The reexamination proceeding control number (in the instant case, the reexamination proceeding control number is 90/006,437), and the patent number, issue date, and first-named inventor of the patent for which reexamination is requested; and

(ii) A column that provides a space, next to each document to be considered, for the examiner's initials.

(2) A legible copy of:

(i) Each foreign patent, and each printed publication, other than U.S. patents and U.S. patent application publications, that is represented by the discussed citations, with appropriate portions underlined or otherwise marked; and

(ii) An English language translation of all the necessary and pertinent parts of any non-English language patent or printed publication that is represented by the discussed citations, with appropriate portions underlined or otherwise marked.

Where there are more than five citations discussed, the copies of the prior art represented by the discussed citations are to be separated by type of citation (e.g., foreign patents, nonpatent literature) and are to be placed in numerical order.

Questions:

1. Identify each listed citation for which the corresponding piece of prior art was reviewed in any way in the context of the subject matter of this proceeding. Identify who reviewed the citation and the extent of the review.

2. For each citation identified in Question 1, set forth whatever actual knowledge (e.g., of the pertinency of the prior art) was obtained from reviewing the piece of prior art, and in particular, how that actual knowledge relates to any element of any claim in the reexamination proceeding. Duplicative knowledge should NOT be supplied.

3. For each citation where actual knowledge thereof was obtained in a manner other than reviewing the corresponding piece of prior art, such as where knowledge arose from communication from an adverse party, set forth that knowledge as it relates to any element of any claim in reexamination. Duplicative knowledge should be supplied.

4. For each piece of actual knowledge provided in answer to either Questions #2 or #3, identify each claim element in the reexamination to which it would apply, as well as where that actual knowledge appears in a piece of cited prior art.

5. Whenever the litigation involving the patent being reexamined identified a subset of the citations submitted in the information disclosure statements, identify the subset. For example, if, during litigation, a subset of references which were particularly pertinent to one of the patented claims was identified, then the patent owner must identify that subset, and the pertinency of the information contained in that subset of references.

The reply must be a complete reply. All of the references cited in the currently submitted information disclosure statements must be identified in the reply, either as documents of which the patent owner has not reviewed and has no actual knowledge of any material information contained therein, or as documents which the patent owner has reviewed. **Any reply which fails to identify all of the documents cited in the currently submitted information disclosure statements will be considered to be an incomplete reply.**

After the patent owner responds to this requirement for information, there may or may not be a need for further information from the patent owner.

Continuing Duty

The patent owner is reminded that the duty to disclose material information and the information requested by the instant requirement for information is a continuous duty and exists with respect to each claim until the claim is cancelled. As stated in 37 CFR 1.555(a):

> "The duty to disclose the information exists with respect to each claim pending in the reexamination proceeding **until the claim is cancelled**.... The duty to disclose all information known to be material to patentability in a reexamination proceeding is deemed to be satisfied if **all** information known to be material to patentability of any claim in the patent **after issuance of the reexamination certificate** was cited by the Office or submitted to the Office in an information disclosure statement." [Emphasis added.]

For example, the patent owner is asked whether any of the prior art documents represented by the citations have been reviewed. If the patent owner first reviews any of these documents subsequent to the filing of a reply to the instant requirement for information, a supplemental reply must be submitted supplying the updated information.

CONCLUSION

The request for reconsideration has been considered, and is **granted**.

Pursuant to 37 CFR 1.105, **the patent owner is required to supply**, in accordance with the above, whatever *actual knowledge* that the patent owner, or any other party associated with the patent owner as defined in 37 CFR 1.555(a), may have regarding material information relating to the prior art cited by the patent owner in this proceeding.

The patent owner is given a shortened statutory period of **thirty (30) days** from the date of this decision to reply to the requirement for information. Extensions of time, **for sufficient cause only,** are available pursuant to 37 CFR 1.550(c).

The **failure to file a complete reply** to the instant requirement for information will be construed as a request to withdraw all currently submitted information disclosure statements from

consideration by the examiner. While the information disclosure statements have been entered into the official file, the examiner will not be required to consider any of the references submitted with the information disclosure statements. The Office will then proceed with the reexamination.

This file is being returned to the Office of the Special Programs Examiner of Technology Center 2600. The Technology Center will await a reply to the requirement for information, or the expiration of the time for a reply, after which an Office action will be issued in a manner not inconsistent with this decision.

Telephone inquiries with regard to this decision should be directed to either Kenneth Schor, Senior Legal Advisor at 571-272-7710, or Cynthia L. Nessler, Legal Advisor, at 571-272-7724.

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

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Paper No. 13

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For Patent Owner

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For Third Party Requester

In re Roberts et al.
Reexamination Proceeding
Control No.: 90/006,437
Filed: October 28, 2002
For: U.S. Patent Number: 6,233,010

: **DECISION GRANTING REQUEST**
: **FOR RECONSIDERATION AND**
: **REQUIRING INFORMATION**
: **PURSUANT TO 37 CFR 1.105**

This is a decision on the patent owner's April 30, 2004, request for reconsideration, entitled "Response to Notification *Re* Defective Information Disclosure Statements and Show Cause Why the Submitted Information Disclosure Statements Should Be Retained and Considered."

This is also a requirement for information pursuant to 37 CFR 1.105.

The instant reexamination proceeding is before the Director of the Office of Patent Legal Administration for decision on the request for reconsideration, and other consideration as the proceeding may warrant.

The request for reconsideration is granted.

Pursuant to 37 CFR 1.105, the patent owner is required to supply, to the extent stated hereinafter, whatever *actual knowledge* that the patent owner, or any other party associated with the patent owner as defined within 37 CFR 1.555(a)[1], may have regarding material information relating to the prior art cited by the patent owner in this proceeding.

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[1] 37 CFR 1.555(a) provides, in pertinent part: ". . . The individuals who have a duty to disclose to the Office all information known to them to be material to patentability in a reexamination proceeding are the patent owner, each attorney or agent who represents the patent owner, and every other individual who is substantively involved on behalf of the patent owner in a reexamination proceeding . . ."

BACKGROUND

- U.S. Patent No. 6,233,010 (the '010 patent) was issued to Roberts et al, on May 15, 2001.
- On October 28, 2002, a request for reexamination of the '010 patent was filed by a third party requester and was assigned Control No. 90/006,437 (the '6437 proceeding).
- On January 8, 2003, reexamination was ordered in the '6437 proceeding.
- The time period for filing a patent owner's statement under 37 CFR 1.530 has expired, and no patent owner's statement has been received for the '6437 proceeding.
- On December 11, 2003, a petition under 37 CFR 1.181(a)(3)and 1.182 to the Director was filed by a third party who was not the third party requester. The petition was returned as an improper submission in a decision of the Director of Technology Center 2600 dated March 9, 2004.
- In each of four companion reexamination proceedings including the present proceeding (the '6435, '6436, '6437, and '6438 proceedings), the patent owner has filed seven information disclosure statement (IDS) submissions containing numerous citations on March 10, 2003 (IDS #1), September 8, 2003 (IDS #2), October 8, 2003 (IDS #3), December 29, 2003 (IDS #4), January 19, 2004 (IDS #5), and March 9, 2004 (IDS #6), and August 11, 2004 (IDS #7). [2]
- The content of the seven IDS submissions is as follows:

IDS #1, filed 3/10/03 - 20 sheets listing:

95 U.S. patents, 30 foreign patent documents, and 183 "other documents."

IDS #2, filed 9/8/03 - 2 sheets listing:

22 other documents.

IDS #3, filed 10/8/03 - 1 sheet listing:

1 U.S. patent

IDS #4, filed 12/29/03 - 26 sheets listing:

373 US patents, 78 foreign patent documents, and 34 other documents.

IDS #5, filed 1/19/04 - 1 sheet listing:

2 attached fax messages comprising listings of -

fax # (1) 41 pages including 512 total documents, and

fax # (2) 10 pages of documents (137 US patents, 47 foreign patents, and 97 other documents).

IDS #6, filed 3/9/04 - 6 sheets listing:

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[2] The numbering of the IDS submissions is for purposes of this decision only, and does not reflect the total number of such submissions in the proceeding.

19 US patents, 42 foreign patent documents, and 86 other documents.

IDS #7, filed 8/11/04 - 1 sheet listing:

5 foreign patent documents and 1 other document.

- The IDS submissions of March 10, 2003, September 8, 2003, and October 8, 2003, have been entered into the record as papers of the record. The IDS submissions of December 29, 2003, January 19, 2004, March 9, 2004, and August 11, 2004 have not yet been entered into the record as papers. Nothing has been indicated yet on the record as to whether any of the submitted citations will be considered.

- On April 1, 2004, a Notification *Re* Defective Information Disclosure Statements was mailed. The patent owner was given one month (from the date of mailing the notification) to either:

  (A) Show cause why the IDS submissions should be retained and considered, or

  (B) Make arrangements to pick up the boxes of IDS submissions from the Technology Center.

  The patent owner was informed that the failure of the patent owner to carry out either (9)(A) or (9)(B) would result in the IDS documents being discarded.

- On April 30, 2004, the present request for reconsideration, entitled "Response to Notification *Re* Defective Information Disclosure Statements And Show Cause Why the Submitted Information Disclosure Statements Should Be Retained and Considered," was received.

- On September 10, 2004, a "Submission of Court Papers from Litigation Involving Patent in Reexamination" was filed, reiterating information previously made known to the Office, and advising the Office of new developments in concurrent litigation.

- A first Office action on the merits has not yet been issued.

REQUEST FOR RECONSIDERATION

Upon review of patent owner's request for reconsideration received on April 30, 2004, the request for reconsideration has been **granted**. The Notification *Re* Defective Information Disclosure Statements, mailed on April 1, 2004, has been **withdrawn**.

The IDS submissions of December 29, 2003, January 19, 2004, March 9, 2004, and August 11, 2004, will be entered into the official record of the present reexamination proceeding as papers of record. The IDS submissions of March 10, 2003, September 8, 2003, and October 8, 2003, have already been entered into the record as papers of record as noted above.

If the patent owner submits an appropriate reply to the requirement for information under 37 CFR 1.105 set forth in this decision, the references will be considered. While the examiner has an obligation to consider the references cited in the information disclosure statements once the

minimum requirements of 37 CFR 1.97 and 1.98 have been met,[3] this obligation will be withdrawn if the patent owner fails to reply to the requirement for information under 37 CFR 1.105 set forth in this decision. The requirement for information under 37 CFR 1.105 is reasonably necessary for the reasons given below.

REQUIREMENT FOR INFORMATION PURSUANT TO 37 CFR 1.105

Reexamination proceedings must be conducted with "special dispatch", pursuant to 35 U.S.C. 305.[4] At the same time, there is a public interest that any material prior art that may have been previously overlooked in the issuance of the patent be reviewed in a reexamination proceeding.

This interest is especially significant in the present reexamination proceeding, given the current litigation involving the instant patent. In this instance, the totality of the submissions to be reviewed make up numerous boxes of unsorted prior art copies that are listed in approximately 100 pages of citations. There is no guidance as to the pertinency of the information contained in the boxes. The extensive amount of prior art that the patent owner is requiring the Office to review, coupled with the lack of meaningful guidance as to their pertinency, not only increases the possibility that a material teaching may continue to be inadvertently overlooked by the Office[5], it also causes a substantial delay in the prosecution of this reexamination proceeding. This delay clearly hinders the Office in carrying out its statutory mandate to conduct reexamination proceedings with "special dispatch."

It is therefore reasonably necessary that the patent owner be required to supply whatever *actual knowledge* that the patent owner, or any other party associated with the patent owner as defined in 37 CFR 1.555(a)[6], may have regarding material information relating to the cited prior art. An example of "material information" would include information regarding the pertinency of the prior art to at least one claim of the patent.

It is possible that the patent owner has never reviewed at least some of the cited prior art. For example, many of the documents were apparently submitted to the patent owner during litigation of the patent. The patent owner, therefore, may not have actual knowledge of at least some of the information, or of the material nature of at least some of the information, presented in the submissions. If this is the case, the patent owner may so state, identifying the documents of which he has no actual knowledge, or of which he has no actual knowledge of any material information contained therein. This statement will be considered a complete reply to the instant

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[3]MPEP 609 provides, in pertinent part: ". . . Once the minimum requirements of 37 CFR 1.97 and 37 CFR 1.98 are met, the examiner has an obligation to consider the information. Consideration by the examiner of the information submitted in an IDS means nothing more than considering the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search . . ."

[4]35 U.S.C. 305 provides, in pertinent part: " . . . All reexamination proceedings . . . will be conducted with special dispatch within the Office . . ."

[5]See MPEP 2004, paragraph no. 13, which states: "It is desirable to avoid the submission of long lists of documents if it can be avoided. Eliminate clearly irrelevant and marginally pertinent cumulative information. If a long list is submitted, highlight those documents which have been specifically brought to applicant's attention and/or are known to be of most significance."

[6]See footnote #1.

requirement for information, as it pertains to those documents so identified by the patent owner. The patent owner is not required to newly review any submissions.

If, however, **the patent owner has in fact reviewed** one or more of the submissions, or has a recollection of information from a previous review of one or more of the submissions not related to the litigation, or has otherwise obtained information regarding one or more of the submissions, the patent owner **must** reply to the questions presented below. **This is the actual knowledge to which the instant requirement for information is addressed.**

Based upon the above, should the patent owner be able to supply any of the requested information about any of the cited prior art, the patent owner is required to supply with such information:

(1) A list of all of the prior art represented by the discussion citations. Each page of the list must include:

(i) The reexamination proceeding control number (in the instant case, the reexamination proceeding control number is 90/006,437), and the patent number, issue date, and first-named inventor of the patent for which reexamination is requested; and

(ii) A column that provides a space, next to each document to be considered, for the examiner's initials.

(2) A legible copy of:

(i) Each foreign patent, and each printed publication, other than U.S. patents and U.S. patent application publications, that is represented by the discussed citations, with appropriate portions underlined or otherwise marked; and

(ii) An English language translation of all the necessary and pertinent parts of any non-English language patent or printed publication that is represented by the discussed citations, with appropriate portions underlined or otherwise marked.

Where there are more than five citations discussed, the copies of the prior art represented by the discussed citations are to be separated by type of citation (e.g., foreign patents, nonpatent literature) and are to be placed in numerical order.

Questions:

1. Identify each listed citation for which the corresponding piece of prior art was reviewed in any way in the context of the subject matter of this proceeding. Identify who reviewed the citation and the extent of the review.

2. For each citation identified in Question 1, set forth whatever actual knowledge (e.g., of the pertinency of the prior art) was obtained from reviewing the piece of prior art, and in particular, how that actual knowledge relates to any element of any claim in the reexamination proceeding. Duplicative knowledge should NOT be supplied.

3. For each citation where actual knowledge thereof was obtained in a manner other than reviewing the corresponding piece of prior art, such as where knowledge arose from communication from an adverse party, set forth that knowledge as it relates to any element of any claim in reexamination. Duplicative knowledge should be supplied.

4. For each piece of actual knowledge provided in answer to either Questions #2 or #3, identify each claim element in the reexamination to which it would apply, as well as where that actual knowledge appears in a piece of cited prior art.

5. Whenever the litigation involving the patent being reexamined identified a subset of the citations submitted in the information disclosure statements, identify the subset. For example, if, during litigation, a subset of references which were particularly pertinent to one of the patented claims was identified, then the patent owner must identify that subset, and the pertinency of the information contained in that subset of references.

The reply must be a complete reply. All of the references cited in the currently submitted information disclosure statements must be identified in the reply, either as documents of which the patent owner has not reviewed and has no actual knowledge of any material information contained therein, or as documents which the patent owner has reviewed. **Any reply which fails to identify all of the documents cited in the currently submitted information disclosure statements will be considered to be an incomplete reply.**

After the patent owner responds to this requirement for information, there may or may not be a need for further information from the patent owner.

Continuing Duty

The patent owner is reminded that the duty to disclose material information and the information requested by the instant requirement for information is a continuous duty and exists with respect to each claim until the claim is cancelled. As stated in 37 CFR 1.555(a):

> "The duty to disclose the information exists with respect to each claim pending in the reexamination proceeding **until the claim is cancelled**.... The duty to disclose all information known to be material to patentability in a reexamination proceeding is deemed to be satisfied if **all** information known to be material to patentability of any claim in the patent **after issuance of the reexamination certificate** was cited by the Office or submitted to the Office in an information disclosure statement." [Emphasis added.]

For example, the patent owner is asked whether any of the prior art documents represented by the citations have been reviewed. If the patent owner first reviews any of these documents subsequent to the filing of a reply to the instant requirement for information, a supplemental reply must be submitted supplying the updated information.

CONCLUSION

The request for reconsideration has been considered, and is **granted**.

Pursuant to 37 CFR 1.105, **the patent owner is required to supply**, in accordance with the above, whatever *actual knowledge* that the patent owner, or any other party associated with the patent owner as defined in 37 CFR 1.555(a), may have regarding material information relating to the prior art cited by the patent owner in this proceeding.

The patent owner is given a shortened statutory period of **thirty (30) days** from the date of this decision to reply to the requirement for information. Extensions of time, **for sufficient cause only,** are available pursuant to 37 CFR 1.550(c).

The **failure to file a complete reply** to the instant requirement for information will be construed as a request to withdraw all currently submitted information disclosure statements from

consideration by the examiner. While the information disclosure statements have been entered into the official file, the examiner will not be required to consider any of the references submitted with the information disclosure statements. The Office will then proceed with the reexamination.

This file is being returned to the Office of the Special Programs Examiner of Technology Center 2600. The Technology Center will await a reply to the requirement for information, or the expiration of the time for a reply, after which an Office action will be issued in a manner not inconsistent with this decision.

Telephone inquiries with regard to this decision should be directed to either Kenneth Schor, Senior Legal Advisor at 571-272-7710, or Cynthia L. Nessler, Legal Advisor, at 571-272-7724.

Robert J. Spar
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In re Roberts et al.
Reexamination Proceeding
Control No.: 90/006,437
Filed: October 28, 2002
For: U.S. Patent No.: 6,233,010

DECISION ON PETITION UNDER 37 CFR 1.182

This is a decision on the August 28, 2006 patent owner petition under 37 CFR 1.182 to enter, and to have the examiner consider, an information disclosure statement (IDS) filed after the termination of the prosecution in this reexamination proceeding.

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

The petition is dismissed for the reasons set forth below.

REVIEW OF SALIENT FACTS

1. Patent number 6,233,010 issued on May 15, 2001 with 1 claim.
2. A request for reexamination, assigned control No. 90/006,437 (the '437 proceeding), was filed on October 28, 2002, by the patent owner.
3. An order granting the reexamination request was mailed January 8, 2003.
4. A Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the '437 proceeding on April 3, 2006.
5. An Information Disclosure Statements (IDS) was filed by the patent owner on June 2, 2006.
6. The Office mailed a communication for the '437 proceeding on June 21, 2006 stating that the IDS filed on June 2, 2006 was not considered because it lacked an entry right.
7. The instant petition was filed on August 28, 2006, accompanied by a new IDS (i.e. a resubmission of the information in the June 2, 2006 IDS), which the patent owner requests the Office to consider.

8. The reexamination proceeding is in the final phase of being prepared for printing of the reexamination certificate (it is in the printing cycle).

RELEVANT LAW AND PROCEDURE

35 U.S.C. 305 Conduct of reexamination proceedings.

... All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with **special dispatch** within the Office. (Emphasis added.)

MPEP 2656 (Rev. 5, Aug. 2006)

.....Once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC.

Once the reexamination has entered the Reexamination Certificate publication process, pulling the proceeding from that process provides an even greater measure of delay. 37 CFR 1.313 states for an application (emphasis added):

> "(c) Once the issue fee has been paid, **the application will not be withdrawn from issue upon petition by the applicant for any reason except:**
> (1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;"

The publication process for an application occurs after the payment of the issue fee (there is no issue fee in reexamination), and thus 37 CFR 1.313(c) applies during the publication cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its publication cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). **Accordingly, where a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), is made while a proceeding is in its publication cycle, the patent owner must provide an unequivocal statement as to why the art submitted makes at least one claim unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable. This is in addition to** the above-discussed (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier. The submission of patents and printed publications must be accompanied by a petition under 37 CFR 1.182 (with petition fee) for withdrawal of the reexamination proceeding from the publication process for entry and consideration of the information submitted by patent owner. A grantable petition must provide the requisite showing discussed in this paragraph. (Emphasis added)

DECISION

There is no issue fee in reexamination, and the present reexamination proceeding has entered the final phase of the publication process (the "printing cycle"). In a reexamination proceeding, there is no withdrawal under 37 CFR 1.313 of the proceeding from the publication process for consideration of an Information Disclosure Statement (IDS), because 37 CFR 1.313(a) applies to applications and not to reexamination proceedings. Accordingly, in this instance the petition for withdrawal of the proceeding from the publication process for consideration of the accompanying IDS papers has been filed under 37 C.F.R. 1.182.

While there is no regulatory provision for withdrawal of a <u>reexamination proceeding</u> from the publication process for consideration of an IDS, 37 CFR 1.313 provides such a mechanism for an application. Accordingly, the requirements of 37 CFR 1.313 for withdrawal of an application from the printing cycle (after the issue fee has been paid) have historically been applied

analogously to the requirements for withdrawal of reexamination proceedings from the printing cycle. This policy is explicitly set forth in the latest revision of MPEP 2656 as follows:

> ... The publication process for an application occurs after the payment of the issue fee (there is no issue fee in reexamination), and thus 37 CFR 1.313(c) applies during the publication cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its publication cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its publication cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). **Accordingly, where a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), is made while a proceeding is in its publication cycle, the patent owner must provide an unequivocal statement as to why the art submitted makes at least one claim unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable. This is in addition to** the above-discussed (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier. The submission of patents and printed publications must be accompanied by a petition under 37 CFR 1.182 (with petition fee) for withdrawal of the reexamination proceeding from the publication process for entry and consideration of the information submitted by patent owner. A grantable petition must provide the requisite showing discussed in this paragraph. (Emphasis added)

In the present instance, the fact situation fails to satisfy any grounds that would be analogous to those of 37 CFR 1.313(c). The instant petition was filed very late in the examination of the reexamination, and it fails to provide a statement as to why the submitted IDS items of information (art citations) make at least one claim unpatentable. To the contrary, patent owner merely states that the items of information were not submitted earlier because of "inadvertent and unintentional misplacement." Patent owner does not provide a discussion of the substance of any of the items of information, and has not applied the teachings of the same to the claim limitations in the present reexamination proceeding.

For *ex parte* reexamination, there is a statutory requirement pursuant to 35 U.S.C. 305 that all *ex parte* reexamination proceedings "will be conducted with special dispatch within the Office." It is required that the withdrawal criteria of 37 CFR 1.313(c) be complied with for an application, in which there is no statutory requirement for special dispatch, and such criteria must certainly be complied with for a reexamination proceeding where there is a statutory requirement for special dispatch. This is explicitly set forth in the latest revision of the MPEP as set forth above.

A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on August 10, 2005, and the proceeding has now entered the final stages of the publication process. The proceeding is not scheduled to come up for further action on the merits. In this instance, the present proceeding would need to be withdrawn from the publication process, thus regressing the processing of the proceeding. This would run contrary to the statutory requirement of 35 U.S.C. 305 that "[a]ll reexamination proceedings under this section...will be conducted with special dispatch within the Office." The statutory mandate of special dispatch is based upon the public interest in providing certainty and finality as to the question of patentability raised by the request for reexamination. In view of the fact that the information submitted was submitted after termination of the prosecution in this reexamination proceeding, is not asserted as raising a question of patentability of the claims, and it is not in any way discussed in detail, it is proper that the reexamination proceeding should not be reopened at this late date to consider the proffered IDS papers. Accordingly the petition is dismissed as to the request for consideration of the IDS papers. The proceeding will not be withdrawn from the publication process.

<u>If, however</u>, the patent owner in fact believes that one or more references submitted raises a substantial question of patentability as to at least one claim of the patent different than raised in

this proceeding, the patent owner can always file a new request for reexamination for consideration of such references.

The IDS submitted by patent owner will be placed in the file, and will remain of record. However, since prosecution has been terminated for this reexamination proceeding, the IDS will not be considered by the examiner.

In view of the above, the petition is dismissed.

CONCLUSION

1. The petition is dismissed as to the request for consideration of the IDS filed on August 28, 2006.

2. The IDS papers will be entered into the file, but will not be considered by the examiner.

3. The present proceeding will continue in the publication process, toward issuance of a reexamination certificate.

4. Telephone inquiries related to this decision should be directed to Karen M. Hastings, Legal Advisor, at (571) 272-7717.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

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Paper No. 13

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For Patent Owner

MAILED
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REEXAM UNIT

Lerner, David, Littenberg,
Krumholz & Mentlik
600 South Avenue West
Westfield, NJ 00530

For Third Party Requester

In re Roberts et al.
Reexamination Proceeding
Control No.: 90/006,438
Filed: October 28, 2002
For: U.S. Patent Number: 6,323,899

: **DECISION GRANTING REQUEST**
: **FOR RECONSIDERATION AND**
: **REQUIRING INFORMATION**
: **PURSUANT TO 37 CFR 1.105**

This is a decision on the patent owner's April 30, 2004, request for reconsideration, entitled "Response to Notification *Re* Defective Information Disclosure Statements and Show Cause Why the Submitted Information Disclosure Statements Should Be Retained and Considered."

This is also a requirement for information pursuant to 37 CFR 1.105.

The instant reexamination proceeding is before the Director of the Office of Patent Legal Administration for decision on the request for reconsideration, and other consideration as the proceeding may warrant.

The request for reconsideration is granted.

Pursuant to 37 CFR 1.105, the patent owner is required to supply, to the extent stated hereinafter, whatever *actual knowledge* that the patent owner, or any other party associated with the patent owner as defined within 37 CFR 1.555(a)[1], may have regarding material information relating to the prior art cited by the patent owner in this proceeding.

[1] 37 CFR 1.555(a) provides, in pertinent part: ". . . The individuals who have a duty to disclose to the Office all information known to them to be material to patentability in a reexamination proceeding are the patent owner, each attorney or agent who represents the patent owner, and every other individual who is substantively involved on behalf of the patent owner in a reexamination proceeding . . ."

BACKGROUND

- U.S. Patent No. 6,323,899 (the '899 patent) was issued to Roberts et al, on November 27, 2001.
- On October 28, 2002, a request for reexamination of the '899 patent was filed by a third party requester and was assigned Control No. 90/006,438 (the '6438 proceeding).
- On January 8, 2003, reexamination was ordered in the '6438 proceeding.
- The time period for filing a patent owner's statement under 37 CFR 1.530 has expired, and no patent owner's statement has been received for the '6438 proceeding.
- On December 11, 2003, a petition under 37 CFR 1.181(a)(3)and 1.182 to the Director was filed by a third party who was not the third party requester. The petition was returned as an improper submission in a decision of the Director of Technology Center 2600 dated March 9, 2004.
- In each of four companion reexamination proceedings including the present proceeding (the '6435, '6436, '6437, and '6438 proceedings), the patent owner has filed seven information disclosure statement (IDS) submissions containing numerous citations on March 10, 2003 (IDS #1), September 8, 2003 (IDS #2), October 8, 2003 (IDS #3), December 29, 2003 (IDS #4), January 19, 2004 (IDS #5), and March 9, 2004 (IDS #6), and August 11, 2004 (IDS #7). [2]
- The content of the seven IDS submissions is as follows:

IDS #1, filed 3/10/03 - 20 sheets listing:

95 U.S. patents, 30 foreign patent documents, and 183 "other documents."

IDS #2, filed 9/8/03 - 2 sheets listing:

22 other documents.

IDS #3, filed 10/8/03 - 1 sheet listing:

1 U.S. patent

IDS #4, filed 12/29/03 - 26 sheets listing:

373 US patents, 78 foreign patent documents, and 34 other documents.

IDS #5, filed 1/19/04 - 1 sheet listing:

2 attached fax messages comprising listings of -

fax # (1) 41 pages including 512 total documents, and

fax # (2) 10 pages of documents (137 US patents, 47 foreign patents, and 97 other documents).

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[2] The numbering of the IDS submissions is for purposes of this decision only, and does not reflect the total number of such submissions in the proceeding.

IDS #6, filed 3/9/04 - 6 sheets listing:

19 US patents, 42 foreign patent documents, and 86 other documents.

IDS #7, filed 8/11/04 - 1 sheet listing:

5 foreign patent documents and 1 other document.

- The IDS submissions of March 10, 2003, September 8, 2003, and October 8, 2003, have been entered into the record as papers of the record. The IDS submissions of December 29, 2003, January 19, 2004, March 9, 2004, and August 11, 2004 have not yet been entered into the record as papers. Nothing has been indicated yet on the record as to whether any of the submitted citations will be considered.

- On April 1, 2004, a Notification *Re* Defective Information Disclosure Statements was mailed. The patent owner was given one month (from the date of mailing the notification) to either:

  (A) Show cause why the IDS submissions should be retained and considered, or

  (B) Make arrangements to pick up the boxes of IDS submissions from the Technology Center.

  The patent owner was informed that the failure of the patent owner to carry out either (9)(A) or (9)(B) would result in the IDS documents being discarded.

- On April 30, 2004, the present request for reconsideration, entitled "Response to Notification *Re* Defective Information Disclosure Statements And Show Cause Why the Submitted Information Disclosure Statements Should Be Retained and Considered," was received.

- On September 10, 2004, a "Submission of Court Papers from Litigation Involving Patent in Reexamination" was filed, reiterating information previously made known to the Office, and advising the Office of new developments in concurrent litigation.

- A first Office action on the merits has not yet been issued.

REQUEST FOR RECONSIDERATION

Upon review of patent owner's request for reconsideration received on April 30, 2004, the request for reconsideration has been **granted**. The Notification *Re* Defective Information Disclosure Statements, mailed on April 1, 2004, has been **withdrawn**.

The IDS submissions of December 29, 2003, January 19, 2004, March 9, 2004, and August 11, 2004, will be entered into the official record of the present reexamination proceeding as papers of record. The IDS submissions of March 10, 2003, September 8, 2003, and October 8, 2003, have already been entered into the record as papers of record as noted above.

If the patent owner submits an appropriate reply to the requirement for information under 37 CFR 1.105 set forth in this decision, the references will be considered. While the examiner has an obligation to consider the references cited in the information disclosure statements once the

minimum requirements of 37 CFR 1.97 and 1.98 have been met,[3] this obligation will be withdrawn if the patent owner fails to reply to the requirement for information under 37 CFR 1.105 set forth in this decision. The requirement for information under 37 CFR 1.105 is reasonably necessary for the reasons given below.

REQUIREMENT FOR INFORMATION PURSUANT TO 37 CFR 1.105

Reexamination proceedings must be conducted with "special dispatch", pursuant to 35 U.S.C. 305.[4] At the same time, there is a public interest that any material prior art that may have been previously overlooked in the issuance of the patent be reviewed in a reexamination proceeding.

This interest is especially significant in the present reexamination proceeding, given the current litigation involving the instant patent. In this instance, the totality of the submissions to be reviewed make up numerous boxes of unsorted prior art copies that are listed in approximately 100 pages of citations. There is no guidance as to the pertinency of the information contained in the boxes. The extensive amount of prior art that the patent owner is requiring the Office to review, coupled with the lack of meaningful guidance as to their pertinency, not only increases the possibility that a material teaching may continue to be inadvertently overlooked by the Office[5], it also causes a substantial delay in the prosecution of this reexamination proceeding. This delay clearly hinders the Office in carrying out its statutory mandate to conduct reexamination proceedings with "special dispatch."

It is therefore reasonably necessary that the patent owner be required to supply whatever *actual knowledge* that the patent owner, or any other party associated with the patent owner as defined in 37 CFR 1.555(a)[6], may have regarding material information relating to the cited prior art. An example of "material information" would include information regarding the pertinency of the prior art to at least one claim of the patent.

It is possible that the patent owner has never reviewed at least some of the cited prior art. For example, many of the documents were apparently submitted to the patent owner during litigation of the patent. The patent owner, therefore, may not have actual knowledge of at least some of the information, or of the material nature of at least some of the information, presented in the submissions. If this is the case, the patent owner may so state, identifying the documents of which he has no actual knowledge, or of which he has no actual knowledge of any material information contained therein. This statement will be considered a complete reply to the instant

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[3]MPEP 609 provides, in pertinent part: ". . . Once the minimum requirements of 37 CFR 1.97 and 37 CFR 1.98 are met, the examiner has an obligation to consider the information. Consideration by the examiner of the information submitted in an IDS means nothing more than considering the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search . . ."

[4]35 U.S.C. 305 provides, in pertinent part: " . . . All reexamination proceedings . . . will be conducted with special dispatch within the Office . . ."

[5]See MPEP 2004, paragraph no. 13, which states: "It is desirable to avoid the submission of long lists of documents if it can be avoided. Eliminate clearly irrelevant and marginally pertinent cumulative information. If a long list is submitted, highlight those documents which have been specifically brought to applicant's attention and/or are known to be of most significance."

[6]See footnote #1.

requirement for information, as it pertains to those documents so identified by the patent owner. The patent owner is not required to newly review any submissions.

If, however, **the patent owner has in fact reviewed** one or more of the submissions, or has a recollection of information from a previous review of one or more of the submissions not related to the litigation, or has otherwise obtained information regarding one or more of the submissions, the patent owner **must** reply to the questions presented below. **This is the actual knowledge to which the instant requirement for information is addressed.**

Based upon the above, should the patent owner be able to supply any of the requested information about any of the cited prior art, the patent owner is required to supply with such information:

(1) A list of all of the prior art represented by the discussion citations. Each page of the list must include:

(i) The reexamination proceeding control number (in the instant case, the reexamination proceeding control number is 90/006,438), and the patent number, issue date, and first-named inventor of the patent for which reexamination is requested; and

(ii) A column that provides a space, next to each document to be considered, for the examiner's initials.

(2) A legible copy of:

(i) Each foreign patent, and each printed publication, other than U.S. patents and U.S. patent application publications, that is represented by the discussed citations, with appropriate portions underlined or otherwise marked; and

(ii) An English language translation of all the necessary and pertinent parts of any non-English language patent or printed publication that is represented by the discussed citations, with appropriate portions underlined or otherwise marked.

Where there are more than five citations discussed, the copies of the prior art represented by the discussed citations are to be separated by type of citation (e.g., foreign patents, nonpatent literature) and are to be placed in numerical order.

Questions:

1. Identify each listed citation for which the corresponding piece of prior art was reviewed in any way in the context of the subject matter of this proceeding. Identify who reviewed the citation and the extent of the review.

2. For each citation identified in Question 1, set forth whatever actual knowledge (e.g., of the pertinency of the prior art) was obtained from reviewing the piece of prior art, and in particular, how that actual knowledge relates to any element of any claim in the reexamination proceeding. Duplicative knowledge should NOT be supplied.

3. For each citation where actual knowledge thereof was obtained in a manner other than reviewing the corresponding piece of prior art, such as where knowledge arose from communication from an adverse party, set forth that knowledge as it relates to any element of any claim in reexamination. Duplicative knowledge should be supplied.

4. For each piece of actual knowledge provided in answer to either Questions #2 or #3, identify each claim element in the reexamination to which it would apply, as well as where that actual knowledge appears in a piece of cited prior art.

5. Whenever the litigation involving the patent being reexamined identified a subset of the citations submitted in the information disclosure statements, identify the subset. For example, if, during litigation, a subset of references which were particularly pertinent to one of the patented claims was identified, then the patent owner must identify that subset, and the pertinency of the information contained in that subset of references.

The reply must be a complete reply. All of the references cited in the currently submitted information disclosure statements must be identified in the reply, either as documents of which the patent owner has not reviewed and has no actual knowledge of any material information contained therein, or as documents which the patent owner has reviewed. **Any reply which fails to identify all of the documents cited in the currently submitted information disclosure statements will be considered to be an incomplete reply.**

After the patent owner responds to this requirement for information, there may or may not be a need for further information from the patent owner.

Continuing Duty

The patent owner is reminded that the duty to disclose material information and the information requested by the instant requirement for information is a continuous duty and exists with respect to each claim until the claim is cancelled. As stated in 37 CFR 1.555(a):

> "The duty to disclose the information exists with respect to each claim pending in the reexamination proceeding **until the claim is cancelled**.... The duty to disclose all information known to be material to patentability in a reexamination proceeding is deemed to be satisfied if **all** information known to be material to patentability of any claim in the patent **after issuance of the reexamination certificate** was cited by the Office or submitted to the Office in an information disclosure statement." [Emphasis added.]

For example, the patent owner is asked whether any of the prior art documents represented by the citations have been reviewed. If the patent owner first reviews any of these documents subsequent to the filing of a reply to the instant requirement for information, a supplemental reply must be submitted supplying the updated information.

CONCLUSION

The request for reconsideration has been considered, and is **granted**.

Pursuant to 37 CFR 1.105, **the patent owner is required to supply**, in accordance with the above, whatever *actual knowledge* that the patent owner, or any other party associated with the patent owner as defined in 37 CFR 1.555(a), may have regarding material information relating to the prior art cited by the patent owner in this proceeding.

The patent owner is given a shortened statutory period of **thirty (30) days** from the date of this decision to reply to the requirement for information. Extensions of time, **for sufficient cause only,** are available pursuant to 37 CFR 1.550(c).

The **failure to file a complete reply** to the instant requirement for information will be construed as a request to withdraw all currently submitted information disclosure statements from

consideration by the examiner. While the information disclosure statements have been entered into the official file, the examiner will not be required to consider any of the references submitted with the information disclosure statements. The Office will then proceed with the reexamination.

This file is being returned to the Office of the Special Programs Examiner of Technology Center 2600. The Technology Center will await a reply to the requirement for information, or the expiration of the time for a reply, after which an Office action will be issued in a manner not inconsistent with this decision.

Telephone inquiries with regard to this decision should be directed to either Kenneth Schor, Senior Legal Advisor at 571-272-7710, or Cynthia L. Nessler, Legal Advisor, at 571-272-7724.

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

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CENTRAL REEXAMINATION UNIT

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(Third Part Requester)

In re Roberts et al.
Reexamination Proceeding
Control No.: 90/006,438
Filed: October 28, 2002
For: U.S. Patent No.: 6,323,899

DECISION ON PETITION UNDER 37 CFR 1.182

This is a decision on the August 28, 2006 patent owner petition under 37 CFR 1.182 to enter, and to have the examiner consider, an information disclosure statement (IDS) filed after the termination of the prosecution in this reexamination proceeding.

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

The petition is dismissed for the reasons set forth below.

REVIEW OF SALIENT FACTS

1. Patent number 6,323,899 issued on November 21, 2001 with 4 claims.
2. A request for reexamination, assigned control No. 90/006,438 (the '438 proceeding), was filed on October 28, 2002, by the patent owner.
3. An order granting the reexamination request was mailed January 8, 2003.
4. A Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the '438 proceeding on April 3, 2006.
5. An Information Disclosure Statements (IDS) was filed by the patent owner on June 2, 2006.
6. The Office mailed a communication for the '438 proceeding on June 21, 2006 stating that the IDS filed on June 2, 2006 was not considered because it lacked an entry right.
7. The instant petition was filed on August 28, 2006, accompanied by a new IDS (i.e. a resubmission of the information in the June 2, 2006 IDS), which the patent owner requests the Office to consider.

8. The reexamination proceeding is in the final phase of being prepared for printing of the reexamination certificate (it is in the printing cycle).

RELEVANT LAW AND PROCEDURE

35 U.S.C. 305 Conduct of reexamination proceedings.

... All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with **special dispatch** within the Office. (Emphasis added.)

MPEP 2656 (Rev. 5, Aug. 2006)

.....Once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC.

Once the reexamination has entered the Reexamination Certificate publication process, pulling the proceeding from that process provides an even greater measure of delay. 37 CFR 1.313 states for an application (emphasis added):

> "(c) Once the issue fee has been paid, **the application will not be withdrawn from issue upon petition by the applicant for any reason except:**
> (1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;"

The publication process for an application occurs after the payment of the issue fee (there is no issue fee in reexamination), and thus 37 CFR 1.313(c) applies during the publication cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its publication cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). **Accordingly, where a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), is made while a proceeding is in its publication cycle, the patent owner must provide an unequivocal statement as to why the art submitted makes at least one claim unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable. This is in addition to** the above-discussed (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier. The submission of patents and printed publications must be accompanied by a petition under 37 CFR 1.182 (with petition fee) for withdrawal of the reexamination proceeding from the publication process for entry and consideration of the information submitted by patent owner. A grantable petition must provide the requisite showing discussed in this paragraph. (Emphasis added)

DECISION

There is no issue fee in reexamination, and the present reexamination proceeding has entered the final phase of the publication process (the "printing cycle"). In a reexamination proceeding, there is no withdrawal under 37 CFR 1.313 of the proceeding from the publication process for consideration of an Information Disclosure Statement (IDS), because 37 CFR 1.313(a) applies to applications and not to reexamination proceedings. Accordingly, in this instance the petition for withdrawal of the proceeding from the publication process for consideration of the accompanying IDS papers has been filed under 37 C.F.R. 1.182.

While there is no regulatory provision for withdrawal of a <u>reexamination proceeding</u> from the publication process for consideration of an IDS, 37 CFR 1.313 provides such a mechanism for an application. Accordingly, the requirements of 37 CFR 1.313 for withdrawal of an application from the printing cycle (after the issue fee has been paid) have historically been applied

analogously to the requirements for withdrawal of reexamination proceedings from the printing cycle. This policy is explicitly set forth in the latest revision of MPEP 2656 as follows:

> ... The publication process for an application occurs after the payment of the issue fee (there is no issue fee in reexamination), and thus 37 CFR 1.313(c) applies during the publication cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its publication cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its publication cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). **Accordingly, where a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), is made while a proceeding is in its publication cycle, the patent owner must provide an unequivocal statement as to why the art submitted makes at least one claim unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable. This is in addition to** the above-discussed (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier. The submission of patents and printed publications must be accompanied by a petition under 37 CFR 1.182 (with petition fee) for withdrawal of the reexamination proceeding from the publication process for entry and consideration of the information submitted by patent owner. A grantable petition must provide the requisite showing discussed in this paragraph. (Emphasis added)

In the present instance, the fact situation fails to satisfy any grounds that would be analogous to those of 37 CFR 1.313(c). The instant petition was filed very late in the examination of the reexamination, and it fails to provide a statement as to why the submitted IDS items of information (art citations) make at least one claim unpatentable. To the contrary, patent owner merely states that the items of information were not submitted earlier because of "inadvertent and unintentional misplacement." Patent owner does not provide a discussion of the substance of any of the items of information, and has not applied the teachings of the same to the claim limitations in the present reexamination proceeding.

For *ex parte* reexamination, there is a statutory requirement pursuant to 35 U.S.C. 305 that all *ex parte* reexamination proceedings "will be conducted with special dispatch within the Office." It is required that the withdrawal criteria of 37 CFR 1.313(c) be complied with for an application, in which there is no statutory requirement for special dispatch, and such criteria must certainly be complied with for a reexamination proceeding where there is a statutory requirement for special dispatch. This is explicitly set forth in the latest revision of the MPEP as set forth above.

A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on August 10, 2005, and the proceeding has now entered the final stages of the publication process. The proceeding is not scheduled to come up for further action on the merits. In this instance, the present proceeding would need to be withdrawn from the publication process, thus regressing the processing of the proceeding. This would run contrary to the statutory requirement of 35 U.S.C. 305 that "[a]ll reexamination proceedings under this section...will be conducted with special dispatch within the Office." The statutory mandate of special dispatch is based upon the public interest in providing certainty and finality as to the question of patentability raised by the request for reexamination. In view of the fact that the information submitted was submitted after termination of the prosecution in this reexamination proceeding, is not asserted as raising a question of patentability of the claims, and it is not in any way discussed in detail, it is proper that the reexamination proceeding should not be reopened at this late date to consider the proffered IDS papers. Accordingly the petition is dismissed as to the request for consideration of the IDS papers. The proceeding will not be withdrawn from the publication process.

<u>If, however</u>, the patent owner in fact believes that one or more references submitted raises a substantial question of patentability as to at least one claim of the patent different than raised in

this proceeding, the patent owner can always file a new request for reexamination for consideration of such references.

The IDS submitted by patent owner will be placed in the file, and will remain of record. However, since prosecution has been terminated for this reexamination proceeding, the IDS will not be considered by the examiner.

In view of the above, the petition is dismissed.

CONCLUSION

1. The petition is dismissed as to the request for consideration of the IDS filed on August 28, 2006.

2. The IDS papers will be entered into the file, but will not be considered by the examiner.

3. The present proceeding will continue in the publication process, toward issuance of a reexamination certificate.

4. Telephone inquiries related to this decision should be directed to Karen M. Hastings, Legal Advisor, at (571) 272-7717.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

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Paper No. 31

Neil S. Cohen Advanced Card Technologies, Inc. 75 Montebello Road Suffern, NY 10901	For Patent Owner
John J. Gresens Merchant & Gould P.C. P.O. Box 2903 Minneapolis, MN 55402-0902	For Requester
In re Reexamination Control No. 90/006,441 Request Filed: November 5, 2002 U.S. Patent No. 5,720,158 Issued: February 24, 1998 Patent Owner: Advanced Card Technologies	DECISION, *SUA SPONTE*, MERGING REEXAMINATION PROCEEDINGS
In re Reexamination Control No. 90/006,795 Request Filed: October 15, 2003 For: U.S. Patent No. 5,720,158 Issued: February 24, 1998 Patent Owner: Advanced Card Technologies	

The above noted reexamination files are before the Director of Patent Examining Group 3700 for consideration of merger of the proceedings under 37 CFR 1.565(c), in accordance with the practice set forth at MPEP § 2283.

Preliminary Matters

On January 13, 2004, in the '441 proceeding, Owner filed an amendment responsive to the Office action dated April 21, 2003. This paper has been entered. There has been no *ex parte* action in the '795 proceeding.

Merger of Copending Reexamination Proceedings

I. Merger of Proceedings

As required by the practice pursuant to MPEP § 2283, and under the authority of 37 CFR 1.565(c), the reexamination proceeding 90/006,441 and reexamination proceeding 90/006,795 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, drawings 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. 31 in both files. There will be no paper Nos. 9-30 in Control No. 90/006,795.

III. Housekeeping Amendment

As discussed above, Owner filed an amendment in control No. 90/006,441 and that paper has been entered in that proceeding. Therefore, Owner is **required** to file a housekeeping amendment in control No. 90/006,795 entering the identical claims therein, as well as making the specification and drawings in the '795 proceeding identical to the specification and drawings in the '441 proceeding if amendments to these items have also been made during the prosecution to date. That paper will be paper No. 32 in control No. 90/006,795. There will then be no paper No. 32 in 90/006,441, unless Owner elects to file additional claims by way of a supplemental amendment in the '441 proceeding. If that is the case, such additional claims **must** also be added to the housekeeping amendment filed in control No. 90/006,795. The next action by the Primary Examiner will then be paper No. 33 in both files. **Owner is required to file the housekeeping amendment not later than ONE MONTH from the date of this decision.** Attention is invited to MPEP § 2282, subsection entitled "Merger of Reexaminations", last paragraph.

IV. Conduct of Merged Proceeding

All 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 and Owner will each receive one copy of the body of the action, and a copy of the cover sheet (*e.g.* Form PTO-466). All papers filed by Owner following filed subsequent to the items in Section III above 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" claims and paragraphs in which specification amendments are requested must be filed together with material satisfying the requirements of 37 CFR 1.530(e).** All words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets. New drawing figures must be labeled "New", while amended drawing figures must be labeled "Amended".

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. 37. 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
Technology Center 3700

REEXAMINATION

66548 U.S. PTO
90006795
10/15/03

PATENT APPLICATION

90006795

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,442	11/05/2002	5921584	10320.11USRX	8013

7590 12/01/2003

ADVANCED CARD TECHNOLOGIES LLC
75 MONTEBELLO ROAD
SUFFERN, NY 10901

EXAMINER
GERRITY

ART UNIT	PAPER NUMBER
3721	25

DATE MAILED: 12/01/2003

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

90006442 .112803

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DEC 1 2003

Paper No. 25

Neil S. Cohen Advanced Card Technologies, Inc. 75 Montebello Road Suffern, NY 10901	: For Patent Owner
John J. Gresens Merchant & Gould P.C. P.O. Box 2903 Minneapolis, MN 55402-0902	: For Requester
In re Reexamination Control No. 90/006,442 U.S. Patent No. 5,921,584 Issued: July 13, 1999 Patent Owner: Advanced Card Technologies Request Filed: November 5, 2002	: DECISION ON PETITION : FOR EXTENSION OF TIME

This is a decision on the paper styled as "Request for Extension of Time Pursuant to 37 CFR 1.550(c)" filed by facsimile transmission on November 25, 2003. Petitioner requests a an extension of time "such that the time period for responding shall expire twenty (20) days after the mailing of the Office Action in the '441 Reexamination." It is noted that the reexamination proceeding referred to is control no. 90/006,441.

The petition is granted to the extent indicated below.

The petition sets forth circumstances which adequately justify the necessity for an extension of time. However, the period of extension requested is an indeterminate one. In view of the adequate justification for an extension of time set forth in the petition, the time for filing a reply to the outstanding Office letter dated October 15, 2003 is extended for a period of one (1) month. A reply to the outstanding Office letter is therefore due on or before January 15, 2004, three months from the date of the outstanding Office action. 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). However, to the extent that additional requests for extension of time are predicated on the necessity of having the examiner's action in the '441 proceeding in hand prior to replying to the outstanding Office letter in this proceeding, Owner will be entitled to request an additional extension of time on that basis and may expect that a request for a reasonable additional fixed period of time to be granted. In no event, however, can the time for filing a reply to the Office letter dated October 15, 2003 be extended to run more than six months from that date.

Owner is requested to note that amendments in reexamination proceedings are governed by 37 CFR 1.530, and not be 37 CFR 1.121. MPEP § 2250 discusses the manner of making amendments in reexamination proceedings. Owner should also note that "Mail Stop *Ex Parte Reexam*" is to be used only for the filing of new requests for ex parte reexamination proceedings. Replies responsive to Office actions in this proceedings should be addressed as one would address a reply directed to a regular nonprovisional application. Facsimile transmissions of official papers to be entered into the record must be made only to (703) 872-9306.

PETITION GRANTED.

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

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P O Box 1450
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JAN 8 2004

Paper No. 27

Neil S. Cohen: Advanced Card Technologies, Inc. 75 Montebello Road Suffern, NY 10901	: For Patent Owner
John J. Gresens Merchant & Gould P.C. P.O. Box 2903 Minneapolis, MN 55402-0902	: For Requester
In re Reexamination Control No. 90/006,442 U.S. Patent No. 5,921,584 Issued: July 13, 1999 Patent Owner: Advanced Card Technologies Request Filed: November 5, 2002	: DECISION ON PETITION : FOR EXTENSION OF TIME

This is a decision on the paper styled as "Request for Extension of Time Pursuant to 37 CFR 1.550(c)" filed by facsimile transmission on January 7, 2004. This is the second request for an extension of time to reply to the outstanding Office action dated October 15, 2003. Petitioner requests an extension of time for a period of one month, so that the reply currently due on January 15, 2004 will be due on February 15, 2004.

The petition is granted.

The petition sets forth circumstances which adequately justify the necessity for an additional one month extension of time. It appears that the extension of time is justified due to the existence of a second reexamination proceeding that involves similar issues. An Office action that should issue on the second reexamination is expected to have an impact on the manner in which owner replies to the October 15, 2003 Office action in this proceeding.

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). However, to the extent that additional requests for extension of time are predicated on the necessity of having the examiner's action in the '441 proceeding in hand prior to replying to the outstanding Office letter in this proceeding, Owner will be entitled to request an additional extension of time on that basis and may expect that a request for a reasonable additional fixed period of time to be granted. In no event, however, can the time for filing a reply to the Office letter dated October 15, 2003 be extended to run more than six months from that date.

Owner is requested to note that amendments in reexamination proceedings are governed by 37 CFR 1.530, and not be 37 CFR 1.121. MPEP § 2250 discusses the manner of making amendments in reexamination proceedings. Owner should also note that "Mail Stop *Ex Parte Reexam*" is to be used only for the filing of new requests for ex parte reexamination proceedings. Replies responsive to Office actions in this proceedings should be addressed as one would address a reply directed to a regular nonprovisional application. Facsimile transmissions of official papers to be entered into the record must be made only to (703) 872-9306.

PETITION GRANTED.

E. Rollins-Cross, Director
Technology Center 3700

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FEB 11 2004

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Paper No. 29

Neil S. Cohen: Advanced Card Technologies, Inc. 75 Montebello Road Suffern, NY 10901	: For Patent Owner
John J. Gresens Merchant & Gould P.C. P.O. Box 2903 Minneapolis, MN 55402-0902	: For Requester
In re Reexamination Control No. 90/006,442 U.S. Patent No. 5,921,584 Issued: July 13, 1999 Patent Owner: Advanced Card Technologies Request Filed: November 5, 2002	: DECISION ON PETITION : FOR EXTENSION OF TIME

This is a decision on the paper styled as "Request for Extension of Time Pursuant to 37 CFR 1.550(c)" filed by facsimile transmission on February 3, 2004. This is the third request for an extension of time to reply to the outstanding Office action dated October 15, 2003. Petitioner requests an extension of time for a period of one month, so that the reply currently due on February 15, 2004 will be due on March 15, 2004. The petition is granted.

The petition sets forth circumstances which adequately justify the necessity for an additional one month extension of time. It appears that the extension of time is justified due to the existence of a second reexamination proceeding that involves similar issues. An Office action that should issue on the second reexamination is expected to have an impact on the manner in which owner replies to the October 15, 2003 Office action in this proceeding.

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). However, to the extent that additional requests for extension of time are predicated on the necessity of having the examiner's action in the '441 proceeding in hand prior to replying to the outstanding Office letter in this proceeding, Owner will be entitled to request an additional extension of time on that basis and may expect that a request for a reasonable additional fixed period of time to be granted. In no event, however, can the time for filing a reply to the Office letter dated October 15, 2003 be extended to run more than six months from that date.

Owner is requested to note that amendments in reexamination proceedings are governed by 37 CFR 1.530, and not be 37 CFR 1.121. MPEP § 2250 discusses the manner of making amendments in reexamination proceedings. Owner should also note that "Mail Stop *Ex Parte Reexam*" is to be used only for the filing of new requests for ex parte reexamination proceedings. Replies responsive to Office actions in this proceedings should be addressed as one would address a reply directed to a regular nonprovisional application. Facsimile transmissions of official papers to be entered into the record must be made only to (703) 872-9306.

PETITION GRANTED.

E. Rollins-Cross, Director
Technology Center 3700

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APR 29 2004

Paper No. 35

Neil S. Cohen Advanced Card Technologies, Inc. 75 Montebello Road Suffern, NY 10901	For Patent Owner
John J. Gresens Merchant & Gould P.C. P.O. Box 2903 Minneapolis, MN 55402-0902	For Requester
In re Reexamination Control No. 90/006,442 Request Filed: November 5, 2002 U.S. Patent No. 5,921,584 Issued: July 13, 1999 Patent Owner: Advanced Card Technologies	DECISION, *SUA SPONTE*, MERGING REEXAMINATION PROCEEDINGS
In re Reexamination Control No. 90/006,796 Request Filed: October 15, 2003 For: U.S. Patent No. 5,921,584 Issued: July 13, 1999 Patent Owner: Advanced Card Technologies	

The above noted reexamination files are before the Director of Patent Examining Group 3700 for consideration of merger of the proceedings under 37 CFR 1.565(c), in accordance with the practice set forth at MPEP § 2283.

Preliminary Matters

On April 14, 2004, in the '442 proceeding, Owner filed an amendment responsive to the Office action dated October 15, 2003, an Information Disclosure Statement, and a declaration pursuant to 37 CFR 1.131. These papers have been entered. There has been no *ex parte* action in the '796 proceeding.

Merger of Copending Reexamination Proceedings

I. Merger of Proceedings

As required by the practice pursuant to MPEP § 2283, and under the authority of 37 CFR 1.565(c), the reexamination proceeding 90/006,442 and reexamination proceeding 90/006,796 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, drawings 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. 35 in both files. There will be no paper Nos. 9-34 in Control No. 90/006,796.

III. Housekeeping Amendment

As discussed above, Owner filed an amendment and other papers in control No. 90/006,442 and those papers have been entered in that proceeding. Therefore, Owner is **required** to file a housekeeping amendment in control No. 90/006,796 entering the identical claims therein, as well as making the specification and drawings in the '796 proceeding identical to the specification and drawings in the '442 proceeding. That paper will be paper No. 36 in control No. 90/006,796. There will then be no paper No. 36 in 90/006,442, unless Owner elects to file additional claims by way of a supplemental amendment in the '442 proceeding. If that is the case, such additional claims **must** also be added to the housekeeping amendment filed in control No. 90/006,796. The next action by the Primary Examiner will then be paper No. 37 in both files. **Owner is required to file the housekeeping amendment not later than ONE MONTH from the date of this decision.** Attention is invited to MPEP § 2282, subsection entitled "Merger of Reexaminations", last paragraph.

IV. Conduct of Merged Proceeding

All 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 and Owner will each receive one copy of the body of the action, and a copy of the cover sheet (*e.g.* Form PTO-466). All papers filed by Owner following filed subsequent to the items in Section III above 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" claims and paragraphs in which specification amendments are requested must be filed together with material satisfying the requirements of 37 CFR 1.530(e).** All words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets. New drawing figures must be labeled "New", while amended drawing figures must be labeled "Amended".

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. 37. 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
Technology Center 3700

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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
2875	28

DATE MAILED: 03/03/2003

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PTO-90C (Rev. 07-01)

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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

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EXAMINER
NEILS

ART UNIT	PAPER NUMBER
2875	27

DATE MAILED: 03/03/2003

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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

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EXAMINER
NEILS

ART UNIT	PAPER NUMBER
2875	27

DATE MAILED: 03/03/2003

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Paper No. 27/8

Richard L. Wood (For Patent Owner)
WELSH & KATZ. LTD.
120 South Riverside Plaza, 22nd Floor
Chicago, Illinois 60606

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

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

DECISION MERGING REEXAMINATION PROCEEDINGS

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.

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

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(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

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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(THIRD PARTY REQUESTERS CORRESPONDENCE ADDRESS)

ROBERT KINBERG
VENABLE
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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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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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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

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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.

90006445 .051903

PTO-90C (Rev. 07-01)

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(For Third Party Requester)

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.

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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(THIRD PARTY REQUESTERS CORRESPONDENCE ADDRESS)

ROBERT KINBERG
VENABLE
P.O. BOX 34385
WASHINGTON, DC 20043-9998

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
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
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(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, 90/006,140, 90/006,523

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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,446	11/06/2002	4850960	129338-00500	6367

5514 7590 01/17/2006

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/17/2006

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Stevan J. Bosses
Fitzpatrick, Cella, Harper & Scinto
30 Rockefeller Plaza
New York, NY 10112-3800

(For Patent Owner)

MAILED
JAN 17 2006
REEXAM UNIT

In re Joseph Grayzel
Reexamination Proceeding
Control No.: 90/006,446
Filed: November 6, 2002
For: U.S. Patent No. 4,850960

: DECISION GRANTING
: PETITION

This is a decision on the August 30, 2005 patent owner petition titled "Petition to Suspend Pursuant to 37 CFR 1.181(a)(2)." No fee is required for the petition, and a refund of the $130.00 fee tendered with the petition will be refunded by crediting Deposit Account No. 06-1205 in due course.

The reexamination proceeding and the petition are before the Office of Patent Legal Administration.

For the reasons set forth below, the petition to suspend is granted to the extent, and for the reasons, set forth below.

BACKGROUND

1. U.S. Patent No. 4,850,960 (hereinafter the '960 patent) issued on July 25, 2989.

2. On August 8, 2001, the patent owner [1] filed an action in the United States District Court for the District of New Jersey [2] seeking a holding that the '960 patent was infringed.

3. On November 6, 2002, patent owner filed a request for reexamination of the '960 patent and the request was accepted as reexamination proceeding Control No. 90/006,446 (hereinafter the '6446 proceeding).

4. Reexamination of the '960 patent was ordered on January 16, 2003.

[1] Patent owner is Joseph Grazyel, the named inventor of the '960 patent.
[2] *Grayzel v. St. Jude Med., Inc.*, No. 01-CV-3737 (D.N.J. Oct. 29, 2004)

5. On May 21, 2002, the patent owner entered into a protective order designed to prohibit improper disclosure or use of confidential information and "Attorneys' Eyes Only" information produced during the course of the litigation. [3]

6. On December 4, 2003, the District Court granted the defendant's motion to enforce the protective order and enjoined patent owner and his attorneys from participation in the'6446 proceeding, in accordance with the recommendations of the Magistrate Judge. [4]

7. On October 13, 2004, the District Court issued an Opinion and Order denying the patent owner's motion for reargument of the December 4, 2003 order.

8. On October 29, 2004, a verdict holding that claims 13, 14 and 16 of the '960 patent are invalid was rendered by the District Court. [5]

9. On June 22, 2005, the first Office action on the merits of the claims of the '960 patent was issued.

10 On August 22, 2005, a response to the June 22, 2005 Office action was filed, including argument and three submissions by patent owner's expert, Dr. Eckmann, dated prior to December 4, 2003. A supplemental response dated September 2, 2005, was also filed.

13. Patent owner states that an appeal to the Court of Appeals for the Federal Circuit from the October 13, 2004 Opinion and Order, and appeal from October 29, 2004 verdict of the District Court have been filed and briefed. [6]

13. Oral argument on the above mentioned appeals was conducted on November 9, 2005.

14. On December 23, 2005, the Court of Appeals for the Federal Circuit issued a decision [7] affirming the decision of the District Court as to the validity of claims 13, 14 and 16 of the '960 patent, dismissing as moot patent owner's challenge to the injunction issued by the District Court with respect to claims 13, 14 and 16, and affirming the injunction with respect to claims 1-12, 15 and 17-26 of the '960 patent.

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[3] Background item nos. 5- 7 appear as reported in an unpublished decision styled *Joseph Grayzel v. St. Jude Medical, Inc. et al*, 2004 U.S. Dist. LEXIS 24215 (D.N.J. 2004). On November 10, 2005, patent owner has filed copies of these background items in the reexamination proceeding.

[4] Patent owner indicates that he has been advised that his expert in the litigation, Dr. Eckmann, is also enjoined from participation in the '6446 proceeding. See petition, at page 3.

[5] *Joseph Grayzel v. St. Jude Medical, Inc. et al*, 345 F. Supp. 2d 466; 2004 U.S. Dist. LEXIS 24214 (D.N.J. 2004)

[6] Petition, at page 3.

[7] *Joseph Grazyel v. St Jude Medical, Daig Division, Inc. et al*, No. 05-1126, slip op., 2005 U.S. App. LEXIS 28690 (Fed. Cir. 2005)

DECISION

I. Relevant Authority

35 U.S.C. § 302 states in pertinent part:

> "Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title."

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

> "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 ... 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 1.565(b) states in pertinent part:

> "If a patent in the process of ex parte reexamination is, or becomes involved in litigation, the Director shall determine whether or not to suspend reexamination."

Ethicon v. Quigg, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988), is the seminal case regarding the ability of the Office to suspend a pending reexamination proceeding.

In *Ethicon*, 849 F.2d at 1426, 7 USPQ2d at 1154, the court considered the language of 35 U.S.C. §§ 302-305, and concluded that:

> "[W]hen read together, the statutes say: "*Any* person *at any time* may request reexamination and *all* reexamination procedures *will* be conducted with *special dispatch*." The issue for us is whether "special dispatch" contemplates that a reexamination be suspended pending the outcome of a district court case involving allegations of invalidity of the same patent. We conclude that it does not." (Emphasis in the original.)

However, the court's opinion went further. After studying the meaning of the term "special dispatch," analyzing the statutory language, and reviewing the legislative history of the statute, the *Ethicon* court concluded that regardless of the pros and cons of conducting reexamination within the Office while *litigation* was proceeding in the courts, [8] the reexamination statutes would not prevent the Commissioner [9] from conducting orderly proceedings within the Office in circumstances in which there are multiple proceedings before the Office, provided that the orderly conduct of the proceedings within the Office "does not violate the statute." [10] In answer to various concerns expressed by the Office if there were no power to stay reexamination proceedings in light of concurrent litigation, the court went on to state:

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[8] In footnote 2, the court stated that "[I]t makes no difference to our view of the case that MPEP § 2286 stays reexamination when a trial has begun while 37 CFR 1.565(b) permits a stay when the patent is in *litigation*. **Neither is authorized.** (Emphasis in italics is in the original.)

[9] Now Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, 35 U.S.C. § 3.

[10] *Ethicon*, 849 F.2d at 1428, 7 USPQ2d at 1156.

> "Finally, even if the Commissioner were correct about these stated fears, there is nothing we can do for him. Congress has said in no uncertain terms that reexaminations are to be conducted with special dispatch. 'Our individual appraisal of the wisdom or unwisdom of a particular course consciously selected by the Congress is to be put aside in the process of interpreting a statute. Once the meaning of an enactment is discerned and its constitutionality determined, the judicial process comes to an end.'"

Id. at 1429, at 1158.

II. Analysis and Findings

A. The Facts Presented By This Petition Differ Radically From The Facts Presented In *Ethicon*

A review of *Ethicon* shows that the facts therein differ in substantial and important ways from the facts presented in the instant reexamination proceeding. In *Ethicon,* patentee United States Surgical Corporation (USSC) filed suit in the United States District Court for the District of Connecticut against a first group of infringers in 1981. The Connecticut trial was completed in 1987. In 1986, USSC filed an infringement suit against Ethicon in the United States District Court for the Southern District of Ohio. In 1987, Ethicon, as a third party requester, filed a request for reexamination pursuant to 35 U.S.C. §§ 301-307, and then sought a stay of the Ohio court proceedings. The stay was refused, the request for reexamination was granted, and thereafter the request for a stay of the court proceedings was renewed by Ethicon, but was again refused by the Ohio court. Patentee USSC then petitioned the Office for a stay of the reexamination proceeding based upon the ongoing trial in Connecticut. The petition for stay was denied by the Office as having been untimely filed. However, the reexamination proceeding was nevertheless stayed by the Office pursuant to the then existing practice under MPEP § 2286. [11] Ethicon then filed suit to enjoin the Office from delaying the reexamination, and the Federal Circuit supported Ethicon's position.

In the present reexamination proceeding, reexamination has been requested by the patent owner, not by a third party requester. There is no third party requesting reexamination of the patent. In contract to Ethicon, the defendant in the existing litigation did not seek reexamination of the '690 patent. Pursuant to the action filed by patent owner in the New Jersey District Court on August 2, 2001, patent owner in this reexamination proceeding entered into a Protective Order on May 21, 2002 that did not specifically mention reexamination proceedings. [12] Thereafter, patent owner became subject to an Opinion and Order of the District Court dated December 4, 2003 that applied the Protective Order to bar patent owner from participating in the reexamination proceeding.

Comparing the *Ethicon* fact situation with that of the present situation, the following is noted. In *Ethicon,* the stay sought was characterized by the court as being "an indefinite suspension of reexamination proceedings pending conclusion of litigation proceedings," [13] and it was the defendant/third party reexamination requester that challenged the indefinite stay pending

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[11] See note 3, *supra.*

[12] See paragraph 19 of the Protective Order dated May 21, 2002, and cf. *Joy Manufacturing Co. v. National Mine Service Company, Inc.*, 810 F.2d 1127; 1 USPQ2d 1627 (Fed. Cir. 1987), reproduced on page 3, *supra.*

[13] *Ethicon v. Quigg*, 849 F.2d at 1426, 7 USPQ2d at 1155.

conclusion of a trial. Here, on the other hand, the trial in District Court has been concluded, an appeal on the propriety of barring patent owner from participating in the instant reexamination has been briefed and argued before the Court of Appeals for the Federal Circuit, and the Federal Circuit has decided the appeal. [14] In addition, there is no third party requester of a reexamination of the patent whose right to have the reexamination proceeding go forward is being prejudiced. While the public has an interest in a speedy resolution of the proceeding, that interest must be balanced in conjunction with the patent owner's rights, the potential prejudice to the patent owner, and the degree of delay in resolution. This will be discussed below.

B. Statutory Provisions In Addition To The "Special Dispatch" Provision of 35 U.S.C. § 305 Are Implicated By The Instant Petition To Suspend This Proceeding

In *Ethicon*, the court based it's holding on the "special dispatch" provision of 35 U.S.C. § 305, which the court held could not be satisfied if the reexamination proceeding was subject to the Commissioner's *sua sponte* suspension of indeterminate length. Here, a suspension of the reexamination proceeding for a short and relatively determinate time is being requested. It is noted that 35 U.S.C. § 302 provides that "any person may at any time request reexamination by the Office ...", and thereby clearly establishes the right of a patent owner to file a reexamination proceeding. [15] In the instant reexamination proceeding, patent owner is precluded by the December 4, 2003 injunction issued by the District Court from participation in the reexamination proceeding he has filed. If the instant reexamination proceeding can not be stayed for a relatively short and definite period of time, the patent owner would be precluded from seeking modification of the existing decision, or possibly review at a higher level (via writ of *certiorari*Such [please review the grammar after accepting tc to the left] relief could be sought based on (a) the provisions establishing the right of the patent owner to file a reexamination proceeding "at any time" of 35 U.S.C. § 302, which would be rendered ineffective, since the ability to file a request for reexamination "at any time" is of little use to a party if that party is barred from participating in the proceeding, and (b) the right of any patent owner "to propose any amendment to his patent and a new claim or claims thereto" as provided by 35 U.S.C. § 305, which would be rendered meaningless and ineffective for a patentee who is barred from participating in the reexamination proceeding.

C. The Office Has Authority To Fashion A Stay In This Reexamination Proceeding

The question of whether a court may bar a patent owner from participating in a reexamination proceeding is a question for the courts that is not presently before the Office. Note is taken that the injunction barring the patent owner from participation in the instant reexamination proceeding has been upheld on appeal. The basis for the action taken by the District Court and the affirmance of that action by the Court of Appeals for the Federal Circuit was concern that confidential material adduced during the litigation would be submitted by the patent owner during the reexamination proceeding and would become public. [16] While the Federal Circuit dismissed the injunction with respect to patent claims 13, 14 and 16, the injunction was affirmed with respect to the remaining patent claims 1-12, 15 and 17-26 and remains in force. Thus, the Federal Circuit has ruled *sub silentio* that the court may in fact bar a patent owner from participating in a reexamination proceeding, based on the present facts. Given the issues previously noted with respect to 35 U.S.C. §§ 302 and 305 and the potential to expend Office

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[14] *Joseph Grazyel v. St Jude Medical, Daig Division, Inc. et al*, No. 05-1126 (December 23, 2005).
[15] cf. *Kucala Enterprises, Ltd v. Auto Wax Company, Inc.*, 2004 U.S. Dist. LEXIS 5723 (Dist. Ct., Northern Dist. of Ill., Eastern Division 2004)
[16] *Id.*, at 22.

resources on a proceeding in which the patent owner is enjoined from participating in the reexamination proceeding, it is equitable that the patent owner be accorded a limited opportunity to challenge that ruling via a request for modification of the existing decision, or, possibly, via writ of *certiorari*).

The decision of the *Ethicon* court did not entirely foreclose the ability of the Director to conduct orderly proceedings within the Office, provided that the orderly conduct of the proceedings within the Office does not violate 35 U.S.C. § 305. For example, in commenting on a hypothetical situation in which multiple proceedings were before the Office, the court noted that:

> "Special dispatch in the posited circumstances may call for coordinated activity to resolve issues seriatim, which would not necessarily violate congressional instructions so long as the reexamination was handled with special priority and progressed as quickly as possible. See MPEP §§ 2283-2285. We hesitate to say more without a case before us."[17]

As noted, *supra*, the facts upon which the instant petition are based clearly present facts that are significantly different from the facts in *Ethicon*. Here, there is no third party requester, and the party adverse to the patentee in the litigation has obtained an appellate decision holding claims 13, 14 and 16, the only claims at bar in the litigation, to be invalid. [18] Since these three claims are withdrawn from the reexamination prosecution because there is no longer a substantial question of patentability regarding these claims (see below), there are no longer any claims remaining in the reexamination proceeding that were asserted against the defendant in the *Grayzel v. St. Jude Med., Inc.* litigation. As to the remaining twenty-three patent claims, some stand rejected; thus, there still exists a substantial new question of patentability with respect to those claims that remains to be resolved. It appears that the patent owner will be prejudiced if he cannot contribute, in spite of his apparent statutory right to prosecute the patent claims during reexamination under 35 USC § 305. It is deemed to **not** be an undue burden on the public interest (right to a speedy resolution of the remaining question of patentability) to fashion the limited stay set forth below, when the potential prejudice to the patent owner in not participating in the defence of its rejected claims is taken into account. The short delay provided in this instance does not appear to contravene the requirement of 35 U.S.C. § 305 that reexamination proceedings be conducted with "special dispatch," because that requirement is construed to take into account, i.e., permit, short delays appropriate to accommodate administrative discretion to preserve rights of parties. The Office retains regulatory authority, pursuant to 37 CFR 1.565, to stay reexamination proceedings; that provision of the rules was expressly not voided in *Ethicon*. As pointed out by the court in *Ethicon*: [19]

> "...nothing we say here prevents the Commissioner from conducting orderly proceedings within his office so long as he does not violate the statute. Special dispatch in the posited circumstances may call for coordinated activity to resolve issues seriatim, which would not necessarily violate congressional instructions so long as the reexamination was handled with special priority and progressed as quickly as possible."

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[17] *Ethicon v. Quigg, op. cit.* at 1428, at 1156

[18] *Joseph Grazyel v. St Jude Medical, Daig Division, Inc. et al*, No. 05-1126,op. cit.; see also MPEP § 2286, subsection IV.

[19] *Ethicon v. Quigg, op. cit.* at 1428, at 1156.

The present fact situation presents another such special circumstance, in its difference from *Ethicon*. In *Ethicon*, a situation existed where the Office could come to a different conclusion that the courts as to the patentability of the claims. Such is not the case here. In this instance, the ability of the patent owner to participate is, as a result of the court's decision, solely within the court's province, and not one that the Office can render. Thus, it is appropriate to provide a short period of time to permit the patent owner to obtain a resolution of the participation issue that cannot be before the Office.

It is also to be noted that, without input from the patent owner, the instant reexamination proceeding would likely be an injudicious use of Office resources benefiting neither patent owner nor the public. Such use of Office resources would be needlessly expended, should the patent owner subsequently obtain a judicial remedy requiring that the Office reopen prosecution and permit the patent owner to participate. Viewed in this manner, a limited stay fashioned to comply with the statutory requirement for special dispatch would be an administrative convenience.

Accordingly, the petition is granted to the extent that will now be set forth:

D. Terms Of The Limited Stay

The instant reexamination proceeding will be stayed for a period not to exceed **two months** from the date of this decision. This limited stay is for the purpose of permitting the patent owner an opportunity to seek a modification of the injunction ordered by the New Jersey District Court that would permit owner to participate in this proceeding in light of the matters discussed in this decision, or to seek court relief as is otherwise appropriate. In that regard, the patent owner may wish to consider bringing the Office practice regarding the treatment of submissions of "confidential" or "protective order" material that is set forth in MPEP §§ 724.02 through 724.06 to the attention of the District Court.

In addition, the patent owner is called upon to:

I. Inform the Office of any actions taken to obtain relief from the present injunction, whether such relief is sought by seeking a modification of the injunction or by way of other available legal means.

II. Immediately notify the Office of status of **any** legal proceeding initiated by patent owner in which patent owner seeks relief from the injunction.

III. Should patent owner decide not to seek relief from the present injunction, immediately notify the Office so that the stay can be lifted and prosecution of the reexamination proceeding resumed.

In the event that patent owner has not obtained a modification of the present injunction, or otherwise secured the ability to participate in this proceeding, within the two month period of the stay, the stay will be lifted and prosecution resumed, unless the patent owner immediately notifies the Office and thereafter, within **10** days, files a paper showing adequate cause why prosecution in this reexamination proceeding should not be resumed.

Any notification, as per above, should take the form of a telephone call directed to Stephen Marcus, Legal Advisor, at (571) 272-7743 or in his absence to the undersigned at (571) 272-7710, followed by the filing of a paper confirming the information conveyed by telephone.

TERMINATION OF REEXAMINATION PROSECUTION AS TO CLAIMS 13, 14 AND 16

The prosecution of claims 13, 14, and 16 of the '960 patent in this reexamination proceeding is hereby terminated.

Claims 13, 14, and 16 are no longer being reexamined in view of the final decision of *Joseph Grazyel v. St Jude Medical, Daig Division, Inc. et al*, No. 05-1126 (December 23, 2005), holding these claims invalid.

CONCLUSION

1. The petition for suspension of this proceeding is granted to the extent that the present reexamination proceeding is hereby stayed for a period not to exceed **two** months from the date of this decision. After the two month period expires, the proceeding will be called up for further consideration.

2. The prosecution of claims 13, 14, and 16 of the '960 patent in this reexamination proceeding is hereby terminated.

3. The patent owner is called upon to:

   I. Inform the Office of any actions taken to obtain relief from the injunction on participation in the present proceeding, whether such relief is sought by seeking a modification of the injunction or by way of other available legal means.

   II. Immediately notify the Office of status of **any** legal proceeding initiated by patent owner in which patent owner seeks relief from the injunction.

   III. Should patent owner decide not to seek relief from the present injunction, immediately notify the Office so that the stay can be lifted and prosecution of the reexamination proceeding resumed.

4. In the event that patent owner has not obtained a modification of the present injunction, or otherwise secured the ability to participate in this proceeding, within the two month period of the stay, the stay will be lifted and prosecution resumed, unless the patent owner immediately notifies the Office (as provided above) and thereafter, within **10** days, file a paper showing adequate cause why prosecution in this reexamination proceeding should not be resumed.

5. **<u>All</u> correspondence relating to an *ex partes* reexamination proceeding should be directed to:**

By Mail: Attn: Mail Stop "*Ex Parte* Reexam"
Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

By FAX: (571) 273-9900
Central Reexamination Unit

By hand: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

5. Patent owner may wish to file papers in connection with this decision by facsimile transmission in the interest of obtaining prompt handling.

6. Telephone inquiries related to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or in his absence, to the undersigned at (571) 272-7733.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

sm
Jan. 10, 2006

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1-17-06

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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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EXAMINER

ART UNIT	PAPER NUMBER
	28

DATE MAILED: 03/27/2003

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Paper No. 27

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 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 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.

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 <u>all</u> 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 <u>all</u> 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.

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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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
	28

DATE MAILED: 03/27/2003

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
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. 27

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 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 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.

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 <u>all</u> 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 <u>all</u> 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.

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
P.O. Box 1450
Alexandria, VA 22313-145

MAY 1 2 2005

CHRISTIE, PARKER & HALE, LLP
P.O. Box 7068
Pasadena, CA 91109-7068

In re application of		
Christopher V. Martin et al.	:	
Application No. 90/006,455	:	**DECISION ON REQUEST**
Filed: November 19, 2002	:	**FOR WITHDRAWAL OF**
For: PIVOTING FRAME SUSPENSION SCOOTER	:	**ATTORNEY**

This is a decision on the request filed on March 31, 2005, under 37 CFR 1.36 and MPEP 402.06, requesting permission to withdraw as the attorney of record in the above-identified application.

The request is **APPROVED**

Under 37 CFR 1.36 an attorney may withdraw only upon application to and approval by the Commissioner. 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) If withdrawal is requested in accordance with 37 CFR 10.40(c) above, there must be at least 30 days between approval of the withdrawal and the later of the expiration date of a time period for reply or the expiration date of the period which can be obtained by a petition and fee for extension of time under 37 CFR 1.136(a).

The request to withdraw as attorney satisfies each of the conditions A) – D) above and the request is therefore **APPROVED**.

The correspondence address will be changed to the sole inventor, Christopher V. Martin.

In summary, the request is **APPROVED**.

Randolph A. Reese

Randolph A. Reese
Special Programs Examiner
Technology Center 3600
(571) 272-6619

RAR/pav: 05/03/05

CC: JACK C. MUNRO
28720 Roadside Drive, Suite 225
Agoura Hills, CA 91301

Christopher V. Martin
Martin Manufacturing, Inc.
1826 West Broadway, Suite 7
Mesa, AZ 85202

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

AUG - 2 2005

FOR PATENT OWNER:

Christopher V. Martin
P.O. Box 6491
Scottsdale, AZ 85261

FOR REQUESTER:

Jack C. Munro
28720 Roadside Drive
Suite 225
Agoura Hills, CA 91301

DECISION ON PETITION FOR ACCEPTANCE OF LATE PAPERS

Reexamination Control No. 90/006,455

This is in response to patent owner's petition filed via facsimile transmission on July 20, 2005 to accept late filed papers. There is no fee for this petition.

The petition is **GRANTED**.

A review of the reexamination file reveals that a nonfinal Office action was mailed on March 9, 2005 to the correspondence address of record at that time. On March 31, 2005 patent owner's attorney submitted a request to withdraw as patent owner's representative. In that request, which was approved on May 12, 2005, patent owner's representative provided a new correspondence address for patent owner which was the same address included in the request for reexamination submitted by the third party requester. This address did not agree with patent owner's address listed on the original patent being reexamined. When the reexamination request was being processed prior to consideration thereof, this discrepancy was detected and the correct address for patent owner was determined. Unfortunately, the Post Office Box number was incorrectly recorded as PO Box 4691 in USPTO records rather than the correct PO Box 6491. This error was not detected until it was necessary to send official correspondence to patent owner after withdrawal of patent owner's attorney. As a result, patent owner did not receive the Office action mailed March 9, 2005 directly. Instead, patent owner became aware of the Office action "[t]hrough a lawsuit, that involved the inventors patent." Patent owner, once aware of the Office action prepared a response that was received on June 11, 2005, one month after expiration of the response period.

Since the USPTO did not properly record patent owner's address when the reexamination request was initially processed and since patent owner's former attorney provided an incorrect

address for patent owner in the request to withdraw, it is clear that patent owner could not have received official correspondence regarding this reexamination proceeding in a timely manner to permit preparation and submission of a response to the March 9, 2005 action within the time period set.

As set forth in the declaration of the original patent application, printed on the cover page of the patent under reexamination, and verified by patent owner in the instant petition, the correspondence address should be Christopher V. Martin, P.O. Box 6491, Scottsdale, AZ 85261. This address has been entered into the record for this reexamination proceeding.

This reexamination proceeding is hereby reinstated to pending status. The file will be forwarded to the examiner of record for prompt consideration of the response submitted June 11, 2005.

Randolph A. Reese
Special Programs Examiner
Patent Technology Center 3600
(703) 308-2121

RAR: 7/29/05

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
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www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,455	11/19/2002	6338393		8169

7590 07/13/2007

Christopher V. Martin
P.O. Box 6491
Scottsdale, AZ 85261

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/13/2007

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

7/16/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Jack C. Munro

28720 Roadside Drive

Suite 225

Agoura Hills, CA 91301

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/006455

PATENT NO. 6,338,393

ART UNI 3993

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 replly 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

MAILED

JUL 13 2007

CENTRAL REEXAMINATION UNIT

Christopher V. Martin
P.O. Box 6491
Scottsdale AZ 85261

(For Patent Owner)

Jack C. Munro
28720 Roadside Drive
Suite 255
Agoura Hills, CA 91301

(For Third Party Requester)

In re Reexamination Proceeding :
C. Martin :
Control No. 90/006,455 : DECISION DISMISSING PETITION
Filed: November 19, 2002 :
U.S. Patent No. 6,338,393 :
For: PIVOTING FRAME SUSPENSION SCOOTER :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on February 23, 2007, by facsimile transmission, for entry of late papers based upon unintentional delay.

The petition is before the Office of Patent Legal Administration (OPLA) for decision. As a courtesy to petitioner, copies of all rules mentioned in this decision have been enclosed.

37 CFR 1.137(b) states, in part:

> "*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 ...."

The present petition under 37 CFR 1.137(b) includes, inter alia, proceeding papers, a $750.00 petition fee under 37 CFR 1.17(m) (item 2), the requisite statement (item 3) and a Certificate of Service on the Third Party Requester.

A review of the record for this reexamination proceeding reveals that the required proper reply to the outstanding final Office action has not been filed.

A further review of the record reveals that the petition includes a paper stating the following "Enclosed is a petition under 37 CFR 1.182 for continued reexamination with a payment of under 37 CFR 1.17(f). Payment by check of $400.00 is enclosed." A copy of a check for $400.00 is embedded in the paper. A review of the Office financial records for this reexamination proceeding reveals that no check for $400.00 has ever been received.

Relief in the form of a continuation of the reexamination prosecution (after a final rejection) is available via a separate 37 CFR 1.182 petition in appropriate circumstances. This will be referred to herein as "the 1.182 petition."

As with a Request for Continued Examination (RCE) in an application, the 1.182 petition must be filed during the pendency of the reexamination proceeding to further the prosecution of the reexamination proceeding, rather than to delay it, and must provide a submission toward that end.

In this instance, a 1.182 petition including a statement explaining why relief in the form of a continuation of the reexamination prosecution should be granted (e.g., alleging that you were unaware that the examiner would apply art in the manner applied in the final Office action), a submission and the requisite $400.00 petition fee would be needed. If the statement alleges that you were unaware that the examiner would apply art in the manner applied in the final Office action, the statement must also state that the manner in which the art was applied that you were unaware of, and what you believed to be the case prior to the final Office action. It is noted that the petition should also include a statement as to which of the communications, or both of the communications, previously filed on October 11, 2005 and January 13, 2006, should be entered and considered as the necessary submission.

If such a petition is filed and granted, the 1.182 petition along with the submission (either or both of the communications previously filed on October 11, 2005 and January 13, 2006) would be considered the proper response to the outstanding final Office action needed for a grant of the petition under 1.137(b). Prosecution would then be reopened for entry into the record of the response, the proceeding would be forwarded to the examiner for consideration of the response, and the examiner would issue an Office action treating the response as a response received after a first Office action. Thereafter, no further continuation of the reexamination proceeding would be granted under 37 CFR 1.182 absent a showing of extraordinary circumstances.

CONCLUSION

1. The petition under 1.137(b) is dismissed.
2. Any renewed petition or request for reconsideration must be filed within TWO (2) MONTHS of the mail date of this decision. An extension of time to file a renewed petition may be requested under 37 CFR 1.1550(c); extensions of time under 37 CFR 1.136 are not available in reexamination proceedings.

3. Any renewed petition, should be directed to:

By U.S. Postal Service Mail:	Mail Stop *Ex Parte* Reexam Central Reexamination Unit United States Patent & Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450
By FAX to:	(571) 273-9900 Central Reexamination Unit
By Hand:	Customer Service Window Attn: Central Reexamination Unit Randolph Building, Lobby Level 401 Dulany St. Alexandria, VA 22314

4. The Office of Patent Legal Administration (OPLA) is retaining jurisdiction over the instant reexamination proceeding. If no renewed petition is received within two months of the mailing date of this decision (or within the time as extended, if any extension of time under 37 CFR 1.550(c) should be granted), then jurisdiction over the proceeding will be returned to the Central Reexamination Unit (CRU).
5. Telephone inquiries related to this decision should be directed to Fred A. Silverberg at 571-272-7719.

Fred A. Silverberg

Fred A. Silverberg
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy

Kenneth M. Schor

Conferee: Kenneth M. Schor, Senior Legal Advisor

Enclosures:
37 CFR 1.17(f)
37 CFR 1.114
37 CFR 1.136
37 CFR 1.137(b)
37 CFR 1.182
37 CFR 1.550(c)

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FEB 26 2008

CENTRAL REEXAMINATION UNIT

Christopher V. Martin
P.O. Box 6491
Scottsdale AZ 85261

(For Patent Owner)

Jack C. Munro
28720 Roadside Drive
Suite 255
Agoura Hills, CA 91301

(For Third Party Requester)

In re Reexamination Proceeding :
C. Martin :
Control No. 90/006,455 : DECISION GRANTING PETITION
Filed: November 19, 2002 :
U.S. Patent No. 6,338,393 :
For: PIVOTING FRAME SUSPENSION SCOOTER :

This is a decision on the petition under 37 CFR 1.182 filed February 23, 2007 supplemented by the communications filed August 27, 2007 and September 14, 2007, in response to the decision mailed July 13, 2007, by the patent owner for relief in the form of a request for continued reexamination of the above-identified reexamination proceeding.

The petition under 37 CFR 1.182 is before the Office of Patent Legal Administration (OPLA) for decision.

On February 23, 2007, a petition under 37 CFR 1.137(b) for entry of late papers based on unintentional delay and a petition under 37 CFR 1.182 for continued reexamination of the above-identified reexamination proceeding were filed.

On July 13, 2007, a decision dismissing the petition under 37 CFR 1.137(b) was mailed setting a two (2) month period for response. The July 13th decision stated that the petition under 37 CFR 1.137(b) included, inter alia, proceeding papers, a $750.00 petition fee under 37 CFR 1.17(m) (item 2), the requisite statement (item 3) and a Certificate of Service on the Third Party Requester; and that the required proper reply to the outstanding final Office action had not been filed. The decision also stated that the submission of the two petitions included a paper stating the following "Enclosed is a petition under 37 CFR 1.182 for continued reexamination with a payment of under 37 CFR 1.17(f)," while the Office financial records for this reexamination proceeding revealed that no check for $400.00 had ever been received.

In response, on September 14, 2007[1], the present communication was filed including a certificate of service on the third party requester. Patent owner argues that the February 23, 2007 communication included a request to charge his credit card for the $400.00 petition fee. Patent owner asserts that on August 27, 2007, he refiled the credit card authorization form to charge the $400.00 petition fee to his credit card and the $400.0 has been charged to his credit card. Patent owner requests reconsideration of the decision dismissing the petition under 37 CFR 1.137(b) and urges that the petition under 37 CFR 1.182 requesting continued reexamination be granted.

In March of 2005, the Office issued a Notice titled "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." Notice was provided therein that a second (or subsequent) reexamination will no longer be ordered on the basis of a "Sbstantial new question of patentability" (SNQ) that is the same as a SNQ raised in an earlier pending reexamination. The Notice stated that:

> "a patent owner will now be prevented from obtaining entry of an amendment and/or evidence not entered after final rejection in an ex parte reexamination proceeding by filing another request for reexamination based on the same substantial question of patentability raised/existing in the pending reexamination proceeding. In order to provide relief to the patent owner, the Office plans to propose a revision to the patent rules to provide for the filing of a request for continued reexamination (RCR) which would be similar to the request for continued examination (RCE) practice for applications. If the RCR practice is implemented, the patent owner, by filing an RCR, could obtain continued prosecution on the merits in the reexamination proceeding, including entry of an amendment and/or evidence that was denied entry after a final rejection in an ex parte reexamination proceeding or after an action closing prosecution in an inter partes reexamination proceeding.
>
> Until these new rules become effective, however, patent owners are advised to use either: (1) the petition procedure under 37 CFR 1.181 to seek review of a denial of entry of an amendment submitted after final rejection in an ex parte reexamination proceeding or after an action closing prosecution in an inter partes reexamination proceeding; or (2) the petition procedure under 37 CFR 1.182 to seek relief that is not currently provided by an existing rule, but that would be provided when a new request for continued reexamination (RCR) practice is in effect."

Accordingly, relief in the form of a continuation of the reexamination prosecution (after a final rejection) is available via a 37 CFR 1.182 petition in appropriate circumstances.

As with a Request for Continued Examination (RCE) in an application, the petition under 37 CFR 1.182 must be filed to further the prosecution of the reexamination proceeding, rather than to delay it. Thus, the patent owner must make a *bona fide* effort to define the issues for appeal, or for the issuance of a reexamination certificate, when filing a request for continued reexamination, since this is a key factor in reducing pendency of a reexamination proceeding. Stated another way, the practice includes a requirement that the filing of the petition under

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[1] For the September 14, 2007 response to be considered timely, it must have been deposited with the United States Postal Service (USPS) on or before September 13, 2007. The USPS Track and Confirm web site indicates that the September 14, 2007 response was delivered to the Office at 9:29 am on September 14, 2007. As the response was deposited with the USPS in Scottsdale, Arizona and delivered to the Office in Alexandria, Virginia at 9.29 am on September 14, 2007, the response must have been deposited with the USPS on or before September 13, 2007. Accordingly, the September 14, 2007 response is considered timely.

37 CFR 1.182 be accompanied by a submission that provides a *bona fide* effort to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate.

Patent owner states, *inter alia*, that he was unaware that the examiner would apply art in the manner applied in the final office action - Patmont was applied in such a way as to not allow him to exercise arguments over the applied art and Gaddi was applied in a manner inconsistent with previous office actions. A review of the record reveals that patent owner is requesting that the Office continue the prosecution of the above-identified reexamination proceeding to provide consideration of the communications filed October 11, 2005 and January 13, 2006 in response to the final Office action mailed August 10, 2005, in view of his comments above.

A review of the financial records for the above-identified reexamination proceeding reveals that the $400 petition fee has been paid.

Based on the present facts and circumstances, the petition is granted, and the prosecution in the above-identified reexamination proceeding is hereby continued. The finality of the August 10, 2005, Office action is withdrawn, and the prosecution is reopened for entry into the record of the communications filed October 11, 2005 and January 13, 2006 . The above-identified reexamination proceeding will be forwarded to the examiner for such consideration. The examiner will then issue an Office action, treating the amendment as a response received after a first Office action.

The petition under 37 CFR 1.182 is granted.

The prosecution of the above-identified reexamination proceeding is continued.

The finality of the August 10, 2005 Office action is withdrawn, and prosecution of the above-identified reexamination proceeding is reopened to the extent that the communications filed October 11, 2005 and January 13, 2006 will be addressed and treated as a response received after a first, non-final Office action.

The communications filed October 11, 2005 and January 13, 2006, will be entered by the Central Reexamination Unit (CRU), and then considered by the examiner.

Any further relief via a Request for Continued Reexamination is barred, absent a showing of an extraordinary situation where justice requires further such relief.

A decision granting the February 23, 2007 petition for entry of late papers based upon unintentional delay is being mailed concurrently with the present decision.

Jurisdiction over the above-identified reexamination proceeding is being returned to the CRU for further handling and examination not inconsistent with this decision.

Any further communications as to the merits of above-identified reexamination proceeding should be directed to the primary examiner, Beverly Flanagan, in CRU Art Unit 3993, who can be reached at 571-272-4766.

Telephone inquiries related to this decision should be directed to Fred A. Silverberg at 571-272-7719.

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

Conferee: Fred A. Silverberg, Senior Legal Advisor

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CENTRAL REEXAMINATION UNIT

Christopher V. Martin
P.O. Box 6491
Scottsdale, AZ 85261

For Patent Owner

Jack C. Munro
32792 Pine Circle
Temecula, CA 92592[1]

For 3rd Party Requester

Ex Parte Reexamination Proceeding
Control No. 90/006,455
Filed: November 19, 2002
For: U.S. Patent No. 6,338,393

DECISION ON PETITION
TO RE-MAIL OFFICE
ACTION

This is a decision on patent owner's paper styled "Petition to Withdraw Abandonment based on failure to Receive Office Action" filed January 9, 2009.[2] This petition is being considered as a petition to re-mail the Office action mailed August 27, 2008, based on patent owner's failure to receive the Office action. There is no fee associated with this petition.

Under the reasoning promulgated in *Delgar v. Schuyler*, 172 USPQ 513, an allegation that an Office action was never received may be considered in a petition to re-mail that Office action. If adequately supported, the Office may grant such a petition and re-mail the Office action.

To establish nonreceipt of an Office communication, the petition must include: (1) a statement from patent owner describing the system used for recording an Office action received at the correspondence of record, and the statement should establish that the docketing system used is sufficiently reliable; (2)a statement from patent owner stating that the Office action was not received at the correspondence address of record, and indicate that a search of patent owner's record indicates that the Office action was not

[1] The prior Office action that was mailed to third party requester on August 27, 2008, was returned by the Post Office as "not deliverable as addressed – unable to forward". This new address is being taken from the Attorney's Roster.

[2] No indication is given in the paper to show service to third party requester as required by 37 CFR 1.550(f) and explained in section 2266.03 of the MPEP. A copy of this petition is being forwarded with this decision to third party requester at the address noted above.

received; and (3) a copy of patent owner's records to show non-receipt of the Office action.

The petition includes all the above elements. Accordingly, it is deemed that patent owner did not receive the Office communication of August 27, 2008 and the petition to re-mail the Office action of August 27, 2008 is hereby **granted**.

Enclosed with this decision is a copy of the Office action mailed August 27, 2008, which Office action was a final Office action. The period for response to that Office action is now set to expire two (2) months from the mailing date of this decision. **That is, a response is due on or before September 23, 2009.**

Patent owner is reminded that under 37 CFR 1.550(f), a copy of every submission must be served on third party requester and the manner of service indicated in the submission. See MPEP 2266.03.

Any inquiry concerning this decision should be directed to Andres Kashnikow, Supervisory Primary Examiner, at telephone No. (571) 272-4361.

Gregory Morse, Director
Central Reexamination Unit

Enclosure to patent owner: copy of Office action originally mailed August 27, 2008
Enclosure to third party requester: copy of petition filed January 9, 2009; copy of Office action originally mailed August 27, 2008

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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.
90/006,456	11/20/2002	5574764	GEMS 0173A	3794

7590 04/14/2003

John A. Artz
Artz & Artz
28333 Telegraph Road Suite 250
Southfield, MI 48034

EXAMINER
DUNN

ART UNIT	PAPER NUMBER
2882	8

DATE MAILED: 04/14/2003

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. 8

John A. Artz
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28333 Telegraph Road, Suite 250
Southfield, MI 48034

(For Patent Owner)

MAILED

APR 14 2003

TECHNOLOGY CENTER 2800
SPECIAL PROGRAM CENTER

In re Paul R. Granfors et al.)
Reexamination Proceeding)
Control No. 90/006,456)
Filed: November 20, 2002)
For: U.S. Patent No. 5,574,764)
Title: DIGITAL BRIGHTNESS DETECTOR)
Issued: November 12, 1996)

DECISION ON PETITION

The petition entitled "Petition for Review of Denial of Request for Ex Parte Re-Examination of United States Patent Number 5,574,764," filed March 5, 2003, is before the Group Director of Technology Center 2800. The petition requests review of the examiner's decision denying reexamination and that all the claims of the above-identified patent be considered for reexamination.

The petition is DISMISSED.

The petition indicates that "Petitioner acknowledges that substantial new questions of patentability may arguably have arisen. In light of such, Petitioner hereby respectfully petitions and requests that all ten claims which Issued in the '764 patent be considered for re-examination. It is Petitioner's firm belief, however, that all of the claims of the '764 patent are indeed patentable over the five prior art patent documents cited in the European Search Report and, thus, a thorough re-examination proceeding is likely not necessary. If Examiner is in agreement, Petitioner further respectfully requests that Examiner confirm the grant of all claims Issued within the '764 patent."

37 CFR § 1.510 (b) and (c) states in part that: "(b) Any request for reexamination must include the following parts:

(1) A statement pointing out each substantial new question of patentability based on prior patents and printed publications.

(2) An identification of every claim for which reexamination is requested, and a detailed explanation of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested. If appropriate the party requesting reexamination may also point out how the claims distinguish over cited prior art.

(3) A copy of every patent or printed publication relied upon or referred to in paragraph

(b)(1) and (2) of this section accompanied by an English language translation of all the necessary and pertinent parts of any non-English language patent or printed publication.

.....

(c) If the request does not include the fee for requesting reexamination or all of the parts required in paragraph (b) of this section, the person identified as requesting reexamination will be so notified and given an opportunity to complete the request within a specified time..."

Pursuant to section 2228 of the Manual for Patent Examining Procedure (MPEP), if the reexamination fee under 37 CFR 1.20(c) has been paid but the request does not contain all the elements called for by 37 CFR 1.510(b), the request is considered informal. The reexamination preprocessing staff of the Central Reexamination Unit will attempt to notify the requester of any informality in the request in order to give the requester time to respond before a decision is made on the request.

A review of the request for reexamination, filed November 20, 2002, indicates that the request is informal because it fails to comply with 37 CFR 1.510(b)(1), (b)(2) and (b)(3). The request does not include (1) a statement pointing out each substantial new question of patentability based on prior patents and printed publication, (2) a detailed explanation of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested, and (3) an English language translation of all the necessary and pertinent parts of the European Patent Office publication EP 0 362 427 B1 which was published in German.

The file record reveals that the requester/petitioner has not been notified of the above-noted informalities and given sufficient time to respond pursuant to 37 CFR 1.510(c) and MPEP § 2228. Accordingly, the petition must be dismissed at this time.

In view of the requirement for "special dispatch" of 35 USC 305, **requester/petitioner is hereby given a statutory period of one month to supply the information required by 37 CFR 1.510 (b)(1), (2) and (3) as indicated above. EXTENSIONS OF THIS TIME ARE GOVERNED BY 37 CFR § 1.550(c).** A response to this decision must be accompanied by a renewed petition for which no petition fee is required. Failure to timely respond and correct the above-noted informalities will result in the petition for review of the denial of the request being reconsidered based solely on the information submitted in the request for reexamination filed November 20, 2002.

Any inquiry concerning this decision should be directed to Hien H. Phan, Special Program Examiner, at telephone No. (703) 308-7502.

Richard K. Seidel, 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.
90/006,456	11/20/2002	5574764	GEMS 0173A	3794

7590 02/20/2004

EXAMINER

John A. Artz
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28333 Telegraph Road Suite 250
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ART UNIT	PAPER NUMBER
	11

DATE MAILED: 02/20/2004

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

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Paper No. 11

John A. Artz
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28333 Telegraph Road, Suite 250
Southfield, MI 48034

(For Patent Owner)

In re Paul R. Granfors et al.	)	
Reexamination Proceeding	)	
Control No. 90/006,456	)	
Filed: November 20, 2002	)	DECISION ON PETITION
For: U.S. Patent No. 5,574,764	)	
Title: DIGITAL BRIGHTNESS DETECTOR	)	
Issued: November 12, 1996	)	

The communications entitled "Supplemental Response To Denial of Request for Ex Parte Re-Examination of United States Patent Number 5,574,764," and "Addition To Supplemental Response To Denial of Request for Ex Parte Re-Examination of United States Patent Number 5,574,764," filed May 19, 2003 and June 16, 2003, respectively, are before the Group Director of Technology Center 2800. The communications are treated as a renewed petition and supplement herein. The renewed petition presented a response to address the informalities indicated in the prior decision and requests that all the claims of the above-identified patent be considered for reexamination.

The petition is DENIED.

The petition indicates that "it is acknowledged that substantial new questions of patentability may arguably, have arisen. In light of such, it is respectfully requested that all ten claims which issued in the `764 patent be considered for re-examination."

37 CFR § 1.510 (b) states in part that: "(b) Any request for reexamination must include the following parts:

> *(1) A statement pointing out each substantial new question of patentability based on prior patents and printed publications.*
>
> *(2) An identification of every claim for which reexamination is requested, and a detailed explanation of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested. If appropriate the party requesting reexamination may also point out how the claims distinguish over cited prior art..*

A review of the renewed petition filed May 19, 2003 and supplemented on June 16, 2003, indicates that petition does not supply the information required by 37 CFR § 1.510(b)(1), (2), as outlined in the previous petition decision.

Specifically, a statement pointing out each substantial new question of patentablility, and a detailed explanation of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested has not been provided. On the contrary, the requestor merely lists the references and provides a brief description of what each reference allegedly discloses or teaches. However, no correlation is made between this description of the references and what is claimed in the patent for which reexamination is sought. The requestor never points out that the cited references raise a substantial new question of patentability, with respect to the claims of the patent, as required.

Since requester/petitioner has been given an opportunity to supply the information lacking in the previous request, and has not done so, the renewed petition, as well as the request for reexamination must be denied.

Inquiries regarding this decision should be directed to Clayton E. LaBalle at (703) 308-0519.

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

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#22

Robert E. Krebs
Thelen Reid & Priest LLP
P.O. Box 640640
San Jose, CA 95164-0640

(For Patent Owner)

DEC - 9 2004

Kenneth L. Cage
McDermott Will & Emery
600 13th Street, NW
Washington, DC 20005-3096

(For Requester)

Reexam Control No.: 90/006,460 Filed: November 25, 2002 For: U.S. Patent No. 6,066,160	:	DECISION MERGING REEXAMINATION PROCEEDINGS
Reexam Control No.: 90/007,085 Filed: June 16, 2004 For: U.S. Patent No. 6,066,160	:	

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. 90/006,460 was ordered in a decision mailed January 16, 2003. Prosecution progressed through to the filing of an amendment to the claims on August 16, 2004, which amendment was responsive to a non-final Office action mailed April 2, 2004.

Reexamination in application Control No. 90/007,085 was ordered in a decision mailed August 6, 2004. The Office has received no Patent Owner statement responsive to the order mailed August 6, 2004.

Merger is proper if a reexamination is ordered while a prior reexamination proceeding is pending (37 CFR 1.565(c)). In view of the above, merger is appropriate and is hereby ordered and will be conducted in accordance with the following guidelines and requirements.

Requirement for Same Claims in Both Proceedings

As noted above the claims have been amended in the '460 reexamination proceedings. The Patent Owner is required to maintain identical specifications, abstract, drawings, 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. See 37 CFR 1.565 (d).

Conclusion

Reexamination Control Nos. 90/006,460 and 90/007,085 are hereby merged. **As stated above, Patent Owner has one month from the mailing date of this decision within which to submit a "housekeeping" amendment placing the same claims in both files.** Upon receipt of the amendment, an Office action will issue in due course.

John E. Kittle, Director
Technology Center 3700
Phone: (571) 272-2975

ak/12/08/04

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte McNeil-PPG, Inc.

Appeal 2007-3158
Reexamination Control 90/006,467
Patent 6,310,269
Technology Center 3700

Mailed: July 25, 2008

DECISION ON PETITION

This is a decision on the "Petition Under 37 C.F.R. § 1.183," filed July 15, 2008 ("Petition"). The Petition relates to a second request for rehearing before the Board, and therefore is treated as a petition delegated to the Chief Administrative Patent Judge. See 37 C.F.R. § 41.3(b)(petitions on matters pending before the Board); see also MPEP 1002.02(f)(4)(b).

As the Appellant's Petition has not demonstrated that consideration of the second Request for Rehearing is in the interests of justice, the Petition is DENIED.

FINDINGS

1. On November 8, 2007, the Board of Patent Appeals and Interferences ("Board") entered a Decision on Appeal affirming the rejection by the Examiner of claims 1, 3 and 4.

2. On December 28, 2007, Appellant filed a "Request for Rehearing Under 37 C.F.R. § 41.52(a)(1)" ("First Request for Rehearing").

3. On June 2, 2008, the Board entered a Decision on Request for Rehearing (37 CFR § 41.52(a)(1), also known as "Board Rule 52(a)(1)") ("Decision on Rehearing") denying rehearing.

4. On July 15, 2008, contemporaneous with the filing of the Petition, Appellant filed a "Second Request for Rehearing Under 37 C.F.R. § 41.52(a)(1)" ("Second Request for Rehearing").

5. In respect to second requests for rehearing, 37 C.F.R. § 41.52(a)(1) specifies:

> No request for rehearing from a decision on rehearing will be permitted, unless the rehearing decision so modified the original decision as to become, in effect, a new decision, and the Board states that a second request for rehearing would be permitted.

6. The Decision on Rehearing did not state that "a second request for rehearing would be permitted." *Id.*

7. The Petition seeks suspension of Board Rule 52(a)(1) under 37 C.F.R. § 1.183, which specifies that the rules will be suspended only "in an extraordinary situation, when justice requires."

8. In both the First and Second Requests for Rehearing, Appellant contends that in the Decision on Appeal, the Board relied on a new ground of rejection. First Request for Rehearing at 8; Second Request for Rehearing at 8-9. Specifically, Appellant argues that:

> Here, the Board has essentially ignored the Examiner's analysis of the case and engaged in its own fact finding that goes beyond anything the Examiner did. Consequently, Appellant has not had a full and fair opportunity to consider whether amendments and/or evidence are warranted.

First Request for Rehearing at 8.

9. In the Decision on Rehearing, the Board specifically addressed and refuted Appellant's new ground of rejection argument, stating:

> The Board did not enter a new ground of rejection.
>
> . . . .
>
> Even if the Board drew its findings more from Sasaki's [,the applied reference's,] Figures 8 and 10 than from Sasaki's written description of its invention, which focus Appellant alleges is different from that of the Examiner, the Board did not overstep the limits of propriety. *See In re Hedges*, 783 F.2d 1038, 1039 (Fed. Cir. 1986) (the PTO should not be constrained from pointing to other portions of the same references in contravention of Appellant's position). . . . The Board's emphasis on Figures 8 and 10 rather than Figure 11 does not change the thrust of the rejection.

Decision on Rehearing at 3-4.

10. In the Petition and Second Request for Rehearing, Appellant argues that in the Decision on Rehearing, "[t]he Board for the first time in the reexamination proceeding required evidence that 'Sasaki, *did not intend* its drawings . . . to show what they reasonably appear to show.'" Petition at 4

(quoting Decision on Rehearing) (emphasis in original); Second Request for Rehearing at 4.

11. In the Decision on Rehearing, the full text of the Board's position on the issue of evidence bearing on the contents of Sasaki's drawings was:

> It cannot be presumed without evidence that persons having ordinary skill in the art would have understood that Sasaki did not intend its drawings, which reasonably appear to show rib separation proximal to the core that is greater than the rib separation distal to the core, to show what they reasonably appear to show. Nor can it be presumed without evidence that persons having ordinary skill in the art would have understood that Sasaki did not intend its drawings, which reasonably appear to show ribs more compressed at their ends proximal to the core than at their ends distal to the core, to show what they reasonably appear to show. To take the opposite view without any evidence, few if any drawings could ever be relied upon to show what they reasonably show. That view is contrary to the direction of *In re Aslanian* [,509 F.2d 911, 914 (CCPA 1979)].

Decision on Rehearing at 5 (emphasis in original).

12. Appellant's other arguments in the Petition and Second Request for Rehearing relate to substantive factual issues, i.e., proper interpretation of the applied reference, and legal issues, i.e., proper application of law, and not to alleged procedural errors. Such factual and legal issues have been the subject of argument throughout this appeal.

DISCUSSION

In view of the demanding showing required to justify a suspension of the rules under 37 C.F.R. § 1.183 – an extraordinary circumstance, when justice requires – the only discernible basis on which Appellant's presently pending Petition could be granted is if the instant record discloses that the Board has denied Appellant due process.

Disagreements about the interpretation of a reference or the correct legal principal applicable to a particular situation do not constitute a denial of due process, particularly where those disagreements have existed from the beginning of an appeal.

Procedural Issues

The Appellant has alleged two procedural errors which may be construed as potential grounds resulting in denial of due process such that granting the petition might be warranted. First, the Appellant alleges that a new ground of rejection was made in the Decision on Appeal and not designated as such. Second, the Appellant alleges that the Board imposed a new requirement in the Decision on Rehearing to provide evidence that the Sasaki reference did not intend its drawings to show what they reasonably appear to show.

Neither of these allegations warrants the granting of the petition, as discussed below.

i) The Designation of the Rejection as a New Ground of Rejection

First, regarding the affirmed rejection in the Decision on Appeal, the record establishes that the Appellant was given a full and fair opportunity to present its position regarding designating the rejection as a new ground of

rejection in the First Request for Rehearing, which it did. FF8, first Request for Reconsideration at p. 1, ll. 4-6, and p. 8.

The Board then considered and rejected the substance of the Appellant's arguments in the Decision on Rehearing. FF9, Decision on Rehearing, pp. 3-4.

Citing recent Board decisions in unrelated cases and alleging that they are "inconsistent" (Petition, page 1, line 6) does not change the fact that in this case the Appellants have had sufficient due process.

Accordingly, this ground of the Petition does not establish that the interests of justice require waiving Board Rule 52(a)(1).

ii) Sasaki's Drawings

The Board, in extensive detail, addressed the contents of Sasaki's drawings in the Decision on Appeal. Decision on Appeal at 5-8. However, this was not the first time the issue had been joined by the Examiner and Appellant.

Sasaki is the same art which was applied by the Examiner throughout prosecution. Indeed, the Appellant noted in the First Request for rehearing, "[b]oth the Examiner and the Board rely primarily on the figures of Sasaki in support of the rejections". First Request for Rehearing, p. 2, ll. 23-24.

Furthermore, during prosecution before the Examiner, the Appellant on at least one occasion argued that "because none of the description or figures in Sasaki discloses, teaches, or suggests a tampon, wherein each of the ribs is compressed ... Sasaki does not anticipate claim 1 or claim 3" Argument, July 27, 2005, page 3, lines 25 et. seq.). Appellant has had opportunity to provide persuasive evidence to support its argument.

In the First Request for Rehearing, Appellant again presented arguments of its counsel as to how the drawings were lacking in detail. The Appellant again presented no persuasive evidence as to how one of ordinary skill in the art would view Sasaki and apply its description. The Decision on Rehearing responded by noting that there was no evidence in the record to support the Appellant's position.

The Board's observations of the weakness of Appellant's position are not a "new" requirement by the Board or opportunity presented for the "Patent Owner to submit evidence." Petition, p. 6, lines 2-3. The Appellant had full opportunity to present such evidence as it desired concerning the contents of Sasaki's drawings. Appellant had full opportunity to present how they would have been interpreted by one of ordinary skill in the art. Appellant could have done so during prosecution and in its appeal brief, when the contents of those drawings was a primary issue.

Substantive Issues

The remaining arguments presented by Appellant relate to substantive factual and legal issues which have existed throughout this appeal and for which the proper remedy for pursuing reversal of the Board's decisions is an appeal to an appropriate judicial tribunal and not a suspension of the rules under 37 C.F.R. § 1.183.

DECISION

In view of the foregoing, the Petition is DENIED.

Michael R. Fleming
Chief Administrative Patent Judge

Wendy A. Choi
Woodcock Washburn LLP
Cira Center
2929 Arch Street, 12th Floor
Philadelphia, PA 19104-2891

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Robert Deberardine
Abbott Laboratories
100 Abbott Park Road
Dept 377/AP6A
Abbott Park , IL 60064-6008

(For Patent Owner)

MAILED

MAY 0 4 2005

REEXAM UNIT

In re Reexamination Proceeding	:
D. Bruce Modesitt	:
Control No. 90/006,469	: DECISION GRANTING PETITION
Filed: November 29, 2002	:
U.S. Patent No. 6,136,010	:
Attorney Docket No. 6771.US.X1	:

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on February 18, 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 January 10, 2005.

The petition is granted.

The reexamination file is being returned to Technology Center Art Unit 3731 for further examination and consideration of the amendment filed January 10, 2005, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Gary Jackson, in Technology Center Art Unit 3731, who can be reached at 571-272-4697.

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

mai

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Paper No. 10

Matthew E. Connors, Esq.
SAMUELS, GAUTHIER &
STEVENS, LLP
225 Franklin Street
Suite 3300
Boston, MA 02110

(For Patent Owner)

MAILED

JUL 2 6 2004

REEXAM UNIT

In re Smith
Reexamination Proceeding
Control No. 90/006,470
Filed: December 2, 2002
For: U.S. Patent No. 5,900,637

DECISION GRANTING PETITION

This is a decision on the patent owner petition filed May 6, 2004, for entry of late papers based upon unintentional delay under 37 CFR § 1.137(b). Patent owner requests entry of a late-filed response to the non-final Office action of August 14, 2003. The petition is before the Office of Patent Legal Administration for consideration.

The petition is **granted**.

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 paid by check.

The petition for entry of late papers under 37 C.F.R. § 1.137(b) based upon unintentional delay is **granted** for the reasons indicated below.

DECISION

35 U.S.C. 41(a) states in part:

> The Director shall charge the following fees:
>
> > (7) . . . for an unintentionally delayed response by the patent owner in any reexamination proceeding, . . .

37 C.F.R. § 1.550(e)(2) states:

> (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).

A grantable petition under 37 C.F.R. § 1.137(b) must be accompanied by:

> (1) the 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 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 response to the non-final Office action of August 14, 2003, and the petition fee were included with the instant petition.

It should be noted that 37 C.F.R. § 1.137(b)(3) requires a statement that the entire delay in filing the 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.

In view of the above, the petition for the entry of late papers is sufficient to meet the criteria set forth under 37 C.F.R. § 1.137(b).

The petition is **granted**.

It should be noted that the response included with the petition includes an amendment, but 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 indicates the deletions using strike-out, instead of bracketing the deletions being made, as required. Any text being deleted from the original patent should be bracketed. Any text being added should be underlined. All changes being made should be made with respect to the text of the original patent, and not with respect to any prior amendment. Any new claims to the patent should be completely underlined as required by 37 CFR § 1.530(d)(2) and (f). 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).

A corrected amendment in compliance 37 CFR § 1.530 should be sent to Technology Center 2800, addressed to the examiner, Jack Berman, of Group Art Unit 2881, within ONE month of the mailing date of this petition decision.

CONCLUSION

1. The petition is **granted**.

2. A corrected amendment in compliance 37 CFR § 1.530, is due within **ONE** month of the mailing date of this petition decision, and should be directed to Technology Center 2800.

3. The reexamination file will be forwarded to Technology Center 2800 to await receipt of the corrected amendment, and for consideration of the response to the non-final Office action of August 14, 2003.

4. Further inquiries with regard to this reexamination proceeding should be directed to the examiner, Jack Berman, of Group Art Unit 2881.

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

July 20, 2004

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Paper No. 17

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DEC 0 2 2003
REEXAM UNIT

John A. Monocello III (For Patent Owner)
Cohen & Grigsby P C
11 Stanwix Street 15th Floor
Pittsburgh PA 15222

Enclosure: Patent owner petition filed March 20, 2003

Irving M. Weiner (For Requester)
Weiner & Burt, P.C.
635 N. US-23
P.O. Box 186
Harrisville, MI 48740

Enclosure: Copy of patent owner petition filed March 20, 2003.

Merlot et al	
Reexamination Proceeding	DECISION
Control No. 90/006,482	RETURNING
Filed: December 13, 2002	PETITION
For: U.S. Patent No. 5,026,109	

This is a decision on the March 20, 2003, patent owner petition under 37 CFR 1.182, titled "PETITION PURSUANT TO 37 CFR 1.182 FOR CLARIFICATION OF QUESTION 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 37 CFR 1.182 petition is $130.00. This fee has been charged to petitioner's deposit account no. 03-2026, as per the petitioner's instructions given in the last page of the instant petition.

The petition is being <u>returned to the patent owner</u> for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 5,026,109 (hereinafter, the '109 patent), issued to Merlot et al, on January 25, 1991.

2. A request for reexamination, assigned control No. 90/006,482, was filed by a third party requester on December 13, 2002.

3. Reexamination was ordered February 11, 2003, for the '482 reexamination proceeding.

4. A first Office action has not yet been issued for the proceeding. Some papers have been filed in the proceeding having no relevance to the instant decision.

5. On March 20, 2003, the patent owner filed the present petition under 37 CFR 1.182, for "CLARIFICATION OF QUESTION NOT SPECIFICALLY PROVIDED FOR IN THE REGULATIONS."

DECISION RETURNING PAPER

Under 37 CFR 1.540:

> ... 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 filed by the patent owner has been filed prior to the start of the examination on the merits. It is not a statement under § 1.530, nor is it a reply under § 1.535. Rather it is a paper seeking clarification of a question not specifically provided for in the rules. Accordingly, the petition is an improper submission under § 1.540, and it will not be made of record in the reexamination file. The petition is being <u>returned to the patent owner</u> with the present decision.

A copy of the petition is being provided to the third party requester, since there is no indication that the third party requester was provided with a copy of the papers, as discussed immediately below.

The present decision will be made of record in the reexamination file.

LACK OF SERVICE

The patent owner's petition is deficient for failure to reflect service of the petition on the third party requester in accordance with 37 CFR 1.550(f).

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.

The requisite proof of service on the requester (a Certificate of Service) was not included with the instant petition papers.

Any future communications filed by the patent owner in this proceeding must include proof of service on the third party requester in accordance with 37 CFR 1.550(f).

ADVISORY INFORMATION

Although the present petition paper does not have an entry right at this point in the proceeding (for the reasons discussed above), such a paper could have an entry right at a future point in the proceeding. Accordingly, it will now be pointed out, as a courtesy to the patent owner, why the relief requested in the petition is not a matter of relief that is provided for.

At page 2 of the petitions, it is stated:

> "The Patent Owner recognizes that some of the same issues with respect to prior art that exists in the reexamination were present in Sundance v. Aero Industries, and may have been referred to in attorney arguments and pleadings in that case However, it is unclear as to whether pleadings and attorney arguments submitted in a prior litigation involving a patent under reexamination should be submitted to the Patent Office as part of the Patent Owner's obligation under 37 CFR 1.555 and 1.565. As such, the **Patent Owner requests a decision on this petition with respect to whether it is necessary to submits pleadings, briefs, memorandum, attorney argument, and other related items that were made of record in the prior litigation.** The Patent Owner will provide such information should the Patent Office deem it necessary." [Emphasis added]

This request that the Office determine whether it is necessary for patent owner to submit pleadings, briefs, etc, is not a matter addressed by the Office. The relief granted in response to a petition is directed to some action that a party wishes to take, or to some action that the party desires the Office to take. The Office does not render advisory opinions as to whether the duties on a patent owner would call for submission of information which the patent owner informs the Office to exist. Accordingly, any future petition directed to this matter which would have an entry right in the present proceeding would be appropriately dismissed for failure to state a cause of relief.

It is pointed out to the patent owner that 37 CFR 1.555(a) and 37 CFR 1.565(a) address information to be submitted in a reexamination proceeding.

Pursuant to 37 CFR 1.555(a), "[e]ach 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." [Emphasis added]

Pursuant to 37 CFR 1.565(a), "[i]n an *ex parte* reexamination proceeding before the Office, the patent owner must **inform** the Office of **any prior or concurrent proceedings in which the patent is or was involved such as interferences, reissues, *ex parte* reexaminations, inter partes reexaminations, or litigation and the results of such proceedings.**" [Emphasis added] Section 2282 of the Manual of Patent Examining Procedure adds "In accordance with 37 CFR 1.565(a), the patent owner is required to provide the Office with information **regarding the existence of any such proceedings**, and **the results thereof**, if known." [Emphasis added]

As stated in the decision of *In re Sivertz*, 227 USPQ 255, 256 (Comm'r Pat. 1985), "a registered attorney ... is presumed either to know the provisions of the rules or **at the least to be able to** obtain and **interpret those rules**." [Emphasis added] Thus, it is the province of the patent owner, by way of the registered practitioners who represent it, to interpret the rules and make the determination as to whether or not the information in question to petitioner should be submitted in the proceeding.

As a final point, it is to be noted that the patent owner is in the best position to determine whether information within its possession should be submitted pursuant to 37 CFR 1.555(a) and 37 CFR 1.565(a), as the patent owner is most familiar with the claimed invention and the nature of the information in its

possession. Further, the patent owner is in the best position to be aware of any ancillary considerations that might bear on whether or not the information should be submitted. Thus, it is quite appropriate that the patent owner, and not the Office, should make the decision as to whether the duties under §§1.555(a) and 37 CFR 1.565(a) call for submission of the information.

CONCLUSION

1. The petition is being <u>returned to the patent owner</u> with the present decision.

2. A copy of the petition is being provided to the third party requester.

3. The reexamination file is being forwarded to the examiner via the Group Director of Technology Center 3600, for the issuance of a first Office action in due course.

4. Telephone inquiries with regard to this decision should be directed to the undersigned at (703) 308-6710.

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

December 2, 2003
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Paper No. 19

John A. Monocello III (For Patent Owner)
Cohen & Grigsby P C
11 Stanwix Street 15th Floor
Pittsburgh PA 15222

Carrier, Blackman & Associates, P.C. (For Requester)
24101 Novi Road
Suite 100
Novi, MI 48375

Irving M. Weiner (Counsel who has withdrawn)
Weiner & Burt, P.C.
635 N. US-23
P.O. Box 186
Harrisville, MI 48740

MAILED
FEB 27 2004
REEXAM UNIT

Merlot et al	:
Reexamination Proceeding	: DECISION
Control No. 90/006,482	: GRANTING
Filed: December 13, 2002	: PETITION
For: U.S. Patent No. 5,026,109	:
	:

This is a decision on papers filed by a third party, Quick Draw Tarpaulin Systems, Inc. (hereinafter Quick Draw), on May 15, 2003, and February 9, 2004, requesting that:

(a) Quick Draw be henceforth recognized as the "third party requester" of the present proceeding, and

(b) the counsel appointed by Quick Draw be entered as requester's attorney of record for the proceeding.

As this request is for a "situation not specifically provided for in the regulations," it is being taken as a petition under 37 CFR 1.182.

Pursuant to 37 CFR 1.17(h), the petition fee for a 37 CFR 1.182 petition is $130.00. This fee has been charged to petitioner's deposit account no. 50-0744, as per the petitioner's instructions given in a telephone conference on February 11, 2004, between Joseph Carrier and the undersigned.

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

The petition is granted.

REVIEW OF FACTS

1. U.S. Patent No. 5,026,109 (hereinafter, the '109 patent), issued to Merlot et al, on January 25, 1991.

2. A request for reexamination, assigned control No. 90/006,482, was filed by a third party requester on December 13, 2002. The third party requester was identified as Irving M. Weiner.

3. Reexamination was ordered February 11, 2003, for the '482 reexamination proceeding.

4. A first Office action has not yet been issued for the proceeding. Papers have been filed in the proceeding having no relevance to the instant decision.

5. On May 14, 2003, Irving M. Weiner filed a "Request for Withdrawal as Attorney or Agent."

6. On February 9, 2004, and May 15, 2003, a third party, Quick Draw, filed papers requesting that (a) Quick Draw be henceforth recognized as the third party requester of the present proceeding, and (b) Joseph Carrier and William Blackman, the counsel appointed by Quick Draw, be entered as requester's attorney of record.

DECISION

Under 37 CFR 1.36:

> "A power of attorney or authorization of agent, pursuant to § 1.31, may be revoked at any stage in the proceedings of a case, **and a registered attorney or agent may withdraw**, upon application to and approval by the Commissioner." [Emphasis added]

In the present instance Irving M. Weiner is the third party requester, since he filed the request for reexamination in his own name, and a real party in interest was not identified in the filing of the request. Mr. Weiner has now filed a "Request for Withdrawal as Attorney or Agent" from the present proceeding. Mr. Weiner wishes to withdraw from representation of Quick Draw in the present reexamination proceeding. Mr. Weiner was not, however, identified as the attorney for Quick Draw (or anyone else), until his request for withdrawal was filed. In addition, even if the request for withdrawal from representation of Quick Draw is granted, Irving Mr. Weiner remains as the third party requester who filed the request, since Quick Draw was not identified as the real party in interest in the filing of the request.

In this instance, however, it is clear the Mr. Weiner does not wish to be accorded the rights of the third party requester in the proceeding, and Quick Draw has come forward to assume that capacity. Given these circumstances, a remedy is fashioned as follows:

A. The "Request for Withdrawal as Attorney or Agent" filed May 14, 2003, by Irving M. Weiner is approved.

B. Quick Draw will be recognized as the third party requester of the present proceeding, from the date of mailing of this decision.

C. The appointment of Joseph Carrier and William Blackman to represent Quick Draw in this proceeding is approved.

D. A copy of any future Office correspondence in this proceeding will be mailed to:

Carrier, Blackman & Associates, P.C.
24101 Novi Road
Suite 100
Novi, MI 48375

D. Any future document filed in the reexamination proceeding by the <u>patent owner</u> must be served on Quick Draw in the manner provided by 37 CFR 1.248, at the address:

Carrier, Blackman & Associates, P.C.
24101 Novi Road
Suite 100
Novi, MI 48375

Any such future patent owner document must reflect service of the document at that address, or it may be refused consideration by the Office.

CONCLUSION

1. The petition is granted.

2. The Request for Withdrawal as Attorney or Agent, filed May 14, 2003, by Irving M. Weiner, is approved.

3. The party Quick Draw is henceforth recognized as the third party requester of the reexamination, and Joseph Carrier and William Blackman as representative counsel for Quick Draw for the reexamination proceeding.

4. The correspondence address has been changed to the Novi Road address identified above.

5. Any future patent owner document filed in this proceeding must reflect service at the Novi Road address.

6. The reexamination file is being returned to Technology Center 3600.

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

February 27, 2004
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FROM DIRECTORS OFFICE

JUL 07 2005

APPROVED
7/7/05

TECHNOLOGY CENTER 3600

PTO/SB/83 (06-03)
Approved for use through 11/30/2005. OMB 0651-0035
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT

Application Number	90/006,483
Filing Date	December 18, 2002
First Named Inventor	Crupi
Art Unit	3671
Examiner Name	Gary S,. Hartmann
Attorney Docket Number	023266.46568

To: Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I hereby apply to withdraw as attorney or agent for the above identified patent application.

The reasons for this request are:

non-payment of fees.

CORRESPONDENCE ADDRESS

1. ☐ The correspondence address is NOT affected by this withdrawal.
2. ☒ Change the correspondence address and direct all future correspondence to:

☐ Customer Number

OR

☒ Firm or Individual Name	Francesco A. Crupi				
Address	2845 Seabreeze Drive South				
Address					
City	Gulfport	State	FL	ZIP	33707
Country	United States of America				
Telephone		Fax			

☒ This request is made on behalf of myself and
- ☐ all the attorneys/agents of record,
- ☐ the attorneys/agents (with registration numbers) listed on the attached paper(s), or
- ☒ the attorneys/agents associated with Customer Number 28172

This request is enclosed in triplicate (including any attachments).

Name	Susan B. Fentress		
Signature	Susan B Fentress	Registration No.	31,327
Date	10-24-04		

NOTE: Withdrawal is effective when approved rather than when received. Unless there are at least 30 days between approval of withdrawal and the expiration date of a time period for response or possible extension period, the request to withdraw is normally disapproved.

This collection of information is required by 37 CFR 1.36. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you are required to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: **Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

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TECHNOLOGY CENTER 3600

For the Patent Owner:

Butler, Snow, O'Mara, Stevens & Cannada, PLLC
6075 Poplar Ave, Suite 500
Memphis, TN 38119

For the Requester:

Michael P. Mazza
686 Cresent Blvd.
Glen Ellyn, IL 60137

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

In re Reexamination proceeding 90/006,484
Filed: December 18, 2002
For: MIXING APPARATUS AND METHOD FOR BLENDING MILLED ASPHALT WITH REJUVENATING FLUID

This is a decision on the renewed request filed on November 8, 2004 under 37 CFR 1.36 and MPEP 402.06, requesting permission to withdraw as the attorney of record in the above-identified application. The delay in treating this request is sincerely regretted.

The request is **NOT APPROVED**.

Under 37 CFR 1.36 an attorney may withdraw only upon application to and approval by the Commissioner. 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) If withdrawal is requested in accordance with 37 CFR 10.40(c) above, there must be at least 30 days between approval of the withdrawal and the later of the expiration date of a time period for reply or the expiration date of the period which can be obtained by a petition and fee for extension of time under 37 CFR 1.136(a).

The request to withdraw as attorney is not accepted in the above-identified application because the request lacks condition C) above.

As to condition C), there now appears to be less than 30 days remaining in the extendable response period for the Office action mailed May 19, 2005.

Steven N. Meyers
Special Programs Examiner
Patent Technology Center 3600
(571) 272-6611

SNM: 7/08/05

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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.
90/006,489	12/17/2002	5261858	SIC-99-041-1	9231

500 7590 05/11/2004

SEED INTELLECTUAL PROPERTY LAW GROUP PLLC
701 FIFTH AVE
SUITE 6300
SEATTLE, WA 98104-7092

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/11/2004 #11

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

90006489 .031504

PTO-90C (Rev. 10/03)

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OK
SM

For the Patent Owner:

Seed Intellectual Property Law Group PLLC
701 Fifth Ave., Suite 6300
Seattle, WA 98104-7092

For the Requester:

James A. Deland
Deland Law Office
P.O. Box 69
Klamath River, CA 96050

DECISION ON PETITION
FOR THE ACCEPTANCE
OF LATE PAPERS

In re Reexamination proceeding 90/006,489
Filed: December 17, 2002
For: METHOD AND SYSTEM FOR COMPUTER-CONTROLLED BICYCLE GEAR SHIFTING

This is in reply to petitioner's communications filed March 15, 2004, March 24, 2004, April 23, 2004 and May 11, 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 Amendment submitted by the patent owner in response to the Office action of August 13, 2003, was apparently never received by the Office. The patent owner has submitted a copy of the above-noted amendment having a Certificate of Mail dated October 14, 2003, along with a statement under 37 CFR 1.8(b)(3) by the person signing the Certificate of Mail. This is acceptable evidence of a timely filing of the lost amendment.

The reexamination file is being forwarded to the Supervisory Legal Instruments Examiner to accept the amendment from the patent owner filed October 14, 2003 as timely filed.

Steven N. Meyers
Patent Technology Center 3600
(703) 308-3868

SM/SM: 1/17/04

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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
90/006,673	06/23/2003	4728721	TKRX721	5433

7590 03/10/2004

Harold C. Wegner
Foley and Lardner
Washington Harbour
3000 K Street NW Suite 500
Washington, DC 20007-5143

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/10/2004 11

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. 11

Harold C. Wegner Foley & Wegner Washington Harbour 3000 K Street, NW, Suite 500 Washington, DC 2007-5143	(for Patent Owner)
William C. Mitchell, Esq. Oakwood Laboratories, LLC 7670 Fist Place, Suite A Oakwood Village, OH 44146	(for Third Party)
Susan P. Petraglia, Esq. 116 Sixth Street, NE, No. 303 Washington, DC 20002	(for Third Party)
In re Yamamoto et al Reexamination Proceeding Control No. 90/006,490 Filed: December 20, 2002 For: U.S. Patent 4,728,721 In re Yamamoto et al Reexamination Proceeding Control No. 90/006,673 Filed: June 23, 2003 For: U.S. Patent 4,728,721	**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 4,728,721, issued March 1, 1988, is the subject of Reexamination Control Nos. 90/006,490 and 90/006,673.

2. A first request for reexamination, assigned Reexamination Control No. 90/006,490 ('490) was filed December 20, 2002 by William C. Mitchell of Oakwood Laboratories. The request urged that a substantial new question of patentability was raised by the teachings of the following references: (a) UK 2,145,422 to Brich et al; (b) EP 0052510 to Kent et al; (c) US Patent 3,773,919 to Boswell et al; (d) EP 0058481 to Hutchinson et al; (e) "Biodegradable Polymers for Sustained Drug Delivery" to Schindler et al; (f) "Stereoregular Bioresorbable Polyesters for Orthopedic Surgery" to Vert et al; (g) "Biodegradable Poly(lactic acid) Polymers" to Kulkarni et al and (h) US Patent 4,273,920 to Nevin.

3. Reexamination was ordered for '490 on February 27, 2003.

4. A second request for reexamination, assigned Reexamination Control No. 90/006,673 ('673), was filed June 23, 2003 by Susan P. Petraglia. The request urged that a substantial new question of patentability was raised by the teachings of (a) U.S. Patent 4,767,628 and EP 58,481 to Hutchinson; (b) Vert (Makromol. Chem., Suppl. 5); and (c) GB 2,145,422 to Brich.

5. Reexamination was ordered for '673 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 90/006,490 and 90/006,673 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 files shall be forwarded to the examiner for preparation of an Office action.

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. 90/006,490 and 90/006,673 as:

Harold C. Wegner
Foley & Wegner
Washington Harbour
3000 K Street, NW, Suite 500
Washington, DC 2007-5143

CONCLUSION

Reexamination Control Nos. 90/006,490 and 90/006,673 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
Director, Technology Center 1700
High Polymer Chemistry, Plastics,
Stock Materials and Compositions

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