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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/006,491 | 12/26/2002 | 5625670 | | 9464 |

20457 7590 03/26/2003

ANTONELLI TERRY STOUT AND KRAUS
SUITE 1800
1300 NORTH SEVENTEENTH STREET
ARLINGTON, VA 22209

| EXAMINER |
|---|
| L. Kincaid |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2685 | 9 |

DATE MAILED: 03/26/2003

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

PTO-90C (Rev. 07-01)

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Paper No. 9

ANTONELLI TERRY STOUT AND KRAUS (For Patent Owner)
SUITE 1800
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ARLINGTON VA 22209

| | | |
|---|---|---|
| In re Reexamination of: | ) | |
| U.S. Patent No. 5,625,670 | ) | DECISION CONCERNING |
| Reexamination Control No. 90/006,491 | ) | PAPERS FILED BY |
| For: ELECTRONIC MAIL SYSTEM WITH RF COMMUNICATIONS TO MOBILE PROCESSORS | ) | PATENT OWNER |

The present proceeding is before the TC 2600 Special Program Examiners' Office for clarification of status of the papers filed on February 26, 2003 and March 14, 2003 by the Patent Owner.

## BACKGROUND

A review of the file finds the following contents of the proceedings:

1) On December 26, 2002, a Director Initiated Order for Reexamination was mailed to the Patent Owner (Paper No. 1).

2) On December 24, 2002 the Title report was placed in the file (Paper No. 2).

3) On February 26, 2003, Patent Owner filed
   a) a Patent Owner's Statement under Protective Order (Paper No. 3),
   b) an Expert Declaration submitted under Protective Order (Paper No. 4),
   c) a Declaration of Donald E. Stout pursuant to 37 CFR 1.131 (Paper No. 5),
   d) a Declaration of Thomas J. Campana, Jr. pursuant to 37 CFR 1.131 (Paper No. 6), and
   e) and Information Disclosure Statement under 37 CFR 1.555 (Paper No. 7).

4) On March 5, 2003, Patent Owner filed copies of date-stamped postcard receipts (Paper No. 8) evidencing the timely filing of the items listed above in section 3) of this communication.

The Office regrets the failure to date-stamp the original papers submitted to the Office on February 26, 2003. The original papers which were missing date-stamps have now been date-stamped in accordance with the evidence provided.

5) On March 14. 2003, Patent Owner filed a Petition under 37 CFR 1.183 for filing a Supplemental Patent Owner's Statement. Entry of the submitted Supplemental Patent Owner's Statement and accompanying Information therewith will be decided by the Office of Patent Legal Administration (OPLA) in their decision on this petition.

## DECISION

There are no provisions for submitting a Patent Owner's Statement and/or declarations under 37 CFR 1.131 and 37 CFR 1.132 under Protective Order. MPEP 724.03 sets forth the types of Trade Secret, Proprietary, and/or Protective Order Materials contemplated for submission under MPEP 724.02 and clearly sets forth that if any protective order materials are submitted in "***amendments, arguments in favor of patentability, or affidavits under 37 CFR 1.131 or 1.132, they will be made of record in the file and will not be given any special status***." Because the Patent Owner's Statement must clearly point out why the claims are deemed to be patentable (see MPEP 2249), by definition, the Patent Owner's Statement is inappropriate for submission under Protective Order. Accordingly, the Patent Owner's Statement has been made of record in the file as Paper No. 3. Likewise, the Expert Declaration which was also submitted under Protective Order was inappropriate for submission under Protective Order and has been made of record in the file as Paper No. 4.

## CONCLUSION

The papers filed under Protective Order have been removed from the envelopes and made of record. The file is being forwarded to OPLA for a decision on the Petition filed March 14, 2003.

Krista Zele
Special Programs Examiner
Technology Center 2600
Communications

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Paper No. 10

Donald E. Stout
Antonelli, Terry, Stout & Kraus
Suite 1800
1300 N. 17th Street
Arlington, VA 22209

(For Patent Owner)

MAILED

APR 0 1 2003

REEXAM UNIT

Enclosure: Patent Owner Petition and attachments filed March 14, 2003

| | | |
|---|---|---|
| In re Campana, Jr. et al. | : | |
| Reexamination Proceeding | : | DECISION DISMISSING |
| Control No. 90/006,491 | : | PETITION AND RETURNING |
| Initiated: December 26, 2002 | : | IMPROPER PAPER |
| For: U.S. Patent No. 5,625,670 | : | |

This is a decision on the March 14, 2003, patent owner petition entitled "PETITION PURSUANT TO 37 C.F.R. § 1.183 TO ENLARGE THE TWO MONTH TIME LIMIT FOR FILING A SUPPLEMENTAL PATENT OWNER'S STATEMENT PURSUANT TO 37 CFR § 1.530." The petition is before the Office of Patent Legal Administration for decision.

For the reasons set forth below, the petition is dismissed and is being returned along with this decision.

**REVIEW OF FACTS**

1. On December 26, 2002, reexamination was ordered for five of Patent Owner's patents. The order for reexamination was issued at the initiative of the Director of the United States Patent and Trademark Office under 37 CFR 1.520. The patents and their assigned control number are: 5,625,670 (90/006,491); 5,631,946 (90/006,492); 5,819,172 (90/006,493); 6,067,451 (90/006,494); and 6,317,592 (90/006,495). The present reexamination proceeding is reexamination control number 90/006,491.

2. On February 26, 2003, Patent Owner filed (a) a Patent Owner's Statement under Protective Order (Paper No. 3), (b)an Expert Declaration submitted under Protective Order (Paper No. 4), (c) a Declaration of Donald E. Stout pursuant to 37 CFR 1.131 (Paper No. 5), (d) a Declaration of Thomas J. Campana, Jr. pursuant to 37 CFR 1.131 (Paper No. 6), and (e) an Information Disclosure Statement under 37 CFR 1.555 (Paper No. 7).

3. On March 5, 2003, Patent Owner filed copies of date-stamped postcard receipts (Paper No. 8) evidencing the timely filing of the February 26, 2003, papers. The original papers which had been missing date-stamps were then date-stamped as received on February 26, 2003, pursuant to the evidence provided by Patent Owner.

4. On March 14, 2003, Patent Owner filed the present petition under 37 CFR 1.183 requesting "suspension of the two-month time limit set for the response to the Order for Reexamination" to permit entry of the *accompanying* "Supplemental Patent Owner's Statement Pursuant to 37 CFR 1.530"

5. On March 26, 2003, a "DECISION CONCERNING PAPERS FILED BY PATENT OWNER" was issued by the Technology Center 2600 Special Programs Examiner, stating that "the papers filed [February 26, 2003] under Protective Order have been removed from the envelopes and made of record."

6. The present file was then forwarded to the Office of Patent Legal Administration for a decision on the petition.

**DECISION**

37 CFR 1.540 states:

> No submissions other than the statement pursuant to § 1.530 and the reply by the *ex parte* reexamination requester pursuant to § 1.535 will be considered prior to examination.

The examination stage of the present proceeding has not yet begun, as a first Office action on the merits has not yet been issued. The present March 14, 2003, submission is not a "reply by the *ex parte* reexamination requester pursuant to § 1.535," since it is filed by the patent owner. Further, the submission is not a Patent Owner's statement pursuant to § 1.530, because the Patent Owner's statement pursuant to § 1.530 was already filed on February 26, 2003. Pursuant to 35 U.S.C. 304, the patent owner is

given a reasonable period "within which he may file **a statement**" [Emphasis added] on the question of patentability raised in the order for reexamination. There is no provision in the statute for more than one statement, i.e., there is no provision for a second statement to supplement the first statement.

Since the present March 14, 2003, submission is submission is not a "statement" nor a "reply," entry of same is barred under 37 CFR 1.540.

37 CFR 1.530(b) states:

> The order for *ex parte* reexamination will set a period of not less than two months from the date of the order **within which the patent owner may file a statement on the new question of patentability**, including any proposed amendments the patent owner wishes to make. [Emphasis Added]

Under 37 CFR 1.530(b), the Patent Owner may file the statement *only* within the period set therein. The period set in the December 26, 2002, order for *ex parte* reexamination was two months. Accordingly, the present March 14, 2003, submission would not be timely, even if it were a proper statement under 37 CFR 1.530.

In view of the above, the March 14, 2003, submission of Patent Owner's petition and the accompanying "Supplemental Patent Owner's Statement Pursuant to 37 CFR 1.530" is an improper submission under 37 CFR 1.530(b) and under 37 CFR 1.540. Accordingly, the submission will not be made of record in the reexamination file and is being returned herewith. MPEP 2267. See *In re Knight*, 217 USPQ 294 (Comm'r Pat. 1982); *Patlex Corp. v Mossinghoff*, 226 USPQ 985, 986 (Fed. Cir. 1985). This decision will, however, be made of record in the reexamination file.

As to petitioner's request to waive the rules pursuant to 37 CFR 1.183:

Patent Owner's request for "suspension of the two-month time limit set" in the order is, in effect, a request that the Director to waive the provisions of 37 CFR 1.530(b) and permit (1) entry of the instant petition and accompanying "Supplemental Patent Owner's Statement Pursuant to 37 CFR 1.530," and (2) consideration of same when the examiner issues the first Office action on the merits. A waiver of the requirement to file the statement within the two month time period (set in the order) will not, however, provide Patent Owner with the relief Patent Owner desires, since consideration of the March 14, 2003,

submission would still be barred under 37 CFR 1.540, because the present March 14, 2003, submission is not a "statement" nor a "reply" as discussed above.

Accordingly, Patent owner's petition is taken as a request to waive the provisions of 37 CFR 1.540 and permit entry of a submission other than a statement pursuant to § 1.530 and a reply pursuant to § 1.535.

In order for grant of a petition under 37 CFR 1.183, a petitioner must show (1) that there is an extraordinary situation (2) where justice requires waiver of the rule. *In re Sivertz*, 227 USPQ 255, 256 (Comm'r Pat. 1985). Petitioner Patent Owner has not show that either condition exists in this case.

The present March 14, 2003, submission, for which entry and consideration in the first Office action is requested, provides a paper that was presented in litigation related to the patent being reexamined, and discusses what Patent Owner believes to be the significance of that paper. If entry is not provided at this point, Patent Owner is free to re-submit the March 14, 2003, submission during the examination stage of the present proceeding, i.e., after the first Office action is issued. At that point, the submission would have an entry right and would be considered by the examiner. There is no showing in the petition that re-submission during the examination stage would prejudice Patent Owner as to the consideration of the information presented (in the submission) in a manner as to create an extraordinary situation where justice requires waiver of the provisions of 37 CFR 1.540. Accordingly, the relief provided by 37 CFR 1.183 is not appropriate in this instance, [1] and the present petition pursuant to 37 CFR 1.183 is dismissed.

**CONCLUSION**

1. The March 14, 2003, patent owner petition filed pursuant to 37 CFR 1.183 is dismissed, and it is being returned along with this decision.

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[1] Note that the Office will not normally consider an extraordinary remedy when the rules already provide an avenue for obtaining the relief sought. *See Cantello v. Rasmussen*, 220 USPQ 664 (Comm'r Pat. 1982).

3. The reexamination file is being returned to Technology Center 2600 for storage until a reply under 37 CFR 1.535 is received, or the time for filing same expires, after which a first Office action on the merits is to be issued.

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

April 1, 2003
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/006,678 and 90/006491 | 06/24/2003 | 5625670 | | 5441 |

803 7590 05/26/2004

EXAMINER

STURM & FIX LLP
206 SIXTH AVENUE
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DES MOINES, IA 50309-4076

| ART UNIT | PAPER NUMBER |
|---|---|

DATE MAILED: 05/26/2004

#19

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

cc: Third Party Requester, as attached

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

David L. Stewart
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255 S. Orange Avenue
Suite 1401
Orlando, FL 32801

# *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/006,678 and 90/006491.

PATENT NO. *5625670*.

ART UNIT *2600*.

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. 19

| | | |
|---|---|---|
| Sturm & Fix LLP<br>206 Sixth Avenue<br>Suite 1213<br>Des Moines, IA 50309-4076 | ) | For Patent Owner |
| David Stewart<br>Allen Dyer Doppelt Milbrath & Gilchrist, PA<br>255 S. Orange Avenue<br>Suite 1401<br>Orlando, FL 32801 | ) | For Third Party Requester |
| In re Campana et al.<br>Reexamination Proceeding<br>Control No.: 90/006,491<br>Filed: December 26, 2002<br>For: U.S. Patent 5,625,670 | ) | DECISION *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS |
| In re Campana et al.<br>Reexamination Proceeding<br>Control No.: 90/006,678<br>Filed: June 24, 2003<br>For: U.S. Patent 5,625,670 | ) | |

DECISION MERGING REEXAMINATION PROCEEDINGS

The above noted reexamination proceedings are before the Director of Technology Center 2600 for consideration of merger of the proceedings under 37 CFR 1.56(c).

## BACKGROUND

1. Patent 5,625,670 issued on April 29, 1997.

2. On December 26, 2002, a Director Initiated Order for Reexamination was mailed to the Patent Owner as Control No. 90/006,491 ('491).

3. A Patent Owner's Statement was filed in the '491 proceeding on February 26, 2003.

4. A request for reexamination, Control No. 90/006,678 ('678) was filed by the Third Party Requester on June 24, 2003.

5. Reexamination was ordered on the '678 reexamination proceeding on September 3, 2003.

6. No Patent Owner Statement was filed in the '678 reexamination proceeding.

## DISCUSSION

37 CFR 1.565(c) states:

> "If reexamination is ordered while a prior reexamination is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under section 1.570".

## DECISION

**I.** Merger of Proceedings

In accordance with 37 CFR 1.565(c), the '491 and '678 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 all proceedings.

The Patent Owner is required to maintain the same claims and specification in both files.

**III.** Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action, which applies to both proceedings. All papers issued by the Office or filed by the Patent Owner must contain the identifying data for both proceedings and will be physically entered in each reexamination file which will be separately maintained. All papers filed by the Patent Owner must also consist of a single response, filed in duplicate, each bearing an original signature, for entry into each file. All papers filed by the Patent Owner must be served on the requestor and requestor will be sent copies of all papers mailed by the Office. See MPEP 2283.

A review of these reexamination files finds that both proceedings currently contain the same claims and specification and therefore the Patent Owner need not take any action.

Page 2 of 5

The merged proceedings are being forwarded to the examiner for appropriate action. An Office action will be mailed in due course.

Andy Faile, Acting Director
Technology Center 2600
Communications

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO | CONFIRMATION NO |
|---|---|---|---|---|
| 90/006,678 | 06/24/2003 | 5625670 | | 5441 |

803 7590 11/24/2003

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| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED 11/24/2003

EF7

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Paper No. __

Donald E. Stout (For Patent Owner)
Antonelli, Terry, Stout & Kraus
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Arlington, VA 22209

Enclosure: Copy of Requester 37 CFR 1.183 petition filed July 31, 2003

David L. Stewart (For Requester)
ALLEN DYER DOPPELT MILBRATH
& GILCHRIST, P.A.
Suite 1401
Orlando, FL 32802

MAILED
NOV 24 2003
REEXAM UNIT

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|---|---|
| In re Campana, Jr. et al. | |
| Reexamination Proceeding | DECISION DISMISSING |
| Control No. 90/006,678 | AND RETURNING |
| Filed: June 24, 2003 | PETITION UNDER |
| For: U.S. Patent No. 5,625,670 | 37 CFR 1.183 |

This is a decision on the July 31, 2003, third party requester petition under 37 CFR 1.183, to suspend the rules, to permit third party requester participation in the examination stage of the instant *ex parte* reexamination proceeding.

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

Petitioner has paid the $130.00 fee associated with this type of petition, in accordance with 37 CFR 1.17(h).

The petition is dismissed.

The petition paper will not be entered in the file, but rather will be forwarded to the patent owner, because the Office records fail to indicate that the owner was ever served with a copy of the paper.

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## REVIEW OF FACTS

1. U.S. Patent No. 5,625,670 (hereinafter, the '670 patent), issued to Campana, Jr. et al., on April 27, 1997, from an application filed on May 18, 1995.

2. On December 26, 2002, reexamination was ordered for five of Patent Owner's patents. The order for reexamination was issued at the initiative of the Director of the United States Patent and Trademark Office under 37 CFR 1.520. The patents and their assigned control number are: 5,625,670 (90/006,491); 5,631,946 (90/006,492); 5,819,172 (90/006,493); 6,067,451 (90/006,494); and 6,317,592 (90/006,495). The ordered reexamination proceeding for the present patent is reexamination control number 90/006,491.

3. On April 17, 2003, a request for *inter partes* reexamination of the '670 patent was deposited in the Office by the third party requester. The '670 patent was held not to be eligible for *inter partes* reexamination, and a decision of the Director of Office of Patent Legal Administration (OPLA) was mailed on June 6, 2003 (and supplemented on June 12, 2003), in which the requestor's May 6, 2003, petition under 37 CFR 1.181 for a determination of eligibility was denied.[1]

4. On June 24, 2003, the requester of the *inter partes* reexamination filed the present request for an ***ex parte*** reexamination of the '670 patent, which was assigned control number 90/006,678.

5. On July 31, 2003, the requester filed the present petition under 37 CFR 1.183 requesting waiver of 37 CFR §§ 1.535, 1.550(g) and 1.560, to permit third party requester participation in the examination stage of this *ex parte* reexamination proceeding.[2]

6. Also on July 31, 2003, the requester filed a petition under 37 CFR 1.181, for review of the decision of the Director of OPLA denying requester's May 6, 2003, petition. The petition under 37 CFR 1.181 is being addressed in a concurrently issued decision.

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[1] Some of the issues raised in the May 6th petition were found not to be ripe for decision due to how they were presented, and were not decided.

[2] As noted at page 3 of the present petition, the decision of the Director of the OPLA found that "the issue of waiver of the rules under 37 C.F.R. 183 was required to be raised in a separate paper. Accordingly, this petition [under §1.183] renews a request made in the Petitions of May 6, 2003 in a separate paper."

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7. Reexamination was ordered September 9, 2003, for this reexamination proceeding.

**DECISION ON PETITION**

1. The present petition urges (at page 4) that the Office has the "authority to permit a Requester to participate in 'Ex Parte' reexamination." Accordingly, the third party requester seeks a waiver of 37 CFR §§ 1.535, 1.550(g) and 1.560 to permit the requestor to participate in the examination stage of the *ex parte* reexamination proceeding that will be conducted.

At page 4 of the petition, it is argued that:

> "The requirement that 'Ex Parte' reexamination under 35 U.S.C. §301-§307 be 'Ex Parte' is not statutory."

And further that:

> "The only prohibition to such a practice *[prohibiting requester participation]* might be found in 37 C.F.R. §1.535 and § 1.550(g) [both limiting participation by 'Ex Parte' requesters] and § 1.560 [limiting participation in interviews]."

At the bottom of page 4 of the petition, the Office's position on this matter is correctly characterized by petitioner as:

> "[T]he requirement that '*Ex Parte*' Reexamination be *Ex Parte* is a statutory requirement. Statutory requirements cannot be waived, only rules. The Director of the Office Of Patent Legal Administration relies on *In re Amp* (*Amp*), 212 USPQ 826 (Comr. Pats. 1981) and on *Syntex (U.S.A.) v U.S. Patent and Trademark Office* (*Syntex*), 11 U.S.P.Q. 2d 1866 (Fed. Cir. 1989).

On this point, *see also In re Chambers* 20 USPQ2d 470, 1476 (Comr. Pat. 1991), where it is stated:

> "It is noted that a third party has no right to comment or participate in a reexamination proceeding beyond the rights specifically provided for by the reexamination statute, i.e., file a request for reexamination and comment on any statement filed by a patent owner. The statutory provisions regarding the reexamination of a patent, and the rules promulgated in support thereof, do not provide for opposition to the grant of a reexamination certificate by a third party. *Yuasa Battery Co. v. Commissioner,* 3 USPQ2d 1143 (D.D.C. 1987). *See also In re Etter, supra,* 756 F.2d at 858 n.6, 225 USPQ at 5-6 n.6 (the reexamination per se of the claims is entirely ex parte); *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office,* 882 F.2d 1570, 1573, 11 USPQ2d 1866, 1868 (Fed. Cir. 1989) (a reexamination is conducted *ex parte* after it is

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instituted) (original emphasis); *In re Opprecht,* 868 F.2d 1264, 10 USPQ2d 1718 (Fed. Cir. 1989) (a third party does not participate before PTO in a reexamination); *Animal Legal Defense Fund v. Quigg,* - F.2d -, -, 18 USPQ2d 1677, 1685 (Fed. Cir. 1991) (five judge court) (third party may not protest grant of a patent)."

2. In spite of this case law, petitioner urges that:

> "Both *Amp* and *Syntex* were prior to the introduction of Inter Partes reexamination by the AIPA and prior to the Justice Department Reauthorization Act."[3]

It is apparently petitioner's position that this enacted legislation changed the nature of the examination provided for by 35 U.S.C. 305, such that *inter partes* participation can now be permitted for a reexamination requested under 35 U.S.C. 302. Petitioner's position will now be addressed.

Beginning in the early 1990's, Congress began a process to expand reexamination to provide an increased level of third party requester participation in a reexamination proceeding. All of the bills drafted by Congress to this end modified the existing *ex partes* reexamination Chapter 30 to increase the level of third party requester participation in the various ways proposed in the bills.[4] This methodology for expanding third party requester participation did not change until optional *inter partes* reexamination was enacted as law via S. 1948 [5] and the American Inventors Protection Act of 1999 (AIPA).[6] When Congress drafted this legislation for *inter partes* reexamination, it provided an entirely new Chapter 31, directed to increased third party requester participation. The existing Chapter 30, on the other hand, was not changed other than to revise the Chapter heading by

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[3] See *Id.*; the petitioner's contention also holds true for the *Chambers* decision, and the cases cited therein.

[4] See, for example, H.R. 1732, 104th Cong., 1st Sess. (1995).

[5] See also H.R.1907, which was passed by the House of Representatives on August 4, 1999.

[6] The American Inventors Protection Act of 1999 (AIPA), was enacted on November 29, 1999, as Pub. L. 106-113, 113 Stat. 1501, 1501A-552 through 1501A-591 (1999). The AIPA was part of the conference report (H. Rep. 106-479) on H.R. 3194, Consolidated Appropriations Act, Fiscal Year 2000. The text of the AIPA is contained in Title IV of **S. 1948**, the Intellectual Property and Communications Omnibus Reform Act of 1999 (Pub. L. 106-113), the Act which is incorporated by reference in Division B of the conference report.

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inserting "EX PARTE" before "REEXAMINATION OF PATENTS." [7]

The Congressional shift in methodology/mechanism from that of simply modifying existing Chapter 30, to that of providing separate Chapters 30 and 31 *shows a specific intent on the part of Congress to retain Chapter 30 as-is with respect to third party requester participation*. The insertion of "EX PARTE" before "REEXAMINATION OF PATENTS" *drives the point home that Congress wanted to keep the examination stage of the Chapter 30 reexamination solely* ***ex parte***.

3. At page 6 of the petition, petitioner presents an interpretation of the reexamination appeal provisions of Public Law 107-273 [8] that is argued to statutorily permit a third party requester appeal in a Chapter 30 *ex parte* reexamination proceeding. Sections 13106(d) and 13202(d) of Public Law 107-273 are relied upon.

In response, it is pointed out that relied-upon Section 13106(d) of P.L. 107-273 is directed to the effective date of expansion of third party requester rights of appeal in an *inter partes* reexamination proceeding; it provides no rights as to *ex parte* reexamination. Further, relied-upon Section 13202(d) is directed solely to the effective date of the *ex parte* reexamination appeals amendments made by section 4605 (b), (c), and (e) of the AIPA; it adds no third party participation rights as to *ex parte* reexamination appeals, or otherwise. Because neither of Sections 13106(d) or 13202(d), nor any other provision of P.L. 107-273, is directed to expansion of third party requester participation rights in Chapter 30 *ex parte* reexamination, the "appeal" argument presented at page 6 of the petition is not persuasive.

4. It is also to be noted that the Federal Circuit has strictly enforced the legislatively set limits on the Office's jurisdiction in Chapter 30 *ex parte* reexamination. *See In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996), and *In re Portola Packaging Inc.*, 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997). Accordingly, the Office does not expect that the Federal Circuit would be receptive to an attempt by the

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[7] Subtitle F, SEC. 4602 (EX PARTE REEXAMINATION OF PATENTS) stated:
"The chapter heading for chapter 30 of title 35, United States Code, is amended by inserting `EX PARTE' before `REEXAMINATION OF PATENTS'."

[8] *See* the 21st Century Department of Justice Appropriations Authorization Act, TITLE III- INTELLECTUAL PROPERTY, Subtitle A - the "Patent and Trademark Office Authorization Act of 2002" - Enacted as part of Pub. L. 107-273, 116 Stat. 1758, 1899-1906 (2002). The Act was enacted on November 2, 2002, and it contained technical corrections to the AIPA as well as other technical amendments to title 35, U.S.C.

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Office to expand third party requester participation rights in *ex parte* reexamination without a clear mandate to do so, and certainly not where the legislative action in drafting what would become part of the AIPA showed an intent to the contrary, as pointed out above.

5. As a final point to be addressed, pages 5 and 6 of the petition present an argument that:

> "The PTO cites *Syntex* as authority for a statutory basis for the *Ex Parte* nature of reexamination, and *Syntex* cites *Etter*, and *Etter* cites a rule, namely 37 C.F.R § 1.550(a) ( 1983 ). In short, the PTO argument for the statutory nature of a requirement that '*Ex Parte*' reexamination be '*Ex Parte*' is circular. Ultimately, the requirement that '*Ex Parte*' reexamination be '*Ex Parte*' is based on a rule and such a requirement may be waived."

This argument ignores the plain language of *Syntex* that -

> "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").[9]

This statement of the Federal Circuit was grounded solely on the statute. It is true that the *Syntex* court makes reference to *In re Etter* [10] which does refer to 37 CFR 1.550(a). That reference, however, is only for the purpose of illustrating the rule that was drafted in compliance with the requirement of the statute. It is to be observed that 35 U.S.C. §§ 132 and 133 are cited in *Etter* (just prior to the citation of the rule discussed by petitioner) as to the *ex parte* nature of the reexamination proceeding that was incorporated into 35 U.S.C. 305. Note that §§ 132 and 133 are directed to an applicant and an application, in which a third party is not permitted to comment on an applicant's responses to Office actions. Accordingly, the *ex parte* nature of the application examination is incorporated into the *ex parte* reexamination statute via 35 U.S.C. 305.

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[9] *Syntex*, 11 USPQ 2d at 1868, 1869, the paragraph bridging the pages

[10] See *In re Etter*, 756 F.2d 852, 859 n.6, 225 USPQ 1,5-6 n.6 (Fed. Cir.) ( *en banc), cert. denied,* 474 U.S. 828 (1985).

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**LACK OF SERVICE**

The requester's petition is deficient for failure to reflect service of the response on the patent owner 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 patent owner (a Certificate of Service) was not included with the instant petition papers.

Any future communications filed by patent owner in this proceeding must include proof of service on the third party requester in accordance with 37 CFR 1.550(f).

**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 third party requester 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. In addition, to the extent that the petition might be construed as an *ultra vires* request for the Office to exercise additional jurisdiction over the patent by authorizing third party requester participation, it has been dismissed as an inappropriate avenue of relief. Accordingly, the petition is an improper submission under § 1.540, and it will not be made of record in the reexamination file.

While ordinarily the petition would be returned to the third party requester, in this instance it is being forwarded to the patent owner, since there is no indication that the patent owner was provided with a copy of the papers, as discussed above.

The present decision will be made of record in the reexamination file.

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## IMPROPER CAPTION

The present petition is captioned to identify the patent number, but not the reexamination Control Number. While the petition has been matched to this reexamination proceeding, in the future, any papers submitted as to this reexamination proceeding should include the Control Number identified in the caption of this decision.

## CONCLUSION

1. The third party requester petition under 37 CFR 1.183 filed July 31, 2003, is **dismissed**.

2. The original of the petition is being sent to the patent owner, along with this decision.

3. A copy of this decision is being made of record in the reexamination file.

4. The reexamination file is being forwarded to the Group Director of Technology Center 2600.

5. Telephone inquiries related to this decision should be directed to Kenneth M. Schor, Senior Legal Advisor, at (703) 308-6710.

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

November 19, 2003
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(For Requester)

In re Thomas J. Campana, Jr. et al.
*Inter partes* Reexamination Proceeding
Control No. 90/006,678
Filed: June 24, 2003
For: U.S. Patent No. 5,625,670

: DECISION GRANTING PETITION
: FOR EXTENSION OF TIME

In re Thomas J. Campana, Jr. et al.
Director Ordered
*Ex parte* Reexamination Proceeding
Control No. 90/006,491
Filed: December 26, 2002
For: U.S. Patent No. 5,625,670

This is a decision on the January 12, 2006, patent owner petition titled "REVISED PETITION FOR THE OFFICE TO FOLLOW ANNOUNCED POLICY AND PROVIDE EQUAL TREATMENT TO PATENT OWNER BY GRANTING A TWO-MONTH PERIOD OF TIME TO RESOND TO THE OFFICE ACTION DATED DECEMBER 30, 2005 " The present petition (1) urges that a two month period should have been set by the Office Action of December 14, 2005, and should be re-set accordingly, and (2) revises its request for an additional month to respond to the Office Action of December 14, 2005, to thereby extend the deadline for response to be February 14, 2006.

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

The petition is granted as to the request for an additional month to respond to the Office Action of December 14, 2005, for the reasons set forth below.

The petition is dismissed as to the request that the time period set in the Office action be reset, since such request is now moot for the reasons set forth below.

## DISCUSSION

The patent owner on January 03, 2006, submitted a petition that urged that a two month period should have been set by the Office Action of December 14, 2005, and should be re-set accordingly, and (2) requested an additional month to respond to the Office Action of December 14, 2005, to thereby extend the deadline for response to be February 14, 2006. The January 03, 2006 petition for extension of time was accompanied by an authorization to debit a deposit account, accordingly the $200.00 petition fee required by 37 CFR 1.515(c) has been charged to Account No. 05-02-06. Thus, the appropriate fee has been paid.

The instant revised petition seeks an additional month in which to file a response to the Office action dated December 14, 2005, which action set a one month date for filing a response thereto. The Office action in question is a non-final action.

37 CFR 1.550 (c ) states:

> (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.

Addressing the requirement of 37 CFR 1.550 (c) to make a showing of "sufficient cause" to grant an extension of time request, MPEP 2265 states, in pertinent part:

> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. 305) 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 patent owner in this revised request, positively states that its expert, Dr. Rhyne, will be available the week of January 23 , 2006, to work on the response for the above identified proceedings. In addition the patent owner states that "With the extremely short availability

window Dr. Rhyne presently has, an additional month is needed to accomplish that without seriously prejudice to NTP's ability to present all of the facts necessary to make its record."

Patent owner further states in the renewed petition for extension of time that the option of engaging another expert instead of Dr. Rhyne has been considered, but at present, patent owner has determined that this option is unrealistic and impractical. The renewed petition states that, aside from Dr. Rhyne's familiarity evaluating the patent that is the subject of this merged reexamination proceeding and other related patents, any other expert having the appropriate qualifications who might be found would need to spend several weeks, or perhaps months, getting up to the level of understanding of the Campana patents and the art generally that equals Dr. Rhyne's.

It is considered that the renewed petition expressly states the steps taken by patent owner, and expressly states when Dr. Rhyne will be available to provide an analysis and formulate an expert opinion on the instant proceedings, thereby providing sufficient basis as to why an extension of time should be granted. Thus, when balancing the needs for special dispatch with the need to provide the patent owner with an opportunity to have its expert evaluate the response of record it has been determined that the need for the expert, at this time and under the instant circumstances, contravenes the requirement for "special dispatch." However, the patent owner is advised that unavailability of Dr. Rhyne beyond the deadline as extended by one month, or the difficulty of securing the services of a second expert meeting patent owner's criteria, and the difficulty of bringing a second expert "up to speed" in advance of the time necessary to prepare a response by the deadline, as extended by one month, will **not** be considered to present a compelling reason establishing an extraordinary situation in support of the grant of a second extension of time.

## DECISION

I. For the reasons stated above, the petition has established sufficient cause to extend the time period, and is granted.

II. Since the petition has been granted for an extension for one month of time, the patent owner request that the time period set in the Office action be reset is dismissed as moot, and need not be addressed further in this decision.

III. Future requests for extensions of time will be strictly evaluated for compliance with 37 CFR 1.550. In light of the length of the pendency of this proceeding and the similar issues shared with other pending proceedings, future petitions for extension of time will be granted only upon a showing of sufficient cause that takes into account the related reexamination proceedings and the statutory requirement that reexamination proceedings must be conducted with "special dispatch."

## CONCLUSION

1. The petition is granted as to the request for an additional month to respond to the Office Action of December 14, 2005. The patent owner's period for response set in the December 14, 2005 Office action is hereby extended to expire on February 14, 2006.

2. The petition is dismissed as to the request that the time period set in the Office action be reset, since such request is now moot.

3. Patent owner is reminded that following the Office's prior guidance on where to submit papers may avoid delays in processing future on. **Future correspondence is to be submitted via one of the following options**:

By Mail to: Mail Stop *Inter Partes* 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
Attention: Central Reexamination Unit
Randolph Building
401 Dulany St.
Alexandria, VA 22314

4. Telephone inquiries with regard to this decision should be directed to Mark Reinhart of the Central Reexamination Unit Art Unit at (571)-272-1611, and in his absence to the undersigned at (571) 272-1596.

Lissi Mojica Marquis, Director
Central Reexamination Unit

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MAILED

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CENTRAL REEXAMINATION UNIT

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/006,491
Filed: December 26, 2002
For: U.S. Patent No. 5,625,670

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No. : 90/006,678
Filed: June 24, 2003
For: U.S. Patent No. 5,625,670

**DECISION, *SUA SPONTE*, DISMISSING PETITION AND "RETURNING" IMPROPER PAPERS**

This is a decision on the June 23, 2006 patent owner petition styled "Petition Pursuant to 37 CFR 1.181 or Alternatively, 37 CFR 1.182 OR Alternatively 37 CFR 1.183 to Reconsider Decision Returning Paper and Enter the Papers into the Official Record." [1]

The petition and the above-captioned reexamination proceedings are before the Office of Patent Legal Administration for consideration.

The petition is dismissed and its attachments are returned to the patent owner for the reasons discussed below.

## REVIEW OF SALIENT FACTS

1. U.S Patent number 5,625,670 ("the '670 patent") issued to Campana *et al* on April 29, 1997 from an application filed on May 18, 1995.

2. On December 26, 2002, a Director Initiated Order for Reexamination of the '670 patent

[1] The present petition is, facially, fully treatable pursuant to the provisions of 37 CFR 1.181. Accordingly, it is manifestly unnecessary to consider the petition under either 37 CFR 1.182 or 37 CFR 1.183. No fee is required.

mailed and assigned control number 90/006,491 ("the '491 reexamination proceeding").

3. On June 24, 2003, a request for ex *parte* reexamination of the '670 patent was filed by a third party requester, and assigned control number 90/006,678 ("the '678 reexamination proceeding").

5. On September 3, 2003, the examiner's Order Granting *Ex Parte* Reexamination for the '678 reexamination proceeding was mailed.

6. On May 26, 2004, the Technology Center Director issued a decision, *sua sponte*, by which the '491 reexamination proceeding and the '678 reexamination proceeding were merged into a single combined reexamination proceeding.

7. On September 16, 2005, a third request for *ex parte* reexamination of the '670 patent, which was assigned control number 90/007,723 ("the '723 reexamination proceeding").

8. On September 23, 2005, the examiner's Order Granting *Ex Parte* Reexamination for the '723 reexamination proceeding was mailed.

9. The '723 reexamination proceeding is not presently merged with the existing merged reexamination proceeding. [2]

10. Following prosecution on the patentability of the '670 patent claims, a nonfinal rejection Office action was issued in the merged reexamination proceeding on December 14, 2005.

11. On January 4, 2006, a Freedom of Information Act ("FOIA") Request was made to the Office requesting the Office's communications with third parties regarding the present reexamination proceedings and pending reexamination proceedings being conducted on other of patent owner's patents.

12. The Office responded to the FOIA request through letters dated between February 8 and March 24, 2006. [3]

13. On February 14, 2006, patent owner filed a response to the December 14, 2005 nonfinal Office action.

14. On April 28, 2006, patent owner filed a paper styled as a supplemental response to the nonfinal rejection, which included a traverse of the nonfinal rejection, copies of material obtained as a result of the FOIA request, and a number of statements in support of patent owner's traverse.

15. On May 17, 2006, the CRU Director mailed a decision returning the April 28, 2006 patent owner supplemental response to the nonfinal rejection noted in Fact 14 above without

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[2] The present petition is directed to the above-captioned *ex parte* reexamination proceedings, in accordance with the May 26, 2004 Technology Center Director decision. The present petition is also directed to *ex parte* reexamination proceeding 90/007,723, which is also a reexamination of U.S. Patent 5,625,670. The facts set forth in the present petition appear to be applicable only to the merged proceeding, but are not entirely applicable to the 90/007,723 reexamination proceeding. Therefore, this decision is directed only to the present merged proceeding involving the '491 and '678 *ex parte* reexamination proceedings. However, insofar as the petition is directed to the 90/007,723 proceeding, the petition will be treated in a separate decision in order to facilitate prosecution of the 90/007,723 proceeding with "special dispatch" in accordance with 35 U.S.C. § 305.

[3] An additional response to the FOIA request was mailed by the Office on June 15, 2006 and received by patent owner on June 16, 2006.

consideration on the merits. [4] The return was based on the grounds that the papers filed were improper because they were not limited to consideration of prior patents and printed publications and also because portions were not in compliance with the 37 CFR 1.3 requirements for decorum and courtesy. Accordingly, the returned supplemental response was not entered into the record.

16. On May 22, 2006, patent owner filed a redacted version of the April 28, 2006 supplemental response, limited to material addressing the outstanding nonfinal rejection Office action, which has been entered into the IFW record.

17. On June 23, 2006, patent owner filed the present petition requesting reconsideration of the CRU Director's May 17, 2006 decision. Patent owner has attached to the petition the material that was refused entry and returned (by the CRU Director's May 17, 2006 decision), for entry into the record as part of patent owner's supplemental response to the December 14, 2005 Office action.

## DECISION DISMISSING THE THIRD PARTY REQUESTER PETITION AND RETURNING PAPERS FILED WITH THE PETITION

### I. Relevant Statutes, Regulations and Practice

35 U.S.C. § 132 provides:

> "(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.
>
> (b) The Director shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant. The Director may establish appropriate fees for such continued examination and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under section 41(h)(1) of this title."

35 U.S.C. § 305 provides, in part:

> "After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent."

35 U.S.C. § 306 provides:

> "The patent owner involved in a reexamination proceeding under this chapter may appeal under the provisions of section 134 of this title, and may seek court review under the provisions of sections 141 to 145 of this title, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent."

[4] Jurisdiction of the merged '491 and '678 reexamination proceedings had previously been transferred from the Technology Center to the CRU.

37 CFR 1.3 provides:

"Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Director and will not be entered. A notice of the non-entry of the paper will be provided. **Complaints against examiners and other employees must be made in correspondence separate from other papers.**" [Emphasis added.]

37 CFR 1.4(c) provides:

"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."

37 CFR 1.111(b) provides:

"In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section."

37 CFR 1.181(a)(1) provides that petition may be taken to the Director:

"**From any action** or requirement of any examiner in the ex parte prosecution of an application, or **in ex parte** or inter partes prosecution **of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court.**" [Emphasis added.]

37 CFR 1.550(a) and (b) provide, in part:

"(a) All *ex parte* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office. **After issuance of the *ex parte* reexamination order and expiration of the time for submitting any responses, the examination will be conducted in accordance with §§ 1.104 through 1.116** and will result in the issuance of an *ex parte* reexamination certificate under § 1.570. [Emphasis added.]

(b) The patent owner in an *ex parte* reexamination proceeding will be given at least thirty days to respond to any Office action. **In response to any rejection,** such response may include further statements and/or proposed amendments or new claims to place the patent in a condition where all claims, if amended as proposed, would be patentable." [Emphasis added.]

MPEP § 2267 provides in part:

"The return of inappropriate submissions complies with the regulations that certain papers will not be considered and also reduces the amount of paper which would ultimately have to be scanned into the record.

I. DISPOSITION OF PAPERS

Where papers are filed during reexamination proceedings which are inappropriate because of some defect, such papers will either be returned to the sender or forwarded to one of three files, the "Reexamination File" (paper file or IFW file history), the "Patent File" (paper file or IFW file history), or the "Storage File" (paper file). Any papers returned to the sender from a Technology Center (TC) must be accompanied by a letter indicating signature and approval of the TC Director." [5]

[5] When the CRU has jurisdiction, as in the case of this merged proceeding, the CRU Director would approve and sign the letter accompanying returned papers.

## II. Findings and Analysis

On April 28, 2006, patent owner filed a supplemental response to the nonfinal action dated December 14, 2005. That paper was returned to patent owner by the decision of the CRU Director dated May 17, 2006, on the grounds that the supplemental response was an improper paper. The basis of this holding was that the supplemental response included statements and documents that were improper because they were not limited to consideration of prior patents and printed publications, and also because portions were not in compliance with 37 CFR 1.3 requirements for decorum and courtesy. Patent owner was invited, in the May 17, 2006 decision returning papers, to submit a redacted supplemental response, and patent owner has in fact filed a redacted version of the supplemental response (the redacted version has been entered into the record).

Patent owner has now attached to the present petition a set of papers to be added to the record as a part of the supplemental response to the December 14, 2005 nonfinal action, which would be available for the examiner's consideration in evaluating the patent owner's supplemental response. Patent owner requests by way of the present petition that these papers be entered into the IFW record to provide a complete administrative record. [6] It is patent owner's position that:

(1) There was no legal basis for the CRU Director's return of the April 28, 2006 supplemental response papers;

(2) The grounds for such return as expressed in the CRU Director's decision returning the supplemental response papers were erroneous;

(3) The patent owner is entitled to argue and provide documents to allege that the December 14, 2005 nonfinal action is an improper action based on allegations of misconduct and bias.

(4) Due process requires that the Office accept the unredacted supplemental response and related FOIA evidence. [7]

It is also noted that patent owner argues that the CRU Director's decision returning the April 28, 2006 supplemental response to the nonfinal action dated December 14, 2005 was inconsistent with a prior petition decision dated March 20, 2006 denying a patent owner petition filed on January 23, 2006. [8] This argument will be separately addressed, *infra.*

### A. The April 28, 2006 Supplemental Response Was An Improper Paper, The Supplemental Response Attached To The Present Petition Is An Improper Paper, And Both Papers Lack An Entry Right In The Merged Reexamination Proceeding

Pursuant to 35 U.S.C. § 306, an issue directed to the merits of a nonfinal rejection in an *ex parte* reexamination proceeding is appealable to the Patent and Trademark Office Board of Patent Appeals and Interferences. On the other hand, pursuant to 37 CFR 1.181(a), a petition to the USPTO Director is the appropriate vehicle to resolve matters not subject to appeal. It is further to be noted that, pursuant to 37 CFR 1.4(c), different matters raised in a given proceeding must

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[6] This would result in the commingling of the now-proffered set of papers with material that the examiner will have to consider.

[7] Petition at pages 10 *et. seq.*

[8] The petition and decision thereon referenced by patent owner are apparently those in the file records of *ex parte* reexamination control number 90/006,495 and *inter partes* reexamination proceeding 95/000,020, which have been merged into a single reexamination proceeding.

be raised in separate papers. Finally, pursuant to 37 CFR 1.3, complaints against examiners and other Office employees "must be made in correspondence separate from other papers" which are not directed to complaints against examiners and other Office employees.

In the present instance, a review of the papers attached to the present petition indicates that (1) the papers are essentially the same as, if not identical to, the papers that were returned by the CRU Director's May 17, 2006 decision, and (2) these papers purport to be a supplemental response to the examiner's treatment of the pending claims in light of the prior art patents and publications applied to the claims by the examiner in the nonfinal action dated December 14, 2005. Pursuant to 37 CFR 1.550(a) (the rule that implements 35 U.S.C. § 305), an *ex parte* reexamination proceeding is "conducted in accordance with [37 CFR] §§ 1.104 through 1.116." Therefore, the appropriate content of a 37 CFR 1.550(b) response to a nonfinal Office action in an *ex parte* reexamination proceeding is defined by 37 CFR 1.111. Subsection (b) of 37 CFR 1.111 does not (contrary to petitioner's argument) provide for "further statements" that are unrestricted as to content. Instead, 37 CFR 1.111(b) requires that a response to a nonfinal action address the issue of patentability of the pending claims with respect to the outstanding rejection, which, in this instance, is the examiner's treatment of the patentability of the claims in light of prior patents and printed publications. In contrast, the papers attached to the present petition include material directed to issues other than the examiner's treatment of the patentability of the claims in light of prior patents and printed publications. In fact, large portions of the remarks contained in the supplemental response to the nonfinal action [9] and documents cited in support are directed to the conduct of Office employees/officials. Thus, large portions of the papers attached to the present petition, are not directed to issues of patentability of the pending claims in light of the applied prior art patents and printed publications. Therefore, these papers clearly constitute responses to the outstanding nonfinal Office action that are not proper under 37 CFR 1.550(b) and do not fall within the jurisdiction of the examiner. Accordingly, each of these papers submitted in response to the Office action lacks an entry right in the present merged reexamination proceeding for consideration by the examiner.

Further, 37 CFR 1.3 expressly precludes "complaints against examiners and other employees" submitted as part of papers directed to other matters. Thus, the patent owner's submission of documents in support of its allegations of misconduct and bias could not properly be included with papers directed to the question of patentability in view of prior art, because the clear and unequivocal language of 37 CFR 1.3 expressly requires that "employee conduct" issues are to be raised in correspondence separate from other papers. Here, patent owner improperly raises allegations of employee misconduct incorporated within papers directed to the merits of the examiner's position on the patentability of the pending claims in light of patents and printed publications as set forth in the nonfinal Office action. Therefore, the originally filed April 28, 2006 supplemental response and the supplemental response attached to the present petition are both improper for the reason that they fail to comply with the requirements of 37 CFR 1.3. Accordingly, each paper further lacks an entry right in the present merged reexamination proceeding for consideration by the examiner.

Moreover, 37 CFR 1.4(c) requires that different matters in a given proceeding appropriate for consideration by different branches within the Office must be raised in separate papers. However, patent owner's April 28, 2006 supplemental response to the nonfinal action improperly presented, in the same paper, both:

---

[9] See, *e.g.*, the arguments at page 74-92 of the supplemental response. Note that even a single instance of an argument directed to matters that are not part of a proper response to a nonfinal action within the meaning of 37 CFR 1.113(a) and 37 CFR 1.116 would suffice to preclude entry of the entire supplemental response as lacking an entry right.

(1) arguments and materials directed to the patentability of the claims in view of the patents and printed publications applied in the nonfinal Office action, and

(2) allegations of employee misconduct and bias.

The patentability arguments are properly considered by the examiner. In contrast, allegations of employee misconduct and bias are considered by way of a petition to the appropriate Office official for the exercise of supervisory authority pursuant to 37 CFR 1.181(a), because alleged employee misconduct and bias relate to non appealable subject matter. Thus both the originally filed April 28, 2006 supplemental response and the response attached to the present petition are improper for the additional reason that they fail to comply with the requirements of 37 CFR 1.4(c).

Therefore, for the foregoing reasons, the April 28, 2006 patent owner supplemental response, and the June 23, 2006 supplemental response attached to the present patent owner petition are deemed improper and therefore these papers lack an entry right in the present merged reexamination proceeding. The disposition of improper papers will be treated as discussed in Section C., *infra*.

B. Further Discussion

1. While the patent owner's April 28, 2006 supplemental response to the December 14, 2005 nonfinal action and the supplemental response to the nonfinal action attached to the present petition each lack an entry right for consideration by the examiner as explained in Section II(A), patent owner may raise the issue of alleged employee misconduct by way of petition under 37 CFR 1.181(a). Note is taken of patent owner's statement that on March 20, 2006, the Office issued a decision in a separate proceeding, such decision denying a patent owner petition filed on January 23, 2006. [10] Patent owner correctly states that the January 23, 2006 petition was denied because it did not provide sufficient details. However, if patent owner is able to now supply those details, they must be submitted in a separate petition under 37 CFR 1.181, but cannot be submitted as part of a paper submitted for consideration by the examiner.

2. Patent owner's characterization of the May 17, 2006 decision issued by the CRU Director returning the April 28, 2006 supplemental response to the nonfinal Office action of December 14, 2005 is not wholly accurate. In actuality, the CRU Director's May 17, 2006 decision did not mean to imply that the FOIA papers would be barred from submission for any and all purposes. Rather, it properly points out that the papers were returned because they raised issues unrelated to patentability and therefore are not appropriate for consideration by the examiner. Therefore, the submitted papers did not comply with the regulations and practice regarding the submission of response papers. [11]

3. To the extent that patent owner disagrees with some or all of the rationale set forth in support of the CRU Director's decision, Section II(A) of the present decision amplifies the reasons in support of the conclusion reached in the CRU Director's May 17, 2006 decision to refuse entry and return the April 28, 2006 supplemental response with attached papers. Section II(A) of the

[10] See footnote 8, *supra*.

[11] Considering the fact that the papers in question were styled as a supplemental response to a nonfinal Office action, the material beginning at the last paragraph of page 2 of the May 17, 2006 CRU Director's decision and running through page 3 thereof indicates to the undersigned that the CRU Director was concerned with the mingling of prior art patent and printed publication patentability issues with the procedural issues raised by the allegations of misconduct and bias of raised in papers.

present decision explains that the patent owner may indeed raise alleged employee misconduct and bias issues, but must do so via a separate petition under 37 CFR 1.181. Such a petition must conform to the governing regulations and practice, i.e., the petition regarding alleged employee misconduct must not be attached to papers directed to the substantive issue of claim patentability in light of the prior patents and printed publication. See 37 CFR 1.3 and 37 CFR 1.4(c).

4. As a final point on this matter, patent owner is not being deprived of due process by a refusal to accept papers that mingle allegations of misconduct (and documents supporting those allegations) with papers that are directed to other matters. Papers raising issues of alleged misconduct, and documents proffered in support of such allegation, are admissible in the Office only if they are provided in a manner that complies with the regulations.

C. Disposition Of Papers

1. In this instance: (1) the April 28, 2006 presentation of the FOIA papers, (2) the April 28, 2006 declaration of Keith Anderson directed the FOIA papers, and (3) the remarks directed to the conduct of Office employees/officials that were included within the April 28, 2006 supplemental response to the nonfinal action have previously been found to be improper, and lacking an entry right in the present merged proceeding. These papers were previously returned, and a redacted form of these papers was entered into the record, as discussed above.

2. In addition, the patent owner has attached to the present petition the material that was refused entry and returned (by the CRU Director's May 17, 2006 decision), for entry into the record as part of patent owner's supplemental response to the December 14, 2005 Office action. These papers have now been found to be improper and therefore lack an entry right in the present merged proceeding to which they are directed. As these papers are determined to lack an entry right in the present merged reexamination proceeding, they will be returned in accordance with provisions of MPEP § 2267. In this instance it would be unduly burdensome to either physically return the large bulk of papers, or expend significant Office resources scanning the documents into the record and then closing them from view. [12] Therefore, the papers are being temporarily held for "pick up" in the Central Reexamination Unit (CRU). If the patent owner desires the physical return of the papers, then patent owner should promptly make arrangements to pick up the papers from the CRU **within one month** of the mailing date of this decision. Patent owner should immediately notify Norma Amador of the CRU, at telephone number (571) 272-6474, of any arrangements that have been made to pick up the papers. If the papers are **not** picked up **within one month** of the mailing date of this decision, **the CRU will dispose of the papers**, note being taken that the patent owner presumably has the originals.

3. As to the present petition, the petition contains facial allegations of employee misconduct and bias. Accordingly, though the petition itself will be retained of record in the IFW file, it is being marked as "non-public."

[12] Patent owner has filed at least six other petitions corresponding to the present petition, and provided such papers as attachments to each filed petition.

## CONCLUSION

1. The June 23, 2006 patent owner petition is dismissed.

2. The (1) the April 28, 2006 presentation of the FOIA papers, (2) the April 28, 2006 declaration of Keith Anderson directed the FOIA papers, and (3) the remarks directed to the conduct of Office employees/officials that were included within the April 28, 2006 supplemental response to the nonfinal action have been found to be improper papers lacking an entry right in the present merged proceeding to which they are directed. These papers were properly returned to patent owner.

3. The papers attached to the present petition that appear to be the material that was refused entry and returned by the CRU Director's May 17, 2006 decision will be held for one month in the CRU in a single storage location, and thereafter will be discarded if not picked up by patent owner.

4. The present petition will be retained of record in the IFW file and is being marked as "non-public."

5. A copy of this decision is being made of record in the merged reexamination proceeding, and the decision will therefore appear in the IFW record of *ex parte* reexamination proceedings 90/006,491 and 90/006,678.

6. **All correspondence relating to an *inter partes* reexamination proceeding should be directed to:**

By Mail to: Mail Stop *Ex Parte* Reexam
ATTN: 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) 273-9900
Central Reexamination Unit

By hand: Customer Service Window
ATTN: Central Reexamination Unit
Randolph Building
401 Dulany St.
Alexandria, VA 22314

8. Telephone inquiries with regard to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or, in his absence, to the undersigned at (571) 272-7710.

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

sm
August 9, 2006

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. |
|---|---|---|---|---|
| 90/006,491 | 12/26/2002 | 5625670 | | 9464 |

803 7590 02/24/2007

STURM & FIX LLP
206 SIXTH AVENUE
SUITE 1213
DES MOINES, IA 50309-4076

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 02/24/2007

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

2/26/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

NOVAK DRUCE & QUIGG, LLP

1300 EYE STREET NW

400 EAST TOWER

WASHINGTON, DC 20005

## *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/006491

PATENT NO. 5,625,670

ART UNI 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 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**

Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

William R. Wright
STUM & FIX LLP
206 Sixth Avenue
Suite 1213
Des Moines, IA 50309-4076

(For Patent Owner)

Donald J. Quigg
NOVAK DRUCE DELUCA & QUIGG LLP
1300 Eye Street N. W.
400 East Tower
Washington, DC 20005

(For Third Party Requester)

DECISION
*SUA SPONTE*
MERGING
REEXAMINATION
PROCEEDINGS
PURSUANT TO
37 C.F.R. § 1.565(c)

In re Thomas J. Campana, Jr. et al
Reexamination Proceeding
Control No. 90/006,491
Filed: December 2, 2002
For U.S. Patent No.5,625,670

In re Thomas J. Campana, Jr. et al
Reexamination Proceeding
Control No. 90/006,678
Filed:June 24, 2003
For U.S. Patent No. 5,625,670

In re Thomas J. Campana, Jr. et al :
Reexamination Proceeding :
Control No. 90/007,723 :
Filed: September 16, 2005 :
For U.S. Patent No. 5,625,670 :

The proceeding control number 90/006,491 was merged with reexamination proceeding 90/006,678, to provide a single consolidated proceeding on May 26, 2004. Further, to provide for a single consolidated proceeding reexamination control number 90/007,723 consideration for merged proceedings with previously merged proceedings 90/006,491 and 90/006,678 will follow.

The above-identified reexamination files are before the Director of the Central Reexam Unit 3999, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

## STATEMENT OF FACTS

1. Patent No. 5,625,670 issued on April 29,1997.

2. Reexamination Control No. 90/006,491 is a Director Ordered reexamination was requested on September 16, 2005.

3. Reexamination Control No. 90/006,491 was granted a filing date of September 16, 2005 in a paper mailed September 20, 2005.

4. Reexamination Control No. 90/006,491 order was granted in a paper mailed September 23, 2005.

5. Reexamination Control number 90/006,678 was requested by a third party requester on June 24, 2003.

6. Reexamination Control No. 90/006,678 order was granted in a paper mailed September 3, 2003.

7. Reexamination Control No. 90/007,723 was requested by a third party requester on September 16, 2005.

8. Reexamination was ordered in the 90/007,723 order was granted in a paper mailed September 23, 2005.

## 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 90/006,491; 90/006,678 and 90007,723 reexamination proceedings are merged.

Patent owner should review the petition decisions that are in the record of the 7,723 proceeding. Copies of papers that have previously been filed in the 7,723 proceeding that are identified in a petition decision as having been "returned" to patent owner in the 7,723 must not be submitted again as part of a housekeeping amendment. The proceeding is being merged at a point where the

Office has determined that such papers are improper, and patent owner has filed petitions requesting reconsideration of that determination. If the determination is reconsidered and withdrawn, patent owner will be given time to file such papers in the merged proceeding. Until that such time, improper papers remain improper.

The redacted paper filed in the 7'723 proceeding on May 22, 2006 need not be resubmitted by patent owner as part of a housekeeping amendment because that paper exists in the IFW as a "closed" paper, and will simply be "opened" in the IFW file.

## I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the 90/006,491; 90/006,678 and 90/007,723 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

The claims have been amended in the reexamination proceeding under merger. Patent owner is required to maintain the same claims and specification in all merged files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in both files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

## III. Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature, for entry in each file. All papers filed by the patent owner must be served on the requester and requester will be sent copies of all papers mailed by the Office.

# CONCLUSION

1. Reexamination Control Nos. '6,491, '6,678 and '7,723 are merged. Patent owner has **one month** from the date of this decision to submit an appropriate "housekeeping" amendment. Since the amendments to the claims in the previously merged reexamination proceedings are extensive, the patent owner is requested to submit al the active claims in these proceedings to provide the Office with a complete set of claims for action. Upon receipt of the "housekeeping" amendment, an Office action will be issued in due course.

2. The status of the merged proceedings 90/006,491; 90/006,678 and 90/007,723 will be returned to the examiner awaiting further action. An office action on the merits from the examiner in charge will be forthcoming in these newly merged proceedings.

3. All correspondence regarding these proceedings should 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

Telephone inquiries with regard to this decision should be directed to Mark Reinhart, Special Program Examiner in the Central Reexamination Unit, Art Unit 3992, at (571) 272-1611

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

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

William R. Wright
Sturm & Fix LLP
206 Sixth Avenue
Des Moines, IA 50309-4076

(For Patent Owner)

FAX RECEIVED
MAR 0 9 2007
CENTRAL REEXAMINATION UNIT

Novak Druce & Quigg LLP
1300 Eye Street NW
Suite 400 East Tower
Washington, DC 20005

(For Third Party Requester)

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/006,491 ✓
Filed: December 26, 2002
For: U.S. Patent No. 5,625,670

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/006,678
Filed: June 24, 2003
For: U.S. Patent No. 5,625,670

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/007,723
Filed: September 16, 2005
For: U.S. Patent No. 5,625,670

**DECISION DENYING PETITION**

This is a decision on the October 23, 2006 patent owner petition styled "Petition Pursuant to 37 CFR 1.181 or Alternatively, 37 CFR 1.182 Or Alternatively 37 CFR 1.183 to Reconsider Decision, *Sua Sponte*, 'Returning' Improper Papers and Alternatively That the Commissioner Declare His Decision A Final Agency Action." [1,2]

The petition and the above-captioned reexamination proceedings are before the Office of Patent Legal Administration for consideration.

The petition is granted to the extent that (1) the "Decision, *Sua Sponte*, Dismissing Petition and 'Returning' Improper Papers" [3] dated August 23, 2006, has been reconsidered, and (2) the

[1] The present petition paper is fully treatable pursuant to 37 CFR 1.181, and it is thus unnecessary to consider the petition paper under either 37 CFR 1.182 or 37 CFR 1.183. A petition fee is not required.
[2] The present paper will hereinafter be referred to as "Petition for Reconsideration."
[3] Hereinafter "Decision Dismissing Petition."

present decision has been designated as a final agency action under 35 U.S.C. § 704. For the reasons discussed below, the underlying relief requested by petitioner patent owner is denied.

## REVIEW OF SALIENT FACTS

1. U.S Patent number 5,625,670 ("the '670 patent") issued to Campana *et al* on April 29, 1997, from an application filed on May 18, 1995.

2. On December 26, 2002, a Director Initiated Order for Reexamination of the '670 patent was mailed. The resulting *ex parte* reexamination proceeding was assigned control number 90/006,491 ("the '491 reexamination proceeding").

3. On June 24, 2003, a request for a second ex *parte* reexamination of the '670 patent was filed by a third party requester, and the resulting proceeding was assigned control number 90/006,678 ("the '678 reexamination proceeding").

4. On September 3, 2003, an examiner's Order Granting *Ex Parte* Reexamination was mailed for the '678 reexamination proceeding.

5. On May 26, 2004, the Technology Center Director issued a decision, *sua sponte*, by which the '491 reexamination proceeding and the '678 reexamination proceeding were merged into a single consolidated reexamination proceeding.

6. On September 16, 2005, a third request for *ex parte* reexamination of the '670 patent, which was assigned control number 90/007,723 ("the '723 reexamination proceeding").

7. On September 23, 2005, the examiner's Order Granting *Ex Parte* Reexamination for the '723 reexamination proceeding was mailed.

8. The '723 reexamination proceeding was not immediately merged with the existing merged '491-'678 merged reexamination proceeding.

9. On December 14, 2005, a nonfinal rejection Office action was issued in the '491-678 merged reexamination proceeding.

10. On January 4, 2006, a Freedom of Information Act ("FOIA") Request was made to the Office requesting the Office's communications with third parties regarding the present reexamination proceedings, as well as pending reexamination proceedings being conducted on other of patent owner's patents.

11. The Office responded to the FOIA request through letters dated between February 8 and March 24, 2006. [4]

12. On February 14, 2006, patent owner filed a response to the nonfinal Office action of December 14, 2005 in the '491-678 merged reexamination proceeding.

13. On April 28, 2006, patent owner filed a supplemental amendment/response to the December 14, 2005 nonfinal Office action '491-678 merged reexamination proceeding and

[4] An additional response to the FOIA request was mailed by the Office on June 15, 2006, and received by patent owner on June 16, 2006.

also filed a copy of the April 28, 2006 paper in the '723 reexamination proceeding.

14. On May 17, 2006, the CRU Director mailed a decision returning the April 28, 2006 patent owner supplemental amendment/response to the nonfinal rejection without consideration on the merits. [5] The return was grounded on the impropriety of the papers, because they were not limited to consideration of prior patents and printed publications, and also because portions of the submission were not in compliance with the requirements of 37 CFR 1.3. Accordingly, the returned supplemental response was not entered into the record.

15. On May 22, 2006, patent owner filed a redacted version of the April 28, 2006 supplemental amendment/response, which is limited to material addressing the outstanding nonfinal rejection Office action, and which has been entered into the IFW record for the merged proceeding. This paper was filed in the merged '491-'678 reexamination proceeding and separately filed in the '723 *ex parte* reexamination proceeding.

16. On June 23, 2006, patent owner filed a single petition requesting reconsideration of the CRU Director's May 17, 2006 decision, directed to all three reexamination control numbers for the '670 patent. Patent owner attached to the petition the material that had been refused entry and returned (by the CRU Director's May 17, 2006 decision), and requested entry of that material into the record, as part of patent owner's supplemental response to the December 30, 2005 nonfinal Office action.

17. On August 23, 2006, the June 23, 2006 patent owner petition was dismissed in a decision directed to the '491-'678 merged reexamination proceeding, [6] and in a separate decision directed to the '723 *ex parte* reexamination proceeding. Both petition decisions "returned" to petitioner the material that had been refused entry by the CRU Director by permitting petitioner to schedule a time to pick up the material (together with similar material from other concurrently filed related petitions). [7]

18. On October 23, 2006, petitioner patent owner filed the present Petition for Reconsideration of the August 23, 2006 petition decision. The present Petition for Reconsideration is again addressed to all three reexamination control numbers for the '670 patent.

19. On February 24, 2007 the CRU Director issued a decision, *sua sponte*, by which the '723 reexamination proceeding was merged with the previously merged '491 and '678 reexamination proceedings into a single consolidated reexamination proceeding.

## DECISION

### I. Relevant Statutes, Regulations and Practice

35 U.S.C. § 132 provides:

> "(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his

[5] The paper was mailed in the '491-'678 merged reexamination proceeding and separately mailed in the '723 *ex parte* reexamination proceeding.

[6] See discussion at pages 5-7, *infra*.

[7] No such pick up was scheduled, and none was made.

claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

(b) The Director shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant. The Director may establish appropriate fees for such continued examination and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under section 41(h)(1) of this title."

35 U.S.C. § 301 provides in pertinent part:

"Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent."

35 U.S.C. § 302 provides 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. § 303(a) provides in pertinent part:

"Within 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. § 305 provides, in pertinent part:

"After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent."

35 U.S.C. § 306 provides:

"The patent owner involved in a reexamination proceeding under this chapter may appeal under the provisions of section 134 of this title, and may seek court review under the provisions of sections 141 to 145 of this title, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent."

37 CFR 1.3 provides:

"Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Director and will not be entered. A notice of the non-entry of the paper will be provided. **Complaints against examiners and other employees must be made in correspondence separate from other papers.**" [Emphasis added.]

37 CFR 1.4(c) provides:

"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."

37 CFR 1.111(b) provides:

"In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of

objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section."

37 CFR 1.181(a)(1) provides that petition may be taken to the Director:

"**From any action** or requirement of any examiner in the *ex parte* prosecution of an application, or **in *ex parte*** or *inter partes* prosecution **of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court.**" [Emphasis added.]

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

"(a) All *ex parte* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office. **After issuance of the *ex parte* reexamination order and expiration of the time for submitting any responses, the examination will be conducted in accordance with §§ 1.104 through 1.116** and will result in the issuance of an *ex parte* reexamination certificate under § 1.570. [Emphasis added.]

(b) The patent owner in an *ex parte* reexamination proceeding will be given at least thirty days to respond to any Office action. **In response to any rejection,** such response may include further statements and/or proposed amendments or new claims to place the patent in a condition where all claims, if amended as proposed, would be patentable." [Emphasis added.]

MPEP § 2267 provides in pertinent part:

"The return of inappropriate submissions complies with the regulations that certain papers will not be considered and also reduces the amount of paper which would ultimately have to be scanned into the record.

I. DISPOSITION OF PAPERS
Where papers are filed during reexamination proceedings which are inappropriate because of some defect, such papers will either be returned to the sender or forwarded to one of three files, the "Reexamination File" (paper file or IFW file history), the "Patent File" (paper file or IFW file history), or the "Storage File" (paper file). Any papers returned to the sender from a Technology Center (TC) must be accompanied by a letter indicating signature and approval of the TC Director." [8]

## II. Basis For The August 23, 2006 Decision

On April 28, 2006, patent owner filed a supplemental amendment/response to an outstanding Office action (issued in the '491-678 merged reexamination proceeding) dated December 14, 2005. The paper was filed in both the merged proceeding and the '723 reexamination proceeding. Both filings of the paper were returned to patent owner without consideration on the merits as an inappropriate submission. [9] The paper was considered to be inappropriate by the Central Reexamination Unit Director, (1) because the paper was not limited to consideration of prior patents and printed publications, [10] and (2) because portions of that paper were not in compliance with the requirements of 37 CFR 1.3. On June 23, 2006, patent owner requested reconsideration of the return of those papers by way of a petition for reconsideration. Patent owner attached to that petition for reconsideration the material that had previously been

[8] When the CRU has jurisdiction, as in the case of this merged proceeding, the CRU Director would approve and sign the letter accompanying returned papers.
[9] See MPEP § 2267.
[10] See 35 U.S.C. §§ 301-303.

refused entry. A decision in the '491-678 merged reexamination proceeding and a separate decision in the '723 reexamination proceeding both issued on August 23, 2006. Each decision set forth in detail the basis for refusing the underlying relief requested in the June 23, 2006 request for reconsideration with respect to the proceeding in which it was mailed. Each decision again returned the material that was not proper for entry into the record of the present merged reexamination proceeding.

It was pointed out in the August 23, 2006 decision directed to the '491-'678 merged reexamination proceeding, in explanation of why the underlying relief requested by petitioner would not be appropriate, that:

> A) Pursuant to 35 U.S.C. § 306, an issue directed to the merits of a rejection in an *ex parte* reexamination proceeding is ultimately appealable to the Patent and Trademark Office Board of Patent Appeals and Interferences (the Board). On the other hand, pursuant to 37 CFR 1.181(a), a petition to the USPTO Director is the appropriate vehicle to resolve matters not subject to appeal.
>
> B) Pursuant to 37 CFR 1.3, complaints against examiners and other Office employees "must be made in correspondence separate from other papers" which are not directed to complaints against examiners and other Office employees.
>
> C) Pursuant to 37 CFR 1.4(c), different matters raised in a given proceeding must be raised in separate papers.

These points have not been persuasively addressed in the present request for reconsideration.

With respect to the '723 reexamination proceeding, the August 23, 2006 decision mailed in that proceeding pointed out the that papers for which patent owner requested entry were improper and non-enterable because they were directed to an Office action (the December 14, 2005 non-final Office action mailed in the '491-'678 merged reexamination proceeding) that did not exist in the '723 reexamination proceeding. At page 4, the August 23, 2006 decision in the '723 reexamination proceeding also advised petitioner patent owner that the rationale relied upon by the Office in the '491-'678 merged reexamination proceeding would apply to the '723 reexamination proceeding in the event that the '723 reexamination proceeding were merged with the '491-'678 merged reexamination proceeding.

A. The April 28, 2006 Papers Did Not Comply With 37 CFR 1.111

The April 28, 2006 papers purported to be a supplemental amendment/response directed to the outstanding nonfinal Office action dated December 14, 2005. Pursuant to 37 CFR 1.550(a), the present merged reexamination proceeding is to be conducted in accordance with sections 1.104 through 1.116 of Title 37 of the Code of Federal Regulations. Those regulations implement the provisions of 35 U.S.C § 132. 37 CFR 1.111(b) specifically requires that a response to a nonfinal Office action address issues of patentability of the pending claims that are subject to an outstanding rejection. The April 28, 2006 papers did contain material directed to the issue of the patentability of the claims of the patents being reexamined that are required to be resolved by appeal to the Board. However, the April 28, 2006 papers also contained comments and documents that were not directed to the merits of the outstanding rejection (*i.e.*, not directed to appealable matters). These additional comments and documents were instead directed to matters of alleged misconduct on the part of Office employees/officials, and requested relief

that is only available by way of petition to the USPTO Director, and not by an appeal to the Board.[11] Accordingly, the April 28, 2006 papers failed to comply with 37 CFR 1.111.

Petitioner is also referred to MPEP § 1201 which states, in pertinent part:

> Where the differences of opinion concern the denial of patent claims because of prior art or other patentability issues, the questions thereby raised are said to relate to the merits, and appeal procedure within the Office and to the courts has long been provided by statute (35 U.S.C. 134).
> The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Director of the U.S. Patent and Trademark Office (Director) should be carefully observed. The Board will not ordinarily hear a question that should be decided by the Director on petition, and the Director will not ordinarily entertain a petition where the question presented is a matter appealable to the Board.

In this instance, the entry of the additional comments and documents directed to matters of alleged misconduct on the part of Office employees/officials would inappropriately place materials unrelated to the merits of patentability before the examiner. Not only would entry of these materials confuse and overburden the record, but also these materials simply are not permitted to be, and will not be, made available for consideration by the examiner in determining the patentability of the claims.

B. The April 28, 2006 Papers Did Not Comply With 37 CFR 1.3

37 CFR 1.3, last sentence, prohibits the submission of "complaints against examiners and other employees" of the Office as a part of papers directed to other matters before the Office. The "returned" April 28, 2006 papers included complaints regarding the conduct of Office employees, and these complaints were submitted as part of papers directed to other matters, *i.e.*, the issues of claim patentability in this merged proceeding. Accordingly, the April 28, 2006 papers are barred by 37 CFR 1.3.

C. The April 28, 2006 Papers Did Not Comply With 37 CFR 1.4(c)

37 CFR 1.4(c) requires that, within a given proceeding, material directed to matters that will be considered by different branches within the Office be raised in separate papers. Yet, the April 28, 2006 papers included complaints regarding conduct together with material directed to the issues of claim patentability, notwithstanding that these separate issues are decided by different branches of the Office and resolved by different appellate review tribunals: (1) decision on petition to the USPTO Director and (2) consideration by the Primary Examiner which may ultimately be reviewed by the Board. Accordingly, the April 28, 2006 papers are barred by 37 CFR 1.4(c).

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[11] See, for example, the arguments at page 74-92 of the supplemental response filed April 28, 2006, that was to be disposed of if not "picked up" by the patent owner in accordance with the August 23, 2006 Decision on Petition. Note that even a single instance of an argument directed to matters that are not part of a proper response to a nonfinal action within the meaning of 37 CFR 1.111(b) would suffice to preclude entry of the entire supplemental response as lacking an entry right.

## III. Findings And Analysis With Respect To The Present Petition For Reconsideration

### A. Patent Owner's Position Is Fundamentally Flawed

Petitioner patent owner argues that there has been improper conduct on the part of Office employees. [12] Patent owner apparently also believes that it has evidence of bias specifically on the part of one or more examiners, [13] and that this evidence, as previously submitted on April 28, 2006, should not be barred from examiner consideration because it bears on issues of patentability. Thus, petitioner patent owner urges that 37 CFR 1.3 should not preclude presentation to the examiner of the material alleging bias (even where bias alleged on the part of the examiner is alleged), because bias bears on patentability issues. Similarly, patent owner argues that 37 CFR 1.4(c) is inapplicable, because evidence of bias addresses the same patentability issues as the remainder of patent owner's substantive reply. [14]

Initially, patent owner has not shown how bias will change whether a claim is patentable over a reference or not. If the patent owner believes that there is a bias that would influence an examiner involved, or another Office employee conducting the examination of the claims for patentability, the proper avenue to address that would be via a 37 CFR 1.182 petition to remove the examiner or other Office employee, not by presenting the allegation of bias to the accused examiner for determination. Also, patent owner's position **assumes** that the evidence presented by patent owner **actually establishes bias**. However, the question of whether the material presented by patent owner in support of patent owner's allegations of bias in fact establishes bias on the part of any Office personnel is an open question that has not yet been decided. Patent owner further assumes that the examiner is the appropriate Office employee to view alleged evidence of bias on the part of Office officials (and on the part of the examiner) in order to make a finding that bias in fact existed. However, the examiner's authority extends to making patentability determinations. The examiner does not exercise supervisory authority with respect to the alleged bias or misconduct on the part of other Office employees.

Pursuant to 35 U.S.C. § 306, an issue directed to the merits of a rejection in an *ex parte* reexamination proceeding is ultimately appealable to the Board, and then to the courts. All matters not subject to appeal to the Board under 35 U.S.C. § 306 are subject to resolution by way of petition under 37 CFR 1.181. Further, 37 CFR 1.3 prohibits complaints about employee conduct to be included within the same papers addressing the merits of patentability. Therefore, the proper avenue for obtaining review of an allegation of procedural impropriety, misconduct or bias on the part of Office personnel would be through petition to appropriate Office officials (as pointed out above). Any decision on such a petition that is adverse to patent owner would be subject to court review in the same manner as any other question of administrative procedure would be reviewed. [15] It is not reasonable to state that the evidence **alleged** to support bias on the part of Office officials, and/or on the part of the examiner, should be placed into the record of the present merged reexamination proceeding before the examiner for review and evaluation by the examiner as part of a patentability determination. Further, some of the allegations of bias are directed to the conduct of the examiner, making it far from clear that the examiner could objectively evaluate the allegations of the examiner's own bias. Yet, as noted above, patent owner appears to have raised the argument that the evidence of examiner bias should be forwarded to the examiner for consideration. Such consideration

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[12] See pages 3-4 of the present Petition for Reconsideration.

[13] See, for example, the headings on pages 4 and 7 of the present Petition for Reconsideration.

[14] See pages 7-9 of the present Petition for Reconsideration.

[15] Non-appealable subject matter reviewed by petition under 37 CFR 1.181 is subject to judicial review under the Administrative Procedures Act.

has, to date, been refused solely on the basis that patent owner has filed a single paper that conflated and intermingled these issues, rather than filing two separate papers that are each directed only to the area of the Office that would properly consider only that paper. [16]

By way of expansion on the above discussion, patent owner is reminded that patent examiners are Office personnel who are charged with evaluating evidence bearing on questions of patentability. In the present merged reexamination proceeding, the examiner's consideration of patentability is limited by 35 U.S.C. §§ 301 – 303 to a consideration of prior patents and printed publications. [17] Examiners are not charged with evaluating evidence of impropriety, misconduct or bias, by examiners or other Office personnel. Also, until the patent owner's evidence and allegations of misconduct are properly evaluated by the appropriate Office personnel, they cannot have any affect on action taken by the Office.

As a final point, patent owner is not being deprived of due process by a refusal to accept papers that co-mingle allegations of misconduct (and documents supporting those allegations) with papers that are directed to other matters. Papers raising issues of alleged misconduct, and documents proffered in support of such allegation, are admissible in the Office, and can properly be submitted for consideration by the Office, but only if they are provided in a manner that complies with the regulations.

B. 37 CFR 1.3 and 37 CFR 1.4(c) Each Precludes The Relief Requested By Petitioner Patent Owner

It is manifestly clear that both 37 CFR 1.3 and 37 CFR 1.4(c) each prohibit patent owner from co-mingling arguments directed to issues of the patentability of the claims with arguments and evidence in support of allegations of procedural impropriety and bias on the part of Office personnel. Those allegations are as yet unproven, and cannot be properly considered to presently establish any basis for reassignment of examining responsibilities. This is not the same as concluding that the regulations preclude **the presentation** of evidence of bias, as patent owner argues, [18] (notwithstanding that the Office has never taken such position [19]). The Office is not refusing to consider patent owner's alleged evidence, but simply is requiring that patent owner's evidence and allegations be presented in accordance with its rules which require them to be directed to the appropriate Office personnel for consideration and evaluation.

To the extent that the present petition again presents the allegation that 37 CFR 1.3 is inapplicable because patent owner has not violated decorum or been discourteous in this proceeding, [20] and also cites case law that is alleged to establish that 37 CFR 1.3 is inapplicable on the facts in this proceeding, patent owner is reminded that the August 23, 2006 Decision on Petition in the '491-'678 merged reexamination proceeding was in no manner based upon patent owner's conduct. Rather, 37 CFR 1.3 was applied because it requires that complaints of misconduct on the part of examiners and Office personnel "must be made in correspondence separate from other papers." [21] This language manifestly includes, as part of the class of "other

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[16] Given that reexaminations are conducted with special dispatch, it is puzzling that patent owner has not seen fit to comply with the relatively straightforward and simple requirements of the 37 CFR 1.3 and 1.4(c) by filing two separate papers, since by doing so, patent owner would have immediately placed before the proper areas of the Office both the conduct issues and the substantive patentability issues for consideration by the appropriate Office personnel.

[17] Extrinsic evidence explaining the content of prior patents and printed publications may be considered as well.

[18] See page 5 of the present petition, last sentence in the paragraph bridging pages 4 and 5.

[19] See for example, Decision Dismissing Petition dated August 23, 2006, section II(B), items 1 and 4.

[20] See the present petition, beginning at the bottom of page 4 and running through page 5.

[21] See Decision on Petition, August 23, 2006, page 7, first full paragraph.

papers" in which complaints of misconduct may not be raised, "papers directed to the merits of claim patentability in any proceeding in which the misconduct is alleged to have occurred."

Moreover, none of the case law cited by patent owner at page 5 of the present petition supports patent owner's position that 37 CFR 1.3 has been misapplied. Here, the Office is not prohibiting the patent owner from submitting evidence regarding its allegations; rather, the Office is simply directing material to the appropriate Office official for review of patent owner's complaint in accordance with the requirements established by 37 CFR 1.3 that employee conduct complaints "must be made in correspondence separate from other papers." None of the cases relied upon by patent owner demonstrate that the Office may not enforce the clear language of 37 CFR 1.3 by requiring papers containing complaints about the conduct of Office officials and personnel to be filed separately from other papers related to the merits of patentability.

Patent owner's argument that 37 CFR 1.4(c) should not prohibit examiner consideration of the merits of patent owner's arguments regarding the existence of bias is similarly fatally flawed. First, 37 CFR 1.4(c) does not preclude consideration of the merits of patent owner's allegations of bias, impropriety or misconduct on the part of Office officials and employees. The record does not show that the Office has taken the position that the allegations raised by patent owner cannot or will not be considered. 37 CFR 1.4(c) merely directs the orderly manner in which such allegations, and the evidence in support of such allegations, must be presented to the Office - for consideration by the proper Office officials. In this instance, 37 CFR 1.4(c) applies, because it requires that matters such as questions of bias or inappropriate conduct by Office personnel, which matters are appropriate for consideration by an Office official in one particular area of the Office, be submitted in a paper *separately* from papers containing substantive patentability issues, which are properly decided by a different Office official of employee in a different area of the Office. As pointed out above, the patent examiner is not the proper Office official to consider and rule on patent owner's allegations of bias, impropriety and misconduct; and thus, such allegations and materials supporting such allegations, are not proper for inclusion in the IFW record as a part of papers otherwise directed to patentability issues. The fact that the "examiner" is one of the employees that is accused of misconduct further highlights the appropriateness of the procedural safeguards provided by the rules. Clearly, the employee accused of alleged misconduct cannot be the official who will decide the issue. Moreover, the rule protects the integrity of the file history by separating employee complaints from the merits of examination.

Thus, 37 CFR 1.4(c) precludes entry of the papers submitted as a part of the June 23, 2006 petition, because the regulation properly requires that:

> matters bearing on the determination of patentability in this proceeding, and
>
> matters directed to a determination of the propriety of the allegations of misconduct, bias or impropriety on the part of Office officials and the examiner

be submitted in separate papers inasmuch as these issues are decided by different Office officials/employees in different areas of the Office.

C. 37 CFR 1.111 Precludes The Relief Requested By Patent Owner

37 CFR 1.111(b) provides that a response to a nonfinal Office action must, *inter alia*, specifically point out supposed errors in the examiner's action, and point out the specific distinctions believed to render the claims patentable over the prior art. The regulation does not provide for

"further statements" that address matters other than the issues of patentability raised in the outstanding Office action. The failure of the April 28, 2006 patent owner submission to comply with 37 CFR 1.111(b) was discussed at pages 6-7 of the Decision Dismissing Petition dated August 23, 2006 in the '491-'678 merged reexamination proceeding. It was pointed out that the April 28, 2006 patent owner submission was not confined to responding to the nonfinal Office action as required by 37 CFR 1.111(b), but instead intermingled matter directed to other issues (the issues of alleged misconduct on the part of Office personnel).

In the present petition patent owner has not directly addressed this point. To the extent that patent owner's general argument that the allegations of misconduct are in fact relevant to the issues of patentability, those arguments are wholly unpersuasive for the reasons set forth in Section III (A) above. Therefore, it is again concluded that the Decision Dismissing Petition mailed on August 23, 2006 in the '491-'678 merged reexamination proceeding properly refused entry of the April 28, 2006 patent owner as being non-compliant with 37 CFR 1.111(b). It is again noted that the Decision Dismissing Petition mailed on August 23, 2006 in the '723 reexamination proceeding specifically advised patent owner of the applicability of the rationale set forth in the August 23, 2006 decision mailed in the '491-'678 merged reexamination proceeding to the '723 reexamination proceeding in the event that that latter and the former were merged.

## CONCLUSION

1. The October 23, 2006 patent owner petition is granted to the extent that the August 23, 2006 Decision Dismissing Petition has been fully reconsidered, and that the present decision will be designated as a final agency decision.

2. The October 23, 2006 patent owner petition is denied with respect to disturbing the holding of the August 23, 2006 Decision Dismissing Petition mailed in the '491-'678 merged reexamination proceeding which refused to enter the papers attached to patent owner's June 23, 2006 Petition and which "returned" those papers.

3. A copy of this decision is being made of IFW record for the merged reexamination proceeding, and the decision will therefore appear in the IFW record of *ex parte* reexamination proceedings 90/006,491, 90/006,678 and 90/007,723.

4. Telephone inquiries with regard to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or, in his absence, to the undersigned at (571) 272-7710.

5. This decision is a final agency action within the meaning of 5 U.S.C. § 704.

/Kenneth M. Schor/

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

sm
February 22, 2007

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/006,492 | 12/26/2002 | 5631946 | | 9466 |

20457 7590 03/26/2003

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| EXAMINER |
|---|
| L. Kincaid |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2685 | 9 |

DATE MAILED: 03/26/2003

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PTO-90C (Rev. 07-01)

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Paper No. 9

ANTONELLI TERRY STOUT AND KRAUS (For Patent Owner)
SUITE 1800
1300 NORTH SEVENTEENTH STREET
ARLINGTON VA 22209

| | | |
|---|---|---|
| In re Reexamination of: | ) | |
| U.S. Patent No. 5,631,946 | ) | DECISION CONCERNING |
| Reexamination Control No. 90/006,492 | ) | PAPERS FILED BY |
| For: SYSTEM FOR TRANSFERRING INFOR- | ) | PATENT OWNER |
| MATION FROM A RF RECEIVER TO A | ) | |
| PROCESSOR UNDER CONTROL OF A | ) | |
| PROGRAM STORED BY THE PROCESSOR | ) | |
| AND METHOD OF OPERATION THEREOF | ) | |

The present proceeding is before the TC 2600 Special Program Examiners' Office for clarification of status of the papers filed on February 26, 2003 and March 14, 2003 by the Patent Owner.

## BACKGROUND

A review of the file finds the following contents of the proceedings:

1) On December 26, 2002, a Director Initiated Order for Reexamination was mailed to the Patent Owner (Paper No. 1).

2) On December 24, 2002 the Title report was placed in the file (Paper No. 2).

3) On February 26, 2003, Patent Owner filed
   a) a Patent Owner's Statement under Protective Order (Paper No. 3),
   b) an Expert Declaration submitted under Protective Order (Paper No. 4),
   c) a Declaration of Donald E. Stout pursuant to 37 CFR 1.131 (Paper No. 5),
   d) a Declaration of Thomas J. Campana, Jr. pursuant to 37 CFR 1.131 (Paper No. 6), and
   e) and Information Disclosure Statement under 37 CFR 1.555 (Paper No. 7).

4) On March 5, 2003, Patent Owner filed copies of date-stamped postcard receipts (Paper No. 8) evidencing the timely filing of the items listed above in section 3) of this communication.

The Office regrets the failure to date-stamp the original papers submitted to the Office on February 26, 2003. The original papers which were missing date-stamps have now been date-stamped in accordance with the evidence provided.

5) On March 14. 2003, Patent Owner filed a Petition under 37 CFR 1.183 for filing a Supplemental Patent Owner's Statement. Entry of the submitted Supplemental Patent Owner's Statement and accompanying Information therewith will be decided by the Office of Patent Legal Administration (OPLA) in their decision on this petition.

## DECISION

There are no provisions for submitting a Patent Owner's Statement and/or declarations under 37 CFR 1.131 and 37 CFR 1.132 under Protective Order. MPEP 724.03 sets forth the types of Trade Secret, Proprietary, and/or Protective Order Materials contemplated for submission under MPEP 724.02 and clearly sets forth that if any protective order materials are submitted in "***amendments, arguments in favor of patentability, or affidavits under 37 CFR 1.131 or 1.132, they will be made of record in the file and will not be given any special status***." Because the Patent Owner's Statement must clearly point out why the claims are deemed to be patentable (see MPEP 2249), by definition, the Patent Owner's Statement is inappropriate for submission under Protective Order. Accordingly, the Patent Owner's Statement has been made of record in the file as Paper No. 3. Likewise, the Expert Declaration which was also submitted under Protective Order was inappropriate for submission under Protective Order and has been made of record in the file as Paper No. 4.

## CONCLUSION

The papers filed under Protective Order have been removed from the envelopes and made of record. The file is being forwarded to OPLA for a decision on the Petition filed March 14, 2003.

Krista Zele
Special Programs Examiner
Technology Center 2600
Communications

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
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Paper No. 10

Donald E. Stout
Antonelli, Terry, Stout & Kraus
Suite 1800
1300 N. 17th Street
Arlington, VA 22209

(For Patent Owner)

MAILED

APR 0 1 2003

REEXAM UNIT

Enclosure: Patent Owner Petition and attachments filed March 14, 2003

| | | |
|---|---|---|
| In re Campana, Jr. et al. | : | |
| Reexamination Proceeding | : | DECISION DISMISSING |
| Control No. 90/006,492 | : | PETITION AND RETURNING |
| Initiated: December 26, 2002 | : | IMPROPER PAPER |
| For: U.S. Patent No. 5,631,946 | : | |

This is a decision on the March 14, 2003, patent owner petition entitled "PETITION PURSUANT TO 37 C.F.R. § 1.183 TO ENLARGE THE TWO MONTH TIME LIMIT FOR FILING A SUPPLEMENTAL PATENT OWNER'S STATEMENT PURSUANT TO 37 CFR § 1.530." The petition is before the Office of Patent Legal Administration for decision.

For the reasons set forth below, the petition is dismissed and is being returned along with this decision.

**REVIEW OF FACTS**

1. On December 26, 2002, reexamination was ordered for five of Patent Owner's patents. The order for reexamination was issued at the initiative of the Director of the United States Patent and Trademark Office under 37 CFR 1.520. The patents and their assigned control number are: 5,625,670 (90/006,491); 5,631,946 (90/006,492); 5,819,172 (90/006,493); 6,067,451 (90/006,494); and 6,317,592 (90/006,495). The present reexamination proceeding is reexamination control number 90/006,492.

2. On February 26, 2003, Patent Owner filed (a) a Patent Owner's Statement under Protective Order (Paper No. 3), (b) an Expert Declaration submitted under Protective Order (Paper No. 4), (c) a Declaration of Donald E. Stout pursuant to 37 CFR 1.131 (Paper No. 5), (d) a Declaration of Thomas J. Campana, Jr. pursuant to 37 CFR 1.131 (Paper No. 6), and (e) an Information Disclosure Statement under 37 CFR 1.555 (Paper No. 7).

3. On March 5, 2003, Patent Owner filed copies of date-stamped postcard receipts (Paper No. 8) evidencing the timely filing of the February 26, 2003, papers. The original papers which had been missing date-stamps were then date-stamped as received on February 26, 2003, pursuant to the evidence provided by Patent Owner.

4. On March 14, 2003, Patent Owner filed the present petition under 37 CFR 1.183 requesting "suspension of the two-month time limit set for the response to the Order for Reexamination" to permit entry of the *accompanying* "Supplemental Patent Owner's Statement Pursuant to 37 CFR 1.530"

5. On March 26, 2003, a "DECISION CONCERNING PAPERS FILED BY PATENT OWNER" was issued by the Technology Center 2600 Special Programs Examiner, stating that "the papers filed [February 26, 2003] under Protective Order have been removed from the envelopes and made of record."

6. The present file was then forwarded to the Office of Patent Legal Administration for a decision on the petition.

**DECISION**

37 CFR 1.540 states:

> No submissions other than the statement pursuant to § 1.530 and the reply by the *ex parte* reexamination requester pursuant to § 1.535 will be considered prior to examination.

The examination stage of the present proceeding has not yet begun, as a first Office action on the merits has not yet been issued. The present March 14, 2003, submission is not a "reply by the *ex parte* reexamination requester pursuant to § 1.535," since it is filed by the patent owner. Further, the submission is not a Patent Owner's statement pursuant to § 1.530, because the Patent Owner's statement pursuant to § 1.530 was already filed on February 26, 2003. Pursuant to 35 U.S.C. 304, the patent owner is

given a reasonable period "within which he may file **a statement**" [Emphasis added] on the question of patentability raised in the order for reexamination. There is no provision in the statute for more than one statement, i.e., there is no provision for a second statement to supplement the first statement.

Since the present March 14, 2003, submission is submission is not a "statement" nor a "reply," entry of same is barred under 37 CFR 1.540.

37 CFR 1.530(b) states:

> The order for *ex parte* reexamination will set a period of not less than two months from the date of the order **within which the patent owner may file a statement on the new question of patentability**, including any proposed amendments the patent owner wishes to make. [Emphasis Added]

Under 37 CFR 1.530(b), the Patent Owner may file the statement *only* within the period set therein. The period set in the December 26, 2002, order for *ex parte* reexamination was two months. Accordingly, the present March 14, 2003, submission would not be timely, even if it were a proper statement under 37 CFR 1.530.

In view of the above, the March 14, 2003, submission of Patent Owner's petition and the accompanying "Supplemental Patent Owner's Statement Pursuant to 37 CFR 1.530" is an improper submission under 37 CFR 1.530(b) and under 37 CFR 1.540. Accordingly, the submission will not be made of record in the reexamination file and is being returned herewith. MPEP 2267. See *In re Knight*, 217 USPQ 294 (Comm'r Pat. 1982); *Patlex Corp. v Mossinghoff*, 226 USPQ 985, 986 (Fed. Cir. 1985). This decision will, however, be made of record in the reexamination file.

As to petitioner's request to waive the rules pursuant to 37 CFR 1.183:

Patent Owner's request for "suspension of the two-month time limit set" in the order is, in effect, a request that the Director to waive the provisions of 37 CFR 1.530(b) and permit (1) entry of the instant petition and accompanying "Supplemental Patent Owner's Statement Pursuant to 37 CFR 1.530," and (2) consideration of same when the examiner issues the first Office action on the merits. A waiver of the requirement to file the statement within the two month time period (set in the order) will not, however, provide Patent Owner with the relief Patent Owner desires, since consideration of the March 14, 2003,

submission would still be barred under 37 CFR 1.540, because the present March 14, 2003, submission is not a "statement" nor a "reply" as discussed above.

Accordingly, Patent owner's petition is taken as a request to waive the provisions of 37 CFR 1.540 and permit entry of a submission other than a statement pursuant to § 1.530 and a reply pursuant to § 1.535.

In order for grant of a petition under 37 CFR 1.183, a petitioner must show (1) that there is an extraordinary situation (2) where justice requires waiver of the rule. *In re Sivertz*, 227 USPQ 255, 256 (Comm'r Pat. 1985). Petitioner Patent Owner has not show that either condition exists in this case.

The present March 14, 2003, submission, for which entry and consideration in the first Office action is requested, provides a paper that was presented in litigation related to the patent being reexamined, and discusses what Patent Owner believes to be the significance of that paper. If entry is not provided at this point, Patent Owner is free to re-submit the March 14, 2003, submission during the examination stage of the present proceeding, i.e., after the first Office action is issued. At that point, the submission would have an entry right and would be considered by the examiner. There is no showing in the petition that re-submission during the examination stage would prejudice Patent Owner as to the consideration of the information presented (in the submission) in a manner as to create an extraordinary situation where justice requires waiver of the provisions of 37 CFR 1.540. Accordingly, the relief provided by 37 CFR 1.183 is not appropriate in this instance, [1] and the present petition pursuant to 37 CFR 1.183 is dismissed.

**CONCLUSION**

1. The March 14, 2003, patent owner petition filed pursuant to 37 CFR 1.183 is dismissed, and it is being returned along with this decision.

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[1] Note that the Office will not normally consider an extraordinary remedy when the rules already provide an avenue for obtaining the relief sought. *See Cantello v. Rasmussen*, 220 USPQ 664 (Comm'r Pat. 1982).

3. The reexamination file is being returned to Technology Center 2600 for storage until a reply under 37 CFR 1.535 is received, or the time for filing same expires, after which a first Office action on the merits is to be issued.

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

April 1, 2003
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 90/006,679 and 90/006492 | 06/24/2003 | 5631946 | | 5440 |

803 7590 05/26/2004

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| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 05/26/2004 #19

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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255 S. Orange Avenue
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Orlando, FL 32801

# *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

90/006492 and

REEXAMINATION CONTROL NO. *90/006,679*.

PATENT NO. *5631946*.

ART UNIT *2600*.

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 PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Paper No. 19

| | | |
|---|---|---|
| Sturm & Fix LLP<br>206 Sixth Avenue<br>Suite 1213<br>Des Moines, IA 50309-4076 | ) | For Patent Owner |
| David Stewart<br>Allen Dyer Doppelt Milbrath & Gilchrist, PA<br>255 S. Orange Avenue<br>Suite 1401<br>Orlando, FL 32801 | ) | For Third Party Requester |
| In re Campana et al.<br>Reexamination Proceeding<br>Control No.: 90/006,492<br>Filed: December 26, 2002<br>For: U.S. Patent 5,631,946 | ) | DECISION *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS |
| In re Campana et al.<br>Reexamination Proceeding<br>Control No.: 90/006,679<br>Filed: June 24, 2003<br>For: U.S. Patent 5,631,946 | ) | |

The above noted reexamination proceedings are before the Director of Technology Center 2600 for consideration of merger of the proceedings under 37 CFR 1.56(c).

## BACKGROUND

1. Patent 5,631,946 issued on May 20, 1997.

2. On December 26, 2002, a Director Initiated Order for Reexamination was mailed to the Patent Owner as Control No. 90/006,492 ('492).

3. A Patent Owner's Statement was filed in the '492 proceeding on February 26, 2003.

4. A request for reexamination, Control No. 90/006,679 ('679) was filed by the Third Party Requester on June 24, 2003.

5. Reexamination was ordered on the '679 reexamination proceeding on September 3, 2003.

6. No Patent Owner Statement was filed in the '679 reexamination proceeding.

## DISCUSSION

37 CFR 1.565(c) states:

> "If reexamination is ordered while a prior reexamination is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under section 1.570".

## DECISION

**I.** Merger of Proceedings

In accordance with 37 CFR 1.565(c), the '492 and '679 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 all proceedings.

The Patent Owner is required to maintain the same claims and specification in both files.

**III.** Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action, which applies to both proceedings. All papers issued by the Office or filed by the Patent Owner must contain the identifying data for both proceedings and will be physically entered in each reexamination file which will be separately maintained. All papers filed by the Patent Owner must also consist of a single response, filed in duplicate, each bearing an original signature, for entry into each file. All papers filed by the Patent Owner must be served on the requestor and requestor will be sent copies of all papers mailed by the Office. See MPEP 2283.

A review of these reexamination files finds that both proceedings currently contain the same claims and specification and therefore the Patent Owner need not take any action.

The merged proceedings are being forwarded to the examiner for appropriate action. An Office action will be mailed in due course.

Andy Faile, Acting Director
Technology Center 2600
Communications

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MAILED

AUG 23 2006

CENTRAL REEXAMINATION UNIT

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/006,492
Filed: December 26, 2002
For: U.S. Patent No. 5,631,946

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No. : 90/006,679
Filed: June 24, 2003
For: U.S. Patent No. 5,631,946

**DECISION, *SUA SPONTE*, DISMISSING PETITION AND "RETURNING" IMPROPER PAPERS**

This is a decision on the June 23, 2006 patent owner petition styled "Petition Pursuant to 37 CFR 1.181 or Alternatively, 37 CFR 1.182 OR Alternatively 37 CFR 1.183 to Reconsider Decision Returning Paper and Enter the Papers into the Official Record." [1]

The petition and the above-captioned reexamination proceedings are before the Office of Patent Legal Administration for consideration.

The petition is dismissed and its attachments are returned to the patent owner for the reasons discussed below.

## REVIEW OF SALIENT FACTS

1. U.S Patent number 5,631,946 ("the '946 patent") issued to Campana *et al* on April 29, 1997 from an application filed on May 18, 1995.

2. On December 26, 2002, a Director Initiated Order for Reexamination of the '946 patent

[1] The present petition is, facially, fully treatable pursuant to the provisions of 37 CFR 1.181. Accordingly, it is manifestly unnecessary to consider the petition under either 37 CFR 1.182 or 37 CFR 1.183. No fee is required.

mailed and assigned control number 90/006,492 ("the '492 reexamination proceeding").

3. On June 24, 2003, a request for ex *parte* reexamination of the '946 patent was filed by a third party requester, and assigned control number 90/006,679 ("the '679 reexamination proceeding").

4. On September 3, 2003, the examiner's Order Granting *Ex Parte* Reexamination for the '679 reexamination proceeding was mailed.

5. On May 26, 2004, the Technology Center Director issued a decision, *sua sponte*, by which the '492 reexamination proceeding and the '679 reexamination proceeding were merged into a single combined reexamination proceeding.

6. Following prosecution on the patentability of the '946 patent claims, a nonfinal rejection Office action was issued in the merged reexamination proceeding on November 30, 2005.

7. On January 4, 2006, a Freedom of Information Act ("FOIA") Request was made to the Office requesting the Office's communications with third parties regarding the present reexamination proceedings and pending reexamination proceedings being conducted on other of patent owner's patents.

8. The Office responded to the FOIA request through letters dated between February 8 and March 24, 2006. [2]

9. On January 30, 2006, patent owner filed a response to the November 30, 2005 nonfinal Office action.

10. On April 28, 2006, patent owner filed a paper styled as a supplemental response to the nonfinal rejection, which included a traverse of the nonfinal rejection, copies of material obtained as a result of the FOIA request, and a number of statements in support of patent owner's traverse.

11. On May 17, 2006, the CRU Director mailed a decision returning the April 28, 2006 patent owner supplemental response to the nonfinal rejection noted in Fact 10 above without consideration on the merits. [3] The return was based on the grounds that the papers filed were improper because they were not limited to consideration of prior patents and printed publications and also because portions were not in compliance with the 37 CFR 1.3 requirements for decorum and courtesy. Accordingly, the returned response was not entered into the record.

12. On May 22, 2006, patent owner filed a redacted version of the April 28, 2006 supplemental response, limited to material addressing the outstanding nonfinal rejection Office action, which has been entered into the IFW record.

13. On June 23, 2006, patent owner filed the present petition requesting reconsideration of the CRU Director's May 17, 2006 decision. Patent owner has attached to the petition the material that was refused entry and returned (by the CRU Director's May 17, 2006

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[2] An additional response to the FOIA request was mailed by the Office on June 15, 2006 and received by patent owner on June 16, 2006.

[3] Jurisdiction of the merged '492 and '679 reexamination proceedings had previously been transferred from the Technology Center to the CRU.

decision), for entry into the record as part of patent owner's response to the November 30, 2005 Office action.

## DECISION DISMISSING THE THIRD PARTY REQUESTER PETITION AND RETURNING PAPERS FILED WITH THE PETITION

### I. Relevant Statutes, Regulations and Practice

35 U.S.C. § 132 provides:

"(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

(b) The Director shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant. The Director may establish appropriate fees for such continued examination and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under section 41(h)(1) of this title."

35 U.S.C. § 305 provides, in part:

"After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent."

35 U.S.C. § 306 provides:

"The patent owner involved in a reexamination proceeding under this chapter may appeal under the provisions of section 134 of this title, and may seek court review under the provisions of sections 141 to 145 of this title, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent."

37 CFR 1.3 provides:

"Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Director and will not be entered. A notice of the non-entry of the paper will be provided. **Complaints against examiners and other employees must be made in correspondence separate from other papers.**" [Emphasis added.]

37 CFR 1.4(c) provides:

"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."

37 CFR 1.111(b) provides:

> "In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section."

37 CFR 1.181(a)(1) provides that petition may be taken to the Director:

> "**From any action** or requirement of any examiner in the ex parte prosecution of an application, or **in ex parte** or inter partes prosecution **of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court.**" [Emphasis added.]

37 CFR 1.550(a) and (b) provide, in part:

> "(a) All *ex parte* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office. **After issuance of the *ex parte* reexamination order and expiration of the time for submitting any responses, the examination will be conducted in accordance with §§ 1.104 through 1.116** and will result in the issuance of an *ex parte* reexamination certificate under § 1.570. [Emphasis added.]
>
> (b) The patent owner in an *ex parte* reexamination proceeding will be given at least thirty days to respond to any Office action. **In response to any rejection,** such response may include further statements and/or proposed amendments or new claims to place the patent in a condition where all claims, if amended as proposed, would be patentable." [Emphasis added.]

MPEP § 2267 provides in part:

> "The return of inappropriate submissions complies with the regulations that certain papers will not be considered and also reduces the amount of paper which would ultimately have to be scanned into the record.
>
> I. DISPOSITION OF PAPERS
> Where papers are filed during reexamination proceedings which are inappropriate because of some defect, such papers will either be returned to the sender or forwarded to one of three files, the "Reexamination File" (paper file or IFW file history), the "Patent File" (paper file or IFW file history), or the "Storage File" (paper file). Any papers returned to the sender from a Technology Center (TC) must be accompanied by a letter indicating signature and approval of the TC Director." [4]

## II. Findings and Analysis

On April 28, 2006, patent owner filed a supplemental response to the nonfinal action dated November 30, 2005. That paper was returned to patent owner by the decision of the CRU Director dated May 17, 2006, on the grounds that the supplemental response was an improper paper. The basis of this holding was that the supplemental response included statements and documents that were improper because they were not limited to consideration of prior patents and printed publications, and also because portions were not in compliance with 37 CFR 1.3 requirements for decorum and courtesy. Patent owner was invited, in the May 17, 2006 decision returning papers, to submit a redacted response, and patent owner has in fact filed a

[4] When the CRU has jurisdiction, as in the case of this merged proceeding, the CRU Director would approve and sign the letter accompanying returned papers.

redacted version of the supplemental response (the redacted version has been entered into the record).

Patent owner has now attached to the present petition a set of papers to be added to the record as a part of the supplemental response to the November 30, 2005 nonfinal action, which would be available for the examiner's consideration in evaluating the patent owner's response. Patent owner requests by way of the present petition that these papers be entered into the IFW record to provide a complete administrative record. [5] It is patent owner's position that:

(1) There was no legal basis for the CRU Director's return of the April 28, 2006 supplemental response papers;

(2) The grounds for such return as expressed in the CRU Director's decision returning the supplemental response papers were erroneous;

(3) The patent owner is entitled to argue and provide documents to allege that the November 30, 2005 nonfinal action is an improper action based on allegations of misconduct and bias.

(4) Due process requires that the Office accept the unredacted supplemental response and related FOIA evidence. [6]

It is also noted that patent owner argues that the CRU Director's decision returning the April 28, 2006 supplemental response to the nonfinal action dated November 30, 2005 was inconsistent with a prior petition decision dated March 20, 2006 denying a patent owner petition filed on January 23, 2006. [7] This argument will be separately addressed, *infra*.

A. The April 28, 2006 Supplemental Response Was An Improper Paper, The Supplemental Response Attached To The Present Petition Is An Improper Paper, And Both Papers Lack An Entry Right In The Merged Reexamination Proceeding

Pursuant to 35 U.S.C. § 306, an issue directed to the merits of a nonfinal rejection in an *ex parte* reexamination proceeding is appealable to the Patent and Trademark Office Board of Patent Appeals and Interferences. On the other hand, pursuant to 37 CFR 1.181(a), a petition to the USPTO Director is the appropriate vehicle to resolve matters not subject to appeal. It is further to be noted that, pursuant to 37 CFR 1.4(c), different matters raised in a given proceeding must be raised in separate papers. Finally, pursuant to 37 CFR 1.3, complaints against examiners and other Office employees "must be made in correspondence separate from other papers" which are not directed to complaints against examiners and other Office employees.

In the present instance, a review of the papers attached to the present petition indicates that (1) the papers are essentially the same as, if not identical to, the papers that were returned by the CRU Director's May 17, 2006 decision, and (2) these papers purport to be a supplemental response to the examiner's treatment of the pending claims in light of the prior art patents and publications applied to the claims by the examiner in the nonfinal action dated November 30, 2005. Pursuant to 37 CFR 1.550(a) (the rule that implements 35 U.S.C. § 305), an *ex parte* reexamination proceeding is "conducted in accordance with [37 CFR] §§ 1.104 through 1.116."

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[5] This would result in the commingling of the now-proffered set of papers with material that the examiner will have to consider.

[6] Petition at pages 10 *et. seq.*

[7] The petition and decision thereon referenced by patent owner are apparently those in the file records of *ex parte* reexamination control number 90/006,495 and *inter partes* reexamination proceeding 95/000,020, which have been merged into a single reexamination proceeding.

Therefore, the appropriate content of a 37 CFR 1.550(b) response to a nonfinal Office action in an *ex parte* reexamination proceeding is defined by 37 CFR 1.111. Subsection (b) of 37 CFR 1.111 does not (contrary to petitioner's argument) provide for "further statements" that are unrestricted as to content. Instead, 37 CFR 1.111(b) requires that a response to a nonfinal action address the issue of patentability of the pending claims with respect to the outstanding rejection, which, in this instance, is the examiner's treatment of the patentability of the claims in light of prior patents and printed publications. In contrast, the papers attached to the present petition include material directed to issues other than the examiner's treatment of the patentability of the claims in light of prior patents and printed publications. In fact, large portions of the remarks contained in the response to the nonfinal action [8] and documents cited in support are directed to the conduct of Office employees/officials. Thus, large portions of the papers attached to the present petition, are not directed to issues of patentability of the pending claims in light of the applied prior art patents and printed publications. Therefore, these papers clearly constitute responses to the outstanding nonfinal Office action that are not proper under 37 CFR 1.550(b) and do not fall within the jurisdiction of the examiner. Accordingly, each of these papers submitted in response to the Office action lacks an entry right in the present merged reexamination proceeding for consideration by the examiner.

Further, 37 CFR 1.3 expressly precludes "complaints against examiners and other employees" submitted as part of papers directed to other matters. Thus, the patent owner's submission of documents in support of its allegations of misconduct and bias could not properly be included with papers directed to the question of patentability in view of prior art, because the clear and unequivocal language of 37 CFR 1.3 expressly requires that "employee conduct" issues are to be raised in correspondence separate from other papers. Here, patent owner improperly raises allegations of employee misconduct incorporated within papers directed to the merits of the examiner's position on the patentability of the pending claims in light of patents and printed publications as set forth in the nonfinal Office action. Therefore, the originally filed April 28, 2006 response and the response attached to the present petition are both improper for the reason that they fail to comply with the requirements of 37 CFR 1.3. Accordingly, each paper further lacks an entry right in the present merged reexamination proceeding for consideration by the examiner.

Moreover, 37 CFR 1.4(c) requires that different matters in a given proceeding appropriate for consideration by different branches within the Office must be raised in separate papers. However, patent owner's April 28, 2006 response to the nonfinal action improperly presented, in the same paper, both:

> (1) arguments and materials directed to the patentability of the claims in view of the patents and printed publications applied in the nonfinal Office action, and
>
> (2) allegations of employee misconduct and bias.

The patentability arguments are properly considered by the examiner. In contrast, allegations of employee misconduct and bias are considered by way of a petition to the appropriate Office official for the exercise of supervisory authority pursuant to 37 CFR 1.181(a), because alleged employee misconduct and bias relate to non appealable subject matter. Thus both the originally filed April 28, 2006 response and the response attached to the present petition are improper for the additional reason that they fail to comply with the requirements of 37 CFR 1.4(c).

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[8] See, *e.g.*, the arguments at page 74-92 of the supplemental response. Note that even a single instance of an argument directed to matters that are not part of a proper response to a nonfinal action within the meaning of 37 CFR 1.113(a) and 37 CFR 1.116 would suffice to preclude entry of the entire supplemental response as lacking an entry right.

Therefore, for the foregoing reasons, the April 23, 2006 patent owner response, and the June 23, 2006 response attached to the present patent owner petition are deemed improper and therefore these papers lack an entry right in the present merged reexamination proceeding. The disposition of improper papers will be treated as discussed in Section C., *infra*.

B. Further Discussion

1. While the patent owner's April 28, 2006 response to the November 30, 2005 nonfinal action and the response to the nonfinal action attached to the present petition each lack an entry right for consideration by the examiner as explained in Section II(A), patent owner may raise the issue of alleged employee misconduct by way of petition under 37 CFR 1.181(a). Note is taken of patent owner's statement that on March 20, 2006, the Office issued a decision in a separate proceeding, such decision denying a patent owner petition filed on January 23, 2006. [9] Patent owner correctly states that the January 23, 2006 petition was denied because it did not provide sufficient details. However, if patent owner is able to now supply those details, they must be submitted in a separate petition under 37 CFR 1.181, but cannot be submitted as part of a paper submitted for consideration by the examiner.

2. Patent owner's characterization of the May 17, 2006 decision issued by the CRU Director returning the April 28, 2006 response to the nonfinal Office action of November 30, 2005 is not wholly accurate. In actuality, the CRU Director's May 17, 2006 decision did not mean to imply that the FOIA papers would be barred from submission for any and all purposes. Rather, it properly points out that the papers were returned because they raised issues unrelated to patentability and therefore are not appropriate for consideration by the examiner. Therefore, the submitted papers did not comply with the regulations and practice regarding the submission of response papers. [10]

3. To the extent that patent owner disagrees with some or all of the rationale set forth in support of the CRU Director's decision, Section II(A) of the present decision amplifies the reasons in support of the conclusion reached in the CRU Director's May 17, 2006 decision to refuse entry and return the April 28, 2006 response with attached papers. Section II(A) of the present decision explains that the patent owner may indeed raise alleged employee misconduct and bias issues, but must do so via a separate petition under 37 CFR 1.181. Such a petition must conform to the governing regulations and practice, i.e., the petition regarding alleged employee misconduct must not be attached to papers directed to the substantive issue of claim patentability in light of the prior patents and printed publication. See 37 CFR 1.3 and 37 CFR 1.4(c).

4. As a final point on this matter, patent owner is not being deprived of due process by a refusal to accept papers that mingle allegations of misconduct (and documents supporting those allegations) with papers that are directed to other matters. Papers raising issues of alleged misconduct, and documents proffered in support of such allegation, are admissible in the Office only if they are provided in a manner that complies with the regulations.

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[9] See footnote 7, *supra*.

[10] Considering the fact that the papers in question were styled as a supplemental response to a nonfinal Office action, the material beginning at the last paragraph of page 2 of the May 17, 2006 CRU Director's decision and running through page 3 thereof indicates to the undersigned that the CRU Director was concerned with the mingling of prior art patent and printed publication patentability issues with the procedural issues raised by the allegations of misconduct and bias of raised in papers.

C. Disposition Of Papers

1. In this instance: (1) the April 28, 2006 presentation of the FOIA papers, (2) the April 28, 2006 declaration of Keith Anderson directed the FOIA papers, and (3) the remarks directed to the conduct of Office employees/officials that were included within the April 28, 2006 response to the nonfinal action have previously been found to be improper, and lacking an entry right in the present merged proceeding. These papers were previously returned, and a redacted form of these papers was entered into the record, as discussed above.

2. In addition, the patent owner has attached to the present petition the material that was refused entry and returned (by the CRU Director's May 17, 2006 decision), for entry into the record as part of patent owner's response to the November 30, 2005 Office action. These papers have now been found to be improper and therefore lack an entry right in the present merged proceeding to which they are directed. As these papers are determined to lack an entry right in the present merged reexamination proceeding, they will be returned in accordance with provisions of MPEP § 2267. In this instance it would be unduly burdensome to either physically return the large bulk of papers, or expend significant Office resources scanning the documents into the record and then closing them from view. [11] Therefore, the papers are being temporarily held for "pick up" in the Central Reexamination Unit (CRU). If the patent owner desires the physical return of the papers, then patent owner should promptly make arrangements to pick up the papers from the CRU **within one month** of the mailing date of this decision. Patent owner should immediately notify Norma Amador of the CRU, at telephone number (571) 272-6474, of any arrangements that have been made to pick up the papers. If the papers are **not** picked up **within one month** of the mailing date of this decision, **the CRU will dispose of the papers,** note being taken that the patent owner presumably has the originals.

3. As to the present petition, the petition contains facial allegations of employee misconduct and bias. Accordingly, though the petition itself will be retained of record in the IFW file, it is being marked as "non-public."

[11] Patent owner has filed at least six other petitions corresponding to the present petition, and provided such papers as attachments to each filed petition.

## CONCLUSION

1. The June 23, 2006 patent owner petition is dismissed.

2. The (1) the April 28, 2006 presentation of the FOIA papers, (2) the April 28, 2006 declaration of Keith Anderson directed the FOIA papers, and (3) the remarks directed to the conduct of Office employees/officials that were included within the April 28, 2006 response to the nonfinal action have been found to be improper papers lacking an entry right in the present merged proceeding to which they are directed. These papers were properly returned to patent owner.

3. The papers attached to the present petition that appear to be the material that was refused entry and returned by the CRU Director's May 17, 2006 decision will be held for one month in the CRU in a single storage location, and thereafter will be discarded if not picked up by patent owner.

4. The present petition will be retained of record in the IFW file and is being marked as "non-public."

5. A copy of this decision is being made of record in the merged reexamination proceeding, and the decision will therefore appear in the IFW record of *ex parte* reexamination proceedings 90/006,492 and 90/006,679.

6. **All correspondence relating to an *inter partes* reexamination proceeding should be directed to:**

By Mail to: Mail Stop *Ex Parte* Reexam
ATTN: 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) 273-9900
Central Reexamination Unit

By hand: Customer Service Window
ATTN: Central Reexamination Unit
Randolph Building
401 Dulany St.
Alexandria, VA 22314

8. Telephone inquiries with regard to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or, in his absence, to the undersigned at (571) 272-7710.

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

sm
August 10, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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CENTRAL REEXAMINATION UNIT

Novak Druce & Quigg LLP
1300 Eye Street NW
Suite 400 East Tower
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(For Third Party Requester)

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/006,492
Filed: December 26, 2002
For: U.S. Patent No. 5,631,946

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/006,679
Filed: June 24, 2003
For: U.S. Patent No. 5,631,946

**DECISION DENYING PETITION**

This is a decision on the October 23, 2006 patent owner petition styled "Petition Pursuant to 37 CFR 1.181 or Alternatively, 37 CFR 1.182 Or Alternatively 37 CFR 1.183 to Reconsider Decision, *Sua Sponte*, 'Returning' Improper Papers and Alternatively That the Commissioner Declare His Decision A Final Agency Action." [1,2]

The petition and the above-captioned reexamination proceedings are before the Office of Patent Legal Administration for consideration.

The petition is granted to the extent that (1) the "Decision, *Sua Sponte*, Dismissing Petition and 'Returning' Improper Papers" [3] dated August 23, 2006, has been reconsidered, and (2) the present decision has been designated as a final agency action under 35 U.S.C. § 704. For the reasons discussed below, the underlying relief requested by petitioner patent owner is denied.

[1] The present petition paper is fully treatable pursuant to 37 CFR 1.181, and it is thus unnecessary to consider the petition paper under either 37 CFR 1.182 or 37 CFR 1.183. A petition fee is not required.
[2] The present paper will hereinafter be referred to as "Petition for Reconsideration."
[3] Hereinafter "Decision Dismissing Petition."

## REVIEW OF SALIENT FACTS

1. U.S Patent number 5,631,946 ("the '946 patent") issued to Campana *et al* on May 20, 1997, from an application filed on May 16, 1995.

2. On December 26, 2002, a Director Initiated Order for Reexamination of the '946 patent was mailed. The resulting *ex parte* reexamination proceeding was assigned control number 90/006,492 ("the '492 reexamination proceeding").

3. On June 24, 2003, a request for a second ex *parte* reexamination of the '946 patent was filed by a third party requester, and the resulting proceeding was assigned control number 90/006,679 ("the '679 reexamination proceeding").

4. On September 3, 2003, an examiner's Order Granting *Ex Parte* Reexamination was mailed for the '679 reexamination proceeding.

5. On May 26, 2004, the Technology Center Director issued a decision, *sua sponte*, by which the '492 reexamination proceeding and the '679 reexamination proceeding were merged into a single consolidated reexamination proceeding.

6. On November 30, 2005, a nonfinal rejection Office action was issued in the merged reexamination proceeding.

7. On January 4, 2006, a Freedom of Information Act ("FOIA") Request was made to the Office requesting the Office's communications with third parties regarding the present reexamination proceedings, as well as pending reexamination proceedings being conducted on other of patent owner's patents.

8. The Office responded to the FOIA request through letters dated between February 8 and March 24, 2006. [4]

9. On January 30, 2006, patent owner filed a response to the nonfinal Office action of November 30, 2005.

10. On April 28, 2006, patent owner filed a supplemental amendment/response to the December 30, 2005 nonfinal Office action.

11. On May 17, 2006, the CRU Director mailed a decision returning the April 28, 2006 patent owner supplemental amendment/response to the nonfinal rejection without consideration on the merits. The return was grounded on the impropriety of the papers, because they were not limited to consideration of prior patents and printed publications, and also because portions of the submission were not in compliance with the requirements of 37 CFR 1.3. Accordingly, the returned supplemental response was not entered into the record.

12. On May 22, 2006, patent owner filed a redacted version of the April 28, 2006 supplemental amendment/response, which is limited to material addressing the outstanding nonfinal rejection Office action, and which has been entered into the IFW record for the merged proceeding.

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[4] An additional response to the FOIA request was mailed by the Office on June 15, 2006, and received by patent owner on June 16, 2006.

13. On June 23, 2006, patent owner filed a petition requesting reconsideration of the CRU Director's May 17, 2006 decision. Patent owner attached to the petition the material that had been refused entry and returned (by the CRU Director's May 17, 2006 decision), and requested entry of that material into the record, as part of patent owner's supplemental response to the December 30, 2005 nonfinal Office action.

14. On August 23, 2006, the June 23, 2006 patent owner petition was dismissed, [5] and was "returned" to petitioner by permitting petitioner to schedule a time to pick up the material (together with similar material from other concurrently filed related petitions). [6]

15. On October 23, 2006, petitioner patent owner filed the present Petition for Reconsideration of the August 23, 2006 petition decision.

## DECISION

### I. Relevant Statutes, Regulations and Practice

35 U.S.C. § 132 provides:

> "(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.
>
> (b) The Director shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant. The Director may establish appropriate fees for such continued examination and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under section 41(h)(1) of this title."

35 U.S.C. § 301 provides in pertinent part:

> "Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent."

35 U.S.C. § 302 provides 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. § 303(a) provides in pertinent part:

> "Within 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. § 305 provides, in pertinent part:

> "After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent

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[5] See discussion at pages 5-7, *infra*.

[6] No such pick up was scheduled, and none was made.

owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent."

35 U.S.C. § 306 provides:

"The patent owner involved in a reexamination proceeding under this chapter may appeal under the provisions of section 134 of this title, and may seek court review under the provisions of sections 141 to 145 of this title, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent."

37 CFR 1.3 provides:

"Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Director and will not be entered. A notice of the non-entry of the paper will be provided. **Complaints against examiners and other employees must be made in correspondence separate from other papers.**" [Emphasis added.]

37 CFR 1.4(c) provides:

"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."

37 CFR 1.111(b) provides:

"In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section."

37 CFR 1.181(a)(1) provides that petition may be taken to the Director:

"**From any action** or requirement of any examiner in the *ex parte* prosecution of an application, or **in *ex parte*** or *inter partes* prosecution **of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court.**" [Emphasis added.]

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

"(a) All *ex parte* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office. **After issuance of the *ex parte* reexamination order and expiration of the time for submitting any responses, the examination will be conducted in accordance with §§ 1.104 thr ugh 1.116** and will result in the issuance of an *ex parte* reexamination certificate under § 1.570. [Emphasis added.]

(b) The patent owner in an *ex parte* reexamination proceeding will be given at least thirty days to respond to any Office action. **In response to any rejecti n,** such response may include further statements and/or proposed amendments or new claims to place the patent in a condition where all claims, if amended as proposed, would be patentable." [Emphasis added.]

MPEP § 2267 provides in pertinent part:

"The return of inappropriate submissions complies with the regulations that certain papers will not be considered and also reduces the amount of paper which would ultimately have to be scanned into the record.

I. DISPOSITION OF PAPERS
Where papers are filed during reexamination proceedings which are inappropriate because of some defect, such papers will either be returned to the sender or forwarded to one of three files, the "Reexamination File" (paper file or IFW file history), the "Patent File" (paper file or IFW file history), or the "Storage File" (paper file). Any papers returned to the sender from a Technology Center (TC) must be accompanied by a letter indicating signature and approval of the TC Director." [7]

## II. Basis For The August 23, 2006 Decision

On April 28, 2006, patent owner filed a supplemental amendment/response to an outstanding Office action dated November 30, 2005. That paper was returned to patent owner without consideration on the merits as an inappropriate submission. [8] The paper was considered to be inappropriate by the Central Reexamination Unit Director, (1) because the paper was not limited to consideration of prior patents and printed publications, [9] and (2) because portions of that paper were not in compliance with the requirements of 37 CFR 1.3. On June 23, 2006, patent owner requested reconsideration of the return of those papers by way of a petition for reconsideration. Patent owner attached to that petition for reconsideration the material that had previously been refused entry. A decision issued August 23, 2006, setting forth in detail the basis for refusing the underlying relief requested in the June 23, 2006 request for reconsideration, and for again returning the material that was not proper for entry into the record of the present merged reexamination proceeding.

It was pointed out in the August 23, 2006 decision, in explanation of why the underlying relief requested by petitioner would not be appropriate, that:

> A) Pursuant to 35 U.S.C. § 306, an issue directed to the merits of a rejection in an *ex parte* reexamination proceeding is ultimately appealable to the Patent and Trademark Office Board of Patent Appeals and Interferences (the Board). On the other hand, pursuant to 37 CFR 1.181(a), a petition to the USPTO Director is the appropriate vehicle to resolve matters not subject to appeal.
>
> B) Pursuant to 37 CFR 1.3, complaints against examiners and other Office employees "must be made in correspondence separate from other papers" which are not directed to complaints against examiners and other Office employees.
>
> C) Pursuant to 37 CFR 1.4(c), different matters raised in a given proceeding must be raised in separate papers.

These points have not been persuasively addressed in the present request for reconsideration.

### A. The April 28, 2006 Papers Did Not Comply With 37 CFR 1.111

The April 28, 2006 papers purported to be a supplemental amendment/response directed to the outstanding nonfinal Office action dated November 30, 2005. Pursuant to 37 CFR 1.550(a), the

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[7] When the CRU has jurisdiction, as in the case of this merged proceeding, the CRU Director would approve and sign the letter accompanying returned papers.
[8] See MPEP § 2267.
[9] See 35 U.S.C. §§ 301-303.

present merged reexamination proceeding is to be conducted in accordance with sections 1.104 through 1.116 of Title 37 of the Code of Federal Regulations. Those regulations implement the provisions of 35 U.S.C § 132. 37 CFR 1.111(b) specifically requires that a response to a nonfinal Office action address issues of patentability of the pending claims that are subject to an outstanding rejection. The April 28, 2006 papers did contain material directed to the issue of the patentability of the claims of the patents being reexamined that are required to be resolved by appeal to the Board. However, the April 28, 2006 papers also contained comments and documents that were not directed to the merits of the outstanding rejection (*i.e.*, not directed to appealable matters). These additional comments and documents were instead directed to matters of alleged misconduct on the part of Office employees/officials, and requested relief that is only available by way of petition to the USPTO Director, and not by an appeal to the Board.[10] Accordingly, the April 28, 2006 papers failed to comply with 37 CFR 1.111.

Petitioner is also referred to MPEP § 1201 which states, in pertinent part:

> Where the differences of opinion concern the denial of patent claims because of prior art or other patentability issues, the questions thereby raised are said to relate to the merits, and appeal procedure within the Office and to the courts has long been provided by statute (35 U.S.C. 134).
> The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Director of the U.S. Patent and Trademark Office (Director) should be carefully observed. The Board will not ordinarily hear a question that should be decided by the Director on petition, and the Director will not ordinarily entertain a petition where the question presented is a matter appealable to the Board.

In this instance, the entry of the additional comments and documents directed to matters of alleged misconduct on the part of Office employees/officials would inappropriately place materials unrelated to the merits of patentability before the examiner. Not only would entry of these materials confuse and overburden the record, but also these materials simply are not permitted to be, and will not be, made available for consideration by the examiner in determining the patentability of the claims.

B. The April 28, 2006 Papers Did Not Comply With 37 CFR 1.3

37 CFR 1.3, last sentence, prohibits the submission of "complaints against examiners and other employees" of the Office as a part of papers directed to other matters before the Office. The "returned" April 28, 2006 papers included complaints regarding the conduct of Office employees, and these complaints were submitted as part of papers directed to other matters, *i.e.*, the issues of claim patentability in this merged proceeding. Accordingly, the April 28, 2006 papers are barred by 37 CFR 1.3.

C. The April 28, 2006 Papers Did Not Comply With 37 CFR 1.4(c)

37 CFR 1.4(c) requires that, within a given proceeding, material directed to matters that will be considered by different branches within the Office be raised in separate papers. Yet, the April 28, 2006 papers included complaints regarding conduct together with material directed to the issues of claim patentability, notwithstanding that these separate issues are decided by different branches of the Office and resolved by different appellate review tribunals: (1) decision on

[10] See, for example, the arguments at page 74-92 of the supplemental response filed April 28, 2006, that was to be disposed of if not "picked up" by the patent owner in accordance with the August 23, 2006 Decision on Petition. Note that even a single instance of an argument directed to matters that are not part of a proper response to a nonfinal action within the meaning of 37 CFR 1.111(b) would suffice to preclude entry of the entire supplemental response as lacking an entry right.

petition to the USPTO Director and (2) consideration by the Primary Examiner which may ultimately be reviewed by the Board. Accordingly, the April 28, 2006 papers are barred by 37 CFR 1.4(c).

III. Findings And Analysis With Respect To The Present Petition For Reconsideration

A. Patent Owner's Position Is Fundamentally Flawed

Petitioner patent owner argues that there has been improper conduct on the part of Office employees. [11] Patent owner apparently also believes that it has evidence of bias specifically on the part of one or more examiners, [12] and that this evidence, as previously submitted on April 28, 2006, should not be barred from examiner consideration because it bears on issues of patentability. Thus, petitioner patent owner urges that 37 CFR 1.3 should not preclude presentation to the examiner of the material alleging bias (even where bias alleged on the part of the examiner is alleged), because bias bears on patentability issues. Similarly, patent owner argues that 37 CFR 1.4(c) is inapplicable, because evidence of bias addresses the same patentability issues as the remainder of patent owner's substantive reply. [13]

Initially, patent owner has not shown how bias will change whether a claim is patentable over a reference or not. If the patent owner believes that there is a bias that would influence an examiner involved, or another Office employee conducting the examination of the claims for patentability, the proper avenue to address that would be via a 37 CFR 1.182 petition to remove the examiner or other Office employee, not by presenting the allegation of bias to the accused examiner for determination. Also, patent owner's position **assumes** that the evidence presented by patent owner **actually establishes bias**. However, the question of whether the material presented by patent owner in support of patent owner's allegations of bias in fact establishes bias on the part of any Office personnel is an open question that has not yet been decided. Patent owner further assumes that the examiner is the appropriate Office employee to view alleged evidence of bias on the part of Office officials (and on the part of the examiner) in order to make a finding that bias in fact existed. However, the examiner's authority extends to making patentability determinations. The examiner does not exercise supervisory authority with respect to the alleged bias or misconduct on the part of other Office employees.

Pursuant to 35 U.S.C. § 306, an issue directed to the merits of a rejection in an *ex parte* reexamination proceeding is ultimately appealable to the Board, and then to the courts. All matters not subject to appeal to the Board under 35 U.S.C. § 306 are subject to resolution by way of petition under 37 CFR 1.181. Further, 37 CFR 1.3 prohibits complaints about employee conduct to be included within the same papers addressing the merits of patentability. Therefore, the proper avenue for obtaining review of an allegation of procedural impropriety, misconduct or bias on the part of Office personnel would be through petition to appropriate Office officials (as pointed out above). Any decision on such a petition that is adverse to patent owner would be subject to court review in the same manner as any other question of administrative procedure would be reviewed. [14] It is not reasonable to state that the evidence **alleged** to support bias on the part of Office officials, and/or on the part of the examiner, should be placed into the record of the present merged reexamination proceeding before the examiner for review and evaluation by the examiner as part of a patentability determination.

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[11] See pages 3-4 of the present Petition for Reconsideration.

[12] See, for example, the headings on pages 4 and 7 of the present Petition for Reconsideration.

[13] See pages 7-9 of the present Petition for Reconsideration.

[14] Non-appealable subject matter reviewed by petition under 37 CFR 1.181 is subject to judicial review under the Administrative Procedures Act.

Further, some of the allegations of bias are directed to the conduct of the examiner, making it far from clear that the examiner could objectively evaluate the allegations of the examiner's own bias. Yet, as noted above, patent owner appears to have raised the argument that the evidence of examiner bias should be forwarded to the examiner for consideration. Such consideration has, to date, been refused solely on the basis that patent owner has filed a single paper that conflated and intermingled these issues, rather than filing two separate papers that are each directed only to the area of the Office that would properly consider only that paper. [15]

By way of expansion on the above discussion, patent owner is reminded that patent examiners are Office personnel who are charged with evaluating evidence bearing on questions of patentability. In the present merged reexamination proceeding, the examiner's consideration of patentability is limited by 35 U.S.C. §§ 301 - 303 to a consideration of prior patents and printed publications. [16] Examiners are not charged with evaluating evidence of impropriety, misconduct or bias, by examiners or other Office personnel. Also, until the patent owner's evidence and allegations of misconduct are properly evaluated by the appropriate Office personnel, they cannot have any affect on action taken by the Office.

As a final point, patent owner is not being deprived of due process by a refusal to accept papers that co-mingle allegations of misconduct (and documents supporting those allegations) with papers that are directed to other matters. Papers raising issues of alleged misconduct, and documents proffered in support of such allegation, are admissible in the Office, and can properly be submitted for consideration by the Office, but only if they are provided in a manner that complies with the regulations.

B. 37 CFR 1.3 and 37 CFR 1.4(c) Each Precludes The Relief Requested By Petitioner Patent Owner

It is manifestly clear that both 37 CFR 1.3 and 37 CFR 1.4(c) each prohibit patent owner from co-mingling arguments directed to issues of the patentability of the claims with arguments and evidence in support of allegations of procedural impropriety and bias on the part of Office personnel. Those allegations are as yet unproven, and cannot be properly considered to presently establish any basis for reassignment of examining responsibilities. This is not the same as concluding that the regulations preclude **the presentation** of evidence of bias, as patent owner argues, [17] (notwithstanding that the Office has never taken such position [18]). The Office is not refusing to consider patent owner's alleged evidence, but simply is requiring that patent owner's evidence and allegations be presented in accordance with its rules which require them to be directed to the appropriate Office personnel for consideration and evaluation.

To the extent that the present petition again presents the allegation that 37 CFR 1.3 is inapplicable because patent owner has not violated decorum or been discourteous in this proceeding, [19] and also cites case law that is alleged to establish that 37 CFR 1.3 is inapplicable on the facts in this proceeding, patent owner is reminded that the August 23, 2006 Decision on Petition was in no manner based upon patent owner's conduct. Rather, 37 CFR 1.3 was applied

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[15] Given that reexaminations are conducted with special dispatch, it is puzzling that patent owner has not seen fit to comply with the relatively straightforward and simple requirements of the 37 CFR 1.3 and 1.4(c) by filing two separate papers, since by doing so, patent owner would have immediately placed before the proper areas of the Office both the conduct issues and the substantive patentability issues for consideration by the appropriate Office personnel.

[16] Extrinsic evidence explaining the content of prior patents and printed publications may be considered as well.

[17] See page 5 of the present petition, last sentence in the paragraph bridging pages 4 and 5.

[18] See for example, Decision Dismissing Petition dated August 23, 2006, section II(B), items 1 and 4.

[19] See the present petition, beginning at the bottom of page 4 and running through page 5.

because it requires that complaints of misconduct on the part of examiners and Office personnel "must be made in correspondence separate from other papers." [20] This language manifestly includes, as part of the class of "other papers" in which complaints of misconduct may not be raised, "papers directed to the merits of claim patentability in any proceeding in which the misconduct is alleged to have occurred."

Moreover, none of the case law cited by patent owner at page 5 of the present petition supports patent owner's position that 37 CFR 1.3 has been misapplied. Here, the Office is not prohibiting the patent owner from submitting evidence regarding its allegations; rather, the Office is simply directing material to the appropriate Office official for review of patent owner's complaint in accordance with the requirements established by 37 CFR 1.3 that employee conduct complaints "must be made in correspondence separate from other papers." None of the cases relied upon by patent owner demonstrate that the Office may not enforce the clear language of 37 CFR 1.3 by requiring papers containing complaints about the conduct of Office officials and personnel to be filed separately from other papers related to the merits of patentability.

Patent owner's argument that 37 CFR 1.4(c) should not prohibit examiner consideration of the merits of patent owner's arguments regarding the existence of bias is similarly fatally flawed. First, 37 CFR 1.4(c) does not preclude consideration of the merits of patent owner's allegations of bias, impropriety or misconduct on the part of Office officials and employees. The record does not show that the Office has taken the position that the allegations raised by patent owner cannot or will not be considered. 37 CFR 1.4(c) merely directs the orderly manner in which such allegations, and the evidence in support of such allegations, must be presented to the Office - for consideration by the proper Office officials. In this instance, 37 CFR 1.4(c) applies, because it requires that matters such as questions of bias or inappropriate conduct by Office personnel, which matters are appropriate for consideration by an Office official in one particular area of the Office, be submitted in a paper *separately* from papers containing substantive patentability issues, which are properly decided by a different Office official of employee in a different area of the Office. As pointed out above, the patent examiner is not the proper Office official to consider and rule on patent owner's allegations of bias, impropriety and misconduct; and thus, such allegations and materials supporting such allegations, are not proper for inclusion in the IFW record as a part of papers otherwise directed to patentability issues. The fact that the "examiner" is one of the employees that is accused of misconduct further highlights the appropriateness of the procedural safeguards provided by the rules. Clearly, the employee accused of alleged misconduct cannot be the official who will decide the issue. Moreover, the rule protects the integrity of the file history by separating employee complaints from the merits of examination.

Thus, 37 CFR 1.4(c) precludes entry of the papers submitted as a part of the June 23, 2006 petition, because the regulation properly requires that:

> matters bearing on the determination of patentability in this proceeding, and
>
> matters directed to a determination of the propriety of the allegations of misconduct, bias or impropriety on the part of Office officials and the examiner

be submitted in separate papers inasmuch as these issues are decided by different Office officials/employees in different areas of the Office.

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[20] See Decision on Petition, August 23, 2006, page 7, first full paragraph.

C. 37 CFR 1.111 Precludes The Relief Requested By Patent Owner

37 CFR 1.111(b) provides that a response to a nonfinal Office action must, *inter alia*, specifically point out supposed errors in the examiner's action, and point out the specific distinctions believed to render the claims patentable over the prior art. The regulation does not provide for "further statements" that address matters other than the issues of patentability raised in the outstanding Office action. The failure of the April 28, 2006 patent owner submission to comply with 37 CFR 1.111(b) was discussed at pages 6-7 of the Decision Dismissing Petition dated August 23, 2006. It was pointed out that the April 28, 2006 patent owner submission was not confined to responding to the nonfinal Office action as required by 37 CFR 1.111(b), but instead intermingled matter directed to other issues (the issues of alleged misconduct on the part of Office personnel).

In the present petition patent owner has not directly addressed this point. To the extent that patent owner's general argument that the allegations of misconduct are in fact relevant to the issues of patentability, those arguments are wholly unpersuasive for the reasons set forth in Section III (A) above. Therefore, it is again concluded that the August 23, 2006 Decision Dismissing Petition properly refused entry of the April 28, 2006 patent owner as being non-compliant with 37 CFR 1.111(b).

## CONCLUSION

1. The October 23, 2006 patent owner petition is granted to the extent that the August 23, 2006 Decision Dismissing Petition has been fully reconsidered, and that the present decision will be designated as a final agency decision.

2. The October 23, 2006 patent owner petition is denied with respect to disturbing the holding of the August 23, 2006 Decision Dismissing Petition which refused to enter the papers attached to patent owner's June 23, 2006 Petition and which "returned" those papers.

3. A copy of this decision is being made of IFW record for the merged reexamination proceeding, and the decision will therefore appear in the IFW record of *ex parte* reexamination proceedings 90/006,492 and 90/006,679.

4. Telephone inquiries with regard to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or, in his absence, to the undersigned at (571) 272-7710.

5. This decision is a final agency action within the meaning of 5 U.S.C. § 704.

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

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February 22, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
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Paper No. 10

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(For Patent Owner)

MAILED

APR 0 1 2003

REEXAM UNIT

Enclosure: Patent Owner Petition and attachments filed March 14, 2003

| | | |
|---|---|---|
| In re Campana, Jr. et al. | : | |
| Reexamination Proceeding | : | DECISION DISMISSING |
| Control No. 90/006,493 | : | PETITION AND RETURNING |
| Initiated: December 26, 2002 | : | IMPROPER PAPER |
| For: U.S. Patent No. 5,819,172 | : | |

This is a decision on the March 14, 2003, patent owner petition entitled "PETITION PURSUANT TO 37 C.F.R. § 1.183 TO ENLARGE THE TWO MONTH TIME LIMIT FOR FILING A SUPPLEMENTAL PATENT OWNER'S STATEMENT PURSUANT TO 37 CFR § 1.530." The petition is before the Office of Patent Legal Administration for decision.

For the reasons set forth below, the petition is dismissed and is being returned along with this decision.

**REVIEW OF FACTS**

1. On December 26, 2002, reexamination was ordered for five of Patent Owner's patents. The order for reexamination was issued at the initiative of the Director of the United States Patent and Trademark Office under 37 CFR 1.520. The patents and their assigned control number are: 5,625,670 (90/006,491); 5,631,946 (90/006,492); 5,819,172 (90/006,493); 6,067,451 (90/006,494); and 6,317,592 (90/006,495). The present reexamination proceeding is reexamination control number 90/006,493.

2. On February 26, 2003, Patent Owner filed (a) a Patent Owner's Statement under Protective Order (Paper No. 3), (b) an Expert Declaration submitted under Protective Order (Paper No. 4), (c) a Declaration of Donald E. Stout pursuant to 37 CFR 1.131 (Paper No. 5), (d) a Declaration of Thomas J. Campana, Jr. pursuant to 37 CFR 1.131 (Paper No. 6), and (e) an Information Disclosure Statement under 37 CFR 1.555 (Paper No. 7).

3. On March 5, 2003, Patent Owner filed copies of date-stamped postcard receipts (Paper No. 8) evidencing the timely filing of the February 26, 2003, papers. The original papers which had been missing date-stamps were then date-stamped as received on February 26, 2003, pursuant to the evidence provided by Patent Owner.

4. On March 14, 2003, Patent Owner filed the present petition under 37 CFR 1.183 requesting "suspension of the two-month time limit set for the response to the Order for Reexamination" to permit entry of the *accompanying* "Supplemental Patent Owner's Statement Pursuant to 37 CFR 1.530"

5. On March 26, 2003, a "DECISION CONCERNING PAPERS FILED BY PATENT OWNER" was issued by the Technology Center 2600 Special Programs Examiner, stating that "the papers filed [February 26, 2003] under Protective Order have been removed from the envelopes and made of record."

6. The present file was then forwarded to the Office of Patent Legal Administration for a decision on the petition.

**DECISION**

37 CFR 1.540 states:

> No submissions other than the statement pursuant to § 1.530 and the reply by the *ex parte* reexamination requester pursuant to § 1.535 will be considered prior to examination.

The examination stage of the present proceeding has not yet begun, as a first Office action on the merits has not yet been issued. The present March 14, 2003, submission is not a "reply by the *ex parte* reexamination requester pursuant to § 1.535," since it is filed by the patent owner. Further, the submission is not a Patent Owner's statement pursuant to § 1.530, because the Patent Owner's statement pursuant to § 1.530 was already filed on February 26, 2003. Pursuant to 35 U.S.C. 304, the patent owner is

given a reasonable period "within which he may file **a statement**" [Emphasis added] on the question of patentability raised in the order for reexamination. There is no provision in the statute for more than one statement, i.e., there is no provision for a second statement to supplement the first statement.

Since the present March 14, 2003, submission is submission is not a "statement" nor a "reply," entry of same is barred under 37 CFR 1.540.

37 CFR 1.530(b) states:

> The order for *ex parte* reexamination will set a period of not less than two months from the date of the order **within which the patent owner may file a statement on the new question of patentability**, including any proposed amendments the patent owner wishes to make. [Emphasis Added]

Under 37 CFR 1.530(b), the Patent Owner may file the statement *only* within the period set therein. The period set in the December 26, 2002, order for *ex parte* reexamination was two months. Accordingly, the present March 14, 2003, submission would not be timely, even if it were a proper statement under 37 CFR 1.530.

In view of the above, the March 14, 2003, submission of Patent Owner's petition and the accompanying "Supplemental Patent Owner's Statement Pursuant to 37 CFR 1.530" is an improper submission under 37 CFR 1.530(b) and under 37 CFR 1.540. Accordingly, the submission will not be made of record in the reexamination file and is being returned herewith. MPEP 2267. See *In re Knight*, 217 USPQ 294 (Comm'r Pat. 1982); *Patlex Corp. v Mossinghoff*, 226 USPQ 985, 986 (Fed. Cir. 1985). This decision will, however, be made of record in the reexamination file.

As to petitioner's request to waive the rules pursuant to 37 CFR 1.183:

Patent Owner's request for "suspension of the two-month time limit set" in the order is, in effect, a request that the Director to waive the provisions of 37 CFR 1.530(b) and permit (1) entry of the instant petition and accompanying "Supplemental Patent Owner's Statement Pursuant to 37 CFR 1.530," and (2) consideration of same when the examiner issues the first Office action on the merits. A waiver of the requirement to file the statement within the two month time period (set in the order) will not, however, provide Patent Owner with the relief Patent Owner desires, since consideration of the March 14, 2003,

submission would still be barred under 37 CFR 1.540, because the present March 14, 2003, submission is not a "statement" nor a "reply" as discussed above.

Accordingly, Patent owner's petition is taken as a request to waive the provisions of 37 CFR 1.540 and permit entry of a submission other than a statement pursuant to § 1.530 and a reply pursuant to § 1.535.

In order for grant of a petition under 37 CFR 1.183, a petitioner must show (1) that there is an extraordinary situation (2) where justice requires waiver of the rule. *In re Sivertz*, 227 USPQ 255, 256 (Comm'r Pat. 1985). Petitioner Patent Owner has not show that either condition exists in this case.

The present March 14, 2003, submission, for which entry and consideration in the first Office action is requested, provides a paper that was presented in litigation related to the patent being reexamined, and discusses what Patent Owner believes to be the significance of that paper. If entry is not provided at this point, Patent Owner is free to re-submit the March 14, 2003, submission during the examination stage of the present proceeding, i.e., after the first Office action is issued. At that point, the submission would have an entry right and would be considered by the examiner. There is no showing in the petition that re-submission during the examination stage would prejudice Patent Owner as to the consideration of the information presented (in the submission) in a manner as to create an extraordinary situation where justice requires waiver of the provisions of 37 CFR 1.540. Accordingly, the relief provided by 37 CFR 1.183 is not appropriate in this instance, [1] and the present petition pursuant to 37 CFR 1.183 is dismissed.

**CONCLUSION**

1. The March 14, 2003, patent owner petition filed pursuant to 37 CFR 1.183 is dismissed, and it is being returned along with this decision.

---

[1] Note that the Office will not normally consider an extraordinary remedy when the rules already provide an avenue for obtaining the relief sought. *See Cantello v. Rasmussen*, 220 USPQ 664 (Comm'r Pat. 1982).

3. The reexamination file is being returned to Technology Center 2600 for storage until a reply under 37 CFR 1.535 is received, or the time for filing same expires, after which a first Office action on the merits is to be issued.

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

April 1, 2003
C:\kiva\kimpropa\6493_2nd.stm

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. |
|---|---|---|---|---|
| 90/006,680 and 90/006493 | 06/24/2003 | 5819172 | | 5439 |

803 7590 05/26/2004

EXAMINER

STURM & FIX LLP
206 SIXTH AVENUE
SUITE 1213
DES MOINES, IA 50309-4076

| ART UNIT | PAPER NUMBER |
|---|---|
| | |

DATE MAILED: 05/26/2004

#19

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

PTO-90C (Rev. 10/03)

CC: Third Party Requester, as attached

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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**DO NOT USE IN PALM PRINTER**

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

David L. Stewart
Allen, Dyer, Doppelt, Milbrath & Gilchrist, PA
255 S. Orange Avenue
Suite 1401
Orlando, FL 32801

# *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

90/006493 and

REEXAMINATION CONTROL NO. *90/006,680*.

PATENT NO. *5819172*.

ART UNIT *2600*.

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 PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No. 19

Sturm & Fix LLP
206 Sixth Avenue
Suite 1213
Des Moines, IA 50309-4076

For Patent Owner

David Stewart
Allen Dyer Doppelt Milbrath & Gilchrist, PA
255 S. Orange Avenue
Suite 1401
Orlando, FL 32801

For Third Party Requester

In re Campana et al.
Reexamination Proceeding
Control No.: 90/006,493
Filed: December 26, 2002
For: U.S. Patent 5,819,172

In re Campana et al.
Reexamination Proceeding
Control No.: 90/006,680
Filed: June 24, 2003
For: U.S. Patent 5,819,172

DECISION *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS

DECISION MAILED

The above noted reexamination proceedings are before the Director of Technology Center 2600 for consideration of merger of the proceedings under 37 CFR 1.56(c).

## BACKGROUND

1. Patent 5,819,172 issued on October 6, 1998.

2. On December 26, 2002, a Director Initiated Order for Reexamination was mailed to the Patent Owner as Control No. 90/006,493 ('493).

3. A Patent Owner's Statement was filed in the '493 proceeding on February 26, 2003.

4. A request for reexamination, Control No. 90/006,680 ('680) was filed by the Third Party Requester on June 24, 2003.

5. Reexamination was ordered on the '680 reexamination proceeding on September 3, 2003.

6. No Patent Owner Statement was filed in the '680 reexamination proceeding.

## DISCUSSION

37 CFR 1.565(c) states:

> "If reexamination is ordered while a prior reexamination is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under section 1.570".

## DECISION

**I.** Merger of Proceedings

In accordance with 37 CFR 1.565(c), the '493 and '680 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 all proceedings.

The Patent Owner is required to maintain the same claims and specification in both files.

**III.** Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action, which applies to both proceedings. All papers issued by the Office or filed by the Patent Owner must contain the identifying data for both proceedings and will be physically entered in each reexamination file which will be separately maintained. All papers filed by the Patent Owner must also consist of a single response, filed in duplicate, each bearing an original signature, for entry into each file. All papers filed by the Patent Owner must be served on the requestor and requestor will be sent copies of all papers mailed by the Office. See MPEP 2283.

A review of these reexamination files finds that both proceedings currently contain the same claims and specification and therefore the Patent Owner need not take any action.

The merged proceedings are being forwarded to the examiner for appropriate action. An Office action will be mailed in due course.

Andy Faile

Andy Faile, Acting Director
Technology Center 2600
Communications

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William Wright
STURM and FIX, LLP
206 Sixth Avenue
Suite 1213
Des Moines, IA 50309-4076

MAILED
JAN 17 2006
REEXAM UNIT

(For Patent Owner)

NOVAK DRUCE & QUIGG, LLP
1300 Eye Street NW
400 East Tower
Washington, DC 20005

(For Requester)

In re Thomas J. Campana, Jr. et al.
*Inter partes* Reexamination Proceeding
Control No. 90/006,493
Filed: December 26, 2002
For: U.S. Patent No. 5,819,172

In re Thomas J. Campana, Jr. et al.
Director Ordered
*Ex parte* Reexamination Proceeding
Control No. 90/006,680
Filed: June 24, 2003
For: U.S. Patent No. 5,819,172

DECISION GRANTING PETITION
FOR EXTENSION OF TIME

This is a decision on the January 12, 2006, patent owner petition titled "REVISED PETITION FOR THE OFFICE TO FOLLOW ANNOUNCED POLICY AND PROVIDE EQUAL TREATMENT TO PATENT OWNER BY GRANTING A TWO-MONTH PERIOD OF TIME TO RESOND TO THE OFFICE ACTION DATED DECEMBER 30, 2005 " The present petition (1) urges that a two month period should have been set by the Office Action of December 30, 2005, and should be re-set accordingly, and (2) revises its request for an additional month to respond to the Office Action of December 30, 2005, to thereby extend the deadline for response to be February 28, 2006.

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

The petition is granted as to the request for an additional month to respond to the Office Action of December 30, 2005, for the reasons set forth below.

The petition is dismissed as to the request that the time period set in the Office action be reset, since such request is now moot for the reasons set forth below.

## DISCUSSION

The patent owner on January 03, 2006, submitted a petition that urged that a two month period should have been set by the Office Action of December 30, 2005, and should be re-set accordingly, and (2) requested an additional month to respond to the Office Action of December 30, 2005, to thereby extend the deadline for response to be February 28, 2006. The January 03, 2006 petition for extension of time was accompanied by an authorization to debit a deposit account, accordingly the $200.00 petition fee required by 37 CFR 1.515(c) has been charged to Account No. 05-02-06. Thus, the appropriate fee has been paid.

The instant revised petition seeks an additional month in which to file a response to the Office action dated December 30, 2005, which action set a one month date for filing a response thereto. The Office action in question is a non-final action.

37 CFR 1.550 (c ) states:

> (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.

Addressing the requirement of 37 CFR 1.550 (c) to make a showing of "sufficient cause" to grant an extension of time request, MPEP 2265 states, in pertinent part:

> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. 305) 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 patent owner in this revised request, positively states that its expert, Dr. Rhyne, will be available the week of January 30 , 2006, to work on the response for the above identified proceedings. In addition the patent owner states that "With the extremely short availability window Dr. Rhyne presently has, an additional month is needed to accomplish that without seriously prejudice to NTP's ability to present all of the facts necessary to make its record."

Patent owner further states in the renewed petition for extension of time that the option of engaging another expert instead of Dr. Rhyne has been considered, but at present, patent owner has determined that this option is unrealistic and impractical. The renewed petition states that, aside from Dr. Rhyne's familiarity evaluating the patent that is the subject of this merged reexamination proceeding and other related patents, any other expert having the appropriate qualifications who might be found would need to spend several weeks, or perhaps months, getting up to the level of understanding of the Campana patents and the art generally that equals Dr. Rhyne's.

It is considered that the renewed petition expressly states the steps taken by patent owner, and expressly states when Dr. Rhyne will be available to provide an analysis and formulate an expert opinion on the instant proceedings, thereby providing sufficient basis as to why an extension of time should be granted. Thus, when balancing the needs for special dispatch with the need to provide the patent owner with an opportunity to have its expert evaluate the response of record it has been determined that the need for the expert, at this time and under the instant circumstances, contravenes the requirement for "special dispatch." However, the patent owner is advised that unavailability of Dr. Rhyne beyond the deadline as extended by one month, or the difficulty of securing the services of a second expert meeting patent owner's criteria, and the difficulty of bringing a second expert "up to speed" in advance of the time necessary to prepare a response by the deadline, as extended by one month, will **not** be considered to present a compelling reason establishing an extraordinary situation in support of the grant of a second extension of time.

## DECISION

I. For the reasons stated above, the petition has established sufficient cause to extend the time period, and is granted.

II. Since the petition has been granted for an extension for one month of time, the patent owner request that the time period set in the Office action be reset is dismissed as moot, and need not be addressed further in this decision.

III. Future requests for extensions of time will be strictly evaluated for compliance with 37 CFR 1.550. In light of the length of the pendency of this proceeding and the similar issues shared with other pending proceedings, future petitions for extension of time will be granted only upon a showing of sufficient cause that takes into account the related reexamination proceedings and the statutory requirement that reexamination proceedings must be conducted with "special dispatch."

## CONCLUSION

1. The petition is granted as to the request for an additional month to respond to the Office Action of December 30, 2005. The patent owner's period for response set in the December 30, 2005 Office action is hereby extended to expire on February 28, 2006.

2. The petition is dismissed as to the request that the time period set in the Office action be reset, since such request is now moot.

3. Patent owner is reminded that following the Office's prior guidance on where to submit papers may avoid delays in processing future on. **Future correspondence is to be submitted via one of the following options**:

By Mail to: Mail Stop *Inter Partes* 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
Attention: Central Reexamination Unit
Randolph Building
401 Dulany St.
Alexandria, VA 22314

4. Telephone inquiries with regard to this decision should be directed to Mark Reinhart of the Central Reexamination Unit Art Unit at (571)-272-1611, and in his absence to the undersigned at (571) 272-1596.

Lissi Mojica Marquis, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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William R. Wright
STUM & FIX LLP
206 Sixth Avenue
Suite 1213
Des Moines, IA 50309-4076

(For Patent Owner)

MAILED
MAR 01 2006
REEXAMINATION

Donald J. Quigg
NOVAK DRUCE DELUCA & QUIGG LLP
1300 Eye Street N. W.
400 East Tower
Washington, DC 20005

(For Third Party Requester)

In re Thomas J. Campana, Jr. *et al*
Reexamination Proceeding
Control No. 90/006,493
Filed: December 26, 2002
For U.S. Patent No.5,819,172

In re Thomas J. Campana, Jr. *et al*
Reexamination Proceeding
Control No. 90/006,680
Filed: June 24, 2003
For U.S. Patent No. 5,819,172

In re Thomas J. Campana, Jr. *et al*
Reexamination Proceeding
Control No. 90/007,735
Filed: September 28, 2005
For U.S. Patent No. 5,819,172

DECISION,
*SUA SPONTE,*
MERGING
REEXAMINATION
PROCEEDINGS
PURSUANT TO
37 C.F.R. § 1.565(c)

The above-identified reexamination files are before the Director of the Central Reexam Unit 3999, for consideration of merger of reexamination control number 90/007,735 (the '735 proceeding) with the previously merged reexamination control numbers 90/006,493 (the '493 proceeding) and 90/006,680 (the '680 proceeding) pursuant to 37 C.F.R. § 1.565(c).

## BACKGROUND

1. Patent No. 5,819,172 issued on October 6, 1998.

2. The '493 reexamination proceeding is a Director Ordered reexamination proceeding that was ordered on December 26, 2002.

3. The '680 reexamination proceeding, filed on June 24, 2003, is a reexamination proceeding that was requested by a third party requester.

4. An order granting reexamination in the '680 reexamination proceeding was mailed on September 3, 2003.

5. The '493 and '680 proceedings were merged to provide a single consolidated proceeding on May 26, 2004.

6. A non-final Office action was mailed on June 21, 2005 in the previously merged proceedings.

7. A response to the June 21, 2005, Office action was timely filed on August 22, 2005. The response added claims 224 to 294 to the merged proceedings. However, the amendment was canceled following notification of fee deficiency in the Interview Summary mailed on November 18, 2005.

8. An amendment with proper fee was filed on November 25, 2005 in the '493 and '680 reexamination proceedings. The amendment canceled claims 224 to 294 and added claims 295 to 317.

9. A non-final Office action was mailed on December 30, 2005 in the previously merged proceedings.

10. The '735 proceeding was filed on September 28, 2005 by a third party requester.

11. The third party requester's correspondence address is the same in the '680 and '735 proceedings.

12. An order granting reexamination in the '735 reexamination proceeding was mailed on October 14, 2005.

13. There are no amendments to the '735 reexamination proceeding.

# 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 , *supra*, reexamination was previously ordered in the '493 and '680 reexamination proceedings, and these proceedings have previously been merged. Reexamination has been ordered in the '735 proceeding.

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 90/006,493, 90/006,680 and 90/007,735 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 '6,493 and '6,680 reexamination proceeding. Patent owner is required to maintain the same claims and specification in all merged 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.

## 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. 90/006,493, 90/006,680 and 90/007,735 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.

All correspondence regarding these proceedings should 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

Telephone inquiries with regard to this decision should be directed to Mark Reinhart, Special Program Examiner in the Central Reexamination Unit, Art Unit 3992, at (571) 272-1611

M Reinhart SPRE-CRU-3992 for
Lissi M. Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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William R. Wright
Sturm & Fix LLP
206 Sixth Avenue
Des Moines, IA 50309-4076

(For Patent Owner)

Novak Druce & Quigg LLP
1300 Eye Street NW
Suite 400 East Tower
Washington, DC 20005

(For Third Party Requester)

MAILED

AUG 23 2006

CENTRAL REEXAMINATION UNIT

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/006,493
Filed: December 26, 2002
For: U.S. Patent No. 5,819,172

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No. : 90/006,680
Filed: June 24, 2003
For: U.S. Patent No. 5,819,172

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/007,735
Filed: September 28, 2005
For: U.S. Patent No. 5,819,172

**DECISION, *SUA SPONTE*, DISMISSING PETITION AND "RETURNING" IMPROPER PAPERS**

This is a decision on the June 23, 2006 patent owner petition styled "Petition Pursuant to 37 CFR 1.181 or Alternatively, 37 CFR 1.182 OR Alternatively 37 CFR 1.183 to Reconsider Decision Returning Paper and Enter the Papers into the Official Record." [1]

The petition and the above-captioned reexamination proceedings are before the Office of Patent Legal Administration for consideration.

The petition is dismissed and its attachments are returned to the patent owner for the reasons discussed below.

[1] The present petition is, facially, fully treatable pursuant to the provisions of 37 CFR 1.181. Accordingly, it is manifestly unnecessary to consider the petition under either 37 CFR 1.182 or 37 CFR 1.183. No fee is required.

## REVIEW OF SALIENT FACTS

1. U.S Patent number 5,819,172 ("the '172 patent") issued to Campana *et al* on October 6, 1998 from an application filed on April 23, 1997.

2. On December 26, 2002, a Director Initiated Order for Reexamination of the '172 patent mailed and assigned control number 90/006,493 ("the '493 reexamination proceeding").

3. On June 24, 2003, a request for ex *parte* reexamination of the '172 patent was filed by a third party requester, and assigned control number 90/006,680 ("the '680 reexamination proceeding").

4. On September 3, 2003, the examiner's Order Granting *Ex Parte* Reexamination for the '680 reexamination proceeding was mailed.

5. On May 26, 2004, the Technology Center Director issued a decision, *sua sponte*, by which the '493 reexamination proceeding and the '680 reexamination proceeding were merged into a single combined reexamination proceeding.

6. On September 28, 2005, a third request for *ex parte* reexamination of the '172 patent, which was assigned control number 90/007,735 ("the '735 reexamination proceeding").

7. On October 14, 2005, the examiner's Order Granting *Ex Parte* Reexamination for the '735 reexamination proceeding was mailed.

8. Following prosecution on the patentability of the '172 patent claims, a nonfinal rejection Office action was issued in the merged reexamination proceeding on December 30, 2005.

9. On January 4, 2006, a Freedom of Information Act ("FOIA") Request was made to the Office requesting the Office's communications with third parties regarding the present reexamination proceedings and pending reexamination proceedings being conducted on other of patent owner's patents.

10. The Office responded to the FOIA request through letters dated between February 8 and March 24, 2006. [2]

11. On February 28, 2006, patent owner filed a response to the nonfinal Office action of December 30, 2005.

12. On March 1, 2006 The Central Reexamination Unit (CRU) Director issued a decision, sua sponte, by which the "'493 reexamination proceeding, the '680 reexamination proceeding and the '735 reexamination proceeding were merged into a single merged reexamination proceeding. [3],[4]

---

[2] An additional response to the FOIA request was mailed by the Office on June 15, 2006 and received by patent owner on June 16, 2006.

[3] Jurisdiction of the merged '493 and '680 reexamination proceedings had previously been transferred from the Technology Center to the CRU.

[4] The Image File Wrapper (IFW does not contain a copy of the February 28, 2006 response to the nonfinal Office action of December 30, 2005, notwithstanding the requirement in the March 1, 2006 decision merging the three reexamination proceedings that patent owner file a housekeeping amendment and maintain all three files identically.

13. On April 28, 2006, patent owner filed a supplemental amendment/response to the December 30, 2005 nonfinal Office action.

14. On May 17, 2006, the CRU Director mailed a decision returning the April 28, 2006 patent owner supplemental response to the nonfinal rejection noted in Fact 13 above without consideration on the merits. The return was based on the grounds that the papers filed were improper because they were not limited to consideration of prior patents and printed publications and also because portions were not in compliance with the 37 CFR 1.3 requirements for decorum and courtesy. Accordingly, the returned supplemental response was not entered into the record.

15. On May 22, 2006, patent owner filed a redacted version of the April 28, 2006 supplemental response, limited to material addressing the outstanding nonfinal rejection Office action, which has been entered into the IFW record.

16. On June 23, 2006, patent owner filed the present petition requesting reconsideration of the CRU Director's May 17, 2006 decision. Patent owner has attached to the petition the material that was refused entry and returned (by the CRU Director's May 17, 2006 decision), for entry into the record as part of patent owner's supplemental response to the February 28, 2006 nonfinal Office action.

## DECISION DISMISSING THE THIRD PARTY REQUESTER PETITION AND RETURNING PAPERS FILED WITH THE PETITION

### I. Relevant Statutes, Regulations and Practice

35 U.S.C. § 132 provides:

> "(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.
>
> (b) The Director shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant. The Director may establish appropriate fees for such continued examination and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under section 41(h)(1) of this title."

35 U.S.C. § 305 provides, in part:

> "After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent."

35 U.S.C. § 306 provides:

> "The patent owner involved in a reexamination proceeding under this chapter may appeal under the provisions of section 134 of this title, and may seek court review under the provisions of sections 141 to 145 of this title, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent."

37 CFR 1.3 provides:

"Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Director and will not be entered. A notice of the non-entry of the paper will be provided. **Complaints against examiners and other employees must be made in correspondence separate from other papers.**" [Emphasis added.]

37 CFR 1.4(c) provides:

"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."

37 CFR 1.111(b) provides:

"In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section."

37 CFR 1.181(a)(1) provides that petition may be taken to the Director:

"**From any action** or requirement of any examiner in the ex parte prosecution of an application, or **in ex parte** or inter partes prosecution **of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court.**" [Emphasis added.]

37 CFR 1.550(a) and (b) provide, in part:

> "(a) All *ex parte* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office. **After issuance of the *ex parte* reexamination order and expiration of the time for submitting any responses, the examination will be conducted in accordance with §§ 1.104 through 1.116** and will result in the issuance of an *ex parte* reexamination certificate under § 1.570. [Emphasis added.]
>
> (b) The patent owner in an *ex parte* reexamination proceeding will be given at least thirty days to respond to any Office action. **In response to any rejection,** such response may include further statements and/or proposed amendments or new claims to place the patent in a condition where all claims, if amended as proposed, would be patentable." [Emphasis added.]

MPEP § 2267 provides in part:

> "The return of inappropriate submissions complies with the regulations that certain papers will not be considered and also reduces the amount of paper which would ultimately have to be scanned into the record.
>
> I. DISPOSITION OF PAPERS
> Where papers are filed during reexamination proceedings which are inappropriate because of some defect, such papers will either be returned to the sender or forwarded to one of three files, the "Reexamination File" (paper file or IFW file history), the "Patent File" (paper file or IFW file history), or the "Storage File" (paper file). Any papers returned to the sender from a Technology Center (TC) must be accompanied by a letter indicating signature and approval of the TC Director." [5]

## II. Findings and Analysis

On February 28, 2006, patent owner filed a response to the nonfinal action dated December 30, 2005. On April 28, 2006, patent owner thereafter filed a supplemental response to the nonfinal action dated December 30, 2005. That paper was returned to patent owner by the decision of the CRU Director dated May 17, 2006, on the grounds that the supplemental response was an improper paper. The basis of this holding was that the supplemental response included statements and documents that were improper because they were not limited to consideration of prior patents and printed publications, and also because portions were not in compliance with 37 CFR 1.3 requirements for decorum and courtesy. Patent owner was invited, in the May 17, 2006 decision returning papers, to submit a redacted supplemental response, and patent owner has in fact filed a redacted version of that supplemental response (the redacted version has been entered into the record).

Patent owner has now attached to the present petition a set of papers to be added to the record as a part of a supplemental response to the December 30, 2005 nonfinal action, which would be available for the examiner's consideration in evaluating the patent owner's supplemental response. Patent owner requests by way of the present petition that these papers be entered into the IFW record to provide a complete administrative record. [6] It is patent owner's position that:

(1) There was no legal basis for the CRU Director's return of the April 28, 2006 supplemental response papers;

(2) The grounds for such return as expressed in the CRU Director's decision returning the papers were erroneous;

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[5] When the CRU has jurisdiction, as in the case of this merged proceeding, the CRU Director would approve and sign the letter accompanying returned papers.

[6] This would result in the commingling of the now-proffered set of papers with material that the examiner will have to consider.

(3) The patent owner is entitled to argue and provide documents to allege that the December 30, 2005 nonfinal action is an improper action based on allegations of misconduct and bias.

(4) Due process requires that the Office accept the unredacted supplemental response and related FOIA evidence. [7]

It is also noted that patent owner argues that the CRU Director's decision returning the April 28, 2006 supplemental response to the nonfinal action dated December 30, 2005 was inconsistent with a prior petition decision dated March 20, 2006 denying a patent owner petition filed on January 23, 2006. [8] This argument will be separately addressed, *infra.*

A. The April 28, 2006 Supplemental Response Was An Improper Paper, The Supplemental Response Attached To The Present Petition Is An Improper Paper, And Both Papers Lack An Entry Right In The Merged Reexamination Proceeding

Pursuant to 35 U.S.C. § 306, an issue directed to the merits of a rejection in an *ex parte* reexamination proceeding is ultimately appealable to the Patent and Trademark Office Board of Patent Appeals and Interferences. On the other hand, pursuant to 37 CFR 1.181(a), a petition to the USPTO Director is the appropriate vehicle to resolve matters not subject to appeal. It is further to be noted that, pursuant to 37 CFR 1.4(c), different matters raised in a given proceeding must be raised in separate papers. Finally, pursuant to 37 CFR 1.3, complaints against examiners and other Office employees "must be made in correspondence separate from other papers" which are not directed to complaints against examiners and other Office employees.

In the present instance, a review of the papers attached to the present petition indicates that (1) the papers are essentially the same as, if not identical to, the papers that were returned by the CRU Director's May 17, 2006 decision, and (2) these papers purport to be a supplemental response to the examiner's treatment of the pending claims in light of the prior art patents and publications applied to the claims by the examiner in the nonfinal action dated December 30, 2005. Pursuant to 37 CFR 1.550(a) (the rule that implements 35 U.S.C. § 305), *ex parte* reexamination proceeding is "conducted in accordance with [37 CFR] §§ 1.104 through 1.116." Therefore, the appropriate content of a 37 CFR 1.550(b) response to a nonfinal Office action in an *ex parte* reexamination proceeding is defined by 37 CFR 1.111. Subsection (b) of 37 CFR 1.111 does not (contrary to petitioner's argument) provide for "further statements" that are unrestricted as to content. Instead, 37 CFR 1.111(b) requires that a response to a nonfinal action address the issue of patentability of the pending claims with respect to the outstanding rejection, which, in this instance, is the examiner's treatment of the patentability of the claims in light of prior patents and printed publications. In contrast, the papers attached to the present petition include material directed to issues other than the examiner's treatment of the patentability of the claims in light of prior patents and printed publications. In fact, large portions of the remarks contained in the supplemental response to the nonfinal action [9] and documents cited in support are directed to the conduct of Office employees/officials. Thus,

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[7] Petition at pages 10 *et. seq.*

[8] The petition and decision thereon referenced by patent owner are apparently those in the file records of *ex parte* reexamination control number 90/006,495 and *inter partes* reexamination proceeding 95/000,020, which have been merged into a single reexamination proceeding.

[9] See, *e.g.*, the arguments at page 74-92 of the supplemental response. Note that even a single instance of an argument directed to matters that are not part of a proper response to a nonfinal action within the meaning of 37 CFR 1.111(b) would suffice to preclude entry of the entire supplemental response as lacking an entry right.

large portions of the papers attached to the present petition, are not directed to issues of patentability of the pending claims in light of the applied prior art patents and printed publications. Therefore, these papers clearly constitute responses to the outstanding nonfinal Office action that are not proper under 37 CFR 1.550(b) and do not fall within the jurisdiction of the examiner. Accordingly, each of these papers submitted in response to the Office action lacks an entry right in the present merged reexamination proceeding for consideration by the examiner.

Further, 37 CFR 1.3 expressly precludes "complaints against examiners and other employees" submitted as part of papers directed to other matters. Thus, the patent owner's submission of documents in support of its allegations of misconduct and bias could not properly be included with papers directed to the question of patentability in view of prior art, because the clear and unequivocal language of 37 CFR 1.3 expressly requires that "employee conduct" issues are to be raised in correspondence separate from other papers. Here, patent owner improperly raises allegations of employee misconduct incorporated within papers directed to the merits of the examiner's position on the patentability of the pending claims in light of patents and printed publications as set forth in the nonfinal Office action. Therefore, the originally filed April 28, 2006 supplemental response and the supplemental response attached to the present petition are both improper for the reason that they fail to comply with the requirements of 37 CFR 1.3. Accordingly, each paper further lacks an entry right in the present merged reexamination proceeding for consideration by the examiner.

Moreover, 37 CFR 1.4(c) requires that different matters in a given proceeding appropriate for consideration by different branches within the Office must be raised in separate papers. However, patent owner's April 28, 2006 supplemental response to the nonfinal action improperly presented, in the same paper, both:

> (1) arguments and materials directed to the patentability of the claims in view of the patents and printed publications applied in the nonfinal Office action, and
>
> (2) allegations of employee misconduct and bias.

The patentability arguments are properly considered by the examiner. In contrast, allegations of employee misconduct and bias are considered by way of a petition to the appropriate Office official for the exercise of supervisory authority pursuant to 37 CFR 1.181(a), because alleged employee misconduct and bias relate to non appealable subject matter. Thus both the originally filed April 28 2006 supplemental response as well as the supplemental response attached to the present petition are improper for the additional reason that they fail to comply with the requirements of 37 CFR 1.4(c).

Therefore, for the foregoing reasons, the April 28, 2006 patent owner supplemental response, and the June 23, 2006 supplemental response attached to the present patent owner petition are deemed improper. Therefore these papers lack an entry right in the present merged reexamination proceeding. The disposition of improper papers will be treated as discussed in Section C., *infra.*

B. Further Discussion

1. While the patent owner's April 28, 2006 supplemental response to the December 30, 2005 nonfinal action and the supplemental response to the nonfinal action attached to the present petition each lack an entry right for consideration by the examiner as explained in Section II(A),

patent owner may raise the issue of alleged employee misconduct by way of petition under 37 CFR 1.181(a). Note is taken of patent owner's statement that on March 20, 2006, the Office issued a decision in a separate proceeding, such decision denying a patent owner petition filed on January 23, 2006. [10] Patent owner correctly states that the January 23, 2006 petition was denied because it did not provide sufficient details. However, if patent owner is able to now supply those details, they must be submitted in a separate petition under 37 CFR 1.181, but cannot be submitted as part of a paper submitted for consideration by the examiner.

2. Patent owner's characterization of the May 17, 2006 decision issued by the CRU Director returning the April 28, 2006 supplemental response to the nonfinal Office action of December 30, 2005 is not wholly accurate. In actuality, the CRU Director's May 17, 2006 decision did not mean to imply that the FOIA papers would be barred from submission for any and all purposes. Rather, it properly points out that the papers were returned because they raised issues unrelated to patentability and therefore are not appropriate for consideration by the examiner. Therefore, the submitted papers did not comply with the regulations and practice regarding the submission of response papers. [11]

3. To the extent that patent owner disagrees with some or all of the rationale set forth in support of the CRU Director's decision, Section II(A) of the present decision amplifies the reasons in support of the conclusion reached in the CRU Director's May 17, 2006 decision to refuse entry and return the April 28, 2006 supplemental response with attached papers. Section II(A) of the present decision explains that the patent owner may indeed raise alleged employee misconduct and bias issues, but must do so via a separate petition under 37 CFR 1.181. Such a petition must conform to the governing regulations and practice, i.e., the petition regarding alleged employee misconduct must not be attached to papers directed to the substantive issue of claim patentability in light of the prior patents and printed publication. See 37 CFR 1.3 and 37 CFR 1.4(c).

4. As a final point on this matter, patent owner is not being deprived of due process by a refusal to accept papers that mingle allegations of misconduct (and documents supporting those allegations) with papers that are directed to other matters. Papers raising issues of alleged misconduct, and documents proffered in support of such allegation, are admissible in the Office only if they are provided in a manner that complies with the regulations.

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[10] See footnote 8, *supra*.

[11] Considering the fact that the papers in question were styled as a supplemental response to the nonfinal Office action, the material beginning at the last paragraph of page 2 of the May 17, 2006 CRU Director's decision and running through page 3 thereof indicates to the undersigned that the CRU Director was concerned with the mingling of prior art patent and printed publication patentability issues with the procedural issues raised by the allegations of misconduct and bias of raised in papers.

C. Disposition Of Papers

1. In this instance: (1) the April 28, 2006 presentation of the FOIA papers, (2) the April 28, 2006 declaration of Keith Anderson directed the FOIA papers, and (3) the remarks directed to the conduct of Office employees/officials that were included within the April 28, 2006 supplemental response to the nonfinal action have previously been found to be improper, and lacking an entry right in the present merged proceeding. These papers were previously returned, and a redacted form of these papers was entered into the record, as discussed above.

2. In addition, the patent owner has attached to the present petition the material that was refused entry and returned (by the CRU Director's May 17, 2006 decision), for entry into the record as part of patent owner's supplemental response to the December 30, 2005 Office action. These papers have now been found to be improper and therefore lack an entry right in the present merged proceeding to which they are directed. As these papers are determined to lack an entry right in the present merged reexamination proceeding, they will be returned in accordance with provisions of MPEP § 2267. In this instance it would be unduly burdensome to either physically return the large bulk of papers, or expend significant Office resources scanning the documents into the record and then closing them from view. [12] Therefore, the papers are being temporarily held for "pick up" in the Central Reexamination Unit (CRU). If the patent owner desires the physical return of the papers, then patent owner should promptly make arrangements to pick up the papers from the CRU **within one month** of the mailing date of this decision. Patent owner should immediately notify Norma Amador of the CRU, at telephone number (571) 272-6474, of any arrangements that have been made to pick up the papers. If the papers are **not** picked up **within one month** of the mailing date of this decision, **the CRU will dispose of the papers**, note being taken that the patent owner presumably has the originals.

3. As to the present petition, the petition contains facial allegations of employee misconduct and bias. Accordingly, though the petition itself will be retained of record in the IFW file, it is being marked as "non-public."

## CONCLUSION

1. The June 23, 2006 patent owner petition is dismissed.

2. The (1) the April 28, 2006 presentation of the FOIA papers, (2) the April 28, 2006 declaration of Keith Anderson directed the FOIA papers, and (3) the remarks directed to the conduct of Office employees/officials that were included within the April 28, 2006 supplemental response to the nonfinal action have been found to be improper papers lacking an entry right in the present merged proceeding to which they are directed. These papers were proper returned to patent owner.

3. The papers attached to the present petition, which appear to be the material that was refused entry and returned by the CRU Director's May 17, 2006 decision will be held for one month in the CRU in a single storage location, and thereafter will be discarded if not picked up by patent owner.

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[12] Patent owner has filed at least six other petitions corresponding to the present petition, and provided such papers as attachments to each filed petition.

4. The present petition will be retained of record in the IFW file and is being marked as "non-public."

5. A copy of this decision is being made of record in the merged reexamination proceeding, and the decision will therefore appear in the IFW record of *ex parte* reexamination proceedings 90/006,493, 90/006,680 and 90/007,735.

6. **All correspondence relating to an *inter partes* reexamination proceeding should be directed to:**

By Mail to: Mail Stop *Ex Parte* Reexam
ATTN: 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) 273-9900
Central Reexamination Unit

By hand: Customer Service Window
ATTN: Central Reexamination Unit
Randolph Building
401 Dulany St.
Alexandria, VA 22314

8. Telephone inquiries with regard to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or, in his absence, to the undersigned at (571) 272-7710.

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

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August 9, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

Novak Druce & Quigg LLP
1300 Eye Street NW
Suite 400 East Tower
Washington, DC 20005

(For Third Party Requester)

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/006,493 ✓
Filed: December 26, 2002
For: U.S. Patent No. 5,819,172

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/006,680 ✓
Filed: June 24, 2003
For: U.S. Patent No. 5,819,172

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/007,735 ✓
Filed: September 28, 2005
For: U.S. Patent No. 5,819,172

**DECISION DENYING PETITION**

This is a decision on the October 23, 2006 patent owner petition styled "Petition Pursuant to 37 CFR 1.181 or Alternatively, 37 CFR 1.182 Or Alternatively 37 CFR 1.183 to Reconsider Decision, *Sua Sponte*, 'Returning' Improper Papers and Alternatively That the Commissioner Declare His Decision A Final Agency Action." [1,2]

The petition and the above-captioned reexamination proceedings are before the Office of Patent Legal Administration for consideration.

[1] The present petition paper is fully treatable pursuant to 37 CFR 1.181, and it is thus unnecessary to consider the petition paper under either 37 CFR 1.182 or 37 CFR 1.183. A petition fee is not required.
[2] The present paper will hereinafter be referred to as "Petition for Reconsideration."

The petition is granted to the extent that (1) the "Decision, *Sua Sponte*, Dismissing Petition and 'Returning' Improper Papers" [3] dated August 23, 2006, has been reconsidered, and (2) the present decision has been designated as a final agency action under 35 U.S.C. § 704. For the reasons discussed below, the underlying relief requested by petitioner patent owner is denied.

## REVIEW OF SALIENT FACTS

1. U.S Patent number 5,819,172 ("the '172 patent") issued to Campana *et al* on October 6, 1998, from an application filed on April 23, 1997.

2. On December 26, 2002, a Director Initiated Order for Reexamination of the '172 patent was mailed. The resulting *ex parte* reexamination proceeding was assigned control number 90/006,493 ("the '493 reexamination proceeding").

3. On June 24, 2003, a request for a second ex *parte* reexamination of the '172 patent was filed by a third party requester, and the resulting proceeding was assigned control number 90/006,680 ("the '680 reexamination proceeding").

4. On September 3, 2003, an examiner's Order Granting *Ex Parte* Reexamination was mailed for the '680 reexamination proceeding.

5. On May 26, 2004, the Technology Center Director issued a decision, *sua sponte*, by which the '493 reexamination proceeding and the '680 reexamination proceeding were merged into a single consolidated reexamination proceeding.

6. On September 28, 2005, a request for a third *ex parte* reexamination of the '172 patent was filed. The resulting proceeding was assigned control number 90/007,735 ("the '735 reexamination proceeding").

7. On October 14, 2005, the examiner's Order Granting *Ex Parte* Reexamination was mailed for the '735 reexamination proceeding.

8. On December 30, 2005, a nonfinal rejection Office action was issued in the merged '493 - '680 reexamination proceeding.

9. On January 4, 2006, a Freedom of Information Act ("FOIA") Request was made to the Office requesting the Office's communications with third parties regarding the present reexamination proceedings, as well as pending reexamination proceedings being conducted on other of patent owner's patents.

10. The Office responded to the FOIA request through letters dated between February 8 and March 24, 2006. [4]

11. On February 28, 2006, patent owner filed a response to the nonfinal Office action of December 30, 2005.

12. On March 1, 2006, the Central Reexamination Unit (CRU) Director issued a decision, *sua*

[3] Hereinafter "Decision Dismissing Petition."

[4] An additional response to the FOIA request was mailed by the Office on June 15, 2006, and received by patent owner on June 16, 2006.

*sponte*, by which the "493 reexamination proceeding, the '680 reexamination proceeding and the '735 reexamination proceeding were merged into a single consolidated reexamination proceeding. [5]

13. On April 28, 2006, patent owner filed a supplemental amendment/response to the December 30, 2005 nonfinal Office action.

14. On May 17, 2006, the CRU Director mailed a decision returning the April 28, 2006 patent owner supplemental amendment/response to the nonfinal rejection without consideration on the merits. The return was grounded on the impropriety of the papers, because they were not limited to consideration of prior patents and printed publications, and also because portions of the submission were not in compliance with the requirements of 37 CFR 1.3. Accordingly, the returned supplemental response was not entered into the record.

15. On May 22, 2006, patent owner filed a redacted version of the April 28, 2006 supplemental amendment/response, which is limited to material addressing the outstanding nonfinal rejection Office action, and which has been entered into the IFW record for the merged proceeding.

16. On June 23, 2006, patent owner filed a petition requesting reconsideration of the CRU Director's May 17, 2006 decision. Patent owner attached to the petition the material that had been refused entry and returned (by the CRU Director's May 17, 2006 decision), and requested entry of that material into the record, as part of patent owner's supplemental response to the December 30, 2005 nonfinal Office action.

17. On August 23, 2006, the June 23, 2006 patent owner petition was dismissed, [6] and was "returned" to petitioner by permitting petitioner to schedule a time to pick up the material (together with similar material from other concurrently filed related petitions). [7]

18. On October 23, 2006, petitioner patent owner filed the present Petition for Reconsideration of the August 23, 2006 petition decision.

## DECISION

### I. Relevant Statutes, Regulations and Practice

35 U.S.C. § 132 provides:

> "(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.
>
> (b) The Director shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant. The Director may establish appropriate fees for such continued

[5] Jurisdiction of the merged '493 and '680 reexamination proceedings had previously been transferred from the Technology Center to the CRU.

[6] See discussion at pages 5-7, *infra*.

[7] No such pick up was scheduled, and none was made.

examination and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under section 41(h)(1) of this title."

35 U.S.C. § 301 provides in pertinent part:

"Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent."

35 U.S.C. § 302 provides 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. § 303(a) provides in pertinent part:

"Within 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. § 305 provides, in pertinent part:

"After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent."

35 U.S.C. § 306 provides:

"The patent owner involved in a reexamination proceeding under this chapter may appeal under the provisions of section 134 of this title, and may seek court review under the provisions of sections 141 to 145 of this title, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent."

37 CFR 1.3 provides:

"Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Director and will not be entered. A notice of the non-entry of the paper will be provided. **Complaints against examiners and other employees must be made in correspondence separate from other papers.**" [Emphasis added.]

37 CFR 1.4(c) provides:

"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."

37 CFR 1.111(b) provides:

"In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a

bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section."

37 CFR 1.181(a)(1) provides that petition may be taken to the Director:

"**From any action** or requirement of any examiner in the *ex parte* prosecution of an application, or **in *ex parte*** or *inter partes* prosecution **of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court.**" [Emphasis added.]

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

"(a) All *ex parte* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office. **After issuance of the *ex parte* reexamination order and expiration of the time for submitting any responses, the examination will be conducted in accordance with §§ 1.104 through 1.116** and will result in the issuance of an *ex parte* reexamination certificate under § 1.570. [Emphasis added.]

(b) The patent owner in an *ex parte* reexamination proceeding will be given at least thirty days to respond to any Office action. **In response to any rejection**, such response may include further statements and/or proposed amendments or new claims to place the patent in a condition where all claims, if amended as proposed, would be patentable." [Emphasis added.]

MPEP § 2267 provides in pertinent part:

"The return of inappropriate submissions complies with the regulations that certain papers will not be considered and also reduces the amount of paper which would ultimately have to be scanned into the record.

I. DISPOSITION OF PAPERS

Where papers are filed during reexamination proceedings which are inappropriate because of some defect, such papers will either be returned to the sender or forwarded to one of three files, the "Reexamination File" (paper file or IFW file history), the "Patent File" (paper file or IFW file history), or the "Storage File" (paper file). Any papers returned to the sender from a Technology Center (TC) must be accompanied by a letter indicating signature and approval of the TC Director." [8]

## II. Basis For The August 23, 2006 Decision

On April 28, 2006, patent owner filed a supplemental amendment/response to an outstanding Office action dated December 30, 2005. That paper was returned to patent owner without consideration on the merits as an inappropriate submission. [9] The paper was considered to be inappropriate by the Central Reexamination Unit Director, (1) because the paper was not limited to consideration of prior patents and printed publications, [10] and (2) because portions of that paper were not in compliance with the requirements of 37 CFR 1.3. On June 23, 2006, patent owner requested reconsideration of the return of those papers by way of a petition for reconsideration. Patent owner attached to that petition for reconsideration the material that had previously been refused entry. A decision issued August 23, 2006, setting forth in detail the basis for refusing the underlying relief requested in the June 23, 2006 request for reconsideration, and for again returning the material that was not proper for entry into the record of the present merged reexamination proceeding.

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[8] When the CRU has jurisdiction, as in the case of this merged proceeding, the CRU Director would approve and sign the letter accompanying returned papers.

[9] See MPEP § 2267.

[10] See 35 U.S.C. §§ 301-303.

It was pointed out in the August 23, 2006 decision, in explanation of why the underlying relief requested by petitioner would not be appropriate, that:

> A) Pursuant to 35 U.S.C. § 306, an issue directed to the merits of a rejection in an *ex parte* reexamination proceeding is ultimately appealable to the Patent and Trademark Office Board of Patent Appeals and Interferences (the Board). On the other hand, pursuant to 37 CFR 1.181(a), a petition to the USPTO Director is the appropriate vehicle to resolve matters not subject to appeal.
>
> B) Pursuant to 37 CFR 1.3, complaints against examiners and other Office employees "must be made in correspondence separate from other papers" which are not directed to complaints against examiners and other Office employees.
>
> C) Pursuant to 37 CFR 1.4(c), different matters raised in a given proceeding must be raised in separate papers.

These points have not been persuasively addressed in the present request for reconsideration.

A. The April 28, 2006 Papers Did Not Comply With 37 CFR 1.111

The April 28, 2006 papers purported to be a supplemental amendment/response directed to the outstanding nonfinal Office action dated December 30, 2005. Pursuant to 37 CFR 1.550(a), the present merged reexamination proceeding is to be conducted in accordance with sections 1.104 through 1.116 of Title 37 of the Code of Federal Regulations. Those regulations implement the provisions of 35 U.S.C § 132. 37 CFR 1.111(b) specifically requires that a response to a nonfinal Office action address issues of patentability of the pending claims that are subject to an outstanding rejection. The April 28, 2006 papers did contain material directed to the issue of the patentability of the claims of the patents being reexamined that are required to be resolved by appeal to the Board. However, the April 28, 2006 papers also contained comments and documents that were not directed to the merits of the outstanding rejection (*i.e.*, not directed to appealable matters). These additional comments and documents were instead directed to matters of alleged misconduct on the part of Office employees/officials, and requested relief that is only available by way of petition to the USPTO Director, and not by an appeal to the Board.[11] Accordingly, the April 28, 2006 papers failed to comply with 37 CFR 1.111.

Petitioner is also referred to MPEP § 1201 which states, in pertinent part:

> Where the differences of opinion concern the denial of patent claims because of prior art or other patentability issues, the questions thereby raised are said to relate to the merits, and appeal procedure within the Office and to the courts has long been provided by statute (35 U.S.C. 134).
> The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Director of the U.S. Patent and Trademark Office (Director) should be carefully observed. The Board will not ordinarily hear a question that should be decided by the Director on petition, and the Director will not ordinarily entertain a petition where the question presented is a matter appealable to the Board.

In this instance, the entry of the additional comments and documents directed to matters of alleged misconduct on the part of Office employees/officials would inappropriately place

[11] See, for example, the arguments at page 74-92 of the supplemental response filed April 28, 2006, that was to be disposed of if not "picked up" by the patent owner in accordance with the August 23, 2006 Decision on Petition. Note that even a single instance of an argument directed to matters that are not part of a proper response to a nonfinal action within the meaning of 37 CFR 1.111(b) would suffice to preclude entry of the entire supplemental response as lacking an entry right.

materials unrelated to the merits of patentability before the examiner. Not only would entry of these materials confuse and overburden the record, but also these materials simply are not permitted to be, and will not be, made available for consideration by the examiner in determining the patentability of the claims.

B. The April 28, 2006 Papers Did Not Comply With 37 CFR 1.3

37 CFR 1.3, last sentence, prohibits the submission of "complaints against examiners and other employees" of the Office as a part of papers directed to other matters before the Office. The "returned" April 28, 2006 papers included complaints regarding the conduct of Office employees, and these complaints were submitted as part of papers directed to other matters, *i.e.*, the issues of claim patentability in this merged proceeding. Accordingly, the April 28, 2006 papers are barred by 37 CFR 1.3.

C. The April 28, 2006 Papers Did Not Comply With 37 CFR 1.4(c)

37 CFR 1.4(c) requires that, within a given proceeding, material directed to matters that will be considered by different branches within the Office be raised in separate papers. Yet, the April 28, 2006 papers included complaints regarding conduct together with material directed to the issues of claim patentability, notwithstanding that these separate issues are decided by different branches of the Office and resolved by different appellate review tribunals: (1) decision on petition to the USPTO Director and (2) consideration by the Primary Examiner which may ultimately be reviewed by the Board. Accordingly, the April 28, 2006 papers are barred by 37 CFR 1.4(c).

## III. Findings And Analysis With Respect To The Present Petition For Reconsideration

A. Patent Owner's Position Is Fundamentally Flawed

Petitioner patent owner argues that there has been improper conduct on the part of Office employees. [12] Patent owner apparently also believes that it has evidence of bias specifically on the part of one or more examiners, [13] and that this evidence, as previously submitted on April 28, 2006, should not be barred from examiner consideration because it bears on issues of patentability. Thus, petitioner patent owner urges that 37 CFR 1.3 should not preclude presentation to the examiner of the material alleging bias (even where bias alleged on the part of the examiner is alleged), because bias bears on patentability issues. Similarly, patent owner argues that 37 CFR 1.4(c) is inapplicable, because evidence of bias addresses the same patentability issues as the remainder of patent owner's substantive reply. [14]

Initially, patent owner has not shown how bias will change whether a claim is patentable over a reference or not. If the patent owner believes that there is a bias that would influence an examiner involved, or another Office employee conducting the examination of the claims for patentability, the proper avenue to address that would be via a 37 CFR 1.182 petition to remove the examiner or other Office employee, not by presenting the allegation of bias to the accused examiner for determination. Also, patent owner's position **assumes** that the evidence presented by patent owner **actually establishes bias**. However, the question of whether the material presented by patent owner in support of patent owner's allegations of bias in fact establishes

[12] See pages 3-4 of the present Petition for Reconsideration.
[13] See, for example, the headings on pages 4 and 7 of the present Petition for Reconsideration.
[14] See pages 7-9 of the present Petition for Reconsideration.

bias on the part of any Office personnel is an open question that has not yet been decided. Patent owner further assumes that the examiner is the appropriate Office employee to view alleged evidence of bias on the part of Office officials (and on the part of the examiner) in order to make a finding that bias in fact existed. However, the examiner's authority extends to making patentability determinations. The examiner does not exercise supervisory authority with respect to the alleged bias or misconduct on the part of other Office employees.

Pursuant to 35 U.S.C. § 306, an issue directed to the merits of a rejection in an *ex parte* reexamination proceeding is ultimately appealable to the Board, and then to the courts. All matters not subject to appeal to the Board under 35 U.S.C. § 306 are subject to resolution by way of petition under 37 CFR 1.181. Further, 37 CFR 1.3 prohibits complaints about employee conduct to be included within the same papers addressing the merits of patentability. Therefore, the proper avenue for obtaining review of an allegation of procedural impropriety, misconduct or bias on the part of Office personnel would be through petition to appropriate Office officials (as pointed out above). Any decision on such a petition that is adverse to patent owner would be subject to court review in the same manner as any other question of administrative procedure would be reviewed. [15] It is not reasonable to state that the evidence **alleged** to support bias on the part of Office officials, and/or on the part of the examiner, should be placed into the record of the present merged reexamination proceeding before the examiner for review and evaluation by the examiner as part of a patentability determination. Further, some of the allegations of bias are directed to the conduct of the examiner, making it far from clear that the examiner could objectively evaluate the allegations of the examiner's own bias. Yet, as noted above, patent owner appears to have raised the argument that the evidence of examiner bias should be forwarded to the examiner for consideration. Such consideration has, to date, been refused solely on the basis that patent owner has filed a single paper that conflated and intermingled these issues, rather than filing two separate papers that are each directed only to the area of the Office that would properly consider only that paper. [16]

By way of expansion on the above discussion, patent owner is reminded that patent examiners are Office personnel who are charged with evaluating evidence bearing on questions of patentability. In the present merged reexamination proceeding, the examiner's consideration of patentability is limited by 35 U.S.C. §§ 301 - 303 to a consideration of prior patents and printed publications. [17] Examiners are not charged with evaluating evidence of impropriety, misconduct or bias, by examiners or other Office personnel. Also, until the patent owner's evidence and allegations of misconduct are properly evaluated by the appropriate Office personnel, they cannot have any affect on action taken by the Office.

As a final point, patent owner is not being deprived of due process by a refusal to accept papers that co-mingle allegations of misconduct (and documents supporting those allegations) with papers that are directed to other matters. Papers raising issues of alleged misconduct, and documents proffered in support of such allegation, are admissible in the Office, and can properly be submitted for consideration by the Office, but only if they are provided in a manner that complies with the regulations.

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[15] Non-appealable subject matter reviewed by petition under 37 CFR 1.181 is subject to judicial review under the Administrative Procedures Act.

[16] Given that reexaminations are conducted with special dispatch, it is puzzling that patent owner has not seen fit to comply with the relatively straightforward and simple requirements of the 37 CFR 1.3 and 1.4(c) by filing two separate papers, since by doing so, patent owner would have immediately placed before the proper areas of the Office both the conduct issues and the substantive patentability issues for consideration by the appropriate Office personnel.

[17] Extrinsic evidence explaining the content of prior patents and printed publications may be considered as well.

B. 37 CFR 1.3 and 37 CFR 1.4(c) Each Precludes The Relief Requested By Petitioner Patent Owner

It is manifestly clear that both 37 CFR 1.3 and 37 CFR 1.4(c) each prohibit patent owner from co-mingling arguments directed to issues of the patentability of the claims with arguments and evidence in support of allegations of procedural impropriety and bias on the part of Office personnel. Those allegations are as yet unproven, and cannot be properly considered to presently establish any basis for reassignment of examining responsibilities. This is not the same as concluding that the regulations preclude **the presentation** of evidence of bias, as patent owner argues, [18] (notwithstanding that the Office has never taken such position [19]). The Office is not refusing to consider patent owner's alleged evidence, but simply is requiring that patent owner's evidence and allegations be presented in accordance with its rules which require them to be directed to the appropriate Office personnel for consideration and evaluation.

To the extent that the present petition again presents the allegation that 37 CFR 1.3 is inapplicable because patent owner has not violated decorum or been discourteous in this proceeding, [20] and also cites case law that is alleged to establish that 37 CFR 1.3 is inapplicable on the facts in this proceeding, patent owner is reminded that the August 23, 2006 Decision on Petition was in no manner based upon patent owner's conduct. Rather, 37 CFR 1.3 was applied because it requires that complaints of misconduct on the part of examiners and Office personnel "must be made in correspondence separate from other papers." [21] This language manifestly includes, as part of the class of "other papers" in which complaints of misconduct may not be raised, "papers directed to the merits of claim patentability in any proceeding in which the misconduct is alleged to have occurred."

Moreover, none of the case law cited by patent owner at page 5 of the present petition supports patent owner's position that 37 CFR 1.3 has been misapplied. Here, the Office is not prohibiting the patent owner from submitting evidence regarding its allegations; rather, the Office is simply directing material to the appropriate Office official for review of patent owner's complaint in accordance with the requirements established by 37 CFR 1.3 that employee conduct complaints "must be made in correspondence separate from other papers." None of the cases relied upon by patent owner demonstrate that the Office may not enforce the clear language of 37 CFR 1.3 by requiring papers containing complaints about the conduct of Office officials and personnel to be filed separately from other papers related to the merits of patentability.

Patent owner's argument that 37 CFR 1.4(c) should not prohibit examiner consideration of the merits of patent owner's arguments regarding the existence of bias is similarly fatally flawed. First, 37 CFR 1.4(c) does not preclude consideration of the merits of patent owner's allegations of bias, impropriety or misconduct on the part of Office officials and employees. The record does not show that the Office has taken the position that the allegations raised by patent owner cannot or will not be considered. 37 CFR 1.4(c) merely directs the orderly manner in which such allegations, and the evidence in support of such allegations, must be presented to the Office - for consideration by the proper Office officials. In this instance, 37 CFR 1.4(c) applies, because it requires that matters such as questions of bias or inappropriate conduct by Office personnel, which matters are appropriate for consideration by an Office official in one particular area of the Office, be submitted in a paper *separately* from papers containing substantive patentability issues, which are properly decided by a different Office official of

[18] See page 5 of the present petition, last sentence in the paragraph bridging pages 4 and 5.
[19] See for example, Decision Dismissing Petition dated August 23, 2006, section II(B), items 1 and 4.
[20] See the present petition, beginning at the bottom of page 4 and running through page 5.
[21] See Decision on Petition, August 23, 2006, page 7, first full paragraph.

employee in a different area of the Office. As pointed out above, the patent examiner is not the proper Office official to consider and rule on patent owner's allegations of bias, impropriety and misconduct; and thus, such allegations and materials supporting such allegations, are not proper for inclusion in the IFW record as a part of papers otherwise directed to patentability issues. The fact that the "examiner" is one of the employees that is accused of misconduct further highlights the appropriateness of the procedural safeguards provided by the rules. Clearly, the employee accused of alleged misconduct cannot be the official who will decide the issue. Moreover, the rule protects the integrity of the file history by separating employee complaints from the merits of examination.

Thus, 37 CFR 1.4(c) precludes entry of the papers submitted as a part of the June 23, 2006 petition, because the regulation properly requires that:

> matters bearing on the determination of patentability in this proceeding, and
>
> matters directed to a determination of the propriety of the allegations of misconduct, bias or impropriety on the part of Office officials and the examiner

be submitted in separate papers inasmuch as these issues are decided by different Office officials/employees in different areas of the Office.

C. 37 CFR 1.111 Precludes The Relief Requested By Patent Owner

37 CFR 1.111(b) provides that a response to a nonfinal Office action must, *inter alia*, specifically point out supposed errors in the examiner's action, and point out the specific distinctions believed to render the claims patentable over the prior art. The regulation does not provide for "further statements" that address matters other than the issues of patentability raised in the outstanding Office action. The failure of the April 28, 2006 patent owner submission to comply with 37 CFR 1.111(b) was discussed at pages 6-7 of the Decision Dismissing Petition dated August 23, 2006. It was pointed out that the April 28, 2006 patent owner submission was not confined to responding to the nonfinal Office action as required by 37 CFR 1.111(b), but instead intermingled matter directed to other issues (the issues of alleged misconduct on the part of Office personnel).

In the present petition patent owner has not directly addressed this point. To the extent that patent owner's general argument that the allegations of misconduct are in fact relevant to the issues of patentability, those arguments are wholly unpersuasive for the reasons set forth in Section III (A) above. Therefore, it is again concluded that the August 23, 2006 Decision Dismissing Petition properly refused entry of the April 28, 2006 patent owner as being non-compliant with 37 CFR 1.111(b).

## CONCLUSION

1. The October 23, 2006 patent owner petition is granted to the extent that the August 23, 2006 Decision Dismissing Petition has been fully reconsidered, and that the present decision will be designated as a final agency decision.

2. The October 23, 2006 patent owner petition is denied with respect to disturbing the holding of the August 23, 2006 Decision Dismissing Petition which refused to enter the papers attached to patent owner's June 23, 2006 Petition and which "returned" those papers.

3. A copy of this decision is being made of IFW record for the merged reexamination

proceeding, and the decision will therefore appear in the IFW record of *ex parte* reexamination proceedings 90/006,493, 90/006,680 and 90/007,735.

4. Telephone inquiries with regard to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or, in his absence, to the undersigned at (571) 272-7710.

5. This decision is a final agency action within the meaning of 5 U.S.C. § 704.

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

sm
February 22, 2007

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For Patent Owner

MAILED

JUN 14 2007

CENTRAL REEXAMINATION UNIT

Novak Druce & Quigg LLP
1300 Eye Street NW
Suite 400 East Tower
Washington, DC 2005

For Requester

In re Campana, Jr. et al.
*Ex Parte* Reexamination Proceeding
Control No. 90/006,493
Filed: December 26, 2002
For: US Patent No.5,819,172

DECISION
GRANTING
PETITION

In re Campana, Jr. et al.
*Ex Parte* Reexamination Proceeding
Control No. 90/006,680
Filed: June 24, 2003
For: US Patent No. 5,819,172

In re Campana, Jr. et al.
*Ex Parte* Reexamination Proceeding
Control No. 90/007,735
Filed: September 28, 2005
For: US Patent No. 5,819,172

This is a decision on the May 25, 2007, "Petition Under 37 CFR 1.181 to Accept Previously Filed Papers" requesting that the Office accept as timely an appeal brief, evidence appendix, and information disclosure statement (IDS) submitted with the instant petition.

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

The petition is granted for the reasons set forth below.

**Decision**

A notice of appeal was received on October 23, 2006, so that an appeal brief was due by December 23, 2006. Patent Owner states that the required brief, evidence appendix, and also an IDS were timely filed on December 21, 2006, but were apparently lost by the Office.

Patent Owner's assertion is corroborated by a stamped postcard receipt from the USPTO, which indicates receipt of the appeal brief, evidence appendix, and IDS on December 21, 2006. Further, true and correct copies of the previously filed papers were submitted with the petition.

Accordingly, Patent Owner's petition is **GRANTED**, and the appeal brief, appendix, and IDS filed with the petition are accepted at timely.

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, for
Director
Central Reexamination Unit

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 90/006,494 | 12/26/2002 | 6067451 | | 9468 |

20457 7590 03/26/2003

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| EXAMINER |
|---|
| L. Kincaid |

| ART UNIT | PAPER NUMBER |
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| 2685 | 9 |

DATE MAILED: 03/26/2003

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

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Paper No. 9

ANTONELLI TERRY STOUT AND KRAUS (For Patent Owner)
SUITE 1800
1300 NORTH SEVENTEENTH STREET
ARLINGTON VA 22209

| | | |
|---|---|---|
| In re Reexamination of: | ) | |
| U.S. Patent No. 6,067,451 | ) | DECISION CONCERNING |
| Reexamination Control No. 90/006,494 | ) | PAPERS FILED BY |
| For: ELECTRONIC MAIL SYSTEM WITH RF COMMUNICATIONS TO MOBILE PROCESSORS | ) | PATENT OWNER |

The present proceeding is before the TC 2600 Special Program Examiners' Office for clarification of status of the papers filed on February 26, 2003 and March 14, 2003 by the Patent Owner.

## BACKGROUND

A review of the file finds the following contents of the proceedings:

1) On December 26, 2002, a Director Initiated Order for Reexamination was mailed to the Patent Owner (Paper No. 1).

2) On December 24, 2002 the Title report was placed in the file (Paper No. 2).

3) On February 26, 2003, Patent Owner filed
   a) a Patent Owner's Statement under Protective Order (Paper No. 3),
   b) an Expert Declaration submitted under Protective Order (Paper No. 4),
   c) a Declaration of Donald E. Stout pursuant to 37 CFR 1.131 (Paper No. 5),
   d) a Declaration of Thomas J. Campana, Jr. pursuant to 37 CFR 1.131 (Paper No. 6), and
   e) and Information Disclosure Statement under 37 CFR 1.555 (Paper No. 7).

4) On March 5, 2003, Patent Owner filed copies of date-stamped postcard receipts (Paper No. 8) evidencing the timely filing of the items listed above in section 3) of this communication.

The Office regrets the failure to date-stamp the original papers submitted to the Office on February 26, 2003. The original papers which were missing date-stamps have now been date-stamped in accordance with the evidence provided.

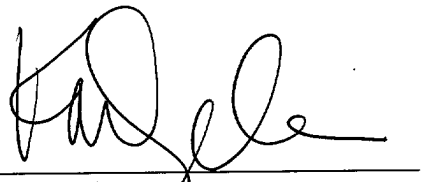
5) On March 14. 2003, Patent Owner filed a Petition under 37 CFR 1.183 for filing a Supplemental Patent Owner's Statement. Entry of the submitted Supplemental Patent Owner's Statement and accompanying Information therewith will be decided by the Office of Patent Legal Administration (OPLA) in their decision on this petition.

## DECISION

There are no provisions for submitting a Patent Owner's Statement and/or declarations under 37 CFR 1.131 and 37 CFR 1.132 under Protective Order. MPEP 724.03 sets forth the types of Trade Secret, Proprietary, and/or Protective Order Materials contemplated for submission under MPEP 724.02 and clearly sets forth that if any protective order materials are submitted in "***amendments, arguments in favor of patentability, or affidavits under 37 CFR 1.131 or 1.132, they will be made of record in the file and will not be given any special status***." Because the Patent Owner's Statement must clearly point out why the claims are deemed to be patentable (see MPEP 2249), by definition, the Patent Owner's Statement is inappropriate for submission under Protective Order. Accordingly, the Patent Owner's Statement has been made of record in the file as Paper No. 3. Likewise, the Expert Declaration which was also submitted under Protective Order was inappropriate for submission under Protective Order and has been made of record in the file as Paper No. 4.

## CONCLUSION

The papers filed under Protective Order have been removed from the envelopes and made of record. The file is being forwarded to OPLA for a decision on the Petition filed March 14, 2003.



Krista Zele
Special Programs Examiner
Technology Center 2600
Communications

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Paper No. 10

Donald E. Stout
Antonelli, Terry, Stout & Kraus
Suite 1800
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Arlington, VA 22209

(For Patent Owner)

MAILED

APR 0 1 2003

REEXAM UNIT

Enclosure: Patent Owner Petition and attachments filed March 14, 2003

| | | |
|---|---|---|
| In re Campana, Jr. et al. | : | |
| Reexamination Proceeding | : | DECISION DISMISSING |
| Control No. 90/006,494 | : | PETITION AND RETURNING |
| Initiated: December 26, 2002 | : | IMPROPER PAPER |
| For: U.S. Patent No. 6,067,451 | : | |

This is a decision on the March 14, 2003, patent owner petition entitled "PETITION PURSUANT TO 37 C.F.R. § 1.183 TO ENLARGE THE TWO MONTH TIME LIMIT FOR FILING A SUPPLEMENTAL PATENT OWNER'S STATEMENT PURSUANT TO 37 CFR § 1.530." The petition is before the Office of Patent Legal Administration for decision.

For the reasons set forth below, the petition is dismissed and is being returned along with this decision.

**REVIEW OF FACTS**

1. On December 26, 2002, reexamination was ordered for five of Patent Owner's patents. The order for reexamination was issued at the initiative of the Director of the United States Patent and Trademark Office under 37 CFR 1.520. The patents and their assigned control number are: 5,625,670 (90/006,491); 5,631,946 (90/006,492); 5,819,172 (90/006,493); 6,067,451 (90/006,494); and 6,317,592 (90/006,495). The present reexamination proceeding is reexamination control number 90/006,494.

2. On February 26, 2003, Patent Owner filed (a) a Patent Owner's Statement under Protective Order (Paper No. 3), (b)an Expert Declaration submitted under Protective Order (Paper No. 4), (c) a Declaration of Donald E. Stout pursuant to 37 CFR 1.131 (Paper No. 5), (d) a Declaration of Thomas J. Campana, Jr. pursuant to 37 CFR 1.131 (Paper No. 6), and (e) an Information Disclosure Statement under 37 CFR 1.555 (Paper No. 7).

3. On March 5, 2003, Patent Owner filed copies of date-stamped postcard receipts (Paper No. 8) evidencing the timely filing of the February 26, 2003, papers. The original papers which had been missing date-stamps were then date-stamped as received on February 26, 2003, pursuant to the evidence provided by Patent Owner.

4. On March 14, 2003, Patent Owner filed the present petition under 37 CFR 1.183 requesting "suspension of the two-month time limit set for the response to the Order for Reexamination" to permit entry of the *accompanying* "Supplemental Patent Owner's Statement Pursuant to 37 CFR 1.530"

5. On March 26, 2003, a "DECISION CONCERNING PAPERS FILED BY PATENT OWNER" was issued by the Technology Center 2600 Special Programs Examiner, stating that "the papers filed [February 26, 2003] under Protective Order have been removed from the envelopes and made of record."

6. The present file was then forwarded to the Office of Patent Legal Administration for a decision on the petition.

**DECISION**

37 CFR 1.540 states:

> No submissions other than the statement pursuant to § 1.530 and the reply by the *ex parte* reexamination requester pursuant to § 1.535 will be considered prior to examination.

The examination stage of the present proceeding has not yet begun, as a first Office action on the merits has not yet been issued. The present March 14, 2003, submission is not a "reply by the *ex parte* reexamination requester pursuant to § 1.535," since it is filed by the patent owner. Further, the submission is not a Patent Owner's statement pursuant to § 1.530, because the Patent Owner's statement pursuant to § 1.530 was already filed on February 26, 2003. Pursuant to 35 U.S.C. 304, the patent owner is

given a reasonable period "within which he may file **a statement**" [Emphasis added] on the question of patentability raised in the order for reexamination. There is no provision in the statute for more than one statement, i.e., there is no provision for a second statement to supplement the first statement.

Since the present March 14, 2003, submission is submission is not a "statement" nor a "reply," entry of same is barred under 37 CFR 1.540.

37 CFR 1.530(b) states:

> The order for *ex parte* reexamination will set a period of not less than two months from the date of the order **within which the patent owner may file a statement on the new question of patentability**, including any proposed amendments the patent owner wishes to make. [Emphasis Added]

Under 37 CFR 1.530(b), the Patent Owner may file the statement *only* within the period set therein. The period set in the December 26, 2002, order for *ex parte* reexamination was two months. Accordingly, the present March 14, 2003, submission would not be timely, even if it were a proper statement under 37 CFR 1.530.

In view of the above, the March 14, 2003, submission of Patent Owner's petition and the accompanying "Supplemental Patent Owner's Statement Pursuant to 37 CFR 1.530" is an improper submission under 37 CFR 1.530(b) and under 37 CFR 1.540. Accordingly, the submission will not be made of record in the reexamination file and is being returned herewith. MPEP 2267. See *In re Knight*, 217 USPQ 294 (Comm'r Pat. 1982); *Patlex Corp. v Mossinghoff*, 226 USPQ 985, 986 (Fed. Cir. 1985). This decision will, however, be made of record in the reexamination file.

As to petitioner's request to waive the rules pursuant to 37 CFR 1.183:

Patent Owner's request for "suspension of the two-month time limit set" in the order is, in effect, a request that the Director to waive the provisions of 37 CFR 1.530(b) and permit (1) entry of the instant petition and accompanying "Supplemental Patent Owner's Statement Pursuant to 37 CFR 1.530," and (2) consideration of same when the examiner issues the first Office action on the merits. A waiver of the requirement to file the statement within the two month time period (set in the order) will not, however, provide Patent Owner with the relief Patent Owner desires, since consideration of the March 14, 2003,

submission would still be barred under 37 CFR 1.540, because the present March 14, 2003, submission is not a "statement" nor a "reply" as discussed above.

Accordingly, Patent owner's petition is taken as a request to waive the provisions of 37 CFR 1.540 and permit entry of a submission other than a statement pursuant to § 1.530 and a reply pursuant to § 1.535.

In order for grant of a petition under 37 CFR 1.183, a petitioner must show (1) that there is an extraordinary situation (2) where justice requires waiver of the rule. *In re Sivertz*, 227 USPQ 255, 256 (Comm'r Pat. 1985). Petitioner Patent Owner has not show that either condition exists in this case.

The present March 14, 2003, submission, for which entry and consideration in the first Office action is requested, provides a paper that was presented in litigation related to the patent being reexamined, and discusses what Patent Owner believes to be the significance of that paper. If entry is not provided at this point, Patent Owner is free to re-submit the March 14, 2003, submission during the examination stage of the present proceeding, i.e., after the first Office action is issued. At that point, the submission would have an entry right and would be considered by the examiner. There is no showing in the petition that re-submission during the examination stage would prejudice Patent Owner as to the consideration of the information presented (in the submission) in a manner as to create an extraordinary situation where justice requires waiver of the provisions of 37 CFR 1.540. Accordingly, the relief provided by 37 CFR 1.183 is not appropriate in this instance, [1] and the present petition pursuant to 37 CFR 1.183 is dismissed.

**CONCLUSION**

1. The March 14, 2003, patent owner petition filed pursuant to 37 CFR 1.183 is dismissed, and it is being returned along with this decision.

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[1] Note that the Office will not normally consider an extraordinary remedy when the rules already provide an avenue for obtaining the relief sought. *See Cantello v. Rasmussen*, 220 USPQ 664 (Comm'r Pat. 1982).

3. The reexamination file is being returned to Technology Center 2600 for storage until a reply under 37 CFR 1.535 is received, or the time for filing same expires, after which a first Office action on the merits is to be issued.

4. 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

April 1, 2003
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| 90/006,681 and 90/006494 | 06/24/2003 | 6067451 | | 5437 |

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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Orlando, FL 32801

# *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

90/006494 and

REEXAMINATION CONTROL NO. *90/006,681*.

PATENT NO. *6067451*.

ART UNIT *2600*.

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 PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Paper No. 19

| | | |
|---|---|---|
| Sturm & Fix LLP<br>206 Sixth Avenue<br>Suite 1213<br>Des Moines, IA 50309-4076 | ) | For Patent Owner |
| David Stewart<br>Allen Dyer Doppelt Milbrath & Gilchrist, PA<br>255 S. Orange Avenue<br>Suite 1401<br>Orlando, FL 32801 | ) | For Third Party Requester |
| In re Campana et al.<br>Reexamination Proceeding<br>Control No.: 90/006,494<br>Filed: December 26, 2002<br>For: U.S. Patent 6,067,451 | ) | DECISION *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS |
| In re Campana et al.<br>Reexamination Proceeding<br>Control No.: 90/006,681<br>Filed: June 24, 2003<br>For: U.S. Patent 6,067,451 | ) | |

The above noted reexamination proceedings are before the Director of Technology Center 2600 for consideration of merger of the proceedings under 37 CFR 1.56(c).

## BACKGROUND

1. Patent 6,067,451 issued on May 23, 2000.

2. On December 26, 2002, a Director Initiated Order for Reexamination was mailed to the Patent Owner as Control No. 90/006,494 ('494).

3. A Patent Owner's Statement was filed in the '494 proceeding on February 26, 2003.

4. A request for reexamination, Control No. 90/006,681 ('681) was filed by the Third Party Requester on June 24, 2003.

5. Reexamination was ordered on the '681 reexamination proceeding on September 3, 2003.

6. No Patent Owner Statement was filed in the '681 reexamination proceeding.

## DISCUSSION

37 CFR 1.565(c) states:

> "If reexamination is ordered while a prior reexamination is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under section 1.570".

## DECISION

**I.** Merger of Proceedings

In accordance with 37 CFR 1.565(c), the '494 and '681 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 all proceedings.

The Patent Owner is required to maintain the same claims and specification in both files.

**III.** Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action, which applies to both proceedings. All papers issued by the Office or filed by the Patent Owner must contain the identifying data for both proceedings and will be physically entered in each reexamination file which will be separately maintained. All papers filed by the Patent Owner must also consist of a single response, filed in duplicate, each bearing an original signature, for entry into each file. All papers filed by the Patent Owner must be served on the requestor and requestor will be sent copies of all papers mailed by the Office. See MPEP 2283.

A review of these reexamination files finds that both proceedings currently contain the same claims and specification and therefore the Patent Owner need not take any action.

The merged proceedings are being forwarded to the examiner for appropriate action. An Office action will be mailed in due course.

Andy Faile, Acting Director
Technology Center 2600
Communications

90006494.052604

UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Thomas J. Campana, Jr. *et al*
Reexamination Proceeding
Control No. 90/006,494
Filed: December 26, 2002
For U.S. Patent No.6,067,451

In re Thomas J. Campana, Jr. *et al*
Reexamination Proceeding
Control No. 90/006,681
Filed: June 24, 2003
For U.S. Patent No. 6,067,451

In re Thomas J. Campana, Jr. *et al*
Reexamination Proceeding
Control No. 90/007,726
Filed: September 22, 2005
For U.S. Patent No. 6,067,451

DECISION,
*SUA SPONTE,*
MERGING
REEXAMINATION
PROCEEDINGS
PURSUANT TO
37 C.F.R. § 1.565(c)

The above-identified reexamination files are before the Director of the Central Reexam Unit 3999, for consideration of merger of reexamination control number 90/007,726 (the '726 proceeding) with the previously merged reexamination control numbers 90/006,494 (the '494 proceeding) and 90/006,681 (the '681 proceeding) pursuant to 37 C.F.R. § 1.565(c).

## BACKGROUND

1. Patent No. 6,067,451 issued on May 23, 2000.

2. The '494 reexamination proceeding is a Director Ordered reexamination proceeding that was ordered on December 26, 2002.

3. The '681 reexamination proceeding, filed on June 24, 2003, is a reexamination proceeding that was requested by a third party requester.

4. An order granting reexamination in the '681 reexamination proceeding was mailed on September 3, 2003.

5. The '494 and '681 proceedings were merged to provide a single consolidated proceeding on May 26, 2004

6. A non-final Office Action was mailed on June 21, 2005 in the previously merged proceedings.

7. A response to the June 21, 2005, Office action was timely filed on August 22, 2005. The response added claims 342 to 392 to the merged proceedings. However, the amendment was canceled following notification of fee deficiency in the Interview Summary mailed on November 18, 2005.

8. An amendment with proper fee was filed on November 25, 2005 in the '494 and '681 reexamination proceedings. The amendment canceled claims 342 to 392 and added claims 393 to 418.

9. A non-final Office action was mailed on November 30, 2005 in the previously merged proceedings.

10. An amendment was filed on January 30, 2005 in the '494 and '681 reexamination proceedings. The amendment added claims 419 to 437.

11. The '726 proceeding was filed on September 22, 2005 by a third party requester.

12. The third party requester's correspondence address is the same in the '681 and '726 proceedings.

13. An order granting reexamination in the '726 reexamination proceeding was mailed on September 30, 2005.

14. There are no amendments to the '726 reexamination proceeding.

## 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 , *supra*, reexamination was previously ordered in the '494 and '681 reexamination proceedings, and these proceedings have previously been merged. Reexamination has been ordered in the '726 proceeding.

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 90/006,494, 90/006,681 and 90/007,723 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 '6,494 and '6,681 reexamination proceeding. Patent owner is required to maintain the same claims and specification in all merged 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.

### 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. 90/006,494, 90/006,681 and 90/007,723 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.

All correspondence regarding these proceedings should 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

Telephone inquiries with regard to this decision should be directed to Mark Reinhart, Special Program Examiner in the Central Reexamination Unit, Art Unit 3992, at (571) 272-1611

MReinhart SPRE - CRU 3992 for

Lissi M. Marquis,
Director,
Central Reexamination Unit

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MAILED

AUG 23 2006

CENTRAL REEXAMINATION UNIT

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/006,494
Filed: December 26, 2002
For: U.S. Patent No. 6,067,451

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No. : 90/006,681
Filed: June 24, 2003
For: U.S. Patent No. 6,067,451

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/007,726
Filed: September 22, 2005
For: U.S. Patent No. 6,067,451

**DECISION, *SUA SPONTE*, DISMISSING PETITION AND "RETURNING" IMPROPER PAPERS**

This is a decision on the June 23, 2006 patent owner petition styled "Petition Pursuant to 37 CFR 1.181 or Alternatively, 37 CFR 1.182 OR Alternatively 37 CFR 1.183 to Reconsider Decision Returning Paper and Enter the Papers into the Official Record." [1]

The petition and the above-captioned reexamination proceedings are before the Office of Patent Legal Administration for consideration.

The petition is dismissed and its attachments are returned to the patent owner for the reasons discussed below.

[1] The present petition is, facially, fully treatable pursuant to the provisions of 37 CFR 1.181. Accordingly, it is manifestly unnecessary to consider the petition under either 37 CFR 1.182 or 37 CFR 1.183. No fee is required.

## REVIEW OF SALIENT FACTS

1. U.S Patent number 6,067,451 ("the '451 patent") issued to Campana *et al* on May 23, 2000 from an application filed on September 28, 1998.

2. On December 26, 2002, a Director Initiated Order for Reexamination of the '451 patent was mailed and assigned control number 90/006,494 ("the '494 reexamination proceeding").

3. On June 24, 2003, a request for ex *parte* reexamination of the '451 patent was filed by a third party requester, and assigned control number 90/006,681 ("the '681 reexamination proceeding").

5. On September 3, 2003, the examiner's Order Granting *Ex Parte* Reexamination for the '681 reexamination proceeding was mailed.

6. On May 26, 2004, the Technology Center Director issued a decision, *sua sponte*, by which the '494 reexamination proceeding and the '681 reexamination proceeding were merged into a single combined reexamination proceeding.

7. On September 22, 2005, a third request for *ex parte* reexamination of the '451 patent, which was assigned control number 90/007,726 ("the '726 reexamination proceeding").

8. On September 30, 2005, the examiner's Order Granting *Ex Parte* Reexamination for the '726 reexamination proceeding was mailed.

9. On January 4, 2006, a Freedom of Information Act ("FOIA") Request was made to the Office requesting the Office's communications with third parties regarding the present reexamination proceedings and pending reexamination proceedings being conducted on other of patent owner's patents.

10. The Office responded to the FOIA request through letters dated between February 8 and March 24, 2006. [2]

11. Following prosecution on the patentability of the '451 patent claims, a final rejection Office action was issued in the merged reexamination proceeding on February 22, 2006.

12. On March 1, 2006, the Central Reexamination Unit (CRU) Director issued a decision, *sua sponte*, by which the '494 reexamination proceeding, the '681 reexamination proceeding and the '726 reexamination proceeding were merged into a single merged reexamination proceeding. [3]

13. On April 24, 2006, patent owner filed both a notice of appeal and an information disclosure statement (IDS) in the single combined reexamination proceeding.

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[2] An additional response to the FOIA request was mailed by the Office on June 15, 2006 and received by patent owner on June 16, 2006.

[3] Jurisdiction of the merged '494 and '681 reexamination proceedings had previously been transferred from the Technology Center to the CRU.

14. Also on April 24, 2006, patent owner filed a paper styled as a response to the final rejection, which included a traverse of the final rejection, copies of material obtained as a result of the FOIA request, and a number of statements in support of patent owner's traverse.

15. On May 17, 2006, the CRU Director mailed a decision returning the April 24, 2006 patent owner response to the final rejection noted in Fact 14 above without consideration on the merits. The return was based on the grounds that the papers filed were improper because they were not limited to consideration of prior patents and printed publications and also because portions were not in compliance with the 37 CFR 1.3 requirements for decorum and courtesy. Accordingly, the returned response was not entered into the record.

16. On May 22, 2006, patent owner filed a redacted version of the April 24, 2006 response, limited to material addressing the outstanding final rejection Office action, which has been entered into the IFW record.

17. On June 23, 2006, patent owner filed the present petition requesting reconsideration of the CRU Director's May 17, 2006 decision. Patent owner has attached to the petition the material that was refused entry and returned (by the CRU Director's May 17, 2006 decision), for entry into the record as part of patent owner's response to the February 22, 2006 final Office action.

## DECISION DISMISSING THE THIRD PARTY REQUESTER PETITION AND RETURNING PAPERS FILED WITH THE PETITION

I. Relevant Statutes, Regulations and Practice

35 U.S.C. § 132 provides:

> "(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.
>
> (b) The Director shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant. The Director may establish appropriate fees for such continued examination and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under section 41(h)(1) of this title."

35 U.S.C. § 134(b) provides:

> "A patent owner in any reexamination proceeding may appeal from the final rejection of any claim by the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal."

35 U.S.C. § 305 provides, in part:

"After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent."

35 U.S.C. § 306 provides:

"The patent owner involved in a reexamination proceeding under this chapter may appeal under the provisions of section 134 of this title, and may seek court review under the provisions of sections 141 to 145 of this title, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent."

37 CFR 1.3 provides:

"Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Director and will not be entered. A notice of the non-entry of the paper will be provided. **Complaints against examiners and other employees must be made in correspondence separate from other papers.**" [Emphasis added.]

37 CFR 1.4(c) provides:

"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."

37 CFR 1.113(a) provides, in part:

"On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon ... for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. **Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181).** ..." [Emphasis added.]

37 CFR 1.116(a)-(e) provide, in part:

"(a) An amendment after final action must comply with § 1.114 or this section.

(b) After a final rejection or other final action (§ 1.113) ... in an ex parte reexamination filed under § 1.510 ... 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 ... patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

(c) The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the ... reexamination proceeding from its condition as subject to appeal or to save ... the reexamination prosecution from termination under § 1.550(d) ... .

(d) (1) ...
(2) Notwithstanding the provisions of paragraph (b) of this section, an amendment made after a final rejection or other final action (§ 1.113) in an ex parte reexamination filed under §1.510 ... may not

cancel claims where such cancellation affects the scope of any other pending claim in the reexamination proceeding except ... as permitted by § 41.77(b)(1) of this title.

(e) An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) ... in an ex parte reexamination filed under § 1.510 ... but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. "

37 CFR 1.181(a)(1) provides that petition may be taken to the Director:

"**From any action** or requirement of any examiner in the ex parte prosecution of an application, or **in ex parte** or inter partes prosecution **of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court.**" [Emphasis added.]

37 CFR 1.550(a) and (b) provide, in part:

"(a) All *ex parte* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office. **After issuance of the *ex parte* reexamination order and expiration of the time for submitting any responses, the examination will be conducted in accordance with §§ 1.104 through 1.116** and will result in the issuance of an *ex parte* reexamination certificate under § 1.570. [Emphasis added.]

(b) The patent owner in an *ex parte* reexamination proceeding will be given at least thirty days to respond to any Office action. **In response to any rejection,** such response may include further statements and/or proposed amendments or new claims to place the patent in a condition where all claims, if amended as proposed, would be patentable." [Emphasis added.]

MPEP § 2267 provides in part:

"The return of inappropriate submissions complies with the regulations that certain papers will not be considered and also reduces the amount of paper which would ultimately have to be scanned into the record.

I. DISPOSITION OF PAPERS
Where papers are filed during reexamination proceedings which are inappropriate because of some defect, such papers will either be returned to the sender or forwarded to one of three files, the "Reexamination File" (paper file or IFW file history), the "Patent File" (paper file or IFW file history), or the "Storage File" (paper file). Any papers returned to the sender from a Technology Center (TC) must be accompanied by a letter indicating signature and approval of the TC Director." [4]

## II. Findings and Analysis

On April 24, 2006, patent owner filed a response to the final action dated February 22, 2006. That paper was returned to patent owner by the decision of the CRU Director dated May 17, 2006, on the grounds that the response was an improper paper. The basis of this holding was that the response included statements and documents that were improper because they were not limited to consideration of prior patents and printed publications, and also because portions were not in compliance with 37 CFR 1.3 requirements for decorum and courtesy. Patent owner was invited, in the May 17, 2006 decision returning papers, to submit a redacted response, and patent owner has in fact filed a redacted version of that response (the redacted version has been entered into the record).

Patent owner has now attached to the present petition - a set of papers to be added to the record as a part of the response to the February 22, 2006 final action, which would be available for the examiner's consideration in evaluating the patent owner's response. Patent owner

[4] When the CRU has jurisdiction, as in the case of this merged proceeding, the CRU Director would approve and sign the letter accompanying returned papers.

requests by way of the present petition that these papers be entered into the IFW record to provide a complete administrative record. [5] It is patent owner's position that:

(1) There was no legal basis for the CRU Director's return of the April 24, 2006 response papers;

(2) The grounds for such return as expressed in the CRU Director's decision returning the papers were erroneous;

(3) The patent owner is entitled to argue and provide documents to allege that the February 22, 2006 final action is an improper action based on allegations of misconduct and bias.

(4) Due process requires that the Office accept the unredacted response and related FOIA evidence. [6]

It is also noted that patent owner argues that the CRU Director's decision returning the April 24, 2006 response to the final action dated February 22, 2006 was inconsistent with a prior petition decision dated March 20, 2006 denying a patent owner petition filed on January 23, 2006. [7] This argument will be separately addressed, *infra.*

A. The April 24, 2006 Response Was An Improper Paper, The Response Attached To The Present Petition Is An Improper Paper, And Both Papers Lack An Entry Right In The Merged Reexamination Proceeding

Pursuant to 35 U.S.C. § 306, an issue directed to the merits of a final rejection in an *ex parte* reexamination proceeding is appealable to the Patent and Trademark Office Board of Patent Appeals and Interferences. On the other hand, pursuant to 37 CFR 1.181(a), a petition to the USPTO Director is the appropriate vehicle to resolve matters not subject to appeal. It is further to be noted that, pursuant to 37 CFR 1.4(c), different matters raised in a given proceeding must be raised in separate papers. Finally, pursuant to 37 CFR 1.3, complaints against examiners and other Office employees "must be made in correspondence separate from other papers" which are not directed to complaints against examiners and other Office employees.

In the present instance, a review of the papers attached to the present petition indicates that (1) the papers are essentially the same as, if not identical to, the papers that were returned by the CRU Director's May 17, 2006 decision, and (2) these papers purport to be a response to the examiner's treatment of the pending claims in light of the prior art patents and publications applied to the claims by the examiner in the final action dated February 22, 2006. Pursuant to 37 CFR 1.550(a) (the rule that implements 35 U.S.C. § 305), *ex parte* reexamination proceeding is "conducted in accordance with [37 CFR] §§ 1.104 through 1.116." Therefore, the appropriate content of a 37 CFR 1.550(b) response to a final Office action in an *ex parte* reexamination proceeding is defined by 37 CFR 1.113(a) and 37 CFR 1.116. These regulations do not (contrary to petitioner's argument) provide for "further statements" that are unrestricted as to content. Instead, 37 CFR 1.113(a) and 37 CFR 1.116 require that a response to a final action address the issue of patentability of the pending claims with respect to the outstanding rejection, which, in this instance, is the examiner's treatment of the patentability of the claims in light of prior

[5] This would result in the commingling of the now-proffered set of papers with material that the examiner will have to consider.

[6] Petition at pages 10 *et. seq.*

[7] The petition and decision thereon referenced by patent owner are apparently those in the file records of *ex parte* reexamination control number 90/006,495 and *inter partes* reexamination proceeding 95/000,020, which have been merged into a single reexamination proceeding.

this instance, is the examiner's treatment of the patentability of the claims in light of prior patents and printed publications. In contrast, the papers attached to the present petition include material directed to issues other than the examiner's treatment of the patentability of the claims in light of prior patents and printed publications. In fact, large portions of the remarks contained in the response to the final action [8] and documents cited in support are directed to the conduct of Office employees/officials. Thus, large portions of the papers attached to the present petition, are not directed to issues of patentability of the pending claims in light of the applied prior art patents and printed publications. Therefore, these papers clearly constitute responses to the outstanding final Office action that are not proper under 37 CFR 1.550(b) and do not fall within the jurisdiction of the examiner. Accordingly, each of these papers submitted in response to the Office action lacks an entry right in the present merged reexamination proceeding for consideration by the examiner.

Further, 37 CFR 1.3 expressly precludes "complaints against examiners and other employees" submitted as part of papers directed to other matters. Thus, the patent owner's submission of documents in support of its allegations of misconduct and bias could not properly be included with papers directed to the question of patentability in view of prior art, because the clear and unequivocal language of 37 CFR 1.3 expressly requires that "employee conduct" issues are to be raised in correspondence separate from other papers. Here, patent owner improperly raises allegations of employee misconduct incorporated within papers directed to the merits of the examiner's position on the patentability of the pending claims in light of patents and printed publications as set forth in the final Office action. Therefore, the originally filed April 24, 2006 response and the response attached to the present petition are both improper for the reason that they fail to comply with the requirements of 37 CFR 1.3. Accordingly, each paper further lacks an entry right in the present merged reexamination proceeding for consideration by the examiner.

Moreover, 37 CFR 1.4(c) requires that different matters in a given proceeding appropriate for consideration by different branches within the Office must be raised in separate papers. However, patent owner's April 24, 2006 response to the final action improperly presented, in the same paper, both:

> (1) arguments and materials directed to the patentability of the claims in view of the patents and printed publications applied in the final Office action, and
>
> (2) allegations of employee misconduct and bias.

The patentability arguments are properly considered by the examiner. In contrast, allegations of employee misconduct and bias are considered by way of a petition to the appropriate Office official for the exercise of supervisory authority pursuant to 37 CFR 1.181(a), because alleged employee misconduct and bias relate to non appealable subject matter. Thus both the originally filed April 24, 2006 response and the response attached to the present petition are improper for the additional reason that they fail to comply with the requirements of 37 CFR 1.4(c).

Therefore, for the foregoing reasons, the April 24, 2006 patent owner response, and the June 23, 2006 response attached to the present patent owner petition are deemed improper and therefore these papers lack an entry right in the present merged reexamination proceeding. The disposition of improper papers will be treated as discussed in Section C., *infra*.

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[8] See, *e.g.*, the arguments at page 74-92 of the response. Note that even a single instance of an argument directed to matters that are not part of a proper response to a final action within the meaning of 37 CFR 1.113(a) and 37 CFR 1.116 would suffice to preclude entry of the entire response as lacking an entry right.

B. Further Discussion

1. While the patent owner's April 24, 2006 response to the Feb 24, 2006 final action and the response to the final action attached to the present petition each lack an entry right for consideration by the examiner as explained in Section II(A), patent owner may raise the issue of alleged employee misconduct by way of petition under 37 CFR 1.181(a). Note is taken of patent owner's statement that on March 20, 2006, the Office issued a decision in a separate proceeding, such decision denying a patent owner petition filed on January 23, 2006. [9] Patent owner correctly states that the January 23, 2006 petition was denied because it did not provide sufficient details. However, if patent owner is able to now supply those details, they must be submitted in a separate petition under 37 CFR 1.181, but cannot be submitted as part of a paper submitted for consideration by the examiner.

2. Patent owner's characterization of the May 17, 2006 decision issued by the CRU Director returning the April 24, 2006 response to the final Office action of February 22, 2006 is not wholly accurate. In actuality, the CRU Director's May 17, 2006 decision did not mean to imply that the FOIA papers would be barred from submission for any and all purposes. Rather, it properly points out that the papers were returned because they raised issues unrelated to patentability and therefore are not appropriate for consideration by the examiner. Therefore, the submitted papers did not comply with the regulations and practice regarding the submission of response papers. [10]

3. To the extent that patent owner disagrees with some or all of the rationale set forth in support of the CRU Director's decision, Section II(A) of the present decision amplifies the reasons in support of the conclusion reached in the CRU Director's May 17, 2006 decision to refuse entry and return the April 24, 2006 response with attached papers. Section II(A) of the present decision explains that the patent owner may indeed raise alleged employee misconduct and bias issues, but must do so via a separate petition under 37 CFR 1.181. Such a petition must conform to the governing regulations and practice, i.e., the petition regarding alleged employee misconduct must not be attached to papers directed to the substantive issue of claim patentability in light of the prior patents and printed publication. See 37 CFR 1.3 and 37 CFR 1.4(c).

4. As a final point on this matter, patent owner is not being deprived of due process by a refusal to accept papers that mingle allegations of misconduct (and documents supporting those allegations) with papers that are directed to other matters. Papers raising issues of alleged misconduct, and documents proffered in support of such allegation, are admissible in the Office only if they are provided in a manner that complies with the regulations.

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[9] See footnote 7, *supra*.

[10] Considering the fact that the papers in question were styled as a response to a final Office action, the material beginning at the last paragraph of page 2 of the May 17, 2006 CRU Director's decision and running through page 3 thereof indicates to the undersigned that the CRU Director was concerned with the mingling of prior art patent and printed publication patentability issues with the procedural issues raised by the allegations of misconduct and bias of raised in papers.

C. Disposition Of Papers

1. In this instance: (1) the April 24, 2006 presentation of the FOIA papers, (2) the April 24, 2006 declaration of Keith Anderson directed the FOIA papers, and (3) the remarks directed to the conduct of Office employees/officials that were included within the April 24, 2006 response to the final action have previously been found to be improper, and lacking an entry right in the present merged proceeding. These papers were previously returned, and a redacted form of these papers was entered into the record, as discussed above.

2. In addition, the patent owner has attached to the present petition the material that was refused entry and returned (by the CRU Director's May 17, 2006 decision), for entry into the record as part of patent owner's response to the February 22, 2006 Office action. These papers have now been found to be improper and therefore lack an entry right in the present merged proceeding to which they are directed. As these papers are determined to lack an entry right in the present merged reexamination proceeding, they will be returned in accordance with provisions of MPEP § 2267. In this instance it would be unduly burdensome to either physically return the large bulk of papers, or expend significant Office resources scanning the documents into the record and then closing them from view. [11] Therefore, the papers are being temporarily held for "pick up" in the Central Reexamination Unit (CRU). If the patent owner desires the physical return of the papers, then patent owner should promptly make arrangements to pick up the papers from the CRU **within one month** of the mailing date of this decision. Patent owner should immediately notify Norma Amador of the CRU, at telephone number (571) 272-6474, of any arrangements that have been made to pick up the papers. If the papers are **not** picked up **within one month** of the mailing date of this decision, **the CRU will dispose of the papers,** note being taken that the patent owner presumably has the originals.

3. As to the present petition, the petition contains facial allegations of employee misconduct and bias. Accordingly, though the petition itself will be retained of record in the IFW file, it is being marked as "non-public."

## CONCLUSION

1. The June 23, 2006 patent owner petition is dismissed.

2. The (1) the April 24, 2006 presentation of the FOIA papers, (2) the April 24, 2006 declaration of Keith Anderson directed the FOIA papers, and (3) the remarks directed to the conduct of Office employees/officials that were included within the April 24, 2006 response to the final action have been found to be improper papers lacking an entry right in the present merged proceeding to which they are directed. These papers will be marked "closed" and "non-public" **will form no part of the official record of the present merged reexamination proceeding.**

3. The papers attached to the present petition which appear to be the material that was refused entry and returned by the CRU Director's May 17, 2006 decision will be held for one month in the CRU in a single storage location, and thereafter will be discarded if not picked up by patent owner.

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[11] Patent owner has filed at least six other petitions corresponding to the present petition, and provided such papers as attachments to each filed petition.

4. The present petition will be retained of record in the IFW file and is being marked as "non-public."

5. A copy of this decision is being made of record in the merged reexamination proceeding, and the decision will therefore appear in the IFW record of *ex parte* reexamination proceedings 90/006,494, 90/006,681 and 90/007,726.

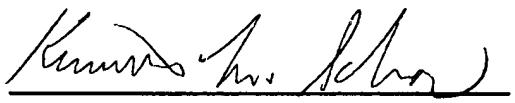
6. **All correspondence relating to an *inter partes* reexamination proceeding should be directed to:**

By Mail to: Mail Stop *Ex Parte* Reexam
ATTN: 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) 273-9900
Central Reexamination Unit

By hand: Customer Service Window
ATTN: Central Reexamination Unit
Randolph Building
401 Dulany St.
Alexandria, VA 22314

8. Telephone inquiries with regard to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or, in his absence, to the undersigned at (571) 272-7710.



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

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July 31, 2006

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(For Third Party Requester)

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/006,494
Filed: December 26, 2002
For: U.S. Patent No. 6,067,451

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/006,681
Filed: June 24, 2003
For: U.S. Patent No. 6,067,451

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/007,726
Filed: September 22, 2005
For: U.S. Patent No. 6,067,451

**DECISION DENYING PETITION**

This is a decision on the October 23, 2006 patent owner petition styled "Petition Pursuant to 37 CFR 1.181 or Alternatively, 37 CFR 1.182 Or Alternatively 37 CFR 1.183 to Reconsider Decision, *Sua Sponte*, 'Returning' Improper Papers and Alternatively That the Commissioner Declare His Decision A Final Agency Action." [1,2]

The petition and the above-captioned reexamination proceedings are before the Office of Patent Legal Administration for consideration.

The petition is granted to the extent that (1) the "Decision, *Sua Sponte*, Dismissing Petition and 'Returning' Improper Papers" [3] dated August 23, 2006, has been reconsidered, and (2) the

[1] The present petition paper is fully treatable pursuant to 37 CFR 1.181, and it is thus unnecessary to consider the petition paper under either 37 CFR 1.182 or 37 CFR 1.183. A petition fee is not required.
[2] The present paper will hereinafter be referred to as "Petition for Reconsideration."
[3] Hereinafter "Decision Dismissing Petition."

present decision has been designated as a final agency action under 35 U.S.C. § 704. For the reasons discussed below, the underlying relief requested by petitioner patent owner is denied.

## REVIEW OF SALIENT FACTS

1. U.S Patent number 6,067,451 ("the '451 patent") issued to Campana *et al* on May 23, 2000, from an application filed on September 28, 1998.

2. On December 26, 2002, a Director Initiated Order for Reexamination of the '451 patent was mailed. The resulting *ex parte* reexamination proceeding was assigned control number 90/006,494 ("the '494 reexamination proceeding").

3. On June 24, 2003, a request for a second ex *parte* reexamination of the '451 patent was filed by a third party requester, and the resulting proceeding was assigned control number 90/006,681 ("the '681 reexamination proceeding").

4. On September 3, 2003, an examiner's Order Granting *Ex Parte* Reexamination was mailed for the '681 reexamination proceeding.

5. On May 26, 2004, the Technology Center Director issued a decision, *sua sponte*, by which the '494 reexamination proceeding and the '681 reexamination proceeding were merged into a single consolidated reexamination proceeding.

6. On September 22, 2005, a request for a third *ex parte* reexamination of the '451 patent was filed. The resulting proceeding was assigned control number 90/007,726 ("the '726 reexamination proceeding").

7. On September 30, 2005, the examiner's Order Granting *Ex Parte* Reexamination was mailed for the '726 reexamination proceeding.

8. On January 4, 2006, a Freedom of Information Act ("FOIA") Request was made to the Office requesting the Office's communications with third parties regarding the present reexamination proceedings, as well as pending reexamination proceedings being conducted on other of patent owner's patents.

9. The Office responded to the FOIA request through letters dated between February 8 and March 24, 2006. [4]

10. Following prosecution on the patentability of the '451 claims, a final rejection Office action was issued in the '434 - '681 merged reexamination proceeding on February 22, 2006.

11. On March 1, 2006, the Central Reexamination Unit (CRU) Director issued a decision, *sua sponte*, by which the '494 reexamination proceeding, the '681 reexamination proceeding and the '726 reexamination proceeding were merged into a single consolidated reexamination proceeding. [5]

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[4] An additional response to the FOIA request was mailed by the Office on June 15, 2006, and received by patent owner on June 16, 2006.

[5] Jurisdiction of the merged '494 and '681 reexamination proceedings had previously been transferred from the Technology Center to the CRU.

12. On April 24, 2006, patent owner filed both a notice of appeal and an information disclosure statement (IDS) in the single combined reexamination proceeding.

13. Also on April 24, 2006, patent owner filed a paper styled as a response to the final rejection, which included a traverse of the final rejection, copies of material obtained as a result of the FOIA request, and a number of statements in support of patent owner's traverse.

14. On May 17, 2006, the CRU Director mailed a decision returning the April 24, 2006 patent owner response to the final rejection without consideration on the merits. The return was grounded on the impropriety of the papers, because they were not limited to consideration of prior patents and printed publications, and also because portions of the submission were not in compliance with the requirements of 37 CFR 1.3. Accordingly, the returned response was not entered into the record.

15. On May 22, 2006, patent owner filed a redacted version of the April 24, 2006 response, which is limited to material addressing the outstanding final rejection Office action, and which has been entered into the IFW record for the merged proceeding.

16. On June 23, 2006, patent owner filed a petition requesting reconsideration of the CRU Director's May 17, 2006 decision. Patent owner attached to the petition the material that had been refused entry and returned (by the CRU Director's May 17, 2006 decision), and requested entry of that material into the record, as part of patent owner's response to the February 22, 2006 final Office action.

17. On August 23, 2006, the June 23, 2006 patent owner petition was dismissed, [6] and was "returned" to petitioner by permitting petitioner to schedule a time to pick up the material (together with similar material from other concurrently filed related petitions). [7]

18. On October 23, 2006, petitioner patent owner filed the present Petition for Reconsideration of the August 23, 2006 petition decision.

## DECISION

### I. Relevant Statutes, Regulations and Practice

35 U.S.C. § 132 provides:

> "(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.
>
> (b) The Director shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant. The Director may establish appropriate fees for such continued examination and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under section 41(h)(1) of this title."

35 U.S.C. § 301 provides in pertinent part:

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[6] See discussion at pages 5-7, *infra*.

[7] No such pick up was scheduled, and none was made.

"Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent."

35 U.S.C. § 302 provides 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. § 303(a) provides in pertinent part:

"Within 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. § 305 provides, in pertinent part:

"After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent."

35 U.S.C. § 306 provides:

"The patent owner involved in a reexamination proceeding under this chapter may appeal under the provisions of section 134 of this title, and may seek court review under the provisions of sections 141 to 145 of this title, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent."

37 CFR 1.3 provides:

"Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Director and will not be entered. A notice of the non-entry of the paper will be provided. **Complaints against examiners and other employees must be made in correspondence separate from other papers.**" [Emphasis added.]

37 CFR 1.4(c) provides:

"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."

37 CFR 1.113(a) provides, in part:

"On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon ... for *ex parte* reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. **Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181).** ..." [Emphasis added.]

37 CFR 1.116(a)-(e) provide, in part:

"(a) An amendment after final action must comply with § 1.114 or this section.

(b) After a final rejection or other final action (§ 1.113) ... in an *ex parte* reexamination filed under § 1.510 ... 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 ... patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

(c) The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the ... reexamination proceeding from its condition as subject to appeal or to save ... the reexamination prosecution from termination under § 1.550(d) ... .

(d) (1) ...
(2) Notwithstanding the provisions of paragraph (b) of this section, an amendment made after a final rejection or other final action (§ 1.113) in an ex parte reexamination filed under §1.510 ... may not cancel claims where such cancellation affects the scope of any other pending claim in the reexamination proceeding except ... as permitted by § 41.77(b)(1) of this title.

(e) An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) ... in an ex parte reexamination filed under § 1.510 ... but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. "

37 CFR 1.181(a)(1) provides that petition may be taken to the Director:

"**From any action** or requirement of any examiner in the *ex parte* prosecution of an application, or **in *ex parte*** or *inter partes* prosecution **of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court.**" [Emphasis added.]

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

"(a) All *ex parte* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office. **After issuance of the *ex parte* reexamination order and expiration of the time for submitting any responses, the examination will be conducted in accordance with §§ 1.104 through 1.116** and will result in the issuance of an *ex parte* reexamination certificate under § 1.570. [Emphasis added.]

(b) The patent owner in an *ex parte* reexamination proceeding will be given at least thirty days to respond to any Office action. **In response to any rejection,** such response may include further statements and/or proposed amendments or new claims to place the patent in a condition where all claims, if amended as proposed, would be patentable." [Emphasis added.]

MPEP § 2267 provides in pertinent part:

"The return of inappropriate submissions complies with the regulations that certain papers will not be considered and also reduces the amount of paper which would ultimately have to be scanned into the record.

I. DISPOSITION OF PAPERS
Where papers are filed during reexamination proceedings which are inappropriate because of some defect, such papers will either be returned to the sender or forwarded to one of three files, the "Reexamination File" (paper file or IFW file history), the "Patent File" (paper file or IFW file history), or the "Storage File" (paper

file). Any papers returned to the sender from a Technology Center (TC) must be accompanied by a letter indicating signature and approval of the TC Director." [8]

## II. Basis For The August 23, 2006 Decision

On April 24, 2006, patent owner filed a response to an outstanding Office action dated February 22, 2006. That paper was returned to patent owner without consideration on the merits as an inappropriate submission. [9] The paper was considered to be inappropriate by the Central Reexamination Unit Director, (1) because the paper was not limited to consideration of prior patents and printed publications, [10] and (2) because portions of that paper were not in compliance with the requirements of 37 CFR 1.3. On June 23, 2006, patent owner requested reconsideration of the return of those papers by way of a petition for reconsideration. Patent owner attached to that petition for reconsideration the material that had previously been refused entry. A decision issued August 23, 2006, setting forth in detail the basis for refusing the underlying relief requested in the June 23, 2006 request for reconsideration, and for again returning the material that was not proper for entry into the record of the present merged reexamination proceeding.

It was pointed out in the August 23, 2006 decision, in explanation of why the underlying relief requested by petitioner would not be appropriate, that:

> A) Pursuant to 35 U.S.C. § 306, an issue directed to the merits of a rejection in an *ex parte* reexamination proceeding is ultimately appealable to the Patent and Trademark Office Board of Patent Appeals and Interferences (the Board). On the other hand, pursuant to 37 CFR 1.181(a), a petition to the USPTO Director is the appropriate vehicle to resolve matters not subject to appeal.
>
> B) Pursuant to 37 CFR 1.3, complaints against examiners and other Office employees "must be made in correspondence separate from other papers" which are not directed to complaints against examiners and other Office employees.
>
> C) Pursuant to 37 CFR 1.4(c), different matters raised in a given proceeding must be raised in separate papers.

These points have not been persuasively addressed in the present request for reconsideration.

### A. The April 24, 2006 Papers Did Not Comply With 37 CFR 1.113(a) and 37 CFR 1.116

The April 24, 2006 papers purported to be a response directed to the outstanding final Office action dated February 22, 2006. Pursuant to 37 CFR 1.550(a), the present merged reexamination proceeding is to be conducted in accordance with sections 1.104 through 1.116 of Title 37 of the Code of Federal Regulations. Those regulations implement the provisions of 35 U.S.C § 132. 37 CFR 1.113(a) and 37 CFR 1.116 specifically require that a response to a final Office action address issues of patentability of the pending claims that are subject to an outstanding final rejection. The April 24, 2006 papers did contain material directed to the issue of the patentability of the claims of the patents being reexamined that are required to be resolved by appeal to the Board. However, in direct contravention of 37 CFR 1.113(a), the April 24, 2006

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[8] When the CRU has jurisdiction, as in the case of this merged proceeding, the CRU Director would approve and sign the letter accompanying returned papers.

[9] See MPEP § 2267.

[10] See 35 U.S.C. §§ 301-303.

papers also contained comments and documents that were not directed to the merits of the outstanding rejection (*i.e.*, not directed to appealable matters). These additional comments and documents were instead directed to matters of alleged misconduct on the part of Office employees/officials, and requested relief that is only available by way of petition to the USPTO Director, and not by an appeal to the Board.[11] Accordingly, the April 24, 2006 papers failed to comply with 37 CFR 1.113(a) and 37 CFR 1.116.

Petitioner is also referred to MPEP § 1201 which states, in pertinent part:

> Where the differences of opinion concern the denial of patent claims because of prior art or other patentability issues, the questions thereby raised are said to relate to the merits, and appeal procedure within the Office and to the courts has long been provided by statute (35 U.S.C. 134).
> The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Director of the U.S. Patent and Trademark Office (Director) should be carefully observed. The Board will not ordinarily hear a question that should be decided by the Director on petition, and the Director will not ordinarily entertain a petition where the question presented is a matter appealable to the Board.

In this instance, the entry of the additional comments and documents directed to matters of alleged misconduct on the part of Office employees/officials would inappropriately place materials unrelated to the merits of patentability before the examiner. Not only would entry of these materials confuse and overburden the record, but also these materials simply are not permitted to be, and will not be, made available for consideration by the examiner in determining the patentability of the claims.

B. The April 24, 2006 Papers Did Not Comply With 37 CFR 1.3

37 CFR 1.3, last sentence, prohibits the submission of "complaints against examiners and other employees" of the Office as a part of papers directed to other matters before the Office. The "returned" April 24, 2006 papers included complaints regarding the conduct of Office employees, and these complaints were submitted as part of papers directed to other matters, *i.e.*, the issues of claim patentability in this merged proceeding. Accordingly, the April 24, 2006 papers are barred by 37 CFR 1.3.

C. The April 24, 2006 Papers Did Not Comply With 37 CFR 1.4(c)

37 CFR 1.4(c) requires that, within a given proceeding, material directed to matters that will be considered by different branches within the Office be raised in separate papers. Yet, the April 24, 2006 papers included complaints regarding conduct together with material directed to the issues of claim patentability, notwithstanding that these separate issues are decided by different branches of the Office and resolved by different appellate review tribunals: (1) decision on petition to the USPTO Director and (2) consideration by the Primary Examiner which may ultimately be reviewed by the Board. Accordingly, the April 24, 2006 papers are barred by 37 CFR 1.4(c).

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[11] See, for example, the arguments at page 74-92 of the supplemental response filed April 24, 2006, that was to be disposed of if not "picked up" by the patent owner in accordance with the August 23, 2006 Decision on Petition. Note that even a single instance of an argument directed to matters that are not part of a proper response to a nonfinal action within the meaning of 37 CFR 1.111(b) would suffice to preclude entry of the entire supplemental response as lacking an entry right.

## III. Findings And Analysis With Respect To The Present Petition For Reconsideration

### A. Patent Owner's Position Is Fundamentally Flawed

Petitioner patent owner argues that there has been improper conduct on the part of Office employees. [12] Patent owner apparently also believes that it has evidence of bias specifically on the part of one or more examiners, [13] and that this evidence, as previously submitted on April 24, 2006, should not be barred from examiner consideration because it bears on issues of patentability. Thus, petitioner patent owner urges that 37 CFR 1.3 should not preclude presentation to the examiner of the material alleging bias (even where bias alleged on the part of the examiner is alleged), because bias bears on patentability issues. Similarly, patent owner argues that 37 CFR 1.4(c) is inapplicable, because evidence of bias addresses the same patentability issues as the remainder of patent owner's substantive reply. [14]

Initially, patent owner has not shown how bias will change whether a claim is patentable over a reference or not. If the patent owner believes that there is a bias that would influence an examiner involved, or another Office employee conducting the examination of the claims for patentability, the proper avenue to address that would be via a 37 CFR 1.182 petition to remove the examiner or other Office employee, not by presenting the allegation of bias to the accused examiner for determination. Also, patent owner's position **assumes** that the evidence presented by patent owner **actually establishes bias**. However, the question of whether the material presented by patent owner in support of patent owner's allegations of bias in fact establishes bias on the part of any Office personnel is an open question that has not yet been decided. Patent owner further assumes that the examiner is the appropriate Office employee to view alleged evidence of bias on the part of Office officials (and on the part of the examiner) in order to make a finding that bias in fact existed. However, the examiner's authority extends to making patentability determinations. The examiner does not exercise supervisory authority with respect to the alleged bias or misconduct on the part of other Office employees.

Pursuant to 35 U.S.C. § 306, an issue directed to the merits of a rejection in an *ex parte* reexamination proceeding is ultimately appealable to the Board, and then to the courts. All matters not subject to appeal to the Board under 35 U.S.C. § 306 are subject to resolution by way of petition under 37 CFR 1.181. Further, 37 CFR 1.3 prohibits complaints about employee conduct to be included within the same papers addressing the merits of patentability. Therefore, the proper avenue for obtaining review of an allegation of procedural impropriety, misconduct or bias on the part of Office personnel would be through petition to appropriate Office officials (as pointed out above). Any decision on such a petition that is adverse to patent owner would be subject to court review in the same manner as any other question of administrative procedure would be reviewed. [15] It is not reasonable to state that the evidence **alleged** to support bias on the part of Office officials, and/or on the part of the examiner, should be placed into the record of the present merged reexamination proceeding before the examiner for review and evaluation by the examiner as part of a patentability determination. Further, some of the allegations of bias are directed to the conduct of the examiner, making it far from clear that the examiner could objectively evaluate the allegations of the examiner's own bias. Yet, as noted above, patent owner appears to have raised the argument that the evidence of examiner bias should be forwarded to the examiner for consideration. Such consideration

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[12] See pages 3-4 of the present Petition for Reconsideration.

[13] See, for example, the headings on pages 4 and 7 of the present Petition for Reconsideration.

[14] See pages 7-9 of the present Petition for Reconsideration.

[15] Non-appealable subject matter reviewed by petition under 37 CFR 1.181 is subject to judicial review under the Administrative Procedures Act.

has, to date, been refused solely on the basis that patent owner has filed a single paper that conflated and intermingled these issues, rather than filing two separate papers that are each directed only to the area of the Office that would properly consider only that paper. [16]

By way of expansion on the above discussion, patent owner is reminded that patent examiners are Office personnel who are charged with evaluating evidence bearing on questions of patentability. In the present merged reexamination proceeding, the examiner's consideration of patentability is limited by 35 U.S.C. §§ 301 - 303 to a consideration of prior patents and printed publications. [17] Examiners are not charged with evaluating evidence of impropriety, misconduct or bias, by examiners or other Office personnel. Also, until the patent owner's evidence and allegations of misconduct are properly evaluated by the appropriate Office personnel, they cannot have any affect on action taken by the Office.

As a final point, patent owner is not being deprived of due process by a refusal to accept papers that co-mingle allegations of misconduct (and documents supporting those allegations) with papers that are directed to other matters. Papers raising issues of alleged misconduct, and documents proffered in support of such allegation, are admissible in the Office, and can properly be submitted for consideration by the Office, but only if they are provided in a manner that complies with the regulations.

B. 37 CFR 1.3 and 37 CFR 1.4(c) Each Precludes The Relief Requested By Petitioner Patent Owner

It is manifestly clear that both 37 CFR 1.3 and 37 CFR 1.4(c) each prohibit patent owner from co-mingling arguments directed to issues of the patentability of the claims with arguments and evidence in support of allegations of procedural impropriety and bias on the part of Office personnel. Those allegations are as yet unproven, and cannot be properly considered to presently establish any basis for reassignment of examining responsibilities. This is not the same as concluding that the regulations preclude **the presentation** of evidence of bias, as patent owner argues, [18] (notwithstanding that the Office has never taken such position [19]). The Office is not refusing to consider patent owner's alleged evidence, but simply is requiring that patent owner's evidence and allegations be presented in accordance with its rules which require them to be directed to the appropriate Office personnel for consideration and evaluation.

To the extent that the present petition again presents the allegation that 37 CFR 1.3 is inapplicable because patent owner has not violated decorum or been discourteous in this proceeding, [20] and also cites case law that is alleged to establish that 37 CFR 1.3 is inapplicable on the facts in this proceeding, patent owner is reminded that the August 23, 2006 Decision on Petition was in no manner based upon patent owner's conduct. Rather, 37 CFR 1.3 was applied because it requires that complaints of misconduct on the part of examiners and Office personnel "must be made in correspondence separate from other papers." [21] This language manifestly includes, as part of the class of "other papers" in which complaints of misconduct may not be

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[16] Given that reexaminations are conducted with special dispatch, it is puzzling that patent owner has not seen fit to comply with the relatively straightforward and simple requirements of the 37 CFR 1.3 and 1.4(c) by filing two separate papers, since by doing so, patent owner would have immediately placed before the proper areas of the Office both the conduct issues and the substantive patentability issues for consideration by the appropriate Office personnel.

[17] Extrinsic evidence explaining the content of prior patents and printed publications may be considered as well.

[18] See page 5 of the present petition, last sentence in the paragraph bridging pages 4 and 5.

[19] See for example, Decision Dismissing Petition dated August 23, 2006, section II(B), items 1 and 4.

[20] See the present petition, beginning at the bottom of page 4 and running through page 5.

[21] See Decision on Petition, August 23, 2006, page 7, first full paragraph.

raised, "papers directed to the merits of claim patentability in any proceeding in which the misconduct is alleged to have occurred."

Moreover, none of the case law cited by patent owner at page 5 of the present petition supports patent owner's position that 37 CFR 1.3 has been misapplied. Here, the Office is not prohibiting the patent owner from submitting evidence regarding its allegations; rather, the Office is simply directing material to the appropriate Office official for review of patent owner's complaint in accordance with the requirements established by 37 CFR 1.3 that employee conduct complaints "must be made in correspondence separate from other papers." None of the cases relied upon by patent owner demonstrate that the Office may not enforce the clear language of 37 CFR 1.3 by requiring papers containing complaints about the conduct of Office officials and personnel to be filed separately from other papers related to the merits of patentability.

Patent owner's argument that 37 CFR 1.4(c) should not prohibit examiner consideration of the merits of patent owner's arguments regarding the existence of bias is similarly fatally flawed. First, 37 CFR 1.4(c) does not preclude consideration of the merits of patent owner's allegations of bias, impropriety or misconduct on the part of Office officials and employees. The record does not show that the Office has taken the position that the allegations raised by patent owner cannot or will not be considered. 37 CFR 1.4(c) merely directs the orderly manner in which such allegations, and the evidence in support of such allegations, must be presented to the Office - for consideration by the proper Office officials. In this instance, 37 CFR 1.4(c) applies, because it requires that matters such as questions of bias or inappropriate conduct by Office personnel, which matters are appropriate for consideration by an Office official in one particular area of the Office, be submitted in a paper *separately* from papers containing substantive patentability issues, which are properly decided by a different Office official of employee in a different area of the Office. As pointed out above, the patent examiner is not the proper Office official to consider and rule on patent owner's allegations of bias, impropriety and misconduct; and thus, such allegations and materials supporting such allegations, are not proper for inclusion in the IFW record as a part of papers otherwise directed to patentability issues. The fact that the "examiner" is one of the employees that is accused of misconduct further highlights the appropriateness of the procedural safeguards provided by the rules. Clearly, the employee accused of alleged misconduct cannot be the official who will decide the issue. Moreover, the rule protects the integrity of the file history by separating employee complaints from the merits of examination.

Thus, 37 CFR 1.4(c) precludes entry of the papers submitted as a part of the June 23, 2006 petition, because the regulation properly requires that:

> matters bearing on the determination of patentability in this proceeding, and
>
> matters directed to a determination of the propriety of the allegations of misconduct, bias or impropriety on the part of Office officials and the examiner

be submitted in separate papers inasmuch as these issues are decided by different Office officials/employees in different areas of the Office.

C. 37 CFR 1.113(a) and 37 CFR 1.116 Preclude The Relief Requested By Patent Owner

37 CFR 1.113(a) and 37 CFR 1.116 provide that a response to a final Office action must, *inter alia*, specifically point out supposed errors in the examiner's action, and point out the specific distinctions believed to render the claims patentable over the prior art. The regulation does not

provide for "further statements" that address matters other than the issues of patentability raised in the outstanding Office action. The failure of the April 24, 2006 patent owner submission to comply with 37 CFR 1.113(a) and 37 CFR 1.116 was discussed at pages 6-7 of the Decision Dismissing Petition dated August 23, 2006. It was pointed out that the April 24, 2006 patent owner submission was not confined to responding to the final Office action as required by 37 CFR 1.113(a), but instead intermingled matter directed to other issues (the issues of alleged misconduct on the part of Office personnel).

In the present petition patent owner has not directly addressed this point. To the extent that patent owner's general argument that the allegations of misconduct are in fact relevant to the issues of patentability, those arguments are wholly unpersuasive for the reasons set forth in Section III (A) above. Therefore, it is again concluded that the August 23, 2006 Decision Dismissing Petition properly refused entry of the April 24, 2006 patent owner as being non-compliant with 37 CFR 1.113(a) and 37 CFR 1.116.

## CONCLUSION

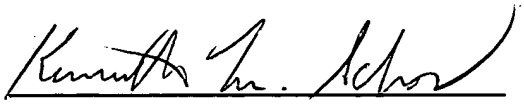
1. The October 23, 2006 patent owner petition is granted to the extent that the August 23, 2006 Decision Dismissing Petition has been fully reconsidered, and that the present decision will be designated as a final agency decision.

2. The October 23, 2006 patent owner petition is denied with respect to disturbing the holding of the August 23, 2006 Decision Dismissing Petition which refused to enter the papers attached to patent owner's June 23, 2006 Petition and which "returned" those papers.

3. A copy of this decision is being made of IFW record for the merged reexamination proceeding, and the decision will therefore appear in the IFW record of *ex parte* reexamination proceedings 90/006,494, 90/006,681 and 90/007,726.

4. Telephone inquiries with regard to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or, in his absence, to the undersigned at (571) 272-7710.

5. This decision is a final agency action within the meaning of 5 U.S.C. § 704.



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

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February 22, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

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Ex parte Campana et al.

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Appeal No. 2008-1116
Reexamination Control Nos. 90/006,494,
90/006,681 and 90/007,726
Patent No. 6,067,451

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Mailed: June 24, 2008

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DECISION ON PETITION

This is a decision on the "Petition Under §41.3 for Consolidating Related Appeals for Hearing and Argument," filed March 19, 2008 ("Petition"). The Petition will be treated as a petition to the Chief Administrative Patent Judge under 37 C.F.R. § 41.3(b).

FINDINGS

1. The present appeal was docketed on December 31, 2007.

2. Appellants allege that they are parties to seven other related appeals including six additional patents involved ex parte reexamination proceedings and one additional patent involved in an inter partes reexamination proceeding. Petition at 2-3. Further, Appellants allege that all of these

appeals involve the same basic technical disclosure, common legal issues, and common technical issues. *Id.* at 3-6.

3. None of the seven additional appeals has yet been docketed by the Board of Patent Appeals and Interferences ("Board"). *Id.* at 3.

4. By the Petition, Appellants seek to consolidate the oral hearings in the eight related appeals, noting significant commonality in the effect on the appealed claims in the eight related patents of decisions on common key issues.

## DISCUSSION

The Board agrees that consolidation of oral hearings may be proper in appropriate circumstances. Before an appeal can be scheduled for oral hearing, however, it must be docketed at the Board. Since only one of the eight appeals here involved has been docketed at the Board, it is premature to schedule a consolidated hearing for the seven undocketed appeals

## DECISION

In view of the foregoing, the Petition is DISMISSED as premature, without prejudice to being renewed after all of the involved appeals have been docketed at the Board.

Michael R. Fleming
Chief Administrative Patent Judge

Appeal No. 2008-1116
Reexamination Control Nos. 90/006,494,
90/006,681 and 90/007,726
Patent No. 6,607,451

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Paper No. 10

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(For Patent Owner)

MAILED

APR 0 1 2003

REEXAM UNIT

Enclosure: Patent Owner Petition and attachments filed March 14, 2003

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| In re Campana, Jr. et al. | : | |
| Reexamination Proceeding | : | DECISION DISMISSING |
| Control No. 90/006,495 | : | PETITION AND RETURNING |
| Initiated: December 26, 2002 | : | IMPROPER PAPER |
| For: U.S. Patent No. 6,317,592 | : | |

This is a decision on the March 14, 2003, patent owner petition entitled "PETITION PURSUANT TO 37 C.F.R. § 1.183 TO ENLARGE THE TWO MONTH TIME LIMIT FOR FILING A SUPPLEMENTAL PATENT OWNER'S STATEMENT PURSUANT TO 37 CFR § 1.530." The petition is before the Office of Patent Legal Administration for decision.

For the reasons set forth below, the petition is dismissed and is being returned along with this decision.

**REVIEW OF FACTS**

1. On December 26, 2002, reexamination was ordered for five of Patent Owner's patents. The order for reexamination was issued at the initiative of the Director of the United States Patent and Trademark Office under 37 CFR 1.520. The patents and their assigned control number are: 5,625,670 (90/006,491); 5,631,946 (90/006,492); 5,819,172 (90/006,493); 6,067,451 (90/006,494); and 6,317,592 (90/006,495). The present reexamination proceeding is reexamination control number 90/006,495.

2. On February 26, 2003, Patent Owner filed (a) a Patent Owner's Statement under Protective Order (Paper No. 3), (b)an Expert Declaration submitted under Protective Order (Paper No. 4), (c) a Declaration of Donald E. Stout pursuant to 37 CFR 1.131 (Paper No. 5), (d) a Declaration of Thomas J. Campana, Jr. pursuant to 37 CFR 1.131 (Paper No. 6), and (e) an Information Disclosure Statement under 37 CFR 1.555 (Paper No. 7).

3. On March 5, 2003, Patent Owner filed copies of date-stamped postcard receipts (Paper No. 8) evidencing the timely filing of the February 26, 2003, papers. The original papers which had been missing date-stamps were then date-stamped as received on February 26, 2003, pursuant to the evidence provided by Patent Owner.

4. On March 14, 2003, Patent Owner filed the present petition under 37 CFR 1.183 requesting "suspension of the two-month time limit set for the response to the Order for Reexamination" to permit entry of the *accompanying* "Supplemental Patent Owner's Statement Pursuant to 37 CFR 1.530"

5. On March 26, 2003, a "DECISION CONCERNING PAPERS FILED BY PATENT OWNER" was issued by the Technology Center 2600 Special Programs Examiner, stating that "the papers filed [February 26, 2003] under Protective Order have been removed from the envelopes and made of record."

6. The present file was then forwarded to the Office of Patent Legal Administration for a decision on the petition.

**DECISION**

37 CFR 1.540 states:

> No submissions other than the statement pursuant to § 1.530 and the reply by the *ex parte* reexamination requester pursuant to § 1.535 will be considered prior to examination.

The examination stage of the present proceeding has not yet begun, as a first Office action on the merits has not yet been issued. The present March 14, 2003, submission is not a "reply by the *ex parte* reexamination requester pursuant to § 1.535," since it is filed by the patent owner. Further, the submission is not a Patent Owner's statement pursuant to § 1.530, because the Patent Owner's statement pursuant to § 1.530 was already filed on February 26, 2003. Pursuant to 35 U.S.C. 304, the patent owner is

given a reasonable period "within which he may file **a statement**" [Emphasis added] on the question of patentability raised in the order for reexamination. There is no provision in the statute for more than one statement, i.e., there is no provision for a second statement to supplement the first statement.

Since the present March 14, 2003, submission is submission is not a "statement" nor a "reply," entry of same is barred under 37 CFR 1.540.

37 CFR 1.530(b) states:

> The order for *ex parte* reexamination will set a period of not less than two months from the date of the order **within which the patent owner may file a statement on the new question of patentability**, including any proposed amendments the patent owner wishes to make. [Emphasis Added]

Under 37 CFR 1.530(b), the Patent Owner may file the statement *only* within the period set therein. The period set in the December 26, 2002, order for *ex parte* reexamination was two months. Accordingly, the present March 14, 2003, submission would not be timely, even if it were a proper statement under 37 CFR 1.530.

In view of the above, the March 14, 2003, submission of Patent Owner's petition and the accompanying "Supplemental Patent Owner's Statement Pursuant to 37 CFR 1.530" is an improper submission under 37 CFR 1.530(b) and under 37 CFR 1.540. Accordingly, the submission will not be made of record in the reexamination file and is being returned herewith. MPEP 2267. See *In re Knight*, 217 USPQ 294 (Comm'r Pat. 1982); *Patlex Corp. v Mossinghoff*, 226 USPQ 985, 986 (Fed. Cir. 1985). This decision will, however, be made of record in the reexamination file.

As to petitioner's request to waive the rules pursuant to 37 CFR 1.183:

Patent Owner's request for "suspension of the two-month time limit set" in the order is, in effect, a request that the Director to waive the provisions of 37 CFR 1.530(b) and permit (1) entry of the instant petition and accompanying "Supplemental Patent Owner's Statement Pursuant to 37 CFR 1.530," and (2) consideration of same when the examiner issues the first Office action on the merits. A waiver of the requirement to file the statement within the two month time period (set in the order) will not, however, provide Patent Owner with the relief Patent Owner desires, since consideration of the March 14, 2003,

submission would still be barred under 37 CFR 1.540, because the present March 14, 2003, submission is not a "statement" nor a "reply" as discussed above.

Accordingly, Patent owner's petition is taken as a request to waive the provisions of 37 CFR 1.540 and permit entry of a submission other than a statement pursuant to § 1.530 and a reply pursuant to § 1.535.

In order for grant of a petition under 37 CFR 1.183, a petitioner must show (1) that there is an extraordinary situation (2) where justice requires waiver of the rule. *In re Sivertz*, 227 USPQ 255, 256 (Comm'r Pat. 1985). Petitioner Patent Owner has not show that either condition exists in this case.

The present March 14, 2003, submission, for which entry and consideration in the first Office action is requested, provides a paper that was presented in litigation related to the patent being reexamined, and discusses what Patent Owner believes to be the significance of that paper. If entry is not provided at this point, Patent Owner is free to re-submit the March 14, 2003, submission during the examination stage of the present proceeding, i.e., after the first Office action is issued. At that point, the submission would have an entry right and would be considered by the examiner. There is no showing in the petition that re-submission during the examination stage would prejudice Patent Owner as to the consideration of the information presented (in the submission) in a manner as to create an extraordinary situation where justice requires waiver of the provisions of 37 CFR 1.540. Accordingly, the relief provided by 37 CFR 1.183 is not appropriate in this instance, [1] and the present petition pursuant to 37 CFR 1.183 is dismissed.

**CONCLUSION**

1. The March 14, 2003, patent owner petition filed pursuant to 37 CFR 1.183 is dismissed, and it is being returned along with this decision.

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[1] Note that the Office will not normally consider an extraordinary remedy when the rules already provide an avenue for obtaining the relief sought. *See Cantello v. Rasmussen*, 220 USPQ 664 (Comm'r Pat. 1982).

3. The reexamination file is being returned to Technology Center 2600 for storage until a reply under 37 CFR 1.535 is received, or the time for filing same expires, after which a first Office action on the merits is to be issued.

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

April 1, 2003
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Paper No. 21

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Orlando, Florida 32802

MAILED

AUG 09 2004

REEXAM UNIT

In re Campana et al
*Ex parte* Reexamination Proceeding
Control No. 90/006,495
Filed: January 26, 2002
For: U.S. Patent No. 6,317,592

In re Campana et al
*Inter partes* Reexamination Proceeding
Control No. 95/000,020
Filed: May 29, 2003
For: U.S. Patent No. 6,317,592

**DECISION, *SUA SPONTE*, MERGING *Ex Parte* and *Inter Partes* 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 C.F.R. § 1.989 at this time.

## REVIEW OF FACTS

1. United States Patent No. 6,317,592, issued to Campana et al., on November 13, 2001.

2. An order for *ex parte* reexamination, assigned Reexamination Control No. 90/006,495 ('6495), was mailed December 26, 2002, at the initiative of the Director of the United States Patent and Trademark Office.

3. On February 26, 2003, a patent owner's statement pursuant to 37 C.F.R. § 1.530 was received in the '6495 proceeding.

4. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,020 ('020), was filed May 29, 2003, by third party requester David Stewart, for Research in Motion (RIM).

5. On August 12, 2003, in the '020 proceeding, and on August 14, 2003, in the '6495 proceeding, the patent owner filed a notice of concurrent proceedings under 37 C.F.R. § 1.985, advising the Office of a decision dated August 5, 2003, appealable within 30 days under Federal Rules of Appellate Procedure Rules 3 and 4, issued by the U.S. District Court for the Eastern District of Virginia, which held that the defendant (the requester RIM) had not sustained its' burden of proving the invalidity of any patent claim in the '592 patent. The notice informed the Office of an order issued in *NTP, Inc. v. Research In Motion*, C.A. # 3:01CV767 (E.D.Va., August 5, 2003), and provided a copy of the order and its' accompanying memoranda and other orders issued. In the order, the defendant, RIM, was found to have infringed certain of plaintiff NTP's patent claims in the '592 patent.

6. Reexamination was ordered pursuant to 37 C.F.R. § 1.931 in the '020 proceeding on August 26, 2003. The decision ordering the *inter partes* reexamination also notified the parties to the reexamination that the decision in the litigation referred to in the notice of concurrent proceedings may be grounds for termination of the instant proceeding.

7. On September 8, 2003, the requester appealed the District Court decision in *NTP, Inc. v. Research In Motion*, *supra*, to the United States Court of Appeals for the Federal Circuit.

8. On October 10, 2003, patent owner filed a petition under 37 C.F.R. § 1.181 in the '020 proceeding, requesting that the *inter partes* reexamination proceeding be dismissed, *i.e.*, terminated. Patent owner argued that the Court's holding and decision in *NTP, Inc. v. Research In Motion*, *supra*, is a "final decision" within the meaning of 35 U.S.C. 317(b), and accordingly, the instant *inter partes* reexamination proceeding filed by the requester,

who is the defendant in that litigation, may not (after the court's order) be maintained by the Office.

9. The Office mailed a decision in the '020 proceeding on June 2, 2004, dismissing the petition under 37 C.F.R. § 1.181.

## 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 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 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 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 '020 *inter partes* reexamination proceeding reveals that the original specification, drawings and all patent claims are presently in the reexamination file, *i.e.,* no claims have been amended or added, or cancelled. The *inter partes* reexamination proceeding is ready for the examiner's preparation of the first Office action on the merits.

A review of the prosecution history of the '6495 *ex parte* reexamination proceeding reveals that the original specification, drawings and all patent claims are presently in the reexamination file,

*i.e.,* no claims have been amended or added, or cancelled. An owner's statement pursuant to 37 C.F.R. § 1.530 has been received. The *ex parte* reexamination proceeding is ready for the examiner's consideration of such owner's statement and preparation of a first Office action on the merits.

Accordingly, the claims are 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 95/000,020 and 90/006,495 reexamination proceedings are **merged**. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

### 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.*

### 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 C.F.R. § 1.989(b), the merged proceeding is governed by 37 C.F.R. §§ 1.902 through 1.997.

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 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 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 should be directed:

by Mail to: Attn: "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: (703) 305-1013
Central Reexamination Unit

by hand: Central Reexamination Unit
Crystal Plaza Three-Four, 3D68
2100 Crystal Drive
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 parties, including papers filed *via* facsimile transmission. 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 § 2666.01. 37 C.F.R. § 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. 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. 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.

F. Reexamination Certificate:

At the conclusion of the examination of the merged reexamination proceeding, 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. 95/000,020 and *ex parte* Reexamination Control No. 90/006,495 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. The reexamination files are being forwarded via the Technology Center 2600 Group Director to the examiner for the preparation of a first Office action on the merits in the merged proceeding, to be issued in due course.

3. Any questions concerning this communication should be directed to Anton W. Fetting, Reexam Legal Advisor at (703) 305-8449.

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

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(For Patent Owner)

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REEXAM UNIT

Enclosure: Patent Owner Petition and attachments filed March 14, 2003

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|---|---|---|
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| Initiated: December 26, 2002 | : | IMPROPER PAPER |
| For: U.S. Patent No. 6,317,592 | : | |

This is a decision on the March 14, 2003, patent owner petition entitled "PETITION PURSUANT TO 37 C.F.R. § 1.183 TO ENLARGE THE TWO MONTH TIME LIMIT FOR FILING A SUPPLEMENTAL PATENT OWNER'S STATEMENT PURSUANT TO 37 CFR § 1.530." The petition is before the Office of Patent Legal Administration for decision.

For the reasons set forth below, the petition is dismissed and is being returned along with this decision.

**REVIEW OF FACTS**

1. On December 26, 2002, reexamination was ordered for five of Patent Owner's patents. The order for reexamination was issued at the initiative of the Director of the United States Patent and Trademark Office under 37 CFR 1.520. The patents and their assigned control number are: 5,625,670 (90/006,491); 5,631,946 (90/006,492); 5,819,172 (90/006,493); 6,067,451 (90/006,494); and 6,317,592 (90/006,495). The present reexamination proceeding is reexamination control number 90/006,495.

2. On February 26, 2003, Patent Owner filed (a) a Patent Owner's Statement under Protective Order (Paper No. 3), (b)an Expert Declaration submitted under Protective Order (Paper No. 4), (c) a Declaration of Donald E. Stout pursuant to 37 CFR 1.131 (Paper No. 5), (d) a Declaration of Thomas J. Campana, Jr. pursuant to 37 CFR 1.131 (Paper No. 6), and (e) an Information Disclosure Statement under 37 CFR 1.555 (Paper No. 7).

3. On March 5, 2003, Patent Owner filed copies of date-stamped postcard receipts (Paper No. 8) evidencing the timely filing of the February 26, 2003, papers. The original papers which had been missing date-stamps were then date-stamped as received on February 26, 2003, pursuant to the evidence provided by Patent Owner.

4. On March 14, 2003, Patent Owner filed the present petition under 37 CFR 1.183 requesting "suspension of the two-month time limit set for the response to the Order for Reexamination" to permit entry of the *accompanying* "Supplemental Patent Owner's Statement Pursuant to 37 CFR 1.530"

5. On March 26, 2003, a "DECISION CONCERNING PAPERS FILED BY PATENT OWNER" was issued by the Technology Center 2600 Special Programs Examiner, stating that "the papers filed [February 26, 2003] under Protective Order have been removed from the envelopes and made of record."

6. The present file was then forwarded to the Office of Patent Legal Administration for a decision on the petition.

**DECISION**

37 CFR 1.540 states:

> No submissions other than the statement pursuant to § 1.530 and the reply by the *ex parte* reexamination requester pursuant to § 1.535 will be considered prior to examination.

The examination stage of the present proceeding has not yet begun, as a first Office action on the merits has not yet been issued. The present March 14, 2003, submission is not a "reply by the *ex parte* reexamination requester pursuant to § 1.535," since it is filed by the patent owner. Further, the submission is not a Patent Owner's statement pursuant to § 1.530, because the Patent Owner's statement pursuant to § 1.530 was already filed on February 26, 2003. Pursuant to 35 U.S.C. 304, the patent owner is

given a reasonable period "within which he may file **a statement**" [Emphasis added] on the question of patentability raised in the order for reexamination. There is no provision in the statute for more than one statement, i.e., there is no provision for a second statement to supplement the first statement.

Since the present March 14, 2003, submission is submission is not a "statement" nor a "reply," entry of same is barred under 37 CFR 1.540.

37 CFR 1.530(b) states:

> The order for *ex parte* reexamination will set a period of not less than two months from the date of the order **within which the patent owner may file a statement on the new question of patentability**, including any proposed amendments the patent owner wishes to make. [Emphasis Added]

Under 37 CFR 1.530(b), the Patent Owner may file the statement *only* within the period set therein. The period set in the December 26, 2002, order for *ex parte* reexamination was two months. Accordingly, the present March 14, 2003, submission would not be timely, even if it were a proper statement under 37 CFR 1.530.

In view of the above, the March 14, 2003, submission of Patent Owner's petition and the accompanying "Supplemental Patent Owner's Statement Pursuant to 37 CFR 1.530" is an improper submission under 37 CFR 1.530(b) and under 37 CFR 1.540. Accordingly, the submission will not be made of record in the reexamination file and is being returned herewith. MPEP 2267. See *In re Knight*, 217 USPQ 294 (Comm'r Pat. 1982); *Patlex Corp. v Mossinghoff*, 226 USPQ 985, 986 (Fed. Cir. 1985). This decision will, however, be made of record in the reexamination file.

As to petitioner's request to waive the rules pursuant to 37 CFR 1.183:

Patent Owner's request for "suspension of the two-month time limit set" in the order is, in effect, a request that the Director to waive the provisions of 37 CFR 1.530(b) and permit (1) entry of the instant petition and accompanying "Supplemental Patent Owner's Statement Pursuant to 37 CFR 1.530," and (2) consideration of same when the examiner issues the first Office action on the merits. A waiver of the requirement to file the statement within the two month time period (set in the order) will not, however, provide Patent Owner with the relief Patent Owner desires, since consideration of the March 14, 2003,

submission would still be barred under 37 CFR 1.540, because the present March 14, 2003, submission is not a "statement" nor a "reply" as discussed above.

Accordingly, Patent owner's petition is taken as a request to waive the provisions of 37 CFR 1.540 and permit entry of a submission other than a statement pursuant to § 1.530 and a reply pursuant to § 1.535.

In order for grant of a petition under 37 CFR 1.183, a petitioner must show (1) that there is an extraordinary situation (2) where justice requires waiver of the rule. *In re Sivertz*, 227 USPQ 255, 256 (Comm'r Pat. 1985). Petitioner Patent Owner has not show that either condition exists in this case.

The present March 14, 2003, submission, for which entry and consideration in the first Office action is requested, provides a paper that was presented in litigation related to the patent being reexamined, and discusses what Patent Owner believes to be the significance of that paper. If entry is not provided at this point, Patent Owner is free to re-submit the March 14, 2003, submission during the examination stage of the present proceeding, i.e., after the first Office action is issued. At that point, the submission would have an entry right and would be considered by the examiner. There is no showing in the petition that re-submission during the examination stage would prejudice Patent Owner as to the consideration of the information presented (in the submission) in a manner as to create an extraordinary situation where justice requires waiver of the provisions of 37 CFR 1.540. Accordingly, the relief provided by 37 CFR 1.183 is not appropriate in this instance, [1] and the present petition pursuant to 37 CFR 1.183 is dismissed.

**CONCLUSION**

1. The March 14, 2003, patent owner petition filed pursuant to 37 CFR 1.183 is dismissed, and it is being returned along with this decision.

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[1] Note that the Office will not normally consider an extraordinary remedy when the rules already provide an avenue for obtaining the relief sought. *See Cantello v. Rasmussen*, 220 USPQ 664 (Comm'r Pat. 1982).

3. The reexamination file is being returned to Technology Center 2600 for storage until a reply under 37 CFR 1.535 is received, or the time for filing same expires, after which a first Office action on the merits is to be issued.

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

April 1, 2003
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 90/006,495 | 12/26/2002 | 6317592 | | 9470 |

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| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 09/16/2005

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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9/16/05

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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# *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/006495

PATENT NO. 6,317,592

ART UNI

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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(For *Inter Partes* Reexamination Requester)

*In re Campana, Jr. et al*
*Inter Partes* Reexamination Proceeding
Control No.: 95/000,020
Filed: May 29, 2003
For: U.S. Patent No. 6,317,592

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/006,495
Filed: December 26, 2002
For: U.S. Patent No.: 6,317,592

**DECISION DISMISSING PETITION**

This is a decision on the July 7, 2005 patent owner petition filed under 37 CFR §§ 1.181 and 1.907 and 35 U.S.C. § 317 in this merged proceeding, requesting (a) that the 90/006,495 and 95/000,020 reexamination proceedings be severed and (b) that *inter partes* proceeding 95/000,020 be dismissed and terminated pursuant to 37 CFR 1.907. On July 20, 2005, the third party requester filed a petition opposing the patent owner's July 7, 2005 petition to sever and terminate.

The 90/006,495 and 95/000,020 reexamination proceedings are before the Director of the Office of Patent Legal Administration for consideration of the July 7, 2005 patent owner petition.

The July 7, 2005 patent owner petition is dismissed for the reasons set forth below.

In addition, for reasons discussed below, requester's July 20, 2005 opposition petition has not been considered and is being returned to requester by separate mailing on even date.

## BACKGROUND

1. U.S. Patent No. 6,317,592 (hereinafter the '592 patent) issued to Campana *et al* on

November 13, 2001, from an application filed on December 6, 1999.

2. On December 26, 2002, reexamination of the '592 patent was ordered at the initiative of the Director of the United States Patent and Trademark Office, and the resulting reexamination proceeding was assigned control number 90/006,495 (hereinafter the '495 reexamination proceeding).

3. On May 29, 2003, a request for *inter partes* reexamination of the '592 patent was filed in the Office by a third party requester, resulting in reexamination proceeding control number 95/000,020 (hereinafter the '020 reexamination proceeding). The real party in interest who requested the reexamination proceeding is Research In Motion (RIM).

4. On August 12, 2003, the patent owner filed a notice of concurrent proceedings under 37 CFR 1.985 in Control No. 95/000,020. The Notice advised the Office of a final decision and order dated August 5, 2003, that was issued by the U.S. District Court for the Eastern District of Virginia, in *NTP, Inc. V. Research In Motion*, C.A. # 3:01CV767 (E.D. Va., August 2003). The August 12, 2003 Notice provided a copy of the Court order and its accompanying memoranda and other orders issued by the Court. From the materials provided, it might be interpreted that the District Court found that the defendant, the third party requester, RIM, had not sustained its burden of proving the invalidity of any patent claim in the '592 patent, and that defendant RIM was found to have infringed certain of plaintiff NTP's patent claims in the '592 patent.[1] The Court's decision was appealable within 30 days under Federal Rules of Appellate Procedure Rules 3 and 4,

5. On August 26, 2003, the Office issued an order, in the '020 reexamination proceeding, for *inter partes* reexamination of the '592 patent. The August 26th order notified the parties to the '020 reexamination proceeding that a decision in the litigation referred to in the August 12, 2003 Notice (see preceding paragraph) might provide grounds for termination of the '020 reexamination proceeding.

6. On October 10, 2003, the patent owner filed a petition under 37 CFR 1.181, requesting that the '020 reexamination proceeding be dismissed, i.e. terminated. Patent owner argued that the Court's holding and decision in *NTP, Inc. v. Research In Motion* [2] constituted a "final decision" within the meaning of 35 U.S.C. § 317(b), and accordingly, the '020 reexamination proceeding, filed by a third party requester who was argued to be in privy with defendant in the litigation, [3] could not be maintained by the Office.

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[1] A review of the final order (and accompanying orders and memoranda), as well as from the three opinions of the U.S. District Court for the Eastern District of Virginia (Richmond Div) styled as "NTP, Inc., Plaintiff v. Research in Motion, Ltd., Defendant" reported at 270 F. Supp. 2d 751; 67 USPQ2D 1594 (May 23, 2003); 67 USPQ2d 1587 (May 23, 2003); and 261 F. Supp. 2d 423; 67 USPQ2d 1574 (November 4, 2002), does not show that the District Court found all of the claims of the '592 not invalid. See also *NTP, Inc., v. Research In Motion, Ltd.*, 392 F.3d 1336; 73 USPQ2d 1231 (Fed. Cir. 2004), from which it appears that claims 40, 150, 278, 287, 653 and 654 of the '592 patent were held to be infringed by RIM; presumably at least these claims were held to be "not invalid" in order for them to have been held by the Court to be infringed.

[2] Presumably the petition referred to the final order discussed in item 4, *supra* and/or the published opinions of the District Court Cited in the above footnote.

[3] RIM was the defendant in the court proceedings, and is the real party in interest in the '020 reexamination.

7. On June 2, 2004, the October 10, 2003 patent owner petition was dismissed on the grounds that the decision of the U.S. District Court relied upon by patent owner was not a "final decision" within the meaning of 35 U.S.C. § 317(b).

8. On August 9, 2004, the Office issued a decision, *sua sponte*, merging the '020 *inter partes* reexamination proceeding and the '495 *ex parte* reexamination proceeding into a single merged proceeding pursuant to 37 CFR 1.989(a). The decision merging the two reexamination proceedings stated that the merged proceeding would be governed by 37 CFR 1.902 through 1.997, as required by 37 CFR 1.989(b).

9. On December 14, 2004, a decision of the Federal Circuit was rendered in the *NTP, Inc. v. Research In Motion* litigation. [4]

10. On July 20, 2005, requester filed a petition opposing patent owner's petition to sever the merged proceeding and to dismiss and terminate the '020 inter partes reexamination proceeding.

11. On August 2, 2005, the Federal Circuit issued an Order granted a request for panel re-hearing and rehearing en banc for the limited purpose of revising portions of the opinion treating Section 271 of Title 35 of the United States Code, and withdrawing the December 14, 2004 opinion.[5]

12. On August 2, 2005, the Federal Circuit issued a new opinion. [6]

## DECISION

I. The Issue Presented:

The record shows that the '020 proceeding *inter partes* reexamination request for reexamination was filed on May 29, 2003 on behalf of RIM (the real party in interest). Reexamination was requested of all of the '592 patent claims. Upon determining that the cited prior art raised a substantial new question of patentability,[7] the Office ordered reexamination on August 26, 2003. Thereafter, on August 9, 2004, the Office merged the '020 *inter partes* reexamination proceeding with the previously ordered '495 *ex parte* reexamination proceeding. [8]

The record further shows that requester RIM is the defendant in a civil action regarding the '592 patent (*NTP, Inc. v. Research In Motion,*), and that petitioner had previously petitioned to dismiss the '020 inter partes reexamination proceeding in light of the decision and supporting orders of the District Court. [9] The petition was dismissed on the grounds that a "final decision" had not yet been issued because the appellate process had not been exhausted (*i.e.*, RIM's appeal to the Federal Circuit was still pending). On December 14, 2004, the Federal Circuit

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[4] *NTP, Inc. v. Research in Motion, Ltd*, 392 F.3d 1336; 73 USPQ2d 1231 (Fed. Cir. 2004).
[5] *NTP, Inc. v. Research in Motion*, No. 03-1615, 2005 U.S. App. LEXIS 15804 (Fed. Cir. August 2, 2005).
[6] *NTP, Inc. v. Research in Motion*, No. 03-1615, (Fed. Cir. August 2, 2005).
[7] 35 U.S.C. § 312; 37 CFR 1.923.
[8] See 37 CFR 1.989; see also MPEP § 2686.01.
[9] See notes 1-3, *supra*.

rendered a decision in the *NTP, Inc. v. Research In Motion* litigation. The Federal Circuit affirmed the holding of the District Court that RIM had infringed claims 40, 150, 278, 287, 653 and 654 of the '592 patent. [10] As noted in paragraphs 10 and 11, *supra,* the Federal Circuit 's December 14, 2004 opinion has been withdrawn and a new opinion has issued. [11]

Based upon the December 14, 2004 Federal Circuit's withdrawn decision, petitioner requests that the '020 *inter partes* reexamination proceeding now be severed from the merged proceeding and terminated in accordance with the 35 U.S.C. § 317(b). Petitioner's request is grounded in its position that the December 14, 2004 Federal Circuit's withrawn decision is a "final decision" that has been entered against RIM (the third party requester) with respect to the validity of the '592 patent. Petitioner's position equally applies to the Court's August 2, 2005 opinion because the new opinion merely treats matters involving infringement pursuant to 35 U.S.C. § 271.[12]

II. Applicable Statutory Provision:

A. Section 317(b) of Title 35 provides:

> Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of **any patent claim** in suit or if a final decision in an *inter partes* reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an *inter partes* reexamination of **any such patent claim** on the basis of issues which that party or its privies raised or could have raised in such civil action or *inter partes* reexamination proceeding, and an *inter partes* reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. **This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings.** [Emphasis added].

B. The legislative history of this section includes the following material, which identifies that its effect occurs after appeals and that its effect does not extend to issues concerning prior art that was unavailable.

> Sec. 4604. Optional *inter partes* Reexamination Procedure
> *****
> Subtitle F creates a new section 317 which sets forth certain conditions by which *inter partes* reexamination is prohibited to guard against harassment of a patent holder. In general, once an order for *inter partes* reexamination has been issued, neither a third-party requester nor the patent owner may file a subsequent request for *inter partes* reexamination until an *inter partes* reexamination certificate is issued and published, unless authorized by the Director. Further, if a third-party requester asserts patent invalidity in a civil action and a final decision is entered that the party failed to prove the assertion of invalidity, or if a final decision in an inter partes reexamination instituted by the requester is favorable to patentability, **after any appeals,** that third-party requester cannot thereafter request *inter partes* reexamination on the basis of issues which were or which could have been raised. **However, the third-party requester may assert invalidity based on newly discovered prior art unavailable at the time of the civil action or *inter partes* reexamination. Prior art was unavailable at the time if it was not known to the individuals who were involved in the civil action or *inter partes* reexamination proceeding on behalf of the third-party requester and the USPTO.** [Emphasis added]. [13]

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[10] *Id.* at 1343; 1236.
[11] See notes 5 and 6, *supra.*
[12] *NTP, Inc. v. Research in Motion,* No. 03-1615, 2005 U.S. App. LEXIS 15804 (Fed. Cir. August 2, 2005).
[13] 106 Cong Rec. S14720, Nov. 17, 1999.

III. Analysis and Findings

Petitioner bases its argument for severing the '020 *inter partes* reexamination proceeding from the '694 *ex parte* reexamination proceeding and then terminating the '020 proceeding, upon certain language appearing in the Office's June 2, 2004 decision. The Office's June 2, 2004 decision dismissed the owner's October 10, 2003 petition which requested the '020 *inter partes* reexamination proceeding be dismissed. Specifically, petitioner quotes the June 2, 2004 decision as stating that "the examination and prosecution will continue until requester has exhausted all its appeal avenues, or the time for such expires."[14] Petitioner alleges that "[t[he Office previously recognized that dismissal of this *inter partes* reexamination would be required when a final decision was reached in the NTP versus RIM litigation."[15] Petitioner argues that, based on the December 14, 2004 Federal Circuit's withdrawn decision, the requester has now exhausted all its appeal avenues, and therefore alleges the Federal Circuit's withdrawn decision is a "final decision" within the meaning of 35 U.S.C. § 317(b). Accordingly, petitioner urges that the Office must now sever and terminate the '020 *inter partes* reexamination proceeding in accordance with 35 USC § 317(b). Petitioner's position is not persuasive for a number of reasons.

A. Petitioner Has Not Shown That The Federal Circuit Decision Is A "Final Decision" Pursuant to 35 U.S.C. § 317(b)

Petitioner has not presented sufficient information from which to conclude that RIM's appeal rights are exhausted. The Federal Circuit decision is not a "final decision" because, the Federal Circuit vacated and remanded to the District Court for more work to be performed on one of the issues before the Court on appeal. Accordingly, it is entirely possible for the District Court to alter it previous decision concerning the validity of the claims at issue in the pending inter partes reexamination proceeding. Such a decision is not a "final decision" as required by 35 U.S.C. § 317(b) because on remand the lower district court would be required to conduct further work and, therefore, would not be a final exhaustion of all appeals.

Since the *inter partes* reexamination statute was enacted in 1999, the Office has interpreted "final decision" as after a Federal Circuit decision. *See* MPEP §2686. The Office's interpretation is based on several factors including the plain language of the statute, the symmetry between the two estoppel provisions, the legislative history, and the policy underlying the whole statutory scheme.[17]

Section 317(b) of Title 35, in pertinent part, states:

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[14] See petition, pg. 5, last sentence, quoting the Decision Dismissing Petition dated June 2, 2004, page 11, item number 2.

[15] Petition, page 6, last paragraph.

[16] See Fed. Cir. R. 41.

[17] It should be noted that a "final decision" can occur at many stages and is interpreted with different meanings depending on the statute from which it emanates, - at the agency level, the district court level and the appellate court level. *See e.g.*, 5 U.S.C. § 704 (final agency decision required prior to judicial review); 28 U.S.C. § 1295 (a) (only "final decisions" of district courts are ripe for appeal); Fed. R. App. P. 41 (b) (1998 advisory committee notes explain "a court of appeals judgment or order is not final until issuance of its mandate; at that time the parties obligations become fixed"). Accordingly, the term "final decision" must be read in the context of the particular statute in which it is embodied.

> Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an *inter partes* reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an *inter partes* reexamination of any such patent claim on the basis of issues which the parties raised or could have raised in such civil action or *inter partes* reexamination proceeding, and an *inter partes* reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, . . .

35 U.S.C. § 317(b) (emphasis added). Thus, estoppel does not take effect until a "final decision . . . in a civil action" has been entered or alternatively, a "final decision" in an earlier *inter partes* reexamination has occurred. As explained in its earlier decision, the Office interprets the term "final decision" for either proceeding[18] as "after all appeals" when the parties' obligations become fixed. *See* MPEP § 2686. The Office's interpretation is sound for a number of reasons.

It is well settled that "in determining the meaning of [a] statute, we look not only to the particular statutory language, but to the design of the statute as a whole and to its object and policy." *Crandon v. United States*, 494 U.S. 152, 158 (1990). Further, when interpreting terms in a statute, we "must find that interpretation which can most fairly be said to be imbedded in the statute, in the sense of being most harmonious with its scheme and with the general purposes that Congress manifested." *NLRB v. Lion Oil Co.*, 352 U.S. 282, 297 (1957).

First, "final decisions" typically only bind the Office after all appeals are exhausted. In other words, the Office's interpretation of "final decision" as "after all appeals" is consistent with existing law that holds that all other Office proceedings, whether *inter partes* or *ex parte*, do not terminate until the mandate is issued by the appellate tribunal (if an appeal is filed). For example, a patent application proceeding will not terminate within the Office until the Federal Circuit issues its mandate or the time for appeal has expired. *See* 37 CFR 1.197(b)(2). *See also In re Jones*, 542 F.2d 65 (CCPA 1976) ("that petitioners did not know that receipt of mandate [by PTO] . . . terminated [the] proceedings in case was an inadequate excuse for delay in filing continuation application before mandate issued"). Similarly, an *inter partes* interference proceeding within the Office will not terminate until the Federal Circuit mandate is issued or the time to file an appeal has expired. 37 CFR 41.205(a). Clearly, Office proceedings will not terminate if the Federal Circuit issues a remand order requiring the lower tribunal to perform further work that can ultimately be appealed again up to the Federal Circuit.

Second, the plain language of the statute reflects Congress' intent to provide estoppel effect in a reciprocal fashion between court and *inter partes* reexamination proceedings. For example, an *inter partes* reexamination will bar a civil action validity challenge on the same claims only after any appeals. *See* 35 U.S.C. § 315 (c) (barred from raising invalidity in a civil action if previously "finally" held valid in a *inter partes* reexamination); *see also* 35 U.S.C. § 316 (mandating that an *inter partes* reexamination certificate cannot be issued until all appeals are

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[18] The estoppel provisions are applied reciprocally for *inter partes* reexamination and civil proceedings.

exhausted). Similarly, a "final decision" in an *inter partes* reexamination proceeding will bar a subsequent *inter partes* reexamination on the same claims, and a "final decision . . . in a civil action" will bar a subsequent reexamination on the same claims. 35 U.S.C. § 317(b). Looking at the plain language of the statute, it is easy to see that the term "final decision" is symmetrically applied to both civil actions in court and *inter partes* reexamination proceedings within the Office throughout §§ 317(b) and 315(c). Further, there is no reason from the reading of the statute that the same term used twice in the same provision, *i.e.*, "final decision," should have two different meanings. Since *an inter partes* reexamination proceeding does not become a "final decision" holding claims valid until "after all appeals," a similar interpretation should be reciprocally applied to a civil action in court. Thus, just like a Board of Patent Appeals and Interferences ("Board") decision pending appeal is not a final decision and does not estop a civil action, a district court decision on appeal to the Federal Circuit does not estop an *inter partes* reexamination proceeding from continuing within the Office. Moreover, when a district court, as in this case, has been ordered on remand by the Federal Circuit to do further work that may alter its original decision, it is clear that any initial decision it previously entered is not final with respect to the issues it has been ordered to address.

Third, the legislative history of 35 U.S.C. § 317 confirms that the term "final decision" must be "after all appeals." In pertinent part, the legislative history states:

> Sec. 4604. Optional inter partes Reexamination Procedure *****
> . . . if a third-party requester asserts patent invalidity in a **civil action** and a **final decision** is entered that the party failed to prove the assertion of invalidity, or if a **final decision** in an *inter partes* reexamination instituted by the requester is favorable to patentability, **after any appeals**, that third-party requester cannot thereafter request *inter partes* reexamination on the basis of issues which were or which could have been raised . . . .

145 Cong. Rec. S14720, (Nov. 17, 1999) (emphasis added). Consistent with the plain language of the statute, the legislative history confirms that a "final decision" is "after any appeals." A simple reading of the legislative history reveals that Congress contemplated that a "final decision" of either a prior *inter partes* reexamination or a civil action has estoppel effect only "after any appeals." As earlier explained, the statutory scheme creates a reciprocal estoppel effect, and the term "final decision," is used equally in reciprocal fashion in the same statutory clause applied to both *inter partes* reexamination proceedings and civil actions. Accordingly, the legislative history confirms, rather than detracts from, the Office's interpretation of "final decision" as "after all appeals."

Finally, logic and policy support construing the term "final decision" as "after all appeals." For example, in this case, the district court entered an initial decision but has now been ordered to reconsider its decision on remand by the Federal Circuit. Termination of the *inter partes* proceeding prior to exhaustion of appeals would be premature. If the *inter partes* reexamination proceeding is prematurely terminated, there is no way to "un-terminate" or re-start the reexamination proceedings. A completely new request for reexamination would have to be made in a redundant fashion. Clearly, such redundancy is a result Congress did not intend in light of the fact that it provided the PTO Director with the discretion to suspend parallel proceedings for "good cause." 35 U.S.C. § 314(c); 37 CFR § 1.987. Accordingly, a "final decision" as articulated in § 317 cannot occur until "after all appeals" in order for the statutory scheme to

work properly. In this case, such a "final decision" will not take place until after the district court completes the further work it was ordered to do and any subsequent appeals from its decision are exhausted.

Thus, the Federal Circuit's December 14, 2004 withdrawn decision has not been shown to be a "final decision" within the meaning of 35 U.S.C. § 317(b). Therefore, termination of the '020 *inter partes* reexamination proceeding has not been shown to be required by the statute.

In addition, it appears from the Federal Circuit's replacement August 2, 2005 decision that the issue remanded to the District Court directly bears on the interpretation of a claim limitation appearing in claim 40 of the '592 patent.[19] Presumably, the District Court's construction of the limitation, on remand, will affect issues directly bearing on the '020 *inter partes* reexamination proceeding, and the merged proceeding as a whole. Thus, Petitioner has not shown that there is a "final decision" with respect to the claim validity issue raised in the inter partes reexamination.[20] Petitioner has not demonstrated that RIM will be unable to obtain a different outcome (from the initial District Court finding) regarding the interpretation of one or more of the claims of the '592 patent, and that a different interpretation would not necessarily require that the Court revisit the issue of the validity of the involved claim or claims.

In summary, if further court review can still be sought,[21] then the Federal Circuit decision is not a "final decision" within the meaning of 35 U.S.C. § 317(b). Certainly, petitioner has not supplied sufficient information to establish on the record that the Federal Circuit decision is a "final decision" within the meaning of 35 U.S.C. § 317(b). Therefore, termination of the '020 reexamination proceeding is not required by the statute. Accordingly, there is presently no reason to sever the '020 *inter partes* reexamination proceeding from the merged '495 *ex parte* reexamination proceeding and terminate '020 *inter partes* proceeding, particularly given that the issues in both proceedings are integrally intertwined.

B. Petitioner Has Not Demonstrated That The '020 *Inter Partes* Reexamination Proceeding Is Based Solely On Patents of Printed Publications "Available" to the Requester During the Litigation

Even if petitioner could demonstrate that there has been a "final decision" in the litigation between NTP and RIM within the meaning of 35 USC § 317(b), it appears from a consideration of the language of 35 U.S.C. § 317(b), read in light of the legislative history of that statute, [22] that in certain circumstances, the statute would nevertheless permit the '020 *inter partes* reexamination proceedings to be maintained.

35 U.S.C. § 317(b) states:

> "This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings."

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[19] 392 F. 3d 1336, 1349; 73 USPQ2d 1231, 1241, and, in particular, footnote 5 of the opinion.

[20] The only issue on remand is directed to infringement, as implied by the petition at page 5, lines 1-4.

[21] Or, the decision is "final" in the sense that it is ripe for appeal and the period for seeking review has expired.

[22] See page 4, *supra*.

The legislative history reproduced (and cited) above states:

> "[T]he third-party requester may assert invalidity based on newly discovered prior art unavailable at the time of the civil action or *inter partes* reexamination. Prior art was unavailable at the time if it was not known to the individuals who were involved in the civil action or *inter partes* reexamination proceeding on behalf of the third-party requester and the USPTO."

In the present instance, a review of the '020 *inter partes* reexamination proceeding, and of the litigation papers made of record by patent owner therein, [23] shows that the patents and printed publications of record in the '020 reexamination *inter partes* reexamination proceeding far outnumber the patents and printed publications **specifically** identified and discussed in the litigation related papers and reported decisions. Further, patent owner's June 30, 2004, Information Disclosure Statement (in the '020 *inter partes* reexamination proceeding) noted that less than all the prior art submitted by the third party requester was submitted in the litigation. Thus, the art advanced by requester in the reexamination proceeding may not be barred by 35 U.S.C. § 317(b), unless petitioner can show that the art:

(a) was "raised" in the District Court litigation, or
(b) "could have" been raised in the litigation by requester.

As to (b) petitioner must show that RIM had a legal right, as to the patent or printed publication, to introduce it into the litigation after it became "available" to RIM.

In addition, it appears from the record that the litigation involving the '592 patent was filed in 2001, and the '020 *inter partes* reexamination proceeding was filed in 2003. Petitioner must show that the patent or printed publication became "available" prior to RIM's filing of the request for *inter partes* reexamination. If the patent or printed publication became "available" at or subsequent to RIM's filing of the request for *inter partes* reexamination, then RIM had a legal right to present it. 35 U. S. C. § 317(b).

Accordingly, petitioner has not demonstrated that all of the patents and printed publications deemed to demonstrate a substantial new question of patentability in the August 26, 2003 order granting reexamination were raised (or could have been raised) in the District Court litigation. Therefore, petitioner has not demonstrated a critical fact to warrant sever and termination of the '020 inter partes reexamination proceeding pursuant to 35 U.S.C. § 317(b).

C. Petitioner Has Not Shown That All of the Claims of The '592 Patent Have Been Held "Not Invalid":

We assume that the district court's prior art validity determination is limited to only those claims that NTP asserted RIM infringed. It does not appear that RIM attempted to invalidate every claim of the patents. With respect to the '592 patent, the issues of infringement and validity appear limited to of claims 40, 150, 278, 287, 653 and 654. Given that only six out of six

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[23] See note 1, supra. Petitioner has now made of record the reported decision of the CAFC on appeal from the District Court.
[24] Petition, page 2, third paragraph, second sentence
[25] Petition, page 3, 4th Statement of Fact

hundred and sixty-five claims of the '592 patent were **specifically** identified in the District Court's final order (August 5, 2003), the District Court's published opinions,[27] and Federal Circuit's published decision,[28] Petitioner has not clearly established that the courts have reached a holding that **all** of the '592 claims are "not invalid" (*i.e.*, valid over the issues addressed in the litigation).

The estoppel effect provided by 35 USC § 317(b) is on a "claim by claim" basis and therefore, each claim must be independently analyzed. 35 USC 317(b) states that:

> Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of **any patent claim** in suit ... then neither that party nor its privies may thereafter request an inter partes reexamination of **any such patent claim** on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of **such issues** may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. [Emphasis added.]

The petitioner has not clearly pointed out the basis for its position that **all** of the '592 claims have been held "not invalid."[29,30] Further, given the lack of clarity in the case reports as to whether **all** of the '592 patent claims or only those **specifically** identified by claim number were determined to be "not invalid," the Office cannot conclude that the claims which have been held "not invalid" include "any such patent claim" other than claims 40, 150, 278, 287, 653 and 654 (the claims **specifically** identified). Therefore, it appears, that on the existing record, even if the '020 *inter partes* reexamination proceeding were to be severed from the merged proceeding, 35 U.S.C. § 317(b) would **not** require that the '020 *inter partes* reexamination be terminated. Rather, the '020 *inter partes* reexamination proceeding would continue with respect to the patent claims not addressed by the litigation, and the intertwined issues of the two reexamination proceedings would continue on independently. This is not a desirable result. Absent any basis for termination of the '020 *inter partes* reexamination proceeding, it is desirable that the two proceedings continue as a merged proceeding.

## Treatment of Requester's Petition in Opposition to Patent Owner's Petition to Sever

A review of requester's petition shows that petition is not enterable into the record of this merged proceeding for several reasons. Therefore, the petition is being returned to requester by a separate mailing of even date. That mailing will address the reasons for non-entry of requester's petition in detail.

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[26] Petition, page 4, penultimate statement of fact.
[27] See note 1, *supra*
[28] See note 7, *supra*
[29] See note 14, *supra*
[30] It is presumed that only claims that are "not invalid", i.e. valid, can be infringed, and so it is clear that claims 40, 150, 278, 287, 653 and 654 of the '592 patent, which have specifically been held to be infringed, have been held to be "not invalid."

## Conclusion

1. The petition to sever the '020 *inter partes* reexamination proceedings from its merger with the '6495 proceeding and to then terminate the '020 *inter partes* reexamination proceedings is dismissed.

2. Petitioner has not demonstrated that the decision on appeal by the Federal Circuit is a "final decision" within the meaning of 35 USC § 317(b) so as to satisfy one of the statutory requirements for termination of *inter partes* reexamination proceeding '020.

3. Petitioner has not demonstrated that all of the prior art relied upon in the merged reexamination proceeding was before the District Court during the litigation of the '592 patent or was unavailable to the requester for entry into the litigation. Thus, another of the statutory requirements for termination of *inter partes* reexamination proceeding '020 has not been satisfied.

4. Petitioner has not demonstrated that any claims of the '592 patent other than claims 40, 150, 278, 287, 653 and 654 have been held by the courts to be "not invalid." Thus, yet another of the statutory requirements for termination of *inter partes* reexamination proceeding '020 has not been satisfied.

5. The merger of the '6495 *ex parte* reexamination proceeding with '020 *inter partes* reexamination proceeding, will continue, i.e., will not be severed, as petitioner has not demonstrated that there is a statutory basis to terminate the '020 *inter partes* reexamination proceeding.

6. **All correspondence relating to an *inter partes* reexamination proceeding should be directed to:**

By Mail to: 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) 273-9900
Central Reexamination Unit

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

7. Telephone inquires with regard to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, and in his absence, 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 Examination Policy

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9-14-05

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(For *Inter Partes* Reexamination Requester)

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REEXAM UNIT

*In re Campana, Jr. et al*
*Inter Partes* Reexamination Proceeding
Control No.: 95/000,020
Filed: May 29, 2003
For: U.S. Patent No. 6,317,592

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/006,495
Filed: December 26, 2002
For: U.S. Patent No.: 6,317,592

**DECISION DENYING PETITION**

This is a decision on the October 7, 2005 patent owner [1] petition filed under 37 CFR §§ 1.181 and 1.907 and 35 U.S.C. § 317 in this merged proceeding. The present petition requests reconsideration of the Office's September 16, 2005 decision dismissing patent owner's July 7, 2005 original petition; in that original petition, the patent owner requested that the 90/006,495 and 95/000,020 reexamination proceedings be severed, [2] and that *inter partes* proceeding 95/000,020 be dismissed and terminated pursuant to 37 CFR 1.907. In addition to requesting reconsideration of the September 16, 2005 decision, the present petition requests that the Office declare its decision to constitute a final agency action within the meaning of 5 U.S.C. § 704.

[1] United States Patent No. 6,317,592 is owned by NTP, Inc. All references, *infra*, to NTP, Inc are to be understood as referring to the "patent owner."

[2] The July 7, 2005 original "Petition to Sever and Dismiss ... *Inter Partes* Reexamination ..." did not request that the requested relief be in any way limited to any particular claims, or to any particular number of claims. The request for reconsideration now requests that the merged proceeding be terminated with respect to at least the six claims of United States Patent No. 6,317,592 for which validity has "been fully adjudicated," and requests dismissal and termination of the severed 95/000,020 *inter partes* reexamination proceeding.

On October 21, 2005, the third party requester [3] filed a petition in opposition to the patent owner's October 7, 2005 request for reconsideration and for designation of any decision reached as being as a final agency action.

The 90/006,495 and 95/000,020 reexamination proceedings are before the Director of the Office of Patent Legal Administration for consideration of the present patent owner and third party requester petitions.

## SUMMARY

The October 7, 2005 patent owner petition is granted to the extent that (a) the September 16, 2005 decision on the July 7, 2005 patent owner petition has been fully reconsidered, and (b) the instant decision is designated as a final agency action under 5 U.S.C. § 704. However, for the reasons set forth below, patent owner's request for reconsideration is denied with respect to the underlying requested relief of severing the merged proceeding and terminating the 95/000,020 *inter partes* reexamination proceeding.

In addition, for reasons discussed below, the third party requester's October 21, 2005 opposition petition is granted to the extent that the merged reexamination proceeding will not be severed and the 95/000,020 *inter partes* reexamination proceeding will not be terminated, but is denied insofar as it opposes designating the instant decision as being a final agency action under 5 U.S.C. § 704.

## BACKGROUND

1. U.S. Patent No. 6,317,592 (hereinafter the '592 patent) issued to Campana *et al* on November 13, 2001, from an application filed on December 6, 1999.

2. On December 26, 2002, reexamination of the '592 patent was ordered at the initiative of the Director of the United States Patent and Trademark Office, and the resulting reexamination proceeding was assigned control number 90/006,495 (hereinafter the '495 reexamination proceeding).

3. On May 29, 2003, a request for *inter partes* reexamination of the '592 patent was filed in the Office by a third party requester, resulting in reexamination proceeding control number 95/000,020 (hereinafter the '020 reexamination proceeding).

4. On August 12, 2003, the patent owner filed a notice of concurrent proceedings under 37 CFR 1.985 in Control No. 95/000,020. The notice advised the Office of a final decision and order dated August 5, 2003, that was issued by the U.S. District Court for the Eastern District of Virginia, in *NTP, Inc. V. Research In Motion*, C.A. # 3:01CV767 (E.D. Va., August 2003). The August 12, 2003 notice provided a copy of the court order and its accompanying memoranda and other orders issued by the court. The materials were provided by the patent owner for the purpose of asserting that the District Court found the defendant, third party requester RIM, (a) not to have sustained its burden of proving the invalidity of any patent claim in the '592 patent, and (b) to have infringed

[3] The third party requester in *inter partes* reexamination proceeding 95/000,020 is David L. Stewart. However, the real party in interest is Research in Motion, Ltd. (hereinafter "RIM"). All subsequent references to RIM are to be understood as referring to the "third party requester."

certain of plaintiff NTP's patent claims in the '592 patent. [4] Pursuant to Federal Rules of Appellate Procedure Rules 3 and 4, the District Court's decision was appealable within 30 days.

5. On August 26, 2003, the Office issued an order in the '020 reexamination proceeding granting *inter partes* reexamination of the '592 patent. The August 26th order notified the parties to the '020 reexamination proceeding that the decision in the litigation referred to in the August 12, 2003 Notice (see preceding paragraph) might provide grounds for termination of the '020 reexamination proceeding.

6. On October 10, 2003, the patent owner filed a petition under 37 CFR 1.181 (the "original" petition), requesting that the '020 reexamination proceeding be dismissed, *i.e.*, terminated. Patent owner argued that the District Court's holding and decision in *NTP, Inc. v. Research In Motion* [5] constituted a "final decision" within the meaning of 35 U.S.C. § 317(b), and accordingly, the '020 reexamination proceeding, filed by a third party requester who was argued to be in privy with defendant in the litigation, could not be maintained by the Office.

7. On June 2, 2004, the October 10, 2003 patent owner petition was dismissed on the grounds that the decision of the U.S. District Court relied upon by patent owner was not a "final decision" within the meaning of 35 U.S.C. § 317(b).

8. On August 9, 2004, the Office issued a decision, *sua sponte*, merging the '020 *inter partes* reexamination proceeding and the '495 *ex parte* reexamination proceeding into a single merged proceeding pursuant to 37 CFR 1.989(a). The decision merging the two reexamination proceedings stated that the merged proceeding would be governed by the provisions of 37 CFR 1.902 through 1.997, as required by 37 CFR 1.989(b).

9. On December 14, 2004, a decision of the Federal Circuit was rendered in the *NTP, Inc. v. Research In Motion* litigation. [6]

10. On July 7, 2005, patent owner filed a petition to sever the instant merged proceeding and to dismiss and terminate the '020 *inter partes* reexamination proceeding.

11. On July 20, 2005, requester filed a petition opposing patent owner's July 7, 2005 petition.

12. On August 2, 2005, the Federal Circuit issued an Order granted a request for panel rehearing and rehearing *en banc* for the limited purpose of revising portions of the opinion treating Section 271 of Title 35 of the United States Code, and withdrawing the December 14, 2004 opinion. [7]

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[4] A review of the final order (and accompanying orders and memoranda), as well as from the three opinions of the U.S. District Court for the Eastern District of Virginia (Richmond Div) styled as "*NTP, Inc., Plaintiff v. Research in Motion, Ltd., Defendant*" reported at 270 F. Supp. 2d 751; 67 USPQ2d 1594 (May 23, 2003); 67 USPQ2d 1587 (May 23, 2003); and 261 F. Supp. 2d 423; 67 USPQ2d 1574 (November 4, 2002), does not show that the District Court found all of the claims of the '592 to be not invalid. See also *NTP, Inc., v. Research In Motion, Ltd.*, 392 F.3d 1336; 73 USPQ2d 1231 (Fed. Cir. 2004), from which it appears that claims 40, 150, 278, 287, 653 and 654 of the '592 patent were held to be infringed by RIM; presumably, at least these claims were held to be "not invalid" in order for them to have been held by the court to be infringed.

[5] Presumably the petition referred to the final order discussed in item 4, *supra* and/or the published opinions of the District Court Cited in the above footnote.

[6] *NTP, Inc. v. Research in Motion, Ltd*, 392 F.3d 1336; 73 USPQ2d 1231 (Fed. Cir. 2004).

[7] *NTP, Inc. v. Research in Motion*, 418 F.3d 1282; 75 USPQ2d 1763 (Fed. Cir. 2005)

13. On August 2, 2005, the Federal Circuit also issued a substituted opinion. [8]

14. On August 16, 2005, third party requester filed a petition for panel rehearing and rehearing *en banc*, based upon the Federal Circuit's August 2, 2005 opinion.

15. On September 16, 2005, the Office rendered a decision dismissing the patent owner's July 7, 2005 petition to sever the merged proceeding, and terminate the '020 *inter partes* reexamination proceeding.

16. On September 28, 2005, the Office issued a first Office action on the merits (*i.e.*, on the patentability of the '592 patent claims) in which all patent claims, *i.e.* claims 1-665, were rejected. The rejection was based upon prior art (*e.g.* the so-called "TeleNor" prior art) , which was not of record until well after the *ex parte* and *inter partes* reexamination proceedings had been individually ordered and subsequently merged into a single proceeding. The TeleNor prior art does not appear to have been considered during any of the court proceedings.

17. On October 7, 2005, the Federal Circuit denied the third party requester's petition for a panel hearing and rehearing *en banc*. [9]

18. Also on October 7, 2005, the patent owner filed the instant petition requesting reconsideration of the September 16, 2005 decision, and designation of the decision on the request for reconsideration as a final agency action under 5 U.S.C. § 704.

19. A motion to stay issuance of the Federal Circuit's mandate was filed by RIM on October 13, 2005.

20. On October 21, 2005, the Federal Circuit denied the motion to stay and issued its mandated, remanding the case to the District Court for further proceedings pursuant to the Federal Circuit's August 2, 2005 substituted opinion. [10]

21. On October 21, 2005, the third party requester filed a petition in opposition to the patent owner's October 7, 2005.

22. Subsequent news reports state that that RIM has petitioned Chief Justice Roberts for a stay of the Federal Circuit's mandate pending filing of a petition for certiorari, but the stay was denied. [11]

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[8] *NTP, Inc. v. Research in Motion*, 418 F.3d 1282; 75 USPQ2d 1763 (Fed. Cir. 2005)

[9] *NTP, Inc. v. Research in Motion, Ltd.*, No 03-1615 (Fed. Cir. October 7, 2005)

[10] The substituted opinion is referenced in note 8, *supra*.

[11] *Patent Trademark & Copyright Journal*, Vol. 70 No. 1742, 10/28/05 (BNA). See also "Third Party Requester's ...Opposition to Patent Owner's request for Reconsideration ...", October 21, 2005, at page 9.

## DECISION ON PATENT OWNER REQUEST FOR RECONSIDERATION

I. Relief Requested By Patent Owner:

In the instant request for reconsideration, patent owner renews its request that the merged proceeding be severed and that the '020 *inter partes* reexamination proceeding then be terminated. As footnoted above, in the instant request for reconsideration, patent owner requests the Office to sever the merged proceedings for at least six claims of the '592 patent that have been adjudicated as valid, but also requests that the '020 *inter partes* proceeding then be dismissed and terminated. This decision will treat the issue of severance with respect to all claims of the '592 patent and fewer than all claims of the '592 patent, and will also treat the issue of dismissal and termination of the '020 *inter partes* proceeding with respect to all claims of the '592 patent and fewer than all claims of the '592 patent.

II. Summary Of The Issue Presented And Its Resolution:

The issue presented by patent owner can be summarized as being whether the estoppel provisions of 35 USC § 317(b) divest the Office of jurisdiction in the '020 *inter partes* proceeding based on the Federal Circuit ruling and apparent affirmance of the decision of the District Court with respect to claim validity. For the reasons discussed, *infra*, the Office finds that the estoppel provisions of 35 USC § 317(b) do not divest the Office of jurisdiction in the '020 *inter partes* proceeding. The Office concludes that the language of 35 USC § 317(b) divests the Office of jurisdiction to engage in *inter partes* reexamination only when all appeal rights are exhausted insofar as a party to the litigation has no further right to appeal to a higher court or otherwise seek review on the merits by a higher court, and the litigation proceeding is terminated. In this instance, the litigation proceeding has not terminated.

III. Applicable Statutory Provision:

A. Section 317(b) of Title 35 provides:

> Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of **any patent claim** in suit or if a final decision in an *inter partes* reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an *inter partes* reexamination of **any such patent claim** on the basis of issues which that party or its privies raised or could have raised in such civil action or *inter partes* reexamination proceeding, and an *inter partes* reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. **This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings.** [Emphasis added].

B. The legislative history of this section includes the following material, which identifies that its effect occurs after appeals and that its effect does not extend to issues concerning prior art that was unavailable:

> Sec. 4604. Optional *inter partes* Reexamination Procedure
> *****
> Subtitle F creates a new section 317 which sets forth certain conditions by which *inter partes* reexamination is prohibited to guard against harassment of a patent holder. In general, once an order for *inter partes* reexamination has been issued, neither a third-party requester nor the patent owner may file a subsequent request for *inter partes* reexamination until an *inter partes* reexamination certificate is issued and published, unless authorized by the Director. Further, if a third-party requester asserts patent invalidity in a civil action and a final decision is entered that the party failed to prove the assertion of invalidity, or if a final decision in an inter partes reexamination instituted by the requester is favorable to patentability, **after any appeals,** that third-party requester cannot thereafter request *inter partes* reexamination on the basis of issues which were or which could have been raised. **However, the third-party requester may assert invalidity based on newly discovered prior art unavailable at the time of the civil action or *inter partes* reexamination. Prior art was unavailable at the time if it was not known to the individuals who were involved in the civil action or *inter partes* reexamination proceeding on behalf of the third-party requester and the USPTO.** [Emphasis added]. [12]

## IV. Discussion Of September 16, 2005 Decision Dismissing The Underlying Original Petition (To Sever The Merger And Terminate The '020 Proceeding) Filed On July 7, 2005

In the original petition filed on July 7, 2005, patent owner based its argument for severing the '020 *inter partes* reexamination proceeding from the '694 *ex parte* reexamination proceeding and then terminating the '020 proceeding, upon certain language appearing in the Office's June 2, 2004 decision. The Office's June 2, 2004 decision had dismissed patent owner's October 10, 2003 petition requesting that the '020 *inter partes* reexamination proceeding be dismissed. Specifically, patent owner quoted the June 2, 2004 decision as stating that "the examination and prosecution will continue until requester has exhausted all its appeal avenues, or the time for such expires." [13] Patent owner alleged in the original petition that "[t[he Office previously recognized that dismissal of this *inter partes* reexamination would be required when a final decision was reached in the NTP versus RIM litigation." [14]

The relief requested in patent owner's original petition filed on July 7, 2005 was that the merged reexamination proceeding be severed, and that the '020 *inter partes* reexamination proceeding then be terminated. When that petition was filed, the basis for the relief requested by patent owner was that the December 14, 2004 Federal Circuit decision [15] on appeal from the District Court's decision [16] constituted a "final decision" within the meaning of 35 U.S.C. §317(b). [17] Patent owner reasoned that because the Federal Circuit had rendered a final holding of validity with respect to the claims of the '592 patent, 35 U.S.C. § 317(b) precluded the Office from maintaining the '020 *inter partes* reexamination proceeding. Patent owner argued that because the Office could not maintain the '020 *inter partes* reexamination proceeding, the Office was required to (a) sever the merged proceeding, thereby separating the '020 *inter partes* proceeding

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[12] 106 Cong Rec. S14720, Nov. 17, 1999.
[13] See "Petition to ... Sever and Dismiss ..." dated July 7, 2005, page 5, last sentence, quoting the Decision Dismissing Petition dated June 2, 2004, page 11, item number 2.
[14] See "Petition to ... Sever and Dismiss ..." dated July 7, 2005, page 6, last paragraph.
[15] See footnote 6, *supra*.
[16] See item 4 in the "Background," *supra*.
[17] See "Petition to Sever and Dismiss ... *Inter Partes* Reexamination ... ", July 7, 2005, at pages 5-7.

and the '495 *ex parte* reexamination proceeding into two distinct proceedings, and then (b) terminate the '020 *inter partes* proceeding.

The decision of Senior Legal Advisor Schor (hereinafter, the "Office") dismissed the original July 7, 2005 petition for a number of reasons. The Office held that the Federal Circuit decision relied upon by patent owner [18] was not a "final decision" within the meaning of 35 U.S.C. 317(b). Rather, a decision is a "final decision" pursuant 35 U.SC. § 317(b) only after all appeals from that decision are exhausted. The Office decided that, as there had been no final decision on the validity of claims because all appeal rights had not been exhausted, the estoppel provisions of 35 U.S.C. § 317(b)(4) had not been triggered in the present case. [19]

It was further noted that 35 U.S.C. § 317(b) states that "[t]his subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings." It appeared from the record of the merged reexamination proceeding that the merged proceeding was being conducted before the Office based upon significantly more applied prior art than had been asserted during the litigation. Patent owner failed to demonstrate that the prior art relied upon by the Office in the merged reexamination proceeding (in which a Director Ordered *ex parte* reexamination proceeding that was ordered on December 26, 2002 was merged with an *inter partes* reexamination proceeding filed on May 29, 2003) was not unavailable to the third party requester during the litigation that commenced in the District Court on November 13, 2001 and concluded in the District Court on May 23, 2003, *i.e.*, was not "newly discovered prior art unavailable to the third party requester and the ... Office at the time of the *inter partes* reexamination proceedings" Therefore, the Office also decided that even assuming, *arguendo*, that the Federal Circuit decision constituted a "final decision" within the meaning of 35 U.S.C. § 317(b), the termination of the '020 *inter partes* reexamination proceeding (and severance of the merged reexamination proceeding) was not required by 35 U.S.C. § 317(b), because, if the proceedings were severed, the '020 *inter partes* reexamination proceeding would still present to the Office a proceeding based upon prior art that was not available to the third party requester (and Office) during the litigation, and, perforce, was not relied upon in the litigation. [20]

In addition, the Office noted that patent owner failed to demonstrate that all of the '592 patent claims had ever been held to be "valid" or "not invalid" in the litigation. It was stated that, from the litigation record, it appeared that only 6 of the 665 claims of the '592 patent had been held to be infringed, and, therefore, held to be "not invalid." The Office pointed out that no other patent claim had been (even inferentially) held to be invalid. Accordingly, even if the merged proceeding were to be severed as requested, the '020 *inter partes* reexamination proceeding would continue with respect to at least 659 claims of the '592 patent. Additionally, the *ex parte* reexamination proceeding would remain, with all 665 claims of the '592 patent subject to reexamination. It was deemed to be undesirable for the two severed proceedings to

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[18] As set forth in the Background section, *supra*, the December 14, 2004 Federal Circuit decision relied upon by patent owner as being a "final decision" had been withdrawn after the petition was filed, and a substituted decision dated August 2, 2005 had been issued by the Federal Circuit. The Office took the position that the August 2, 2005 was also not a "final" decision with the meaning of 35 U.S.C. § 317(b). See Decision Dismissing Petition, dated September 16, 2005, at pages 5-8.

[19] "Decision Dismissing Decision", September 6, 2005, pages 5-8.

[20] *Id*, at pages 8 and 9. This finding by the Office was made prior to the September 28, 2005 Office action in which the so-called "TeleNor" prior art was applied against the claims. The TeleNor prior art provides new art which clearly was not of record until well after the *ex parte* and *inter partes* reexamination proceedings had been ordered and merged, and was not considered during any of the court proceedings, and further distances the instant proceeding from the estoppel of 35 U.S.C. § 317(b).

continue independently of one another, rather than as a single merged proceeding, especially in view of the overlapping issues that would be present in the independent proceedings. [21]

## V. Further Analysis And Findings

In support of patent owner's position, the present petition (requesting reconsideration) incorporates by reference all of the arguments made in patent owner's original petition filed on July 7, 2005.[22] However, patent owner's main argument is that there can be no dispute that the validity of the claims of the '592 patent was litigated in a civil action involving the requester, "with the resultant holding that these claims were not invalid." Patent owner further argues that this holding "was part of a final judgment by the United States District Court for the Eastern District of Virginia," an assertion first made by patent owner in a petition filed on October 10, 2003 and subsequently reasserted in patent owner's original July 7, 2005 petition that was based on the Federal Circuit's December 14, 2004 decision on RIM's appeal from the District Court. [23]

Patent owner argues that 35 U.S.C. § 317(b) does not simply say "once a final decision has been entered against a party in a civil action." Nor does Section 317(b) require entry of a "final judgment." Patent owner reads the term "final decision" as being qualified to state ***"[o]nce a final decision has been entered against a party in a civil action ... that the party has not sustained its burden of proving the invalidity of any patent claim in suit ..."*** (Emphasis added by patent owner.) Patent owner concludes that the statute does not require that a decision be "final" with respect to all issues in the case, but only requires that a final decision has been reached with respect to the pertinent validity issues. Patent owner believes that the instant facts show that a final decision on the pertinent validity issues has been reached in the '592 patent litigation. Patent owner's position is that even if litigation is ongoing with respect to issues other than claim validity, such as damages, scope of injunctive relief, etc., the litigation is nevertheless final on the question of claim validity within the meaning of 35 U.S.C. § 317(b).[24] This argument is addressed as now follows.

### A. Patent Owner Has Not Established That Third Party Requester's Litigation Appeal Rights Have Been Exhausted Within The Meaning of 35 U.S.C. § 317(b)

The record of the '020 proceeding shows that the request for *inter partes* reexamination was filed on May 29, 2003 on behalf of RIM (the real party in interest). Reexamination was requested for all of the '592 patent claims. Upon determining that the cited prior art raised a substantial new question of patentability, [25] the Office ordered reexamination on August 26, 2003. Thereafter, on August 9, 2004, the Office merged the '020 *inter partes* reexamination proceeding with the previously ordered '495 *ex parte* reexamination proceeding. [26] The litigation record reveals that requester RIM is the defendant in a civil action regarding the '592 patent (*NTP, Inc. v. Research In Motion*).

Patent owner has previously petitioned to dismiss the '020 *inter partes* reexamination proceeding in light of the District Court's decision and supporting orders in the civil action,

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[21] *Id.* at page 10.

[22] "Request for Reconsideration ... " dated October 7, 2005, page 2.

[23] Although not expressly stated by patent owner, it is presumed that patent owner now intends to refer to the substituted Federal Circuit decision of August 2, 2005 as the "final decision" on validity. See the Background section, supra, specifically items 4, 6, 9 and 13.

[24] "Request for Reconsideration ..." dated October 7, 2005 at pages 2-3.

[25] 35 U.S.C. § 312; 37 CFR 1.923.

[26] See 37 CFR 1.989; see also MPEP § 2686.01.

which are adverse to RIM. [27] The Office dismissed the previous petition on the grounds that a "final decision" had not yet been issued for the civil action, because the appellate process had not been exhausted (*i.e.*, RIM's appeal to the Federal Circuit was still pending). On December 14, 2004, the Federal Circuit rendered a decision in the *NTP, Inc. v. Research In Motion* litigation. The Federal Circuit affirmed the holding of the District Court that RIM had infringed claims 40, 150, 278, 287, 653 and 654 of the '592 patent. [28] As noted in paragraphs 10 and 11, *supra*, the Federal Circuit 's December 14, 2004 opinion was withdrawn and a new opinion has issued. [29]

The record also shows that the Federal Circuit's December 14, 2004 decision [30] was withdrawn in favor of a new decision by the Federal Circuit, as a result of a petition for rehearing that was granted on August 2, 2005. [31] Under the interpretation of 35 U.S.C. § 317(b) that patent owner previously advanced, patent owner would have had the Office sever the merged proceeding and terminate the *inter partes* proceeding based upon a decision by the Federal Circuit that was, *almost nine months subsequent to the decision,* withdrawn by the court and could well have resulted in the Federal Circuit taking an entirely different position vis-à-vis claim validity. **In and of itself, this should be sufficient to demonstrate that a decision of a court is not final until all parties have exhausted all rights subsequent to the court's decision.** Nevertheless, a detailed analysis of the meaning of "final decision" in 35 USC § 317(b) is presented below.

B. Patent Owner Has Still Not Shown That The Federal Circuit Decision Is A "Final Decision" Pursuant to 35 U.S.C. § 317(b)

Petitioner has not presented sufficient information from which to conclude that RIM's appeal rights are exhausted. The Federal Circuit decision of August 2, 2005 is not a "final decision" on claim validity, because the Federal Circuit vacated and remanded to the District Court for more work to be performed on an issue that may well effect claim validity. It is entirely possible for the District Court to alter its previous decision concerning the validity of the claims, which are also at issue in the present pending *inter partes* reexamination proceeding. Such a decision is not a "final decision" as required by 35 U.S.C. § 317(b), because, on remand, the District Court is required to conduct further work resulting in a different result subject to appeal. Therefore, there would not be a final exhaustion of all appeals. Even further, it is noted that while third party requester's petition for a stay of the Federal Circuit's injunction has been denied by Chief Justice Roberts, [32] third party requester has stated that it has a right to file a petition for *certiorari* to the United States Supreme Court and intends to do so. [33]

Since the *inter partes* reexamination statute was enacted in 1999, the Office has interpreted "final decision" as after a Federal Circuit decision with exhaustion of all appeal avenues as to the litigation. *See* MPEP §2686. The Office's interpretation is based on several factors including the plain language of the statute, the symmetry between the two estoppel provisions, the legislative history, and the policy underlying the whole statutory scheme.[34]

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[27] See notes 1-3, *supra*.
[28] *Id.* at 1343; 1236.
[29] See notes 5 and 6, *supra*.
[30] A decision argued as being "final" by patent owner in the July 7, 2005 "Petition to ... Sever and Dismiss ..."
[31] See Background section, *supra*, specifically items 12 and 13.
[32] See Background section, item 21.
[33] Third Party Requester's Petition ... in Opposition to Patent Owner's Request for Reconsideration... ", October 21, 2005 at page 9. See also Sup. Ct. R. 13., which provides a 90 day period to petition for certiorari.
[34] It should be noted that a "final decision" can occur at many stages and is interpreted with different meanings depending on the statute from which it emanates, - at the agency level, the district court level and the appellate court level. *See e.g.*, 5 U.S.C. § 704 (final agency decision required prior to judicial review); 28 U.S.C. § 1295 (a) (only

Section 317(b) of Title 35, in pertinent part, states:

> Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an *inter partes* reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an *inter partes* reexamination of any such patent claim on the basis of issues which the parties raised or could have raised in such civil action or *inter partes* reexamination proceeding, and an *inter partes* reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, . . .

35 U.S.C. § 317(b) (emphasis added). Thus, estoppel does not take effect until a "final decision . . . in a civil action" has been entered or alternatively, a "final decision" in an earlier *inter partes* reexamination has occurred. As explained in both of the earlier decisions on petition, the Office interprets the term "final decision" for both reexamination and civil action proceedings [35] as "after all appeals" when the obligations of both parties become fixed. *See* MPEP § 2686. The Office's interpretation is sound for a number of reasons.

It is well settled that "in determining the meaning of [a] statute, we look not only to the particular statutory language, but to the design of the statute as a whole and to its object and policy." *Crandon v. United States*, 494 U.S. 152, 158 (1990). Further, when interpreting terms in a statute, we "must find that interpretation which can most fairly be said to be imbedded in the statute, in the sense of being most harmonious with its scheme and with the general purposes that Congress manifested." *NLRB v. Lion Oil Co.*, 352 U.S. 282, 297 (1957).

Initially, it is to be noted that "final decisions" typically only bind the Office after all appeals are exhausted. In other words, the Office's interpretation of "final decision" as "after all appeals" is consistent with existing law, which holds that all other Office proceedings, whether *inter partes* or *ex parte*, do not terminate until the mandate is issued by the appellate tribunal (if an appeal is filed). For example, a patent application proceeding will not terminate within the Office until the Federal Circuit issues its mandate or the time for appeal has expired. *See* 37 CFR 1.197(b)(2). *See also In re Jones*, 542 F.2d 65 (CCPA 1976) ("that petitioners did not know that receipt of mandate [by PTO] . . . terminated [the] proceedings in case was an inadequate excuse for delay in filing continuation application before mandate issued"). Similarly, an *inter partes* interference proceeding within the Office will not terminate until the Federal Circuit mandate is issued or the time to file an appeal has expired. 37 CFR 41.205(a). Clearly, Office proceedings will not terminate if the Federal Circuit issues a remand order requiring the lower tribunal to perform further work that itself can ultimately be appealed to the Federal Circuit.

Second, the plain language of the statute reflects Congress' intent to provide estoppel effect in a reciprocal fashion between court (litigation) proceedings and *inter partes* reexamination proceedings. For example, an *inter partes* reexamination will bar a civil action validity challenge on the same claims only after any appeals. *See* 35 U.S.C. § 315 (c) (third party is barred from

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"final decisions" of district courts are ripe for appeal); Fed. R. App. P. 41 (b) (1998 advisory committee notes explain "a court of appeals judgment or order is not final until issuance of its mandate; at that time the parties obligations become fixed"). Accordingly, the term "final decision" must be read in the context of the particular statute in which it is embodied.

[35] The estoppel provisions are applied reciprocally for *inter partes* reexamination and civil proceedings.

raising invalidity in a civil action if claims previously "finally" held valid in an *inter partes* reexamination); *see also* 35 U.S.C. § 316 (mandating that an *inter partes* reexamination certificate cannot be issued until all appeals are exhausted). Similarly, a "final decision" in an *inter partes* reexamination proceeding will bar a subsequent *inter partes* reexamination on the same claims, and a "final decision . . . in a civil action" will bar a subsequent reexamination on the same claims. 35 U.S.C. § 317(b). Looking at the plain language of the statute, it is clear that the term "final decision" is symmetrically applied to both civil actions in court and *inter partes* reexamination proceedings within the Office throughout §§ 317(b) and 315(c). Further, there is no reason from the reading of the statute that the same term used twice in the same provision, *i.e.*, "final decision," should have two different meanings. Since *an inter partes* reexamination proceeding does not become a "final decision" holding claims valid until "after all appeals," a similar interpretation should be reciprocally applied to a civil action in court. Thus, just like a Board of Patent Appeals and Interferences ("Board") decision pending appeal is not a final decision and does not estop a civil action, a district court decision on appeal to the Federal Circuit does not estop an *inter partes* reexamination proceeding from continuing within the Office. Moreover, when a district court, as in this case, has been ordered on remand by the Federal Circuit to do further work that may alter its original decision, it is clear that any initial decision it previously entered is not final with respect to the issues it has been ordered to address.

Third, the legislative history of 35 U.S.C. § 317 confirms that the term "final decision" must be "after all appeals." In pertinent part, the legislative history states:

> Sec. 4604. Optional inter partes Reexamination Procedure *****
> ... if a third-party requester asserts patent invalidity in a **civil action** and a **final decision** is entered that the party failed to prove the assertion of invalidity, or if a **final decision** in an *inter partes* reexamination instituted by the requester is favorable to patentability, **after any appeals**, that third-party requester cannot thereafter request *inter partes* reexamination on the basis of issues which were or which could have been raised ...

145 Cong. Rec. S14720, (Nov. 17, 1999) (emphasis added). Consistent with the plain language of the statute, the legislative history confirms that a "final decision" is "after any appeals." A simple reading of the legislative history reveals that Congress contemplated that a "final decision" of either a prior *inter partes* reexamination or a civil action has estoppel effect only "after any appeals." As earlier explained, the statutory scheme creates a reciprocal estoppel effect, and the term "final decision," is used equally in reciprocal fashion in the same statutory clause applied to both *inter partes* reexamination proceedings and civil actions. Accordingly, the legislative history confirms, rather than detracts from, the Office's interpretation of "final decision" as "after all appeals."

Finally, logic and policy support construing the term "final decision" as "after all appeals." For example, in this instance, the District Court entered a decision but has now been ordered to reconsider its decision on remand by the Federal Circuit. Termination of the *inter partes* proceeding prior to exhaustion of appeals would be premature. If the *inter partes* reexamination proceeding is prematurely terminated, there is no way to "un-terminate" or re-start the *inter partes* reexamination proceeding. [36] A completely new request for reexamination would have to

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[36] Indeed, it is not clear how the Office could grant the requested relief of **severing** the merged proceeding only with respect to the six claims determined to be "not invalid." It is also not clear why severing the merged proceedings on this basis would mandate terminating and dismissing the '020 inter partes reexamination proceeding in its entirety, notwithstanding that 659 claims would remain in the '592 that were not subject to any determination of validity in the litigation.

be made in a redundant fashion, and the added time needed to go through this redundant process clearly runs counter to the "special dispatch" mandate of 35 U.S.C. 314(c). Clearly, such redundancy is a result that Congress did not intend in light of the fact that it provided the USPTO Director with the discretion to suspend parallel proceedings for "good cause." 35 U.S.C. § 314(c); 37 CFR § 1.987. Accordingly, a "final decision" as articulated in § 317 cannot occur until "after all appeals" in order for the statutory scheme to work in the efficient manner intended by Congress. In this case, such a "final decision" will not take place until after the District Court completes the further work it was ordered to do and any subsequent appeals from the District Court's subsequent decision are exhausted.

Thus, the Federal Circuit's August 2, 2005 decision has not been shown to be a "final decision" within the meaning of 35 U.S.C. § 317(b). Accordingly, termination of the '020 *inter partes* reexamination proceeding has not been shown to be required by the statute.

In addition, it appears from the Federal Circuit's replacement August 2, 2005 decision that the issue remanded to the District Court directly bears on the interpretation of a claim limitation appearing in claim 40 of the '592 patent. [37] Presumably, the District Court's construction of the limitation, on remand, could well effect issues directly bearing on the '020 *inter partes* reexamination proceeding, and the merged proceeding as a whole. Thus, patent owner has not shown that there has been a "final decision" with respect to the claim validity issue raised in the *inter partes* reexamination. Even if the only issue on remand is directed to claim interpretation with respect to infringement, petitioner has not demonstrated that a different construction of the claim would not require revisiting of the validity of the reinterpreted claim. Thus, notwithstanding patent owner's arguments that 35 U.S.C. § 317(b) defines "final decision" in the context of decisions on claim validity, it is clear that the action taken on remand in the District Court may reasonably have a potential impact on claim validity. Even crediting patent owner's position that continuing litigation on issues other than claim validity does not necessarily mean that a given court decision on claim validity is not final, petitioner has nevertheless failed to demonstrated that in this case, RIM will be unable to obtain a different outcome (from the initial District Court finding) regarding the interpretation of one or more of the claims of the '592 patent, and that a different interpretation would not necessarily require that the court revisit the issue of the validity of the involved claim or claims.

Further, there is still the matter of third party requester's right to petition for *certiorari* to the United States Supreme Court from the Federal Circuit's holding of claim validity. It appears that third party requester has the right to petition for *certiorari* on the issue of claim validity through January 5, 2006. [38] In light of this fact, it clearly cannot be concluded that the decision of the validity of *any* claims held valid in the litigation to date is a final decision.

Finally, if the merged proceeding were severed, the '495 *ex parte* reexamination proceeding would still remain intact. The estoppel provisions of 35 U.S.C. § 317(b) would not apply to that proceeding. Pursuant to the guidance provided by the Federal Circuit, the Office would be required to continue the '495 *ex parte* reexamination proceeding notwithstanding that there has been a final holding of claim validity. [39] In the event that the "final decision" of the Federal Circuit were then subsequently modified on the issue of claim validity (whether as a result of a determination on the remand to the District Court or as a result of a review of the Federal Circuit's decision on *certiorari* to the United States Supreme Court) and the litigation on the

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[37] 392 F. 3d 1336, 1349; 73 USPQ2d 1231, 1241, and, in particular, footnote 5 of the opinion.
[38] See note 42, *supra*.
[39] *Ethicon v. Quigg*, 849 F.2d 1422, 1428, 7 USPQ2d 1152, 1157 (Fed. Cir. 1988)

question of claim validity then continued, the Office could find itself in a position of having to conduct two separate reexamination proceedings on the same patent, with the proceedings being at two diverse and distinct stages. Many scenarios can be envisioned in which the *ex parte* proceeding might have to be delayed (contrary to the statutory mandate of "special dispatch") pending any prosecution necessary to bring a newly re-started (or re-filed) *inter partes* proceeding to the same point in prosecution as the on-going *ex parte* reexamination proceeding that has continued in the Office. [40] Construing 35 U.S.C. § 317(b) to require that the Office proceed with the *ex parte* proceeding while terminating, or even suspending, the *inter partes* proceeding does not bode well for conducting orderly proceedings within the Office, since the *inter partes* proceeding may potentially have to re-started or reconstituted as a result of a modification on the question of claim validity resulting from ongoing litigation.

In summary, if further court review can still be sought, [41] then the Federal Circuit decision is not a "final decision" within the meaning of 35 U.S.C. § 317(b). Patent owner has not supplied sufficient information to establish on the record that the Federal Circuit decision is a "final decision" within the meaning of 35 U.S.C. § 317(b). Therefore, termination of the '020 reexamination proceeding is not required by the statute. Accordingly, there is presently no reason to sever the '020 *inter partes* reexamination proceeding from the merged '495 *ex parte* reexamination proceeding and terminate the '020 *inter partes* proceeding, particularly given that the issues in both proceedings are integrally intertwined.

C. Patent Owner Has Not Demonstrated That The '020 *Inter Partes* Reexamination Proceeding Is Based Solely On Patents Of Printed Publications "Available" To The Requester (Or Office) During The Litigation

Even if petitioner could demonstrate that there has been a "final decision" in the litigation between NTP and RIM within the meaning of 35 USC § 317(b), the language of 35 U.S.C. § 317(b) reproduced immediately below, read in light of the legislative history of that statute, would nevertheless permit the '020 *inter partes* reexamination proceeding to be maintained.

35 U.S.C. § 317(b) states:

> "This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings."

The legislative history reproduced (and cited) above states:

> "[T]he third-party requester may assert invalidity based on newly discovered prior art unavailable at the time of the civil action or *inter partes* reexamination. Prior art was unavailable at the time if it was not known to the individuals who were involved in the civil action or *inter partes* reexamination proceeding on behalf of the third-party requester and the USPTO."

In the present instance, a review of the '020 *inter partes* reexamination proceeding, and of the litigation papers made of record by patent owner therein, [42] shows that the patents and printed publications of record in the '020 *inter partes* reexamination proceeding far outnumber the

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[40] As noted by the *Ethicon* court, "nothing ... prevents the Commissioner from conducting orderly proceedings within his office so long as he does not violate the statute." *See Id.*

[41] Or, the decision is "final" in the sense that it is ripe for appeal and the period for seeking review has not expired.

[42] See note 4, *supra*, with respect to available reports involving the District Court litigation

patents and printed publications **specifically** identified and discussed in the litigation related papers and reported decisions. Further, patent owner's June 30, 2004, Information Disclosure Statement (in the '020 *inter partes* reexamination proceeding) noted that less than all the prior art *submitted by the third party requester to establish the substantial new question of patentability* was submitted in the litigation. The art advanced by requester in the reexamination proceeding may not be barred by 35 U.S.C. § 317(b), unless patent owner can show that a given patent or printed publication:

(a) was "raised" in the District Court litigation, or
(b) "could have" been raised in the litigation by requester.

With respect to element (a), the patent owner has not shown that all of the prior art relief upon in the merged reexamination proceeding "was raised" in the District Court litigation. As to element (b), the patent owner has not shown that RIM had a legal right, as to a given patent or printed publication relied on in the merged reexamination proceeding, to introduce that patent or publication into the litigation after it became "available" to RIM. Patent owner has neither alleged nor established that, at the inception of the litigation, RIM knew of the prior art that is of record in the merged reexamination proceeding that was not of record in the litigation. Alternatively, patent owner has not established that RIM learned of this "additional" prior art subsequent to the inception of the litigation and could have raised that art during the litigation but failed to do so. In particular, patent owner has not demonstrated that the prior art applied in the outstanding Office action dated September 28, 2005 that was not considered during the litigation was ever introduced into the litigation, or could have been raised therein by RIM. That is, patent owner has not established that any of the prior art of record in the merged prior was available to be introduced at the inception of the litigation, or that the prior art was available at any stage subsequent to the commencement of the litigation. Thus even if the there had been a "final" court decision within the meaning of 37 U.S.C. § 317(b), Congress legislated that an *inter partes* proceeding based upon prior art that was not raised during litigation of claim validity, and could not have been raised during such litigation, should continue in the Office.

As pointed out, the patent owner has not demonstrated that the merged reexamination proceeding is based entirely upon prior art that was raised, or could have been raised, in the litigation between NTP and RIM. It is further pointed out that the patent owner's request for reconsideration is silent on this issue. For example, patent owner has not stated whether a motion to have prior art that apparently was not of record in the litigation proceedings, (*e.g*, the so-called "TeleNor" prior art), considered by the District Court or the Federal Circuit was ever filed, and if so, what the outcome of such motion was. Accordingly, patent owner has not demonstrated that all of the patents and printed publications deemed to demonstrate a substantial new question of patentability in the *inter partes* reexamination were raised (or could have been raised) in the District Court litigation. Additionally, patent owner has not demonstrated that all of the prior art of record applied in the Office action dated September 28, 2005 [43] was raised in the District Court litigation or was known by and available to third party requester so that it could have been raised in the litigation. Therefore, even assuming, *arguendo*, that the litigation at this stage could be deemed to have reached a "final decision" on claim validity, patent owner has not demonstrated a critical element to warrant sever and termination of the '020 *inter partes* reexamination proceeding pursuant to 35 U.S.C. § 317(b).

[43] For example, the so-called "TeleNor" prior art.

D. Patent Owner Has Not Shown That All of the Claims of The '592 Patent Have Been Held "Not Invalid"

In the September 16, 2005 decision on petition, it was stated that the District Court's prior art validity determination is limited to only those claims that NTP asserted RIM to have infringed. It does not appear that RIM attempted to invalidate every claim of the patents. With respect to the '592 patent, the issues of infringement and validity appear to be limited to claims 40, 150, 278, 287, 653 and 654. Given that only six out of six hundred and sixty-five claims of the '592 patent were **specifically** identified in the District Court's final order (August 5, 2003), the District Court's published opinions, [44] and Federal Circuit's published decision;[45] the patent owner has not established that the courts have reached a holding that **all** of the '592 claims are "not invalid" (*i.e.*, valid over the issues addressed in the litigation). In fact, it now appears that patent owner now wishes to sever the merged reexamination proceeding only with respect to the above mentioned six claims.

The estoppel effect provided by 35 USC § 317(b) is on a "claim by claim" basis and therefore, each claim must be independently analyzed. 35 USC 317(b) states that:

> Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of **any patent claim** in suit ... then neither that party nor its privies may thereafter request an inter partes reexamination of **any such patent claim** on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of **such issues** may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. [Emphasis added.]

In the petitions filed on October 10, 2003 and July 7, 2005, patent owner did not point out the basis for its position that **all** of the '592 claims have been held "not invalid."[46,47] Further, given the lack of information in the case reports that **all** of the '592 patent claims were determined to be "not invalid," as opposed to only those **specifically** identified by claim number, the Office was, and is, unable to conclude that the claims which have been held "not invalid" include "any such patent claim" other than claims 40, 150, 278, 287, 653 and 654, - the claims **specifically** identified. Therefore, it appears, that on the existing record, even if the '020 *inter partes* reexamination proceeding were to be severed from the merged proceeding, 35 U.S.C. § 317(b) would **not** require that the '020 *inter partes* reexamination be terminated. Rather, the '020 *inter partes* reexamination proceeding would continue with respect to the patent claims not addressed by the litigation, and the intertwined issues of the two formerly merged reexamination proceedings would continue on independently. This is considered by the Office to be a far from desirable result. Absent any basis for termination of the '020 *inter partes* reexamination proceeding, it is desirable that the two proceedings continue as a merged proceeding.

In light of patent owner's present request for relief in the form of severing "with respect to at least the six claims of United States Patent No. 6,217,592, the validity of which have been fully

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[44] See note 1, *supra*

[45] See note 7, *supra*

[46] See note 14, *supra*

[47] It was presumed that only claims that are "not invalid", i.e. valid, can be infringed, and so it is clear that claims 40, 150, 278, 287, 653 and 654 of the '592 patent, the only claims that have specifically been held to be infringed, have also been held to be "not invalid."

adjudicated," [48] it is even more clear that 35 U.S.C. § 317(b) does not require the '020 *inter partes* reexamination proceeding to be terminated. If the merged proceedings were to be severed, there would be no basis upon which to terminate the '020 *inter partes* reexamination proceeding inasmuch as the question of patentability of the remaining 659 claims would remain. Independently conducting two separate reexamination proceedings on the '592 patent with respect to 659 identical claims in each proceeding is not considered by the Office to be a desirable result. Absent any basis for completely terminating the '020 *inter partes* reexamination proceeding, it is desirable that the two proceedings continue on as a merged proceeding.

## DECISION ON REQUESTER'S PETITION IN OPPOSITION TO PATENT OWNER'S REQUEST FOR RECONSIDERATION

Relief Requested By Third Party Requester:

Essentially, the third party requester opposition requests that the Office not grant the patent owner's renewal of its request that the merged proceeding be severed and that the '020 *inter partes* reexamination proceeding then be terminated. That relief, requested and argued for by the third party requester, is grantable for the reasons set forth above in denying the patent owner's petition. Accordingly, that aspect of relief will not be further discussed in this portion of the decision. The third party requester additionally urges that the September 16, 2005 decision on petition is not a final agency action because "[A]n agency decision regarding a petition to sever and dismiss an *inter partes* reexamination proceeding does not rise to the level of a final agency action." [49] In support of this position, third party quotes 5 U.S.C. § 704 as follows, and relies upon the emphasized language:

> "Agency action made reviewable by statute and final agency action for which there is no other adequate remedy in a court are subject to judicial review. **A preliminary, procedural, or intermediate agency action or ruling not directly reviewable is subject to review on the review of the final agency action.** Except as otherwise expressly required by statute, agency action otherwise final is final for the purposes of this section whether or not there has been presented or determined an application for a declaratory order, for any form of reconsideration, or, **unless the agency otherwise requires by rule and provides that the action meanwhile is inoperative, for an appeal to superior agency authority.**" (Emphasis supplied by third party requester.)

I. Summary of the Issue Presented and its Resolution:

The sole issue here is whether, in a merged reexamination proceeding in which an *inter partes* reexamination proceeding has been merged with an *ex parte* reexamination proceeding, the refusal to grant a patent owner petition to sever the merged proceeding and to then terminate the *inter partes* reexamination proceeding may properly be designated as a final agency action for purposes of permitting patent owner to seek judicial review. For the reasons discussed, *infra*, the Office concludes that the language of 5 U.S.C. § 704 read in light of the statutes and regulations governing appeals in reexamination proceedings permits the Office to designate a the refusal to grant patent owner the relief petitioned for as a final agency decision.

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[48] See note 2, *supra*.

[49] Third Party Requester's Petition ... in Opposition to Patent Owner's Request for Reconsideration... ", October 21, 2005 at page 14.

## II. Applicable Statutory and Regulatory Provisions:

**35 U.S.C. § 315** states:

"(a) PATENT OWNER.– The patent owner involved in an *inter partes* reexamination proceeding under this chapter–

(1) may appeal under the provisions of section 134 and may appeal under the provisions of sections 141 through 144, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent; and

(2) may be a party to any appeal taken by a third-party requester under subsection (b).

(b) THIRD-PARTY REQUESTER.– A third-party requester–

(1) may appeal under the provisions of section 134, and may appeal under the provisions of sections 141 through 144, with respect to any final decision favorable to the patentability of any original or proposed amended or new claim of the patent; and

(2) may, subject to subsection (c), be a party to any appeal taken by the patent owner under the provisions of section 134 or sections 141 through 144.

(c) CIVIL ACTION.– A third-party requester whose request for an *inter partes* reexamination results in an order under section 313 is estopped from asserting at a later time, in any civil action arising in whole or in part under section 1338 of title 28, the invalidity of any claim finally determined to be valid and patentable on any ground which the third-party requester raised or could have raised during the *inter partes* reexamination proceedings. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings.

**35 U.S.C. § 134 states in pertinent part:**

(b) PATENT OWNER.– A patent owner in any reexamination proceeding may appeal from the final rejection of any claim by the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

(c) THIRD-PARTY.– A third-party requester in an *inter partes* proceeding may appeal to the Board of Patent Appeals and Interferences from the final decision of the primary examiner favorable to the patentability of any original or proposed amended or new claim of a patent, having once paid the fee for such appeal.

**35 U.S.C. 141 states in pertinent part:**

"An applicant dissatisfied with the decision in an appeal to the Board of Patent Appeals and Interferences under section 134 of this title may appeal the decision to the United States Court of Appeals for the Federal Circuit. By filing such an appeal the applicant waives his or her right to proceed under section 145 of this title. A patent owner, or a third-party requester in an *inter partes* reexamination proceeding, who is in any reexamination proceeding dissatisfied with the final decision in an appeal to the Board of Patent Appeals and Interferences under section 134 may appeal the decision only to the United States Court of Appeals for the Federal Circuit. ..."

**37 CFR 1.181(a) states:**

Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

III. Analysis and Findings:

Third party requester does not sufficiently explain why the emphasized portions of the statute (5 U.S.C. § 704), or the entire statute, would preclude designating the instant decision [50] a final agency action pursuant to 5 U.S.C. § 704, particularly since requester appears to acknowledge that the right to appeal in an *inter partes* reexamination is limited to appeal of "any decision adverse to the patentability of any original or proposed amended or new claim of the patent" under 35 U.S.C. § 315. It appears that third party requester believes that the relief sought by patent owner is appealable pursuant 35 U.S.C. § 315. However, third party requester does not expressly articulate any rationale explaining why a decision refusing to sever and terminate this *inter partes* reexamination proceeding would constitute "a decision adverse to patentability of any original or proposed amended or new claim of the patent." It may be that third party requester equates severing the merged proceeding and then terminating the '020 *inter partes* reexamination proceeding as a confirmation of the claims of the '592 patent, and that granting the relief requested by patent owner would divest third party requester of the right to appeal from a finding of validity for one or more of the '592 patent claims. This is, however, not the case.

It is clear from a consideration of 35 U.S.C. §§ 134, 141 and 315 that third party requester in an *inter partes* reexamination proceeding has a right to appeal to the Court of Appeals for the Federal Circuit, and that such appeal is only from a final decision of the Patent and Trademark Office Board of Patent Appeals and Interferences ("BPAI") as to a final decision of the primary examiner **favorable to the patentability** of any original or proposed amended or new claim of a patent. In this instance, however, there cannot be a final decision by the primary examiner as to the patentability of the claims based on the art, since the challenge is that the Office lacks jurisdiction to reexamine a patent and to consider the patentability of any original or proposed amended or new claim of the patent. In this decision, the Office is rendering a final decision that the Office does in fact have jurisdiction to reexamine the '592 patent and to consider the patentability of any original or proposed amended or new claim of that patent. This action by the Office is a final action within the meaning of 5 U.S.C. § 704, and the patent owner has a right to challenge this action by appeal to the courts, since this action is independent of the patentability issue as to the art advanced in the reexamination proceeding.

The action being taken by the Office is to deny a petition to sever the merged proceeding and to also deny patent owner's petition to then terminate the '020 *inter partes* reexamination proceeding. It is not appealable to the BPAI, because it does not involve any final adverse determination by the primary examiner on the question of patentability of any of the pending claim. Rather, pursuant to 37 CFR 1.181(a), the refusal to grant the relief requested by patent owner is petitionable, and the patent owner has done so. Since there is no appeal to the BPAI available to patent owner from the action being taken by the Office, the patent owner has the right to challenge the office holding as to its petition by way of the courts. This decision states that none of the relief requested by patent owner will be granted. Accordingly, it appears that

[50] As indicated in the fourth paragraph of page 2, *supra*, patent owner's "Request for Reconsideration ... " is construed to request that the instant decision reconsidering the "Decision Dismissing Petition" dated September 16, 2005 be designated as a final agency action, and not that the "Decision Dismissing Petition" dated September 16, 2005 be so designated.

the final refusal by the Office to grant the relief requested in patent owner's petitions filed on October 10, 2003 and July 5, 2005 clearly constitutes a final agency action for which there would be a remedy pursuant to 5 U.S.C. § 704 in an appropriate court.

## CONCLUSION

1. Patent owner's request to reconsider the September 16, 2005 decision is granted to the extent that the decision has been fully reconsidered, but the request to sever the '020 *inter partes* reexamination proceedings from its merger with the '495 *ex parte* reexamination proceeding and to then terminate the '020 *inter partes* reexamination proceedings is denied.

2. Patent owner has not demonstrated that the August 2, 2005 decision on appeal by the Federal Circuit is a "final decision" within the meaning of 35 U.S.C. § 317(b) that would satisfy the 35 U.S.C. § 317(b) "final decision" requirement for termination of *inter partes* reexamination proceeding '020.

3. Patent owner has not demonstrated that all of the prior art relied upon in the merged reexamination proceeding was before the District Court during the litigation of the '592 patent, or was available to the third party requester for entry into the litigation prior to the filing of the request for *inter partes* reexamination. Thus, another of the 35 U.S.C. § 317(b) requirements for termination of the *inter partes* reexamination proceeding '020 has not been demonstrated.

4. Patent owner has not demonstrated that any claims of the '592 patent other than claims 40, 150, 278, 287, 653 and 654 have been held by the courts to be "not invalid." Thus, still another of the 35 U.S.C. § 317(b) requirements for termination of *inter partes* reexamination proceeding '020 has not been demonstrated.

5. The merger of the '695 *ex parte* reexamination proceeding with '020 *inter partes* reexamination proceeding, will continue, *i.e.*, will not be severed, as petitioner has not demonstrated that there is a statutory basis to terminate the '020 *inter partes* reexamination proceeding.

6. Third party requester's petition in opposing patent owner's petition for reconsideration is granted to the extent that the severance and termination relief requested by patent owner will not be granted as set forth above, but is denied with respect to the requested relief of refusing to designate this decision as a final agency action.

7. This decision is a final agency action within the meaning of 5 U.S.C. § 704.

8. Telephone inquiries with regard to this decision should be directed to Kenneth M. Schor, Senior Legal Advisor, or, in his absence, to Stephen Marcus, Legal Advisor, at 571-272-7710.

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

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STURM and FIX, LLP
206 Sixth Avenue
Suite 1213
Des Moines, IA 50309-4076

(For Patent Owner)

MAILED

FEB 23 2006

REEXAM UNIT

NOVAK DRUCE & QUIGG, LLP
1300 Eye Street NW
400 East Tower
Washington, DC 20005

(For Requester)

In re Thomas J. Campana, Jr. et al.
*Inter partes* Reexamination Proceeding
Control No. 95/000,020
Filed: May 29, 2003
For: U.S. Patent No. 6,317,592

In re Thomas J. Campana, Jr. et al.
Director Ordered
*Ex parte* Reexamination Proceeding
Control No. 90/006,495
Filed: December 26 2002
For: U.S. Patent No. 6,317,592

DECISION DENYING PETITION
FOR WITHDRAWAL OF ACTION
CLOSING PROSECUTION
(37 CFR 1.949)

This is a decision on the February 17, 2006, patent owner petition titled "Expedited Petition to Withdraw The Action Closing Prosecution of February 1, 2006 Due to Inclusion of New Grounds of Rejection Not Necessitated by Amendment."

The petition is taken as a petition under 37 CFR 1.181(a)(1), as it is a petition from an action of an examiner in the prosecution of a reexamination proceeding which action is not subject to appeal. Accordingly, the petition is before the Director of the Central Reexamination Unit for consideration.

The petition is denied for the reasons set forth below.

## DECISION

Patent Owner requests withdrawal of the Action Closing Prosecution action (hereinafter ACP) dated February 1, 2006.

The petition was filed February 17, 2006, together with authorization to charge the fee as required under 37 CFR 1.17 (g). However, the petition is taken as a petition under 37 CFR 1.181(a)(1), and, thus, no fee is needed.

I. Patent Owner Petitioner's Position:

The Patent Owner states that the February 1, 2006 Office action "contained numerous new points and new grounds for rejection that have not been fully developed and to which the Patent Owner has not been permitted to respond through affidavit, declaration or other forms of evidence."

The Patent Owner asserts that the Office relies upon "unsupported hearsay evidence from Norwegian Librarian" and "unsupported factual assertion regarding search techniques used in 1991."

The Patent Owner urges that Verjinski and Perkins, both of record in the proceedings, raise issues of "new inherency rejections."

II. Applicable Regulation And Practice Regarding Action Closing Prosecution:

**37 CFR 1.949 Examiner's Office action closing prosecution in *inter partes* reexamination.**

Upon consideration of the issues a second or subsequent time, or upon a determination of patentability of all claims, the examiner shall issue an Office action treating all claims present in the *inter partes* reexamination, which may be an action closing prosecution. The Office action shall set forth all rejections and determinations not to make a proposed rejection, and the grounds therefor. An Office action will not usually close prosecution if it includes a new ground of rejectionwhich was not previously addressed by the patent owner, unless the new ground was necessitated by an amendment.

**37 CFR 1.951 Options after Office action closing prosecution in inter partes reexamination.**

(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.
(b) When the patent owner does file comments, a third party requester may once file comments responsive to the patent owner's comments within 30 days from the date of service of patent owner's comments on the third party requester.

**MPEP 1207.03, part III**

III. SITUATIONS THAT ARE NOT CONSIDERED AS NEW GROUNDS OF REJECTION

There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. *Id.* At 1303, 190 USPQ at 427 (reliance upon fewer references in affirming a rejection under 35 U.S.C. 103 does not constitute a new ground of rejection).

III. Applicable Case Law:

*Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991): "To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." (The court went on to explain that "this modest flexibility in the rule that anticipation' requires that every element of the claims appear in a single reference accommodates situations in which the common knowledge of technologists is not recorded in the reference; that is, where technological facts are known to those in the field of the invention, albeit not known to judges." 948 F.2d at 1268, 20 USPQ at 1749-50.). Note that as long as there is evidence of record establishing inherency, failure of those skilled in the art to contemporaneously recognize an inherent property, function or ingredient of a prior art reference does not preclude a finding of anticipation. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1349, 51 USPQ2d 1943, 1948 (Fed. Cir. 1999) (Two prior art references disclosed blasting compositions containing water-in-oil emulsions with identical ingredients to those claimed, in overlapping ranges with the claimed composition. The only element of the claims arguably not present in the prior art compositions was "sufficient aeration . . . entrapped to enhance sensitivity to a substantial degree." The Federal Circuit found that the emulsions described in both references would inevitably and inherently have "sufficient aeration" to sensitize the compound in the claimed ranges based on the evidence of record (including test data and expert testimony). This finding of inherency

was not defeated by the fact that one of the references taught away from air entrapment or purposeful aeration.). See also *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 139 (Fed. Cir. 1986); *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 782, 227 USPQ 773, 778 (Fed. Cir. 1985). See MPEP §§ 2112 - 2112.02 for case law on inherency. Also note that the date of extrinsic evidence showing a universal fact need not antedate the filing date. See MPEP § 2124.

*In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n. 3 (CCPA 1970): Where a newly cited reference is added merely as evidence of the prior statement made by the examiner as to what is "well-known" in the art which was challenged for the first time in the appeal brief, the citation of the reference in the examiner's answer would not ordinarily constitute a new ground of rejection within the meaning of 37 CFR 41.39(a)(2).

IV. Analysis and Findings

The allegation that the February 2006 Office Action is an improper ACP as it contains new points and new grounds of rejection not necessitated by amendment is not deemed persuasive.

The Patent Owner petitioner urges that the Office relies upon unsupported hearsay evidence from a Norwegian Librarian. However, the Norwegian Librarian comments referred to are not a part of the actual Telenor rejection. The statements have no bearing on the actual rejection of the claims. Absent some specific evidence that the Librarian's comments are a part of an applied rejection, this point raised by petitioner cannot be considered a "new grounds for rejection."

Petitioner's comments about unsupported factual assertion regarding search techniques used in 1991 are likewise not persuasive. Again the issues are not a part of any applied rejection of the claims. To establish whether the ACP is premature, the Patent Owner would need to point out where new grounds for rejection have been applied in the Office action, which new grounds were not necessitated by amendment.

Petitioner lastly comments that there are new inherency rejections based upon Verjinski and Perkins.[1] The Patent Owner's comments directed to Verjinski and Perkins are from the remarks section of the February 1, 2006 Office action, in those remarks, the examiner pointed out that the claim construction of the Patent Owner is not supported by the actual claim limitation when read according to the MPEP 2258. "During reexamination, claims are given the broadest reasonable interpretation consistent with the specification and limitations in the specification are not read into the claims (*In re Yamamoto*, 740 F.2d 1569, 222 USPQ 934 (Fed. Cir. 1984))." The arguments previously presented by the Patent Owner were directed to the claim construction. In any event, even if the Patent

[1] The rejections of claims by the Telenor references are apparently not at issue.

Owner's position was adopted, the remarks presented by the examiner were used to illustrate the point that the narrow construction would still be inherent. This is explained in the remarks of the February 1, 2006 Office action by the examiner. Thus this is in not a new grounds for rejection. Even if this were presented in the actual rejection of the claims by Verjinski or Perkins, which it is not, it would still not be persuasive, since establishing what is old and well-known does not ordinarily establish a new ground of rejection. *In re Hoch, supra.*

Lastly, it is pointed out that the Patent Owner has an avenue of procedure available as addressed in 37 CFR 1.951 in which the "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." The Patent Owner may wish to consider making use of this avenue.

## CONCLUSION

1. The Patent Owner's petition under 37 CFR 1.181 for withdrawal of the Action Closing Prosecution is **denied**.

2. All correspondence regarding these proceedings should be submitted as follows:

By Mail to: Mail Stop *Inter Partes* 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

Telephone inquiries with regard to this decision should be directed to Mark Reinhart, Special Program Examiner for the Central Reexamination Unit, Art Unit 3992, at (571) 272-1611

M Reinhart / SPRE-CRU 3992 for
Lissi M. Marquis,
Director,
Central Reexamination Unit

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(For *Inter Partes* Reexamination Requester)

*In re Campana, Jr. et al*
*Inter Partes* Reexamination Proceeding
Control No.: 95/000,020
Filed: May 29, 2003
For: U.S. Patent No. 6,317,592

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/006,495 ✓
Filed: December 26, 2002
For: U.S. Patent No.: 6,317,592

**DECISION DENYING PETITION**

MAILED
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REEXAM UNIT

This is a decision on the January 23, 2006 patent owner [1] petition filed entitled "PETITION PURSUANT TO 37 CFR 1.181 TO THE DIRECTOR TO COMPLY WITH CONGRESSIONAL MANDATE AND DISMISS INTER PARTES REEXAMINATION OR, IN THE ALTERNATIVE, TO TREAT NTP EQUALLY UNDER THE LAW WITH OTHER SIMILARLY SITUATED PARTIES." The petition is taken as a request for reconsideration of the November 30, 2005 "Decision Denying Petition," which decision was designated as being a final agency action under 5 U.S.C. § 704. The request for reconsideration is based upon a change in circumstances that occurred subsequent to the November 30, 2005 decision. Specifically, patent owner requests that *inter partes* reexamination proceeding 90/000,020 be dismissed. [2] In the alternative, patent owner requests that the Office discontinue what patent owner asserts is disparate treatment of NTP relative to similarly situated parties and suspend (i.e., stay) *inter partes* reexamination proceeding 95/000,020. Patent owner also

[1] United States Patent No. 6,317,592 is owned by NTP, Inc. Any reference, *infra*, to NTP, Inc. are to be understood as referring to the "patent owner."

[2] It is not clear whether patent owner's use of the word "dismissed" (or variations thereof) throughout this petition is intended to mean that the '020 *inter partes* reexamination prosecution should be "terminated." Termination of an *inter partes* reexamination prosecution may, in turn, result in conclusion of the proceeding by publication of a reexamination certificate. See 35 U.S.C. § 316, and the discussion in MPEP § 2694, which points out that conclusion of an *inter partes* reexamination may occur as a result of the vacating the proceeding, which would not result in publication of a reexamination certificate. In prior petitions directed to this issue, patent owner's requested relief was that the 95/000,020 proceeding be "severed and dismissed," but patent owner also used the phrase "severed and terminated" interchangeably. In discussing patent owner's requested relief and rationale therefor, this decision will continue to use patent owner's terminology, *i.e.* "dismiss," or a variation thereof. While it is unclear whether patent owner actually is requesting that the 95/000,020 be concluded by publication of a reexamination certificate, or simply vacated, the result reached in this decision would apply for either interpretation.

requests that the Office remove "the taint of the prior unlawful submissions" by the third party requester. [3] The third party requester has not filed an opposition to the present petition.

The 90/006,495 and 95/000,020 reexamination proceedings are before the Director of the Office of Patent Legal Administration for consideration of the present patent owner petition for reconsideration.

## SUMMARY

The patent owner petition is granted to the extent that the November, 2005 decision on the October 7, 2005 patent owner petition has been fully reconsidered in light of the change in circumstances that has occurred subsequent to that decision. However, for the reasons set forth below, patent owner's request for reconsideration is otherwise denied with respect to all of the relief requested, including the requested "dismissing" or staying the 95/000,020 *inter partes* reexamination proceeding.

## BACKGROUND

1. U.S. Patent No. 6,317,592 (hereinafter the '592 patent) issued to Campana *et al* on November 13, 2001, from an application filed on December 6, 1999.

2. On December 26, 2002, a reexamination of the '592 patent was ordered at the initiative of the Director of the United States Patent and Trademark Office, and the resulting reexamination proceeding was assigned control number 90/006,495 (hereinafter the '495 reexamination proceeding).

3. On May 29, 2003, a request for *inter partes* reexamination of the '592 patent was filed in the Office by a third party requester, resulting in reexamination proceeding control number 95/000,020 (hereinafter the '020 reexamination proceeding).

4. On August 12, 2003, the patent owner filed a notice of concurrent proceedings under 37 CFR 1.985 in the '020 proceeding. The notice advised the Office of a final decision and order dated August 5, 2003, that was issued by the U.S. District Court for the Eastern District of Virginia, in *NTP, Inc. V. Research In Motion*, C.A. # 3:01CV767 (E.D. Va., August 2003). The August 12, 2003 notice provided a copy of the court order and its accompanying memoranda and other orders issued by the court. The materials were provided by the patent owner for the purpose of asserting that the District Court found the defendant, third party requester RIM, (a) not to have sustained its burden of proving the invalidity of any patent claim in the '592 patent, and (b) to have infringed certain of plaintiff NTP's patent claims in the '592 patent. [4] Pursuant to Federal Rules of Appellate Procedure Rules 3 and 4,

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[3] The third party requester in *inter partes* reexamination proceeding 95/000,020 is David L. Stewart. However, the real party in interest is Research in Motion, Ltd. (hereinafter "RIM"). Any subsequent reference to RIM is to be understood as referring to the "third party requester."

[4] A review of the final order (and accompanying orders and memoranda), as well as from the three opinions of the U.S. District Court for the Eastern District of Virginia (Richmond Div) styled as "*NTP, Inc., Plaintiff v. Research in Motion, Ltd., Defendant*" reported at 270 F. Supp. 2d 751, 67 USPQ2d 1594 (May 23, 2003); 67 USPQ2d 1587 (May 23, 2003); and 261 F. Supp. 2d 423; 67 USPQ2d 1574 (November 4, 2002), does not show that the District Court found all of the claims of the '592 to be not invalid. See also *NTP, Inc.; v. Research In Motion, Ltd.*, 392 F.3d 1336, 73 USPQ2d 1231 (Fed. Cir. 2004), from which it appears that claims 40, 150, 278, 287, 653 and 654 of the '592 patent were held to be infringed by RIM. Presumably, at least these claims were held to be "not invalid" in order for them to have been held by the court to be infringed.

the District Court's decision was appealable within 30 days.

5. On August 26, 2003, the Office issued an order in the '020 reexamination proceeding granting *inter partes* reexamination of the '592 patent. The August 26th order notified the parties to the '020 reexamination proceeding that the decision in the litigation referred to in the August 12, 2003 Notice (see preceding paragraph) might be shown to provide grounds for termination of the '020 reexamination proceeding.

6. On October 10, 2003, the patent owner filed a petition under 37 CFR 1.181 (the "original" petition), requesting that the '020 reexamination proceeding be dismissed, *i.e.*, concluded. Patent owner argued that the District Court's holding and decision in *NTP, Inc. v. Research In Motion* [5] constituted a "final decision" within the meaning of 35 U.S.C. § 317(b) adverse to RIM. It was accordingly urged that the '020 reexamination proceeding, filed by a third party requester who was argued to be in privy with defendant RIM in the litigation, could not be maintained by the Office.

7. On June 2, 2004, the October 10, 2003 patent owner petition was dismissed on the grounds that the decision of the U.S. District Court relied upon by patent owner was not a "final decision" within the meaning of 35 U.S.C. § 317(b).

8. On August 9, 2004, the Office issued a decision, *sua sponte*, merging the '020 *inter partes* reexamination proceeding and the '495 *ex parte* reexamination proceeding into a single merged proceeding pursuant to 37 CFR 1.989(a). The decision merging the two reexamination proceedings stated that the merged proceeding would be governed by the provisions of 37 CFR 1.902 through 1.997, as required by 37 CFR 1.989(b).

9. On December 14, 2004, a decision of the Federal Circuit was rendered in the *NTP, Inc. v. Research In Motion* litigation. [6]

10. On July 7, 2005, patent owner filed a petition to sever the instant merged proceeding and to dismiss and terminate the '020 *inter partes* reexamination proceeding.

11. On July 20, 2005, requester filed a petition opposing patent owner's July 7, 2005 petition.

12. On August 2, 2005, the Federal Circuit issued an Order granting a request for panel rehearing and rehearing *en banc* for the limited purpose of revising portions of the opinion treating Section 271 of Title 35 of the United States Code, and withdrawing the December 14, 2004 opinion. [7]

13. On August 2, 2005, the Federal Circuit also issued a substituted opinion. [8]

14. On August 16, 2005, RIM filed a petition in the litigation for panel rehearing and rehearing *en banc*, based upon the Federal Circuit's August 2, 2005 opinion.

15. On September 16, 2005, the Office rendered a decision dismissing the patent owner's July 7,

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[5] Presumably the petition referred to the final order discussed in item 4, *supra* and/or the published opinions of the District Court Cited in the above footnote.

[6] *NTP, Inc. v. Research in Motion, Ltd*, 392 F.3d 1336, 73 USPQ2d 1231 (Fed. Cir. 2004).

[7] *NTP, Inc. v. Research in Motion*, 418 F.3d 1282, 75 USPQ2d 1763 (Fed. Cir. 2005)

[8] *NTP, Inc. v. Research in Motion*, 418 F.3d 1282, 75 USPQ2d 1763 (Fed. Cir. 2005)

2005 petition to sever the merged proceeding, and terminate the '020 *inter partes* reexamination proceeding.

16. On September 28, 2005, the Office issued a first Office action on the merits (*i.e.*, on the patentability of the '592 patent claims) in which all patent claims, *i.e.* claims 1-665, were rejected. The rejection was based upon prior art (*e.g.* the so-called "TeleNor" prior art) , which was not of record until well after the *ex parte* and *inter partes* reexamination proceedings had been individually ordered and subsequently merged into a single proceeding. The TeleNor prior art does not appear to have been considered during any of the court proceedings.

17. On October 7, 2005, the Federal Circuit denied RIM's petition for a panel hearing and rehearing *en banc.* [9]

18. Also on October 7, 2005, the patent owner filed a petition requesting reconsideration of the Office's September 16, 2005 decision, and designation of the decision on the request for reconsideration as a final agency action under 5 U.S.C. § 704.

19. In the litigation, a motion to stay issuance of the Federal Circuit's mandate was filed by RIM on October 13, 2005.

20. On October 21, 2005, the Federal Circuit denied the motion to stay and issued its mandate, remanding the case to the District Court for further proceedings pursuant to the Federal Circuit's August 2, 2005 substituted opinion. [10]

21. Also on October 21, 2005, the third party requester filed a petition in opposition to the patent owner's October 7, 2005 petition.

22. Subsequent news reports stated that that RIM has petitioned Chief Justice Roberts for a stay of the Federal Circuit's mandate pending filing of a petition for *certiorari*, but the stay was denied. [11]

23. On November 17, 2005, the Office issued a decision granting two petitions (by the patent owner for those proceedings) to suspend pending *inter partes* reexamination proceedings 95/000,093 and 95/000,094. Those proceedings involved U.S. Patent Nos. 6,424,333 and 6,275,213, respectively. Those patents will be referred to as the '333 and '213 patents.

24. On November 30, 2005, the Office rendered a decision denying the patent owner's October 7, 2005, petition to sever the merged proceeding, and terminate the '020 *inter partes* reexamination proceeding. The decision was designated as a final agency action under 5 U.S.C. § 704.

25. On November 30, 2005, the United States District Court for the Eastern District of Virginia, Richmond Division denied a motion for stay of proceedings. [12]

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[9] *NTP, Inc. v. Research in Motion, Ltd.*, No 03-1615 (Fed. Cir. October 7, 2005)

[10] The substituted opinion is referenced in note 8, *supra.*

[11] *Patent Trademark & Copyright Journal*, Vol. 70 No. 1742, 10/28/05 (BNA). See also "Third Party Requester's ...Opposition to Patent Owner's request for Reconsideration ...", October 21, 2005, at page 9.

[12] *Research in Motion, Ltd., Petitioner v. NTP, Inc.* 397 F. Supp. 2d 785, 76, USPQ2d 1857

26. On January 23, 2006, the Supreme Court of the United States denied RIM's petition for *certiorari*. [13]

27 On March 3, 2006, the District Court dismissed the underlying action as a result of a settlement reached by the parties. [14]

## DECISION ON RECONSIDERATION

### I. Relief Requested By Patent Owner

#### A. Request That The Proceeding Be Dismissed

The present request for reconsideration was filed prior to the dismissal of the litigation on March 3, 2006. In it, the patent owner first requests that the '020 *inter partes* reexamination proceeding be "dismissed." As a basis for this request, patent owner alleges that the Office must now apply the estoppel provision of 35 U.S.C. § 317(b). [15] Patent owner argues that, in the Decision Denying Petition dated November 30, 2005, the Office incorrectly failed to find that there has been a "final decision" in accordance with 35 U.S.C. § 317(b), and therefore failed to correctly apply the estoppel provision of the statute. Patent owner identifies (1) the reliance by the Office on the existence of an outstanding petition for *certiorari* filed by RIM, and (2) the reliance of the Office on the existence of additional proceedings in the District Court as the reasons relied upon by the Office for refusing to apply 35 U.S.C. § 317(b) estoppel. Patent owner alleges that the circumstances have now changed, and there is in fact a "final decision" within the meaning of 35 U.S.C. § 317(b), because third party requester's petition for *certiorari* has been denied, and because the District Court was not asked by third party requester to revisit validity of any claim of the '592 patent. [16]

In further support of the position that 35 U.S.C. § 317(b) requires the Office to dismiss the '020 *inter partes* reexamination proceeding, patent owner also asserts that the Office has "[defied] the clear statements of Senator Hatch, Senator Leahy and the rest of Congress and ignore[d] Congress' clear statements limiting litigants to 'one bite at the apple'." Patent owner relies upon certain statements by Senators Hatch and Leahy which, in patent owner's view, indicate that the language of 35 U.S.C. § 317(b) requires a third party requester to choose between either pursuing a reexamination, or going directly to Federal court. [17] Patent owner's position is that a third party requester must choose either litigation or *inter partes* reexamination. Patent owner argues that the third party requester, having chosen to pursue litigation with respect to the '592 patent, is estopped from pursing *inter partes* reexamination by reason of 35 U.S.C. § 317(b) because the litigation is, in patent owner's view, finally decided.

#### B. Request To End "Disparate Treatment" Of Patent Owner By Suspending Proceeding

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[13] *Research in Motion, Ltd., Petitioner v. NTP, Inc.*, 2006 U.S. LEXIS 1053 (U.S. Jan. 23, 2006) (No. 05-763).
[14] *NTP, Inc. v. Research in Motion, LTD.* No. 3:01CV767 (E. D. VA March 3, 2006).
[15] 35 U.S.C. § 317(b) provides in pertinent part the "Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit ... then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. "
[16] See pages 2-3 and Appendix B of the instant petition.
[17] See pages 3-5 of the instant petition.

Patent owner argues that, in the alternative, patent owner (NTP) has been treated differently than another patent owner (Immersion Corporation) was treated in *inter partes* reexamination proceedings 95/000,093 and 95/000,094 (hereinafter the '093 proceeding and the '094 proceeding reexamination proceedings). [18] The records in the '093 and '094 proceedings show that on September 29, patent owner Immersion Corporation Patent owner filed a petition in each proceeding requesting that the proceeding be suspended. On November 17, 2005, the Office granted the petitions in a single decision addressed to both of the proceedings. NTP asserts that the reasoning in the Immersion decision that supports the grant of the requested suspensions is applicable to the present '020 *inter partes* reexamination proceeding. NTP therefore requests that, if the Office will not dismiss the '020 reexamination proceeding, then for the same reasons relied upon in the decision granting the Immersion petitions to suspend, the Office should "not continue its disparate treatment of NTP as compared to other similarly situated parties," and should suspend the '020 *inter parties* reexamination proceeding. [19]

C. Request To Cleanse the Record Of Information Resulting From Unlawful Contacts and Submissions By The Third Party Requester

Patent owner alleges that in the course of the '020 *inter partes* reexamination proceeding, there have been unlawful contacts and submissions "in violation of the statute." It is further alleged that the third party requester has submitted numerous papers that are null and void and cannot be considered by the Office. Patent owner alleges that the third party requester has engaged in numerous contacts with the Office that are not of record, but which "must be revealed and fully set forth on the public record." Patent owner requests that the Office "devise a plan" to eliminate the "taint and "prejudice" caused by these contacts, "including any assurances" made by Office personnel to the third party requester regarding the timing and outcome of Office activities.

## II. Analysis and Findings

### A. Dismissal Of The '020 Proceeding

Patent owner argues that the litigation between patent owner and RIM (the real party in interest for the third party requester) has now reached a stage in which there is a final decision on claim validity within the meaning of 35 U.S.C. § 317(b). Patent owner points to the denial of RIM's petition for writ of *certiorari* and to the failure of RIM to move for consideration of claim validity issues on remand to the District Court. Subsequent to the filing of the present petition, the litigation has been dismissed "without prejudice" in view of a settlement agreement reached between patent owner NTP and RIM. [20] While it is not believed that this dismissal "without prejudice" constitutes a "final decision" where RIM "has not sustained its burden of proving the invalidity of any paten claim in suit" pursuant to 35 U.S.C. § 317(b), that issue need not be reached in this decision. Even, assuming for the sake of discussion, if the dismissal "without prejudice" did constitute a final decision on the question of claim validity adverse to RIM, the estoppel provision of 35 U.S.C. § 317(b) is inapplicable on the record of the '020 *inter partes* reexamination proceeding for the reasons previously set forth in the Decision Dismissing Petition dated September 16, 2005 and the Decision Denying Petition dated November 30, 2005, and now repeated, *infra*. Based on those reasons, the '020 *inter partes* reexamination proceeding will not be dismissed and will not be

[18] The '093 proceeding was filed on May 17, 2005 and reexamination was ordered on August 17, 2005. The '094 proceeding was filed on May 19, 2005 and was ordered on August 17, 2005.
[19] See pages 5-7 of the instant petition.
[20] See note 14, *supra*.

severed from its merger with the '495 *ex parte* reexamination proceeding; rather the merged proceeding will continue.

It is once again pointed out that the '020 *inter partes* reexamination proceeding is directed to a patent for reexamination having six hundred and sixty five claims, only six of which were even involved in the litigation. [21] It is also pointed out once again that there had been no decision on the patentability of any claims other than these six claims, and that the estoppel effect provided by 35 U.S.C. § 317(b) is on a "claim by claim" basis. [22] Therefore, it is reiterated that even if the litigation were presumed to be final with respect to RIM having failed to establish claim invalidity, the '020 *inter partes* reexamination proceeding cannot simply be "dismissed" (*i.e.*, terminated) based upon 35 U.S.C. § 317(b) estoppel. The '020 *inter partes* reexamination proceeding would have to continue with respect to the remaining claims that were not litigated as to claim validity. [23] Once again, it is also pointed out that severance of the merged proceeding would leave the '495 *ex parte* reexamination proceeding intact, because there are no estoppel provisions in the *ex parte* reexamination statutes. Therefore, the '495 *ex parte* reexamination proceeding would have to continue separately on all of the claims, while the '020 *inter partes* proceeding would have to continue separately on fewer than all the claims. It is still deemed to be undesirable for the two severed proceedings to continue independently of one another, because there would clearly be overlapping issues in the independent proceedings.

In addition to the reasons articulated in the immediately preceding paragraph for refusing to terminate the '020 *inter partes* proceeding and to keep the merged proceeding intact, the November 30, 2005 Decision Denying Petition repeated yet another reason that had been set forth in the September 16, 2005 Decision Dismissing Petition, which patent owner has never addressed. [24] Both decisions clearly relied upon the last two sentences of 35 U.S.C. § 317(b), which follow immediately *after* the language quoted in footnote 15, *supra*. The present decision repeats the analysis and continues to rely upon that analysis as follows.

The last sentence of Section 317(b) states:

> "This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings."

If this language were not clear enough, both the Decision Dismissing Petition and the Decision Denying Petition quoted the following legislative history of 35 U.S.C. § 317(b): [25]

> "Further, if a third-party requester asserts patent invalidity in a civil action and a final decision is entered that the party failed to prove the assertion of invalidity, or if a final decision in an *inter partes* reexamination instituted by the requester is favorable to patentability, **after any appeals,** that third-party requester cannot thereafter request *inter partes* reexamination on the basis of issues **which were or which could have been raised. However, the third-party requester may assert invalidity based on newly discovered prior art unavailable at the time of the civil action or *inter partes* reexamination. Prior art was unavailable at the time if it was not known to the individuals who were involved in the civil action or *inter partes* reexamination proceeding on behalf of the third-party requester and the USPTO."** (Emphasis added.)

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[21] Decision Dismissing Petition, September 16, 2005, pages 9-10; Decision Denying Petition, November 30, 2005, pages 7 and 8.

[22] *Id.*, at page 15; at page 10.

[23] An amendment filed on December 28, 2005 has now increased the total number of claims to seven hundred sixty-four.

[24] Decision Dismissing Petition, September 15, 2005, pages 4 and 8-9; Decision Denying Petition, November 30, 2005, pages 5, 6 and 13-14.

[25] 106 Cong Rec. S14720, Nov. 17, 1999.

The language of the legislative history leaves no room for doubt as to the meaning of 35 U.S.C. § 317(b). It is clear that even where a final decision in a civil action has been rendered, that is, after any appeals, [26] the third-party requester **is not estopped** from requesting *inter partes* reexamination, **if** the request is based upon previously unknown prior art that was not available to the third-party requester and the Office. Indeed, that is clear even from the same Judiciary Committee material relied upon by patent owner in the present petition, [27] which states that:

> " ... a party would have a choice of either pursuing a reexamination or going directly to Federal Court. In either event, the estoppel provisions of this section prevent that party or its privies from raising **the same issues or any issues that could have been raised at that time** in future."
>
> "Symmetrically, **if a claim of invalidity is asserted in litigation, reexamination is precluded on the issues raised in that claim of invalidity or any issue that could have been raised.**"
>
> (Emphasis added in this decision.)

It is considered to be equally clear that, by definition, "newly discovered prior art unavailable at the time of the civil action or *inter partes* reexamination" was not available to have raised any issue of claim validity in the litigation that was conducted. Patent owner specifically invokes the following words of Senator Leahy, to assert that the Office is "defy[ing]" them: [28]

> "The Hatch-Leahy substitute enhances protection against harassment by strengthening the estoppel provisions **to prevent a party from raising an issue that was raised or could have been raised in one forum from raising it in any other forum in the future.**" (Emphasis added in this decision.)

Those words, however, clearly and unequivocally demonstrate that the estoppel provisions of 35 U.S.C. § 317(b) apply only to issues that had been raised or could have been raised. Certainly, an issue of claim validity based on prior art that was unknown or unavailable during the litigation cannot be a an issue "that was raised or could have been raised."

The comments of various members of Congress, [29] which are relied upon by patent owner, state: [30]

> "Similarly, estoppel provisions similar to those agreed to in the Senate form a key component on the broad-based agreement on patent reform."

These comments merely express agreement with the words of Senator Leahy, and do **not** support patent owner's position. Nothing in the quoted material attributed to Senator Hatch [31] addresses the question of *newly discovered prior art.*

In the present instance, it appears from the record of the merged reexamination proceeding that the merged proceeding was, and is, being conducted before the Office based upon significantly more applied prior art than had been asserted during the litigation. The patent owner has been repeatedly challenged in the prior decisions on petitions to provide

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[26] Note the use of the word "appeals"; it is clear that a "final decision" requires exhaustion of any available appeals, not just a single appeal. See also Decision Denying Petition, November 30, 2005, pages 10-12; Decision Dismissing Petition, September 16, 2005, pages 6-7.

[27] S. Rep. 105-42 (1997), cited at pages 3-4 of the present petition.

[28] *Id.*

[29] From the context of the remarks, the members of Congress referred to were presumably Representatives.

[30] Page 4 of the present petition.

[31] *Id.*

any evidence that the applied references were known and available to the requester in time to enter them into the District Court proceeding, and the patent owner has failed to address that challenge. Thus, as has been previously pointed out to petitioner patent owner, these references must be found to support the '020 reexamination. This point is, by itself, a basis to maintain the '020 reexamination proceeding, even if (a) patent owner's position as to "final decision" within the meaning of 35 U.S.C. § 317(b) was accepted, (b) all the patent claims had been subject to the litigation and (c) there was no copending '495 *ex parte* reexamination proceeding.

The fact remains that the patent owner still has not shown, or even attempted to show, that the reference material that was cited and applied in the merged proceeding for the first time in the Office action dated September 28, 2005, [32] (and was cited by patent owner in an IDS filed on September 30, 2005), was other than "newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* proceedings." Patent owner has never shown, or attempted to show, that the reexamination orders in the '020 *inter partes* reexamination proceeding and the '495 *ex parte* reexamination proceeding were wholly based on prior art that was not "newly discovered" discussed in the District Court proceeding. [33] As discussed in both the September 16, 2005 Decision Dismissing Petition and the November 30, 2005 Decision Denying Petition, and as reiterated and relied on in the present petition, absent a showing that this prior art was available to and known to the third party requester and could have been introduced in the litigation, the estoppel provision of 35 U.S.C. § 317(b) relied upon by patent owner as mandating the dismissal of the '020 *inter partes* reexamination proceeding is simply inapplicable on the present record.

In summary, the '020 *inter partes* proceeding will not be dismissed and will not be severed from the merged proceeding because:

(1) The patent owner has failed to show that the merged reexamination proceeding is being conducted solely based upon "old" prior art, i.e., art that is not "newly discovered prior art" within the meaning of 35 U.S.C. § 317(b). Rather, from a review of the record, it appears that the merged reexamination proceeding is indeed being conducted based upon "newly discovered prior art." [34]

(2) Of the six hundred and sixty five claims of the '592 patent, only six claims were involved in the litigation. Since the estoppel effect provided by 35 U.S.C. § 317(b) is on a "claim by claim"

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[32] This is more than three years and 10 months after the litigation between patent owner and the third party requester was filed, more than two years and four months after the District Court's final order, more than two years and nine months after reexamination was ordered in the '495 Director Ordered *ex parte* reexamination proceeding, more than two years and four months after '020 *inter partes reexamination proceeding* was filed and two years and one month after reexamination was ordered in the '020 *inter partes reexamination proceeding.*

[33] A review of the Memorandum Opinion of Judge Spencer, *NTP Inc., v. Research in Motion, Ltd.*, 2003 U.S. Dist. LEXIS 14338, 67 USPQ2d 1587 (E.D VA, May 23, 2003) shows that in both reexamination proceedings, the order for reexamination relied upon certain prior art that was not discussed in the litigation with respect to claim validity. Therefore, it is clear the Office initially had a basis upon which to assume jurisdiction the '020 reexamination *inter partes* proceeding based upon 35 U.S.C. §§ 313 and 314. The Office clearly had a basis assume jurisdiction over the previously ordered '495 *ex parte* reexamination proceeding under 35 U.S.C. §§ 303 and 304. The record in the merged proceeding clearly shows that certain prior art that has been applied to the claims was first introduced into the proceeding in September, 2005, and patent owner has not shown that this prior art is other than "newly discovered" prior art within the meaning of 35 U.S.C. § 317(b). The Office, therefore, has always had a basis to assume, and retain, jurisdiction over the '495 and '020 reexamination proceedings, notwithstanding any decisions in the litigation between patent owner and the third party requester, whether "final" or otherwise.

[34] See, for example, the so-called "TeleNor" prior art discussed in part 16 of the summary above.

basis, the '020 *inter partes* proceeding would need to continue as to the non-litigated six hundred and fifty nine claims of the '592 patent.

(3) The '495 *ex parte* reexamination is not subject to any litigation estoppel; thus, reexamination by the Office must continue on all the '592 patent claims. As pointed out in (2) immediately above, the '020 *inter partes* reexamination must continue on all claims except those involved in the litigation. The issues of the two proceedings overlap, and it is both administratively inefficient and undesirable for the Office to conduct two separate reexamination proceedings on the '592 patent under these circumstances.

The above reasons provide a strong basis to deny the petition, even aside from the fact that the patent owner has not shown the District Court dismissal "without prejudice"of the underlying action (based on a settlement agreement reached between patent owner NTP and RIM) to in any way be a final decision where RIM "has not sustained its burden of proving the invalidity of any paten claim in suit" pursuant to 35 U.S.C. § 317(b).

B. Suspension of the '020 *Inter Partes* Reexamination Proceeding (Alternative Relief Requested)

Patent owner argues that the Office treatment of patent owner is not consistent with the way in which a different patent owner was treated in the '093 and '094 *inter partes* reexamination proceedings. Patent owner premises this argument on the conclusion that patent owner in the '020 reexamination proceeding and the patent owner in the '093 and '094 *inter partes* proceedings the are "similarly situated." Indeed, patent owner states the reasoning by the Office in the petition granting the suspension of the '093 and '094 *inter partes* reexamination proceedings "is identical to those that NTP has previously explained exist in this proceeding." [35] Patent owner argues that the alleged disparate treatment amounts to an arbitrary and capricious action on the part of the Office. Initially, it is pointed out that the concurrent litigation, which provided the underlying basis for suspension in the '093 and '094 proceedings, no longer currently exists with respect to the '020 *inter partes* reexamination proceeding as a result of March 3, 2006 Order dismissing the litigation "without prejudice." In addition, prior to the dismissal of the NTP-RIM litigation, the facts were very different. In the present instance, for example, there are non-litigated claims for which reexamination has been requested in the '020 reexamination proceeding, there is a concurrent *ex parte* reexamination proceeding having overlapping issues with the '020 reexamination proceeding, and "newly discovered prior art" within the meaning of 35 U.S.C. § 317(b) is being applied. None of these facts were the case when the decision referred to by petitioner was decided. Therefore, petitioner patent owner's arguments on this point are not persuasive, and need no further discussion.

C. Request To "Cleanse The Record", Etc.

Patent owner alleges that there are "unlawful contacts and submissions that the Office has permitted to occur in violation of the statute as part of the inter partes proceedings." Patent owner has not, however, identified any such contacts, or any specific statutes that the alleged contacts are alleged to have violated, let alone how the alleged but unspecified conduct by the unidentified parties has violated one or more of the unidentified statutes. Patent owner further alleges that the third party requester "has submitted numerous papers that are now null and void and cannot be considered by the Office." Yet patent owner has identified no specific papers, and has not

[35] Page 5 of the present petition.

explained why any of these unidentified papers should now be null and void, such that the Office could not consider them. Patent owner alleges that contacts between the Office and the third party requester (including counsel, and other representatives/lobbyists) has tainted and prejudiced patent owner, and demands that the Office devise a plan to eliminate such taint and prejudice as has occurred. Yet patent owner does not identify the particular contacts, or the particular parties involved. Patent owner alludes to assurances communicated by Office personnel to third party requester regarding the timing and ultimate outcome of Office activities. [36] Again, patent owner provides no specifics.

It is noted that patent owner has not earlier requested the sort of relief now requested in any of the previously filed petitions. Patent owner has not established the existence of any changed circumstance that would entitle patent owner to present the request for relief for the first time in response to the Decision Denying Petition dated November 30, 2005, which was designated as being a final agency decision under 5 U.S.C. § 704.

It is also to be noted that the broad devising of a plan to eliminate such taint and prejudice (that is requested) is not directed to petitionable matter, and does not identify the specific actions that patent owner believes to be in need of correction in the present proceeding. A petitioner must provide a foundation for the relief requested, and patent owner failed to do so. Patent owner has not identified any specific contact between any specific Office personnel and any specific parties representing or otherwise in the employ of third party requester, including contacts in which "assurances" of any kind were made to third party requester or any employee or other representative thereof. Patent owner has also failed to explain how any of those alleged (but unspecified) contacts prejudiced or tainted patent owner. In light of the failure of patent owner to present specifics and thereby provide a foundation, and in light of the apparent untimely nature of the request for relief, none of the relief requested by patent owner on page 7 of the present petition can, or will, be granted.

[36] In general, see the present petition, page 7, first paragraph.

## CONCLUSION

1. Patent owner's January 23, 2006 petition, taken as a request for reconsideration of the November 30, 2005 Decision Denying Petition, is granted to the extent that the decision has been fully reconsidered, but denied as to the request to "dismiss" or suspend the '020 *inter partes* reexamination proceeding.

2. Patent owner has not demonstrated that the there has been a "final decision" within the meaning of 35 U.S.C. § 317(b) in the litigation between patent owner and third party requester such that § 317(b) would require "dismissal" or termination of the '020 *inter partes* reexamination proceeding.

3. Patent owner has not demonstrated that all of the prior art relied upon in the merged reexamination proceeding was before the District Court during the litigation of the '592 patent, or was available to the third party requester for entry into the litigation prior to the filing of the request for *inter partes* reexamination. Thus, another of the 35 U.S.C. § 317(b) requirements for termination of the *inter partes* reexamination proceeding '020 has not been demonstrated.

4. The alternative relief of suspending the '020 *inter partes* reexamination proceeding will not be granted because there is currently no litigation on the '592 patent to provide a basis for considering suspension.

5. Patent owner has wholly failed to present any specific facts supporting the requested relief that the Office cleanse the record of information resulting from unlawful contacts and submissions by the third party requester. Accordingly, that requested relief is denied.

7. This decision is a final agency action within the meaning of 5 U.S.C. § 704.

8. Telephone inquiries with regard to this decision should be directed to Kenneth M. Schor, Senior Legal Advisor, or, in his absence, to Stephen Marcus, 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
March 9, 2006

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

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## *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/006495 95/000,020

PATENT NO. 6,317,592

ART UNI 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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(For Patent Owner)

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SEP 13 2006

CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
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*In re Campana, Jr. et al*
*Inter Partes* Reexamination Proceeding
Control No.: 95/000,020
Filed: May 29, 2003
For: U.S. Patent No. 6,317,592

**DECISION DISMISSING PETITION AND, *SUA SPONTE*, "RETURNING" IMPROPER PAPERS**

This is a decision on the May 12, 2006 patent owner petition styled "Petition Pursuant to 37 CFR §1.183 or, Alternatively, 37 CFR 1.182 To Grant Patent Owner Leave to File Supplemental comments After Action Closing Prosecution." [1]

The petition and the above-captioned reexamination proceedings are before the Office of Patent Legal Administration for consideration.

The petition is dismissed, and its attachments are returned to the patent owner for the reasons discussed below.

**PETITION FEE**

A single petition fee of $400.00 is being charged to petitioner patent owner's Deposit Account No. 50-0206 as authorized in the present petition.

[1] The present petition will be considered under the provisions of both 37 CFR 1.182 and 37 CFR 1.183. A single petition fee is required.

## REVIEW OF SALIENT FACTS

1. U.S Patent number 6,317,592 ("the '592 patent") issued to Campana *et al* on November 13, 2001 from an application filed on December 6, 1999.

2. On December 26, 2002, a Director Initiated Order for Reexamination of the '592 patent mailed and assigned control number 90/006,495 ("the '495 reexamination proceeding").

3. On May 29, 2003, a request for *inter partes* reexamination of the '592 patent was filed by a third party requester, and assigned control number 95/000,020 ("the '020 reexamination proceeding").

5. On August 26, 2003, the examiner's Order Granting *Inter Partes* Reexamination for the '020 reexamination proceeding was mailed.

6. On August 9, 2004, the Senior Special Projects Advisor issued a decision, *sua sponte*, by which the '495 reexamination proceeding and the '020 reexamination proceeding were merged into a single combined reexamination proceeding.

7. The August 26, 2003 decision merging the proceedings established that the merged proceeding would be conducted in accordance with 37 CFR 1.982, *i.e.*, in accordance with the regulations governing the prosecution of an *inter partes* reexamination proceeding.

8. On January 4, 2006, a Freedom of Information Act ("FOIA") Request was made to the Office requesting information directed to the Office's communications with third parties regarding the present reexamination proceedings and pending reexamination proceedings being conducted on other of patent owner's patents.

9. Following prosecution on the patentability of the '592 patent claims, the examiner issued an Action Closing Prosecution (ACP) in the present merged reexamination proceeding on February 1, 2006.

10. The Office responded to the FOIA request through letters dated between February 8 and March 24, 2006. [2]

12. On March 1, 2006, the patent owner filed comments after the ACP. The third party requester has not filed a response to patent owner's comments on the ACP.

14. May 12, 2006, the patent owner filed papers which included copies of materials obtained as a result of the FOIA request, and a number of verified statements.

15. Also on May 12, 2006, patent owner filed the present petition seeking entry of all of the papers filed on May 12, 2006.

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[2] An additional response to the FOIA request was mailed by the Office on June 15, 2006 and received by patent owner on June 16, 2006.

## RELEVANT STATUTES, REGULATIONS AND PRACTICE

35 U.S.C. § 311(a) provides:

"IN GENERAL. – Any third-party requester at any time may file a request for inter partes reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301."

37 CFR 1.3 provides:

"Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Director and will not be entered. A notice of the non-entry of the paper will be provided. **Complaints against examiners and other employees must be made in correspondence separate from other papers.**" [Emphasis added.]

37 CFR 1.4(c) provides:

"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."

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 1.913 provides:

"Except as provided for in § 1.907, any person other than the patent owner or its privies may, at any time during the period of enforceability of a patent which issued from an original application filed in the United States on or after November 29, 1999, file a request for *inter partes* reexamination by the Office of any claim of the patent on the basis of prior art patents or printed publications cited under § 1.501."

37 CFR 1.939(a) provides:

"If an unauthorized paper is filed by an party at any time during the *inter partes* reexamination proceeding it will not be considered, and may be returned."

37 CFR 1.951(a) provides:

"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."

MPEP § 2667 provides in part:

"The applicable regulations (such as 37 CFR 1.501, 1.902 and 1.905, 1.948 and 1.939) provide that certain types of correspondence will not be considered. Whenever reexamination correspondence is received, a decision is required of the Office as to the action to be taken on the correspondence based on what type of paper it is and

whether it is timely. In certain instances, the submitted correspondence (submission) will be entered into the reexamination file and be considered. In other instances, the correspondence will be entered into the reexamination file, but will not be considered. In still other instances, the correspondence will not be entered into the reexamination file and will be returned to the party that sent it. The return of certain inappropriate submissions, not being considered, reduces the amount of paper which would ultimately have to be scanned into the record.

Where papers are filed during reexamination proceedings which are inappropriate because of some defect, such papers will either be returned to the sender or be forwarded to one of three places: the reexamination file (paper file or IFW file history)<; the patent file (paper file or IFW file history)<; or the storage area (paper file). Any papers returned to the sender must be accompanied by a letter as to the return. The letter is prepared by the Technology Center (TC) Director (or in some instances, by the Office of Patent Legal Administration (OPLA) and is forwarded to the Central Reexamination Unit (CRU) for mailing. The original of the letter returning the paper will be retained in the file and given a paper number."

## DECISION DISMISSING THE THIRD PARTY REQUESTER PETITION AND RETURNING PAPERS FILED WITH THE PETITION

### I. Patent Owner's Position

Patent owner has attached to the present petition - a set of papers to be added to the record as a part of the supplemental response to the March 1, 2006 response to the February 1, 2006 ACP. These papers are submitted to make them available for the examiner's consideration in evaluating the patent owner's supplemental response. Patent owner requests by way of the present petition that these papers be entered into the IFW record (for the present merged proceeding) to provide what patent owner urges to be a complete administrative record.

Recognizing that an ACP has been promulgated, patent owner seeks an entry right for the papers attached to the present petition pursuant to 37 CFR 1.183 and 37 CFR 1.182. It is patent owner's position that these papers should be entered into the record because:

(1) The present circumstances are extraordinary, and the requested relief should be granted under 37 CFR 1.183 as a matter of Office policy and general fairness with respect to the information provided being previously unavailable to patent owner prior to the February 1, 2006 ACP and the March 1, 2006 patent owner response thereto; [3]

(2) The content of the attached papers is necessary for a proper patentability determination; [4]

(3) A transition procedure was announced in the Notice published at 1292 OG 20 (March 1, 2005) by which a patent owner may obtain relief under 37 CFR 1.182 in order to permit the filing of a so-called request for continued reexamination (RCR) analogous to the current request for continued reexamination (RCE) practice available in the examination of nonprovisional patent applications. Such transition procedure is urged to be appropriate in this instance.

### II. Findings and Analysis

#### A. Waiver of the Rules Pursuant to 37 CFR 1.183

A review of the papers filed on May 12, 2006 with the present petition shows that certain of the papers appear to be arguably relevant to the patentability issues in the ACP, *e.g.*, the papers that are directed to the issues raised by patent owner with respect to the so-called "Telenor Documents." [5] However, a review of the May 12, 2006 papers also shows that the papers

[3] Petition dated May 12, 2006, pages 10-11.
[4] *Id.*, at pages 11-12.
[5] *Id.*, at pages 13-14.

include FOIA material, and other material, that is directed to complaints of misconduct and bias against patent owner on the part of Office personnel participating in the decision-making process. [6] Thus, contrary to petitioner patent owner's allegations, the papers presented are not confined to papers that are necessary for a proper patentability determination. Instead, the papers intermingle material directed to substantive patentability issues with material directed to complaints of misconduct/bias that are not substantive patentability issues.

37 CFR 1.3 specifically indicates that "[C]omplaints against examiners and other employees must be made in correspondence separate from other papers." Patent owner has filed a submission **intermingling** (a) the FOIA material that is filed in support of complaints going to the conduct of Office personnel in this proceeding with (b) material directed to the merits of the patentability determination arrived at during this proceeding Patent owner **has not filed** one submission being solely directed to the merits of the patentability determination arrived at during this proceeding, and a separate submission in support of complaints going to the conduct of Office personnel in this proceeding. Thus, petitioner patent owner has filed a submission that is not in compliance with the regulation. The patent owner may comply with the regulation by filing the papers as separate submissions, so that the papers directed to substantive patentability issues may be entered into the present record, and the papers directed to complaints regarding conduct may be kept separately from the record while they are being considered. Thus, compliance with the 37 CFR 1.3 does not present an extraordinary situation that requires waiver of the regulation, but rather, this is a mechanism wholly within control of patent owner which can be employed by the patent owner in compliance with the rules. Therefore, 37 CFR 1.3 will not be waived.

The same analysis applies with respect to 37 CFR 1.4(c), which requires that matters decided by different branches or areas of the Office be submitted in separate papers so that they can be properly directed. Thus, papers directed to the substantive patentability issues raised in the ACP are properly directed to the examiner's consideration, while papers directed to complaints of employee misconduct and bias are not. Again, compliance with this regulation is a matter that is wholly within control of patent owner, and, as such, does not present an extraordinary situation. The interests of justice do not require that this regulation be waived. Therefore, 37 CFR 1.4(c) will not be waived.

As a further consideration, 37 CFR 1.951(a) provides, *inter alia*, that "[A]fter 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 relief requested by patent owner would require waiver of 37 CFR 1.951(a) in order to permit more than a single submission of comments following an ACP. However, the requested relief is precluded because the comments for which entry is sought are not limited to issues raised in the action closing prosecution. Instead, as discussed above, the papers filed on May 12, 2006 intermingle comments directed to the substantive patentability issues raised in the ACP with complaints of misconduct and bias that are not a part of "the issues raised in the Office action closing prosecution." Therefore, patent owner has not established the existence of an extraordinary circumstance that would justify waiving 37 CFR 1.951(a) to permit entry of the papers filed on May 12, 2006. Again, the presentation of papers that are "limited to the issues raised in the Office action closing prosecution" is a matter within control of patent owner. Patent owner can present a paper limited to "the issues raised in the Office action closing prosecution," and also present separate complaints of perceived misconduct and bias in accordance with 37 CFR 1.3 and 37 1.4(c), *i.e.*, by filing a separate paper directed to the complaints of misconduct and bias for consideration by the Office such that the paper can be maintained separate from the record

[6] *Id.*, at page 9.

of the merged reexamination proceeding to be considered by the examiner. The question of whether the interests of justice would justify waiving 37 CFR 1.951(a) so as to permit additional patent owner comments on the ACP is reserved, and will be decided only at such time as patent owner requests waiver of 37 CFR 1.951(a) so permit entry of a paper that is limited to the presentation of comments directed only to the issues of patentability raised in the ACP. On the present record, 37 CFR 1.951(a) will not be waived.

B. 37 CFR 1.182 Is Not Applicable With Respect To A So-Called "Request for Continued Reexamination"

Patent owner requests that pursuant to the Notice published at 1292 OG 20 (March 1, 2005), relief under 37 CFR 1.182 be granted so that patent owner would be permitted to file and have entered "supplemental comments" to the February 1, 2006 ACP. The Notice discusses a change in reexamination practice whereby a patent owner in an *ex parte* reexamination proceeding would newly be required to demonstrate the existence of a different substantial new question of patentability in order to obtain a second or subsequent request for reexamination than was demonstrated in a prior *ex parte* reexamination proceeding for the same patent. Because of that change in practice, a patent owner would no longer be able to obtain the entry of new evidence and/or an amendment (for a patent being reexamined) by filing a second or subsequent request for *ex parte* reexamination based on the same substantial new question of patentability that was found to exist in a pending *ex parte* reexamination proceeding. The Notice then discusses the ability of a patent owner to obtain this relief in a manner analogous to the relief that would available if a so-called "request for continued reexamination" (RCR) practice were in existence. Such relief is available, pursuant to the Notice, by filing a petition under 37 CFR 1.182 requesting such relief, and presenting evidence and/or an amendment that would advance prosecution in the existing *ex parte* reexamination proceeding. Although a patent owner can not file a request for *inter partes* reexamination because 35 U.S.C. § 311(a) and implementing regulation 37 CFR 1.907 expressly preclude a patent owner or its privies from filing a request for *inter partes* reexamination, the Notice nevertheless specifically provides for the possibility of permitting a patent owner to obtain entry of additional evidence and/or an amendments after the promulgation of an ACP in an *inter partes* reexamination by filing a petition under 37 CFR 1.182 requesting such entry.

However, the patent owner petition requests relief which, if granted, would permit patent owner to obtain entry of material that is not confined to evidence and/or an amendment directed to issues of patentability raised in the ACP. Rather, as presented by patent owner, the supplemental comments to the ACP that were filed on May 12, 2006 are directed to complaints of misconduct and bias, as well as issues of patentability raised in the ACP. To grant the requested relief under 37 CFR 1.182 would necessarily require a waiver of 37 CFR 1.3, 37 CFR 1.4(c) and 37 CFR 1.951(a) as discussed above. However, for the reasons pointed out above, waiver of those regulations is not available, because patent owner has not established the existence of an extraordinary situation that would require suspension or waiver of those regulations in the interest of justice. Therefore, the requested relief pursuant to 37 CFR 1.182 is not granted.

C. Disposition Of Papers

The patent owner papers filed on May 12, 2006 cannot be entered into the record. The May 12, 2006 papers intermingle comments that are directed to the issues of patentability raised in the February 1, 2006 ACP with complaints of misconduct and bias on the part of Office officials. Complaints of that nature are required by the regulations to be presented separately from other papers that so that they may be directed within the Office to the appropriate official and

considered without entry into the record of the present merged reexamination proceeding considered by the examiner. Accordingly, the papers filed on May 12, 2006 are improper papers that facially lack an entry right in the present merged proceeding to which they are directed. Patent owner has not established the existence of extraordinary circumstances that would require waiver of the regulations that preclude intermingling of complaints of misconduct and bias with substantive patentability issues in the same paper. Neither has patent owner established the right to have the May 12, 2006 papers entered pursuant to the Notice published at 1292 OG 20 in order to have this evidence considered after an ACP, for reasons pointed out above.

Accordingly, the papers filed on May 12, 2006 are appropriately returned in accordance with provisions of MPEP § 2267. In this instance, the papers were previously scanned into the Image File Wrapper (IFW) of each of the two individual reexamination proceedings that together comprise the present merged reexamination proceeding. Therefore, the papers cannot be physically returned to patent owner. Instead, the papers will be "returned" by marking the papers as "non-public" and "closed" so that they do not appear in the IFW with the active papers that comprise the public record.

The present petition itself contains allusions to patent owner's complaints of employee misconduct and bias. Accordingly, though the petition itself is being retained of record in the IFW file, it is being marked as "non-public."

## CONCLUSION

1. The May 12, 2006 patent owner petition is dismissed.

2. The papers filed with the May 12, 2006 patent owner petition lack an entry right in the merged reexamination proceeding, and are being "returned" to patent owner by being marked "non-public" and "closed."

3. The present petition will be retained of record in the IFW file, and it is being marked as "non-public."

4. A copy of this decision is being made of record in the merged reexamination proceeding, and the decision will therefore appear in the public IFW record of *ex parte* reexamination proceedings 90/006,495 and 95/000,020.

5. **All correspondence relating to an *inter partes* reexamination proceeding should be directed to:**

   By Mail to: Mail Stop *Inter Partes* Reexam
   ATTN: 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) 273-9900
   Central Reexamination Unit

   By hand: Customer Service Window
   ATTN: Central Reexamination Unit
   Randolph Building
   401 Dulany St.
   Alexandria, VA 22314

6. In the event that patent owner elects to file a renewed petition and again submit material directed to both complaints of misconduct/bias and substantive issues of patentability raised in the February 1, 2006 ACP, the former material must be separately filed and the "misconduct/bias" paper plainly marked so as to identify it as material that is not to be scanned into the IFW record.

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 the undersigned at (571) 272-7710.

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

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August 22, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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CENTRAL REEXAMINATION UNIT

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/006,495
Filed: December 26, 2002
For: U.S. Patent No. 6,317,592

*In re Campana, Jr. et al*
*Inter Partes* Reexamination Proceeding
Control No.: 95/000,020
Filed: May 29, 2003
For: U.S. Patent No. 6,317,592

: **DECISION**
: **GRANTING**
: **PETITION**

This is a decision on the February 23, 2007 patent owner petition styled "Petition Pursuant To 37 CFR § 1.181 Or, Alternatively, 37 CFR § 1.182, Or, Alternatively, 37 CFR § 1.183 To Suspend The Page and Word Count Limitations of 37 CFR § 1.943."

The petition and the above-captioned merged reexamination proceedings are before the Office of Patent Legal Administration for consideration.

**Summary:** Patent owner's petition is taken as a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.943(c), and is granted to the extent that, the page limit for the patent owner's appellant's brief is extended to not exceed 60 pages, or 28,000 words, in length.

**PETITION FEE**

A petition fee under 37 CFR 1.17(f) of $ 400.00 is required for a petition under 37 CFR 1.183. As authorized on page 8 of the present petition, the $ 400.00 petition fee will be charged to patent owner's Deposit Account No. 50-0206.

## REVIEW OF SALIENT FACTS

1. U.S Patent number 6,317,592 ("the '592 patent") issued to Campana *et al* on November 13, 2001 from an application filed on December 6, 1999.

2. On December 26, 2002, a Director Initiated Order for Reexamination of the '592 patent was mailed, and the resulting *ex parte* reexamination proceeding was assigned control number 90/006,495 ("the '495 reexamination proceeding").

3. On May 29, 2003, a request for *inter partes* reexamination of the '592 patent was filed by a third party requester, and assigned control number 95/000,020 ("the '020 reexamination proceeding").

4. On August 26, 2003, the examiner's Order Granting *Inter Partes* Reexamination for the '020 reexamination proceeding was mailed.

5. On August 9, 2004, the Senior Special Projects Advisor issued a decision, *sua sponte*, by which the '495 reexamination proceeding and the '020 reexamination proceeding were merged into a single combined reexamination proceeding ("the merged reexamination proceeding").

6. The August 26, 2003 decision merging the proceedings set forth that the merged reexamination proceeding would be conducted in accordance with 37 CFR 1.982, *i.e.*, in accordance with the regulations governing the prosecution of an *inter partes* reexamination proceeding.

7. On January 4, 2006, a Freedom of Information Act ("FOIA") Request was made to the Office requesting information directed to the Office's communications with third parties regarding the present reexamination proceedings, as well as pending reexamination proceedings being conducted on others of patent owner's patents.

8. On February 1, 2006, following prosecution on the patentability of the '592 patent claims, the examiner issued an Action Closing Prosecution (ACP) for the merged reexamination proceeding.

9. The Office responded to the FOIA request through letters dated between February 8 and March 24, 2006.[1]

10. On March 1, 2006, the patent owner filed written comments after the ACP. The third party requester has not filed a paper responsive to the patent owner's comments on the ACP.

11. On May 12, 2006, the patent owner filed papers which included copies of materials obtained as a result of the FOIA request (hereinafter "the FOIA material"), and also a number of verified statements directed to the issue of the authenticity of the so-called "Telenor documents" that have been relied upon (applied) as prior art in the merged reexamination proceeding.

12. Also on May 12, 2006, the patent owner filed a petition requesting entry of all of the papers filed on May 12, 2006.

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[1] An additional response to the FOIA request was mailed by the Office on June 15, 2006 and received by patent owner on June 16, 2006.

13. On September 13, 2006, a Decision Dismissing Petition was mailed that dismissed the May 12, 2006 petition, "returned" the papers that were filed on May 12, 2006, and invited petitioner to resubmit the May 12, 2006 papers by filing the FOIA material and the material directed to substantive patentability issues separately in accordance with 37 CFR 1.3 and 1.4(c).

14. On December 12, 2006, the Office issued a Right of Appeal Notice (RAN) for the merged reexamination proceeding.

15. On January 3, 2007, the patent owner filed a Notice of Appeal together with authorization to charge patent owner's deposit account for the $500.00 appeal fee.

16. Also on January 3, 2007, the patent owner filed a petition requesting entry into the record of a redacted version of the material filed on May 12, 2006, which did not include the FOIA material.

17. On January 4, 2007, patent owner filed a Notice of Appeal in this merged proceeding.

18. On February 5, 2007, patent owner filed a Petition for Reconsideration of the September 13, 2006 Decision Dismissing Petition in which patent owner facially requested that all of the material filed on May 12, 2006 be entered into the record.

19. No decision on either the January 4, 2007 patent owner petition or the February 5, 2007 petition has been mailed.

20. Prosecution has progressed to the point where appellant briefs are due from parties. [2]

21. On February 23, 2007, patent owner filed the present petition to suspend the page and word-count limitation of 37 CFR 1.943.

## DECISION

### I. Applicable Regulatory Provisions

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 1.943(c) provides:

> Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed fifteen pages in length or 7,000 words. If the page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

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[2] The third party requester has waived its right to any further response in this proceeding that may be allowed or provided for in accordance with the rules. See the third party requester paper filed on March 27, 2006 coded RXLET.

Petitioner patent owner has requested a waiver of the requirements of 37 CFR 1.943 As the prosecution has advanced to the point where patent owner's appellant's brief is due, the request is being construed as a request for waiver of the requirements of 37 CFR 1.943(c). The request is based on the fact that the examiner's ACP is 209 pages in length and the RAN is over 37 pages in length. [3] Petitioner patent owner further notes that the 37 page RAN included several references to the ACP, but was still 7 pages longer than allowed by 37 CFR 1.943(c) for patent owner's appellant brief. [4] Patent owner asserts that it will be unable to fully address the numerous allegations and rejections set forth in the RAN in the space allotted by 37 CFR 1.943(c). [5] Patent owner additionally advances a number of other arguments in support of the requested relief.

Petitioner patent owner is also requesting that if a decision on the present patent owner petition to waive the provisions of 37 CFR 1.943 is not granted prior to the filing of patent owner's appellant's brief in compliance with the rule, then patent owner be granted leave to file a *supplemental* appeal brief that is not subject to any page or word count limitation.

II. Findings and Analysis

The present petition owner petition fails to specifically state how many additional pages, beyond the permitted 30 page length (or additional words beyond the permitted 14,000 words), petitioner is requesting to "fully address" the appealed the rejections set forth. Given this lack of specificity in petitioner's request and the presence of the 30 page or 14,000 word limit set forth in 37 CFR 1.943(c), the petition as presented cannot be granted. The length limitations on responses in *inter partes* reexamination are imposed, in part, to assist the Office in compliance with its mandate to handle *inter partes* reexamination proceedings with "special dispatch" as is required by 35 U.S.C. § 305, and are analogous to those provided in litigation. [6] Petitioner has failed to provide any justification for an extension of the permitted page or word limit for an appellant's brief without any limitation as to the specific number of pages or words. To allow petitioner the unfettered ability to provide a response of whatever page or word limit petitioner deems necessary to address each of the grounds of the Office action could foreseeably open the door for an appellant's brief so voluminous as to substantially delay the instant reexamination proceeding.

Nevertheless, given the large number of claims involved, the numerous grounds of rejection set forth by the examiner, the number of pages that were required to set forth the examiner's position, as well as petitioner's timely request, the Office will grant the present petition to the extent of waiving the 37 CFR 1.943(c) appellant brief limit of 30 pages or 14,000 words:

(A) For only the filing of patent owner's appellant's brief, and,

(B) To permit patent owner to provide as much as 60 pages or 28,000 words for patent owner's appellant's brief. The Office will enforce compliance with this new limit of 60 pages or 28,000 words, and a strict review of the length of patent owner's appellant's brief will be made upon its receipt. It is to be noted, that pursuant to 37 CFR 1.943(c), if the page limit for any brief is exceeded, "a certificate is required stating the number of words contained in

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[3] Patent owner's present petition, at page 4, second full paragraph.
[4] *Id.*, at page 5, first full paragraph.
[5] *Id.*, at page 6, line 2.
[6] See *Rules to Implement Optional Inter Partes Reexamination Proceedings*, 65 FR 18154 (April 6, 2000) (Notice of Proposed Rule Making) at page 18160 - "These numbers of pages are in line with procedural rules of the Federal Courts; see for example Rule 32(a)(7)(A) of the Federal Rules of Appellate Procedure or Rule 33 of the Rules of the Supreme Court of the United States (Practice & Procedure). "

the brief." Failure to comply with the presently extended length limitation will result in *non-entry* of the appellant's brief.

It is to be noted that appellant's brief need not re-state all of the rejections that are detailed in the Office action; it need only refer to them and contest them. Accordingly, twice the regulatory allotted amount is deemed sufficient. Further, in litigation, records are more lengthy than the present record; yet the length of briefs is limited by court rules.

It is emphasized that this waiver is granted based only upon the factors set forth in the preceding paragraph, specifically:

(A) The length of the RAN and the ACP to which numerous references are made in the RAN to which patent owner must respond.

(B) The large number of appealed claims (764 total claims) and the correspondingly large number of rejections that address these claims that are involved in the appeal.

(C) Petitioner patent owner's timely filing of the present petition.

In patent owner petitions dated January 3, 2007 and February 5, 2007, patent owner requested entry into the active IFW record certain material that is voluminous, extending to hundreds of pages. As the record currently stands, there is no present right to have this material entered and considered and this material is not of record in the active IFW record. Accordingly, this material cannot provide, and does not provide any basis for the granting of the present waiver.

## ADDITIONAL DISCUSSION

With respect to any subsequently filed patent owner brief that may be filed (for example, a rebuttal brief under 37 CFR 41.71(b)(1)), it will be required patent owner provide a separate petition for waiver, supported by a showing that will independently satisfy the requirements of 37 CFR 1.183.

Additionally, until such time as the material that was the subject of the January 3, 2007 and February 5, 2007 petitions has been determined to enjoy an entry right in the present merged reexamination proceeding, or has otherwise been entered into the active IFW record of the present merged reexamination proceeding, that material may not be submitted as part of patent owner's appellant's brief, including the appendices thereto. In this regard, patent owner should note that the evidence that may be included in the evidence appendix (37 CFR 41.67(b)(ix)) of an appellant's brief is limited to evidence submitted pursuant to 37 CFR 1.130, 37 CFR 1.131, or 37 CFR 1.132 or any other evidence entered into the record by the examiner and relied upon by appellant. Patent owner should further note the requirement that the evidence appendix also include a statement setting forth *where in the record* that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted. In the event that the material that was the subject of the January 3, 2007 and February 5, 2007 petitions is determined to enjoy an entry right and is entered into the record subsequent to filing of patent owner's appellant's brief, such material would be addressed by the Office at that point.

Insofar as the present patent owner petition requests permission to file a supplemental appellant's brief without page or word limitation in the event that the present patent owner petition had not been decided prior to the filing of patent owner's appellant's brief, that request is *moot* in view of the mailing of the present decision prior to the filing of patent owner's appellant's brief.

## CONCLUSION

1. The petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(c) is granted to the extent that the page limit for the appellant's brief is extended to not exceed 60 pages or 28,000 words in length.

2. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit to await the filing of any party papers, and to process any and all party papers at the point where there is no further time remaining for filing such papers. After the Central Reexamination Unit has processed all party papers, or there are no such papers and the time for filing same has expired, jurisdiction will be transferred to the Primary Examiner for appropriate action on the proceeding.

3. Telephone inquiries with regard to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or, in his absence, to the undersigned at (571) 272-7710.

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

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March 8, 2007

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*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/006,495
Filed: December 26, 2002
For: U.S. Patent No. 6,317,592

*In re Campana, Jr. et al*
*Inter Partes* Reexamination Proceeding
Control No.: 95/000,020
Filed: May 29, 2003
For: U.S. Patent No. 6,317,592

MAILED

MAR 15 2007

CENTRAL REEXAMINATION UNIT

**DECISION DENYING PETITION**

This is a decision on the February 5, 2007 patent owner petition styled "Petition Pursuant To 37 CFR § 1.181 Or, Alternatively, 37 CFR § 1.182, Or, Alternatively, 37 CFR § 1.183 To Reconsider Decision Dismissing Petition And, *Sua Sponte*, "Returning" Papers And Enter The Papers Into The Official Record. " [1]

The petition and the above-captioned merged reexamination proceedings are before the Office of Patent Legal Administration for consideration.

**Summary:** The petition is granted to the extent that (1) the "Decision Dismissing Petition and, *Sua Sponte*, 'Returning' Improper Papers" [2] dated September 13, 2006, has been reconsidered. For the reasons set forth below, the relief requested by petitioner patent owner is denied. The present decision is designated as a final agency action under 35 U.S.C. § 704.

**PETITION FEE**

No fee is required for the present Petition for Reconsideration.

[1] Hereinafter "Petition for Reconsideration."
[2] Hereinafter "Decision Dismissing Petition."

## REVIEW OF SALIENT FACTS

1. U.S Patent number 6,317,592 ("the '592 patent") issued to Campana *et al* on November 13, 2001 from an application filed on December 6, 1999.

2. On December 26, 2002, a Director Initiated Order for Reexamination of the '592 patent was mailed, and the resulting *ex parte* reexamination proceeding was assigned control number 90/006,495 ("the '495 reexamination proceeding").

3. On May 29, 2003, a request for *inter partes* reexamination of the '592 patent was filed by a third party requester, and assigned control number 95/000,020 ("the '020 reexamination proceeding").

4. On August 26, 2003, the examiner's Order Granting *Inter Partes* Reexamination for the '020 reexamination proceeding was mailed.

5. On August 9, 2004, the Office issued a decision *sua sponte* merging the '495 reexamination proceeding and the '020 reexamination proceeding into a single combined reexamination proceeding ("the merged reexamination proceeding").

6. The August 9, 2004 decision merging the proceedings set forth that the merged reexamination proceeding would be conducted in accordance with 37 CFR 1.982, *i.e.*, in accordance with the regulations governing the prosecution of an *inter partes* reexamination proceeding.

7. On January 4, 2006, a Freedom of Information Act ("FOIA") Request was made to the Office requesting information directed to the Office's communications with third parties regarding the present reexamination proceedings, as well as pending reexamination proceedings being conducted on others of patent owner's patents.

8. On February 1, 2006, following prosecution on the patentability of the '592 patent claims, the examiner issued an Action Closing Prosecution (ACP) for the merged reexamination proceeding.

9. The Office responded to the FOIA request through letters dated between February 8 and March 24, 2006. [3]

10. On March 1, 2006, the patent owner filed written comments after the ACP. The third party requester has not filed a paper responsive to the patent owner's comments on the ACP.

11. On May 12, 2006, the patent owner filed papers which included copies of materials obtained as a result of the FOIA request (hereinafter "the FOIA material"), and also a number of verified statements directed to the issue of the authenticity of the so-called "Telenor documents" that have been relied upon (applied) as prior art in the merged reexamination proceeding.

12. Also on May 12, 2006, the patent owner filed a petition requesting entry of all of the papers filed on May 12, 2006.

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[3] An additional response to the FOIA request was mailed by the Office on June 15, 2006 and apparently received by patent owner on June 16, 2006.

13. On September 13, 2006, a Decision Dismissing Petition was mailed that dismissed the May 12, 2006 petition, "returned" the papers that were filed on May 12, 2006, [4] and invited petitioner to resubmit the May 12, 2006 papers by filing the FOIA material and the material directed to substantive patentability issues separately in accordance with 37 CFR 1.3 and 1.4(c).

14. On December 12, 2006, the Office issued a Right of Appeal Notice ("RAN") for the merged reexamination proceeding.

15. On January 3, 2007, the patent owner filed a Notice of Appeal together with authorization to charge patent owner's deposit account for the $500.00 appeal fee.

16. Also on January 3, 2007, the patent owner filed a petition requesting entry into the record of a redacted version of the material filed on May 12, 2006, which does not include the FOIA material.

17. On February 5, 2007, patent owner filed the present Petition for Reconsideration of the September 13, 2006 Decision Dismissing Petition, facially requesting that all of the material filed on May 12, 2006 be entered into the record. [5]

18. On February 23, 2007, patent owner filed a petition to suspend the page and word-count limitation of 37 CFR 1.943.

19. On March 5, 2007, patent owner timely filed an appellant's brief.

20. On March 9, 2007, a decision was mailed granting, to a limited extent, the February 23, 2007 petition.

## DECISION

### I. Relevant Statutes, Regulations and Practice

35 U.S.C. § 314(c) provides:

> "SPECIAL DISPATCH.– Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office."

37 CFR 1.3 provides:

> "Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Director and will not be entered. A notice of the non-entry of the paper will be provided. **Complaints against examiners and other employees must be made in correspondence separate from other papers.**" [Emphasis added.]

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[4] The papers were "returned" by being marked as "closed" and "non-public" in the Image File Wrapper (IFW) because papers that have been scanned into the IFW cannot be removed from the IFW. Such papers are not part of the active record in the IFW.

[5] While the present Petition for Reconsideration broadly seeks relief in the form of entry of both the FOIA material and the material directed to the authenticity of the Telenor documents, see page 10, patent owner's arguments are directed only to entry of the FOIA material.

37 CFR 1.4(c) provides:

"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."

37 CFR 1.181 provides in pertinent part:

"(a) Petition may be taken to the Director:

...

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

...

(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.**

(g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions. [Emphasis in bold added.]

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 1.903 provides:

"The patent owner and the third party requester will be sent copies of Office actions issued during the *inter partes* reexamination proceeding. After filing of a request for *inter partes* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on every other party in the reexamination proceeding in the manner provided in § 1.248. Any document must reflect service or the document may be refused consideration by the Office. The failure of the patent owner or the third party requester to serve documents may result in their being refused consideration."

37 CFR 1.939(a) provides:

"If an unauthorized paper is filed by an party at any time during the *inter partes* reexamination proceeding it will not be considered, and may be returned."

37 CFR 1.951(a) provides:

"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."

MPEP § 2667 provides in part:

> "The applicable regulations (such as 37 CFR 1.501, 1.902 and 1.905, 1.948 and 1.939) provide that certain types of correspondence will not be considered. Whenever reexamination correspondence is received, a decision is required of the Office as to the action to be taken on the correspondence based on what type of paper it is and whether it is timely. In certain instances, the submitted correspondence (submission) will be entered into the reexamination file and be considered. In other instances, the correspondence will be entered into the reexamination file, but will not be considered. In still other instances, the correspondence will not be entered into the reexamination file and will be returned to the party that sent it. The return of certain inappropriate submissions, not being considered, reduces the amount of paper which would ultimately have to be scanned into the record.
>
> Where papers are filed during reexamination proceedings which are inappropriate because of some defect, such papers will either be returned to the sender or be forwarded to one of three places: **the reexamination file (paper file or IFW file history)**<; the patent file (paper file or IFW file history)<; or the storage area (paper file). Any papers returned to the sender must be accompanied by a letter as to the return. The letter is prepared by the Technology Center (TC) Director (or in some instances, by the Office of Patent Legal Administration (OPLA) and is forwarded to the Central Reexamination Unit (CRU) for mailing. The original of the letter returning the paper will be retained in the file and given a paper number." [Emphasis added.]

## II. Basis For The September 13, 2006 Decision

On February 1, 2006, an ACP was promulgated by the Office in this merged *inter partes* reexamination proceeding. On March 1, 2006, patent owner timely filed written comments to the ACP under 37 CFR 1.951(a). Thereafter, on May 12, 2006, patent owner filed a second set of written comments in response to the ACP that included (1) papers directed to the merits of the patentability issues in the merged proceeding, and (2) the FOIA material. Recognizing that 37 CFR 1.951(a) permits a patent owner to "once file" comments to an ACP, petitioner patent owner sought a 37 CFR 1.183 waiver of 37 CFR 1.951(a) to permit entry of the second set of comments to the ACP. Patent owner argued that the information for which entry was sought by waiver of 37 CFR 1.951(a) was new information that could not have been earlier presented.

Patent owner also sought entry of the May 12, 2006 submission on alternative grounds under 37 CFR 1.182, in the form of part of a request for continued reexamination (a so-called "RCR") pursuant to the Notice published at 1292 OG 20 (2005). Grant of the petition pursuant to 37 CFR 1.182 and the O. G. Notice would have provided for withdrawal of the ACP, entry of the May 12, 2006 papers and continuation of prosecution in the present merged reexamination proceeding in a manner somewhat analogous to request for continued examination (RCE) practice under 37 CFR 1.114 in a non-provisional patent application.

It was pointed out in the September 13, 2006 decision, in explanation of why the underlying relief requested by petitioner would not be appropriate, that:

A) Pursuant to 37 CFR 1.3, complaints against examiners and other Office employees "must be made in correspondence separate from other papers" which are not directed to complaints against examiners and other Office employees.

B) Pursuant to 37 CFR 1.4(c), different matters raised in a given proceeding must be raised in separate papers so as to avoid confusion and delay in addressing the subjects.

C) 37 CFR 1.951(a) provides that after an action closing prosecution, the patent owner is permitted to filing a response that is "limited to the issues raised in the Office action closing prosecution." However, the supplemental response was not so limited. Rather, the supplemental response co-mingled material that was directed to substantive patentability matters to be reviewed by the examiner, and which were ultimately subject to appeal to the

Board of Patent Appeals and Interferences ("BPAI") with material directed to matters to be reviewed through the exercise the USPTO Director's supervisory authority under 37 CFR 1.181.

These points have not been persuasively addressed in the present Petition for Reconsideration.

A. The May 12, 2006 Papers Did Not Comply With 37 CFR 1.3 - No Extraordinary Circumstance Established To Support Waiver Of This Regulation

37 CFR 1.3, last sentence, prohibits the submission of "complaints against examiners and other employees" of the Office as a part of papers directed to other matters before the Office. The FOIA material that was included in the now "returned" May 12, 2006 papers was argued by patent owner to constitute evidence of improper conduct on the part of Office personnel. The Office construed patent owner's characterization such as, for example, "[T]he PTO Engaged In Improper Communications with Third Parties That Are Not Reflected In The Record Of Decision for the Reexamination" and "[T]he non-record communications demonstrate actual bias against Patent Owner by persons participating in the decision-making process" [6] as constituting complaints regarding the conduct of Office employees. Yet this complaint was submitted as part of papers directed to other matters, *i.e.*, the question of claim patentability in this merged proceeding. Accordingly, entry of the May 12, 2006 papers was considered to be barred by 37 CFR 1.3. It was determined that patent owner did not establish any reason why patent owner could not simply comply with 37 CFR 1.3 and file the FOIA material outside of the active IFW record of the present merged reexamination proceeding, separately from proffered materials directed to substantive patentability matter. Neither did patent owner establish any reason why papers filed in the active IFW record of the present reexamination proceeding could not be limited to matters directed to substantive patentability issues. It is now to be noted that, in a petition filed on January 3, 2007, patent owner has separately requested entry of papers that were essentially limited only to matters directed to substantive patentability issues.

B. The May 12, 2006 Papers Did Not Comply With 37 CFR 1.4(c)(3) - No Extraordinary Circumstance Established To Support Waiver Of This Regulation

37 CFR 1.4(c) requires that, within a given proceeding, material directed to matters that will be considered by different branches within the Office be raised in separate papers. Yet, the May 12, 2006 papers included both (a) the FOIA material, (material argued to establish improper conduct on the part of Office employees, as discussed in Section II(A) immediately above) and (b) material directed to the authenticity of the Telenor documents (material directed to an issue of claim patentability). Patent owner filed such papers notwithstanding that the matters raised therein are decided by different branches of the Office and resolved by different appellate review tribunals:

(a) Decision on petition to the USPTO Director, and
(b) Consideration by the examiner, which may ultimately be reviewed by the Board of BPAI.

Accordingly, entry of the May 12, 2006 papers was considered to be barred by 37 CFR 1.4(c). Again, patent owner apparently recognized this and requested waiver of the regulation. It was determined that patent owner did not establish any reason why patent owner could not simply comply with 37 CFR 1.4(c) and file the FOIA material outside of the active IFW record of the present merged reexamination proceeding and separately from materials directed to

[6] See the original Petition filed on May 12, 2006, at page 10.

substantive patentability matter. Neither did patent owner establish any reason why papers filed in the active IFW record of the present merged reexamination proceeding could not be limited to matters directed to substantive patentability issues. Again, it is now to be noted that, in the petition filed on January 3, 2007, patent owner does in fact request entry of papers that are essentially limited only to matters directed to substantive patentability issues. Thus, petitioner did not establish the existence of an extraordinary situation, when justice requires waiver of 37 CFR 1.4(c) in this merged proceeding.

C. The May 12, 2006 Papers Did Not Comply With 37 CFR 1.951(a) - No Extraordinary Circumstance Established To Support Waiver Of This Regulation

The May 12, 2006 papers purported to be a second set of written comments directed to the outstanding ACP dated February 1, 2006. Pursuant to 37 CFR 1.951(a), a patent owner may once file written comments limited to the issues raised in the Office action closing prosecution. The May 12, 2006 papers did contain material directed to the Telenor documents, and such is directed to the issue of the patentability of the claims of the patents being reexamined. This issue, and all issues of claim patentability, would ultimately be resolved by appeal to the Board. However, the Office determined that because the May 12, 2006 papers included the FOIA material, the May 12, 2006 papers also contained comments and documents that were not limited to the issues raised in the ACP Office (*i.e.*, the material was not limited to appealable matters). These additional comments and documents were instead directed to matters of alleged misconduct (*e.g.* improper contact with third parties) on the part of Office employees/officials. A determination of whether the FOIA material in fact established misconduct on the part of Office personnel is only available by way of petition to the USPTO Director, and not by an appeal to the Board. Patent owner did not establish that compliance with the provisions of 37 CFR 1.951(a) represented an extraordinary situation such that waiver of the regulation was required. Patent owner could simply have limited the submission in the record of this merged reexamination proceeding to material directed to the issue of patentability of the claims, and separately filed material directed to conduct matters outside of the active IFW record. Once again, it is now to be noted that the petition filed on January 3, 2007, patent owner does in fact request entry of papers that are essentially limited only to matters directed to substantive patentability issues.

D. The May 12, 2006 Papers Did Not Establish A Basis For Relief Under 37 CFR 1.182

Patent owner's petition dated May 12, 2007 did not establish why the concurrently filed papers should be entered as part of as part of a so-called "request for continued reexamination" pursuant to the Notice published at 1292 OG 20. Facially, such relief would not be appropriate because, absent a 37 CFR 1.183 waiver of 37 CFR 1.3 and 1.4(c), the May 12, 2006 papers submitted would continue to be non-enterable papers for the reasons discussed above. That is, absent waiver of 37 CFR 1.3 and 1.4(c), granting the relief requested would have approved of the entry of papers into the active IFW record that were otherwise precluded by 37 CFR 1.3 and 1.4(c). Again, patent owner did not establish that compliance with these regulations would present an extraordinary situation so as to justify waiving any of 37 CFR 1.3 or 37 CFR 1.4(c).

## III. Findings And Analysis With Respect To The Present Request For Reconsideration

A. Certificate of Service

37 CFR 1.903 requires, *inter alia*, that after the filing of a request for *inter partes* reexamination by a third party requester, any document filed by the patent owner must be served on every other party in the reexamination proceeding in the manner provided in 37 CFR 1.248. 37 CFR 1.903

also states that any document must reflect service or the document may be refused consideration by the Office, and that the failure of the patent owner to serve documents may result in their being refused consideration.

It appears that the present Petition for Reconsideration was accompanied by the filing of a collection of FOIA material, and some material related to the Telenor documents. However, the Certificate of Service that accompanied patent owner's filing of all of the papers filed by patent owner on February 5, 2007 states only that counsel for patent owner "caused a copy of the foregoing 'PETITION PURSUANT TO 37 CFR § 1.181 OR, ALTERNATIVELY, 37 CFR § 1.182, OR, ALTERNATIVELY, 37 CFR § 1.181 TO RECONSIDER DECISION DISMISSING PETITION AND SUA SPONTE, 'RETURNING' PAPERS AND ENTER THE PAPERS INTO THE OFFICIAL RECORD" to be served on the third party requester. It cannot be established from the language of the Certificate of Service that the papers accompanying the present Petition for Reconsideration (*i.e.*, the copies of the FOIA material and the material related to the Telenor documents) were considered to be part of the petition and were, therefore, also served on the third party requester.

Therefore, the patent owner petition is incomplete, and cannot be granted, because (1) the record does not clearly show that all of the patent owner's papers filed concurrently with the present Petition for Reconsideration have been served on the third party requester, and (2) it is not clear that the such papers have actually been served on the third party requester.

B. Patent Owner's Request To Reconsider The Decision Dated September 13, 2006 Is Not Timely Filed

37 CFR 1.181(f) provides, *inter alia*, that any petition under Part I of 37 CFR ("...any petition under this part...") which is 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." 37 CFR 1.181(f) also provides that this two-month period "is not extendable." Thus, any petition filed pursuant to 37 CFR 1.181, 1.182 or 1.183 may be dismissed as untimely filed, if it is not filed within two months of the mailing date of the notice from which relief is requested. When the Office's September 13, 2006 Decision on Petition was mailed on May 12, 2006, a two month non-extendable period under 37 CFR 1.181(f) was established for requesting reconsideration of the Decision on Petition.

The two-month period for reconsideration of the September 13, 2006 decision expired after November 13, 2006. Patent owner did not file the present Request for Reconsideration of the September 13, 2006 Decision on Petition on or before November 13, 2006. Had petitioner patent owner filed the present petition (together with the supplemental patent owner comments and the verified statement evidence) by November 13, 2006, it would have preceded the Right of Appeal Notice (RAN) that was issued almost one month after November 13, 2006. To the extent that 37 CFR 1.181(f) allows for discretion on the part of the USPTO Director to accept the present petition as timely filed, the present Request for Reconsideration contains no explanation of why patent owner did not submit the present Request for Reconsideration for entry of the papers submitted therewith within two months of the September 13, 2006 decision. Indeed, the present petition is almost identical to the petition filed on May 12, 2006, differing only in that it expands upon arguments for entry of the materials related to conduct issues, in order to respond to the September 13, 2006 Decision. The present Request for Reconsideration offers no explanation as to why it could not have been filed within the two month period established by 37 CFR 1.181(f). *Accordingly, the present petition offers no explanation as to why the USPTO Director should exercise discretion and accept the presently filed papers that have been filed more than a month late.*

Also weighing heavily against accepting the late filed Request for Reconsideration is that if the underlying requested relief is granted, the Office will need to do substantial re-work to then issue a new RAN, or possibly reopen prosecution, if new issues are raised. Patent owner has argued the importance of the information submitted; however, that must be balanced against the significant delay that consideration of such information would entail as well as petitioner's lack of equities due to delay in requesting reconsideration. In litigation, where a time period for filing a pleading is missed, the material contained therein can also be important. Yet, when the time period is missed, the pleading will not be admitted, in order to maintain an orderly court proceeding. It is no different in this instance, where it is especially important to maintain an orderly reexamination proceeding since:

> 35 U.S.C. § 305 mandates that the *ex parte* reexamination of the present merged proceeding must be conducted with special dispatch within the Office, and
>
> 35 U.S.C. § 314(c) mandates that the *inter partes* reexamination is to be conducted with special dispatch.

**Nothing in the present petition, or in the record of the merged reexamination proceeding as a whole, provides a compelling basis to act counter to both 35 U.S.C. § 305 and 35 U.S.C. § 314(c) by removing the present merged proceeding from its status as a proceeding that is ready for the appeal process to commence.** In this regard, note is taken of the fact that an ACP been promulgated and commented on by patent owner, a Right of Appeal Notice has been promulgated and a Notice of Appeal in response thereto has been timely filed. The merged proceeding is ripe for appeal on the present record, and patent owner has not established a persuasive reason why the merged reexamination proceeding should now be reopened and delayed, especially given that patent owner itself has introduced a large delay factor by not timely filing the present Request for Reconsideration.

Accordingly, patent owner's supplemental comments to the action closing prosecution and the verified statements in support of the supplemental comments will not be entered and considered in the present merged reexamination proceeding.

C. Patent Owner's Petition To Reconsider The Decision Dated September 13, 2006 Does Not Establish The Existence Of An Extraordinary Circumstance Justifying Waiver Of The Rules

1. Material For Which Entry Is Requested Based Upon Waiver of the Rules

As has been pointed out, the May 12, 2006 material for which patent owner seeks a 37 CFR 1.183 waiver in order to permit entry into the record of the present merged proceeding is of two kinds. Some of the material filed by patent owner on May 12, 2006 is alleged by patent owner to demonstrate that the Telenor documents (applied to evidence claim unpatentability) are not in fact prior art. The rest of the material filed on May 12, 2006, (the so-called "FOIA material"), is alleged by patent owner to evidence improper communications in an effort to demonstrate "actual bias against Patent Owner by persons participating in the decision-making process," which in turn resulted in a reexamination process that was "not fair and impartial," in that "the outcome was predetermined against" patent owner. [7] Patent owner further alleges that the material evidences improper communications that were "expressly in violation of statutory requirements." [8]

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[7] See the paragraph bridging pages 4 and 5 of the present Petition for Reconsideration.
[8] *Id.*

2. Relief Pursuant to 37 CFR 1.183 (Waiver of the Regulations)

a. Requirement Necessary for Relief Pursuant to 37 CFR 1.183

37 CFR 1.183 provides that where an extraordinary situation is presented, a requirement of the regulations that is not a requirement of the statutes may be waived in the interest of justice. Patent owner again requests that 37 CFR 1.951(a) be waived in order to permit entry of the May 12, 2006 papers. The waiver is asserted to be necessary because 37 CFR 1.951(a) permits patent owner to only once file written comments responsive to the February 1, 2006 ACP, while the May 12, 2006 papers constitute a second set of written comments responsive to the ACP.

b. Patent Owner's Position

Patent owner's position is that entry of the FOIA material into the active IFW record is not precluded by either 37 CFR 1.3 (a regulation that requires that complaints against examiners and Office employees be submitted in correspondence separate from other papers) or 37 CFR 1.4(c) (a regulation that requires that where different matters may be considered by different branches or sections of the Office, each distinct subject must be contained in a separate paper to avoid confusion and delay in dealing with the different subjects). Rather, patent owner argues that the FOIA material has been submitted to demonstrate that the "so-called patentability determination was actually a patentability pre-determination and/or based upon the improper communications. " [9] Patent owner takes the position that the FOIA material is, therefore, relevant to the patentability determination in this merged proceeding. [10] Specifically, patent owner relies upon 37 CFR 1.104(a)(2), which requires that a patent owner be informed of the reasons for any adverse action and be provided with such information as may be useful in aiding the patent owner to judge the propriety of continuing its prosecution. Patent owner also relies upon 37 CFR 1.104(b) to assert that the examiner's actions in this proceeding are incomplete because they do not acknowledge the alleged improper communications. Patent owner additionally relies upon 37 CFR 1.104(d)(2) to assert that the examiner is required to inform patent owner of facts within the personal knowledge of an employee of the Office when a rejection is based thereon. [11] Patent owner argues that the FOIA material demonstrates that all of these regulatory provisions were violated by the Office, that these violations go to the merits of the patentability determination in this merged proceeding and not to employee conduct, and that the FOIA material is, accordingly, enterable into the active IFW record. Patent owner apparently concludes that the FOIA material is directed to substantive patentability issues, and accordingly, entry of the FOIA material requires a waiver of 37 CFR 1.951(a) only. Patent owner argues that this rule should be waived because the interests of justice require such a waiver.

c. Patent Owner Has Not Demonstrated That the FOIA Material is Directed to Substantive Patentability Issues Such That Waiver of 37 CFR 1.951(a) Alone Would Permit Entry Thereof

Initially, it is to be noted that, in related reexamination proceedings involving other patents owned by patent owner, patent owner has in fact argued that the FOIA material goes to actual bias on the part of specifically named Office employees. [12] Whether patent owner now intends,

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[9] See Petition for Reconsideration at page 5, last paragraph

[10] *Id.*, at page 7.

[11] See Petition for Reconsideration at page 6.

[12] As one example, in the August 23, 2006 petition filed by patent owner (a paper that is is in the non-public sections of the IFW records) for merged reexamination control nos. 90/006,493, 90/006,680 and 90/007735 (directed to patent owner's U.S. Patent 5,819,172), patent owner names specific Office employees and characterizes their conduct as having been improper. In the October 23, 2006 petition for reconsideration in that merged proceeding, patent owner has actually styled a subsection of the petition using the phrase "NTP's Evidence of Examiner Bias."

or ever intended, to categorize such material as evidence that is, in its nature, directed to the substantive patentability determination in the present merged reexamination proceeding, is wholly irrelevant. The FOIA material undeniably goes to the conduct of Office employees that patent owner alleges to have been improper, which conduct is alleged to have resulted in bias against the patent owner, and patent owner has stated as much in the related reexamination proceedings involving patents owned patent owner and involving the same third party requester in the present merged reexamination proceeding. [13] The FOIA material clearly is presented in order to complain about alleged misconduct and bias on the part of Office employees.

Patent owner has not demonstrated that the FOIA material goes to the substantive patentability issues in this merged reexamination proceeding to any extent. The FOIA material proffered by patent owner merely constitutes "evidence," upon which patent owner then bases certain allegations, including allegations that the outcome of this reexamination proceeding has been "pre-determined" (whether as the result of bias or for other reasons). Patent owner argues that pursuant to the provisions of 37 CFR 1.104, this material must be considered and evaluated by the examiner as part of the examiner's determination of substantive patentability issues. However, the mere presentation of evidence by patent owner in support of allegations advanced by patent owner does not establish the truth of the proposition that the present status of this merged reexamination proceeding is the result of improper conduct by Office employees, and/or bias on the part of Office employees or that the results of the proceeding have been pre-determined. The issue of whether one or more Office employees in fact engaged in improper conduct, and whether any such improper conduct would in fact demonstrate bias (to affect the outcome of this merged reexamination proceeding on the question of patentability), is, in the first instance, a matter for determination by the Director (or his delegate for that purpose). The Examiner is **not** the Office official charged with making that determination, and does not have the authority to do so. In accordance with 37 CFR 1.104(a)(1), the examiner in a reexamination proceeding "shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention." Further, the regulation charges the examiner with making an examination that "shall be complete with respect both to compliance with the applicable statutes and rules, and to the patentability of the invention as claimed, ... ." The first quoted provision of 37 CFR 1.104(a)(1) makes it clear that examiner is not charged with making a determination of any substantive issue other than a consideration of the available prior art that relates to the subject matter of the invention claimed in the proceeding to which the examiner is assigned. The second quoted sentence merely requires that the patentability determination based upon a consideration and application of the relevant prior art is to be made in accordance with the relevant statutes and rules. It is not part of the examiner's responsibility under 37 CFR 1.104(a)(1) to consider whether evidence of alleged improprieties on the part of Office officials has resulted in a bias against an official that would bear on the outcome of a proceeding, because such a determination does not arise from a consideration, under the applicable statutes and rules, of the available prior art. [14] Indeed, since it is the examiner who in the first instance determines the outcome of patentability issues in the proceeding to which the examiner has been assigned, it is not reasonable to assert that the examiner should be considering evidence that goes to whether misconduct and internal bias within the Office has pre-determined the outcome on the question of patentability in that proceeding.

Consideration of the meaning of 37 CFR 1.104(a)(1), as set forth in the preceding paragraph, will also demonstrate that patent owner's reliance upon 37 CFR 1.104(a)(2), 37 CFR 1.104(b) and 37 CFR 1.104(d)(2) as requiring that the FOIA materials be considered by the examiner as evidence

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[13] *Id.*

[14] MPEP § 1004 lists the matters within the jurisdiction of the Primary Examiner.

directed to substantive patentability issues is misplaced. The provisions of 37 CFR 1.104(a)(2), (b), and (d)(2) must be read in the context of 37 CFR 1.104(a)(1), which limits the examiner's role to an investigation of the available prior art and a patentability determination based on that prior art in light of the applicable statutes and rules. Thus, 37 CFR 1.104(a)(2), which requires that a patent owner be informed of the reasons for any adverse action and provided with such information as may be useful in aiding the patent owner to judge the propriety of continuing its prosecution, means that the patent owner must be informed of the rationale supporting the examiner's determination that the available prior art has mandated a particular holding on claim patentability, in light of the statute and rules governing patentability. The provisions of the 37 CFR 1.104(a)(2) have nothing to do with determining the presence or absence of influence on the patentability determination based upon evidence of allegedly improper communications (that are in turn alleged to establish bias resulting in a pre-determined outcome of a patentability determination) without regard to how the prior art is applied. Evidence of that kind is simply not prior art, and allegations based upon such evidence are not prior art. 37 CFR 1.104(b) means that the examiner's action has to be complete in all matters respecting the merits of a patentability determination of the claimed invention, based upon the available prior art, as applied in accordance with the statutes and rules. 37 CFR 1.104(b) does not mean that the examiner is to evaluate evidence proffered to demonstrate improper conduct and bias on the part of Office personnel and to somehow factor that evaluation into the examiner's substantive patentability determination. *It is to be noted that if claims are unpatentable over specified prior art, they remain so despite any allegation of bias and evidence proffered to support the allegation.* 37 CFR 1.104(d)(2) requires that where the evidence of prior art is in whole or in part based upon the personal knowledge of the an Office employee, the data must be as specific as possible and must be supported by an affidavit of that employee, if so requested by an applicant. 37 CFR 1.104(d)(2) is not at all relevant to an evaluation by the examiner of evidence proffered to show alleged misconduct by Office personnel or an allegation of bias on the part of Office personnel, because such evidence and allegations are simply not prior art. 37 CFR 1.104(d)(2) merely means that to the extent that an examiner has personal knowledge that would amount to relevant prior art in the reexamination proceeding pursuant to 37 CFR 1.104(a)(1), that personal knowledge can be considered by the examiner, and it may be required that such personal knowledge be cast in the form of a verified statement. The FOIA material is not proffered as prior art to be considered in determining the patentability of the claimed invention in the present merged reexamination proceeding, [15] and it is not merits evidence that the Examiner would be either authorized or required to consider under any provision of 37 CFR 1.104.

Patent owner has also failed to demonstrate why consideration of the FOIA material by the examiner would have any impact on the substantive patentability determination that has been reached with respect to the claims in the present merged reexamination proceeding in view of the prior art of record in the merged proceeding. Patent owner has not explained why, if a rejection in the merged reexamination is based upon prior art that in fact demonstrates that one or more claims are not patentable, consideration of the FOIA material would change that outcome. Patent owner has also not demonstrated why, if one or more patent claims presently determined to be unpatentable at this stage of the proceeding are in fact patentable over the prior art, patent owner would be unable to convincingly demonstrate such to the examiner, or failing that, to persuade the Board of Patent Appeals and Interferences] that the claims are patentable on appeal, or failing that, to obtain a favorable decision on patentability by appeal to the Courts. Stated differently, patent owner has not demonstrated that there is any necessary link between (a) the alleged improper conduct and bias (on the part of Office personnel), and (b) the patentability of the claims in the present reexamination proceeding (which must be *objectively* determined by the above mentioned deciding officials). It is entirely possible that the

[15] The FOIA material was also not proffered as prior art in any of the other pending reexamination proceedings involving patent owner's patents and the present third party requester.

claim rejections currently of record are proper, even if inappropriate influence could somehow be shown. To the extent that patent owner is arguing that the rejections are improper, patent owner has not shown why the alleged misconduct and bias that has occurred to date will somehow influence the BPAI or the Courts. If patent owner believes that the misconduct and bias would extend to the BPAI or the Courts, that issue would be addressed under 37 CFR 1.3, and could not be addressed on the merits by the examiner.

For all of the foregoing reasons, patent owner has not demonstrated that waiver of 37 CFR 1.951(a) is appropriate or required. Patent owner has not demonstrated that a second set of written comments in response to the February 1, 2006 ACP should be entered into the active IFW record of the present merged reexamination proceeding in the interests of justice, because patent owner has not demonstrated that the second set of comments is confined to material that relates only to substantive patentability matters in the present proceeding. Rather, the FOIA material has not been shown by patent owner to be directed to the substantive patentability matters that exist in the present merged reexamination proceeding. To the extent that the FOIA material, as proffered by patent owner, is still co-mingled with the Telenor documents, there is no basis for waiving 37 CFR 1.951(a). Grant of a waiver of 37 CFR 1.951(a) would not serve the interests of justice, at least because it would sill be required that the FOIA material be entered notwithstanding that entry is precluded by 37 CFR 1.3 and 37 CFR 1.4(c) which are not waived for reasons set forth below. Therefore, even if the present Petition for Reconsideration had been timely filed, the requested waiver of 37 CFR 1.951(a) would not be granted.

d. Patent Owner Has Not Demonstrated That the Either 37 CFR 1.3 or 37 CFR 1.4(c) Should Be Waived to Permit Entry of the FOIA Material

In the present request for reconsideration, patent owner does not now appear to be requesting a waiver of either 37 CFR 1.3 or 37 CFR 1.4(c). Rather, patent owner now appears to take the position that the FOIA material was not filed as a matter of complaint against Office personnel, but as material bearing upon patentability that should be considered by the examiner. For the reasons set forth in Section III(C)(2)(c) above, patent owner has not demonstrated that the FOIA material is directed to substantive patentability issues, and has not demonstrated that the material should therefore be entered based upon solely on a waiver of 37 CFR 1.951(a). It is further deemed to be appropriate to reconsider whether the FOIA material, if offered as a complaint directed to improper conduct and bias, should be entered pursuant to a waiver of 37 CFR 1.3 and 37 CFR 1.4(c) in conjunction with a waiver of 37 CFR 1.951(a).

There does not appear to be any basis for waiving the provisions of 37 CFR 1.3 to permit entry of the FOIA material into the IFW record together with the material directed to the Telenor documents. The regulation will not be waived because there is no extraordinary circumstance that demands entry of this material into the active IFW record of the present merged proceeding. The suspension or waiver of a provision of the rules under 37 CFR 1.183 is an extraordinary action, which will not normally be considered if the rules provide an avenue for obtaining the relief sought. *Cantello v. Rasmussen,* 220 USPQ 664 (Comm'r Pat. 1982). In this instance, to the extent that the FOIA material relates to misconduct and bias on the part of Office personnel, the patent owner could have easily obtained consideration of the FOIA material in the Office by timely filing the FOIA material in compliance with the provisions of 37 CFR 1.3, so that the FOIA material could have been considered outside of the active IFW record of the present merged reexamination proceeding by the appropriate Office officials. Thus, petitioner had a suitable remedy on hand that does not require the extraordinary remedy of invoking 37 CFR 1.183, but chose not to exercise it. Therefore, no basis has been provided for waiver of 37 CFR 1.3.

There also does not appear to be any basis for waiving the provisions of 37 CFR 1.4(c) to permit entry of the FOIA material into the IFW record together with the material directed to the Telenor documents. The regulation will not be waived because there is no extraordinary situation that demands entry of this material into the active IFW record of the present merged proceeding. Again. patent owner could have obtained consideration of the FOIA material in the Office by timely filing the FOIA material in compliance with the provisions of 37 CFR 1.4(c), so that the FOIA material could be considered outside of the active IFW record of the present merged reexamination proceeding, and by the appropriate Office officials in the appropriate area of the Office. As demonstrated in Section III(C)(2)(c) above, the FOIA material has nothing to do with the merits of the substantive patentability determinations that are of record in the merged reexamination proceeding. Therefore, there is no basis for entry of the FOIA material into the active IFW record for consideration of that material by either the examiner or the BPAI in the event that patent owner perfects an appeal.

Thus, even if the present Petition for Reconsideration had been timely filed, patent owner has not demonstrated any basis to waive 37 CFR 1.3 and 1.4(c).

3. Relief Pursuant to 37 CFR 1.182 in the Form of A So-Called "Request for Continued Reexamination

Patent owner requests that, pursuant to the Notice published at 1292 OG 20 (March 1, 2005), relief under 37 CFR 1.182 should be granted, so that patent owner would be permitted to file and have entered "supplemental comments" to the February 1, 2006 ACP. The O.G. Notice discusses a change in reexamination practice whereby a patent owner in an *ex parte* reexamination proceeding would newly be required to demonstrate the existence of a different substantial new question of patentability in order to obtain a second or subsequent request for reexamination than was demonstrated in a prior *ex parte* reexamination proceeding for the same patent. Because of that change in practice, a patent owner is no longer able to obtain the entry of new evidence and/or an amendment (for a patent being reexamined) by filing a second or subsequent request for *ex parte* reexamination based on the same substantial new question of patentability that was found to exist in a pending *ex parte* reexamination proceeding. The O.G. Notice then discusses the ability of a patent owner to obtain this relief in a manner analogous to the relief that would available if a so-called "request for continued reexamination" (RCR) practice were in existence. Such relief is available pursuant to the O.G. Notice by filing a petition under 37 CFR 1.182 requesting such relief, and presenting evidence and/or an amendment that would advance prosecution in the existing *ex parte* reexamination proceeding. Although a patent owner can not file a request for *inter partes* reexamination because 35 U.S.C. § 311(a) and implementing regulation 37 CFR 1.907 expressly preclude a patent owner or its privies from filing a request for *inter partes* reexamination, the O.G. Notice nevertheless specifically provides for the possibility of permitting a patent owner to obtain entry of additional evidence and/or an amendments after the promulgation of an ACP in an existing *inter partes* reexamination by filing a petition under 37 CFR 1.182 requesting such entry.

The requested relief under 37 CFR 1.182 and the O.G. Notice, if granted, would permit patent owner to obtain entry of material that is not evidence directed solely to issues of patentability raised in the ACP, and is also not an amendment directed solely to issues of patentability raised in the ACP. Rather, the supplemental comments paper that was filed on May 12, 2006 is directed in part to the FOIA material. For the reasons set forth in Section III above, the FOIA material is not directed to substantive patentability issues in the present merged reexamination. Rather, it is material that purports to support allegations by patent owner that Office officials engaged in misconduct and were biased against patent owner so as to pre-determine the outcome of this merged reexamination proceeding. As previously discussed, material of that

character constitutes a complaint regarding the conduct of Office personnel, and can only be considered if filed in accordance with the provisions of 37 CFR 1.3. Further, 37 CFR 1.4(c) precludes submission of material of that character if it is intermingled with material that is directed to the entirely different issues of patentability raised in the ACP and RAN, such as the Telenor documents. Therefore, to grant the requested relief under 37 CFR 1.182 would necessarily require a waiver of both 37 CFR 1.3 and 37 CFR 1.4(c), in addition to a waiver of 37 CFR 1.951(a) as discussed above. However, for the reasons set forth above, even if the present Petition for Reconsideration had been timely filed, waiver of those regulations is not available, because patent owner has not established the existence of an extraordinary situation that would require suspension or waiver of those regulations in the interest of justice. Therefore, the requested relief pursuant to 37 CFR 1.182 is not granted.

As a final point, the RCR remedy is provided for entry of papers after ACP. Patent owner delayed renewing its request for an RCR until February 5, 2007, at which point the RAN was issued. The proceeding is now ready for appeal, and both an appeal and an appellant's brief have now been filed. If an RCR were to be granted at this stage, the Office would need "reverse" the appeal process and do substantial re-work.

## IV. Synopsis

The patent owner has filed a set of papers on February 5, 2007 together with the present Petition for Reconsideration that cannot be entered into the active IFW record. The February 5, 2007 papers intermingle papers that are directed to the issues of patentability raised in the February 1, 2006 ACP and which are now ready for appeal, with FOIA material that constitutes complaints of misconduct and bias on the part of Office officials. Complaints of that nature are required by the regulations to be presented separately from other papers that so that they may be directed within the Office to the appropriate official and considered without entry into the record of the present merged reexamination proceeding considered by the examiner. Accordingly, the additional papers filed on February 5, 2007 are improper papers that facially lack an entry right in the present merged proceeding to which they are directed. Patent owner has not established the existence of extraordinary circumstances that would require waiver of the regulations that preclude intermingling of complaints of misconduct and bias with substantive patentability issues in the same paper. Neither has patent owner established the right to have any of the additional papers filed on February 5, 2007 entered pursuant to the Notice published at 1292 O.G. 20 in order to have this evidence considered after an ACP and a RAN.

## V. Disposition Of Papers:

The additional papers filed on February 5, 2007 are appropriately returned in accordance with provisions of 37 CFR 1.939(a) and MPEP § 2667. In this instance, the papers have been scanned into the Image File Wrapper (IFW) of each of the two individual reexamination proceedings that together comprise the present merged reexamination proceeding. Therefore, the papers cannot be physically returned to patent owner. Instead, the papers will be "returned" by marking the papers as "non-public" and "closed" so that they do not appear in the active IFW record with the other active papers that comprise the public record of the proceedings.

## CONCLUSION

1. The February 5, 2007 patent owner Petition for Reconsideration is granted to the extent that the September 13, 2006 Decision Dismissing Petition has been fully reconsidered, both procedurally and on its merits.

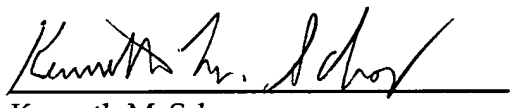
2. The February 5, 2007 patent owner Petition for Reconsideration is denied with respect to disturbing the holding of the September 13, 2006 Decision Dismissing Petition, and with respect to the underlying relief requested by patent owner.

3. The papers filed with the February 5, 2007 patent owner Request for Reconsideration will remain in the IFW as "closed" and "non-public" papers. The papers will not be considered by the examiner on their merits, because they lack an entry right in the present merged reexamination proceeding.

4. A copy of this decision is being made of IFW record for the merged reexamination proceeding, and the decision will therefore appear in the active IFW record of *ex parte* reexamination proceeding 90/006,495 and in the active IFW record of *inter partes* reexamination proceeding 95/000,020.

5. Telephone inquiries with regard to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or, in his absence, to the undersigned at (571) 272-7710.

6. This decision is a final agency action within the meaning of 5 U.S.C. § 704.



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

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March 13, 2007

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/006,495 | 12/26/2002 | 6317592 | | 9470 |

803 7590 03/30/2007

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

STURM & FIX LLP
206 SIXTH AVENUE
SUITE 1213
DES MOINES, IA 50309-4076

DATE MAILED: 03/30/2007

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

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3/30/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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1300 EYE STREET NW

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WASHINGTON, DC 20005

## *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/006495

PATENT NO. 6,317,592

ART UNI 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 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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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 95/000,020 | 05/29/2003 | 6317592 | 81208 | 3141 |

803 7590 03/30/2007

STURM & FIX LLP
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| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

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3/30/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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WASHINGTON, DC 20005

# *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 95/000020
PATENT NO. 6,317,592
ART UNI 3992

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MAILED

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CENTRAL REEXAMINATION UNIT

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/006,495
Filed: December 26, 2002
For: U.S. Patent No. 6,317,592

*In re Campana, Jr. et al*
*Inter Partes* Reexamination Proceeding
Control No.: 95/000,020
Filed: May 29, 2003
For: U.S. Patent No. 6,317,592

**DECISION DENYING PETITION**

This is a decision on the January 3, 2007 patent owner petition styled "Petition Pursuant to 37 CFR § 1.183 Or, Alternatively, 37 CFR § 1.182, Or, Alternatively, 37 CFR § 1.181 To Enter Evidence Against The Authenticity Of The Telenor Documents Into The Record Of The *Inter Partes* Proceeding." [1]

The petition, and the above-captioned merged reexamination proceedings, are before the Office of Patent Legal Administration for consideration.

The petition is denied, for the reasons discussed below. The present decision is designated as a final agency action under 35 U.S.C. § 704.

**PETITION FEE**

A single petition fee of $400.00 is being charged to petitioner patent owner's Deposit Account No. 50-0206 as authorized in the present petition.

[1] A single petition fee is required for the alternative requests for relief under the provisions of 37 CFR 1.182 and 37 CFR 1.183.

## REVIEW OF SALIENT FACTS

1. U.S Patent number 6,317,592 ("the '592 patent") issued to Campana *et al* on November 13, 2001 from an application filed on December 6, 1999.

2. On December 26, 2002, a Director Initiated Order for Reexamination of the '592 patent was mailed, and the resulting proceeding was assigned control number 90/006,495 ("the '495 reexamination proceeding").

3. On May 29, 2003, a request for *inter partes* reexamination of the '592 patent was filed by a third party requester, and assigned control number 95/000,020 ("the '020 reexamination proceeding").

4. On August 26, 2003, the examiner's Order Granting *Inter Partes* Reexamination for the '020 reexamination proceeding was mailed.

5. On August 9, 2004, the Office issued a decision, *sua sponte*, merging the '495 reexamination proceeding and the '020 reexamination proceeding into a single combined reexamination proceeding ("the merged reexamination proceeding").

6. The August 9, 2004 decision merging the proceedings set forth that the merged reexamination proceeding would be conducted in accordance with 37 CFR 1.982, *i.e.*, in accordance with the regulations governing the prosecution of an *inter partes* reexamination proceeding.

7. On January 4, 2006, a Freedom of Information Act ("FOIA") Request was made to the Office requesting information directed to the Office's communications with third parties regarding the present reexamination proceedings, as well as pending reexamination proceedings being conducted on others of patent owner's patents.

8. On February 1, 2006, following prosecution on the patentability of the '592 patent claims, the examiner issued an Action Closing Prosecution (ACP) for the merged reexamination proceeding.

9. The Office responded to the FOIA request through letters dated between February 8 and March 24, 2006.[2]

10. On March 1, 2006, the patent owner filed comments after the ACP. The third party requester has not filed a paper responsive to the patent owner's comments on the ACP.

11. On May 12, 2006, the patent owner filed papers which included supplemental comments, copies of materials obtained as a result of the FOIA request, and also a number of verified statements directed to the issue of the authenticity of the Telenor documents [3] that have been relied upon (applied) as prior art in the merged reexamination proceeding.

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[2] An additional response to the FOIA request was mailed by the Office on June 15, 2006 and received by patent owner on June 16, 2006.

[3] The Telenor documents are made up of eight volumes, one of which is stapled with three staples down its left spine, and the others of which are bound together along one edge with glue. The Telenor documents were catalogued and maintained in Trondheim University Library in Norway. Some volumes are dated "22/2/89" and the rest are dated "24/4/89", facially qualifying them as prior art to the '592 patent under 35 U.S.C. § 102(b).

12. Also on May 12, 2006, the patent owner filed a petition requesting entry of all of the papers filed on May 12, 2006.

13. On September 13, 2006, a Decision (1) dismissing the May 12, 2006 petition, (2) "returning" the papers that were filed on May 12, 2006, [4] and (3) inviting petitioner to resubmit the May 12, 2006 papers by filing the FOIA material and the material directed to substantive patentability issues separately in accordance with 37 CFR 1.3 and 1.4(c).

14. Patent owner did not file a request for reconsideration of the September 13, 2006 Decision dismissing the May 12, 2006 petition on or before November 13, 2006. [5] A request for reconsideration of the September 13, 2006 Decision was, however, filed on February 5th - see fact # 15 below.

15. On December 12, 2006, the Office issued a Right of Appeal Notice (RAN) for the merged reexamination proceeding.

16. On January 3, 2007, the patent owner filed a Notice of Appeal together with authorization to charge patent owner's deposit account for the $500.00 appeal fee.

17. On January 3, 2007, the patent owner filed the present petition requesting entry of a paper titled "Patent Owner's Supplemental Patent Owner Comments After An Action Closing Prosecution" and supporting evidence into the record, at this point in the prosecution (i.e., after the RAN had been issued).

18. On February 5, 2007, patent owner filed a petition requesting reconsideration of the September 13, 2006 decision dismissing the May 12, 2006 patent owner petition.

19. On February 23, 2007, patent owner filed a petition requesting waiver of the page and word count limitations established by 27 CFR 1.943 for filing appellant's brief filed under 37 CFR 41.67.

20. On March 7, 2007, patent owner filed its appellant brief.

21. On March 9, 2007, a decision was mailed granting patent owner's February 23, 2007 petition for waiver of the provisions of 37 CFR 1.943 to the extent stated in the decision.

22. On March 15, 2007, a decision was mailed denying the underlying relief requested in patent owner's February 5, 2007 petition for reconsideration.

## RELEVANT STATUTES, REGULATIONS AND PRACTICE

35 U.S.C. § 314(c) provides:

> "SPECIAL DISPATCH.– Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office."

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[4] The papers were "returned" by being marked as "closed" and "non-public" in the Image File Wrapper (IFW) because papers that have been scanned into the IFW cannot be removed from the IFW.

[5] See 37 CFR 1.181(f), reproduced below, and the discussion regarding the regulation as to the timeliness requirements for petitions.

37 CFR 1.3 provides:

"Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Director and will not be entered. A notice of the non-entry of the paper will be provided. **Complaints against examiners and other employees must be made in correspondence separate from other papers.**" [Emphasis added.]

37 CFR 1.4(c) provides:

"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."

37 CFR 1.181 provides in pertinent part:

"(a) Petition may be taken to the Director:

...

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

...

(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.**

(g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions." [Emphasis in bold added.]

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 1.903 provides:

"The patent owner and the third party requester will be sent copies of Office actions issued during the *inter partes* reexamination proceeding. After filing of a request for *inter partes* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on every other party in the reexamination proceeding in the manner provided in § 1.248. Any document must reflect service or the document may be refused consideration by the Office. The failure of the patent owner or the third party requester to serve documents may result in their being refused consideration."

37 CFR 1.937(a) provides:

"All *inter partes* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office, unless the Director makes a determination that there is good cause for suspending the reexamination proceeding.

37 CFR 1.939(a) provides:

> "If an unauthorized paper is filed by an party at any time during the *inter partes* reexamination proceeding it will not be considered, and may be returned."

37 CFR 1.951(a) provides:

> "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."

MPEP § 2667 provides in part:

> "The applicable regulations (such as 37 CFR 1.501, 1.902 and 1.905, 1.948 and 1.939) provide that certain types of correspondence will not be considered. Whenever reexamination correspondence is received, a decision is required of the Office as to the action to be taken on the correspondence based on what type of paper it is and whether it is timely. In certain instances, the submitted correspondence (submission) will be entered into the reexamination file and be considered. In other instances, the correspondence will be entered into the reexamination file, but will not be considered. In still other instances, the correspondence will not be entered into the reexamination file and will be returned to the party that sent it. The return of certain inappropriate submissions, not being considered, reduces the amount of paper which would ultimately have to be scanned into the record.
>
> Where papers are filed during reexamination proceedings which are inappropriate because of some defect, such papers will either be returned to the sender or be forwarded to one of three places: **the reexamination file (paper file or IFW file history)**<; the patent file (paper file or IFW file history)<; or the storage area (paper file). Any papers returned to the sender must be accompanied by a letter as to the return. The letter is prepared by the Technology Center (TC) Director (or in some instances, by the Office of Patent Legal Administration (OPLA) and is forwarded to the Central Reexamination Unit (CRU) for mailing. The original of the letter returning the paper will be retained in the file and given a paper number." [Emphasis added.]

## DECISION DENYING THE PETITION

### I. Patent Owner's Position

Patent owner recognizes that an Action Closing Prosecution (ACP) was promulgated in this merged proceeding on February 1, 2006, that patent owner timely filed comments on the ACP on March 1, 2006, and that 37 CFR 1.951(a) limits patent owner to the filing of a single response to an ACP. Patent owner has accordingly petitioned to obtain an entry right for the supplemental response to the ACP. [6] Patent owner invokes, in the alternative, 37 CFR 1.181, 37 CFR 1.182 and 37 CFR 1.183 as providing a basis *for entry of the supplemental response to the ACP.* Patent owner's position, as set forth in the present petition, can be summarized as follows:

(1) Patent owner urges that extraordinary circumstances exist to justify entry, and consideration by the examiner, of the supplemental comments to the ACP and the material submitted in support thereof. [7] The extraordinary circumstances asserted by patent owner are that the

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[6] The January 3, 2007 patent owner petition states, in the paragraph bridging pages 1 and 2 (emphasis added):

> Pursuant to 37 C.F.R. 1.183, Patent Owner submits that **the requirement for Patent Owner to *once*, file comments** within thirty days of an Office Action Closing Prosecution (see 37 C.F.R. § 1.951 (emphasis added)) should be suspended or waived, where, as here, new information that has been deemed relevant to substantive patentability issues by the PTO becomes available after the expiration of the thirty day period of time for filing comments after ACP.

[7] The supporting material consists of verified statements that purport to demonstrate that the Telenor documents are not authentic documents.

supporting material was not available to patent owner until after the ACP had been promulgated. Therefore, to the extent that 37 CFR 1.951 permits a patent owner to only once file comments to an ACP, a 37 CFR 1.183 waiver of the provisions of 37 CFR 1.951 is requested in the interest of justice. In patent owner's view, the waiver should be granted as a matter of Office policy and general fairness, since the information requested to be entered was unavailable to patent owner prior to the February 1, 2006 ACP and the March 1, 2006 patent owner response thereto. [8]

(2) Patent owner further urges that the content of the presently submitted papers has been deemed to be arguably relevant by the Office. Therefore, even if a 37 CFR 1.183 waiver of 37 CFR 1.951 is not granted, the papers should nevertheless be entered into the record and considered by the examiner *under the provisions of 37 CFR 1.182*, because there is no regulation specifically permitting entry of the papers. [9]

(3) Patent owner asserts that it would be unfair to refuse entry to the submitted papers, because the papers are relevant, and could not have been earlier submitted, since they were not available to patent owner in time to include them in a timely response to the ACP. Therefore, even if relief is not available under either 37 CFR 1.182 or 37 CFR 1.183, patent owner argues prosecution that should be *reopened* under the general supervisory provisions of 37 CFR 1.181 for the limited purpose of permitting entry of the submitted papers. [10]

## II. Findings and Analysis

### A. Inclusion of FOIA Material in the Present Petition

While the present petition purports to be limited to requesting entry of evidence against the authenticity of the Telenor documents, the petition is in fact not so limited. Instead, the papers (for which entry is now sought) submitted with the present petition, , include a declaration executed on April 24, 2006 by one Kevin P. Anderson. The declaration relates to the FOIA material obtained by patent owner - see Facts 7 and 9 above. As noted in Facts 11-14 above, patent owner filed a petition on May 12, 2006 requesting entry of papers that included both the Telenor documents and the FOIA material, and the petition was dismissed in a decision dated September 13, 2006. Patent owner requested reconsideration of that decision on February 5, 2007, and that petition was denied on March 15, 2007, as to the underlying relief requested - Fact 21.

Entry of the papers submitted with the present petition into the active IFW record of the present merged reexamination proceeding, that is, papers that intermingle material directed to the Telenor documents with FOIA material, will not be permitted for the reasons discussed in the September 13, 2006 and March 15, 2007 decisions that addressed patent owner's request for entry of the intermingled papers. The rationale set forth in the decisions applies with equal force to the present petition; i.e.:
(1) Patent owner has failed to establish that waiver of the applicable regulations (37 CFR 1.3, 1.4(c) and 1.951(a)) under 37 CFR 1.183 is necessary in the interest of justice so as to permit entry of the intermingled papers, and
(2) Relief under 37 CFR 1.182 to permit a request for continued reexamination can not be granted because such relief would still require waiver of 37 CFR 1.3 and 37 CFR 1.4(c).

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[8] See the paragraph bridging pages 1 and 2 and the paragraph bridging pages 9 and 10 of the present petition.
[9] See the first full paragraph of page 2, and footnote 3, of the present petition.
[10] See the first paragraph of page 3, and footnote 3, of the present petition.

B. Consideration of the Petition

Notwithstanding the matter discussed in section II.A. above, the substance of the present patent owner petition has been considered as if the FOIA were not commingled within the present petition, in the interest of handling this merged reexamination proceeding with special dispatch as required by both 35 U.S.C. § 305 and 35 U.S.C. § 314(c).

The May 12, 2006 Petition and September 13, 2006 Decision

The record of this merged reexamination proceeding shows that the verified statements in support of the patent owner's proposed supplemental comments after ACP (for which patent owner now requests an entry right) were originally submitted by patent owner on May 12, 2006, for entry and consideration by the examiner with respect to the merits of the patentability determination set forth in the ACP. The submission of that material was accompanied by a petition requesting exercise of the Director's supervisory authority under 37 CFR 1.181, or in the alternative, relief under either of 37 CFR 1.182 or 37 CFR 1.183, in order to obtain entry of that material. [11] The entry of these verified statements, as requested by the May 12, 2006 petition, was refused based on the Office's position that these verified statements were *commingled* with material that was not directed to the merits of the patentability determination set forth in the ACP. All of the commingled material submitted on May 12, 2006 was deemed to have been filed in a manner that failed to comply with the regulations, [12] because some of the material was directed to allegations of misconduct and bias on the part of Office personnel, and some of the material was directed to substantive patentability issues. The Decision refusing entry of, and "returning," all material filed on May 12, 2006 except the petition itself, **was mailed on September 13, 2006.**

Current Petition Decided Under 37 CFR 1.181(f)

37 CFR 1.181(f) provides, *inter alia*, that any petition under Part I of 37 CFR ("...any petition under this part...") which is 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." 37 CFR 1.181(f) also provides that this two-month period "is not extendable." Thus, any petition filed pursuant to 37 CFR 1.181, 1.182 or 1.183 may be dismissed as untimely filed, if it is not filed within two months of the mailing date of the notice from which relief is requested.

In this case, the relief requested with respect to the presently submitted papers directed to the merits of the proceeding [13] is precisely the same as the relief directed to the merits papers of the proceeding that was originally requested in the May 12, 2006 patent owner petition which included copies of the same papers as are presently submitted (material directed to the authenticity of the Telenor documents intermingled which include additional non-enterable material as discussed above). When the Office's September 13, 2006 decision on the May 12, 2006 petition issued, it put patent owner on notice, pursuant to 37 CFR 1.181(f), that entry of the

[11] It does not appear that any specific patent owner supplemental comments after ACP, other than the comments set forth in the petition itself, accompanied the verified statements.
[12] For example, 37 CFR 1.3 and 37 CFR 1.4(c).
[13] I.e., aside from the commingled FOIA material discussed above in part II.A above.

presently submitted papers would not be granted due to a defect in the submission. [14] Accordingly, after curing the defect in the May 12, 2006 submission pursuant to the September 13, 2006 petition decision, patent owner could have submitted those papers (*i.e.*, the papers presently submitted for entry in the record) together with the present petition (whether more properly styled as a petition for reconsideration or styled as the present petition is styled) within two months of the September 13, 2006 decision.

The two-month period for reconsideration of the September 13, 2006 decision expired after November 13, 2006. Had petitioner patent owner filed the present petition (together with the supplemental patent owner comments and the verified statement evidence) by November 13, 2006, it would have preceded the Right of Appeal Notice (RAN) that was issued almost one month after November 13, 2006. To the extent that 37 CFR 1.181(f) allows for discretion on the part of the USPTO Director to accept the present petition as timely filed, the present petition contains no explanation of why patent owner did not submit the present petition for entry of the papers submitted therewith within two months of the September 13, 2006 decision. The papers submitted for entry with the present petition decision differ only slightly from those submitted on May 12, 2006 to establish that the Telenor documents are not authentic. [15] Indeed, the present petition is almost identical to the petition filed on May 12, 2006, differing only in that it omits arguments for entry of the materials related to conduct issues. The papers for which entry is requested consist of duplicates of the verified statements that had been filed in order to contest the authenticity of the Telenor documents, (aside from the document directed to the FOIA material discussed in Part II.A above) together with a paper styled as "Patent Owner's Supplemental Comments After An Action Closing Prosecution." This last mentioned paper appears to be the only paper directed to the issue of the Telenor documents that was prepared subsequent to the September 13, 2006 Decision on Petition. The present petition offers no explanation as to why the present petition could not have been filed with attached papers within the two month period established by 37 CFR 1.181(f). *Accordingly, the present petition*

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[14] See Decision on Petition, September 13, 2006, page 5, last paragraph, wherein it was stated: "Again, the presentation of papers that are 'limited to the issues raised in the Office action closing prosecution' is a matter within control of patent owner. Patent owner can present a paper limited to the 'issues raised in the Office action closing prosecution,' and also present separate complaints of perceived misconduct and bias in accordance with 37 CFR 1.3 and 37 1.4(c), *i.e.*, by filing a separate paper directed to the complaints of misconduct and bias for consideration by the Office such that the paper can be maintained separate from the record of the merged reexamination proceeding to be considered by the examiner. The question of whether the interests of justice would justify waiving 37 CFR 1.951(a) so as to permit additional patent owner comments on the ACP is reserved, and will be decided only at such time as patent owner requests waiver of 37 CFR 1.951(a) so permit entry of a paper that is limited to the presentation of comments directed only to the issues of patentability raised in the ACP." The inclusion of FOIA material with the material directed to the authenticity of the Telenor documents effectively makes the present patent owner petition a request for reconsideration of the decision on petition dated September 13, 2006 as to the entry of the material directed to the merits. However, even if patent owner regards the present to be an original petition for relief, the material directed to the Telenor documents that patent owner previously had in its possession by the end of April, 2006, could easily have been submitted by a petition filed within two months of the decision of the September 13, 2006. Whether the present petition is regarded as being a request for reconsideration of the September 13, 2006 petition, or as an original petition, the September 13, 2006 decision clearly invited patent owner to file a paper presenting the Telenor material without intermingling it with additional nonenterable FOIA material. The September 13, 2006 decision constituted "action or notice from which relief is requested" under 37 CFR 1.181(f). And, 37 CFR 1.181(f) provides that "[A]ny 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." Moreover, the regulation provides that "[T]his two-month period is not extendable." However, patent owner did not file the present request for relief within two months from the September 13, 2006 action or notice as required by the 37 CFR 1.181(f), but instead delayed such filing until almost four months from September 13, 2006, thereby permitting prosecution to continue resulting in the issuance of a RAN on December 12, 2006. Pursuant to 37 CFR 1.953(c), "no amendment can be made in response to the Right of Appeal Notice." Further, patent owner has also filed a Notice of Appeal, and on March 7, 2007, patent owner filed its appellant brief. No reason was provided for the delay until after the RAN was issued.

[15] See footnote 10, *supra*.

*offers no explanation as to why the USPTO Director should exercise discretion and accept the presently filed papers that have been filed more than a month late.*

Also weighing against accepting the late filed petition is that if the requested relief were to be granted, the Office would then need to do substantial re-work to issue a new RAN, or possibly reopen, if new issues are raised, in addition to the work of considering the newly submitted material. Petitioner patent owner has argued the importance of the information submitted; however, that must be balanced against the delay that consideration of such information would entail as well as petitioner's lack of equities since avoiding the delay was entirely within petitioner's control. In litigation, where a time period for filing a pleading is missed, the material contained therein can also be important. Yet, when the time period is missed, the pleading will not be admitted, in order to maintain an orderly court proceeding. It is no different in this instance.

Pursuant to 35 U.S.C. § 305 the *ex parte* reexamination of the present merged proceeding must be conducted with special dispatch within the Office. Likewise, pursuant to 35 U.S.C. § 314(c), the *inter partes* reexamination is to be conducted with special dispatch. **Nothing in the present petition, or in the record of the merged reexamination proceeding as a whole, provides a compelling basis to act counter to both 35 U.S.C. § 305 and 35 U.S.C. § 314(c) by removing the present merged proceeding from a proceeding that is ready for the appeal process to commence.** In this regard, note is taken of the fact that an ACP been promulgated and commented on by patent owner, a Right of Appeal Notice has been promulgated, a Notice of Appeal in response thereto has been timely filed and petitioner patent owner has filed an appellant's brief (on March 5, 2007). The merged proceeding is ripe for appeal on the present record, and patent owner has not established a persuasive reason why the merged reexamination proceeding should now be reopened and delayed, especially when patent owner itself has introduced a large delay factor by not timely filing pursuing its request for entry of papers that were in its possession not later than May 12, 2006. If prosecution were to be reopened, the proceeding would be delayed by issuance of an additional ACP, responsive comments, issuance of another RAN, and the filing of another Notice of Appeal and another Brief. This delay would fly in the face of the pending litigation [16] and the statutory mandate to advance the prosecution with special dispatch which would provide the court the benefits of the Office's action.

For the foregoing reasons, the January 3, 2007 patent owner's supplemental comments to the action closing prosecution and the accompanying verified statements will not be entered and considered in the present merged reexamination proceeding.

## ADDITIONAL DISCUSSION

Even assuming that the present petition had been timely filed, the petition would not have shown an adequate cause for the relief requested. The material that has been submitted with the present petition is essentially, but not completely, confined to verified statements that question the authenticity of the so-called Telenor documents that have been applied to the claims as prior art. Patent owner's argument is grounded upon the verified statement of David Richard Browne, a Forensic Documents Examiner, who at the time of execution of his verified statement was head of the Questioned Documents Department of BSB Forensic Ltd., an

[16] In a ruling handed down by Judge James R. Spencer of the U.S. District Court for the Eastern District of Virginia on March 22, 2007, action was stayed in a patent infringement lawsuit (NTP v PALM) until the Office rules on the validity of the '592 patent (and other Campana patents).

independent company. [17] A brief review of the verified statement of Mr. Browne shows that his ultimate conclusions are at best speculative, based on conjecture, and not sufficient to require withdrawal of the Telenor documents [18] as a prior art reference on any basis argued by patent owner.

None of Mr. Browne's findings would warrant a conclusion by a reasonable patent examiner that, as alleged by patent owner, the Telenor documents are not authentic and that the parent copy was not on file in the Trondheim University Library in Norway as of the dates facially set forth on the Telenor documents. [19] For example, even if it is accepted that these reference materials, located in a library, may have been unbound to facilitate photocopying, such fails to constitute persuasive evidence, by any evidentiary standard, that these documents are not authentic and do not, as of the dates on the face of these documents, teach the subject matter set forth therein, when read through the eyes of one of ordinary skill in the art. Further, nothing in Mr. Browne's verified statement rules out the conclusion that his findings may be a result of innocent causes. Nothing in Mr. Browne's verified statement states unequivocally that the documents in question are not authentic teaching documents that constitute prior art to the '592 patent. In fact, the last two statements by Mr. Browne in his report [20] are that:

> "Without knowledge of the other documents in the University library and or the Telecommunications Research Institute and the control procedures in use, or the copiers in use, **it is not possible to give a definite opinion as to the dates of any alterations.**"
>
> "However my findings are significant and do **cast doubt** as to when these documents were created, when changes were made and what text was actually on the pages when they were first filed."
>
> [Emphasis added.]

Mr. Browne's statement that there may be "doubt" does not present any concrete basis to establish the likely truth of patent owner's allegations regarding the authenticity of the Telenor documents; [21] nor does it carry patent owner's burden of rebutting the status of the Telenor documents as printed publications that are prior art to the '592 patent that is *prima facie* established by the dates on the document. Patent owner's failure to adequately address the caveats expressed by patent owner's own expert regarding the expert's inability to establish definite dates for any alterations, or what text was actually on the pages as first filed the University library procedures, would preclude any reasonable examiner from accepting the patent owner's allegations regarding the Telenor documents, or concluding that these documents are not prior art printed publications (valid references) for what they disclose.

Certificate of Service:

As an additional point, the record is not clear that the service of all the patent owner papers in question was actually made. 37 CFR 1.903 requires, *inter alia*, that after the filing of a request for

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[17] Additional verified statements have been submitted by a number of declarants in order to establish "chain of custody" of the examined Telenor documents.

[18] The Telenor documents are eight volumes documents, one of which is stapled with three staples down its left spine and the others of which are bound together along one edge with glue, which were catalogued and maintained in Trondheim University Library in Norway.

[19] See "Patent Owner's Supplemental Comments After an Action Closing Prosecution," which accompanies the present petition. at page 1 ("Telenor documents are not authentic") and at page 2 ("'Telenor Documents' refers to the documents cited in the present reexamination" and "The Telenor Documents do not qualify as printed publications under 35 U.S.C. § 102(b) because they have been manipulated and altered.")

[20] Report of David Richard Browne, entitled "Re: NTP" signed April 21, 2006 , page 6, attached as Exhibit 2 to Declaration of David Richard Browne Under 37 C.F.R. § 1.132" executed April 21, 2006

[21] See footnote 16.

*inter partes* reexamination by a third party requester, any document filed by the patent owner must be served on every other party in the reexamination proceeding in the manner provided in 37 CFR 1.248. 37 CFR 1.903 also states that any document must reflect service or the document may be refused consideration by the Office, and that the failure of the patent owner to serve documents may result in their being refused consideration.

The Certificate of Service that accompanied patent owner's filing of all of the papers filed on January 3, 2007 by states only that petitioner "caused a copy of the foregoing 'PETITION PURSUANT TO 37 CFR § 1.183 OR, ALTERNATIVELY, 37 CFR § 1.182, OR, ALTERNATIVELY, 37 CFR § 1.181 TO ENTER EVIDENCE AGAINST THE AUTHENTICITY OF THE TELENOR DOCUMENTS INTO THE RECORD OF THE INTER PARTES PROCEEDING' to be served" on the third party requester. It is not clear from the language of the Certificate of Service whether the papers accompanying the petition (*i.e.*, the patent owner's supplemental comments and the supporting verified statements) were considered to be part of the petition and were, therefore, also served on the third party requester. Therefore, (1) the record does not clearly show that the patent owner's supplemental comments and the verified statements in support of those comments have been served on the third party requester, and (2) it is not clear that the patent owner's supplemental comments and the verified statements in support of those comments have actually been served on the third party requester.

## DISPOSITION OF IMPROPER PAPERS

As pointed out above, the Office's September 13, 2006 decision clearly invited the patent owner to file a paper presenting the material directed to Telenor material without intermingling it with additional nonenterable FOIA material. The September 13, 2006 decision constituted "action or notice from which relief is requested" under 37 CFR 1.181(f). 37 CFR 1.181(f) provides that (a) "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," and (b) "this two-month period is not extendable." In spite of this, patent owner did not file the present request for relief within two months from the September 13, 2006 action or notice as required by the 37 CFR 1.181(f), but instead delayed such filing until almost four months from September 13, 2006, thereby permitting prosecution to continue resulting in the issuance of a RAN on December 12, 2006. [22] (Further, patent owner has now filed a Notice of Appeal, and an appeal brief.) Patent owner's delay until after the RAN was issued has not been explained, while entry of the submission at this point would cause considerable delay (as detailed above) clearly running counter to the statutory mandate for special dispatch. Accordingly, the Office is exercising its discretion to return the present submission (petition papers and attachments). With respect to such discretion, MPEP 2672 states (emphasis added):

> "I. ONE OPPORTUNITY TO MAKE SUBMISSIONS UNDER 37 CFR 1.951(a) AND (b) After an Action Closing Prosecution (ACP), the patent owner may once file (pursuant to 37 CFR 1.951(a)) written comments limited to the issues raised in the reexamination proceeding and/or present a proposed amendment to the claims. Where the patent owner does so, the third party requester may once file (pursuant to 37 CFR 1.951(b)) comments responsive to the patent owner's comments. **Any second or supplemental submission after ACP by either the patent owner or the third party requester will thus be returned.** "

[22] Pursuant to 37 CFR 1.953(c), "no amendment can be made in response to the Right of Appeal Notice."

MPEP 2667 I.A.3 states (emphasis added):

> "3. Improper Patent Owner Response
>
> The patent owner can only file once under 37 CFR 1.951(a). Any second or supplemental submission after ACP by the patent owner **will be returned, unless prosecution has been reopened.** See MPEP § 2672."

These provisions of the MPEP are grounded on 37 CFR 1.939 (Unauthorized papers in *inter partes* reexamination), which provides.

> "(a) If an **unauthorized** paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and **may be returned.**"

The rule provides discretion for the Office to return an unauthorized (improper) paper, and the MPEP shows that the Office procedure is, and has been, to return second or supplemental submissions after ACP filed by a party. In the present instance the petition is integrally tied to the "Patent Owner's Supplemental Patent Owner Comments After An Action Closing Prosecution" and supporting evidence to present one composite set of supplemental comments/arguments after ACP. It is to be noted that the petition is not confined to advancing reasons why the interests of justice would mandate either waiver of the regulations, or relief not provided for in the regulations. Rather, the petition itself is argumentative as the authenticity of the Telenor documents. [23] Accordingly, the present petition, the patent owner's supplemental comments after ACP and the supporting evidence (hereinafter, "the January 3, 2007 patent owner papers") are appropriately returned in accordance with provisions of 37 CFR 1.939(a) and MPEP §§ 2672 and 2667 I.A.3. In this instance, the January 3, 2007 patent owner papers have already been scanned into the Image File Wrapper (IFW) of each of the two individual reexamination proceedings that together comprise the present merged reexamination proceeding. Therefore, the papers cannot be physically returned to patent owner. Instead, the papers will be "returned" by marking the papers as "non-public" and "closed" so that they do not appear in the active IFW record with the other active papers that comprise the public record of the proceedings. The January 3, 2007 patent owner papers, are being placed in a separate archive e-file, which is not part of the public record.

## CONCLUSION

1. The January 3, 2007 patent owner petition is denied.

2. The January 3, 2007 patent owner papers will not remain in the active IFW record for the merged proceeding, and will not be considered by the examiner on their merits, because they lack an entry right in the merged reexamination proceeding. Instead, the he January 3, 2007 patent owner papers will be "returned" by marking the papers as "non-public" and "closed" so that they do not appear in the active IFW record with the other active papers that comprise the public record of the proceedings.

3. The present decision will be placed in the active IFW record for the merged proceeding.

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[23] For example, the petition, at page 4, states:

> "Many of the claims under reexamination have been rejected on the basis of several volumes of technical documents (the "Telenor documents") that are alleged to have been catalogued in Norges teknisk-naturvitenskapelige universitet (NTNU) library in Trondheim, Norway prior to the earliest filing date of the '592 patent. Patent Owner...."

As pointed out above, patent owner could easily have properly submitted this before the RAN issued; and, at present, it does not have an entry right in the proceeding.

4. Telephone inquiries with regard to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or, in his absence, to the undersigned at (571) 272-7710.

5. This decision is a final agency action within the meaning of 5 U.S.C. § 704.

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

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March 28, 2007

March 29, 2007
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MAILED

MAY 23 2007

CENTRAL REEXAMINATION UNIT

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/006,495
Filed: December 26, 2002
For: U.S. Patent No. 6,317,592

*In re Campana, Jr. et al*
*Inter Partes* Reexamination Proceeding
Control No.: 95/000,020
Filed: May 29, 2003
For: U.S. Patent No. 6,317,592

**DECISION GRANTING PETITION**

This is a decision on the April 4, 2007 patent owner petition styled "Petition Pursuant To 37 CFR § 1.181 Or, Alternatively, 37 CFR § 1.182, Or, Alternatively, 37 CFR § 1.183 To Suspend The Page and Word Count Limitations of the Decision Granting Petition Dated March 9, 2007."

The petition and the above-captioned merged reexamination proceedings are before the Office of Patent Legal Administration for consideration.

Summary:

Patent owner's petition, taken as a petition under 37 CFR 1.183 to waive the 37 CFR 1.943(c) limit as to page length, is granted to the extent that the page limit for the appellant's brief is extended to not exceed 141 pages or 51,225 words in length.

It is being presumed that the patent owner is substituting, via its attachment to the petition, the "Appeal Brief" attached as Exhibit A to the present petition - for both of the appellant's briefs that were filed on March 5, 2007. If this presumption is incorrect, petitioner patent owner must file a notification paper so stating within 15 DAYS of the mailing date of this decision. If such a notification paper is not filed, the presumption will become final, and the April 4, 2007 "Appeal Brief" will become the sole patent owner appellant brief of record in the proceeding.

## PETITION FEE

A petition fee under 37 CFR 1.17(f) of $ 400.00 is required for a petition under 37 CFR 1.183. As authorized on page 8 of the present petition, the $ 400.00 petition fee will be charged to patent owner's Deposit Account No. 50-0206.

## REVIEW OF SALIENT FACTS

1. U.S Patent number 6,317,592 ("the '592 patent") issued to Campana *et al* on November 13, 2001, from an application filed on December 6, 1999.

2. On December 26, 2002, a Director Initiated Order for Reexamination of the '592 patent was mailed, and the resulting *ex parte* reexamination proceeding was assigned control number 90/006,495 ("the '495 reexamination proceeding").

3. On May 29, 2003, a request for *inter partes* reexamination of the '592 patent was filed by a third party requester, and assigned control number 95/000,020 ("the '020 reexamination proceeding").

4. On August 26, 2003, the examiner's Order Granting *Inter Partes* Reexamination for the '020 reexamination proceeding was mailed.

5. On August 9, 2004, the Office issued a decision *sua sponte* merging the '495 reexamination proceeding and the '020 reexamination proceeding into a single combined reexamination proceeding ("the merged reexamination proceeding").

6. The August 26, 2003 decision merging the proceedings set forth that the merged reexamination proceeding would be conducted in accordance with 37 CFR 1.982, *i.e.*, in accordance with the regulations governing the prosecution of an *inter partes* reexamination proceeding.

7. On January 4, 2006, a Freedom of Information Act ("FOIA") Request was made to the Office requesting information directed to the Office's communications with third parties regarding the present reexamination proceedings, as well as pending reexamination proceedings being conducted on others of patent owner's patents.

8. On February 1, 2006, following prosecution on the patentability of the '592 patent claims, the examiner issued an Action Closing Prosecution (ACP) for the merged reexamination proceeding.

9. The Office responded to the FOIA request through letters dated between February 8 and March 24, 2006.[1]

10. On March 1, 2006, the patent owner filed written comments after the ACP. The third party requester did not file a paper responsive to the patent owner's March 1, 2006 comments.

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[1] An additional response to the FOIA request was mailed by the Office on June 15, 2006 and received by patent owner on June 16, 2006.

11. On May 12, 2006, the patent owner filed papers which included copies of materials obtained as a result of the FOIA request (hereinafter "the FOIA material"), and also a number of verified statements directed to the issue of the authenticity of the so-called "Telenor documents" relied upon (applied) as prior art in the merged reexamination proceeding.

12. Also on May 12, 2006, the patent owner filed a petition requesting entry of all of the papers filed on May 12, 2006.

13. On September 13, 2006, the Office issued a Decision Dismissing Petition that dismissed the May 12, 2006 petition, "returned" the papers that were filed on May 12, 2006, and invited petitioner to resubmit the May 12, 2006 papers by filing the FOIA material and the material directed to substantive patentability issues separately in accordance with 37 CFR 1.3 and 1.4(c).

14. Patent owner did not file a request for reconsideration of the September 13, 2006 Decision on or before November 13, 2006. A request for reconsideration of the September 13, 2006 Decision was, however, filed on February 5, 2007 - see item # 18 below.

15. On December 12, 2006, the Office issued a Right of Appeal Notice (RAN) for the merged reexamination proceeding.

16. On January 3, 2007, the patent owner filed a petition requesting entry into the record of a redacted version of the material filed on May 12, 2006.

17. On January 4, 2007, patent owner filed a Notice of Appeal in the merged proceeding, together with authorization to charge patent owner's deposit account for the $500.00 appeal fee.

18. On February 5, 2007, patent owner filed a Petition for Reconsideration of the September 13, 2006 Decision Dismissing Petition, in which petition the patent owner facially requested that all of the material filed on May 12, 2006 be entered into the record.

19. On February 23, 2007, patent owner filed a petition to suspend the page and word-count limitation set for an appellant's brief by 37 CFR 1.943.

20. On March 5, 2007, patent owner timely filed its appellant's brief. [2]

21. On March 9, 2007, a decision granting patent owner's February 23, 2007 petition to suspend the page and word-count limitation of 37 CFR 1.943 was granted to increase the page and word-count limitation to the limited extent set forth in that decision.

22. On March 15, 2007, the Office issued a decision denying patent owner's February 5, 2007 petition. The March 15, 2007decision was designated as a final agency action under 35 U.S.C. § 704.

23. On March 30, 2007, the Office issued a decision dismissing patent owner's January 3, 2007 petition.

[2] The record shows that two different versions of an appellant's brief were filed on March 5, 2007.

24. On April 4, 2007, patent owner filed the present petition to request leave to file a 141-page, 51,255-word Supplemental Brief attached to the petition as Appendix A.

## DECISION

### I. Applicable Regulatory Provisions

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 1.943(c) provides:

> Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed fifteen pages in length or 7,000 words. If the page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

### II. Findings and Analysis

A review of the record shows that, on February 23, 2007, patent owner filed a petition requesting a waiver of the requirements of 37 CFR 1.943(c) to permit the filing of an appeal brief in excess of the 30-page or 14,000-word limit for an appellant's brief filed in an *inter partes* reexamination proceeding. No specific page or word count limitation was requested in the February 23, 2007 petition. As the time for filing the patent owner's appellant's brief extended only through March 5, 2007, patent owner filed an appellant's brief on March 5, 2007 that was certified to comply with 37 CFR 1.943(c) by including 13,887 words. Also on March 5, 2007 patent owner filed another, more voluminous appellant's brief, apparently in anticipation that the relief requested in the February 23, 2007 petition would be granted. However, on March 9, 2007, a decision was mailed granting the March 5, 2007 patent owner petition for waiver of 37 CFR 1.943(c) only to the extent that the appeal brief could include as many as 60 pages or 28,000 words. [3,4] In view of the showing now provided via the present petition, waiver of 37 CFR 1.943(c) is granted to the extent that the page limit for the appellant's brief is extended to not exceed 141pages or 51,225 words in length.

The present patent owner petition is accompanied by an attachment designated Appendix A. The document appearing in Appendix A is styled as an "Appeal Brief." The present petition itself requests leave to file a "Supplemental Appeal Brief." [5] Although there is no certificate of compliance attached to the "Supplemental Appeal Brief," it is stated in the present petition [6] to be a 141-page, 51,255-word document, exclusive of both the Claims Appendix and other reference materials. Note is taken that petitioner patent owner "considers the Evidence

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[3] See Decision Granting Petition, March 9, 2007.

[4] The more voluminous appellant's brief filed on March 5, 2007 could not be entered, because it did not certify the number of pages or words contained therein.

[5] *Id.*, at pages 1-2.

[6] *Id.*

Appendix and the Related Proceedings Appendix to be reference materials and are thus not included in the word count." [7]

The length limitations for appellant's briefs and other briefs and party papers in *inter partes* reexamination are imposed, in part, to assist the Office in compliance with its mandate to handle *inter partes* reexamination proceedings with "special dispatch" as is required by 35 U.S.C. § 305. These length limitations are analogous to similar length limitations established in Federal appellate litigation practice. [8] It is agreed that, as opined by petitioner patent owner, the Evidence Appendix and Related Proceedings Appendix that are required by 37 CFR 41.67 are, at least implicitly, excluded from the page and word count limitations established by 37 CFR 1.943(c). To the extent necessary, the provisions of 37 CFR 1.943(c) are hereby waived to expressly exclude the Evidence Appendix and related Proceedings Appendix from the 37 CFR 1.943(c) page and word limits.

The "Appeal Brief" attached as Appendix A to the present petition is within the expanded page and word limit set by the present decision. Although the patent owner makes repeated refers to the "Appeal Brief" attached as Appendix A as being a "Supplemental Appeal Brief," [9] the relief requested with respect to giving petitioner patent owner leave to submit the "Appeal Brief" attached as Appendix A to the present petition can accordingly be granted, but this is so **only by presuming that the patent owner is substituting, via the attachment to the petition, the "Appeal Brief" attached as Exhibit A to the present petition - for both of the appellant's briefs that were filed on March 5, 2007.** [10] In the interest of special dispatch, the undersigned will engage in that presumption, and grant the relief requested on an interim basis. **In the event that petitioner does not accept the substitution of the April 4, 2007 "Appeal Brief" as a replacement for the two March 5, 2007 appellant's briefs that are currently in the record, petitioner patent owner must file a paper so stating within 15 DAYS of the mailing date of this decision. If such a paper is not filed, the presumption will become final, and the April 4, 2007 "Appeal Brief" will become the sole patent owner's appellant brief of record in this merged reexamination proceeding.**

## CONCLUSION

1. The petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(c) is granted to the extent that the page limit for the appellant's brief is extended to not exceed 141 pages or 51,225 words in length.

2. It has been presumed that the patent owner is substituting, via attachment to the petition, the "Appeal Brief" attached as Exhibit A to the present petition - for both of the appellant's briefs that were filed on March 5, 2007. In the event that this presumption is incorrect, petitioner patent owner must file a notification paper so stating within 15 DAYS of the mailing date of this decision. If such a notification paper is not filed, the presumption will become final, and the April 4, 2007 "Appeal Brief" will become the sole patent owner's

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[7] *Id.*, at footnote 1

[8] See *Rules to Implement Optional Inter Partes Reexamination Proceedings*, 65 FR 18154 (April 6, 2000) (Notice of Proposed Rule Making), at page 18160 - "These numbers of pages are in line with procedural rules of the Federal Courts; see for example Rule 32(a)(7)(A) of the Federal Rules of Appellate Procedure or Rule 33 of the Rules of the Supreme Court of the United States (Practice & Procedure). "

[9] See, for example, page 2 and page 6 of the present patent owner petition.

[10] As pointed out above, on March 5, 2007, patent owner filed two appellant's briefs; each is styled as "Appeal Brief."

appellant brief of record in this merged reexamination proceeding.

3. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit to await the filing of any party papers, and to process any and all party papers at the point where there is no further time remaining for filing such papers. After the Central Reexamination Unit has processed all party papers, or there are no such papers and the time for filing same has expired,[11] jurisdiction will be transferred to the Primary Examiner for appropriate action on the proceeding.

4. Telephone inquiries with regard to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or, in his absence, to the undersigned at (571) 272-7710.

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

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May 17, 2007

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[11] In this instance, if no patent owner paper is received within 15 days of the mailing of this decision, the CRU should ensure that the proceeding is processed to reflect the substitution of the "Appeal Brief" attached as Exhibit A to the present petition - for both of the appellant's briefs that were filed on March 5, 2007.

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(For Patent Owner)

MAILED

SEP 2 1 2007

CENTRAL REEXAMINATION UNIT

NOVAK DRUCE & QUIGG, LLP
1300 Eye Street NW
400 East Tower
Washington, DC 20005

(For Requester)

In re Thomas J. Campana, Jr. et al.
*Inter partes* Reexamination Proceeding
Control No. 95/000,020
Filed: May 29, 2003
For: U.S. Patent No. 6,317,592

In re Thomas J. Campana, Jr. et al.
Director Ordered
*Ex parte* Reexamination Proceeding
Control No. 90/006,495
Filed: December 26 2002
For: U.S. Patent No. 6,317,592

DECISION GRANTING PETITION

This is a decision on the September 14, 2007, patent owner petition entitled "PETIION UNDER §§ 1.181, 1.182 AND 1.183 FOR SUSPENSION OF RULE 41.66(D) TO GRANT PATENT OWNER LEAVE TO SEEK AND OBTAIN AN EXTENSION OF TIME PURSUANT TO 37 CFR 1.956 TO FILE ITS REBUTTAL BRIEF."

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

The petition is granted for the reasons set forth below.

**PETITION FEE**

A petition fee of $400.00 under 37 CFR 1.17(f), as required by 37 CFR 1.183, is being charged to petitioner patent owner's Deposit Account No. 50-0206 as authorized at page 10 of the present petition. A petition fee of $200.00 under 37 CFR 1.17(g), as required by 37 CFR 1.956, is also being charged to petitioner patent owner's Deposit Account No. 50-0206 as authorized in the present petition.

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## REVIEW OF SALIENT FACTS

1. U.S Patent number 6,317,592 ("the '592 patent") issued to Campana *et al* on November 13, 2001 from an application filed on December 6, 1999.

2. On December 26, 2002, a Director Initiated Order for reexamination of the '592 patent was mailed, and the resulting proceeding was assigned control number 90/006,495 ("the '495 reexamination proceeding").

3. On May 29, 2003, a request for *inter partes* reexamination of the '592 patent was filed by a third party requester, and the resulting proceeding was assigned control number 95/000,020 ("the '020 reexamination proceeding").

4. On August 26, 2003, the examiner's Order Granting *Inter Partes* Reexamination for the '020 reexamination proceeding was mailed.

5. On August 9, 2004, the Senior Special Projects Advisor issued a decision, *sua sponte*, by which the '495 reexamination proceeding and the '020 reexamination proceeding were merged into a single combined reexamination proceeding ("the present merged reexamination proceeding").

6. The August 26, 2003 decision merging the proceedings set forth that the present merged proceeding would be conducted in accordance with 37 CFR 1.982, *i.e.*, in accordance with the regulations governing the prosecution of an *inter partes* reexamination proceeding.

7. Following extensive prosecution on the patentability of the claims in the present merged proceeding, the Office issued a Right of Appeal Notice ("RAN") on December 12, 2006.

8. On January 3, 2007, the patent owner filed a Notice of Appeal together with authorization to charge patent owner's deposit account for the $500.00 appeal fee.

9. On August 7, 2007, the patent owner filed an amended appellant's brief (37 CFR 41.66(a)) that was accepted as a proper filing.

10. An examiner's answer (37 CFR 41.69), responsive to the August 7, 2007 patent owner appellant's brief, was mailed on August 24, 2007.

11. The present patent owner petition was filed on September 14, 2007 for the purpose of extending the time permitted (37 CFR 41.66(d)) in which patent owner may file a rebuttal brief (37 CFR 41.71) in reply to the examiner's answer.

12. Seven other patents related to the '592 patent are each concurrently undergoing *ex parte* reexamination proceedings and are under appeal.

## RELEVANT AUTHORITY

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

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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 1.956 provides in part:

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).

37 CFR 41.30 provides that for *ex parte* appeals:

Applicant means either the applicant in a national application for a patent or the applicant in an application for reissue of a patent.

37 CFR 41.41(a)(1) provides:

Appellant may file a reply brief to an examiner's answer within two months from the date of the examiner's answer.

37 CFR 41.60 provides, that for *inter partes* appeals:

*Appellant* means any party, whether the owner or a requester, filing a notice of appeal or cross appeal under § 41.61. If more than one party appeals or cross appeals, each appealing or cross appealing party is an appellant with respect to the claims to which his or her appeal or cross appeal is directed.

*Respondent* means any requester responding under § 41.68 to the appellant's brief of the owner, or the owner responding under § 41.68 to the appellant's brief of any requester. No requester may be a respondent

37 CFR 41.66(d) provides:

Any appellant may file a rebuttal brief under § 41.71 within one month of the date of the examiner's answer. The time for filing a rebuttal brief or an amended rebuttal brief may not be extended.

37 CFR 41.71 provides, in part:

(a) Within one month of the examiner's answer, any appellant may once file a rebuttal brief.
(b)(1) The rebuttal brief of the owner may be directed to the examiner's answer and/or any respondent brief.

## DECISION

The '592 patent is one of eight patents directed to related subject matter and owned by the same patent owner that are currently being reexamined. Some of the seven other reexamination proceedings are merged proceedings, wherein two or more *ex parte* reexamination proceedings for the same patent have been merged. Each of the seven reexamination proceedings is being conducted pursuant to the regulations and examining practice governing *ex parte* reexamination. The present merged reexamination proceeding for the '592 patent involves an *ex parte* reexamination proceeding and an *inter partes* reexamination proceeding that have been merged in accordance with Office

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practice. The present merged proceeding is being conducted under the rules governing an *inter partes* reexamination proceeding. [1]

Appeals in *ex parte* reexamination proceedings are conducted pursuant to 37 CFR Part 41, subpart B (*Ex Parte* Appeals). The appeal in the present merged reexamination proceeding for the '592 patent is being conducted in accordance with 37 CFR Part 41, subpart C (*Inter Partes* Appeals). *Ex parte* appeal practice provides for an appeal brief (which in reexamination, will always be filed by the patent owner, an examiner's answer issued in response to the appeal brief, and a reply brief filed by the patent owner. 37 CFR 41.41 provides that the reply brief must be filed within two months of the date of the examiner's answer.

*Inter partes* appeal practice provides for an appellant's brief (analogous to an appeal brief in *ex parte* reexamination), which may be filed by either the patent owner or the third party requester pursuant to 37 CFR 41.67, then a respondent's brief, which may be filed by the party who did not file the appellant's brief. The examiner will then issue an examiner's answer under 37 CFR 41.66 that is responsive to the appellant's brief, and to the respondent's brief, if one has been filed. Under 37 CFR 41.66(d), any appellant may then file a rebuttal brief in reply to the examiner's answer. 37 CFR 41.66(d) further provides the rebuttal brief must be filed within one month of the date of the examiner's answer, and that the time for filing the rebuttal brief may not be extended.

Patent owner has requested that the provisions of 37 CFR 41.66 [2] be waived in accordance with the provisions of 37 CFR 1.183 to the extent that 37 CFR 41.66 precludes patent owner from requesting an extension of time. The petition is taken as (a) a petition to waive the provisions of 37 CFR 41.66(d) to the extent that they preclude any extension of time, and (b) a petition to then grant a one-month extension of time, since both types of relief are required to achieve petitioner's goal.

The facts of this particular proceeding include: (1) there are seven other reexamination proceedings that are directed to patents that are owned by patent owner, which patents are directed to subject matter related to the subject matter of the present '592 patent; (2) patent owner will have two months in which to file a brief that is responsive to an examiner's answer in those seven proceedings, but is limited, by rule, to one-month in which to file a brief responsive to the examiner's answer in the present merged proceeding; and (3) the examiner's answer is lengthy, due in large part to the complexity of the involved technology. Based on these facts, and the present fact-situation taken as a whole, it is deemed that justice requires waiver of 37 CFR 41.66(d) to permit patent owner to request an extension of the one-month period provided by 37 CFR 41.66(d).

Further, in view of the complex nature of the technology involved in the appeal in the present merged reexamination proceeding and the resulting length of the examiner's answer, it is deemed that sufficient cause exists to grant patent owner's request to extend the period in which patent owner may file a rebuttal brief directed to the examiner's answer by one-month. Therefore, the period in which to file the rebuttal brief will extend through October 24, 2007. Any request in this proceeding for an additional extension of time in which to file a rebuttal brief will require both an additional

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[1] Reference may be had to 37 CFR 1.989 regarding merger of copending *ex parte* and *inter partes* reexaminations proceedings for the same patent, and to MPEP § 2686.01 for the circumstances in which merger will take place, and the manner in which the merged proceeding will be conducted.

[2] Patent owner has requested a waiver of 37 CFR 41.66(**b**) on page 1 of the petition, but has also requested a waiver of 37 CFR 41.66(**d**) on pages 1, 2 and 9. Patent owner has also requested, in the alternative, that the Commissioner (*sic*, "Director") "replace" the one-month requirement of 37 CFR 41.66(d) with a two month requirement." The present petition is taken as a request to waive the provisions of 37 CFR 41.66(d), which are directed to the filing of a rebuttal brief, (the type of brief that patent owner intends to file). 37 CFR 41.66(b) relates to a respondent's brief, which as discussed above, is an original "appeal brief" that has been filed by the second party to file such a brief.

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showing under 37 CFR 1.183 to support another waiver of 37 CFR 41.66(d) to permit an additional extension of time, as well as a showing of sufficient cause to support the requested additional extension of time.

## CONCLUSION

1. Patent owner's petition to waive the provisions of 37 CFR 41.66(d) so as to entertain an extension of the one-month period in which to file a rebuttal brief is granted.

2. Patent owner's request for a one-month extension of time is also granted.

3. Patent owner's rebuttal brief is due on or before October 24, 2007.

4. Telephone inquiries with regard to this decision should be directed to the undersigned at 571-272-7710, or, in his absence, to Stephen Marcus, Legal Advisor, at (571) 272-7743.

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

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September 20, 2007

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11/7/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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## *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/006495 + 95/000,020
PATENT NO. 6,317,592
ART UNI 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 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

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. |
|---|---|---|---|---|
| 90/006,495 | 12/26/2002 | 6317592 | | 9470 |

803 7590 11/07/2007

STURM & FIX LLP
206 SIXTH AVENUE
SUITE 1213
DES MOINES, IA 50309-4076

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 11/07/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Third Party Requester)

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CENTRAL REEXAMINATION UNIT

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/006,495
Filed: December 26, 2002
For: U.S. Patent No. 6,317,592

*In re Campana, Jr. et al*
*Inter Partes* Reexamination Proceeding
Control No.: 95/000,020
Filed: May 29, 2003
For: U.S. Patent No. 6,317,592

**DECISION GRANTING PETITION**

This is a decision on the October 24, 2007 patent owner petition styled "Petition Pursuant To 37 CFR § 1.181 Or, Alternatively, 37 CFR § 1.182, Or, Alternatively, 37 CFR § 1.183 To Suspend The Page and Word Count Limitations of 37 CFR 1.943."

The petition and the above-captioned merged reexamination proceedings are before the Office of Patent Legal Administration for consideration.

Summary:

Patent owner's petition, taken as a petition under 37 CFR 1.183 to waive the 37 CFR 1.943(c) limit as to page length and word count, is granted to the extent that the page limit for the appellant's currently filed Supplemental Rebuttal Brief is extended to not exceed 131 pages or 39,146 words in length.

It is being presumed that the patent owner is substituting the Supplemental Rebuttal Brief filed concurrently with the present petition for the Rebuttal Brief that was also concurrently filed with the present petition. If this presumption is incorrect, petitioner patent owner must file a notification paper so stating within 15 DAYS of the mailing date of this decision. If such a notification paper is not filed, the presumption will become final, and the October 24, 2007

Supplemental Rebuttal Brief will become the sole patent owner rebuttal brief entered into the active record in the present merged reexamination proceeding.

## PETITION FEE

A petition fee under 37 CFR 1.17(f) of $ 400.00 is required for a petition under 37 CFR 1.183. As authorized on page 6 of the present petition, the $ 400.00 petition fee will be charged to patent owner's Deposit Account No. 50-0206.

## REVIEW OF SALIENT FACTS

1. U.S Patent number 6,317,592 ("the '592 patent") issued to Campana *et al* on November 13, 2001, from an application filed on December 6, 1999.

2. On December 26, 2002, a Director Initiated Order for Reexamination of the '592 patent was mailed, and the resulting *ex parte* reexamination proceeding was assigned control number 90/006,495 ("the '495 reexamination proceeding").

3. On May 29, 2003, a request for *inter partes* reexamination of the '592 patent was filed by a third party requester, and assigned control number 95/000,020 ("the '020 reexamination proceeding").

4. On August 26, 2003, the examiner's Order Granting *Inter Partes* Reexamination for the '020 reexamination proceeding was mailed.

5. On August 9, 2004, the Office issued a decision *sua sponte* merging the '495 reexamination proceeding and the '020 reexamination proceeding into a single combined reexamination proceeding ("the merged reexamination proceeding").

6. On February 1, 2006, following prosecution on the patentability of the '592 patent claims, the examiner issued an Action Closing Prosecution (ACP) for the merged reexamination proceeding.

7. On January 4, 2006, a Freedom of Information Act ("FOIA") Request was made to the Office requesting information directed to the Office's communications with third parties regarding the present reexamination proceedings, as well as pending reexamination proceedings being conducted on others of patent owner's patents.

8. On December 12, 2006, the Office issued a Right of Appeal Notice (RAN) for the merged reexamination proceeding.

9. On January 4, 2007, patent owner filed a Notice of Appeal in the merged proceeding, together with authorization to charge patent owner's deposit account for the $500.00 appeal fee.

10. On March 5, 2007, patent owner timely filed its appellant's brief. [1]

11. On April 4, 2007, patent owner filed the present petition to request leave to file a 141-page, 51,255-word Supplemental Brief attached to the petition as Appendix A.

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[1] The record shows that two different versions of an appellant's brief were filed on March 5, 2007.

12. On May 23, 2007, the April 4, 2007 patent owner petition was granted.

13. An examiner's answer that was properly executed by appeal conferees and that was responsive to the Supplemental Brief filed on April 4, 2007 was mailed on August 24, 2007.

14. On September 14, 2007, patent owner filed a petition requesting a one-month extension of time in which to file a rebuttal brief responsive to the examiner's answer.

15. On September 21, 2007, a decision granting the September 21, 2007 patent owner petition by patent owner on an extension of time for patent owner to file a rebuttal brief was mailed.

16. On October 24, 2007, the last day for filing the patent owner's rebuttal brief, patent owner filed a Rebuttal Brief, also filed a Supplemental Rebuttal Brief, and also filed the present patent owner petition requesting waiver of 37 CFR 1.943(c) to permit entry of the Supplemental Rebuttal Brief.

## DECISION

I. Applicable Regulatory Provisions

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 1.943(c) provides:

> Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed fifteen pages in length or 7,000 words. If the page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

II. Findings and Analysis

The present patent owner petition requests that the page and word limits established by 37 CFR 1.943(c) be waived to permit filing of a rebuttal brief that fully addresses the examiner's answer. Specifically, the patent owner requests that the Office (1) permit patent owner to file a supplemental rebuttal brief that includes 131 pages and 39,146 words, (2) then accept the Supplemental Rebuttal Brief filed on October 24, 2007. A certificate of service in compliance with 37 CFR 1.903 accompanies the present patent owner petition. The Supplemental Rebuttal Brief is accompanied by a certificate of service in compliance with 37 CFR 1.903, and by a certification that the Supplemental Rebuttal Brief includes 131 pages and 39,146 words.

The length limitations for appellant's briefs and other briefs and party papers in *inter partes* reexamination are imposed, in part, to assist the Office in compliance with its mandate to handle *inter partes* reexamination proceedings with "special dispatch" as is required by 35 U.S.C. § 305. These length limitations are analogous to similar length limitations established in

Federal appellate litigation practice. [2] Inasmuch as this proceeding involves an unusually large number of claims, and noting that the page and word limitations were previously waived with respect to the appellant's brief in a decision dated April 4, 2007, it is found that waiver of the page and word count limitations of 37 CFR 1.943(c) is appropriate with respect to filing of a rebuttal brief by petitioner patent owner. However, entry of the Supplemental Rebuttal Brief that was filed on October 24, 2007 into the active IFW record of the present merged reexamination proceeding as a result of waiver of the provisions of 37 CFR 1.943(c) is limited as follows:

(1) The Supplemental Rebuttal Brief filed on October 24, 2007 was accompanied by the simultaneous filing of both the present patent owner petition, and a Rebuttal Brief in compliance with the page and word count limitations of 37 CFR 1.943(c). Although the Office is granting the relief requested by petitioner with respect to giving petitioner patent owner leave to submit a rebuttal brief including 131 pages and 39,146 words, the acceptance of the October 24, 2007 Supplemental Rebuttal Brief for entry into the active IFW record is conditioned **upon the presumption that the patent owner is substituting, via the attachment to the petition, the Supplemental Rebuttal Brief for the concurrently filed Rebuttal Brief. It otherwise appears that the Rebuttal Brief complies with the page and word count provisions of 37 CFR 1.943(c) such that it would be enterable into the record of the present merged reexamination proceeding as a matter of right (assuming that it otherwise complies with 37 CFR 41.77 and MPEP § 2678).** In the interest of special dispatch, the undersigned will engage in that presumption, and grant the entry of the October 24, 2007 Supplemental Rebuttal Brief into the active IFW record on an interim basis. **In the event that petitioner does not accept the substitution of the October 24, 2007 Supplemental Rebuttal Brief as a replacement for the Rebuttal Brief filed on October 24, 2007, petitioner patent owner must file a paper so stating within 15 DAYS of the mailing date of this decision. If such a paper is not filed, the presumption will become final, and the October 24, 2007 Supplemental Rebuttal Brief will become the sole patent owner's rebuttal brief entered into the active IFW record in this merged reexamination proceeding.**

(2) The acceptance of the Supplemental Rebuttal Brief filed on October 24, 2007 into the active record is also predicated upon a determination by the Primary Examiner that it complies with all of the provisions governing the filing of an appellants' rebuttal brief as set forth in 37 CFR 41.71, and the corresponding practice provisions in MPEP § 2678. Stated differently, even if the presumption that the Supplemental Rebuttal Brief filed on October 24, 2007 replaces the October 24, 2007 Rebuttal Brief is confirmed by patent owner or otherwise becomes final, the Supplemental Rebuttal Brief will not be entered into the active IFW record unless it complies with the rules and practice pertaining to an appellant's rebuttal brief that is filed in an *inter partes* reexamination proceeding.

## CONCLUSION

1. The petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(c) is granted to the extent that the page limit for the appellant's rebuttal brief is extended to not exceed 131 pages or 39,146 words in length.

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[2] See *Rules to Implement Optional Inter Partes Reexamination Proceedings*, 65 FR 18154 (April 6, 2000) (Notice of Proposed Rule Making), at page 18160 - "These numbers of pages are in line with procedural rules of the Federal Courts; see for example Rule 32(a)(7)(A) of the Federal Rules of Appellate Procedure or Rule 33 of the Rules of the Supreme Court of the United States (Practice & Procedure). "

2. It has been presumed that the patent owner is substituting, via the relief requested in the present petition, the Supplemental Rebuttal Brief filed on October 24, 2007 for the Rebuttal Brief that was also filed on October 24, 2007. In the event that this presumption is incorrect, petitioner patent owner must file a notification paper so stating within 15 DAYS of the mailing date of this decision. If such a notification paper is not filed, the presumption will become final, the Supplemental Rebuttal Brief filed on October 24, 2007 will become the sole patent owner's rebuttal brief entered into the active IFW record of this merged reexamination proceeding, and the concurrently filed Rebuttal Brief will sealed by marking it "closed" and "non-public" in the IFW. The sealed Rebuttal Brief will not be part of the active record in this merged proceeding.

3. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit to await the filing of any party papers, and to process any and all party papers at the point where there is no further time remaining for filing such papers.

4. After the Central Reexamination Unit has processed the Supplemental Rebuttal Brief and all party papers, or there are no such papers and the time for filing same has expired, [3] jurisdiction will be transferred to the Primary Examiner for appropriate action on the proceeding. Such action shall begin with a review of the Supplemental Rebuttal Brief filed on October 24, 2007 for compliance with the applicable regulations and examining practice.

5. Telephone inquiries with regard to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or, in his absence, to the undersigned at (571) 272-7710.

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

sm
November 1, 2007

[3] In this instance, if no patent owner paper is received within 15 days of the mailing of this decision, the CRU should ensure that the proceeding is processed to reflect the substitution of the "Supplemental Rebuttal Brief" filed October 24, 2007 for the October 24, 2007 Rebuttal Brief, and mark the latter "closed" and "non-public."

UNITED STATES PATENT AND TRADEMARK OFFICE

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

11/7/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

NOVAK DRUCE & QUIGG, LLP
1300 EYE STREET NW
400 EAST TOWER
WASHINGTON, DC 20005

## *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/006495 + 95/000,020
PATENT NO. 6,317,592
ART UNI 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 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

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. |
|---|---|---|---|---|
| 90/006,495 | 12/26/2002 | 6317592 | | 9470 |

803 7590 11/07/2007

STURM & FIX LLP
206 SIXTH AVENUE
SUITE 1213
DES MOINES, IA 50309-4076

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 11/07/2007

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
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MAILED

NOV 07 2007

CENTRAL REEXAMINATION UNIT

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/006,495
Filed: December 26, 2002
For: U.S. Patent No. 6,317,592

*In re Campana, Jr. et al*
*Inter Partes* Reexamination Proceeding
Control No.: 95/000,020
Filed: May 29, 2003
For: U.S. Patent No. 6,317,592

**DECISION DISMISSING PETITION**

This is a decision on the October 17, 2007 patent owner petition entitled "ORIGINAL PETITION PURSUANT TO 37 CFR § 1.181 IN RESPONSE TO STATEMENTS MADE IN THE EXAMINER ANSWER TO ENTER INTO THE RECORD FOR APPEAL EVIDENCE AGAINST THE AUTHENTICITY OF THE TELENOR DOCUMENTS"

The petition and the above-captioned merged reexamination proceedings are before the Office of Patent Legal Administration for consideration.

**Summary:** The petition is granted to the extent that the petition has been considered. For the reasons set forth below, the relief requested by petitioner patent owner is dismissed.

**PETITION FEE**

The petition is being considered pursuant to 37 CFR 1.183 to waive the provisions of 37 CFR 41.63 and/or 37 CFR 41.71 in order to permit the filing and entry of additional new or non-admitted evidence, or an affidavit or other evidence at this stage of proceedings. A $400.00 petition fee has been charged to Deposit Account No. 50-0206 as authorized by petitioner patent owner at page 14 of the present petition.

## REVIEW OF SALIENT FACTS

1. U.S Patent number 6,317,592 ("the '592 patent") issued to Campana *et al* on November 13, 2001 from an application filed on December 6, 1999.

2. On December 26, 2002, a Director Initiated Order for Reexamination of the '592 patent was mailed, and the resulting *ex parte* reexamination proceeding was assigned control number 90/006,495 ("the '495 reexamination proceeding").

3. On May 29, 2003, a request for *inter partes* reexamination of the '592 patent was filed by a third party requester, and assigned control number 95/000,020 ("the '020 reexamination proceeding").

4. On August 26, 2003, the examiner's Order Granting *Inter Partes* Reexamination for the '020 reexamination proceeding was mailed.

5. On August 9, 2004, the Office issued a decision *sua sponte* merging the '495 reexamination proceeding and the '020 reexamination proceeding into a single combined reexamination proceeding ("the merged reexamination proceeding").

6. The August 9, 2004 decision merging the proceedings set forth that the merged reexamination proceeding would be conducted in accordance with 37 CFR 1.982, *i.e.*, in accordance with the regulations governing the prosecution of an *inter partes* reexamination proceeding.

7. On May 12, 2006, the patent owner filed papers which included copies of materials obtained as a result of a FOIA request, and a number of verified statements directed to the issue of the authenticity of the so-called "Telenor documents" that have been relied upon (applied) as prior art in the merged reexamination proceeding, together with a petition for entry of these papers.

8. On September 13, 2006, a Decision Dismissing Petition was mailed that dismissed the May 12, 2006 petition, "returned" the papers that were filed on May 12, 2006, [1] and invited petitioner to resubmit the May 12, 2006 papers by filing the FOIA material and the material directed to substantive patentability issues separately in accordance with 37 CFR 1.3 and 1.4(c).

9. Patent owner did not file a request for reconsideration of the September 13, 2006 Decision dismissing the May 12, 2006 petition on or before November 13, 2006, as required by 37 CFR 1.181(f).

10. On December 12, 2006, the Office issued a Right of Appeal Notice ("RAN") for the merged reexamination proceeding.

11. On January 3, 2007, the patent owner filed a Notice of Appeal together with authorization to charge patent owner's deposit account for the $500.00 appeal fee.

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[1] The papers were "returned" by being marked as "closed" and "non-public" in the Image File Wrapper (IFW) because papers that have been scanned into the IFW cannot be removed from the IFW. Such papers are not part of the active record in the IFW.

12. Also on January 3, 2007, the patent owner filed a petition requesting entry into the record of a redacted version of the material filed on May 12, 2006, which did not include the FOIA material and was limited to the material directed to the authenticity of the Telenor documents.

13. On February 5, 2007, patent owner filed a Petition for Reconsideration of the September 13, 2006 Decision Dismissing Petition, facially requesting that all of the material filed on May 12, 2006, including the documents directed to the authenticity of the Telenor documents, be entered into the record.

14. On March 5, 2007, patent owner timely filed an appellant's brief.

15. On March 15, 2007, a decision designated as a final agency action under 5 U.S.C. § 704 was mailed denying the underlying relief requested in patent owner's February 5, 2007 petition for reconsideration, so that the documents directed to the authenticity of the Telenor documents, was not entered into the record.

16. On March 30, 2007, a decision designated as a final agency action under 5 U.S.C. § 704 was mailed denying the January 3, 2007 patent owner petition.

17. On May 30, 2007, patent owner filed a petition paper ostensibly as a request for reconsider of the March 30, 2007 or, alternatively, as an original petition, to obtain entry of the materials directed to the Telenor documents.

18. On July 2, 2007, a decision designated as a final agency action under 5 U.S.C. § 704 was mailed denying the May 30, 2007 patent owner request for reconsideration.

19. On August 20, 2007 and August 24, 2007, an examiner's answer was mailed. [2]

20. On September 21, 2007, patent owner was granted an extension of time until October 24, 2007, to file a rebuttal brief responsive to the examiner's answer.

21. On October 17, 2007, patent owner filed the present petition.

## DECISION

I. Relevant Authority

37 CFR 41.63 provides:

> "(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).

[2] It appears that the August 20, 2007 Examiner's Answer was mailed without additional signatures of two appeal conferees. The August 24, 2007Examiner's Answer bears the signatures of two appeal conferees.

37 CFR 41.71 provides, in part:

"(a) Within one month of the examiner's answer, any appellant may once file a rebuttal brief.
(b) (1)The rebuttal brief of the owner may be directed to the examiner's answer and/or any respondent brief.
(2)The rebuttal brief of the owner shall not include any new or non-admitted amendment, or an affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63 for amendments, affidavits or other evidence filed after the date of filing the appeal."

MPEP § 2678 provides, in part:

"After the examiner's answer, only a rebuttal brief (or an amended rebuttal brief, where appellant is given one opportunity to correct a defective original rebuttal brief (MPEP § 2679)) will be received into the reexamination proceeding. No other submission will be considered, and any such other submission will be returned as an improper paper. 37 CFR 1.939."

## II. Background

Patent owner is involved in multiple reexamination proceedings directed to a number of related patents. In the course of these proceedings, a reference (hereinafter referred to as "the Telenor documents") was applied as prior art against the patent claims in the multiple reexamination proceedings. Patent owner has contested the prior art status of the Telenor documents, and has taken the position that it is unclear that the Telenor documents as relied upon by the Office are even authentic documents that have not been tampered with.

In support of the position taken on the authenticity of the Telenor documents, patent owner has filed a verified statement by a document examiner, and certain supporting documents related to the chain of custody of the Telenor documents that patent owner submitted to the document examiner for analysis. The verified statement and supporting documents have been refused entry in the present merged proceeding, although they have been entered in others of the reexamination proceedings. The refusal to enter the rebuttal documents in the present merged reexamination proceeding was on procedural grounds, and been repeated the subject of three petition decisions that have been designated as final agency decisions under 5 U.S.C. § 704 and are of record in the present merged reexamination proceeding. [3]

## III. Analysis and Findings

Patent owner now seeks entry of the evidence attacking the authenticity of the Telenor documents yet again. Patent owner has requested that this petition be decided under 37 CFR 1.181, or 37 CFR 1.182, or 37 CFR 1.183, or 37 CFR 41.64(d) (*sic*, 41.64(b)). It does not appear that the petition sets forth a request for supervisory direction of the examiner under 37 CFR 1.181. 37 CFR 1.182 is inapplicable because the regulations specifically address (*i.e.*, provide for) the present situation by precluding entry of the requested material as a matter of procedure. It would appear, however, that the present petition may properly be construed to request waiver of the provisions of the regulations, specifically 37 CFR 41.63 and/or 37 CFR 41.71. [4] The

[3] Decision Denying Petition, March 15, 2007; Decision Denying Petition, March 30, 2007; Decision Denying Petition and Returning Nonenterable Papers, dated July 2, 2007.

[4] To the extent that the petition might be viewed as requesting waiver of the regulations that have been previously cited as precluding entry of the Telenor documents (as in the three decisions cited in footnote 3), the Office will not

petition will be treated as a requesting relief that requires waiver of the provisions of 37 CFR 41.63 and/or 37 CFR 41.71, as well as the waiver of any other regulation that is necessary, for entry of the material itemized at page 7 of the present petition.

Patent owner's rationale for again requesting waiver of the rules to permit patent owner to enter into evidence material that addresses the authenticity of the Telenor documents that patent owner has previously been filed, but which has been refused entry into the record, is that on pages 230-231 of the examiner's answer dated August 24, 2007, the examiner has allegedly included an assertion that the patent owner "'has not proffered evidence to support arguments' that the Telenor documents relied upon by the Office in rejecting the claims of the '592 patent have been altered in any way." [5] Patent owner argues that patent owner has been prejudiced by the examiner's language because the language in question is inaccurate, inasmuch as patent owner did file (*i.e.*, proffer) evidence directed to the authenticity of the Telenor documents, (although such evidence has not been entered into the record). [6] Patent owner further argues that patent owner has been prejudiced because the examiner is relying upon the alleged failure to proffer evidence as support for the examiner's conclusion that certain statements appearing in an email by one Torv Aursoy (hereinafter "the Aursoy statement") are reliable even if they are deemed to be hearsay. [7] Patent owner states that patent owner is not attempting to reargue the merits of the previous petition decisions that refused entry of the evidence attacking the Telenor documents. [8] Instead, patent owner argues that the examiner's statements that are alleged to be inaccurate and prejudicial provide an independent basis for supplementing the record by entering the evidence relating to the authenticity of the Telenor documents into the record that was previously excluded, for purposes of addressing the examiner's position regarding the Aursoy statement. Patent owner also argues that due process and fundamental fairness also require entry of the previously excluded evidence relating to the Telenor documents.

A review of the examiner's answer, particularly at pages 230-231, shows that the examiner's position is not as characterized by the partial quotation that appears on page 1 of the present patent owner petition. [9] Rather, the examiner's language regarding the failure of patent owner "to proffer any evidence" was made solely in the context of the patent owner's failure to proffer evidence rebutting the truthfulness of the assertions in the Aursoy statement. Patent owner alleges the Aursoy statement is unreliable because it is hearsay, and that patent owner has in fact proffered evidence to so demonstrate. However, throughout the detailed argument at pages 9-14 of the present petition, patent owner appears to confuse the issue of whether patent

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revisit those final agency decisions yet again. 37 CFR 41.64(d) does not exist, but to the extent that petitioner may have intended to petition for waiver of 37 CFR 41.64(b), it is noted that 37 CFR 41.64 is not involved here since jurisdiction has not passed to the Board of Patent Appeals and interferences. 37 CFR 41.63 precludes the entry of evidence after the filing of a notice of appeal and prior to a decision on the appeal, while 37 CFR 41.71 precludes the rebuttal brief of a patent owner in an *inter partes* reexamination proceeding from including any new or non-admitted amendment, or an affidavit or other evidence. Inasmuch as the present merged proceeding is being conducted under the *inter partes* statutes, regulations and practice, (see: Decision, *Sua Sponte*, Merging *Ex Parte* and *Inter Partes* Reexamination Proceedings, at page 4), 37 CFR 41.63 and/or 37 CFR 41.71 would preclude entry of any affidavit or other evidence at this stage of the present merged proceeding. Accordingly, the relief requested by petitioner would require waiver of the provisions of 37 CFR 41.63 and/or 37 CFR 41.71.

[5] Note is taken that only the language in the single quotation marks appears in what the examiner wrote. The language in the double quotation marks appears at page 1 of the present patent owner petition and includes language not appearing in the examiner's answer.

[6] See page 2 of the present patent owner petition.

[7] *Id.*

[8] See page 10 of the present patent owner petition.

[9] See footnote 5; only the words "has not proffered evidence" are the examiner's words.

owner submitted evidence challenging the authenticity of the Telenor documents with the issue of whether patent owner has submitted (*i.e.*, "proffered") evidence to rebut the truthfulness of the Aursoy statement. The Aursoy statement is an email in which an unverified statement is made regarding the receipt and cataloguing of the Telenor documents in a library in Trodheim, Norway. [10] The Aursoy statement is relied upon by the examiner to establish the status of the Telenor documents as a printed publication having a definite publication date. [11] On the other hand, the evidence directed to the authenticity of the Telenor documents relates to a verified statement and a supporting report by a forensics document expert in which the expert expresses an opinion on the authenticity of the Telenor documents. The evidence regarding authenticity of the Telenor documents also includes "chain of custody" verified statements regarding the Telenor documents that were analyzed by the expert.

As reproduced on page 11 of the petition, the language at pages 230-231 of the examiner's answer states only that patent owner has not proffered evidence rebutting the truthfulness of the Aursoy statement. Again, the Aursoy statement relates to receipt and cataloging of the Telenor documents in a library in Norway, and is relied upon in support of those documents being a printed publication and obtaining that status as of a given date. The examiner's answer, at pages 230-231, states that patent owner was free to investigate the truthfulness of the allegedly hearsay statements in the Aursoy email and to present evidence to rebut them, but had failed to present such evidence. The language that appears at pages 230-231 of the examiner's answer is not a statement that patent owner has not proffered evidence that is directed to the authenticity of the Telenor documents. The examiner's answer does not state or imply that patent owner did not investigate the hearsay nature of the Aursoy statement. The examiner's answer does not imply that patent owner did not proffer evidence regarding the authenticity of the Telenor documents. The examiner's answer states only that patent owner submitted no evidence (as opposed to comments in the nature of argument) directed to rebutting the truthfulness of the Aursoy statement. The examiner's answer is most certainly is not a general allegation that patent owner has never proffered any evidence that the Telenor documents have been altered in any way, as characterized on the page 1 of the instant petition.

On the other hand, inspection of the evidence proffered by patent owner that has been refused entry into the record of this merged reexamination proceeding (for the reasons set forth in the decisions cited in footnote 3) shows that patent owner has proffered evidence including (1) a verified statement by a documents expert that does not specifically address the Aursoy statement, and (2) verified statements by various individuals that pertain to the chain of custody of the material obtained by patent owner that was submitted to the documents expert for examination. The excluded evidence proffered by patent owner also includes a verified statement establishing that an inquiry on behalf of patent owner was directed to the university library that houses the Telenor documents, that the inquiry was directed to ascertaining the "checkout history" of those documents, and an inquiry into the procedures utilized in the library, (if any), for ascertaining whether materials returned to the library were returned in the same condition in which they had been checked out was also made. [12] Patent owner's

[10] The Aursoy email was made of record on January 10, 2006.

[11] Examiner's answer, pages 230-231.

[12] On page 7 of the present patent owner petition, Patent owner lists the evidence previously submitted regarding the authenticity of the Telenor documents. In addition to the items mentioned, the list includes Patent Owner's Supplemental Comments to the Action Closing Prosecution." Obviously, comments are not "evidence," and the examiner's quoted statement cannot be read to be inclusive of such proffered, but non-entered, comments. It is noted that patent owner has not pointed to any paper filed by patent owner, entered or not, in which evidence (not comments/arguments) was specifically directed to rebutting the truthfulness of the allegedly hearsay Aursoy statement, as opposed to the rebutting the authenticity of the Telenor documents.

argument that a statement in the examiner's answer that is directed to a failure to proffer rebuttal evidence on the issue of the truthfulness of the Aursoy statement that is being relied upon to establish a date or receipt and the cataloging of the Telenor documents somehow warrants entry into the record of evidence that is directed to the entirely different issue of whether the Telenor documents are authentic and unaltered documents is simply not persuasive. Further, there are three final agency decisions refusing entry (on procedural grounds) of the evidence that was directed to the authenticity of the Telenor documents in the active record present in the active record. Although the evidence directed to the authenticity of the Telenor documents has been excluded from the active record, no reasonable person could conclude that patent owner has failed to proffer evidence in respect to the authenticity of the Telenor documents.

It is also to be noted that with respect to the issue of the truthfulness of the Aursoy statement, notwithstanding that it is allegedly hearsay evidence, patent owner filed a paper entitled "Response To Office Action/Comments By Patent Owner under 37 CFR 1.951" on March 1, 2006. That paper included comments that are directed to the truthfulness of the Aursoy email statement, and such comments are of record. However, as noted, *supra*, comments are not evidence. Patent owner has not pointed to any paper in which patent owner submitted evidence (as opposed to comments/arguments) that is specific to the issue of the truthfulness of the allegedly hearsay statements in the Aursoy statement. Thus it does not appear that the examiner's position is technically inaccurate with respect to the failure of patent owner to submit "evidence" directed to rebutting the Aursoy email statement. However, to the extent that patent owner believes such comments/arguments to fit within the language at pages 230-231 of the examiner's answer as being "evidence," it would appear that no reasonable person could be prejudiced by that statement since the record clearly shows that patent owner in fact submitted such comments. Therefore, petitioner patent owner has not demonstrated that patent owner has been prejudiced by the language at pages 230-231 of the examiner's answer so as to warrant entry of any excluded evidence that was directed to the truthfulness of the statements contained in the Aursoy email.

There is an additional reason why patent owner's petition fails to demonstrate that the language in the examiner's answer prejudices patent owner's position and thereby warrants entry of the excluded evidence directed to the truthfulness of the Aursoy statement. The present merged reexamination proceeding is at the appeal stage. It would appear that patent owner may, or may not, prevail on the merits of the appeal. To the extent that the truthfulness of the Aursoy statement is ultimately accepted because, as argued by the examiner, there is a lack of evidence in the record that shows that the statement Aursoy is not truthful, it is immaterial whether evidence showing that the statement was not truthful was proffered by patent owner or not. It is the absence of such evidence, not the reason why the evidence is absent, that would have been the determinant for the acceptance of the truthfulness of the Aursoy statement. The examiner's characterization of the reason why such evidence is not in the record is unimportant with respect to whether such evidence is, or is not in the record, and if it is in the record, whether such evidence establishes patent owner's position, or not.

Finally, the Brundidge declaration attached to the present petition has been considered, but does not mandate the relief requested by petitioner patent owner. In the context of the overall circumstances in which multiple related patents owned by patent owner were being reexamined in a plurality of reexamination proceedings (each directed to one of the patents), the alleged position attributed by declarant to Ms. Lissi Marquis (the Director of the Central Reexamination Unit) and Mr. Mark Reinhart (a Special Program Examiner in the Central

Reexamination Unit) cannot be taken to mean that evidence submitted for entry into the record of a given reexamination proceeding would be entered into the record of another reexamination proceeding notwithstanding the failure of patent owner to file the evidence in that proceeding in accordance with the applicable regulations. Further, the alleged position attributed to Ms. Marquis and Mr. Reinhart cannot be taken to apply to comments in the nature of argument (as opposed to evidence), particularly if such comments are untimely filed. In this instance, patent owner's March 1, 2006 comments regarding the truthfulness of the Aursoy email statement have already been entered into the record. Patent owner has not explained what other comments or evidence on that specific issue have previously been proffered and excluded from the record, why patent owner is entitled to have such entered notwithstanding that the have been previously excluded, or why presentation of new comments/evidence on that specific issue should be entered at this late point in the merged reexamination proceeding.

In summary, it appears to be the fact that the proffer of evidence directed to the authenticity of the Telenor documents was repeatedly defective and was also, in one instance, untimely. The result is that such evidence has been excluded from the record. Patent owner has not convincingly established why it should be permitted to recover from the effects of patent owner's failure to have that evidence entered into the record, by arguing prejudice based upon the examiner's characterization of why the record does not contain evidence directed to the entirely different issue of the truthfulness of the Aursoy statement. There is, in fact, no evidence in the record (as opposed to comments in the nature of argument) that specifically bears upon the truthfulness of the allegedly hearsay statements in the Aursoy email. The examiner's characterization of why evidence on that is absent from the record is irrelevant to the outcome that might result based on the absence of such evidence. Petitioner patent owner has not established any basis for holding that the language at page 230-231 in any way prejudices petitioner's appeal so as to warrant the requested relief.

## CONCLUSION

1. The October 17, 2007 patent owner petition is dismissed.

2. Jurisdiction of the merged reexamination proceeding is being retained in the Office of Patent Legal Administration to render a decision on the patent owner petition filed on October 24, 2007 that requests suspension of the page and word count limits to permit entry of a Supplemental Rebuttal Brief that has been filed simultaneously with patent owner's Rebuttal Brief. Thereafter, jurisdiction will be returned to the Central Reexamination Unit for appropriate action.

3. Telephone inquiries with regard to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or, in his absence, to the undersigned at (571) 272-7710.

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

sm
October 30, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

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JAN 29 2008

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*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/006,495
Filed: December 26, 2002
For: U.S. Patent No. 6,317,592

*In re Campana, Jr. et al*
*Inter Partes* Reexamination Proceeding
Control No.: 95/000,020
Filed: May 29, 2003
For: U.S. Patent No. 6,317,592

**DECISION DISMISSING PETITION**

This is a decision on the December 10, 2007 patent owner petition entitled "PETITION PURSUANT TO 37 CFR § 1.181, § 1.182 AND § 1.183 TO WITHDRAW THE NOTIFICATION REGARDING DEFECTIVE REBUTTAL BRIEF DATED NOVEMBER 9, 2007."

The petition and the above-captioned merged reexamination proceedings is before the Director of the Central Reexamination Unit, and is being treated as a request for the exercise of the USPTO Director's supervisory authority as delegated to the undersigned.

**Summary:** The petition is dismissed.

## PETITION FEE

The relief requested is considered to be relief pursuant to 37 CFR 1.181. No fee is required for a petition filed pursuant to 37 CFR 1.181. Accordingly, a refund of the petition fee of $400.00 that has been charged to Deposit Account No. 50-0206 will be scheduled in due course.

## REVIEW OF SALIENT FACTS

1. U.S Patent number 6,317,592 ("the '592 patent") issued to Campana *et al* on November 13, 2001 from an application filed on December 6, 1999.

2. On December 26, 2002, a Director Initiated Order for Reexamination of the '592 patent was mailed, and the resulting *ex parte* reexamination proceeding was assigned control number 90/006,495 ("the '495 reexamination proceeding").

3. On May 29, 2003, a request for *inter partes* reexamination of the '592 patent was filed by a third party requester, and assigned control number 95/000,020 ("the '020 reexamination proceeding").

4. On August 26, 2003, the examiner's Order Granting *Inter Partes* Reexamination for the '020 reexamination proceeding was mailed.

5. On August 9, 2004, the Office issued a decision *sua sponte* merging the '495 reexamination proceeding and the '020 reexamination proceeding into a single combined reexamination proceeding ("the merged reexamination proceeding").

6. The August 9, 2004 decision merging the proceedings set forth that the merged reexamination proceeding would be conducted in accordance with 37 CFR 1.982, *i.e.*, in accordance with the regulations governing the prosecution of an *inter partes* reexamination proceeding.

7. On May 12, 2006, the patent owner filed papers which included copies of materials obtained as a result of a FOIA request, and a number of verified statements directed to the issue of the authenticity of the so-called "Telenor documents" that have been relied upon (applied) as prior art in the merged reexamination proceeding, together with a petition for entry of these papers.

8. On September 13, 2006, a Decision Dismissing Petition was mailed that dismissed the May 12, 2006 petition, "returned" the papers that were filed on May 12, 2006, [1] and invited petitioner to resubmit the May 12, 2006 papers by filing the FOIA material and the material directed to substantive patentability issues separately in accordance with 37 CFR 1.3 and 1.4(c).

9. Patent owner did not file a request for reconsideration of the September 13, 2006 Decision dismissing the May 12, 2006 petition on or before November 13, 2006, as required by 37 CFR 1.181(f).

10. On December 12, 2006, the Office issued a Right of Appeal Notice ("RAN") for the merged reexamination proceeding.

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[1] The papers were "returned" by being marked as "closed" and "non-public" in the Image File Wrapper (IFW) because papers that have been scanned into the IFW cannot be removed from the IFW. Such papers are not part of the active record in the IFW.

11. On January 3, 2007, the patent owner filed a Notice of Appeal together with authorization to charge patent owner's deposit account for the $500.00 appeal fee.

12. Also on January 3, 2007, the patent owner filed a petition requesting entry into the record of a redacted version of the material filed on May 12, 2006, which did not include the FOIA material and was limited to the material directed to the authenticity of the Telenor documents.

13. On February 5, 2007, patent owner filed a Petition for Reconsideration of the September 13, 2006 Decision Dismissing Petition, facially requesting that all of the material filed on May 12, 2006, including the documents directed to the authenticity of the Telenor documents, be entered into the record.

14. On March 5, 2007, patent owner timely filed an appellant's brief and evidence appendix.

15. On March 15, 2007, a decision designated as a final agency action under 5 U.S.C. § 704 was mailed denying the underlying relief requested in patent owner's February 5, 2007 petition for reconsideration, so that the documents directed to the authenticity of the Telenor documents, was not entered into the record.

16. On April 4, 2007, patent owner filed a substitute appeal brief after obtaining an expansion of the page and word count limitations imposed by the rules.

17. On March 30, 2007, a decision designated as a final agency action under 5 U.S.C. § 704 were mailed denying the January 3, 2007 patent owner petition.

18. On May 30, 2007, patent owner filed a petition paper ostensibly as a request for reconsider of the March 30, 2007 or, alternatively, as an original petition, to obtain entry of the materials directed to the Telenor documents.

19. On July 2, 2007, a decision designated as a final agency action under 5 U.S.C. § 704 was mailed denying the May 30, 2007 patent owner request for reconsideration.

20. On July 11, 2007, a Notice was mailed informing patent owner that the appeal brief filed on March 5, 2007 was not in compliance with the rules.

21 On August 7, 2007, patent owner filed redacted versions of the appealed brief and evidence appendix that replaced the unredacted versions filed on April 4, 2007.

22. On August 20, 2007 and August 24, 2007, an examiner's answer was mailed. [2]

23. On September 21, 2007, patent owner was granted an extension of time until October 24, 2007, to file a rebuttal brief responsive to the examiner's answer.

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[2] It appears that the August 20, 2007 Examiner's Answer was mailed without additional signatures of two appeal conferees. The August 24, 2007 Examiner's Answer bears the signatures of two appeal conferees.

24. On October 17, 2007, patent owner filed a petition to obtain entry into the record of certain evidence alleged to establish that the so-called Telenor documents that have been applied as a prior art reference have been altered.

25. On October 24, 2007, patent owner filed a rebuttal brief and a supplemental rebuttal brief.

26. On November 7, 2007, the October 17, 2007 patent owner petition was dismissed.

27. On November 9, 2007, a Notification was mailed informing patent owner that the supplemental rebuttal brief filed on October 24, 2007 was defective on the grounds that it was deemed to raise issues that were not present in the examiner's answer as to whether patent owner had proffered evidence that the Telenor documents had been altered.

28. On December 10, 2007, (a Monday), patent owner timely filed a redacted version of the October 24, 2007 supplemental rebuttal brief, in which the material objected to in the November 9, 2007 Notification was redacted.

29. On December 14, 2007, patent owner was notified that jurisdiction of the appeal was transferred to the Board of Patent Appeals and Interferences (BPAI), and that the December 10, 2007 redacted supplemental rebuttal brief was part of the appeal record.

30. On December 10, 2007, patent owner filed the present petition.

## DECISION

### I. Relevant Authority

37 CFR 41.71 provides, in part:

> "(a) Within one month of the examiner's answer, any appellant may once file a rebuttal brief.
> (b) (1)The rebuttal brief of the owner may be directed to the examiner's answer and/or any respondent brief.
> (2)The rebuttal brief of the owner shall not include any new or non-admitted amendment, or an affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63 for amendments, affidavits or other evidence filed after the date of filing the appeal."

MPEP § 2678 provides, in part:

> "The rebuttal brief must (A) clearly identify each issue, and (B) point out where the issue was raised in the examiner's answer and/or in the respondent brief. In addition, the rebuttal brief must be limited to issues raised in the examiner's answer or in any respondent brief. A rebuttal brief will not be entered if it does not clearly identify each issue and/or is not limited to issues raised in the examiner's answer or in any respondent brief. Such a rebuttal brief will remain in the file, but it will not be addressed nor considered, except to inform the appropriate party that it was not entered and why.."

## II. Background

Patent owner is involved in multiple reexamination proceedings directed to a number of related patents. In the course of these proceedings, a reference (hereinafter referred to as "the Telenor documents") was applied as prior art against the patent claims in the multiple reexamination proceedings. Patent owner has contested the prior art status of the Telenor documents, by taking the position that it is unclear that the Telenor documents as relied upon by the Office are authentic documents that have not been tampered with.

In support of the position taken on the authenticity of the Telenor documents, patent owner filed a verified statement by a documents examiner, and certain supporting documents related to the chain of custody of the Telenor documents that patent owner submitted to the documents examiner for analysis. The verified statement and supporting documents had been refused entry in the present merged proceeding, although they have been entered in others of the reexamination proceedings. The refusal to enter the rebuttal documents in the present merged reexamination proceeding was on procedural grounds, and has been the subject of three petition decisions that have been designated as final agency decisions under 5 U.S.C. § 704 and are of record in the present merged reexamination proceeding. [3]

In the course of prosecution, the merged reexamination proceeding entered the appeal stage. As part of the appeal process, on April 4, 2007, patent owner filed an appeal brief containing an evidence appendix as required by 37 CFR 41.67. [4] However, patent owner was thereafter notified by the examiner that the expanded appeal brief and evidence appendix filed on April 4, 2007 did not comply with 37 CFR 41.67 because certain supplemental declarations referred to were not entered into the record, and because the appeal brief did not identify where in the record such declarations were found. Patent owner thereafter filed redacted versions of the appeal brief and the evidence appendix on August 7, 2007. The redacted appeal brief, at pages 45-48, merely argued that the Telenor documents were not printed publications for purposes of 35 U.S.C. § 102 and that the Office had not supported its position that these documents did constitute printed publications with any evidence. These arguments were addressed at pages 230-231 in the examiner's answer, wherein the examiner noted that the record contained an email authored by one Tove Aursoy, the Coordinator of Library Catalogs at the NTNU library. The statements in the Aursoy email explain when the Telenor documents were received and catalogued.

On October 24, 2007, patent owner filed a rebuttal brief and a supplemental rebuttal brief together with a petition to suspend the page and word count limitation imposed by 37 CFR 1.943. The petition was granted, and therefore the supplemental rebuttal brief was entered into the record. However, on November 9, 2007, following the November 7, 2007 decision that dismissed the patent owner's October 17, 2007 petition to have the evidence directed to the authenticity of the Telenor documents entered, the examiner mailed a Notification to patent owner holding that the supplemental rebuttal brief was defective and setting a

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[3] Decision Denying Petition, March 15, 2007; Decision Denying Petition, March 30, 2007; Decision Denying Petition and Returning Nonenterable Papers, dated July 2, 2007.

[4] This appeal brief was filed because patent owner had obtained an increase in the page and word count limitations imposed on appeal briefs by 37 CFR 1.943.

period in which to file an amended rebuttal brief. The holding was based upon the examiner's position that the supplemental rebuttal brief went addressed issues that were not present in the examiner's answer regarding whether or not patent owner proffered evidence directed to the authenticity of the Telenor documents. Patent owner timely filed a redacted version of the rebuttal brief concurrently with the present petition. [5]

III. Analysis and Findings

a. Patent Owner's Position

Patent owner's rationale for requesting relief in the form of being permitted to proceed with its unredacted supplemental rebuttal brief is that patent owner should, in fairness, be entitled to submit any argument addressing why the Aursoy statement "does not reliably establish the publication date of the Telenor art, and therefore that the Patent Office has failed to carry its burden of proof." [6] Patent owner appears to believe that the examiner's comments that the statements in the Aursoy email are accurate and reliable, even if hearsay, because patent owner has not proffered proof that such statements are not accurate and reliable, are prejudicial. Patent owner believes that it has proffered proof that the Telenor documents are not authentic, and cannot, therefore, be applied as prior art. Patent owner disputes that the examiner's answer was directed solely to the truthfulness of the Aursoy, because the examiner's answer also "plainly references the "accuracy" and "reliability" of the statements in the Aursoy email. Stated differently, patent owner alleges that because the examiner has relied on the Aursoy statement to prove the publication date of the Telenor documents, the patent owner's proffer of evidence that purportedly goes to whether the Telenor documents have been altered clearly constitutes evidence that the Aursoy email statement is not accurate or reliable. Patent owner's theory is that "if the (Telenor) art has been altered, the Aursoy statement is not a truthful statement of the publication date of the art currently relied upon to reject the patent" in this merged proceeding. [7] Patent owner opines that the examiner is micro-managing the content of patent owner's rebuttal brief, and that "[D]ue process and fundamental fairness require that the Patent Owner be granted "reasonable latitude fashion its legal arguments that address and counter assertions in the Examiner's Answer that Patent Owner failed to proffer any evidence challenging the truthfulness, accuracy and reliability of the Aursoy hearsay statements. [8] Patent owner also relies on the following quotation from the examiner's answer: *"Here, there is nothing on the face of the Aursoy statements to suggest that information has been altered in any way or that the statements lacked accuracy and reliability. Furthermore, Appellant has not proffered evidence to the contrary."* {Emphasis in the original.] [9]

b. The Patent Owner's Position Is Wholly Unpersuasive

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[5] It is noted that in order to comply with the Notification that the supplemental rebuttal brief filed on October 24, 2007 was defective, patent owner filed a redacted supplemental reply brief on December 10, 2007. Jurisdiction of the appeal was thereafter transferred to the BPAI. Jurisdiction of the present patent owner petition is, however, properly with the Central Reexamination Unit, in the Office of the Deputy Commissioner for Patent Examination and Policy. See MPEP § 1000.02(c) and compare MPEP §§1000.02(f) and (g).

[6] Petition, page 3, first full paragraph.

[7] *Id.*, page 8, the last paragraph.

[8] *Id.*, page 3, the last paragraph.

[9] *Id.*, page 14, first paragraph.

A review of the record of this proceeding, including the examiner's answer, particularly at pages 230-231, and of the Aursoy document itself [10], shows that patent owner's position here is not well taken because it is based upon a co-mingling and confusion of two distinct issues.

Patent owner's contention that the examiner is relying upon the Aursoy statement to prove the date of the Telenor documents is incorrect. The Telenor documents facially include a date. On pages 230-231 of the examiner's answer dated August 24, 2007, in a section entitled "The Office's Allegation that the Telenor Documents Are Printed Publications Is Supported by Evidence," the examiner relied upon the Aursoy email to address patent owner's arguments at pages 45-48 of the amended appeal brief filed on August 7, 2007. Those arguments are that the Telenor documents are not printed publications under 35 U.S.C. § 102(b). The examiner addressed those arguments by noting in the examiner's answer that the Aursoy email includes statements regarding the receipt dates for various ones of the Telenor documents at the NTNU library in Trondheim Norway, and the date on which the Telenor documents were cataloged at that library. [11] The examiner considered that based upon the dates of receipt and cataloguing, the Telenor documents qualified as printed publications under 35 U.S.C. § 102(b). The examiner further considered that to the extent that patent owner had characterized the Aursoy statement as being unreliable because it is hearsay, the patent owner had not offered evidence **that the statements in the Aursoy email regarding the receipt and cataloguing of the Telenor documents** were not in fact facially accurate and reliable. Accordingly, the examiner concluded that **the statements in the Aursoy email regarding the receipt and cataloguing of the Telenor documents appeared to be facially accurate and reliable**. The examiner's answer also notes that the examiner considers that that although patent owner was free to investigate the truth of **the statements in the Aursoy email regarding the receipt and cataloguing of the Telenor documents**, the record did not contain any evidence submitted by patent owner directed to showing that **the statements in the Aursoy email regarding the receipt and cataloguing of the Telenor documents** were inaccurate or untrue. The examiner concluded that on the record, **the statements contained in the Aursoy email regarding the receipt and cataloguing of the Telenor document**, must, therefore, be considered to be reliable even if such statements are deemed to be hearsay. Further, the statements deemed by the examiner to be facially accurate and reliable are **statements respecting receipt and cataloging of the Telenor documents**. They are not statements regarding **the technical content of those documents**.

Thus, patent owner's position that patent owner's proffer of evidence going to the authenticity of the Telenor documents, (*i.e.*, the filing of verified statements **directed to the issue of whether the content of the Telenor documents had been (subsequently) altered so as to change the technical teachings thereof**) was an attempt by patent owner to contest the accuracy and reliability of the content of the Aursoy email, co-mingles and confuses two distinct issues. The first issue is whether an unverified statement that a document was received on a given date and then catalogued is truthful, accurate and reliable, and supports

[10] The Aursoy email was filed entered into the record as part of the third party requester comments pursuant to 37 CFR § 1.947 on January 10, 2006. The email amounts to an unverified statement regarding the receipt and cataloguing of the Telenor documents in the NTNU library in Trondheim, Norway.

[11] The Telenor documents include eight volumes, and the volumes include various dates.

that document being a printed publication as of the date that it was available to, and locatable by, interested persons of ordinary skill in the art. The second issue is whether the technical content of that document is, or is not, authentic, such that the printed publication is not a printed publication of the receipt and cataloguing dates. The two are wholly different issues.

Viewed with the distinction between the two issues discussed above in mind, it is clear that when read in context, the examiner's position in the examiner's answer that is quoted at the end of Section 3(a), *supra*, and on page 14 of the present petition, is not a basis for affording patent owner the requested relief. The quoted statement simply sets forth the examiner's position that the statements in the Aursoy email, on their face, have nothing to do with any subsequent alteration of the technical information set forth in any of the Telenor documents. Evidence alleging such an alteration simply does not provide any evidence to support a belief that statements in the Aursoy email are facially inaccurate or unreliable for the proposition for which it was offered by Aursoy. Patent owner has not proffered any evidence directed to the topics addressed by the Aursoy email, namely the receipt and cataloguing of the Telenor documents, although patent owner did offer comments on the Aursoy email in the March 1, 2006 paper entitled "Response To Office Action/Comments By Patent Owner under 37 CFR 1.951". To the extent that patent owner proffered evidence going to the authenticity of the technical content of the Telenor documents, the proffer of such evidence has nothing to do with the issue of whether the documents are *prima facie* entitled to status as a printed publication as of a particular date based upon the receipt and cataloging of such documents as set forth in the uncontradicted email statement of Tove Aursoy.

It is also to be noted that in the October 17, 2007 petition, patent owner alleged that on pages 230-231 of the examiner's answer dated August 24, 2007, the examiner had included an assertion that the patent owner "'has not proffered evidence to support arguments' that the Telenor documents relied upon by the Office in rejecting the claims of the '592 patent have been altered in any way." [12] In the present petition paper, patent owner now casts the argument in slightly different language: "[O]n pages 230-231 of the Examiner's Answer, the Patent Office asserts, among other things, that the Patent Owner 'has not proffered evidence to support arguments' that statements by Tove Aursoy are accurate and reliable." [13] Again, it is pointed out that the statements in the email of Tove Aursoy are limited to the receipt date and the subsequent cataloguing of documents. The Aursoy statements do not address the authenticity or accuracy of the technical content of the documents. The receipt date and cataloguing is material to the status of the Telenor documents as *prima facie* constituting printed publications which, if early enough in date, would in turn *prima facie* constitute prior art pursuant to 35 U.S.C. § 102 and the case law construing the statute as to what does, and does not, constitute a "printed publication." The authenticity of the technical content of the Telenor documents goes to the issue of whether the technical content of the publications is such as to be evidence of non-entitlement of an applicant or a patent owner to one or more claims due to anticipation under 35 U.S.C § 102 and/or non-obviousness under 35

[12] See page 1 of patent owner's October 17, 2007 petition. It is once again pointed out, as was done in the November 7, 2007 decision dismissing patent owner's October 17, 2007 petition, that only the language in the single quotation marks actually appears in what the examiner wrote in the August 24, 2007 examiner's answer.
[13] See page 7, first full paragraph, of the present patent owner petition paper.

U.S.C. § 103. Evidence introduced as to the latter is not evidence that is necessarily directed to the former.

On the present record, it is clear that evidence directed to the authenticity of the technical content of the Telenor documents is not material to the question of whether the Telenor documents constitute printed publications as of a given date, regardless of the content thereof. Patent owner cannot convert a proffer of evidence on authenticity of the technical content of the Telenor documents into evidence that somehow contradicts Aursoy's email statements that are limited to the issues of receipt and cataloguing of the Telenor documents, and to other library procedures not relevant here. That the record does not contain evidence that patent owner contends would show that the technical content of the printed publications were somehow altered as to their technical content after the date of the invention claimed in the patent that is the subject of the present merged reexamination proceeding, and so cannot therefore constitute prior art as to such claimed invention, is due to patent owner's unwillingness and/or inability to comply with the regulations for submitting such evidence after having been notified of how to submit such evidence within the requirements of the regulations, and having been given a period of time in which to do so. The situation cannot be remedied by converting an accurate statement by the examiner regarding the record as it pertains to the statements in the Aursoy email into a procedural error on the part of the examiner. [14]

For the foregoing reasons, it is considered that the examiner did not commit any procedural error in holding that the supplemental rebuttal brief filed on April 4, 2007 failed to comply with 37 CFR 41.71 and the practice implementing the regulation set forth in MPEP § 2679. Therefore, the examiner will not be directed to withdraw the requirement for the filing of an amended supplemental rebuttal brief that was set forth in the Notification filed on November 9, 2007.

[14] See footnote 3, *supra*.

## CONCLUSION

1. The December 10, 2007 patent owner petition is dismissed.

2. The April 4, 2007 supplemental reply brief (and the confirmation copy thereof filed on June 7, 2007) have been sealed by being marked "closed" and non-public." These documents form no part of the official Image File Wrapper of the merged reexamination proceeding.

3. Jurisdiction of the merged reexamination proceeding is being transferred to the Office of Patent Legal Administration for consideration of the patent owner petition filed on January 11, 2008 that requests reconsideration of the Decision on Petition dated November 7, 2007.

4. Telephone inquiries with regard to this decision should be directed to the undersigned at (571) 272-1596.

Lissi Mojica Marquis, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

MAILED

JUN 19 2008

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*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/006,495
Filed: December 26, 2002
For: U.S. Patent No. 6,317,592

*In re Campana, Jr. et al*
*Inter Partes* Reexamination Proceeding
Control No.: 95/000,020
Filed: May 29, 2003
For: U.S. Patent No. 6,317,592

**DECISION DENYING PETITION**

This is a decision on the March 31, 2008 patent owner petition entitled "PETITION PURSUANT TO 37 C.F.R § 1.181, § 1.182 AND § 1.183 TO RECONSIDER THE JANUARY 29, 2008 DECISION DENYING ORIGINAL PETITION PURSUANT TO 37 C.F.R. § 1.181, § 1.182 AND § 1.183 TO WITHDRAW THE NOTIFICATION REGARDING DEFECTIVE REBUTTAL BRIEF DATED NOVEMBER 9, 2007."

The petition and the above-captioned merged reexamination proceeding are before the Director of Technology Center 1700. The petition is being treated as a request for the exercise of the USPTO Director's supervisory authority as delegated to the undersigned.

**Summary:** The petition is denied. The decision is designated as a final agency action under 5 U.S.C. § 704.

**PETITION FEE**

The relief requested is considered to be relief pursuant to 37 CFR 1.181. No fee is required for a petition filed pursuant to 37 CFR 1.181. Accordingly, a refund of the petition fee of $400.00 that has been charged to Deposit Account No. 50-0206 (accounting date April 3, 2008) will be scheduled in due course.

## REVIEW OF SALIENT FACTS

1. U.S Patent number 6,317,592 ("the '592 patent") issued to Campana *et al* on November 13, 2001 from an application filed on December 6, 1999.

2. On December 26, 2002, a Director Initiated Order for Reexamination of the '592 patent was mailed, and the resulting *ex parte* reexamination proceeding was assigned control number 90/006,495 ("the '495 reexamination proceeding").

3. On May 29, 2003, a request for *inter partes* reexamination of the '592 patent was filed by a third party requester, and assigned control number 95/000,020 ("the '020 reexamination proceeding").

4. On August 26, 2003, the examiner's Order Granting *Inter Partes* Reexamination for the '020 reexamination proceeding was mailed.

5. On August 9, 2004, the Office issued a decision *sua sponte* merging the '495 reexamination proceeding and the '020 reexamination proceeding into a single combined reexamination proceeding ("the merged reexamination proceeding").

6. The August 9, 2004 decision merging the proceedings set forth that the merged reexamination proceeding would be conducted in accordance with 37 CFR 1.982, *i.e.*, in accordance with the regulations governing the prosecution of an *inter partes* reexamination proceeding.

7. On May 12, 2006, the patent owner filed papers which included copies of materials obtained as a result of a FOIA request, and a number of verified statements directed to the issue of the authenticity of the so-called "Telenor documents" that have been relied upon (applied) as prior art in the merged reexamination proceeding, together with a petition for entry of these papers.

8. On September 13, 2006, a Decision Dismissing Petition was mailed that dismissed the May 12, 2006 petition, "returned" the papers that were filed on May 12, 2006, [1] and invited petitioner to resubmit the May 12, 2006 papers by filing the FOIA material and the material directed to substantive patentability issues separately in accordance with 37 CFR 1.3 and 1.4(c).

9. Patent owner did not file a request for reconsideration of the September 13, 2006 Decision dismissing the May 12, 2006 petition on or before November 13, 2006, as required by 37 CFR 1.181(f).

10. On December 12, 2006, the Office issued a Right of Appeal Notice ("RAN") for the merged reexamination proceeding.

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[1] The papers were "returned" by being marked as "closed" and "non-public" in the Image File Wrapper (IFW) because papers that have been scanned into the IFW cannot be removed from the IFW. Such papers are not part of the active record in the IFW.

11. On January 3, 2007, the patent owner filed a Notice of Appeal together with authorization to charge patent owner's deposit account for the $500.00 appeal fee.

12. Also on January 3, 2007, the patent owner filed a petition requesting entry into the record of a redacted version of the material filed on May 12, 2006, which did not include the FOIA material and was limited to the material directed to the authenticity of the Telenor documents.

13. On February 5, 2007, patent owner filed a Petition for Reconsideration of the September 13, 2006 Decision Dismissing Petition, facially requesting that all of the material filed on May 12, 2006, including the documents directed to the authenticity of the Telenor documents, be entered into the record.

14. On March 5, 2007, patent owner timely filed an appellant's brief and evidence appendix.

15. On March 15, 2007, a decision designated as a final agency action under 5 U.S.C. § 704 was mailed denying the underlying relief requested in patent owner's February 5, 2007 petition for reconsideration, so that the documents directed to the authenticity of the Telenor documents, was not entered into the record.

16. On April 4, 2007, patent owner filed a substitute appeal brief after obtaining an expansion of the page and word count limitations imposed by the rules.

17. On March 30, 2007, a decision designated as a final agency action under 5 U.S.C. § 704 were mailed denying the January 3, 2007 patent owner petition.

18. On May 30, 2007, patent owner filed a petition paper ostensibly as a request for reconsider of the March 30, 2007 or, alternatively, as an original petition, to obtain entry of the materials directed to the Telenor documents.

19. On July 2, 2007, a decision designated as a final agency action under 5 U.S.C. § 704 was mailed denying the May 30, 2007 patent owner request for reconsideration.

20. On July 11, 2007, a Notice was mailed informing patent owner that the appeal brief filed on March 5, 2007 was not in compliance with the rules.

21 On August 7, 2007, patent owner filed redacted versions of the appealed brief and evidence appendix that replaced the unredacted versions filed on April 4, 2007.

22. On August 20, 2007 and August 24, 2007, an examiner's answer was mailed.[2]

23. On September 21, 2007, patent owner was granted an extension of time until October 24, 2007, to file a rebuttal brief responsive to the examiner's answer.

[2] It appears that the August 20, 2007 Examiner's Answer was mailed without additional signatures of two appeal conferees. The August 24, 2007 Examiner's Answer bears the signatures of two appeal conferees.

24. On October 17, 2007, patent owner filed a petition to obtain entry into the record of certain evidence alleged to establish that the so-called Telenor documents that have been applied as a prior art reference have been altered.

25. On October 24, 2007, patent owner filed a rebuttal brief and a supplemental rebuttal brief.

26. On November 7, 2007, the October 17, 2007 patent owner petition was dismissed.

27. On November 9, 2007, a Notification was mailed informing patent owner that the supplemental rebuttal brief filed on October 24, 2007 was defective on the grounds that it was deemed to raise issues that were not present in the examiner's answer as to whether patent owner had proffered evidence that the Telenor documents had been altered.

28. On December 10, 2007, (a Monday), patent owner timely filed a redacted version of the October 24, 2007 supplemental rebuttal brief, in which the material objected to in the November 9, 2007 Notification was redacted.

29. Also on December 10, 2007, patent owner filed a petition to withdraw the November 9, 2007 Notification that the supplemental rebuttal brief filed on October 24, 2007 was defective.

30. On December 14, 2007, patent owner was notified that jurisdiction of the appeal was transferred to the Board of Patent Appeals and Interferences (BPAI), and that the December 10, 2007 redacted supplemental rebuttal brief was part of the appeal record.

31. On January 7, 2008, patent owner filed a petition for reconsideration of the November 7, 2007 decision on petition.

32. On January 29, 2008, the December 10, 2007 patent owner petition was dismissed in a decision by the Director of the Central Reexamination Unit.

33. On March 31, 2008, (a Monday), patent owner filed the present petition for reconsideration of the January 29, 2008 decision on petition.

## DECISION

I. Relevant Authority

37 CFR 41.71 provides, in part:

"(a) Within one month of the examiner's answer, any appellant may once file a rebuttal brief.
(b) (1)The rebuttal brief of the owner may be directed to the examiner's answer and/or any respondent brief.
(2)The rebuttal brief of the owner shall not include any new or non-admitted amendment, or an affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other

evidence filed after final action but before or on the same date of filing an appeal and § 41.63 for amendments, affidavits or other evidence filed after the date of filing the appeal."

MPEP § 2678 provides, in part:

"The rebuttal brief must (A) clearly identify each issue, and (B) point out where the issue was raised in the examiner's answer and/or in the respondent brief. In addition, the rebuttal brief must be limited to issues raised in the examiner's answer or in any respondent brief. A rebuttal brief will not be entered if it does not clearly identify each issue and/or is not limited to issues raised in the examiner's answer or in any respondent brief. Such a rebuttal brief will remain in the file, but it will not be addressed nor considered, except to inform the appropriate party that it was not entered and why."

II. Background

Patent owner is involved in multiple reexamination proceedings directed to a number of related patents. In the course of these proceedings, a reference (hereinafter referred to as "the Telenor documents") was applied as prior art against the patent claims in the multiple reexamination proceedings. Patent owner contested the prior art status of the Telenor documents, by taking the position that it is unclear that the Telenor documents as relied upon by the Office are authentic documents that have not been tampered with.

In support of the position taken on the authenticity of the Telenor documents, patent owner filed evidence in the form of a verified statement by a documents examiner, and certain supporting documents related to the chain of custody of the Telenor documents that patent owner submitted to the documents examiner for analysis. The verified statement and supporting documents have been refused entry in the present merged proceeding, although they have been entered in others of the reexamination proceedings. The refusal to enter the rebuttal documents in the present merged reexamination proceeding was based on patent owner's failure to comply with the Office's rules, and has been the subject of three petition decisions that have been designated as final agency actions under 5 U.S.C. § 704. These decisions are of record in the present merged reexamination proceeding.[3]

In the course of prosecution, the merged reexamination proceeding entered the appeal stage. On April 4, 2007, as part of the appeal process, patent owner filed an appeal brief containing an evidence appendix as required by 37 CFR 41.67.[4] However, patent owner was thereafter notified by the examiner that the expanded appeal brief and evidence appendix filed on April 4, 2007 did not comply with 37 CFR 41.67 because certain supplemental declarations referred to were not entered into the record, and because the appeal brief did not identify where in the record such declarations were found. Patent owner thereafter filed, on August 7, 2007, redacted versions of the appeal brief and the evidence appendix. The redacted appeal brief, at pages 45-48, merely argued that the Telenor documents were not printed publications for purposes of 35 U.S.C. § 102 and that the Office had not supported its position that these documents did constitute printed publications with any evidence. These arguments were addressed at pages 230-231 in the examiner's answer, wherein the examiner

[3] Decision Denying Petition, March 15, 2007; Decision Denying Petition, March 30, 2007; Decision Denying Petition and Returning Nonenterable Papers, dated July 2, 2007.

[4] This appeal brief was filed because patent owner had obtained an increase in the page and word count limitations imposed on appeal briefs by 37 CFR 1.943.

noted that the record contained an email authored by one Tove Aursoy, the Coordinator of Library Catalogs at the NTNU library. The statements in the Aursoy email explain when the Telenor documents were received and catalogued.

On October 24, 2007, patent owner filed a rebuttal brief and a supplemental rebuttal brief together with a petition to suspend the page and word count limitation imposed by 37 CFR 1.943. The petition was granted, and therefore, the supplemental rebuttal brief was entered into the record. However, on November 9, 2007, following the November 7, 2007 decision that dismissed the patent owner's October 17, 2007 petition to have the evidence directed to the authenticity of the Telenor documents entered,[5] the examiner mailed a Notification to patent owner that held the supplemental rebuttal brief to be defective. The Notification set a period of time in which to file an amended rebuttal brief. The holding that the supplemental brief was defective was based upon the examiner's position that the supplemental rebuttal brief addressed issues that were not present in the examiner's answer regarding whether or not patent owner proffered evidence directed to the authenticity of the Telenor documents. Patent owner timely filed a redacted version of the rebuttal brief concurrently with the December 10, 2007 petition requesting entry of the unredacted supplemental rebuttal brief. [6]

III. The January 29, 2008 Decision Dismissing the December 10, 2007 Petition

a. Patent Owner's Position

As presented in the petition filed on December 10, 2007, patent owner's rationale for requesting relief in the form of being permitted to proceed with its unredacted supplemental rebuttal brief was that patent owner should, in fairness, be entitled to submit any argument addressing why the Aursoy statement "does not reliably establish the publication date of the Telenor art, and therefore that the Patent Office has failed to carry its burden of proof." [7]

Patent owner took the position that because the examiner had commented in the examiner's answer on appeal that patent owner had never proffered any evidence challenging the statements made in an email from Tove Aursoy, patent owner had been prejudiced. Patent owner asserted that the examiner's comments were prejudicial to patent owner because patent owner had proffered proof that the Telenor documents are not authentic, and cannot, therefore, be applied as prior art. Patent owner alleged in the December 10, 2007 petition that because the examiner has relied on the Aursoy email statement to prove the publication date of the Telenor documents, the patent owner's proffer of evidence directed to whether the Telenor documents have been altered was a proffer of evidence that the Aursoy email statement is not accurate or reliable. Patent owner's reasoning, as presented in the December 10, 2007 petition, was that "if the (Telenor) art has been altered, the Aursoy statement is not

[5] A decision on the January 7, 2008 patent owner petition for reconsideration of the November 7, 2007 petition decision was still pending at the time that the instant petition was filed.

[6] It is noted that in order to comply with the Notification that the supplemental rebuttal brief filed on October 24, 2007 was defective, patent owner filed a redacted supplemental reply brief on December 10, 2007. Jurisdiction of the appeal was thereafter transferred to the BPAI. Jurisdiction of the December 10, 2007 patent owner petition was properly with the Central Reexamination Unit, in the Office of the Deputy Commissioner for Patent Examination and Policy. See MPEP § 1000.02(c) and compare MPEP §§1000.02(f) and (g). Jurisdiction of the present petition for reconsideration is properly with the undersigned to review a decision of the Central Reexamination Unit Director.

[7] Petition dated December 10, 2007, page 3, first full paragraph.

a truthful statement of the publication date of the art currently relied upon to reject the patent" in this merged proceeding.[8] Patent owner was of the opinion that the examiner was micro-managing the content of patent owner's rebuttal brief, and that "[D]ue process and fundamental fairness require that the Patent Owner be granted "reasonable latitude fashion its legal arguments that address and counter assertions in the Examiner's Answer that Patent Owner failed to proffer any evidence challenging the truthfulness, accuracy and reliability of the Aursoy hearsay statements.[9] Patent owner also relied on the following quotation from the examiner's answer: "***Here, there is nothing on the face of the Aursoy statements to suggest that information has been altered in any way or that the statements lacked accuracy and reliability. Furthermore, Appellant has not proffered evidence to the contrary."*** [Emphasis in the original.][10]

b. The January 29, 2008 Petition Decision

The January 29, 2008 petition decision was predicated on a complete and thorough review of the record of this merged reexamination proceeding. In particular, a review of the examiner's answer at pages 230-231, and a review of the Aursoy email document itself,[11] showed that patent owner's position was not well taken because it was based upon a co-mingling and confusion of two distinct issues.

Patent owner's contention that the examiner relied upon the Aursoy statement to prove the date of the Telenor documents is incorrect. The Telenor documents facially include a date. On pages 230-231 of the examiner's answer dated August 24, 2007, in a section entitled "The Office's Allegation that the Telenor Documents Are Printed Publications Is Supported by Evidence," the examiner relied upon the Aursoy email to address patent owner's arguments at pages 45-48 of the amended appeal brief filed on August 7, 2007. Patent owner's arguments were that the Telenor documents are not printed publications under 35 U.S.C. § 102(b). The examiner addressed those arguments by noting in the examiner's answer that the Aursoy email includes statements regarding the receipt dates for various ones of the Telenor documents at the NTNU library in Trondheim Norway, and the dates on which the Telenor documents were cataloged at that library.[12] The examiner considered that based upon the dates of receipt and cataloguing, the Telenor documents qualified as printed publications under 35 U.S.C. § 102(b). The examiner further considered that to the extent that patent owner had characterized the Aursoy email statement as being unreliable because it is hearsay, the patent owner had not offered evidence **that the statements in the Aursoy email regarding the receipt and cataloguing of the Telenor documents** were not in fact facially accurate and reliable. Accordingly, the examiner concluded that **the statements in the Aursoy email regarding the receipt and cataloguing of the Telenor documents appeared to be facially accurate and reliable**. The examiner's answer also noted that the examiner considered that although patent owner was free to investigate **the truth of the statements in the Aursoy email regarding the receipt and cataloguing of the Telenor**

[8] *Id.*, page 8, the last paragraph.
[9] *Id.*, page 3, the last paragraph.
[10] *Id.*, page 14, first paragraph.
[11] The Aursoy email was entered into the record as part of the third party requester comments pursuant to 37 CFR § 1.947 on January 10, 2006. The email amounts to an unverified statement regarding the receipt and cataloguing of the Telenor documents in the NTNU library in Trondheim, Norway.
[12] The Telenor documents include eight volumes, and the volumes include various dates.

**documents**, the record did not contain any evidence submitted by patent owner directed to showing that **the statements in the Aursoy email regarding the receipt and cataloguing of the Telenor documents** were inaccurate or untrue. The examiner concluded that on the record, **the statements contained in the Aursoy email regarding the receipt and cataloguing of the Telenor document**, must, therefore, be considered to be reliable even if such statements are deemed to be hearsay. Further, the statements deemed by the examiner to be facially accurate and reliable are **statements regarding the receipt and cataloging of the Telenor documents**. They are not statements regarding **the technical content of those documents**.

Thus, the position taken by patent owner in the December 10, 2007 petition was determined to be that patent owner's proffer of evidence going to the authenticity of the Telenor documents, (*i.e.*, the filing of verified statements **directed to the issue of whether the content of the Telenor documents had been (subsequently) altered so as to change the technical teachings thereof**) was an attempt by patent owner to contest the accuracy and reliability of the content of the Aursoy email. However, it was determined in the January 29, 2008 decision that patent owner's position co-mingled and confused two distinct issues. The first issue was whether an unverified statement that a document was received on a given date and then catalogued is truthful, accurate and reliable, and supports that document being a printed publication as of the date that it was available to, and locatable by, interested persons of ordinary skill in the art. The second issue was whether the technical content of that document is, or is not, authentic, such that the printed publication is not a printed publication as of the receipt and cataloguing dates for content that had been altered. The two are wholly different issues.

Viewed with the distinction between the two issues discussed above in mind, it was determined in the January 29, 2008 petition decision that when read in context, the examiner's position in the examiner's answer that is quoted at the end of Section 3(a), *supra*, and on page 14 of the December 10, 2007 petition, was not a basis for affording patent owner the requested relief. It was determined in the January 29, 2008 petition decision that the quoted statement merely set forth the examiner's position that the statements in the Aursoy email, on their face, have nothing to do with any subsequent alteration of the technical information set forth in any of the Telenor documents. It was further determined in the January 29, 2008 petition decision that evidence alleging such an alteration simply does not provide any evidence to support a belief that statements in the Aursoy email are facially inaccurate or unreliable for the proposition for which they were offered by Aursoy. It was also determined in the January 29, 2008 petition decision that patent owner had not proffered any evidence directed to the topics addressed by the Aursoy email, namely the receipt and cataloguing of the Telenor documents, although patent owner had offered comments on the Aursoy email in the March 1, 2006 paper entitled "Response To Office Action/Comments By Patent Owner under 37 CFR 1.951." To the extent that patent owner proffered evidence going to the authenticity of the technical content of the Telenor documents, it was determined in the January 29, 2008 petition decision that the proffer of such evidence had nothing to do with the issue of whether the documents are *prima facie* entitled to status as a printed publication as of a particular date based upon the receipt and cataloging of such documents as set forth in the uncontradicted email statement of Tove Aursoy.

In the October 17, 2007 petition, patent owner had alleged that on pages 230-231 of the examiner's answer dated August 24, 2007, the examiner had included an assertion that the patent owner "'has not proffered evidence to support arguments' that the Telenor documents relied upon by the Office in rejecting the claims of the '592 patent have been altered in any way."[13] In the December 10, 2007 petition, patent owner had cast the argument in slightly different language: "[O]n pages 230-231 of the Examiner's Answer, the Patent Office asserts, among other things, that the Patent Owner 'has not proffered evidence to support arguments' that statements by Tove Aursoy are accurate and reliable."[14] It was, therefore, reiterated in the January 29, 2008 decision that the statements in the email of Tove Aursoy were limited to the receipt date and the subsequent cataloguing of documents. It was held that the Aursoy statements did not address the authenticity or accuracy of the technical content of the documents. It was also held in the January 29, 2008 petition decision that the receipt and cataloguing dates were material to the status of the Telenor documents as *prima facie* constituting printed publications which, if early enough in date, would in turn *prima facie* constitute prior art pursuant to 35 U.S.C. § 102 and the case law construing the statute as to what does, and does not, constitute a "printed publication." It was additionally held in the January 29, 2008 petition decision that the authenticity of the technical content of the Telenor documents goes to the issue of whether the technical content of the publications is such as to be evidence of non-entitlement of an applicant or a patent owner to one or more claims due to anticipation under 35 U.S.C § 102 and/or non-obviousness under 35 U.S.C. § 103. It was further held that evidence introduced as to the latter is not evidence that is necessarily directed to the former.

IV. The March 31, 2008 Petition for Reconsideration

A review of March 31, 2008 petition for reconsideration shows that patent owner has essentially rehashed the position and arguments presented in the December 10, 2007 petition. Patent owner has not presented in the March 31, 2008 petition for reconsideration any persuasive rebuttal of any of the reasoning that resulted in the December 10, 2007 petition being dismissed. Rather, patent owner continues to adhere to the position that a proffer of evidence directed to whether the Telenor documents had, at some time, been altered as to their original content, equates to a proffer of evidence that would rebut a statement made with respect to when the Telenor documents were received and catalogued at the NTNU library in Trondheim Norway.

However, in the March 31, 2008 petition for reconsideration, patent owner for the first time now states:

> "[I]n particular, Patent Owner submitted the Declaration of Dr. V. Thomas Rhyne under 37 C.F.R. §132 (hereinafter "Rhyne Dec.)" wherein Dr. Rhyne, one of ordinary skill in the art, states that the Telenor documents were not catalogued or indexed in such a way to make them available to persons interested and ordinarily skilled in the relevant art of the Campana patents. See, e.g., Rhyne Dec, ¶s 70-76, which sets forth the testimony of one of ordinary skill in the art

[13] See page 1 of patent owner's October 17, 2007 petition. It is once again pointed out, as was done in the November 7, 2007 decision dismissing patent owner's October 17, 2007 petition, that only the language in the single quotation marks actually appears in what the examiner wrote in the August 24, 2007 examiner's answer.
[14] See page 7, first full paragraph, of the present patent owner petition paper.

that the documents were not properly indexed and catalogued, and therefore do not constitute a printed publication for purposes of 35 U.S.C. §102.[15]

There are several "Rhyne Declarations" in the record. None were referenced in the original petition filed on December 10, 2007. No specific "Rhyne Declaration" is referenced in the statement from the present petition for reconsideration that is quoted above. However, the December 28, 2005 declaration of Dr. V. Thomas Rhyne does discuss indexing and cataloguing of the Telenor documents at paragraphs 70-75. In those paragraphs, Dr. Rhyne, an expert in the field of electrical engineering and a registered patent practitioner, opines that one of ordinary skill in the art would not have found the Telenor documents in a search that exercised reasonable diligence, due to the manner in which Dr. Rhyne guesses that one of ordinary skill in the art would have formulated a search.

To the extent that the Rhyne declaration is deserving of consideration in a petition for the requested relief, after having not been relied upon in the December 10, 2007 petition, it is not seen that these statements are at all directed at the specific statements contained in the Aursoy email.[16] The Rhyne declaration does not dispute that the Telenor documents were received and catalogued at the NTNU library as stated in the Aursoy email. Yet again, patent owner has confused issues; the reliability and truthfulness of the statements contained in the Aursoy email have nothing to do with the issue of the usefulness of the key words under which the Telenor documents were catalogued as aids for locating the Telenor documents. Therefore, Dr. Rhyne's declaration in no way renders the examiner's statement at pages 230-231 of the examiner's answer untrue. To the extent that it may be agued that Dr. Rhyne's opinion that one of ordinary skill in the art would not have found the Telenor documents that were catalogued under the phrases "mobile telephone" and "communication protocol", but not under phrases such as "email" or "electronic mail" or "electronic message," such an argument may go to the issue of whether the Telenor documents are, or are not, printed publications, but Dr. Rhyne's opinion does nothing to rebut anything stated in the Aursoy email. Accordingly, the existence in the record of the Rhyne Declaration filed on December 28, 2005 in no way opens the door for patent owner to discuss evidence directed to whether the Telenor documents were altered, when such evidence has properly been excluded from the record. At best, Dr. Rhyne's opinion goes to whether the Telenor documents that were catalogued at the time and in the manner set forth in the Aursoy email statement were "properly" catalogued.

On the present record, it remains clear that evidence directed to the authenticity of the technical content of the Telenor documents is not material to the question of whether the Telenor documents constitute printed publications as of a given date, regardless of the content thereof. Similarly, evidence that would establish whether the content of the Telenor documents had, at some point in the existence of the Telenor documents, been altered from their original content, would not be material to the status of the Telenor documents as a printed publication as of the date they were received and catalogued at the NTNU library as described in the Aursoy email. Patent owner cannot convert a proffer of evidence on the

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[15] Petition ... To Reconsider ..." March 31, 2008 at page 14.

[16] It should be noted the Dr. Rhyne candidly states that his opinion on this issue is based on circumstances that were "presented" to him which has "not attempted to confirm or refute." Rhyne Declaration, filed December 28, 2005, at page 27. There is nothing to indicate that Dr. Rhyne ever saw, or was presented with, the statements in the Aursoy email.

authenticity of the technical content of the Telenor documents into evidence that somehow contradicts the truth of the statements contained in the Aursoy email, which statements are limited to the issues of receipt and cataloguing of the Telenor documents, and to other library procedures not relevant here. Neither can Dr. Rhyne's opinion regarding the quality of the cataloguing of the Telenor documents contradict the truth or statements contained in the Aursoy email. That the present record does not contain the evidence that patent owner contends would show that the technical content of the Telenor printed publications was somehow altered after the date of the invention claimed in the patent that is the subject of the present merged reexamination proceeding, (and so cannot therefore constitute prior art as to such claimed invention due to that alteration), appears to be due to patent owner's unwillingness and/or inability to comply with the Office's rules for submitting such evidence after having been notified of how to submit such evidence within the requirements of the rules, and having been given a period of time in which to do so. The absence from the record of evidence directed to the authenticity of the technical content of the Telenor printed publications [17] cannot be remedied by attempting to convert an accurate exposition by the examiner regarding what the record specifically shows with respect to how and when the Telenor documents were received and catalogued in the NTNU library, (*i.e.*, the statements in the Aursoy email), into a procedural error on the part of the examiner.

For the foregoing reasons, it is considered that, in the January 29, 2008 petition decision, the Director of the Central Reexamination Unit correctly determined that the examiner did not commit any procedural error in holding that the supplemental rebuttal brief filed on October 24, 2007 failed to comply with both 37 CFR 41.71 and the practice implementing the regulation set forth in MPEP § 2679. Therefore, the decision of the Director of the Central Reexamination Unit will not be disturbed, and the examiner will not be directed to withdraw the requirement for the filing of an amended supplemental rebuttal brief that was set forth in the Notification filed on November 9, 2007.

[17] See footnote 3, *supra*.

## CONCLUSION

1. The March 31, 2008 patent owner petition is granted to the extent that the January 29, 2008 decision dismissing the December 10, 2007 petition has been fully reconsidered. However, the March 31, 2008 patent owner petition is denied with respect to the relief requested by patent owner.

2. The October 24, 2007 supplemental reply brief has been sealed by being marked "closed" and non-public." This document forms no part of the official Image File Wrapper of the merged reexamination proceeding.

3. Jurisdiction of the merged reexamination proceeding is being returned to the Board of Patent Appeals and Interferences.

4. This decision is designated as a final agency action under 5 U.S.C. § 704.

5. Telephone inquiries with regard to this decision should be directed to the undersigned at (571) 272-1100, or in her absence, to Greg Morse at (571) 272-3838 or Andy Kashnikow at (571) 272-4361.

Marian C. Knode

Marian C. Knode, Director
Technology Center 1700

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(For Patent Owner)

MAILED

JUN 19 2008

CENTRAL REEXAMINATION UNIT

Novak Druce & Quigg LLP
1300 Eye Street NW
Suite 400 East Tower
Washington, DC 20005

(For Third Party Requester)

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/006,495
Filed: December 26, 2002
For: U.S. Patent No. 6,317,592

*In re Campana, Jr. et al*
*Inter Partes* Reexamination Proceeding
Control No.: 95/000,020
Filed: May 29, 2003
For: U.S. Patent No. 6,317,592

**DECISION DENYING PETITION**

This is a decision on the January 7, 2008 patent owner petition entitled "PETITION PURSUANT TO 37 C.F.R. § 1.181 OR, ALTERNATIVELY, 37 C.F.R. § 1.182 OR ALTERNATIVELY 37 C.F.R. § 1.183 TO RECONSIDER THE NOVEMBER 7, 2007 DECISION DENYING ORIGINAL PETITION PURSUANT TO 37 C.F.R. § 1.181 IN RESPONSE TO STATEMENTS MADE IN THE EXAMINER ANSWER TO ENTER INTO THE RECORD FOR APPEAL EVIDENCE AGAINST THE AUTHENTICITY OF THE TELENOR DOCUMENTS."

The petition and the above-captioned merged reexamination proceedings are before the Office of Patent Legal Administration. The petition is a request for reconsideration of the decision dated November 17, 2007, in which the Office dismissed October 17, 2007 petition in which patent owner requested entry into the record of evidence "against the authenticity" of certain documents.

**Summary:** The petition for reconsideration is granted to the extent that the petition decision dated November 17, 2007 has been reconsidered. For the reasons set forth below, the relief requested by petitioner patent owner is denied. The present decision is designated as a final agency action under 5 U.S.C. § 704.

## PETITION FEE

The relief requested would require that the provisions of 37 CFR 41.63 and/or 37 CFR 41.67 be waived pursuant to 37 CFR 1.183, in order to permit the filing and entry of additional new or non-admitted evidence, or an affidavit or other evidence at this stage of the proceeding. Accordingly, a petition fee of $400.00 has been charged to Deposit Account No. 50-0206 pursuant to patent owner's instructions at page 17 of the present petition.

## REVIEW OF SALIENT FACTS

1. U.S Patent number 6,317,592 ("the '592 patent") issued to Campana *et al* on November 13, 2001, from an application filed on December 6, 1999.

2. On December 26, 2002, a Director Initiated Order for Reexamination of the '592 patent was mailed, and the resulting *ex parte* reexamination proceeding was assigned control number 90/006,495 ("the '495 reexamination proceeding").

3. On May 29, 2003, a request for *inter partes* reexamination of the '592 patent was filed by a third party requester, and assigned control number 95/000,020 ("the '020 reexamination proceeding").

4. On August 26, 2003, the examiner's Order Granting *Inter Partes* Reexamination for the '020 reexamination proceeding was mailed.

5. On August 9, 2004, the Office issued a decision *sua sponte* merging the '495 reexamination proceeding and the '020 reexamination proceeding into a single combined reexamination proceeding ("the merged reexamination proceeding").

6. The August 9, 2004 decision merging the proceedings set forth that the merged reexamination proceeding would be conducted in accordance with 37 CFR 1.982, *i.e.*, in accordance with the regulations governing the prosecution of an *inter partes* reexamination proceeding.

7. On May 12, 2006, the patent owner filed papers which included copies of materials obtained as a result of a FOIA request, and a number of verified statements directed to the issue of the authenticity of the so-called "Telenor documents" that have been relied upon (applied) as prior art in the merged reexamination proceeding, together with a petition for entry of these papers.

8. On September 13, 2006, a Decision Dismissing Petition was mailed that dismissed the May 12, 2006 petition, "returned" the papers that were filed on May 12, 2006,[1] and invited petitioner to resubmit the May 12, 2006 papers by filing the FOIA material and the material directed to substantive patentability issues, *i.e.*, the material directed to the authenticity of the Telenor documents, separately, as required by 37 CFR 1.3 and 1.4(c).

[1] The papers were "returned" by being marked as "closed" and "non-public" in the Image File Wrapper (IFW) because papers that have been scanned into the IFW cannot be removed from the IFW. Such papers are not part of the active record in the IFW.

9. Patent owner did not file a request for reconsideration of the September 13, 2006 Decision dismissing the May 12, 2006 petition on or before November 13, 2006, as required by the provisions of 37 CFR 1.181(f).

10. On December 12, 2006, the Office issued a Right of Appeal Notice ("RAN") for the merged reexamination proceeding.

11. On January 3, 2007, the patent owner filed a Notice of Appeal together with authorization to charge patent owner's deposit account for the $500.00 appeal fee.

12. Also on January 3, 2007, the patent owner filed a petition requesting entry into the record of a redacted version of the material filed on May 12, 2006, which was stated not to include the FOIA material and to be limited to the material directed to the authenticity of the Telenor documents.

13. On February 5, 2007, patent owner filed a Petition for Reconsideration of the September 13, 2006 Decision Dismissing Petition, facially requesting that all of the material filed on May 12, 2006, including the documents directed to the authenticity of the Telenor documents, be entered into the record.

14. On March 5, 2007, patent owner timely filed an appellant's brief and evidence appendix.

15. On March 15, 2007, a decision designated as a final agency action under 5 U.S.C. § 704 was mailed denying the underlying relief requested in patent owner's February 5, 2007 petition for reconsideration, so that the documents directed to the authenticity of the Telenor documents (as well as the other materials for which entry was requested) were not entered into the record. Relief was denied because the request for reconsideration was untimely filed and the FOIA material remained co-mingled with the material directed to the Telenor documents in contradiction to the requirement of the rules.

16. On April 4, 2007, patent owner filed a substitute appeal brief after obtaining an expansion of the page and word count limitations imposed by the rules.

17. On March 30, 2007, a decision designated as a final agency action under 5 U.S.C. § 704 was mailed denying the January 3, 2007 patent owner petition because the FOIA material still remained co-mingled with the material directed to the Telenor documents.

18. On May 30, 2007, patent owner filed a petition paper ostensibly as a request for reconsideration of the March 30, 2007 decision, or alternatively, as an original petition, to obtain entry of the materials directed to the Telenor documents.

19. On July 2, 2007, a decision designated as a final agency action under 5 U.S.C. § 704 was mailed denying the May 30, 2007 patent owner request for reconsideration since the matter was regarded as ripe for judicial review in light of the two prior decisions designated as final agency actions, and because, contrary to patent owner's arguments, the FOIA material continued to remain co-mingled with the material directed to the Telenor documents.

20. On July 11, 2007, a Notice was mailed informing patent owner that the appeal brief filed on March 5, 2007 was not in compliance with the rules.

21 On August 7, 2007, patent owner filed redacted versions of the appeal brief and evidence appendix that replaced the unredacted versions filed on April 4, 2007.

22. On August 20, 2007, and on August 24, 2007, an examiner's answer was mailed by the Office.[2]

23. On September 21, 2007, patent owner was granted an extension of time until October 24, 2007, to file a rebuttal brief responsive to the examiner's answer.

24. On October 17, 2007, patent owner filed a petition to obtain entry into the record of certain evidence alleged to establish that the so-called Telenor documents that have been applied as a prior art reference had been altered.

25. On October 24, 2007, patent owner filed a rebuttal brief and a supplemental rebuttal brief.

26. On November 7, 2007, the October 17, 2007 patent owner petition was dismissed.

27. On November 9, 2007, a Notification was mailed informing patent owner that the supplemental rebuttal brief filed on October 24, 2007 was defective on the grounds that it was deemed to raise issues that were not present in the examiner's answer, i.e., issues regarding whether patent owner had, or had not, proffered evidence that the Telenor documents had been altered.

28. On December 10, 2007 (a Monday), patent owner timely filed a redacted version of the October 24, 2007 supplemental rebuttal brief, in which the material objected to in the November 9, 2007 Notification was redacted.

29. On December 10, 2007, patent owner filed a petition requesting supervisory review of the examiner's November 9, 2007 Notification.

30. On December 14, 2007, patent owner was notified that jurisdiction over the appeal and the present proceeding was transferred to the Board of Patent Appeals and Interferences (BPAI), and that the December 10, 2007 redacted supplemental rebuttal brief was part of the appeal record.

31. On January 11, 2008, patent owner filed the present request for reconsideration of the November 7, 2007 decision dismissing the October 17, 2007 patent owner petition.

32. On January 29, 2008, the December 10, 2007 patent owner petition was dismissed by the Director of the Central Reexamination Unit (CRU), after jurisdiction over the proceeding was returned to the CRU by the BPAI.

33. On February 7, 2008, the BPAI returned jurisdiction over the proceeding to the CRU, relinquishing jurisdiction under 37 CFR 41.64(b). Jurisdiction has been assumed by the Office of Patent Legal Administration to address the patent owner's January 11, 2008 petition for reconsideration of the November 7, 2007 decision.

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[2] It appears that the August 20, 2007 Examiner's Answer was mailed without additional signatures of two appeal conferees. The August 24, 2007 Examiner's Answer bears the signatures of two appeal conferees.

34. On March 31, 2008, patent owner filed a petition reconsideration of the January 29, 2008 CRU decision.

## DECISION

### I. Relevant Authority

37 CFR 41.63 provides:

> "(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).

37 CFR 41.71 provides, in part:

> "(a) Within one month of the examiner's answer, any appellant may once file a rebuttal brief.
> (b) (1)The rebuttal brief of the owner may be directed to the examiner's answer and/or any respondent brief.
> (2)The rebuttal brief of the owner shall not include any new or non-admitted amendment, or an affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63 for amendments, affidavits or other evidence filed after the date of filing the appeal."

MPEP § 2678 provides, in part:

> "After the examiner's answer, only a rebuttal brief (or an amended rebuttal brief, where appellant is given one opportunity to correct a defective original rebuttal brief (MPEP § 2679)) will be received into the reexamination proceeding. No other submission will be considered, and any such other submission will be returned as an improper paper. 37 CFR 1.939."

### II. Background

Patent owner is involved in multiple reexamination proceedings directed to a number of its related patents. In the course of these proceedings, a reference (hereinafter referred to as "the Telenor documents") was applied as prior art against the patent claims in the multiple reexamination proceedings, including the present merged reexamination proceeding. Patent owner has taken the position that it is unclear that the Telenor documents as relied upon by the Office are authentic documents that have not been tampered with, and has contested the prior art status of the Telenor documents with respect to the contents thereof.

In support of the position taken on the authenticity of the Telenor documents, patent owner filed a verified statement by a documents examiner in a manner that failed to comply with the Office's rules. Similarly, patent owner filed certain supporting documents related to the chain of custody of the Telenor documents that also failed to comply with the Office's rules. As a result of patent owner's failure to comply with the rules for submitting such documents, these documents have

not been entered in the present merged proceeding.[3] The refusal to enter the rebuttal documents in the present merged reexamination proceeding was on procedural grounds; involving the failure to submit the documents in a manner that complied with the Office's rules. After the Office issued the first decision on September 13, 2006, refusing entry of these documents, subsequent decisions refusing entry thereafter noted that entry of the material directed to the authenticity of the Telenor documents would require withdrawing the proceeding from the appeal stage and much re-work by the Office, which clearly runs counter to the statutorily mandated special dispatch required for reexamination proceedings. Ultimately, the improper filing of these documents was the subject of three petition decisions refusing the relief requested of entering the material directed to the authenticity of the Telenor documents. Each of these decisions were designated as final agency decisions under 5 U.S.C. § 704 and are of record in the present merged reexamination proceeding.[4]

As part of the appeal process, on April 4, 2007, patent owner filed an appeal brief containing an evidence appendix as required by 37 CFR 41.67.[5] However, patent owner was notified by the examiner on July 11, 2007 that the appeal brief and evidence appendix filed on April 4, 2007 did not comply with 37 CFR 41.67 because the appeal brief did not identify where in the record certain supplemental declarations were found. The declarations in question were not found because these were the declarations directed to the authenticity of the Telenor documents (discussed above) that had been refused entry into the record because of patent owner's failure to properly file the documents with the Office. Patent owner thereafter filed redacted versions of the appeal brief and the evidence appendix on August 7, 2007. The redacted versions of the appeal brief and evidence appendix did not argue or reference material directed to the authenticity of the Telenor documents. However, in the redacted appeal brief, patent owner argued, at pages 45-48, that the Telenor documents were not printed publications for purposes of 35 U.S.C. § 102 and that the Office had not supported its position that the Telenor documents constituted printed publications with any evidence. This line of argument was based on how issues directed to the cataloguing and indexing of the Telenor documents at the NTNU library.[6] In the examiner's answer mailed on August 24, 2004, at pages 230-231, the examiner addressed the patent owner's arguments that the Telenor documents did not qualify as printed publications under 35 U.S.C. § 102. The examiner pointed out that the record contained an e-mail authored by one Tove Aursoy, the Coordinator of Library Catalogs at the NTNU library. In that e-mail, Aursoy explains the procedures employed at the NTNU library when the Telenor documents were received and catalogued, states that these procedures were applied to the Telenor documents, and gives the dates of receipt and cataloguing of the Telenor documents.

On October 17, 2007, prior to filing a rebuttal brief directed to the examiner's answer, patent owner again filed a petition requesting entry of the previously excluded evidence directed to the

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[3] This material was entered in other reexamination proceedings where patent owner complied with the Office's rules for submitting such documents.

[4] Decision Denying Petition, March 15, 2007; Decision Denying Petition, March 30, 2007; Decision Denying Petition and Returning Nonenterable Papers, dated July 2, 2007.

[5] This appeal brief was filed because patent owner had obtained an increase in the page and word count limitations imposed on appeal briefs by 37 CFR 1.943, and replaced a previously filed appeal brief that was limited in accordance with the requirements of 37 CFR 1.943.

[6] The foundation for the patent owner's arguments begins at page 41 of the August 7, 2007 redacted appeal brief and is direct to establishing that the Telenor documents were cannot be considered printed publications due to how they were catalogued and indexed at the NTNU library, located in Trondheim, Norway.

authenticity of the Telenor documents.[7] On October 24, 2007, patent owner filed both a rebuttal brief and a supplemental rebuttal brief together with a petition for relief from the page and word count limitations of 37 CFR 1.943.[8] The petition for relief from the page and word count limitations was granted in a decision dated November 7, 2007, and the supplemental rebuttal brief was entered into the record. However, patent owner's October 17, 2007 petition for entry of the evidence directed to the authenticity of the Telenor documents was dismissed in a separate decision dated November 7, 2007. Following dismissal of the October 17, 2007 petition, the examiner issued a Notification on November 9, 2007, informing patent owner that patent owner's supplemental rebuttal brief would not be entered into the record because, in contravention of 37 CFR 41.67, the patent owner's supplemental rebuttal brief improperly included discussions of issues not raised in the examiner's answer. Specifically, the patent owner's supplemental rebuttal brief discussed the excluded evidence directed to the authenticity of the Telenor documents, and failed to include any reference to the portion of the record containing the discussed excluded evidence directed to the authenticity of the Telenor documents.[9]

The present January 7, 2008 request for reconsideration is directed to the November 7, 2007 decision dismissing patent owner's petition for entry of the excluded evidence directed to the authenticity of the Telenor documents. It is noted that patent owner filed a redacted supplemental rebuttal brief on December 10, 2007, and concurrently filed a petition requesting supervisory review and reversal of the examiner's holding that the October 24, 2007 supplemental rebuttal brief was improper for the purpose of having the October 24, 2007 supplemental rebuttal brief reinstated into the record. The December 10, 2007 petition has been dismissed.

## III. Analysis and Findings

### a. Patent Owner's Position[10]

Patent owner's rationale for again requesting waiver of the rules to permit patent owner to enter into evidence the information that was previously filed to question the authenticity of the Telenor documents is essentially the same argument presented in the original October 17, 2007 petition. Patent owner renews the argument that patent owner has been prejudiced by the examiner's statement that patent owner has not proffered any evidence rebutting the statements contained in the Aursoy e-mail, which e-mail is relied upon by the examiner to establish that the Telenor documents are printed publications. In patent owner's view, the language in question is inaccurate and prejudicial because patent owner did file (*i.e.*, proffer) evidence directed to the authenticity of the Telenor documents (although such evidence has not been entered into the record). Patent owner argues that the proffer of the evidence directed to the authenticity of the Telenor documents clearly relates to the truthfulness, accuracy and reliability of the statements

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[7] The Office had already issued the three different petition decisions that were each designated as final agency actions, as previously discussed.

[8] The rebuttal brief filed on October 24, 2007 is designated as being a "supplemental" rebuttal brief because it was intended to replace the concurrently filed rebuttal brief that, as filed, was limited by the page and word count limitations of 37 CFR 1.943, in the event that the concurrently filed petition was granted.

[9] See 37 CFR 41.67(a)(vii) and (c)(1)(vii).

[10] This section of the decision is intended to summarize the eight pages of arguments presented patent owner on pages 9-16 of the present request for reconsideration. The failure to specifically list or reproduce a particular argument is not to be taken as an indication that such argument was not fully and carefully considered. Rather, it is the main thrust of patent owner's argument that is set forth in this section.

contained in the e-mail authored by Tove Aursoy, which is relied upon by the examiner to establish that the Telenor documents are printed publications. Patent owner further urges that the proffer of the evidence directed to the authenticity of the Telenor documents demonstrates that Aursoy cannot show that the Telenor documents submitted to the NTNU library, where they were received and catalogued, are the same documents relied upon by the Office as "prior art." Accordingly, patent owner argues that one must not give additional weight to the Aursoy statements, as the examiner has done, based upon the examiner's determination that the patent owner has not submitted evidence contesting the Aursoy statement. Patent owner believes that the statements in the Aursoy e-mail are "not the least bit probative of the publication date of the Telenor 'art' if the documents relied on by the PTO's (*sic*, PTO) are not the same as those catalogued in the NTNU library in 1986 and 1989."[11]

Patent owner further argues in the present request for reconsideration that the certain statements in the examiner's answer such as "[A]ppellant was free to investigate alleged hearsay assertions during the prosecution" but did not present evidence directed to the Aursoy hearsay statement are unfair and prejudicial statements. Patent owner takes the position that the evidence directed to the authenticity of the Telenor documents constitutes evidence directed to the Aursoy hearsay statement. In particular, patent owner argues that the following statement in the examiner's answer is unfair and prejudicial:

> "For example, the Aursoy statements were introduced into the record of the current reexamination proceeding on January 10, 2006, over a year before the mailing date of this Office Action, with the Appellant have had an opportunity to investigate said alleged hearsay assertions and present rebutting evidence, even in the form of declarations and affidavits. 37 § 1.116(e) (*sic*, 37 CFR 1.116(e)). Epstein[12] also indicated that the truthfulness of the assertions in the alleged hearsay documents can be assumed when the documents appear on their face to be accurate and reliable and ***Appellant fails to proffer any evidence to support arguments to the contrary.*** Id. at 1566. Here there is nothing on the face of the Aursoy statements to suggest that information has been altered in any way or that the statements lacked accuracy and reliability. ***Furthermore, Appellants has not proffered evidence to support arguments to the contrary.***[13] [Emphasis that includes italics and bold font supplied by patent owner.]

Patent owner also argues the evidence relating to the authenticity of the Telenor documents, excluded as a result of patent owner's failure to properly and timely submit it, should now be entered, even after prosecution in the present merged proceeding has progressed to the point where a rebuttal brief directed to an examiner's answer has been filed, because such entry would allegedly not delay or impede the ability of the Office to conduct the prosecution of the present merged proceeding with special dispatch. Patent owner relies on the Office's entry of the evidence in question into reexamination proceedings for related patents, and the relatively

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[11] "Petition ... to Reconsider The November 7, 2007 Decision ..." at pages 15-16.

[12] The examiner's reference is to *In re Epstein*, 32 F.3d 1559 (Fed. Cir. 1994)

[13] It is to be noted that what the examiner is stating here is that there is nothing about the Aursoy statement itself that suggests that the statements in the **Aursoy e-mail relating to the receipt and cataloging of the Telenor documents in the NTNU library is inaccurate or has been itself altered in any way.** This statement was made by the examiner in the context of establishing that the Aursoy e-mail is reliable, notwithstanding that it is not a verified statement and may be criticized as being "hearsay." This statement in the examiner's answer was not directed or related to evidence of alteration of the Telenor documents or the lack of a proffer of evidence directed to any allegations of such alternation; neither could it have been properly so directed inasmuch as the record is devoid of any evidence going to the issue of alteration of the Telenor documents.

contemporaneously completed examiner's answers in those related proceedings for support of this position.

Patent owner additionally argues that patent owner was promised by the Office that evidence and information submitted in one reexamination proceeding would be considered in all reexamination proceedings. Patent owner continues to rely on the Declaration of Carl Brundidge that was attached to the October 17, 2007 petition to support this argument. Patent owner also states that, despite patent owner's failure to file the evidence in compliance with the Office's rules, it is fundamentally unfair to exclude from the record, and from patent owner's brief, any reference to the irregularity of the Telenor documents, and then to take advantage of the absence of such evidence in the record to argue that the evidence was not proffered in the first place.

b. Timeliness Considerations

On February 1, 2006, the Office mailed an Action Closing Prosecution (ACP) in the present merged *inter partes* reexamination proceeding. Patent owner timely filed comments directed to the ACP under the 37 CFR 1.951, which provides, *inter alia* that a patent owner may once file comments after an ACP. However, on May 12, 2006, patent owner filed additional material addressed to the ACP, together with a petition requesting waiver of 37 CFR 1.951 to permit entry of that additional material into the Image File Wrapper (IFW) record of the present merged *inter partes* reexamination proceeding. The May 12, 2006 submission included supplemental comments, copies of materials obtained as a result of the FOIA request, and also a number of verified statements directed to the issue of the authenticity of the Telenor documents. In a decision dated September 13, 2006, the Office dismissed the petition for the relief requested by patent owner in the May 12, 2006 petition. Entry of the May 12, 2006 papers was refused in a decision dated September 13, 2006. Entry was refused because the material for which entry into the file of the present merged *inter partes* reexamination proceeding was requested was not limited to addressing the ACP or the merits of the present merged *inter partes* reexamination proceeding. Rather, material related to alleged misconduct was co-mingled with material directed to the merits of the present merged *inter partes* reexamination proceeding (including the issue of the authenticity of the Telenor documents). The refusal to enter the material submitted on May 12, 2006, was without prejudice to patent owner obtaining entry of the merits directed material and consideration of the material directed to the alleged misconduct if the former was submitted to the file of the present merged proceeding and the latter was submitted separately submitted to so that it would be maintained separate from the record of the merged *inter partes* reexamination proceeding while it was being considered. Patent owner was expressly so informed.[14]

Patent owner took no further action regarding the refusal to enter the material directed to the authenticity of the Telenor documents until January 3, 2007, when patent owner again submitted a petition to waive the regulations and enter supplemental material after the ACP. However, the Office's September 13, 2006 decision on the May 12, 2006 petition put patent owner on notice, pursuant to 37 CFR 1.181(f), that entry of the material directed to the authenticity of the Telenor documents would not be granted due to the co-mingling of FOIA material and material directed to the authenticity of the Telenor documents. The Office's September 13, 2006 decision also clearly invited patent owner to submit the material directed to the authenticity of the Telenor documents

[14] "Decision Dismissing Petition and, Sua Sponte, 'Returning' Improper Papers," September 13, 2006, page 5, first full paragraph

without co-mingling it with additional nonenterable FOIA material. The September 13, 2006 decision constituted "action or notice from which relief is requested" under 37 CFR 1.181(f). And, 37 CFR 1.181(f) provides that "[A]ny 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." Moreover, the regulation provides that "[T]his two-month period is not extendable." However, patent owner did not file a request for relief to obtain entry of the Telenor material within two months from the September 13, 2006 action or notice as required by the 37 CFR 1.181(f), but instead delayed such filing until almost four months from September 13, 2006, thereby permitting prosecution to continue resulting in the issuance of a RAN on December 12, 2006. Pursuant to 37 CFR 1.953(c), "no amendment can be made in response to the Right of Appeal Notice." Patent owner provided no reason for the delay in submitting material that would amend the record of the present merged proceeding until after the RAN was issued. Accordingly, the Telenor material, which constituted an amendment to the record, was denied entry. Patent owner filed other petitions to obtain entry of the Telenor material in which no reason was provided for the delay in filing the Telenor material until after the RAN was issued, and these too were denied entry.

The present merged proceeding had progressed to the point where nothing else remained other than that the Board of Patent Appeals and Interferences (BPAI's) render its decision. Yet, notwithstanding that patent owner had been advised how to seasonably and correctly submit the material directed to the authenticity of the Telenor documents, but had failed to do so, and notwithstanding that the Office has previously rendered three final agency actions pursuant to 5 U.S.C. § 704 that afford patent owner the opportunity to seek judicial review of the refusal to enter such material into the record of the present merged proceeding, and notwithstanding that 37 CFR 41.63 expressly provides that "[a]ffidavits 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), patent owner has filed yet another petition to obtain entry of that material. The filing of the petition itself necessitated that the Board of Patent Appeals and Interferences relinquish jurisdiction and remand the proceeding for consideration of the present petition. Even beyond the delay in this proceeding introduced by the necessity of the remand, it is apparent that if the previously excluded material directed to the authenticity of the Telenor documents for which entry is requested were entered into the record at this point, in contravention to 37 CFR 41.63, the present merged reexamination proceeding would have to be reopened and the proceeding would no longer be at the appeal stage, ready for the BPAI's decision. The Telenor documents were first filed on September 28, 2005, and entry of the evidence in accordance with the relief presently requested by patent owner would have the effect of negating the prosecution that occurred subsequent to September 28, 2005. The material directed to the authenticity of the Telenor documents was not timely presented, and waiver of the any rule(s) necessary to permit entry of the such material would, therefore, have a significant effect in retarding the statutorily mandated "special dispatch" in reexamination.

c. The Patent Owner's Position For Requesting Entry and Consideration of the Evidence Directed to the Authenticity of the Telenor Documents Is Wholly Unpersuasive

(1) Evidence Directed To The Technical Content Of The Telenor Documents Is **Not** Evidence That Is Directed To The Statements In The Aursoy E-mail, Because The E-mail Does Not Address The Content Of The Telenor Documents

A review of the record of this proceeding, including the examiner's answer, particularly at pages 230-231, and of the Aursoy document itself,[15] shows that patent owner's position that the proffer of the evidence directed to the authenticity of the Telenor documents constitutes evidence rebutting the statements in the Aursoy e-mail is not well taken. The fundamental flaw in patent owner's position is that it is based upon a co-mingling and confusion of two distinct issues. One issue is **whether the unverified statements in the Aursoy e-mail are reliable statements regarding the receipt and cataloguing of the Telenor documents at the NTNU library, and regarding certain library procedures**. If the statements in the Aursoy e-mail are reliable, then such statements would support the proposition that the Telenor documents *prima facie* constitute printed publications as of a particular date, in accordance with 35 U.S.C. § 102 and the case law that interprets the meaning of "printed publication." The second issue is **whether the technical teachings contained in the Telenor documents have been altered after the date of receipt and cataloguing, so that the Telenor documents can not be applied as of the *prima facie* publication date to questions of the novelty and non-obviousness pursuant 35 U.S.C. §§ 102 and 103 because the Telenor documents did not contain those technical teachings as of the *prima facie* publication date.** The two issues are wholly distinct and separate from each other, and it is to the second issue that the excluded material proffered by patent owner was directed, not to the first issue. And it is to be noted that the examiner has not raised an issue of whether the Telenor documents were altered. Such issue would be patent owner's to raise, since the content of a printed publication is presumably accurate. Patent owner was entitled to raise that issue, but was not entitled to do so in a manner that contravened the rules, for the reasons set forth in the three final agency actions dated March 15, 2007, March 30, 2007 and July 2, 2007, respectively.

Pages 230-231 of the examiner's answer dated August 24, 2007, include a section entitled "The Office's Allegation that the Telenor Documents Are Printed Publications Is Supported by Evidence." In that section, the examiner relied upon the statements in the Aursoy e-mail to address the patent owner's argument at pages 45-48 of the amended appellant brief to the effect that the Telenor documents are not printed publications under 35 U.S.C. § 102(b). The examiner addressed that argument by pointing out that the Aursoy e-mail is evidence of (1) the receipt dates for various ones of the Telenor documents at the NTNU library in Trondheim Norway, and (2) the date on which the Telenor documents were cataloged at that library.[16] The examiner found that, based upon the dates of receipt and cataloguing, the Telenor documents qualified as printed publications under 35 U.S.C. § 102(b) and as prior art to the claims at bar. The examiner further found that, to the extent that patent owner had characterized the statements in the Aursoy e-mail as being unreliable hearsay, the patent owner had not proffered evidence **that the statements in the Aursoy e-mail regarding the receipt and cataloguing of the Telenor documents** were facially inaccurate and unreliable. The examiner noted that, although patent owner was free to investigate the truth of **the statements in the Aursoy e-mail regarding the receipt and cataloguing of the Telenor documents**, the record does not contain any evidence submitted by patent owner directed to showing that **the statements in the Aursoy e-mail regarding the receipt and cataloguing of the Telenor documents** were inaccurate or untrue. The examiner concluded that, on the record and in light of certain case law,[17] that **the statements contained in the Aursoy e-mail regarding the receipt and cataloguing of the Telenor documents**, must be accepted as accurate, reliable and true, even if such statements are deemed

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[15] The Aursoy e-mail was entered into the record as part of the third party requester comments pursuant to 37 CFR § 1.947 on January 10, 2006.

[16] The Telenor documents include eight volumes, and the volumes include various dates.

[17] See page 8, *supra*, and footnote 12.

to be hearsay. The statements in the Aursoy e-mail that are deemed by the examiner to be facially accurate and true are not statements directed to **the technical content of the Telenor documents**. There are no statements whatsoever in the Aursoy e-mail pertaining to **the technical content of those documents**. The examiner then proceeding to rely upon the technical content of the Telenor documents, there being no evidence in the record that such content was inaccurate and/or not effective prior art as of the date afforded to the Telenor documents by reason of it being a dated publication that was indexed and available in the NTNU library.

Thus, it is clear that the argument presented by patent owner co-mingles and confuses (a) **the issue of whether an unverified statement that a document was received on a given date and then catalogued is truthful, accurate and reliable**, with (b) **the issue of whether the technical content of that document is, or is not, authentic**. It is for that reason that patent owner's position is untenable. The two issues are wholly different issues, and there is simply no nexus between the two issues. In the present merged reexamination proceeding, the portion of the examiner's answer that is complained of is directed to issue (a), which is the issue that was raised by patent owner at pages 45-48 of the appellant's brief in a section entitled "The Office's Allegation that the Telenor Documents are Printed Publications is not Supported by any Evidence." Perforce, the examiner was required to respond to that issue.[18]

Patent owner's prior proffers of evidence going to the authenticity of the Telenor documents, (*i.e.*, the filing of verified statements **directed to the issue of whether the content of the Telenor documents had been (subsequently) altered so as to change the technical teachings thereof**) were not equivalent to an attempt by patent owner to contest the accuracy and reliability of the content of the Aursoy e-mail, which document is confined to receipt and cataloguing of the Telenor documents (and certain other library procedures), and thus, **had nothing to do with the alterations argued to be established by the excluded evidence**.

(2) Patent Owner Has Not Been Prejudiced By Statements In The Examiner' Answer Regarding The Failure Of Patent Owner To Submit Evidence Contravening The Statements In The Aursoy E-Mail

Patent owner filed a paper on March 1, 2006 entitled "Response To Office Action/Comments By Patent Owner under 37 CFR 1.951." That paper did include **comments** that are directed to the truthfulness of the Aursoy e-mail statement, and such comments are of record.[19] However, comments are not evidence and cannot take the place of evidence in the record. Moreover, the comments were limited to an allegation that the Aursoy e-mail was simply hearsay. Patent owner has argued that the examiner made prejudicial comments by stating that patent owner has not submitted evidence directed to rebutting the statements contained in the Aursoy email. However, patent owner has not pointed to any paper in which patent owner submitted evidence (as opposed to comments/arguments) **that is specific to the issue of the truthfulness of the allegedly hearsay statements in the Aursoy statement**. Thus, it does not appear that the examiner's position as quoted, for example, on page 8, *infra*, is technically inaccurate with respect to the failure of patent owner to proffer "evidence" directed to rebutting the Aursoy e-mail statement. To the extent that patent owner believes patent owner's comments/arguments (that the Aursoy e-mail was hearsay) are encompassed by the language at pages 230-231 of the examiner's answer as being "evidence," it is found that no reasonable person could be prejudiced by the examiner's position that patent owner has not proffered "evidence" directed to

[18] See: 37 CFR 41.69(a).
[19] See subsection XI.A., pages 10-11.

rebuttal of the statements in the Aursoy email, since the record clearly shows that patent owner in fact submitted such comments. Further, as has been found in section (b)(1) above, the proffered evidence that was excluded as to the Telenor reference evidence was not directed to the Aursoy e-mail statement; thus, the examiner's position that patent owner did not submit "evidence" directed to the statements set forth in the Aursoy email was also not prejudicial to patent owner. It should be noted that patent owner was free to point out in the rebuttal brief where evidence **directed to the Aursoy e-mail statement** was proffered; this patent owner did not do in the rebuttal brief, nor in the present petition. In view of the above, petitioner patent owner has not demonstrated that patent owner has been prejudiced by the language at pages 230-231 of the examiner's answer so as to warrant entry of any excluded **evidence**, as there was directed to the truthfulness of the statements contained in the Aursoy e-mail.

It is also pointed out that the evidence excluded from the record (for the reasons set forth in the decisions listed in "footnote 4" includes (1) a verified statement by a documents expert that does not specifically address the Aursoy statement, and (2) verified statements by a number of individuals that pertain to the chain of custody of the material that patent owner submitted to the documents expert for examination. The excluded evidence proffered by patent owner does include a verified statement establishing that the NTNU library was visited by the author of the verified statement, and that certain inquiries on behalf of patent owner were made. However, it appears that those inquiries were directed to ascertaining the "checkout history" of documents, and the procedures utilized in the library, (if any), for ascertaining whether materials returned to the library were returned in the same condition in which they had been checked out was also made. Patent owner has not argued that the declarant stated that any inquiry was made with respect to **the initial receipt and cataloguing of documents, or whether the content of such documents was "checked" for authenticity at the time of receipt and cataloguing.** Therefore, entry of the excluded evidence directed to the authenticity of the Telenor documents could not address the truth, accuracy or reliability of the statements in the Aursoy e-mail, which statements are limited to the receipt and cataloguing of documents, (and to certain library procedures), that do not involve ascertaining whether materials are returned to the library in the same condition in which they had been checked out.

Instead, the excluded evidence was proffered to establish patent owner's theory that the Telenor documents relied upon by the Office were altered subsequent to their receipt at the library, something that is not the subject of the statements set forth in the Aursoy e-mail. Whether such evidence may be relevant is not at issue in this merged reexamination proceeding, as it has been excluded from the record of the present merged reexamination proceeding because patent owner failed to submit such evidence in accordance with Office's rules, as clearly set forth in prior discussed three final agency decisions. Entry at this point would severely "back-up" the proceeding and clearly run counter to the statutory mandate for "special dispatch" as discussed below.[20] That the record does not contain such evidence, (a circumstance which may be prejudicial to patent owner because patent owner's theory that the technical content of the Telenor printed publications was somehow altered after the date of the invention claimed in the presently reexamined patent is not supported in the present record by anything other than argument), any prejudice to patent owner as a result of the absence of such evidence from the present record is solely due to patent owner's failure to comply with the regulations when filing such evidence, **even after having been notified of how to submit such evidence within the requirements of the regulations, and having been given a period of time in which to do so.** A prior art printed publication is evidence for that which it teaches, and in the absence of evidence

[20] See the decisions cited in footnote 4.

that a teaching in a printed publication is not prior art at as of a given date, the examiner is constrained to apply the printed publication as prior art. That such is the present state of the record is not something that occurred because the examiner has stated that patent owner failed to proffer any evidence **to rebut the statements in the Aursoy e-mail.**

(3) Entry of the Excluded Evidence Directed to the Authenticity of the Telenor Documents Would Impede the Statutory Requirement That This Merged Proceeding be Conducted with Special Dispatch

Patent owner has taken issue with the Office's position that admission of the evidence directed to the authenticity of the Telenor documents into the record of this merged reexamination proceeding would have impeded the treatment of the proceeding with special dispatch as required by the reexamination statute. Patent owner's position is equally unpersuasive with respect to this issue. Given that the Office promulgated three final agency decisions refusing to enter that evidence, that the earliest such decision was mailed on March 15, 2007, that patent owner did not resort to the Federal District Court for relief, and the proceeding has now progressed to the point where nothing else remains other than for the Board of Patent Appeals and Interferences (BPAI's) to render a decision, patent owner is not well placed in equity to request that the prosecution of the merged proceeding be reopened, especially since patent owner's own failure to timely comply with directions on how to submit the evidence directed to the authenticity of the Telenor documents is the reason why such evidence remains excluded from the present record. Patent owner urges that consideration of the evidence directed to the authenticity of the Telenor documents would not impede special dispatch, as evidenced by the fact that, in other concurrently conducted reexamination proceedings, such evidence has been entered. However, those other proceedings did not have examiner's answers completed; they were at earlier stages when the evidence directed to the authenticity of the Telenor documents was properly submitted. This proceeding is significantly older and farther advanced than the other proceedings. Further, the Telenor documents were entered into the record September 28, 2005, and submission of the patent owner's evidence submitted on the authenticity of the Telenor documents was not proposed by patent owner until May 12, 2006. Entry of the evidence in accordance with the relief presently requested by patent owner would have the effect of negating the prosecution that occurred subsequent September 28, 2005. Thus, the present merged reexamination proceeding would no longer be at the appeal stage, ready for the BPAI's decision.

(4) The Brundidge Declaration Does Not Mandate The Requested Relief

The Brundidge declaration referenced at page 14, footnote 4, of the present petition for reconsideration was originally attached to the October 17, 2007 petition. The Brundidge declaration relates to a position allegedly expressed to declarant by Ms. Lissi Marquis (the Director of the Central Reexamination Unit) and Mr. Mark Reinhart (a Special Program Examiner in the Central Reexamination Unit).[17] This declaration was considered in the November 7, 2007 decision dismissing that petition. Nevertheless, the Brundidge declaration has again been considered. The Brundidge declaration is, however, still deemed to fail to justify granting the relief requested by petitioner patent owner.

[17] Declarant states, at page 2 of the declaration, that "[M]r. Reinhart and Ms. Marquis assured us that - - in the interest of fairness and for complete resolution of the issues - - evidence submitted in a particular proceeding would be considered in all reexamination proceedings."

Initially, it is to be noted that oral statements made with respect to a reexamination proceeding are not given effect.[18] However, even assuming that the Office would give effect to the oral statement attributed to Ms. Marquis and Mr. Reinhart, that statement cannot be applied to help petitioner patent owner in this proceeding. In the context of the overall circumstances in which multiple related patents owned by patent owner were being reexamined in a plurality of reexamination proceedings (each directed to one of the patents), the statement attributed by declarant to Ms. Marquis and Mr. Mark Reinhart cannot be taken to mean that evidence properly submitted and entered in one of the given reexamination proceedings would be entered into the record of another reexamination proceeding **notwithstanding the failure of patent owner to file the evidence in that other proceeding in accordance with the applicable regulations of the Office**. Also, the alleged position attributed to Ms. Marquis and Mr. Reinhart cannot be taken to apply to **comments in the nature of argument (as opposed to evidence), particularly if such comments are untimely filed**. In this instance, patent owner's March 1, 2006 comments regarding the truthfulness of the Aursoy e-mail statement have in fact already been entered into the record. Patent owner has not explained what **other** comments or evidence **on that specific issue** have previously been proffered and excluded from the record, why patent owner is entitled to have any such excluded comments entered, or why presentation of new comments/evidence **on that specific issue** should be entered at this late point in the merged reexamination proceeding.

In summary, it appears to be the fact that the proffer of evidence directed to the authenticity of the Telenor documents was repeatedly defective and no proper submission of the proffered evidence was timely submitted. The result is that such evidence has not been entered into the record. Patent owner has not persuasively established why it should be permitted to recover from the effects of patent owner's own failure to have that evidence entered into the record and severely back-up the proceeding, by arguing prejudice based upon the examiner's characterization of why the record does not contain evidence directed to the entirely different issue of the truthfulness of the Aursoy statement. There is, in fact, no **evidence** in the record (as opposed to comments in the nature of argument) that **specifically** bears upon the truthfulness of the allegedly hearsay statements in the Aursoy e-mail. The examiner's characterization of why evidence on the issue of the authenticity of the technical teachings in the Telenor documents is absent from the record is irrelevant to the entry of the evidence it seeks to have entered via this petition, especially inasmuch as petitioner patent owner was given multiple opportunities to present such evidence in a manner that was both compliant with the regulations and timely. Petitioner patent owner has not established any basis for holding that patent owner's appeal in this proceeding has been prejudiced by **any** actions of the examiner or of the Office as a whole. Accordingly, there is no basis upon which to grant the requested relief.

## CONCLUSION

1. The January 7, 2008 patent owner Petition for Reconsideration is granted to the extent that the October 17, 2007 Decision Dismissing Petition has been fully reconsidered, both procedurally and on its merits.

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[18] 37 CFR 1.2 provides that "[a]ll business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt."

2. The January 7, 2008 patent owner Petition for Reconsideration is denied with respect to disturbing the holding of the October 17, 2007 Petition Dismissing Petition and with respect to the underlying relief requested by patent owner.

3. Jurisdiction of the merged reexamination proceeding is being forwarded to the Central Reexamination Unit for appropriate action on the March 31, 2008 patent owner petition.

4. Telephone inquiries with regard to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or, in his absence, to the undersigned at (571) 272-7710.

5. This decision is a final agency action within the meaning of 5 U.S.C. § 704.

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

sm
June 19, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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Paper No. 11

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(For Patent Owner)

MAILED

NOV 20 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**

DO NOT ENTER

This is a decision on the October 27, 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 $1330.00 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 July 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 2600 for consideration of the response to the non-final Office action of July 21, 2003.

3. Further inquiries with regard to this reexamination proceeding should be directed to the examiner, Wengpeng Chen, of Group Art Unit 2624.

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

U.S. Patent and Trademark Office

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

November 18, 2003

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. |
|---|---|---|---|---|
| 90/006,497 | 12/27/2002 | 5763831 | 1390/679 | 6163 |

23123 7590 06/03/2003

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| EXAMINER |
|---|
| ESTRADA |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2831 | 14 |

DATE MAILED: 06/03/2003

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

PTO-90C (Rev. 07-01)

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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WASHINGTON, D.C. 20231
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Paper No. 14

Schmeiser Olsen & Watts
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Mesa, AZ 85201

(for patent owner)

William F. Prendergast
Brinks, Hofer, Gilson & Lione
P.O. Box 10395
Chicago, IL 60610

(for requester)

In re Shotey *et al.*
Reexamination Proceeding
Control Number 90/006,005
Filed: May 11, 2001
For: U.S. Patent No. 5,763,831

DECISION MERGING
REEXAMINATION PROCEEDINGS

In re Shotey *et al.*
Reexamination Proceeding
Control Number 90/006,005
Filed: December 27, 2002
For: U.S. Patent No. 5,763,831

MAILED

JUN 0 3 2003

TECHNOLOGY CENTER 2800
SPECIAL PROGRAM CENTER

DECISION MERGING REEXAMINATION PROCEEDINGS

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

## BACKGROUND

1. Patent No. 5,763,831 issued on June 9, 1998.

2. A first request for reexamination, Reexamination Control No. 90/006,005, was filed by a third party requester on May 11, 2001.

3. Reexamination was ordered in the '005 reexamination proceeding on August 3, 2001.

4. A statement indicating that the patent owner elects not to file a patent owner's statement was filed on February 28, 2002.

5. A non-final Office action was mailed on July 10, 2002, rejecting claims 8-12 and 14-16 under 35 U.S.C. §§ 102 and 103, and confirming the patentability of claims 1-7, 13, and 17-20.

6. A telephone interview between Michael Shotey, an inventor, Ken Booth, representative for patent owner, Angel Estrada and Dean Reichard, PTO personnel, was held on September 10, 2002.

7. An amendment amending claims 8 and 14, and adding new claims 21-40 was submitted on September 10, 2002, the same day the telephone interview was held.

8. On November 21, 2002, an Information Disclosure Statement and a supplemental amendment amending claim 14 and adding new claim 41 was submitted. A certificate of service for the communications of November 21, 2002, was filed on December 4, 2002.

9. A Notice of Defective Paper in Ex Parte Reexamination was mailed on December 10, 2002, indicating that the amendments filed September 10, 2002 and November 21, 2002, did not fully comply with 37 C.F.R. § 1.530(d)-(j).

10. A second request for reexamination, Reexamination Control No. 90/006,497, was filed by the third party requester on December 27, 2002.

11. A Notice of Concurrent Office Proceeding was filed on January 3, 2003, by the third party requester.

12. On January 10, 2003, an amendment in response to the notice mailed December 10, 2002 was filed.

13. Reexamination was ordered in the '497 reexamination proceeding on March 14, 2003.

14. To date, no patent owner's statement pursuant to 37 C.F.R. § 1.530(b) has been received for the '497 reexamination proceeding and the two-month time period for filing such statement has expired.

## DISCUSSION

Under 37 C.F.R. § 1.565(c):

> If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* reexamination proceeding has not been terminated, the *ex parte* reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570.

As noted above, reexamination has been ordered in both of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is appropriate.

## DECISION

### I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '005 and '497 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

### II. Requirements for Same Amendments in Both Proceedings.

As noted above, the claims have been amended in the '005 reexamination proceeding and the claims have not been amended in the '497 reexamination proceeding. Patent owner is required to maintain the same claims and specification in both files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in both files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

### III. Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature, for entry in each file. All papers filed by the patent owner must be served on the requester and requester will be sent copies of all papers mailed by the Office.

## CONCLUSION

Reexamination Control Nos. 90/006,005 and 90/006,497 are merged. Patent owner has **one month** from the date of this decision to submit an appropriate "housekeeping" amendment. Upon receipt of the "housekeeping" amendment, an Office action will be issued in due course.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

William F Prendergast
Brinks Hofer Gilson & Lione
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Chicago, Illinois 60610

# *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/006,497*.

PATENT NO. *5763831*.

ART UNIT *2831*.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(e)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(e)).

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United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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| APPLICATION NO | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/006,005 | 05/11/2001 | 5763831 | 1390/679 | 2338 |

23123 -7590 06/03/2003

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MESA, AZ 85201

| EXAMINER |
|---|
| ESTRADA |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2931 | 14 |

DATE MAILED: 06/03/2003

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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# REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/006,005*.

PATENT NO. *5763831* .

ART UNIT *2831* .

Enclosed is a copy of the latest communication from the Patent and Trademark Office in the above identified reexamination proceeding (37 CFR 1.550 (e)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the reexamination requester will be acknowledge or considered (37 CFR 1.550 (e)).

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Paper No. 15

Andrew C. Sonu
Finnegan, Henderson, Farabow,
Garrett & Dunner, L.L.P.
1300 I Street, N.W.
Washington, D.C. 2005

(For Patent Owner)

MAILED
NOV 18 2003
REEXAM UNIT

Hong et al.
Reexamination Proceeding
Control No. 90/006,499
Filed: December 27, 2002
For: U.S. Patent No. 5,962,468

: DECISION
: GRANTING
: PETITION

DECISION MAILED

This is a decision on the October 31, 2003, patent owner petition filed under 37 CFR 1.182 entitled PETITION TO ENTER AMENDMENT AFTER NOTICE OF INTENT TO ISSUE *EX PARTE* REEXAMINATION CERTIFICATE. Patent owner requests entry and consideration of an amendment filed subsequent to the Notice of Intent to Issue Reexamination Certificate (NIRC) mailed September 11, 2003. Petitioner urges that the amendment is necessary to prevent impermissible broadening of the claims. As the rules do not provide for an amendment to be filed in a reexamination proceeding after prosecution had been closed in the NIRC, patent owner's requested relief is appropriately raised under 37 CFR 1.182. See MPEP 2287. The petition is before the Office of Patent Legal Administration for decision.

The petition is granted for the reasons set forth below.

## DECISION

Patent owner seeks entry of a proposed amendment filed concurrently with the present petition into the reexamination file. Patent owner alleges that the subject matter of presently allowed claim 5 "had been amended to add a hydration number (n=2), but this embodiment does not appear in the claim as originally issued." Patent owner submits a concurrently filed amendment to correct this by deleting the added hydration number. Patent owner requests that the proposed amendment be entered and considered.

Section 305 of the reexamination statute (Title 35) provides that no amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding. If presently allowed claim 5 enlarges the scope of patent claim 5, as alleged, it would be an improper new claim under section 305. Accordingly, it is appropriate that the amendment be entered and considered by the examiner.

For the above reasons, the petition is granted.

## CONCLUSION

1. The patent owner's petition under 37 CFR 1.182 is granted.

2. The October 31, 2003, amendment will be entered into the reexamination record..

3. The reexamination file is being returned to Technology Center 1600 for consideration of the proposed amendment by the examiner and either the reopening of prosecution of the reexamination proceeding, or the allowance of newly amended claim 5 and the issuance of a supplemental NIRC.

4. Any questions regarding this decision should be directed to the undersigned at (703) 305 - 8610.

5. Telephone inquiries related to the examination of the reexamination proceeding should be directed to the examiner, D. Seaman at (703) 308-4528, or Special Program Examiner William Dixon of Technology Center 1600 at (703) 308-3824.

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

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MAR 19 2004

REEXAM UNIT

Paper No. 14

David M. Thimmig
Mayer Brown & Platt
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Chicago, IL 60690-2828

(For Patent Owner)

Hugh D. Jaeger, P.A.
1000 Superior Blvd.
Suite 302
Wayzata, MN 55391-1873

(For Requester)

Enclosure: Petition papers filed January 28, 2004.

90006508 20040319

Rogers et al. :
*Ex Parte* Reexamination Proceeding : **DECISION DISMISSING**
Control No. 90/006,508 : **PETITION**
Filed: January 06, 2003 :
For: U.S. Patent No. 5,050,353 :

This is a decision on the January 28, 2004, third party reexamination requester petition requesting that the provisions of 37 CFR 1.550(g) and 1.550(h) be waived, and that requester be permitted to submit a paper directed to the merits of the reexamination for the purpose of supervisory review of the proceeding. The petition is before the Office of Patent Legal Administration.

The petition is dismissed for the reasons set forth below.

## DECISION ON PETITION

37 CFR 1.550(g) provides:

> (g) The active participation of the *ex parte* reexamination requester ends with the reply pursuant to § 1.535, and no further submissions on behalf of the reexamination requester will be acknowledged or considered. Further, no submissions on behalf of any third parties will be acknowledged or considered unless such submissions are:
>
> (a) in accordance with § 1.510 or § 1.535; or
>
> (b) entered in the patent file prior to the date of the order for *ex parte* reexamination pursuant to § 1.525.

The present petition is not a request for reexamination in compliance with the requirements of 37 CFR 1.510, and it is not a reply pursuant to 37 CFR 1.535. Nor does the petition qualify as a prior art statement under 37 CFR 1.501. Neither the rules nor any provision of the statute provide authority for a third party requester of an *ex parte* reexamination proceeding requested under 35 U.S.C. 302 to file a paper directed to the issues of the reexamination proceeding. *In re Amp*, 212 USPQ 826 (Comm'r. Pats. 1981). The statute and its intent are clear that a reexamination proceeding requested under 35 U.S.C. 302 must be *ex parte*. Petitioner requests the privilege to file a paper directed to inaccuracies or omissions made by the patent owner, or any perceived misunderstandings or omission related to the prior art on behalf of the examiner during the prosecution of the *ex parte* reexamination. These requests by petitioner are clearly directed to the merits of the reexamination proceeding, and addressing same would be contrary to the intent of the *ex parte* reexamination statute. Comments by third parties at this stage are precluded since a reexamination proceeding requested under 35 U.S.C. 302 is an *ex parte* proceeding (after the expiration of the statement/reply period under §§ 1.530 and 1.535). A waiver/suspension of the rules in the present case to permit a third party submission would not be justified in view of the intent of the legislation and rules to make reexamination under 35 U.S.C. 302 - 307 an *ex parte* proceeding. See *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 11 USPQ2d 1866, 1869 (Fed. Cir. 1989) (third parties do not participate before the USPTO).

The Office in 1980 implemented the original 35 U.S.C.§§ 302-307 to provide requester, other than the patent owner, only that degree of participation specifically provided for by §§ 302 and 304. The Office intentionally chose to make the proceedings *ex parte* in order to reduce costs and to comply with the special dispatch requirement of the statute. On balance, it was and is the position of the Office that an *ex parte* reexamination proceeding best served the interests of all, and best complied with the intent of the 1980 statute and was in keeping with its legislative history.

It is clear that Congress has endorsed the Office's 1980 decision to implement reexamination as an *ex parte* proceeding. Beginning in the early 1990's Congress began a process to expand the 1980 reexamination statute to provide an increased level of third party requester participation in

the proceeding. All of the bills introduced into Congress to this end merely modified the existing 1980 Chapter 30 reexamination statute to increase the level of third party requester participation in the various ways proposed in the bills. This methodology for expanding third party requester participation did not change until optional *inter partes* reexamination was enacted in 1999. When Congress drafted the legislation for *inter partes* reexamination it provided for an entirely new Chapter 31, directed to increased third party requester participation. The existing Chapter 30, on the other hand, was not changed other than to revise the Chapter heading by inserting "*EX PARTE*" before "REEXAMINATION OF PATENTS."

The Congressional shift in methodology/mechanism from that of simply modifying the existing Chapter 30 (1980) reexamination statute to that of providing separate Chapters 30 and 31 shows a specific intent on the part of Congress to retain Chapter 30 as-is with respect to third party requester participation (as implemented by the Office). The insertion of "*EX PARTE*" before "REEXAMINATION OF PATENTS" drives home the point that Congress wanted to keep the examination stage of Chapter 30 solely *ex parte*.

For the reasons set forth above, the third party requester petition of January 28, 2004, is dismissed and is being returned with this decision.

## CONCLUSION

1. The third party requester petition filed January 28, 2004, is **dismissed**.

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

Gerald A. Dost
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner for Patent Examination Policy

C:\zJerry\90_6508 petition by 3PR to participate in ex parte reexam.wpd

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APR 28 2004

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

David M. Thimmig (For Patent Owner)
Mayer Brown & Platt
P.O. Box 2828
Chicago, IL 60690-2828

Hugh D. Jaeger, P.A. ( For Requester)
1000 Superior Blvd.
Suite 302
Wayzata, MN 55391-1873

Reexamination Control No. 90/006,508 : DECISION ON PETITION
Filed: January 6, 2003 : FOR THE ACCEPTANCE
For: U.S. Patent No. 5,050,353 : OF LATE PAPERS

This is in reply to petitioner's communication filed January 27, 2004 and supplemented on April 2, 2004 which will be treated as a Petition To Accept Late Filed Papers. There is no fee required for this petition.

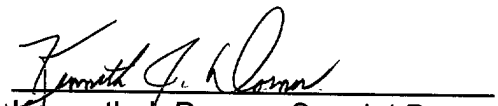
The petition is **GRANTED**.

A review of the above reexamination file indicates that an Office action was mailed on November 18, 2003 wherein a two-month shortened statutory period for response was set. Petitioner alleges that a timely response was filed on January 16, 2004. Petitioner has submitted copy of the amendment, which bears a Certificate of Facsimile Transmission indicating that the amendment was timely mailed on January 16, 2004. A statement under 37 CFR 1.8(b)(3) attesting to the previous timely mailing also accompanied the petition. This is acceptable evidence of 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 January 16, 2004.

Kenneth J. Dorner



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

kjd: 4/23/04

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Paper No. 17

David M. Thimmig (For Patent Owner)
MAYER BROWN & PLATT
P.O. Box 2828
Chicago, IL 60690-2828

Hugh D. Jaeger, P.A. (For Requester)
1000 Superior Blvd.
Suite 302
Wayzata, MN 55391-1873

Enclosure: April 15, 2004 third party requester petition papers.

MAILED

APR 19 2005

REEXAM UNIT

| | | |
|---|---|---|
| In re Rogers et al. | : | |
| Reexamination Proceeding | : | DECISION |
| Control No. 90/006,508 ✓ | : | DISMISSING |
| Filed: January 6, 2003 | : | PETITION |
| For: U.S. Patent No. 5,050,353 | : | |
| | : | |

This is a decision on the April 15, 2004, requester petitions titled PETITION UNDER RULE 183 FOR SUPERVISORY REVIEW OF THE REEXAMINATION PROCEEDING and REQUEST FOR RECONSIDERATION OF PETITION UNDER RULE 183. Petitioner requests that the Office reconsider the March 19, 2004 decision of the Senior Legal Advisor dismissing the January 28, 2004 petition to permit a requester submission of a paper directed to the merits in the instant reexamination proceeding.

In view of the request for review of the March 19, 2004 decision by the Senior Legal Advisor, the present petition titled REQUEST FOR RECONSIDERATION OF PETITION UNDER RULE 183 is taken as a petition under 37 CFR 1.181(a)(3) for review of that decision. Both the PETITION UNDER RULE 183 FOR SUPERVISORY REVIEW OF THE REEXAMINATION PROCEEDING and the REQUEST FOR RECONSIDERATION OF PETITION UNDER RULE 183 will be addressed jointly in this decision.

The petition under 37 CFR 1.181(a)(3) is **granted** to the extent that the Senior Legal Advisor's March 19, 2004 decision, and the present record, have been reviewed.

The petition under 37 CFR 1.181(a)(3) is **denied** as to making a change in the ultimate decision by the Senior Legal Advisor.

The petition under 37 CFR 1.183 is **denied**.

The third party requester petition papers are being **returned** for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 5,050,353 issued on September 24, 1991.

2. A request for reexamination of the '353 patent was filed by a third party requester on January 6, 2003, and the resulting proceeding assigned control No. 90/006,508 (the present proceeding).

3. Reexamination was ordered for the '6508 reexamination proceeding on March 19, 2003.

4. A patent owner's statement pursuant to 37 CFR 1.530 was received on May 5, 2003.

5. A requester's reply pursuant to 37 CFR 1.535 was received on July 17, 2003.

6. A non-final Office action was mailed on November 18, 2003.

7. A patent owner communication was filed January 27, 2004, and supplemented April 2, 2004, and alleged that a timely response to the November 18, 2003 Office action was filed on January 16, 2004. Patent owner submitted a copy of the amendment, which bears a Certificate of Facsimile Transmission indicating that the amendment was timely mailed on January 16, 2004, and a statement under 37 CFR 1.8(b)(3) attesting to the previous timely mailing of that amendment.

8. On January 28, 2004, the requester filed a petition requesting that the provisions of 37 CFR 1.550(g) and (h) be waived and that requester be permitted to submit a paper directed to the merits of the reexamination for the purpose of supervisory review of the proceeding.

9. On March 19, 2004, a decision dismissing the requester's January 28, 2004 petition was issued by the Senior Legal Advisor of the Office of Patent Legal Administration. The January 28, 2004 petition was returned to the requester with the decision.

10. On April 15, 2004, the requester filed the instant petitions for reconsideration of the March 19, 2004 decision, and waiver of the rules to permit requester participation in the proceeding.

11. On April 28, 2004, the Special Programs Examiner of Patent Technology Center 3600 issued a decision treating the patent owner communications of January 27, 2004, and supplemented April 2, 2004, as a Petition To Accept Late Filed Papers. In the decision, the Special Programs Examiner accepted the proffered evidence of timely filing of patent owner's amendment responding to the November 18, 2003 Office action, and granting the petition.

DECISION ON PETITIONS

The instant petitions, and the record of the present proceeding, have been given a plenary review, and it is found that there is no basis for disturbing the March 19, 2004 decision by the Senior Legal Advisor of the Office of Patent Legal Administration. In addition, it is appropriate to return the petition papers to the third party requester.

**I. Return of Papers:**

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 petitions are not requests for reexamination in compliance with the requirements of 37 CFR 1.510, and they are not replies pursuant to 37 CFR 1.535. Nor do the petitions qualify as a prior art statement under 37 CFR 1.501.

Accordingly, the rules provide that the present petition papers do not have an entry right, and the petition papers are being returned with this decision. A copy of the petition papers is currently of record within the Office Image File Wrapper system; that copy will be closed to remove that copy from access. A copy of the present decision will, however, be made of record in the reexamination file.

**II. The petition under 37 CFR 1.183:**

Petitioner urges that, pursuant to 37 CFR 1.183, the rules should be suspended to permit entry and consideration of the two requester petitions. At page two of the REQUEST FOR RECONSIDERATION OF PETITION UNDER RULE 183, it is stated:

> "The requester's petition was filed under the auspices of 37 CFR 1.183 which, the requester contends, supersedes all other rules cited for dismissing the petition. The decision failed to address the authority given to the Commissioner under Section 183. Why is there a Section 183 if it was not contemplated that certain situations are so egregious and compelling that the Commissioner is authorized to suspend the rules and take appropriate action? The requester's petition strives to bring certain critical and essential facts to the reexamination in question. The circumstances warrant the commissioner's intervention under 37 CFR 1.183. The requester contends that the dismissal of the petition was an error and that the decision should have been based upon the guidelines of Section 183 and not Section 550(g).
> The denial of the petition for this reexamination is so egregious that it calls for intervention under Rule 183 by the commissioner for superceding and suspending the rules as this reexamination proceeding is in dire need of supervisory review."

The requested waiver/suspension of the rules in the present case to permit the requester to participate in the proceeding via the petition papers would not, however, be justified in view of the intent of the legislation (and rules) to make reexamination under 35 U.S.C. 302 - 307 an *ex parte* proceeding. This will be discussed more fully in the treatment of the request for reconsideration, immediately below in this decision. Accordingly, the request for waiver pursuant to 37 CFR 1.183 is denied.

**III. The request for reconsideration of the March 19, 2004 decision:**

Neither the rules nor any provision of the statute provide authority for a third party requester of an *ex parte* reexamination proceeding requested under 35 U.S.C. 302 to file a paper directed to the issues of the reexamination proceeding. *In re Amp, 212 USPQ 826* (Comm'r. Pats. 1981). The statute and its intent are clear that a reexamination proceeding requested under 35 U.S.C. 302 must be *ex parte*. Petitioner requests the privilege to file a paper directed to inaccuracies, omissions, made by the patent owner, failure to cure informalities, and perceived misunderstandings or omission related to the prior art on behalf of the examiner during the prosecution of the *ex parte* reexamination. These matters are clearly directed to the merits of the reexamination proceeding, and addressing same would be contrary to the intent of the *ex parte* reexamination statute. Comments by third parties at this stage of the proceeding 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. A waiver/suspension of the rules in the present case to permit a third party submission would not be justified in view of the intent of the legislation and rules to make reexamination under 35 U.S.C. 302 - 307 an *ex parte* proceeding. See *Syntex (U.S.A.)Inc. v. U.S. Patent and Trademark Office*, 11 USPQ2d 1866, 1869 (Fed. Cir. 1989)(third parties do not participate before the USPTO).

The Office in 1980 implemented the original 35 U.S.C. §§ 302-307 to provide a requester, other than the patent owner, only that degree of participation specifically provided for by §§302 and 304. The reexamination rules were drafted to make the the examination stage of the reexamination proceeding *ex parte* in keeping with its legislative history of the 1980 enactment, in order to reduce costs and to comply with the special dispatch requirement of the statute. It was, and is, the position of the Office that an *ex parte* reexamination proceeding best serves the interests of all, best complies with the intent of the 1980 statute, and is in keeping with its legislative history.

It is clear that Congress has endorsed the Office's 1980 decision to implement reexamination as an *ex parte* proceeding. Beginning in the early 1990's, Congress began a process to expand the 1980 reexamination statute to provide an increased level of third party requester participation in the proceeding. All of the bills introduced into Congress to this end merely modified the existing 1980 Chapter 30 reexamination statute to increase the level of third party requester participation in the various ways proposed in the bills. This methodology for expanding third party requester participation did not change until optional *inter partes* reexamination was

enacted in 1999. When Congress drafted the legislation for *inter partes* reexamination, it provided for an entirely new Chapter 31, directed to increased third party requester participation. The existing Chapter 30, on the other hand, was not changed other than **to revise the Chapter heading** by inserting "EX PARTE" before "REEXAMINATION OF PATENTS."

The Congressional methodology and mechanism of not modifying the existing Chapter 30 (1980) reexamination statute, but instead providing separate Chapters 30 and 31 shows a specific intent on the part of Congress to retain Chapter 30 as-is with respect to third party requester participation (as implemented by the Office). The insertion of "EX PARTE" before "REEXAMINATION OF PATENTS" drives home the point that Congress wanted to retain the examination stage of Chapter 30 as solely *ex parte*.

Petitioner argues that the provisions of 37 CFR 1.183 supersedes the above cited rules. 37 CFR 1.183 reads as follows:

> 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(h).

This rule provides the Office with the capacity to provide relief by waiving a rule (a) in an extraordinary situation, (b) where the waiver does not contravene the statute. Petitioner has not shown that the statute permits the examination stage of an *ex parte* reexamination proceeding to be conducted other than *ex parte*, nor has petitioner shown that the instant situation is extraordinary.

37 CFR 1.183, by its terms, cannot be employed to the contrary of any law.. The Office simply lacks the authority or discretion to relax any requirement of law. See *Baxter Int'l, Inc. v. McGaw, Inc.*, 149 F.3d 1321, 1334, 47 USPQ2d 1225, 1234-1235 (Fed. Cir. 1998)(the PTO cannot, by rule, or waiver of the rules, fashion a remedy that contravenes 35 U.S.C. §§ 112, 120); *A. F. Stoddard v. Dann,* 564 F.2d 556, 566, 195 USPQ 97, 105 (D.C. Cir 1977), (since the USPTO is an executive branch agency, it must follow the strict provisions of the applicable statute). Since the *ex parte* nature of the examination stage of the present *ex parte* reexamination proceeding is statutory, the rules cannot be waived to provide the relief that the petitioner seeks.

It is also to be noted that this situation is not an extraordinary situation. Rather, it is a situation for which 37 CFR 1.565(c) provides a remedy. Pursuant to 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."

By its terms, 37 CFR 1.565(c) provides that where a subsequent reexamination request is granted, the resulting reexamination proceeding will be merged with the ongoing reexamination proceeding. Thus, an avenue is provided for a third party to bring to light further information raising a substantial new question of patentability *not raised in the pending reexamination*. Since an alternative avenue to attain relief is available to requester, there is no necessity to invoke the extraordinary remedy of 37 CFR 1.183 to accomplish the same end. It is understood that if the requester's further information fails raise a substantial new question of patentability not raised in the pending reexamination, the subsequent reexamination request will not be granted. However, in that instance there is also no reason to waive the rules to permit the third party requester to bring it to the attention of the Office.

For the reasons set forth above, the present request for reconsideration of the April 15, 2004 decision is denied.

## CONCLUSION

1. The requester's petition under 37 CFR 1.181(a)(3) is:

   (A) **granted** to the extent that the Senior Legal Advisor's March 19, 2004 decision, and the present record, have been reviewed, and

   (B) **denied** as to making a change in the ultimate decision by the Senior Legal Advisor.

2. The requester's petition under 37 CFR 1.183 is **denied**.

3. The **April 15, 2004** requester petition papers are being **returned** to the requester, as improper papers. A copy of this decision will be made of record in the reexamination file.

4. The reexamination file is being forwarded to the Central Reexamination Unit to immediately **close** the file history entry for the **April 15, 2004** requester petition papers.

5. The reexamination file will then be forwarded to the examiner via the Group Director of Technology Center 3600, for consideration of the patent owner's amendment responding to the November 18, 2003 Office action, and the issuance of an Office action.

6. This decision may be viewed as a **final agency action** within the meaning of 5 U.S.C. 704 for purposes of seeking judicial review. See MPEP 1002.02.

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

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

April 19, 2005
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FROM DIRECTORS OFFICE

JAN 12 2006

TECHNOLOGY CENTER 3600

**FOR PATENT OWNER :**

David M. Thimmig
Mayer Brown & Platt
P.O. Box 2828
Chicago, IL 60690-2828

**FOR REQUESTOR:**

Hugh D. Jaeger
1000 Superior Blvd., Suite 302
Wayzata, MN 55391-1873

In re Reexam Control No. 90/006,508 :
Filed January 6, 2003 :
For U.S. Patent No. 5,050,353 : DECISION RETURNING
: IMPROPER PAPER
:

Papers were filed by the third party requester on November 14, 2005 and December 2, 2005 in the above-identified reexamination proceeding.

The active participation of the requester ends with any reply submitted under 37 CFR 1.535, and no further submissions on behalf of the requester will be acknowledged or considered and will be returned to the requester. See 37 CFR 1.550(g) and MPEP 2267.

Therefore, the papers filed by the requestor on November 14, 2005 and December 2, 2005 have not been considered. The submission cannot be returned in accordance with MPEP 2267 because the file is now in electronic format. These submission have been "closed" so that they are no longer viewable in electronic file. This decision will be made of record in the reexamination file.

John J. Love, Director
Patent Technology Center 3600
(571) 272-5250

kjd/kjd: 12/21/05

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MAR 14 2008

CENTRAL REEXAMINATION UNIT

Mr. Joseph J. Jochman (For Patent Owner)
Andrus, Sceales, Starke & Sawall LLP
100 East Wisconsin Avenue, Suite 1100
Milwaukee, Wisconsin 53202

In re Reexamination Proceeding :
David A. White :
Control No. 90/006,511 : DECISION GRANTING PETITION
Filed: January 10, 2003 :
U.S. Patent No. 5,156,811 :
:

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on January 4, 2008, for entry of late papers based upon unintentional delay.

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

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:

Item # (1) The requisite response - an Amendment After Board Decision in accordance with MPEP 1214.07, and confirmed as being a proper reply by the examiner of record and the Supervisory Patent Examiner (See MPEP 1002.02(d)(8).

Item # (2): The $1,540.00 petition fee under 37 CFR 1.17(m); an authorization to charge counsel's deposit account for the $1,540.00 petition fee under 37 CFR 1.17(m)) has been provided for the petition.

Item # (3): The requisite statement regarding the unintentional delay.

Accordingly, the petition for entry of the late papers is granted.

CONCLUSION

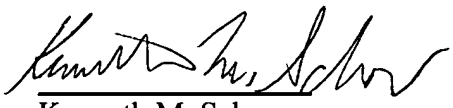
1. The petition under 37 CFR 1.137(b) is granted.

2. A fee in the amount of 1540 USD has been charged in accordance with petitioner's authorization.

3. Jurisdiction over the reexamination proceeding is being returned to Technology Center 1700, Art Unit 1797 for further examination, in due course, in light of the Amendment After Board Decision filed January 4, 2008.

4. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Jan Ludlow, in TC 1700 Art Unit 1797, who can be reached at (571)272-1260.

5. 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

3-11-08
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Paper No. 10

Docket Administrator
Avaya Inc.
307 Middletown-Lincroft Road
Room 1N-391
Lincroft NJ 07736

MAIL

SEP 2 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

Reexamination Proceeding: 90/006,516
Filed: January 17, 2003
Attorney Docket No.: **Bell 1-1-6-1-1-1-**
For: **FACSIMILE MACHINE HAVING USER NOTIFICATION CAPABILITY**

: DECISION GRANTING REQUEST
: TO RESTART PERIOD FOR REPLY

This is a decision on the August 25, 2004 request (see interview summary, paper no. 9), requesting that the shortened statutory period for reply set forth in the Office communication mailed on July 19, 2004 be restarted to run from the date on which the Office re-mails a complete Office action, including a copy of the Ichikawa (JP 401190067) reference to Patent Owner.

The request is **GRANTED**.

Patent Owner provided a statement that the Office communication in question was incomplete due to failure of the Office to supply a copy of the Ichikawa reference (JP 40119067) used in a rejection in the Office action mailed July 19, 2004. The requester did not notify the Office within one month of the mail date of the Office action; however, the requester did notify the Office within 6 weeks of the mail date of the Office action and prior to the expiration of the period for reply.

Accordingly, the request complies with the requirements set forth in MPEP Section 710.06 for setting a new period for reply substantially equaling the time remaining in the reply period. The request is granted and the period will be restarted to set a new 1-month period for reply from the date of the re-mailing of a complete Office action including a copy of the missing reference.

The reexamination file is being forwarded to TC 2600 Technical Support Staff for remailing of a complete Office action setting a new **1-month** period for reply. The new period for response will run from the date of the new mailing.

Mark Powell, Director
Technology Center 2600
Communications

mad

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

Docket Administrator
Avaya, Inc.
307 Middletown-Lincroft Road
Room 1N-391
Lincroft, NJ 07736

(For Patent Owner)

In re John F. Bell, et al :
Reexamination Proceeding : **DECISION**
Control No. 90/006,516 : **GRANTING**
Filed: January 17, 2003 : **PETITION**
For: U.S. Patent No. 5,127,047 :

MAILED
JUL 12 2005
REEXAM UNIT

This is a decision on the June 20, 2005 patent owner PETITION TO ACCEPT UNINTENTIONALLY DELAYED RESPONSE BY THE PATENT OWNER IN A REEXAMINATION PROCEEDING PURSUANT TO 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 fee of $1500 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. 501602, in accordance with petitioner's authorization in the first paragraph of the instant 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, an amendment after final Office action was filed with patent owner's June 20, 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 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.

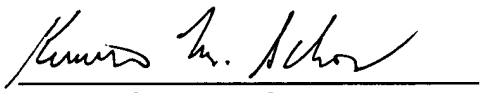
**CONCLUSION**

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

2. The reexamination file is being returned to Technology Center 2600 to, in due course, process the June 20, 2005 amendment after final Office action.

3. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Melur Ramakrishnaiah, in Technology Center Art Unit 2643, who can be reached at (571) 272-8098.

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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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/007,099<br>+90/006,517 | 06/25/2004 | 4706275 | 55771-140 | 8509 |

7590 12/03/2004

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

Jeffrey H. Ingerman, Esq.
Fish and Neave
1251 Avenue of the Americas
New York, NY 10020-1105

DATE MAILED: 12/03/2004 #9

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

cc: Third Party Requester as attached

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

David A. Spenard
McDermott Will & Emery LLP
600 13th Street, N.W.
Washington, DC 20005

# *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/006,517*.

PATENT NO. *4,706,275*.

ART UNIT *2600*.

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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COMMISSIONER FOR PATENTS
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Paper No. 9

| | | |
|---|---|---|
| Jeffrey Ingerman<br>Fish and Neave<br>1251 Avenue of the Americas<br>New York NY 10020-1104 | ) | FOR OWNER |
| David A. Spenard<br>McDermott Will & Emery LLP,<br>600 13th Street, N.W.<br>Washington, DC 20005 | ) | FOR THIRD PARTY REQUESTOR |
| In Re Kamil<br>Reexamination Proceeding<br>Control No. 90/006,517<br>Filed 1-17-03<br>For U.S. Patent No. 4,706,275 | ) | DECISION SUA SPONTE MERGING REEXAMINATION PROCEEDINGS |
| In Re Kamil<br>Reexamination Proceeding<br>Control No. 90/007,099<br>Filed 6-25-04<br>For U.S. Patent No. 4,706,275 | ) | |

The above noted reexamination proceedings are before the Director of Technology Center 2600 for consideration of merger of the proceedings under 37 CFR 1.56(c).

## BACKGROUND

1. Patent No. 4,706,275 issued on November 10, 1987.

2. A first request for reexamination, Control No. 90/006,517 ('517) was filed by the Third Party Requestor on January 17, 2003.

3. Reexamination was ordered on the '517 reexamination proceedings on April 4, 2003.

4. No Patent Owner's statement was filed in the '517 reexamination proceeding.

5. A second request for reexamination, Control No. 90/007, 099 ('099) was filed by the Second Third Party Requestor on June 25, 2004.

6. Reexamination was ordered on the '099 reexamination proceedings on August 27, 2004.

7. No Patent Owner's statement was filed in the '099 reexamination proceeding.

**DISCUSSION**

37 CFR 1.565(c) states:

> "If reexamination is ordered while a prior reexaminations is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under section 1.570".

**DECISION**

I. Merger of Proceedings

In accordance with 37 CFR 1.565(c), the '517 and '099 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for the same amendment's in all proceedings.

The Patent Owner is required to maintain the same claims and specification in 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 must contain the identifying data for each proceeding and will be physically entered in each reexamination proceeding 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 proceeding file. All papers filed by the Patent Owner must be served on the requestor and requestor will be sent copies of all papers mailed by the Office. See MPEP §2283.

A review of these reexamination files finds that both proceedings currently contain the same claims and specification and therefore the Patent Owner need not take any action.

The merged proceedings are being forwarded to the examiner for appropriate action. An Office action will be mailed in due course.

Mark R. Powell

Mark Powell, Director
Technology Center 2600
Communications & Information Processing

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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. |
|---|---|---|---|---|
| 90/005,924 | 02/06/2001 | 5837126 | 39591-039 | 2910 |

7590 07/21/2003

Gregory F. Wirzbicki
Patent Department
Union Oil Company of California
1150 CONNECTICUT AVENUE, NW SUITE 1025
WASHINGTON, DC 20036

| EXAMINER |
|---|

| ART UNIT | PAPER NUMBER |
|---|---|

DATE MAILED: 07/21/2003 30

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CST

Paper No. 30

Gregory F. Wirzbicki
C/O Ingrid Impink
Unocal Corporation
1150 Connecticut Avenue, N.W.
Suite 1025
Washington, DC 20036

(for Patent Owner)

Robert L. Price
McDermott, Will & Emery
600 13th Street, NW
Washington, DC 20005-3096

(for Third Party)

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. 90/005,924
Filed: February 6, 2001
For: U.S. Patent 5,837,126

In re Jessup et al
Reexamination Proceeding
Control No. 90/006,518
Filed: January 17, 2003
For: U.S. Patent 5,837,126

**DECISION MERGING REEXAMINATION PROCEEDINGS**

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

**BACKGROUND**

1. United States Patent 5,837,126, issued November 17, 1998, is the subject of Reexamination Control Nos. 90/005,924 and 90/006,518.

2. A first request for reexamination, assigned Reexamination Control No. 90/005,924 ('5924), was filed February 6, 2001 by Robert L. Price of McDermott, Will and Emery. The request urged that a substantial new question of patentability was raised by the teachings of (a) SAE Paper No. 730474, "An Evaluation of the Performance and Emissions of a CRF Engine Equipped with a Prechamber"; (b) "Carburetor Evaporation Losses", SAE Paper No. 12B; (c) CRC Report No. 510, "1978 Fuel Rating Program: Road Octane Performance in 1978 Model Cars"; (d) CRC Report No. 477, "1973 CRC Fuel Rating Program Part I: Road Octane Performance in 1973 Model Cars"; (e) CRC Report No. 494, "1975 CRC Fuel Rating Program: Road Octane Performance in 1975 Model Cars"; (f) File History of U.S. Patent 4,812,146 to P.J. Jessup; (g) SAE Paper No. 730616, "Gasolines for Low-Emission Vehicles"; (h) API Publication 4310; (i) California Air Resources Board Publication #SS-86-01, "California Perspective on Controlling Gasoline Evaporative Emissions"; (j) Kirk-Othmer Encyclopedia of Chemical Technology, Third Edition; (k) "A New Approach to Blending Octanes", Healy et al; (l) "The Interaction Approach to Gasoline Blending", William E. Morris; (m) SAE Publication 841206, Schmidt et al; (n) SAE Publication 841210, Dorn et al; and (o) GAO Report to Chairman, Subcommittee on Oversight and Investigations, Committee on Energy and Commerce, House of Representatives.

3. Patent owner filed a petition under 37 CFR 1.182 and 1.183 on March 28, 2001 requesting that the Commissioner waive the provisions of 37 CFR 1.530 and permit entry and consideration of this petition prior to the initial determination of the request for reexamination.

4. The petition filed on March 28, 2001 was dismissed on April 30, 2001.

5. The request for reexamination for '5924 was denied on May 2, 2001.

6. Robert L. Price of McDermott, Will and Emery petitioned for reversal of the examiner's decision denying the request for reexamination on June 1, 2001.

7. The petition for reversal of the examiner's decision denying the request for reexamination was granted on January 24, 2002. The request for reexamination for '5924 was thus granted.

8. A first Office action for '5924 was mailed on June 26, 2002. A supplemental Office action was subsequently mailed on July 25, 2002.

9. Patent owner timely responded to the first Office action on September 30, 2002 (certificate of mailing September 25, 2002).

10. A second request for reexamination, assigned Reexamination Control No. 90/006,518 ('6518), was filed January 17, 2003 by Michael S. Marcus of Morgan & Finnegan, LLP. The request urged that a substantial new question of patentability was raised by the teachings of (a) the January 17, 1972 Oil and Gas Journal publication ("GM-1"), either alone or in view of an August 1987 Notice of Proposed Rule Making published by the EPA ("the EPA RVP limits"); (b) the October 2, 1972 Oil and Gas Journal publication ("GM-2"), either alone or in view of the May 1973 Adams API publication ("Adams") and/or the EPA RVP limits; (c) GM-1, either alone or in view of the EPA RVP limits, together with the Kirk-Othmer publication describing gasoline blending and (d) GM-2, either alone or in view of Adams and/or the EPA RVP limits, together with Kirk-Othmer.

11. Reexamination was ordered for '6518 on March 18, 2003.

## DISCUSSION

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

> If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* proceeding has not been terminated, the *ex parte* reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570.

As noted in the above review of facts, reexamination has been ordered in each of the above reexamination proceedings. Accordingly, merger of the proceedings under 37 C.F.R. 1.565(c) is appropriate. MPEP 2283 further sets forth:

> If the second request is based upon essentially the *same* patents or publications as in the first request or on patents or printed publications which raise essentially the same issues as those raised in the first request, and if reexamination is ordered, the examination of the merged proceeding will continue at the point reached in the first reexamination proceeding. If, however, *new* patents or printed publications are presented in the second request which raise different questions than those raised in the first request, then prosecution in the merged reexamination proceeding will be reopened, if applicable, to the extent necessary to fully treat the questions raised.

## DECISION

I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. 1.565(c), the 90/005,924 and 90/006,518 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. Since the claims are the same in both files, a "housekeeping amendment" is NOT needed. See MPEP 2283, "Merger of Reexaminations."

III. CONDUCT OF MERGED PROCEEDING

The reexamination files shall be forwarded to the examiner for consideration of the Request for Reexamination in the '6518 reexamination proceeding, as well as consideration of the RESPONSE TO REJECTION, submitted September 30, 2002 (certificate of mailing September 25, 2002), in the '5924 reexamination proceeding.

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, **filed in duplicate**, each bearing a signature and identifying data for both files, for entry into each file. All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control Nos. 90/005,924 and 90/006,518 as:

Gregory F. Wirzbicki
C/O Ingrid Impink
Unocal Corporation
1150 Connecticut Avenue, NW
Suite 1025
Washington, D.C. 20036

Also, until further notice, courtesy copies of all correspondence will be mailed to the California Attorney General's Office.

**CONCLUSION**

Reexamination Control Nos. 90/005,924 and 90/006,518 are merged. The merged reexamination files are being forwarded to the examiner for preparation of an Office action, to be issued in due course.

Jacqueline M. Stone

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

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/005,924;<br>90/006,518;<br>90/007,273 | 02/06/2001 | 5837126 | 39591-039 | 2910 |

7590 05/10/2005

EXAMINER

Gregory F. Wirzbicki
Patent Department
Union Oil Company of California
1150 CONNECTICUT AVENUE, NW SUITE 1025
WASHINGTON, DC 20036

| ART UNIT | PAPER NUMBER |
|---|---|
| | 39 |

DATE MAILED: 05/10/2005

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Robert L. Price
McDermott, Will & Emery
600 13th Street, NW
Washington, DC 20005-3096

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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. 90/005,924
Filed: February 6, 2001
For: U.S. Patent 5,837,126

In re Jessup et al
Reexamination Proceeding
Control No. 90/006,518
Filed: January 17, 2003
For: U.S. Patent 5,837,126

In re Jessup et al
Reexamination Proceeding
Control No. 90/007,273
Filed: October 29, 2004
For: U.S. Patent 5,837,126

**DECISION MERGING REEXAMINATION PROCEEDINGS**

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

**BACKGROUND**

1. United States Patent 5,837,126, issued November 17, 1998, is the subject of Reexamination Control Nos. 90/005,924; 90/006,518 and 90/007,273.

2. A first request for reexamination, assigned Reexamination Control No. 90/005,924 ('5924), was filed February 6, 2001 by Robert L. Price of McDermott, Will and Emery. The request urged that a substantial new question of patentability was raised by the teachings of (a) SAE Paper No. 730474, "An Evaluation of the Performance and Emissions of a CRF Engine Equipped with a Prechamber"; (b) "Carburetor Evaporation Losses", SAE Paper No. 12B; (c) CRC Report No. 510, "1978 Fuel Rating Program: Road Octane Performance in 1978 Model Cars"; (d) CRC Report No. 477, "1973 CRC Fuel Rating Program Part I: Road Octane Performance in 1973 Model Cars"; (e) CRC Report No. 494, "1975 CRC Fuel Rating Program: Road Octane Performance in 1975 Model Cars"; (f) File History of U.S. Patent 4,812,146 to P.J. Jessup; (g) SAE Paper No. 730616, "Gasolines for Low-Emission Vehicles"; (h) API Publication 4310; (i) California Air Resources Board Publication #SS-86-01, "California Perspective on Controlling Gasoline Evaporative Emissions"; (j) Kirk-Othmer Encyclopedia of Chemical Technology, Third Edition; (k) "A New Approach to Blending Octanes", Healy et al; (l) "The Interaction Approach to Gasoline Blending", William E. Morris; (m) SAE Publication 841206, Schmidt et al; (n) SAE Publication 841210, Dorn et al; and (o) GAO Report to Chairman, Subcommittee on Oversight and Investigations, Committee on Energy and Commerce, House of Representatives.

3. Patent owner filed a petition under 37 CFR 1.182 and 1.183 on March 28, 2001 requesting that the Commissioner waive the provisions of 37 CFR 1.530 and permit entry and consideration of this petition prior to the initial determination of the request for reexamination.

4. The petition filed on March 28, 2001 was dismissed on April 30, 2001.

5. The request for reexamination for '5924 was denied on May 2, 2001.

6. Robert L. Price of McDermott, Will and Emery petitioned for reversal of the examiner's decision denying the request for reexamination on June 1, 2001.

7. The petition for reversal of the examiner's decision denying the request for reexamination was granted on January 24, 2002. The request for reexamination for '5924 was thus granted.

8. A first Office action for '5924 was mailed on June 26, 2002. A supplemental Office action was subsequently mailed on July 25, 2002.

9. Patent owner timely responded to the first Office action on September 30, 2002 (certificate of mailing September 25, 2002).

10. A second request for reexamination, assigned Reexamination Control No. 90/006,518 ('6518), was filed January 17, 2003 by Michael S. Marcus of Morgan & Finnegan, LLP. The request urged that a substantial new question of patentability was raised by the teachings of (a) the January 17, 1972 Oil and Gas Journal publication ("GM-1"), either alone or in view of an August 1987 Notice of Proposed Rule Making published by the EPA ("the EPA RVP limits"); (b) the October 2, 1972 Oil and Gas Journal publication ("GM-2"), either alone or in view of the May 1973 Adams API publication ("Adams") and/or the EPA RVP limits; (c) GM-1, either alone or in view of the EPA RVP limits, together with the Kirk-Othmer publication describing gasoline blending and (d) GM-2, either alone or in view of Adams and/or the EPA RVP limits, together with Kirk-Othmer.

11. Reexamination was ordered for '6518 on March 18, 2003.

12. A Decision Merging Reexamination Control Nos. 90/005,924 and 90/006,518 was mailed on July 21, 2003.

13. A non-final Office action for the merged proceeding was mailed on March 22, 2004.

14. Patent owner responded to the non-final action on May 12, 2004.

15. A third request for reexamination, assigned Reexamination Control No. 90/007,273 ('7273), was filed October 29, 2004 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) CRC Report No. 464 describing the Fuel 253 Specifications, either alone or in view of the Kirk-Othmer publication describing gasoline blending and (b) CRC Report No. 493 describing the Fuel 287 Specifications, either alone or in view of the Kirk-Othmer publication describing gasoline blending.

16. Reexamination was ordered for '7273 on January 10, 2005.

**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 90/005,924; 90/006,518 and 90/007,273 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 all files throughout the merged proceeding. Since the claims are the same in all 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 '7273 reexamination proceeding, as well as consideration of the response, submitted May 12, 2004, in the merged reexamination proceeding including '5924 and '6518.

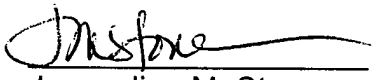
All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for all files and will be physically entered in each reexamination file. 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. 90/005,924; 90/006,518 and 90/007,273 as:

Gregory F. Wirzbicki
C/O Ingrid Impink
Unocal Corporation
1150 Connecticut Avenue, NW
Suite 1025
Washington, D.C. 20036

Also, until further notice, courtesy copies of all correspondence will be mailed to the California Attorney General's Office.

**CONCLUSION**

Reexamination Control Nos. 90/005,924; 90/006,518 and 90/007,273 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

#165
DW

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OCT 15 2004

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TC 3600

FOR PATENT OWNER:

Marshall Gerstein & Borun
233 South Wacker Drive
6300 Sears Tower
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FOR REQUESTER:

Lawrence F. Scinto
Fitzpatrick Cella Harper & Scinto
30 Rockefeller Plaza
New York, NY 10112-3801

Reexamination Control No. 90/006,519
Filed: January 21, 2003
For: Patent No. 4,725,259

DECISION ON PETITION
FOR THE ACCEPTANCE
OF LATE PAPERS

This is in reply to petitioner's petition to accept late papers filed June 21, 2004 and supplemented on October 12, 2004. 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 December 4, 2003 wherein a one-month shortened statutory period for response was set. Petitioner alleges that a timely response was filed on December 11, 2003. Petitioner has submitted copy of the amendment, which bears a Certificate of Facsimile Transmission indicating that the amendment was timely faxed on December 11, 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 process the amendment filed December 11, 2003.

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

kjd: 10/13/04

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/006,529 | 02/10/2003 | 6185681 | | 8234 |

7590 10/21/2004

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| EXAMINER | |
|---|---|
| Darrow, Justin | |
| ART UNIT | PAPER NUMBER |
| 2132 | 19 |

DATE MAILED: 10/21/2004

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Paper No. 19

Steven C. Sereboff
SoCal IP Law Group
310 N. Westlake Boulevard
Suite 120
Westlake Village, California 91362

**FOR PATENT OWNER**

In re Reexamination of:
U.S. Patent No. 6,185,681
Reexamination Control No.
90/006,529
Filed: February 10, 2003
For: METHOD OF TRANSPARENT ENCRYPTION AND DECRYPTION FOR AN ELECTRONIC DOCUMENT MANAGEMENT SYSTEM

**DECISION ON PETITION FOR EXTENSION OF TIME TO FILE APPEAL BRIEF**

This decision is in response to a petition filed October 13, 2004 requesting an extension of time in which to file an appeal brief in the above captioned reexamination proceeding.

The petition is DISMISSED as premature.

A final rejection was mailed on August 9, 2004 setting a 2 month period for reply. An amendment[1] under 37 C.F.R. §1.116 and accompanying affidavits were timely filed[2] by Express mail (EV517968741US) on October 12, 2004 and received in the Office on October 14.

Patent Owner alleges that a Notice of Appeal was filed on August 19, 2004 thus requiring the Appeal Brief to filed by October 19 absent an extension of time. Patent Owner requests that either (a) an extension of time be granted until the response to the after final amendment is received or (b) cancellation of the Notice of Appeal.

---

[1] The amendment is not compliant with 37 C.F.R. §1.530. Claims 12 and 29 should be underlined and bracketed with respect to the originally issued patent claims.

[2] October 12 was the first business day following Saturday October 9, 2004.

To date, the Office has no record of the receipt of the Notice of Appeal allegedly filed August 19, 2004 and Patent Owner has not provided proof of such filing. Therefore, at this point there is no time period running for filing of the Appeal Brief. In the event that the Notice of Appeal is received in the Office petition may be appropriate.

Note further, that the 2-month period to file an Appeal Brief ordinarily commences when the Notice of Appeal is ***received*** in the Office - not upon the date of submission. (*See,* MPEP 1206.) Therefore, if Patent Owner establishes that the Notice of Appeal was **received** by the Office then the period for filing an Appeal would indeed commence as of the date of receipt and petition may be necessary. However, if patent Owner merely establishes that the Notice of Appeal was submitted (e.g., by meeting the conditions of 37 C.F.R. §1.8(b)) then the period for filing the Appeal Brief would not commence until the mailing of the decision accepting the paper as timely filed.

In reexamination proceedings, the filing of a first timely response to a final rejection is construed as a request for a one-month extension of time which is routinely granted. Patent Owner will be afforded a reasonable period "to consider the ruling of the examiner and act on it". (See MPEP §2265 "FINAL ACTION TIME FOR RESPONSE".) In no event will the period for response be extended outside 6 months from the August 9, 2004 mail date of the Office action.

Inquiries with respect to this decision may be directed to Special Programs Examiner 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

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. |
|---|---|---|---|---|
| 90/006,533 | 01/30/2003 | 5436960 | | 4340 |

+ 90/006675

803 7590 08/23/2004

| EXAMINER | |
|---|---|

STURM & FIX LLP
206 SIXTH AVENUE
SUITE 1213
DES MOINES, IA 50309-4076

| ART UNIT | PAPER NUMBER |
|---|---|

DATE MAILED: 08/23/2004 #13

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

ccd: Third Party Requester, as on attached decision

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. 13

| | | |
|---|---|---|
| Sturm & Fix LLP<br>206 Sixth Avenue<br>Suite 1213<br>Des Moines, IA 50309-4076 | ) | For Patent Owner |
| David Stewart<br>Allen Dyer Doppelt Milbrath & Gilchrist, PA<br>255 S. Orange Avenue<br>Suite 1401<br>Orlando, FL 32801 | ) | For Third Party Requester |
| In re Campana et al.<br>Reexamination Proceeding<br>Control No.: 90/006,533<br>Filed: January 30, 2003<br>For: U.S. Patent 5,436,960 | ) | DECISION *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS |
| In re Campana et al.<br>Reexamination Proceeding<br>Control No.: 90/006,675<br>Filed: June 24, 2003<br>For: U.S. Patent 5,436,960 | ) | |

The above noted reexamination proceedings are before the Director of Technology Center 2600 for consideration of merger of the proceedings under 37 CFR 1.56(c).

## BACKGROUND

1. Patent 5,436,960 issued on July 25, 1995.

2. A request for reexamination, Control No. 90/006,533 ('533) was filed by the Third Party Requester on January 30, 2003.

3. Reexamination was ordered on the '533 reexamination proceeding on April 17, 2003.

4. A request for reexamination, Control No. 90/006,675 ('675) was filed by the Third Party Requester on June 24, 2003.

5. Reexamination was ordered on the '675 reexamination proceeding on September 3, 2003.

6. No Patent Owner Statement was filed in the '675 reexamination proceeding.

7. A waiver to file Patent Owner Statement was filed in the '533 reexamination proceeding on August 14, 2003. Certificate of Service on the Third Party Requester for this paper was filed on February 25, 2004.

## 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 '533 and '675 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 all proceedings.

The Patent Owner is required to maintain the same claims and specification in both files.

**III.** Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action, which applies to both proceedings. All papers issued by the Office or filed by the Patent Owner must contain the identifying data for both proceedings and will be physically entered in each reexamination file which will be separately maintained. All papers filed by the Patent Owner must also consist of a single response, filed in duplicate, each bearing an original signature, for entry into each file. All papers filed by the Patent Owner must be served on the requestor and requestor will be sent copies of all papers mailed by the Office. See MPEP 2283.

A review of these reexamination files finds that both proceedings currently contain the same claims and specification and therefore the Patent Owner need not take any action.

The merged proceedings are being forwarded to the examiner for appropriate action. An Office action will be mailed in due course.

Mark Powell, Director
Technology Center 2600
Communications

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REEXAM UNIT

William Wright
STURM and FIX, LLP
206 Sixth Avenue
Suite 1213
Des Moines, IA 50309-4076

(For Patent Owner)

NOVAK DRUCE & QUIGG, LLP
1300 Eye Street NW
400 East Tower
Washington, DC 20005

(For Requester)

In re Thomas J. Campana, Jr. et al.
*Inter partes* Reexamination Proceeding
Control No. 90/006,675
Filed: June 24, 2003
For: U.S. Patent No. 5,436,960

In re Thomas J. Campana, Jr. et al.
Director Ordered
*Ex parte* Reexamination Proceeding
Control No. 90/006,533
Filed: January 30, 2003
For: U.S. Patent No. 5,436,960

: DECISION GRANTING PETITION
: FOR EXTENSION OF TIME

This is a decision on the January 12, 2006, patent owner petition titled "REVISED PETITION FOR THE OFFICE TO FOLLOW ANNOUNCED POLICY AND PROVIDE EQUAL TREATMENT TO PATENT OWNER BY GRANTING A TWO-MONTH PERIOD OF TIME TO RESOND TO THE OFFICE ACTION DATED DECEMBER 30, 2005 " The present petition (1) urges that a two month period should have been set by the Office Action of December 15, 2005, and should be re-set accordingly, and (2) revises its request for an additional month to respond to the Office Action of December 15, 2005, to thereby extend the deadline for response to be February 15, 2006.

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

The petition is granted as to the request for an additional month to respond to the Office Action of December 15, 2005, for the reasons set forth below.

The petition is dismissed as to the request that the time period set in the Office action be reset, since such request is now moot for the reasons set forth below.

## DISCUSSION

The patent owner on January 03, 2006, submitted a petition that urged that a two month period should have been set by the Office Action of December 15, 2005, and should be re-set accordingly, and (2) requested an additional month to respond to the Office Action of December 15, 2005, to thereby extend the deadline for response to be February 15, 2006. The January 03, 2006 petition for extension of time was accompanied by an authorization to debit a deposit account, accordingly the $200.00 petition fee required by 37 CFR 1.515(c) has been charged to Account No. 05-02-06. Thus, the appropriate fee has been paid.

The instant revised petition seeks an additional month in which to file a response to the Office action dated December 15, 2005, which action set a one month date for filing a response thereto. The Office action in question is a non-final action.

37 CFR 1.550 (c ) states:

> (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.

Addressing the requirement of 37 CFR 1.550 (c) to make a showing of "sufficient cause" to grant an extension of time request, MPEP 2265 states, in pertinent part:

> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. 305) 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 patent owner in this revised request, positively states that its expert, Dr. Rhyne, will be available the week of January 23 , 2006, to work on the response for the above identified proceedings. In addition the patent owner states that "With the extremely short availability window Dr. Rhyne presently has, an additional month is needed to accomplish that without seriously prejudice to NTP's ability to present all of the facts necessary to make its record."

Patent owner further states in the renewed petition for extension of time that the option of engaging another expert instead of Dr. Rhyne has been considered, but at present, patent owner has determined that this option is unrealistic and impractical. The renewed petition states that, aside from Dr. Rhyne's familiarity evaluating the patent that is the subject of this merged reexamination proceeding and other related patents, any other expert having the appropriate qualifications who might be found would need to spend several weeks, or perhaps months, getting up to the level of understanding of the Campana patents and the art generally that equals Dr. Rhyne's.

It is considered that the renewed petition expressly states the steps taken by patent owner, and expressly states when Dr. Rhyne will be available to provide an analysis and formulate an expert opinion on the instant proceedings, thereby providing sufficient basis as to why an extension of time should be granted. Thus, when balancing the needs for special dispatch with the need to provide the patent owner with an opportunity to have its expert evaluate the response of record it has been determined that the need for the expert, at this time and under the instant circumstances, contravenes the requirement for "special dispatch." However, the patent owner is advised that unavailability of Dr. Rhyne beyond the deadline as extended by one month, or the difficulty of securing the services of a second expert meeting patent owner's criteria, and the difficulty of bringing a second expert "up to speed" in advance of the time necessary to prepare a response by the deadline, as extended by one month, will **not** be considered to present a compelling reason establishing an extraordinary situation in support of the grant of a second extension of time.

## DECISION

I. For the reasons stated above, the petition has established sufficient cause to extend the time period, and is granted.

II. Since the petition has been granted for an extension for one month of time, the patent owner request that the time period set in the Office action be reset is dismissed as moot, and need not be addressed further in this decision.

III. Future requests for extensions of time will be strictly evaluated for compliance with 37 CFR 1.550. In light of the length of the pendency of this proceeding and the similar issues shared with other pending proceedings, future petitions for extension of time will be granted only upon a showing of sufficient cause that takes into account the related reexamination proceedings and the statutory requirement that reexamination proceedings must be conducted with "special dispatch."

## CONCLUSION

1. The petition is granted as to the request for an additional month to respond to the Office Action of December 15, 2005. The patent owner's period for response set in the December 15, 2005 Office action is hereby extended to expire on February 15, 2006.

2. The petition is dismissed as to the request that the time period set in the Office action be reset, since such request is now moot.

3. Patent owner is reminded that following the Office's prior guidance on where to submit papers may avoid delays in processing future on. **Future correspondence is to be submitted via one of the following options**:

By Mail to: Mail Stop *Inter Partes* 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
Attention: Central Reexamination Unit
Randolph Building
401 Dulany St.
Alexandria, VA 22314

4. Telephone inquiries with regard to this decision should be directed to Mark Reinhart of the Central Reexamination Unit Art Unit at (571)-272-1611, and in his absence to the undersigned at (571) 272-1596.

Lissi Mojica Marquis, Director
Central Reexamination Unit

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

William R. Wright
STUM & FIX LLP
206 Sixth Avenue
Suite 1213
Des Moines, IA 50309-4076

(For Patent Owner)

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MAR 01 2006
REEXAM UNIT

Donald J. Quigg
NOVAK DRUCE DELUCA & QUIGG LLP
1300 Eye Street N. W.
400 East Tower
Washington, DC 20005

(For Third Party Requester)

In re Thomas J. Campana, Jr. *et al*
Reexamination Proceeding
Control No. 90/006,533
Filed: January 30, 2003
For U.S. Patent No.5,436,960

In re Thomas J. Campana, Jr. *et al*
Reexamination Proceeding
Control No. 90/006,675
Filed: June 24, 2003
For U.S. Patent No. 5,436,960

In re Thomas J. Campana, Jr. *et al*
Reexamination Proceeding
Control No. 90/007,731
Filed: September 27, 2005
For U.S. Patent No. 5,436,960

DECISION,
*SUA SPONTE,*
MERGING
REEXAMINATION
PROCEEDINGS
PURSUANT TO
37 C.F.R. § 1.565(c)

The above-identified reexamination files are before the Director of the Central Reexam Unit 3999, for consideration of merger of reexamination control number 90/007,731 (the '731 proceeding) with the previously merged reexamination control numbers 90/006,533 (the '533 proceeding) and 90/006,675 (the '675 proceeding) pursuant to 37 C.F.R. § 1.565(c).

## BACKGROUND

1. Patent No. 5,436,960 issued on July 25, 1995.

2. The '533 reexamination proceeding, filed on January 30, 2003, is a reexamination proceeding that was requested by a third party requester.

3. An order granting reexamination in the '533 reexamination proceeding was mailed on April 17, 2003.

4. The '675 reexamination proceeding, filed on June 24, 2003, is a reexamination proceeding that was requested by a third party requester.

5. An order granting reexamination in the '675 reexamination proceeding was mailed on September 3, 2003.

6. The '533 and '675 proceedings were merged to provide a single consolidated proceeding on August 23, 2004.

7. A non-final Office action was mailed on April 19, 2005 in the previously merged proceedings.

8. A response to the April 19, 2005, Office action was timely filed on July 19, 2005. The response added claims 90 to 182 to the merged proceedings. However, the amendment was canceled following notification of fee deficiency in the Interview Summary mailed on November 18, 2005.

9. An amendment with proper fee was filed on November 25, 2005 in the '533 and '675 reexamination proceedings. The amendment canceled claims 90 to 182 and added claims 183 to 200.

10. A non-final Office action was mailed on December 15, 2005 in the previously merged proceedings.

11. A response to the December 15, 2005 Office action was timely filed on February 15, 2006. The response added claims 201 to 233.

12. A Final Office action was mailed on February 24, 2006 in the previously merged proceedings.

13. The '731 proceeding was filed on September 27, 2005 by a third party requester.

14. The third party requester's correspondence address is the same in each of the above mentioned proceedings.

15. An order granting reexamination in the '731 reexamination proceeding was mailed on October 14, 2005.

16. There are no amendments to the '731 reexamination proceeding.

## 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 , *supra*, reexamination was previously ordered in the '533 and '675 reexamination proceedings, and these proceedings have previously been merged. Reexamination has been ordered in the '731 proceeding.

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 90/006,533, 90/006,675 and 90/007,731 reexamination proceedings are hereby 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 '6,533 and '6,675 reexamination proceeding. Patent owner is required to maintain the same claims and specification in all merged 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.

### 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. 90/006,533, 90/006,675 and 90/007,731 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.

All correspondence regarding these proceedings should 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

Telephone inquiries with regard to this decision should be directed to Mark Reinhart, Special Program Examiner in the Central Reexamination Unit, Art Unit 3992, at (571) 272-1611

M Reinhart SPRE-CRU-3992
Lissi M. Marquis,
Director,
Central Reexamination Unit

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COMMISSIONER FOR PATENTS
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William R. Wright
Sturm & Fix LLP
206 Sixth Avenue
Des Moines, IA 50309-4076

(For Patent Owner)

Novak Druce & Quigg LLP
1300 Eye Street NW
Suite 400 East Tower
Washington, DC 20005

(For Third Party Requester)

MAILED

AUG 23 2006

CENTRAL REEXAMINATION UNIT

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/006,533
Filed: January 30, 2003
For: U.S. Patent No. 5,436,960

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No. : 90/006,675
Filed: June 24, 2003
For: U.S. Patent No. 5,436,960

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/007,731
Filed: September 27, 2005
For: U.S. Patent No. 5,436,960

**DECISION, *SUA SPONTE*, DISMISSING PETITION AND "RETURNING" IMPROPER PAPERS**

This is a decision on the June 23, 2006 patent owner petition styled "Petition Pursuant to 37 CFR 1.181 or Alternatively, 37 CFR 1.182 OR Alternatively 37 CFR 1.183 to Reconsider Decision Returning Paper and Enter the Papers into the Official Record." [1]

The petition and the above-captioned reexamination proceedings are before the Office of Patent Legal Administration for consideration.

The petition is dismissed and its attachments are returned to the patent owner for the reasons discussed below.

[1] The present petition is, facially, fully treatable pursuant to the provisions of 37 CFR 1.181. Accordingly, it is manifestly unnecessary to consider the petition under either 37 CFR 1.182 or 37 CFR 1.183. No fee is required.

## REVIEW OF SALIENT FACTS

1. U.S Patent number 5,436,960 ("the '960 patent") issued to Campana *et al* on July 25, 1995 from an application filed on May 20, 1991.

2. On January 30, 2003, a request for *ex parte* reexamination of the '960 patent was filed by a third party requester and assigned control number 90/006,533 ("the '533 reexamination proceeding").

3. On April 17, 2003, the examiner's Order Granting *Ex Parte* Reexamination for the '533 reexamination proceeding was mailed.

4. On June 24, 2003, a second request for ex *parte* reexamination of the '960 patent was filed by the same third party requester, and assigned control number 90/006,675 ("the '675 reexamination proceeding").

5. On September 3, 2003, the examiner's Order Granting *Ex Parte* Reexamination for the '675 reexamination proceeding was mailed.

6. On August 23, 2004, the Technology Center Director issued a decision, *sua sponte*, by which the '533 reexamination proceeding and the '675 reexamination proceeding were merged into a single combined reexamination proceeding.

7. On September 27, 2005, third party requester filed a third request for *ex parte* reexamination of the '960 patent, which was assigned control number 90/007,731 ("the '731 reexamination proceeding").

8. On October 14, 2005, the examiner's Order Granting *Ex Parte* Reexamination for the '731 reexamination proceeding was mailed.

9. On January 4, 2006, a Freedom of Information Act ("FOIA") Request was made to the Office requesting the Office's communications with third parties regarding the present reexamination proceedings and pending reexamination proceedings being conducted on other of patent owner's patents.

10. The Office responded to the FOIA request through letters dated between February 8 and March 24, 2006. [2]

11. Following prosecution on the patentability of the '960 patent claims, a final rejection Office action was issued in the merged reexamination proceeding on February 24, 2006.

12. On March 1, 2006, the Central Reexamination Unit (CRU) Director issued a decision, *sua sponte*, by which the '533 reexamination proceeding, the '675 reexamination proceeding and the '731 reexamination proceeding were merged into a single merged reexamination proceeding. [3]

---

[2] An additional response to the FOIA request was mailed by the Office on June 15, 2006 and received by patent owner on June 16, 2006.

[3] Jurisdiction of the merged '533 and '675 reexamination proceedings had previously been transferred from the Technology Center to the CRU.

13. On April 24, 2006, patent owner filed both a notice of appeal and an information disclosure statement (IDS) in the single combined reexamination proceeding.

14. Also on April 24, 2006, patent owner filed a paper styled as a response to the final rejection, which included a traverse of the final rejection, copies of material obtained as a result of the FOIA request, and a number of statements in support of patent owner's traverse.

15. On May 17, 2006, the CRU Director mailed a decision returning the April 24, 2006 patent owner response to the final rejection noted in Fact 14 above without consideration on the merits. The return was based on the grounds that the papers filed were improper because they were not limited to consideration of prior patents and printed publications and also because portions were not in compliance with the 37 CFR 1.3 requirements for decorum and courtesy. Accordingly, the returned response was not entered into the record.

16. On May 22, 2006, patent owner filed a redacted version of the April 24, 2006 response, limited to material addressing the outstanding final rejection Office action, which has been entered into the IFW record.

17. On June 23, 2006, patent owner filed the present petition requesting reconsideration of the CRU Director's May 17, 2006 decision. Patent owner has attached to the petition the material that was refused entry and returned (by the CRU Director's May 17, 2006 decision), for entry into the record as part of patent owner's response to the February 24, 2006 final Office action.

## DECISION DISMISSING THE THIRD PARTY REQUESTER PETITION AND RETURNING PAPERS FILED WITH THE PETITION

I. Relevant Statutes, Regulations and Practice

35 U.S.C. § 132 provides:

> "(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.
>
> (b) The Director shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant. The Director may establish appropriate fees for such continued examination and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under section 41(h)(1) of this title."

35 U.S.C. § 134(b) provides:

> "A patent owner in any reexamination proceeding may appeal from the final rejection of any claim by the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal."

35 U.S.C. § 305 provides, in part:

"After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent."

35 U.S.C. § 306 provides:

"The patent owner involved in a reexamination proceeding under this chapter may appeal under the provisions of section 134 of this title, and may seek court review under the provisions of sections 141 to 145 of this title, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent."

37 CFR 1.3 provides:

"Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Director and will not be entered. A notice of the non-entry of the paper will be provided. **Complaints against examiners and other employees must be made in correspondence separate from other papers.**" [Emphasis added.]

37 CFR 1.4(c) provides:

"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."

37 CFR 1.113(a) provides, in part:

"On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon ... for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. **Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181).** ..." [Emphasis added.]

37 CFR 1.116(a)-(e) provide, in part:

"(a) An amendment after final action must comply with § 1.114 or this section.

(b) After a final rejection or other final action (§ 1.113) ... in an ex parte reexamination filed under § 1.510 ... 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 ... patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

(c) The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the ... reexamination proceeding from its condition as subject to appeal or to save ... the reexamination prosecution from termination under § 1.550(d) ... .

(d) (1) ...
(2) Notwithstanding the provisions of paragraph (b) of this section, an amendment made after a final rejection or other final action (§ 1.113) in an ex parte reexamination filed under §1.510 ... may not

cancel claims where such cancellation affects the scope of any other pending claim in the reexamination proceeding except ... as permitted by § 41.77(b)(1) of this title.

(e) An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) ... in an ex parte reexamination filed under § 1.510 ... but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. "

37 CFR 1.181(a)(1) provides that petition may be taken to the Director:

"**From any action** or requirement of any examiner in the ex parte prosecution of an application, or **in ex parte** or inter partes prosecution **of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court.**" [Emphasis added.]

37 CFR 1.550(a) and (b) provide, in part:

"(a) All *ex parte* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office. **After issuance of the *ex parte* reexamination order and expiration of the time for submitting any responses, the examination will be conducted in accordance with §§ 1.104 through 1.116** and will result in the issuance of an *ex parte* reexamination certificate under § 1.570. [Emphasis added.]

(b) The patent owner in an *ex parte* reexamination proceeding will be given at least thirty days to respond to any Office action. **In response to any rejection,** such response may include further statements and/or proposed amendments or new claims to place the patent in a condition where all claims, if amended as proposed, would be patentable." [Emphasis added.]

MPEP § 2267 provides in part:

"The return of inappropriate submissions complies with the regulations that certain papers will not be considered and also reduces the amount of paper which would ultimately have to be scanned into the record.

I. DISPOSITION OF PAPERS
Where papers are filed during reexamination proceedings which are inappropriate because of some defect, such papers will either be returned to the sender or forwarded to one of three files, the "Reexamination File" (paper file or IFW file history), the "Patent File" (paper file or IFW file history), or the "Storage File" (paper file). Any papers returned to the sender from a Technology Center (TC) must be accompanied by a letter indicating signature and approval of the TC Director." [4]

## II. Findings and Analysis

On April 24, 2006, patent owner filed a response to the final action dated February 24, 2006. That paper was returned to patent owner by the decision of the CRU Director dated May 17, 2006, on the grounds that the response was an improper paper. The basis of this holding was that the response included statements and documents that were improper because they were not limited to consideration of prior patents and printed publications, and also because portions were not in compliance with 37 CFR 1.3 requirements for decorum and courtesy. Patent owner was invited, in the May 17, 2006 decision returning papers, to submit a redacted response, and patent owner has in fact filed a redacted version of that response (the redacted version has been entered into the record).

Patent owner has now attached to the present petition - a set of papers to be added to the record as a part of the response to the February 24, 2006 final action, which would be available for the examiner's consideration in evaluating the patent owner's response. Patent owner

[4] When the CRU has jurisdiction, as in the case of this merged proceeding, the CRU Director would approve and sign the letter accompanying returned papers.

requests by way of the present petition that these papers be entered into the IFW record to provide a complete administrative record.[5] It is patent owner's position that:

(1) There was no legal basis for the CRU Director's return of the April 24, 2006 response papers;

(2) The grounds for such return as expressed in the CRU Director's decision returning the papers were erroneous;

(3) The patent owner is entitled to argue and provide documents to allege that the February 24, 2006 final action is an improper action based on allegations of misconduct and bias.

(4) Due process requires that the Office accept the unredacted response and related FOIA evidence. [6]

It is also noted that patent owner argues that the CRU Director's decision returning the April 24, 2006 response to the final action dated February 24, 2006 was inconsistent with a prior petition decision dated March 20, 2006 denying a patent owner petition filed on January 23, 2006. [7] This argument will be separately addressed, *infra*.

A. The April 24, 2006 Response Was An Improper Paper, The Response Attached To The Present Petition Is An Improper Paper, And Both Papers Lack An Entry Right In The Merged Reexamination Proceeding

Pursuant to 35 U.S.C. § 306, an issue directed to the merits of a final rejection in an *ex parte* reexamination proceeding is appealable to the Patent and Trademark Office Board of Patent Appeals and Interferences. On the other hand, pursuant to 37 CFR 1.181(a), a petition to the USPTO Director is the appropriate vehicle to resolve matters not subject to appeal. It is further to be noted that, pursuant to 37 CFR 1.4(c), different matters raised in a given proceeding must be raised in separate papers. Finally, pursuant to 37 CFR 1.3, complaints against examiners and other Office employees "must be made in correspondence separate from other papers" which are not directed to complaints against examiners and other Office employees.

In the present instance, a review of the papers attached to the present petition indicates that (1) the papers are essentially the same as, if not identical to, the papers that were returned by the CRU Director's May 17, 2006 decision, and (2) these papers purport to be a response to the examiner's treatment of the pending claims in light of the prior art patents and publications applied to the claims by the examiner in the final action dated February 24, 2006. Pursuant to 37 CFR 1.550(a) (the rule that implements 35 U.S.C. § 305), *ex parte* reexamination proceeding is "conducted in accordance with [37 CFR] §§ 1.104 through 1.116." Therefore, the appropriate content of a 37 CFR 1.550(b) response to a final Office action in an *ex parte* reexamination proceeding is defined by 37 CFR 1.113(a) and 37 CFR 1.116. These regulations do not (contrary to petitioner's argument) provide for "further statements" that are unrestricted as to content. Instead, 37 CFR 1.113(a) and 37 CFR 1.116 require that a response to a final action address the issue of patentability of the pending claims with respect to the outstanding rejection, which, in this instance, is the examiner's treatment of the patentability of the claims in light of prior

[5] This would result in the commingling of the now-proffered set of papers with material that the examiner will have to consider.

[6] Petition at pages 10 *et. seq.*

[7] The petition and decision thereon referenced by patent owner are apparently those in the file records of *ex parte* reexamination control number 90/006,495 and *inter partes* reexamination proceeding 95/000,020, which have been merged into a single reexamination proceeding.

patents and printed publications. In contrast, the papers attached to the present petition include material directed to issues other than the examiner's treatment of the patentability of the claims in light of prior patents and printed publications. In fact, large portions of the remarks contained in the response to the final action [8] and documents cited in support are directed to the conduct of Office employees/officials. Thus, large portions of the papers attached to the present petition, are not directed to issues of patentability of the pending claims in light of the applied prior art patents and printed publications. Therefore, these papers clearly constitute responses to the outstanding final Office action that are not proper under 37 CFR 1.550(b) and do not fall within the jurisdiction of the examiner. Accordingly, each of these papers submitted in response to the Office action lacks an entry right in the present merged reexamination proceeding for consideration by the examiner.

Further, 37 CFR 1.3 expressly precludes "complaints against examiners and other employees" submitted as part of papers directed to other matters. Thus, the patent owner's submission of documents in support of its allegations of misconduct and bias could not properly be included with papers directed to the question of patentability in view of prior art, because the clear and unequivocal language of 37 CFR 1.3 expressly requires that "employee conduct" issues are to be raised in correspondence separate from other papers. Here, patent owner improperly raises allegations of employee misconduct incorporated within papers directed to the merits of the examiner's position on the patentability of the pending claims in light of patents and printed publications as set forth in the final Office action. Therefore, the originally filed April 24, 2006 response and the response attached to the present petition are both improper for the reason that they fail to comply with the requirements of 37 CFR 1.3. Accordingly, each paper further lacks an entry right in the present merged reexamination proceeding for consideration by the examiner.

Moreover, 37 CFR 1.4(c) requires that different matters in a given proceeding appropriate for consideration by different branches within the Office must be raised in separate papers. However, patent owner's April 24, 2006 response to the final action improperly presented, in the same paper, both:

> (1) arguments and materials directed to the patentability of the claims in view of the patents and printed publications applied in the final Office action, and
>
> (2) allegations of employee misconduct and bias.

The patentability arguments are properly considered by the examiner. In contrast, allegations of employee misconduct and bias are considered by way of a petition to the appropriate Office official for the exercise of supervisory authority pursuant to 37 CFR 1.181(a), because alleged employee misconduct and bias relate to non appealable subject matter. Thus both the originally filed April 24, 2006 response and the response attached to the present petition are improper for the additional reason that they fail to comply with the requirements of 37 CFR 1.4(c).

Therefore, for the foregoing reasons, the April 24, 2006 patent owner response, and the June 23, 2006 response attached to the present patent owner petition are deemed improper and therefore these papers lack an entry right in the present merged reexamination proceeding. The disposition of improper papers will be treated as discussed in Section C., *infra*.

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[8] See, *e.g.*, the arguments at page 74-92 of the response. Note that even a single instance of an argument directed to matters that are not part of a proper response to a final action within the meaning of 37 CFR 1.113(a) and 37 CFR 1.116 would suffice to preclude entry of the entire response as lacking an entry right.

B. Further Discussion

1. While the patent owner's April 24, 2006 response to the Feb 24, 2006 final action and the response to the final action attached to the present petition each lack an entry right for consideration by the examiner as explained in Section II(A), patent owner may raise the issue of alleged employee misconduct by way of petition under 37 CFR 1.181(a). Note is taken of patent owner's statement that on March 20, 2006, the Office issued a decision in a separate proceeding, such decision denying a patent owner petition filed on January 23, 2006. [9] Patent owner correctly states that the January 23, 2006 petition was denied because it did not provide sufficient details. However, if patent owner is able to now supply those details, they must be submitted in a separate petition under 37 CFR 1.181, but cannot be submitted as part of a paper submitted for consideration by the examiner.

2. Patent owner's characterization of the May 17, 2006 decision issued by the CRU Director returning the April 24, 2006 response to the final Office action of February 24, 2006 is not wholly accurate. In actuality, the CRU Director's May 17, 2006 decision did not mean to imply that the FOIA papers would be barred from submission for any and all purposes. Rather, it properly points out that the papers were returned because they raised issues unrelated to patentability and therefore are not appropriate for consideration by the examiner. Therefore, the submitted papers did not comply with the regulations and practice regarding the submission of response papers. [10]

3. To the extent that patent owner disagrees with some or all of the rationale set forth in support of the CRU Director's decision, Section II(A) of the present decision amplifies the reasons in support of the conclusion reached in the CRU Director's May 17, 2006 decision to refuse entry and return the April 24, 2006 response with attached papers. Section II(A) of the present decision explains that the patent owner may indeed raise alleged employee misconduct and bias issues, but must do so via a separate petition under 37 CFR 1.181. Such a petition must conform to the governing regulations and practice, i.e., the petition regarding alleged employee misconduct must not be attached to papers directed to the substantive issue of claim patentability in light of the prior patents and printed publication. See 37 CFR 1.3 and 37 CFR 1.4(c).

4. As a final point on this matter, patent owner is not being deprived of due process by a refusal to accept papers that mingle allegations of misconduct (and documents supporting those allegations) with papers that are directed to other matters. Papers raising issues of alleged misconduct, and documents proffered in support of such allegation, are admissible in the Office only if they are provided in a manner that complies with the regulations.

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[9] See footnote 7, *supra*.

[10] Considering the fact that the papers in question were styled as a response to a final Office action, the material beginning at the last paragraph of page 2 of the May 17, 2006 CRU Director's decision and running through page 3 thereof indicates to the undersigned that the CRU Director was concerned with the mingling of prior art patent and printed publication patentability issues with the procedural issues raised by the allegations of misconduct and bias of raised in papers.

C. Disposition Of Papers

1. In this instance: (1) the April 24, 2006 presentation of the FOIA papers, (2) the April 24, 2006 declaration of Keith Anderson directed the FOIA papers, and (3) the remarks directed to the conduct of Office employees/officials that were included within the April 24, 2006 response to the final action have previously been found to be improper, and lacking an entry right in the present merged proceeding. These papers were previously returned, and a redacted form of these papers was entered into the record, as discussed above.

2. In addition, the patent owner has attached to the present petition the material that was refused entry and returned (by the CRU Director's May 17, 2006 decision), for entry into the record as part of patent owner's response to the February 24, 2006 Office action. These papers have now been found to be improper and therefore lack an entry right in the present merged proceeding to which they are directed. As these papers are determined to lack an entry right in the present merged reexamination proceeding, they will be returned in accordance with provisions of MPEP § 2267. In this instance it would be unduly burdensome to either physically return the large bulk of papers, or expend significant Office resources scanning the documents into the record and then closing them from view. [11] Therefore, the papers are being temporarily held for "pick up" in the Central Reexamination Unit (CRU). If the patent owner desires the physical return of the papers, then patent owner should promptly make arrangements to pick up the papers from the CRU **within one month** of the mailing date of this decision. Patent owner should immediately notify Norma Amador of the CRU, at telephone number (571) 272-6474, of any arrangements that have been made to pick up the papers. If the papers are **not** picked up **within one month** of the mailing date of this decision, **the CRU will dispose of the papers,** note being taken that the patent owner presumably has the originals.

3. As to the present petition, the petition contains facial allegations of employee misconduct and bias. Accordingly, though the petition itself will be retained of record in the IFW file, it is being marked as "non-public."

## CONCLUSION

1. The June 23, 2006 patent owner petition is dismissed.

2. The (1) the April 24, 2006 presentation of the FOIA papers, (2) the April 24, 2006 declaration of Keith Anderson directed the FOIA papers, and (3) the remarks directed to the conduct of Office employees/officials that were included within the April 24, 2006 response to the final action have been found to be improper papers lacking an entry right in the present merged proceeding to which they are directed. These papers were properly returned to patent owner.

3. The papers attached to the present petition that appear to be the material that was refused entry and returned by the CRU Director's May 17, 2006 decision will be held for one month in the CRU in a single storage location, and thereafter will be discarded if not picked up by patent owner.

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[11] Patent owner has filed at least six other petitions corresponding to the present petition, and provided such papers as attachments to each filed petition.

4. The present petition will be retained of record in the IFW file and is being marked as "non-public."

5. A copy of this decision is being made of record in the merged reexamination proceeding, and the decision will therefore appear in the IFW record of *ex parte* reexamination proceedings 90/006,533, 90/006,675 and 90/007,731.

6. **All correspondence relating to an *inter partes* reexamination proceeding should be directed to:**

By Mail to: Mail Stop *Ex Parte* Reexam
ATTN: 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) 273-9900
Central Reexamination Unit

By hand: Customer Service Window
ATTN: Central Reexamination Unit
Randolph Building
401 Dulany St.
Alexandria, VA 22314

8. Telephone inquiries with regard to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or, in his absence, to the undersigned at (571) 272-7710.

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

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July 31, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

Novak Druce & Quigg LLP
1300 Eye Street NW
Suite 400 East Tower
Washington, DC 20005

(For Third Party Requester)

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/006,533
Filed: January 30, 2003
For: U.S. Patent No. 5,436,960

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/006,675
Filed: June 24, 2003
For: U.S. Patent No. 5,436,960

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/007,731
Filed: September 27, 2005
For: U.S. Patent No. 5,436,960

**DECISION DENYING PETITION**

This is a decision on the October 23, 2006 patent owner petition styled "Petition Pursuant to 37 CFR 1.181 or Alternatively, 37 CFR 1.182 Or Alternatively 37 CFR 1.183 to Reconsider Decision, *Sua Sponte*, 'Returning' Improper Papers and Alternatively That the Commissioner Declare His Decision A Final Agency Action." [1,2]

The petition and the above-captioned reexamination proceedings are before the Office of Patent Legal Administration for consideration.

The petition is granted to the extent that (1) the "Decision, *Sua Sponte*, Dismissing Petition and 'Returning' Improper Papers" [3] dated August 23, 2006, has been reconsidered, and (2) the

[1] The present petition paper is fully treatable pursuant to 37 CFR 1.181, and it is thus unnecessary to consider the petition paper under either 37 CFR 1.182 or 37 CFR 1.183. A petition fee is not required.
[2] The present paper will hereinafter be referred to as "Petition for Reconsideration."
[3] Hereinafter "Decision Dismissing Petition."

present decision has been designated as a final agency action under 35 U.S.C. § 704. For the reasons discussed below, the underlying relief requested by petitioner patent owner is denied.

## REVIEW OF SALIENT FACTS

1. U.S Patent number 5,436,960 ("the '960 patent") issued to Campana *et al* on July 25, 1995 from an application filed on May 20, 1991.

2. On January 30, 2003, a request for *ex parte* reexamination of the '960 patent was filed by a third party requester. The resulting *ex parte* reexamination proceeding was assigned control number 90/006,533 ("the '533 reexamination proceeding").

3. On April 17, 2003, the examiner's Order Granting *Ex Parte* Reexamination for the '533 reexamination proceeding was mailed.

4. On June 24, 2003, a request for a second ex *parte* reexamination of the '960 patent was filed by the same third party requester, and the resulting proceeding was assigned control number 90/006,675 ("the '675 reexamination proceeding").

5. On September 3, 2003, the examiner's Order Granting *Ex Parte* Reexamination was mailed for the '675 reexamination proceeding.

6. On August 23, 2004, the Technology Center Director issued a decision, *sua sponte*, by which the '533 reexamination proceeding and the '675 reexamination proceeding were merged into a single consolidated reexamination proceeding.

7. On September 27, 2005, third party requester filed a third request for *ex parte* reexamination of the '960 patent, which was assigned control number 90/007,731 ("the '731 reexamination proceeding").

8. On October 14, 2005, the examiner's Order Granting *Ex Parte* Reexamination for the '731 reexamination proceeding was mailed.

9. On January 4, 2006, a Freedom of Information Act ("FOIA") Request was made to the Office requesting the Office's communications with third parties regarding the present reexamination proceedings and pending reexamination proceedings being conducted on other of patent owner's patents.

10. The Office responded to the FOIA request through letters dated between February 8 and March 24, 2006. [4]

11. Following prosecution on the patentability of the '960 claims, a final rejection Office action was issued in the merged '533 - '675 reexamination proceeding on February 24, 2006.

12. On March 1, 2006, the Central Reexamination Unit (CRU) Director issued a decision, *sua sponte*, by which the '533 reexamination proceeding, the '675 reexamination proceeding and the '731 reexamination proceeding were merged into a single consolidated reexamination

[4] An additional response to the FOIA request was mailed by the Office on June 15, 2006, and received by patent owner on June 16, 2006.

proceeding. [5]

13. On April 24, 2006, patent owner filed both a notice of appeal and an information disclosure statement (IDS) in the single combined reexamination proceeding.

14. Also on April 24, 2006, patent owner filed a paper styled as a response to the final rejection, which included a traverse of the final rejection, copies of material obtained as a result of the FOIA request, and a number of statements in support of patent owner's traverse.

15. On May 17, 2006, the CRU Director mailed a decision returning the April 24, 2006 patent owner response to the final rejection without consideration on the merits. The return was grounded on the impropriety of the papers, because they were not limited to consideration of prior patents and printed publications, and also because portions of the submission were not in compliance with the requirements of 37 CFR 1.3. Accordingly, the returned supplemental response was not entered into the record.

15. On May 22, 2006, patent owner filed a redacted version of the April 24, 2006 supplemental amendment/response, which is limited to material addressing the outstanding nonfinal rejection Office action, and which has been entered into the IFW record for the merged proceeding.

16. On June 23, 2006, patent owner filed a petition requesting reconsideration of the CRU Director's May 17, 2006 decision. Patent owner attached to the petition the material that had been refused entry and returned (by the CRU Director's May 17, 2006 decision), and requested entry of that material into the record, as part of patent owner's supplemental response to the December 30, 2005 nonfinal Office action.

17. On August 23, 2006, the June 23, 2006 patent owner petition was dismissed, [6] and was "returned" to petitioner by permitting petitioner to schedule a time to pick up the material (together with similar material from other concurrently filed related petitions). [7]

18. On October 23, 2006, petitioner patent owner filed the present Petition for Reconsideration of the August 23, 2006 petition decision.

## DECISION

### I. Relevant Statutes, Regulations and Practice

35 U.S.C. § 132 provides:

> "(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

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[5] Jurisdiction of the merged '533 and '675 reexamination proceedings had previously been transferred from the Technology Center to the CRU.

[6] See discussion at pages 5-7, *infra*.

[7] No such pick up was scheduled, and none was made.

(b) The Director shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant. The Director may establish appropriate fees for such continued examination and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under section 41(h)(1) of this title."

35 U.S.C. § 301 provides in pertinent part:

"Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent."

35 U.S.C. § 302 provides 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. § 303(a) provides in pertinent part:

"Within 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. § 305 provides, in pertinent part:

"After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent."

35 U.S.C. § 306 provides:

"The patent owner involved in a reexamination proceeding under this chapter may appeal under the provisions of section 134 of this title, and may seek court review under the provisions of sections 141 to 145 of this title, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent."

37 CFR 1.3 provides:

"Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Director and will not be entered. A notice of the non-entry of the paper will be provided. **Complaints against examiners and other employees must be made in correspondence separate from other papers.**" [Emphasis added.]

37 CFR 1.4(c) provides:

"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."

37 CFR 1.113(a) provides, in part:

"On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon ... for *ex parte* reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. **Petition may be taken t the Director in the case of objecti ns or requirements not involved in the rejection of any claim (§ 1.181).** ..." [Emphasis added.]

37 CFR 1.116(a)-(e) provide, in part:

"(a) An amendment after final action must comply with § 1.114 or this section.

(b) After a final rejection or other final action (§ 1.113) ... in an *ex parte* reexamination filed under § 1.510 ... 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 ... patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

(c) The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the ... reexamination proceeding from its condition as subject to appeal or to save ... the reexamination prosecution from termination under § 1.550(d) ... .

(d) (1) ...
(2) Notwithstanding the provisions of paragraph (b) of this section, an amendment made after a final rejection or other final action (§ 1.113) in an ex parte reexamination filed under §1.510 ... may not cancel claims where such cancellation affects the scope of any other pending claim in the reexamination proceeding except ... as permitted by § 41.77(b)(1) of this title.

(e) An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) ... in an ex parte reexamination filed under § 1.510 ... but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented."

37 CFR 1.181(a)(1) provides that petition may be taken to the Director:

"**From any action** or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution **of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court.**" [Emphasis added.]

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

"(a) All *ex parte* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office. **After issuance of the *ex parte* reexamination order and expiration of the time for submitting any responses, the examination will be conducted in accordance with §§ 1.104 through 1.116** and will result in the issuance of an *ex parte* reexamination certificate under § 1.570. [Emphasis added.]

(b) The patent owner in an *ex parte* reexamination proceeding will be given at least thirty days to respond to any Office action. **In response to any rejection,** such response may include further statements and/or proposed amendments or new claims to place the patent in a condition where all claims, if amended as proposed, would be patentable." [Emphasis added.]

MPEP § 2267 provides in pertinent part:

"The return of inappropriate submissions complies with the regulations that certain papers will not be considered and also reduces the amount of paper which would ultimately have to be scanned into the record.

I. DISPOSITION OF PAPERS
Where papers are filed during reexamination proceedings which are inappropriate because of some defect, such papers will either be returned to the sender or forwarded to one of three files, the "Reexamination File" (paper file or IFW file history), the "Patent File" (paper file or IFW file history), or the "Storage File" (paper

file). Any papers returned to the sender from a Technology Center (TC) must be accompanied by a letter indicating signature and approval of the TC Director." [8]

## II. Basis For The August 23, 2006 Decision

On April 24, 2006, patent owner filed a response to an outstanding final Office action dated February 24, 2006. That paper was returned to patent owner without consideration on the merits as an inappropriate submission. [9] The paper was considered to be inappropriate by the Central Reexamination Unit Director, (1) because the paper was not limited to consideration of prior patents and printed publications, [10] and (2) because portions of that paper were not in compliance with the requirements of 37 CFR 1.3. On June 23, 2006, patent owner requested reconsideration of the return of those papers by way of a petition for reconsideration. Patent owner attached to that petition for reconsideration the material that had previously been refused entry. A decision issued August 23, 2006, setting forth in detail the basis for refusing the underlying relief requested in the June 23, 2006 request for reconsideration, and for again returning the material that was not proper for entry into the record of the present merged reexamination proceeding.

It was pointed out in the August 23, 2006 decision, in explanation of why the underlying relief requested by petitioner would not be appropriate, that:

> A) Pursuant to 35 U.S.C. § 306, an issue directed to the merits of a rejection in an *ex parte* reexamination proceeding is ultimately appealable to the Patent and Trademark Office Board of Patent Appeals and Interferences (the Board). On the other hand, pursuant to 37 CFR 1.181(a), a petition to the USPTO Director is the appropriate vehicle to resolve matters not subject to appeal.
>
> B) Pursuant to 37 CFR 1.3, complaints against examiners and other Office employees "must be made in correspondence separate from other papers" which are not directed to complaints against examiners and other Office employees.
>
> C) Pursuant to 37 CFR 1.4(c), different matters raised in a given proceeding must be raised in separate papers.

These points have not been persuasively addressed in the present request for reconsideration.

### A. The April 24, 2006 Papers Did Not Comply With 37 CFR 1.113(a) and 37 CFR 1.116

The April 24, 2006 papers purported to be a response directed to the outstanding final Office action dated February 24, 2006. Pursuant to 37 CFR 1.550(a), the present merged reexamination proceeding is to be conducted in accordance with sections 1.104 through 1.116 of Title 37 of the Code of Federal Regulations. Those regulations implement the provisions of 35 U.S.C § 132. 37 CFR 1.113(a) and 37 CFR 1.116 specifically require that a response to a final Office action address issues of patentability of the pending claims that are subject to an outstanding final rejection. The April 24, 2006 papers did contain material directed to the issue of the patentability of the claims of the patents being reexamined that are required to be resolved by appeal to the Board. However, in direct contravention of 37 CFR 1.113(a), the April 24, 2006

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[8] When the CRU has jurisdiction, as in the case of this merged proceeding, the CRU Director would approve and sign the letter accompanying returned papers.

[9] See MPEP § 2267.

[10] See 35 U.S.C. §§ 301-303.

papers also contained comments and documents that were not directed to the merits of the outstanding rejection (*i.e.*, not directed to appealable matters). These additional comments and documents were instead directed to matters of alleged misconduct on the part of Office employees/officials, and requested relief that is only available by way of petition to the USPTO Director, and not by an appeal to the Board.[11] Accordingly, the April 24, 2006 papers failed to comply with 37 CFR 1.113(a) and 37 CFR 1.116.

Petitioner is also referred to MPEP § 1201 which states, in pertinent part:

> Where the differences of opinion concern the denial of patent claims because of prior art or other patentability issues, the questions thereby raised are said to relate to the merits, and appeal procedure within the Office and to the courts has long been provided by statute (35 U.S.C. 134).
> The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Director of the U.S. Patent and Trademark Office (Director) should be carefully observed. The Board will not ordinarily hear a question that should be decided by the Director on petition, and the Director will not ordinarily entertain a petition where the question presented is a matter appealable to the Board.

In this instance, the entry of the additional comments and documents directed to matters of alleged misconduct on the part of Office employees/officials would inappropriately place materials unrelated to the merits of patentability before the examiner. Not only would entry of these materials confuse and overburden the record, but also these materials simply are not permitted to be, and will not be, made available for consideration by the examiner in determining the patentability of the claims.

B. The April 24, 2006 Papers Did Not Comply With 37 CFR 1.3

37 CFR 1.3, last sentence, prohibits the submission of "complaints against examiners and other employees" of the Office as a part of papers directed to other matters before the Office. The "returned" April 24, 2006 papers included complaints regarding the conduct of Office employees, and these complaints were submitted as part of papers directed to other matters, *i.e.*, the issues of claim patentability in this merged proceeding. Accordingly, the April 24, 2006 papers are barred by 37 CFR 1.3.

C. The April 24, 2006 Papers Did Not Comply With 37 CFR 1.4(c)

37 CFR 1.4(c) requires that, within a given proceeding, material directed to matters that will be considered by different branches within the Office be raised in separate papers. Yet, the April 24, 2006 papers included complaints regarding conduct together with material directed to the issues of claim patentability, notwithstanding that these separate issues are decided by different branches of the Office and resolved by different appellate review tribunals: (1) decision on petition to the USPTO Director and (2) consideration by the Primary Examiner which may ultimately be reviewed by the Board. Accordingly, the April 24, 2006 papers are barred by 37 CFR 1.4(c).

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[11] See, for example, the arguments at page 74-92 of the supplemental response filed April 24, 2006, that was to be disposed of if not "picked up" by the patent owner in accordance with the August 23, 2006 Decision on Petition. Note that even a single instance of an argument directed to matters that are not part of a proper response to a nonfinal action within the meaning of 37 CFR 1.111(b) would suffice to preclude entry of the entire supplemental response as lacking an entry right.

## III. Findings And Analysis With Respect To The Present Petition For Reconsideration

### A. Patent Owner's Position Is Fundamentally Flawed

Petitioner patent owner argues that there has been improper conduct on the part of Office employees. [12] Patent owner apparently also believes that it has evidence of bias specifically on the part of one or more examiners, [13] and that this evidence, as previously submitted on April 24, 2006, should not be barred from examiner consideration because it bears on issues of patentability. Thus, petitioner patent owner urges that 37 CFR 1.3 should not preclude presentation to the examiner of the material alleging bias (even where bias alleged on the part of the examiner is alleged), because bias bears on patentability issues. Similarly, patent owner argues that 37 CFR 1.4(c) is inapplicable, because evidence of bias addresses the same patentability issues as the remainder of patent owner's substantive reply. [14]

Initially, patent owner has not shown how bias will change whether a claim is patentable over a reference or not. If the patent owner believes that there is a bias that would influence an examiner involved, or another Office employee conducting the examination of the claims for patentability, the proper avenue to address that would be via a 37 CFR 1.182 petition to remove the examiner or other Office employee, not by presenting the allegation of bias to the accused examiner for determination. Also, patent owner's position **assumes** that the evidence presented by patent owner **actually establishes bias**. However, the question of whether the material presented by patent owner in support of patent owner's allegations of bias in fact establishes bias on the part of any Office personnel is an open question that has not yet been decided. Patent owner further assumes that the examiner is the appropriate Office employee to view alleged evidence of bias on the part of Office officials (and on the part of the examiner) in order to make a finding that bias in fact existed. However, the examiner's authority extends to making patentability determinations. The examiner does not exercise supervisory authority with respect to the alleged bias or misconduct on the part of other Office employees.

Pursuant to 35 U.S.C. § 306, an issue directed to the merits of a rejection in an *ex parte* reexamination proceeding is ultimately appealable to the Board, and then to the courts. All matters not subject to appeal to the Board under 35 U.S.C. § 306 are subject to resolution by way of petition under 37 CFR 1.181. Further, 37 CFR 1.3 prohibits complaints about employee conduct to be included within the same papers addressing the merits of patentability. Therefore, the proper avenue for obtaining review of an allegation of procedural impropriety, misconduct or bias on the part of Office personnel would be through petition to appropriate Office officials (as pointed out above). Any decision on such a petition that is adverse to patent owner would be subject to court review in the same manner as any other question of administrative procedure would be reviewed. [15] It is not reasonable to state that the evidence **alleged** to support bias on the part of Office officials, and/or on the part of the examiner, should be placed into the record of the present merged reexamination proceeding before the examiner for review and evaluation by the examiner as part of a patentability determination. Further, some of the allegations of bias are directed to the conduct of the examiner, making it far from clear that the examiner could objectively evaluate the allegations of the examiner's own bias. Yet, as noted above, patent owner appears to have raised the argument that the evidence of examiner bias should be forwarded to the examiner for consideration. Such consideration

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[12] See pages 3-4 of the present Petition for Reconsideration.

[13] See, for example, the headings on pages 4 and 7 of the present Petition for Reconsideration.

[14] See pages 7-9 of the present Petition for Reconsideration.

[15] Non-appealable subject matter reviewed by petition under 37 CFR 1.181 is subject to judicial review under the Administrative Procedures Act.

has, to date, been refused solely on the basis that patent owner has filed a single paper that conflated and intermingled these issues, rather than filing two separate papers that are each directed only to the area of the Office that would properly consider only that paper. [16]

By way of expansion on the above discussion, patent owner is reminded that patent examiners are Office personnel who are charged with evaluating evidence bearing on questions of patentability. In the present merged reexamination proceeding, the examiner's consideration of patentability is limited by 35 U.S.C. §§ 301 - 303 to a consideration of prior patents and printed publications. [17] Examiners are not charged with evaluating evidence of impropriety, misconduct or bias, by examiners or other Office personnel. Also, until the patent owner's evidence and allegations of misconduct are properly evaluated by the appropriate Office personnel, they cannot have any affect on action taken by the Office.

As a final point, patent owner is not being deprived of due process by a refusal to accept papers that co-mingle allegations of misconduct (and documents supporting those allegations) with papers that are directed to other matters. Papers raising issues of alleged misconduct, and documents proffered in support of such allegation, are admissible in the Office, and can properly be submitted for consideration by the Office, but only if they are provided in a manner that complies with the regulations.

B. 37 CFR 1.3 and 37 CFR 1.4(c) Each Precludes The Relief Requested By Petitioner Patent Owner

It is manifestly clear that both 37 CFR 1.3 and 37 CFR 1.4(c) each prohibit patent owner from co-mingling arguments directed to issues of the patentability of the claims with arguments and evidence in support of allegations of procedural impropriety and bias on the part of Office personnel. Those allegations are as yet unproven, and cannot be properly considered to presently establish any basis for reassignment of examining responsibilities. This is not the same as concluding that the regulations preclude **the presentation** of evidence of bias, as patent owner argues, [18] (notwithstanding that the Office has never taken such position [19]). The Office is not refusing to consider patent owner's alleged evidence, but simply is requiring that patent owner's evidence and allegations be presented in accordance with its rules which require them to be directed to the appropriate Office personnel for consideration and evaluation.

To the extent that the present petition again presents the allegation that 37 CFR 1.3 is inapplicable because patent owner has not violated decorum or been discourteous in this proceeding, [20] and also cites case law that is alleged to establish that 37 CFR 1.3 is inapplicable on the facts in this proceeding, patent owner is reminded that the August 23, 2006 Decision on Petition was in no manner based upon patent owner's conduct. Rather, 37 CFR 1.3 was applied because it requires that complaints of misconduct on the part of examiners and Office personnel "must be made in correspondence separate from other papers." [21] This language manifestly includes, as part of the class of "other papers" in which complaints of misconduct may not be

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[16] Given reexaminations that are conducted with special dispatch, it is puzzling that patent owner has not seen fit to comply with the relatively straightforward and simple requirements of the 37 CFR 1.3 and 1.4(c) by filing two separate papers, since by doing so, patent owner would have immediately placed before the proper areas of the Office both the conduct issues and the substantive patentability issues for consideration by the appropriate Office personnel.

[17] Extrinsic evidence explaining the content of prior patents and printed publications may be considered as well.

[18] See page 5 of the present petition, last sentence in the paragraph bridging pages 4 and 5.

[19] See for example, Decision Dismissing Petition dated August 23, 2006, section II(B), items 1 and 4.

[20] See the present petition, beginning at the bottom of page 4 and running through page 5.

[21] See Decision on Petition, August 23, 2006, page 7, first full paragraph.

raised, "papers directed to the merits of claim patentability in any proceeding in which the misconduct is alleged to have occurred."

Moreover, none of the case law cited by patent owner at page 5 of the present petition supports patent owner's position that 37 CFR 1.3 has been misapplied. Here, the Office is not prohibiting the patent owner from submitting evidence regarding its allegations; rather, the Office is simply directing material to the appropriate Office official for review of patent owner's complaint in accordance with the requirements established by 37 CFR 1.3 that employee conduct complaints "must be made in correspondence separate from other papers." None of the cases relied upon by patent owner demonstrate that the Office may not enforce the clear language of 37 CFR 1.3 by requiring papers containing complaints about the conduct of Office officials and personnel to be filed separately from other papers related to the merits of patentability.

Patent owner's argument that 37 CFR 1.4(c) should not prohibit examiner consideration of the merits of patent owner's arguments regarding the existence of bias is similarly fatally flawed. First, 37 CFR 1.4(c) does not preclude consideration of the merits of patent owner's allegations of bias, impropriety or misconduct on the part of Office officials and employees. The record does not show that the Office has taken the position that the allegations raised by patent owner cannot or will not be considered. 37 CFR 1.4(c) merely directs the orderly manner in which such allegations, and the evidence in support of such allegations, must be presented to the Office - for consideration by the proper Office officials. In this instance, 37 CFR 1.4(c) applies, because it requires that matters such as questions of bias or inappropriate conduct by Office personnel, which matters are appropriate for consideration by an Office official in one particular area of the Office, be submitted in a paper *separately* from papers containing substantive patentability issues, which are properly decided by a different Office official of employee in a different area of the Office. As pointed out above, the patent examiner is not the proper Office official to consider and rule on patent owner's allegations of bias, impropriety and misconduct; and thus, such allegations and materials supporting such allegations, are not proper for inclusion in the IFW record as a part of papers otherwise directed to patentability issues. The fact that the "examiner" is one of the employees that is accused of misconduct further highlights the appropriateness of the procedural safeguards provided by the rules. Clearly, the employee accused of alleged misconduct cannot be the official who will decide the issue. Moreover, the rule protects the integrity of the file history by separating employee complaints from the merits of examination.

Thus, 37 CFR 1.4(c) precludes entry of the papers submitted as a part of the June 23, 2006 petition, because the regulation properly requires that:

> matters bearing on the determination of patentability in this proceeding, and
>
> matters directed to a determination of the propriety of the allegations of misconduct, bias or impropriety on the part of Office officials and the examiner

be submitted in separate papers inasmuch as these issues are decided by different Office officials/employees in different areas of the Office.

C. 37 CFR 1.113(a) and 37 CFR 1.116 Preclude The Relief Requested By Patent Owner

37 CFR 1.111(a) and 37 CFR 1.116 provide that a response to a final Office action must, *inter alia*, specifically point out supposed errors in the examiner's action, and point out the specific distinctions believed to render the claims patentable over the prior art. The regulation does not

provide for "further statements" that address matters other than the issues of patentability raised in the outstanding Office action. The failure of the April 24, 2006 patent owner submission to comply with 37 CFR 1.113(a) and 37 CFR 1.116 was discussed at pages 6-7 of the Decision Dismissing Petition dated August 23, 2006. It was pointed out that the April 24, 2006 patent owner submission was not confined to responding to the nonfinal Office action as required by 37 CFR 1.111(b), but instead intermingled matter directed to other issues (the issues of alleged misconduct on the part of Office personnel).

In the present petition patent owner has not directly addressed this point. To the extent that patent owner's general argument that the allegations of misconduct are in fact relevant to the issues of patentability, those arguments are wholly unpersuasive for the reasons set forth in Section III (A) above. Therefore, it is again concluded that the August 23, 2006 Decision Dismissing Petition properly refused entry of the April 24, 2006 patent owner as being non-compliant with 37 CFR 1.113(a) and 37 CFR 1.116.

## CONCLUSION

1. The October 23, 2006 patent owner petition is granted to the extent that the August 23, 2006 Decision Dismissing Petition has been fully reconsidered, and that the present decision will be designated as a final agency decision.

2. The October 23, 2006 patent owner petition is denied with respect to disturbing the holding of the August 23, 2006 Decision Dismissing Petition which refused to enter the papers attached to patent owner's June 23, 2006 Petition and which "returned" those papers.

3. A copy of this decision is being made of IFW record for the merged reexamination proceeding, and the decision will therefore appear in the IFW record of *ex parte* reexamination proceedings 90/006,533, 90/006,675 and 90/007,731.

4. Telephone inquiries with regard to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or, in his absence, to the undersigned at (571) 272-7710.

5. This decision is a final agency action within the meaning of 5 U.S.C. § 704.

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

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February 22, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

MAILED

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(For Third Party Requester)

Harvey et al :
Reexamination Proceeding : DECISION
Control No. 90/006,536 : GRANTING-IN-PART
Filed: February 4, 2003 : PETITION
For: U.S. Patent No. 4,965,825 :

This is a decision on the May 30, 2003, patent owner petition titled PETITION TO EXPUNGE PAPERS FROM THE REQUEST FOR REEXAMINATION.

The petition is addressed in three respects:

(1) Under 37 CFR 1.183 as a request to waive the rules and provide an entry right for the petition paper.

(2) Under 37 CFR 1.59(b) as a request to expunge or redact the request for reexamination or papers therefrom, and

(3) Under 37 CFR 1.182 as a request that papers from the request for reexamination be sealed, i.e., a situation not specifically provided for in the regulations.

Pursuant to 37 CFR 1.17(h), a petition fee of $130.00 is required for a petition under 37 CFR 1.59(b), 37 CFR 1.182 and/or 37 CFR 1.183. The required petition fee of $130.00 has been charged to Deposit Account No. 50-0206 for the present petition under 37 CFR 1.59(b), 37 CFR 1.182 and/or 37 CFR 1.183, as authorized in the second paragraph of the petition.

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

The petition under 37 CFR 1.183 is granted, such that the present petition paper will be permitted entry and will be addressed.

The petition under 37 CFR 1.59(b) is granted to the extent that materials will be expunged from the CRU Scanning Data Base, is dismissed as to the request for expungement of the reexamination request, and is otherwise held in abeyance for the reasons set forth below.

The petition under 37 CFR 1.182 to seal papers is granted to the extent that Exhibit E will be sealed, but is otherwise dismissed (with a cure to the dismissal being available by renewed petition) for the reasons set forth below.

**REVIEW OF FACTS**

1. U.S. patent No. 4,965,825 issued on October 23, 1990.

2. A request for reexamination, assigned control No. 90/006,536, was filed by a third party requester on February 4, 2003.

3. Reexamination was ordered for the '6536 reexamination proceeding on April 10, 2003.

4. A patent owner paper was filed May 30, 2003, to inform the Office that no statement under 37 CFR 1.530 will be filed.

5. Also on May 30, 2003, patent owner filed the present petition titled "PETITION TO EXPUNGE PAPERS FROM THE REQUEST FOR REEXAMINATION."

**DECISION**

Addressing the present petition requires a decision as to three areas of relief, provided for by 37 CFR 1.183, 37 CFR 1.59(b), and 37 CFR 1.182, respectively. Each will be presented in its own section below.

## I. DECISION ON PETITION UNDER 37 CFR 1.183

As pointed out above, patent owner filed a paper on May 30, 2003, informing the Office that no statement under 37 CFR 1.530 will be filed. In addition, the petition (page 2) makes it clear that:

> "PMC is not submitting this petition as a 'patent owner's statement' under 37 C.F.R. § 1.530, and it should not be construed to be a patent owner's statement."

Thus, the present petition paper is clearly not a patent owner's statement under 37 CFR 1.530.

Yet, pursuant to 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."

Accordingly, the present petition paper does not have an entry right under the reexamination rules.

A right of entry for the petition paper would require a waiver of the above-quoted provision of 37 CFR 1.540, such a waiver being available only pursuant to 37 CFR 1.183.[1] Accordingly, the present petition is taken to provide, as one of its requests for relief, as a request under 37 CFR 1.183 for a waiver of the rules.

In addressing the request for a waiver of the rules, it is noted that, in the paragraph bridging pages 2 and 3 of the petition, petitioner provides grounds for waiver of the rules as follows:

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[1] 37 CFR 1.183 states as follows:
"In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(h)."

> "PMC believes that the unusual circumstances related to Thomson's Request dictate the filing of the instant petition to protect PMC's important and statutorily recognized interest in maintaining the confidentiality of its abandoned patent applications. [Footnote omitted] See 35 U.S.C. § 122; 37 C.F.R. § 1.14; see also M.P.E.P. § 724.05."

This argument by petitioner is found to be persuasive to waive the above-quoted provision of 37 CFR 1.540. The interest in maintaining the confidentiality of the patent owner's abandoned patent application, and giving effect to the May 2, 2003, Order of the District Court [2] granting patent owner's motion for a protective order, are deemed to provide an extraordinary situation, when justice requires waiver of the rules to protect rights. Patent owner's rights could be prejudiced if a decision on the matter presented is delayed until the examination stage of this reexamination proceeding.

Accordingly, the petition, as it relates to relief under 37 CFR 1.183, is granted.

**II. PETITION UNDER 37 CFR 1.59(b)**

In the first page of the petition, it is stated:

> "The patent owner, Personalized Media Communication LLC (PMC) hereby petitions the Commissioner to expunge or appropriately redact the Request for Reexamination from the file of U.S. Patent 4,965,825, the reexamination file, the electronic copy of the reexamination file made available to the public, and any other publicly available file in which Exhibit E of the Request resides."

(1) To the extent that the petition is taken as a petition for expungement of **the reexamination request, including all exhibits,** the petition is **dismissed**.

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[2] Issued in *Personalized Media Communications,LLC v. Scientific-Atlanta, Inc., et al.*, Civil Action File No.1:02-CV -824-CAP, (United States District Court for the Northern District of Georgia) in Atlanta before Judge Charles A. Pannell, Jr. (the Atlanta Litigation). See Exhibit 4 of the present petition.

It is stated in 35 U.S.C. 302 that:

> "*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." (emphasis added)

The violation of confidentiality set forth in the petition is not a proper basis for expunging a reexamination. A request for reexamination can be terminated only based upon statute or rule. The present patent owner petition does not cite any statute or rule that would call for termination of a reexamination as a result of the protected nature of the "confidential" materials. Accordingly, the patent owner's petition for expungement of the reexamination request is **dismissed**.

(2) Pursuant to 37 CR 1.59(b):

> "An applicant may request that the Office expunge and return information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge and return information from an application must include the fee set forth in § 1.17(h) and establish to the satisfaction of the Commissioner that the return of the information is appropriate."

To the extent that the present petition is taken as a petition for expungement under 37 CR 1.59(b) of **the confidential materials** entirely from the record, the petition is **premature**.

MPEP 724.04(c) sets forth the guidelines for a petition to expunge "Materials Submitted in Reexamination File Open to the Public Under 37 CFR 1.11(d)." When the application is considered for action on the merits, the examiner (and/or other appropriate Office official responsible for considering the information) will review the sealed information, and will make a determination as to whether or not any portion or all of the information submitted is "important to a reasonable examiner in deciding whether or not a claim is patentable." The examiner may issue a determination on the issue of importance of the sealed information in the first Office action on the merits, or in an Office action issued any time thereafter that is appropriate, but, *in no event, later than the close of prosecution.*

It is not appropriate to make, in this decision, a final determination of whether or not the material requested to be

expunged is "important to a reasonable examiner in deciding whether or not a claim is patentable." Rather, such a decision is issued by the examiner, and is issued no later than the close of prosecution. Thus, the decision on the petition to expunge is premature and must be held in abeyance at this time. After the examiner has issued a determination on the issue of importance of the sealed information in an Office action on the merits (as discussed above), the petition to expunge may be renewed by patent owner.

*It is, however, appropriate* that the confidential materials of the reexamination paper file be sealed from public view. Such sealing would further the interest in maintaining the confidentiality of the patent owner's abandoned patent application, and give effect to the May 2, 2003, Order of the District Court [3] granting patent owner's motion for a protective order. Accordingly, Exhibit E is being sealed by the present decision; see Section III below. In addition, the request for reexamination as filed will be sealed if Section III of this decision is complied with.

(3) To the extent that the petition is taken as a petition for expungement of the request for reexamination containing the confidential material from the Central Reexamination Unit (CRU) Scanning Data Base, the petition is **granted**. This expungement would serve the interest in maintaining the confidentiality of the patent owner's confidential materials as pointed out in the previous paragraph. Accordingly, the electronic copy of the request for reexamination will be deleted by the CRU, pursuant to Section IV of this decision, below. After resolution of the issues set forth in this decision on petition, any *appropriate* redacted materials submitted for this proceeding will be scanned into the CRU Scanning Data Base, and become available to the public.

## III. DECISION ON PETITION UNDER 37 CFR 1.182

It is stated in the last paragraph of page 7 of the petition:

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[3] The order was issued in *Personalized Media Communications, LLC v.Scientific-Atlanta, Inc., et al.*, Civil Action File No.1:02-CV -824-CAP (United States District Court for the Northern District of Georgia.

> "PMC respectfully requests that the PTO expunge the Request for Reexamination **from all files accessible to the public** to comply with its statutory obligation to keep PMC's abandoned applications confidential and prevent public disclosure of PMC's confidential abandoned patent applications."[Emphasis added]

This is a request under 37 CFR 1.182 that papers from the request for reexamination be **sealed**, so that such papers are no longer "accessible to the public."

At page 8 of the petition, it is stated:

> If the PTO is not inclined to expunge Thomson's entire Request for Reexamination, PMC alternatively requests that the PTO **expunge or redact Exhibit E, and all quotations from Exhibit E,** [Footnote omitted] from the publicly available files which include Thomson's Request. [Emphasis added]

While it would be premature to *expunge* materials from the paper file of the proceeding for the reasons set forth above, it is appropriate to *seal* Exhibit E [4] pending a final determination as to whether that exhibit should be expunged, and the petition is granted to that extent.

The petition is, however, dismissed as to sealing the request for reexamination as filed, since that would remove/eliminate the entire record of the reexamination request. If, however, patent owner will provide a redacted copy of the request for reexamination for insertion in place of the copy of the request as filed, then the request for reexamination as filed would be sealed, and the redacted copy provided in its place for public viewing. This further would permit the Office to retain a version of the request for reexamination, if the petition to expunge is ultimately granted.

In order to provide an acceptable redacted copy, the request for reexamination may be redacted **only** to remove the quotations from Exhibit E and other material which provides a description of the content of Exhibit E.

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[4] At the top of page 3 of the petition it is pointed out that "Thomson's Request for Reexamination gratuitously included a copy of a withdrawn notice of abandonment (Confidential Notice) from one of PMC's confidential applications.[Footnote omitted] See Exhibit E to Thomson's Request."

Petitioner is given a **one month from the date of this decision** to submit a renewed petition to seal the request for reexamination. In the event that no such renewed petition is filed, examination will proceed based on the existing copy of the request for reexamination, which will be unsealed, and only Exhibit E will remain sealed. **Any renewed petition** which is filed **must include** a complete redacted copy of the request.

**IV. ACTION TO BE TAKEN BY THE CENTRAL REEXAMINATION UNIT**

The appropriate Central Reexamination Unit (CRU) personnel will immediately:

1. Expunge, *in toto*, the electronic images of the request for reexamination from the CRU Scanning Data Base.

2. Seal the paper copy of Exhibit E of the request for reexamination as follows:

   A. Place Exhibit E in a sealed, clearly labeled, envelope or container.

   B. Provide a label, or enter information, on the envelope:

      1) Label the envelope or container as "Proprietary Documents Subject To Confidentiality/Protective Order."

      2) Set forth the tribunal issuing the protective order, i.e., the Federal District Court, on the label. The tribunal will be identified as follows:

         *"Personalized Media Communications, LLC v. Scientific-Atlanta, Inc., et al.,* Civil Action File No. 1:02-CV -824-CAP, United States District Court for the Northern District of Georgia"

      3) Set forth the appropriate reexamination information (reexamination control number, filing date, patent owner, inventors, examiner, Art Unit) for the present reexamination.

   C. Store the sealed envelope or container in a place separate from the present reexamination file, and not available to the public. [This sealed envelope or container will be forwarded to the Technology Center (TC) with the file, when the file is later forwarded to

the TC for action on the proceeding.]

D. Place a notation on the face of the file to indicate that confidential/protective order materials are present. The location of the materials, i.e., in the envelope or container, will also be specified. The words "CONFIDENTIAL/PROTECTIVE ORDER MATERIALS FILED WHICH ARE NOT OPEN TO PUBLIC" are sufficient to indicate the presence of such materials.

3. Store the file in the CRU, pending a patent owner response (via renewed petition) providing a "redacted copy" of the reexamination request redacted such that it does not include the confidential matter, or the expiration of time for submitting same. **The file shall <u>not</u> be made available to the public while it is being stored in the CRU under the instructions of this decision.**

**V. THE INFORMATION STATED TO BE CONFIDENTIAL HAS BEEN AVAILABLE TO THE PUBLIC:**

It is to be noted that the information which patent owner has requested to be expunged/sealed has already been made available to the public and subject to copying (of the file by the public) by the *filing* of the present reexamination request, 37 CFR 1.11(d). Accordingly, the Office cannot guarantee that the materials being sealed as a result of this decision were not previously accessed by the public.

**CONCLUSION**

1. The petition under 37 CFR 1.183 is granted, such that the present petition paper has been entered and addressed above.

2. The decision on the petition under 37 CR 1.59(b) is granted as to the request for expungement of the materials of the reexamination from the CRU Scanning Data Base. It is dismissed as to the request for expungement of the reexamination request. It is otherwise is held in abeyance.

3. The petition to seal materials under 37 CR 1.182 is granted to the extent that Exhibit E will be sealed, but is otherwise is dismissed, subject to petitioner's right to complete the petition as set forth in Section III of this decision.

4. **A redacted copy as set forth in Section III above is required from patent owner within ONE MONTH from the date of this decision.** The redacted copy should be submitted as an attachment to a paper titled "Renewed Petition to Seal Reexamination Request." **If the redacted copy is not received within the one month period set, examination will proceed based on the existing copy of the request, which will be unsealed, and only Exhibit E will be sealed.**

5. (A) The reexamination file is being forwarded to the CRU for expungement of materials from the CRU Scanning Data Base pursuant to Section IV of this decision, and scanning into the Data Base - the present petition filed May 30, 2003, and patent owner paper filed May 30, 2003, to inform the Office that no statement under 37 CFR 1.530 will be filed.

(B) The file will then be stored in the CRU **and not be made available to the public,** pending response by patent owner providing the redacted copy of the reexamination request, or the expiration of time for such.

6. Any questions regarding this decision should be directed to the undersigned at (703) 308-6710.

7. Telephone inquiries related to the examination of the reexamination proceeding should be directed to Examiner David E. Harvey of Art Unit 2614 at 703-305-4635.

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

June 26, 2003
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Paper No. 10 AR

HUNTON & WILLIAMS (For Patent Owner)
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MAILED
AUG 0 5 2003
REEXAM UNIT

Arthur J. Usher, Esquire (For Third Party Requester)
WOODARD, EMHARDT, NAUGHTON,
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Harvey et al :
Reexamination Proceeding : DECISION
Control No. 90/006,536 : GRANTING-IN-PART
Filed: February 4, 2003 : PETITION
For: U.S. Patent No. 4,965,825 :

This is a decision on the July 7, 2003, patent owner renewed petition filed under 37 CFR 1.182 and titled PETITION TO SEAL PAPERS FROM THE REQUEST FOR REEXAMINATION.

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

The petition is addressed in two respects:

(1) Under 37 CFR 1.182 as a request that papers from the request for reexamination be sealed.

(2) Under 37 CFR 1.182 as a request that the Office contact any parties that may have accessed the materials that petitioner has stated to be protected, and request return of such materials.

The petition to seal papers is granted to seal the originally filed request for reexamination, the originally filed Exhibit A1 and Exhibit E. The redacted copy of the request for reexamination, and that of Exhibit A1 (both submitted with the petition) will replace the originally filed request and

Exhibit A1, and the redacted copies will be open to the public. The redacted copies will be scanned into the REPS Scanning Data Base of the CRU.

The petition, as it relates to the request for contacting any parties that may have accessed unprotected materials, is dismissed, for the reasons set forth below.

**REVIEW OF FACTS**

1. U.S. patent No. 4,965,825 issued on October 23, 1990.

2. A request for reexamination, assigned control No. 90/006,536, was filed by a third party requester on February 4, 2003.

3. Reexamination was ordered for the '6536 reexamination proceeding on April 10, 2003.

4. A patent owner paper was filed May 30, 2003, to inform the Office that no statement under 37 CFR 1.530 will be filed.

5. Also on May 30, 2003, patent owner filed the present petition titled "PETITION TO EXPUNGE PAPERS FROM THE REQUEST FOR REEXAMINATION."

6. A decision was mailed June 26, 2003, in which:

   A. The petition under 37 CFR 1.183 was granted, to enter and address the petition paper.

   B. The petition under 37 CR 1.59(b) was granted to expunge the materials of the original reexamination request papers from the REPS Scanning Data Base. It was dismissed as to the request for expungement of the reexamination request, and it was otherwise held in abeyance.

   C. The petition to seal materials under 37 CR 1.182 was granted to the extent that Exhibit E was sealed, but was otherwise is dismissed, subject to petitioner's right to complete the petition by providing a redacted copy of the request.

7. On July 7, 2003, patent owner filed the present renwed

petition titled "PETITION TO SEAL PAPERS FROM THE REQUEST FOR REEXAMINATION."

## DECISION

### I. DECISION ON PETITION TO SEAL

The present renewed petition provides a redacted copy of request for reexamination and a redacted copy of Exhibit A1.

At page 4 of the renewed petition, it is pointed out that Exhibit A1 is an index of the exhibits filed with the request, and it identifies the document attached as Exhibit E

For the reasons set forth in the decision mailed June 26, 2003, it is appropriate to ***seal*** the unredacted original request for reexamination, the unredacted original of Exhibit A1, and Exhibit E pending a final determination as to whether the sealed papers should be expunged, and the present petition is granted to do so.

### II. ACTION TO BE TAKEN BY THE CENTRAL REEXAMINATION UNIT

The appropriate Central Reexamination Unit (CRU) personnel will immediately:

1. Scan into the REPS Scanning Data Base - the present renewed petition filed July 7, 2003, and the redacted copy of the request for reexamination and the redacted copy of Exhibit A1 submitted with the renewed petition, together with the attachments other than Exhibit E and the original of Exhibit A1.

2. Forward the file to the Technology Center for sealing of documents.

### III. ACTION TO BE TAKEN BY THE TECHNOLOGY CENTER TO SEAL MATERIALS

Upon return of the present file to the Technology Center, the appropriate personnel thereof will immediately:

1. Seal the paper copy of the unredacted original request for reexamination and the unredacted original Exhibit A1

as follows:

A. If possible, place the documents in a the clearly labeled, envelope in which Exhibit E was placed.

B. If there is insufficient room in the envelope for the documents, place them in a new envelope labeled as is the existing envelope. If this is the case, it should be added to the notation on the face of the file that there are two envelopes.

C. Store the sealed envelope(s) in a place separate from the present reexamination file, and not available to the public. [The sealed envelope(s) will be forwarded to the examiner with the file, when the file is forwarded to the examiner for action on the proceeding.]

2. Enter the redacted copy of the request for reexamination, and that of Exhibit A1 (both submitted with renewed July 7, 2003, petition) into the file to replace the originally filed request and Exhibit A1.

3. Forward the file in the examiner for action, with instructions to follow the procedure set forth in MPEP 724.04(c).

## IV. DECISION ON REQUEST TO CONTACT PERSONS WHO ACCESSED THE INFORMATION STATED TO BE CONFIDENTIAL, WHILE THE INFORMATION HAS BEEN AVAILABLE TO THE PUBLIC:

The information which patent owner has requested to be expunged/sealed has already been made available to the public and subject to copying (of the file by the public) by the *filing* of the present reexamination request, 37 CFR 1.11(d). Accordingly, the Office cannot guarantee that the materials being sealed as a result of this decision were not previously accessed by the public.

At page 6 of the supplemental petition, it is requested that the Office contact any persons who accessed the information stated to be confidential (protected) while the information has been available to the public, and request return of same. This request will not be granted, and the petition is dismissed as to this request.

Pursuant to 37 CFR 1.11(c), *Files open to the public.*, requests for reexamination are announced in the *Official Gazette*. Reexamination proceedings are then open to the public, i.e., access is permitted to reexamination proceedings.[1] See also MPEP 2232. Thus, any persons who accessed the information stated to be confidential (protected) did so while the information was appropriately available to the public. The public cannot be asked to return what it legitimately had access to.

Petitioner refers to the January 2, 2003, letter from Karin Ferriter, a copy of which was filed as an attachment to the original petition. In that letter, the patent owner was notified that parties who were known to have accessed patent owner's applications had been contacted by the Office and asked to return materials. It is to be noted, however, that applications are maintained confidential as required by 35 U.S.C. 122, and access to applications is strictly limited since they are to be maintained in confidence as per the statute. In the instance referred to by the letter, any party that should not have been entitled to access was requested to return proprietary materials, because such party would have obtained materials that should not have legitimately been open to access. In the present instance, reexaminations, are open to the public, and thus any party who obtained access did so within the statute and rules.

It is noted that the request for reexamination in this proceeding was filed by the third party requester on February 4, 2003, and patent owner was served with a copy of same at that time. Yet, the patent owner did not file the initial petition addressing the materials stated to be protected until May 30, 2003, more than three months after February 4, 2003. Thus, the Office did not have notice that protected materials might be present in the proceeding until almost three months after the request for reexamination was filed. During that period, any member of the public could have legitimately accessed the proceeding. Now that the Office has been made aware of the matter, relief is being provided. Such relief cannot, however, be provided retroactively.

**CONCLUSION**

1. The petition to seal materials under 37 CR 1.182 is granted

[1] In practice, any member of the public desiring a copy of all or part of a reexamination file may obtain such in the Office's Public Search Room from the reexamination database via REPS (Reexamination Processing System) terminals in the Public Search Room.

to seal the originally filed request for reexamination, the originally filed Exhibit A1 and Exhibit E.

2. The petition, as it relates to the request for contacting any parties that may have accessed unprotected materials, is dismissed.

3. The reexamination file is being forwarded to the CRU to scan into the REPS Scanning Data Base - the present renewed petition filed July 7, 2003, and the redacted copy of the request for reexamination and the redacted copy of Exhibit A1 submitted with the renewed petition, together with the attachments other than Exhibit E and the original of Exhibit A1.

4. The reexamination file will then be returned by the CRU to Technology Center 2600. The Technology Center will:

(A) Seal materials as directed by part III of this decision.

(B) Enter the redacted copy of the request for reexamination, and that of Exhibit A1 (both submitted with renewed July 7, 2003, petition) into the file to replace the originally filed request and Exhibit A1.

5. The reexamination file will then be forwarded to the examiner who will prepare an Office action in due course.

6. As pointed out in the June 26, 2003, decision on the original petition, a decision on the petition as it related, under 37 CR 1.59(b), to the request for expungement of the materials stated to be protected from the reexamination file is presently being held in abeyance, pending renewal of same by patent owner at an appropriate time. **The patent owner is cautioned that a failure to timely renew the petition to expunge prior to the point at which the file is forwarded for issuance of the reexamination certificate will result in the sealed material being unsealed and made of record in the reexamination file and thus becoming open to the public.**

7. Any questions regarding this decision should be directed to the undersigned at (703) 308-6710.

8. Telephone inquiries related to the examination of the reexamination proceeding should be directed to Examiner David E. Harvey of Art Unit 2614 at 703-305-4635.

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

August 4, 2003
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Paper No. 13

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(For Patent Owner)

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INDIANAPOLIS, IN 46204-5137

(For Third Party Requester)

MAILED

SEP 12 2003

REEXAM UNIT

Enclosure: August 7, 2003, third party requester petition and attachments.

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| Harvey et al | : |
| Reexamination Proceeding | : DECISION |
| Control No. 90/006,536 | : GRANTING-IN-PART |
| Filed: February 4, 2003 | : PETITION |
| For: U.S. Patent No. 4,965,825 | : |

This is a decision on (A) the August 7, 2003, third party requester petition titled REQUESTER THOMSON INC.'S PETITION TO UNSEAL PAPERS FROM THE REQUEST FOR REEXAMINATION and (B) the patent owner August 21, 2003, petition titled PETITION TO SEAL AND IN OPPOSITION TO REQUESTER THOMSON'S PETITION TO UNSEAL PAPERS FROM THE REQUEST FOR REEXAMINATION.

The requester petition is addressed in three respects:

(1) Under 37 CFR 1.183 as a request to waive the rules and provide an entry right for the requester petition papers.

(2) Under 37 CFR 1.182 [1] as a request to restore the electronic images expunged from the request for reexamination, and a request to unseal the paper documents sealed in the present reexamination proceeding.

(3) Under 37 CFR 1.182 as a request that all the request materials originally submitted by requester be publicly available in accord with 37 CFR 1.11.

The patent owner petition is addressed in three respects:

(1) Under 37 CFR 1.183 as a request to waive the rules and provide an entry right for the opposition petition papers.

(2) Under 37 CFR 1.182 as a request that requester's petition be denied consideration and returned to requester, or that the petition should be denied and sealed.

(3) As an opposition to the requester's position that the document attached as exhibit A of requester's petition should be open to the public in the present proceeding.

Pursuant to 37 CFR 1.17(h), a petition fee of $130.00 is required for a petition under 37 CFR 1.182 and/or 37 CFR 1.183. The required petition fees of $130.00 have been received from both requester and patent owner in the form of checks.

The petitions are before the Office of the Patent Legal Administration of the United States Patent and Trademark Office for decision.

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[1] All the requests in the requester and patent owner petitions directed to situations not specifically provided for in the regulations are addressed under 37 CFR 1.182.

**SUMMARY OF ACTION TAKEN**

The requester and patent owner petitions under 37 CFR 1.183 are granted, such that both petition papers will be considered and addressed.

The requester petition under 37 CFR 1.182 is dismissed and the materials previously expunged and sealed will not be restored and unsealed (respectively) for the reasons set forth below.

The patent owner petition under 1.182 is dismissed to the extent that the requester petition has been considered on its merits, and is granted to the extent that the requester petition is being returned to requestor to redact it to remove the improper content identified below.[2]

**REVIEW OF FACTS**

1. U.S. patent No. 4,965,825 issued on October 23, 1990.

2. A request for reexamination, assigned control No. 90/006,536, was filed by a third party requester on February 4, 2003.

3. Reexamination was ordered for the '6536 reexamination proceeding on April 10, 2003.

4. A patent owner paper was filed May 30, 2003, to inform the Office that no statement under 37 CFR 1.530 will be filed.

5. Also on May 30, 2003, patent owner filed the present petition titled "PETITION TO EXPUNGE PAPERS FROM THE REQUEST FOR REEXAMINATION."

6. A decision on patent owner's original petition was mailed June 26, 2003, in which:

   A. The petition under 37 CFR 1.183 was granted, to enter and address the petition paper.

[2] Since the requester petition is being returned, there is no need to address the alternatively requested sealing of the petition.

B. The petition under 37 CR 1.59(b) was granted to expunge the materials of the original reexamination request papers from the REPS Scanning Data Base. It was dismissed as to the request for expungement of the reexamination request, and it was otherwise held in abeyance.

C. The petition to seal materials under 37 CR 1.182 was granted to the extent that Exhibit E was sealed, but was otherwise is dismissed, subject to petitioner's right to complete the petition by providing a redacted copy of the request.

7. On July 7, 2003, patent owner filed a renewed petition titled "PETITION TO SEAL PAPERS FROM THE REQUEST FOR REEXAMINATION."

8. A decision on patent owner's renewed petition was mailed August 5, 2003, in which the petition to seal materials under 37 CR 1.182 was granted to the extent that (1) the originally filed request for reexamination and Exhibit A1 was sealed, to accompany already sealed Exhibit E, (2) the redacted paper copy of the request for reexamination, and that of Exhibit A1, were physically entered into the file to replace the originally filed request and Exhibit A1, and (3) the redacted copy of the request and the redacted copy of Exhibit A1 were scanned into the REPS Scanning Data Base together with the attachments other than Exhibit E and the original of Exhibit A1.

9. On August 7, 2003, the requester filed the instant petition *sub silentio* requesting waiver of the rules to provide an entry right for the petition paper, and specifically requesting that the electronic images expunged from the request for reexamination be restored, that the paper documents sealed in the present reexamination proceeding be unsealed, and that all the request materials originally submitted by requester be publicly available in accord with 37 CFR 1.11. The instant requester petition addresses the May 30, 2003, and July 7, 2003, patent owner petitions.

7. On August 21, 2003, the patent owner filed a petition in opposition to requester's August 7, 2003, petition, and request for return of same to requester. This patent owner paper will also require a waiver of the rules to provide it with an entry right, as will be discussed below.

## DECISION ON PETITIONS UNDER 37 CFR 1.183

### I. Requester Petition Under 37 CFR 1.183:

Pursuant to 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."

In addition, 37 CFR 1.550(g) provides:

> "(g) The active participation of the *ex parte* reexamination requester ends with the reply pursuant to § 1.535, and no further submissions on behalf of the reexamination requester will be acknowledged or considered. Further, no submissions on behalf of any third parties will be acknowledged or considered unless such submissions are:
>
> (1) in accordance with § 1.510 or § 1.535; or
>
> (2) entered in the patent file prior to the date of the order for *ex parte* reexamination pursuant to § 1.525."

Accordingly, the present requester petition paper does not have an entry right under the reexamination rules.

A right of entry for the petition paper would require a waiver of the above-quoted provisions of 37 CFR 1.540 and 37 CFR 1.550(g), such a waiver being available only pursuant to 37 CFR 1.183.[3] Accordingly, the present requester petition is taken to provide, as one of its requests for relief, a request under 37 CFR 1.183 for a waiver of the rules.

With respect to the sealing and expungement issue, patent owner's petition papers were entered, considered, and acted upon via the decisions dated June 26, 2003 and August 5, 2003. The rule

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[3] 37 CFR 1.183 states as follows:
"In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(h)."

(37 CFR 1.540) was waived because patent owner's rights could be prejudiced if a decision on the matter presented was delayed until the examination stage of this reexamination proceeding.

In the interest of fairness, justice requires that the rule be likewise waived to permit requester's "response" to patent owner's petition to be considered and addressed.

Accordingly, the requester petition, as it relates to relief under 37 CFR 1.183, is granted.

**II. Patent Owner Petition Under 37 CFR 1.183:**

Pursuant to 37 CFR 1.540, the patent owner opposition petition paper also does not have an entry right under the reexamination rules. Accordingly, the patent owner petition is also taken to provide a request under 37 CFR 1.183 for a waiver of the rules.

Once again, in the interest of fairness, justice requires that the rule be likewise waived to permit patent owner's "opposition" to requester's petition to be considered and addressed.

Accordingly, the patent owner petition, as it relates to relief under 37 CFR 1.183, is granted.

**DECISION ON REQUESTER PETITION UNDER 37 CFR 1.182**

**I. The Requester Petition, as it Relates to the Requests to Restore Expunged Materials and Unseal Materials:**

At page 3 of the third party requester petitioner petition (hereinafter "requester petition"), it is urged that:

> "Thomson properly obtained copies of the Notice of Abandonment from several sources such that Thomson is free to publicly disseminate the Notice of Abandonment. These sources include: (1) discovery in the Delaware Litigation, (2) the public record of other court proceedings involving PMC's patents, and, (3) from third parties who requested a file history containing the Notice Abandonment and received it from the PTO. PMC's petitions to expunge and/or seal devote extensive argument to the latter two sources but fail to fully address the first."

As to sources (2) and (3), petitioner requester (hereinafter "requester") has not provided a showing that any of the copies of the "Notice of Abandonment" referred to at page 3 of the petition were other than the "fruits" of the original improper access to the application involved.

As to source (1), it is apparently requester's position that the documents were obtained via discovery in the Delaware Litigation [4] in a manner that legitimately places the documents in the public domain. In order to address this position of requester, a review of the history of the matter is in order.

In November of 2001, as part of the "Delaware Litigation" procedure, a conference was conducted with Judge Sleet and the parties as to whether the Notice of Abandonment (hereinafter "the Notice") should be protected by protective order. [5] Requester points out that, after the conference:

> "Ultimately, pursuant to Thomson's November 2002 challenge to the confidentiality of various documents (Thomson' s objection stated that the Notice of Abandonment should be treated as public ), and as a result of the negotiation between the parties, PMC agreed to treat the Notice of Abandonment as public." Indeed, PMC's June 10,2003 PETITION TO EXPUNGE PAPERS FROM THE REQUEST FOR REEXAMINATION admits as much (see page 7), acknowledging that "PMC wrote Thomson that PMC would allow Thomson to treat the document as public." [Requester Petition at 7]

Requester bolsters this point (agreement to treat the Notice as public) by reference to an e-mail dated December 20, 2003 (attached as Exhibit D) from patent owner's counsel to requester's counsel.

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[4] *Pegasus Development Corporation & Personalized Media Communications, LLC v. DIRECTV, Inc., et al.,* Civil Action File No.1:02-CV -824-CAP, (United States District Court for the Northern District of Georgia) in Atlanta before Judge Sleet (the Delaware Litigation).

[5] A review of pages 18-20 of the transcript of the conference appears to indicate that the Judge directed the parties to reach a compromise as to the dissemination of the Notice, and the Judge closed with advice to counsel for patent owner that if counsel would not be reasonable in making a compromise, the Notice would be designated as public. Requester has characterized the result of the conference otherwise at page 6 of the petition.

In an e-mail dated January 9, 2003,[6] patent owner notified requester that patent owner withdrew its consent to making the notice public a "change of circumstances" warranted "treatment of the Notice of Abandonment as confidential." [7] The "change of circumstances" referred to in the patent owner's notification is the January 2, 2003, letter authored by Karin Ferriter (a Senior Legal Adviser of the Office of Patent Legal Administration) holding that the access which was granted by the Office to the Notice should not have been granted.

Then, in a January 13, 2003, letter, requester informed the patent owner that requester rejected patent owner's attempt to renege on what requester characterized as an agreement that the Notice "was to be treated as public." [8]

Page 7 of the requester petition goes on to state that

> "Thomson [requester] has maintained this position and has distributed copies of the Notice of Abandonment to third parties with no restriction of confidentiality. Despite its knowledge of Thomson's position and unrestricted distribution of the Notice of Abandonment, the patent owner has made absolutely no attempt to raise this issue with the Delaware Court"

As to requester's contention that patent owner has not approached the Delaware Court for a modification of the protective order which did not protect the Notice of Abandonment, patent owner, on pages 9 and 10 of the patent owner petition, disputes this. Patent owner argues that, pursuant to Judge Sleet's Standing Order for resolving the matter, patent owner took steps in January of 2003 to arrange for contact with "chambers" to schedule a telephone conference with the Court.

On May 2, 2003, Order of the Atlanta District Court [9] granted patent owner's motion for a protective order to protect the Notice. Requester is not a party to that action and there is no

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[6] Exhibit E of the requester petition.

[7] *See* Exhibit E, second paragraph.

[8] *See* Exhibit F of the requester petition.

[9] Issued in *Personalized Media Communications,LLC v. Scientific-Atlanta, Inc., et al.*, Civil Action File No. 00-1020 (GMS), (United States District Court for the District of Delaware) in Wilmington before Judge Pannell (the Atlanta Litigation).

indication that requester made any attempt to intervene in that action.

It is initially noted that the Order of the Atlanta District Court granting patent owner protection of the Notice was issued after all of the above history; yet, in spite of the history the Atlanta District Court found that the Notice could not be made public. Thus, at the very least there exists a conflict of District Court findings on the confidentiality of the Notice.[10] The Office is not about to arbitrate that dispute, especially since, petitioner has not provided a showing as to how the materials remaining sealed and the redacted request being publicly available will prejudice the decision made on the reexamination request, and/or the examination of the reexamination proceeding. MPEP 724.04(c) sets forth the guidelines for a petition to expunge "Materials Submitted in Reexamination File Open to the Public Under 37 CFR 1.11(d)." When the application is considered for action on the merits, the examiner (and/or other appropriate Office official responsible for considering the information) **will review the sealed information, and will make a determination as to whether or not any portion or all of the information submitted is "important to a reasonable examiner in deciding whether or not a claim is patentable."** Thus, a full review of requester's submissions will be made, and there is no reason to grant this request of the third party requester which is not provided for in the rules and is at least open to dispute by the courts. The Office does not need to arbitrate the matter, when it can satisfy its mission of reexamining patents without arbitrating the matter (see the discussion of this below), and accordingly will not do so. [11]

[10] It is to be noted that the interaction with Delaware District Court as to the Notice took place prior to the Office's January 2, 2003, letter by the Senior Legal Adviser holding that the access which was granted by the Office to the Notice should not have been granted, and that statutory issues of patent application confidentiality (35 U.S.C. 122) were involved. It is not entirely clear as to the approach the Delaware District Court will have subsequent to the Office's letter.

[11] Stated another way, when balancing the interests here, the statutorily recognized (35 U.S.C. 122) interest in maintaining the confidentiality of material present in patent owner abandoned patent applications far outweighs the requester's interest in making the material present, since the examination of the proceeding will not be impeded by the Notice not being available to the public via the reexamination.

Thus, the petition, as it relates to the requests to **restore expunged materials and to unseal materials,** is dismissed.

At page 3 of the requester petition, requester states its request for relief in terms of public policy:

> "Thomson asks that this petition be given consideration so that its due process rights can be met, and the public can be served by learning of the contents of the Notice of Abandonment."

In response, the present decision does not aide nor hinder the dissemination of the Notice of Abandonment outside the Office. Nor does it affect any remedies that parties may have and may exercise as to action/conduct by parties in regard to dissemination of the Notice by parties to the public. Such matters are left to the courts, and, as pointed out in the requester petition, "Thomson continues to freely distribute copies of the Notice of Abandonment to others...."[12] The present decision is merely a statement that the Office can accomplish its mission in reexamining the patent of the present proceeding while the papers are under seal, because the Office has access to those papers as needed. Requester is not being prejudiced in any manner as to the examination that will be provided and the consideration of the materials submitted by requester. It is the purpose of reexamination to determine whether the patent claims are patentable over the patents and printed publications; it is not the purpose of reexamination to make, or ensure that, the submitted materials are public. Whether dissemination of the Notice is appropriate or not is a matter left to the courts. The Office is simply refusing to be the agent by which dissemination is carried out (via filing the Notice of Abandonment in the reexamination proceedings) until it becomes clear that there is a right for such dissemination. Given the above-discussed history, the matter is far from being clear.

As a final point, it is not clear what prompted requester to ask for a copy of the Notice of Abandonment in the discovery stage of the litigation. If such were prompted by knowledge of its existence obtained as a result of the improper access to the Notice in the application (and subsequent dissemination thereof), then the "publication" of the Notice via the Delaware litigation would also be fruits of the improper access, and as such, the Office could not permit the Notice to remain available to the public.

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[12] Requester petition at 13.

**II. The Requester Petition, as it Relates to the Request That All Materials Originally Submitted by Requester Be Publicly Available in Accord with 37 CFR 1.11:**

The requests for unsealing and restoring expunged materials to make the materials publicly available in accord with 37 CFR 1.11 have already been addressed in the preceding section of this decision. To the extent that this request is a repetition of the first two requests, it is dismissed for the reasons set forth in the preceding section.

Other than unsealing the sealed materials and restoring the expunged electronic materials, it is not clear what action the Office can take to address this request. If petitioner desires a statement that such materials are in the public domain, such a statement would not be addressed to providing relief in the present proceeding, and is dismissed as such. In any event, as pointed out above, there has not been any showing of the existence of a copy of the materials not obtained in some manner as the fruit of the original improper access, thus there would be no basis to make the materials public.

**III. Other Requester Arguments:**

A. At pages 11 through 13 of the requester petition, it is argued that the patent owner has no right to expunge and/or seal material from Thomson's third party request for reexamination under the governing law.

In response, 37 CFR 1.182 provides relief to parties in "situations not specifically provided for in the regulations" such relief being provided "in accordance with the merits of each situation." In this instance, the patent owner has an interest in maintaining the confidentiality of it's confidential material. Such an interest can be protected by sealing the materials, as has been done. It is to be noted that prior to the promulgation of 37 CFR 1.59 for expungement of papers, such relief was also provided by 37 CFR 1.182 based on the interest of protecting confidential material.

B. At page 13 of the requester petition, it is argued that:

> "[T]he procedure sought to be invoked by PMC results in a denial of due process to Requester, in that it contemplates a striking of the material without the Requester having an appropriate role in the matter. Whether material should be struck from any paper a requester files with the PTO is a matter in which the requester must be given an opportunity to be heard, and not resolved solely between the PTO and some other party who believes it might be impacted by the contents of the filing. At best, PMC's request can be viewed as a public request to have the PTO strike matter filed by another party. If the PTO desires to inquire further as to the merits of the request, it should then deal directly with the filer of the papers, Thomson, allowing an opportunity for Thomson to be heard on the merits."

In response, requester has not indicated that it was not served with a copy of patent owner's initial petition to expunge; [13] yet, requester failed to file an opposition to patent owner's initial petition - not in this proceeding nor in any of the related proceedings identified in the first footnote of the requester petition. In addition, by way of the present requester petition (and this decision), requester has in fact been heard on the merits.

**DECISION ON PATENT OWNER PETITION UNDER 37 CFR 1.182 AND RETURN OF THE REQUESTER PETITION FOR REDACTION**

**A. Discussion:**

At pages 4-6 of the patent owner petition, it is argued that requester's petition should be denied consideration and returned to the requester, or denied and sealed.

As pointed out by patent owner, neither the rules nor any provision of the statute provide authority for a third party to participate in a reexamination proceeding by filing a paper directed to the substantive issues of the proceeding. *See In re Amp*, 212 USPQ 826 (Comr. Pats. 1981). The statute and its intent

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[13] And a certificate of service of the petitions (that accompanied the filing of the petitions) *prima facie* establishes that requester was served.

are clear that a reexamination proceeding requested under 35 U.S.C. 302 must be *ex parte*. In this regard, the Court of Appeals for the Federal Circuit stated in *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 882 F.2d 1570, 1573, 11 USPQ2d 1866, 1868, 1869 (Fed. Cir. 1989):

> "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."

*Also see In re Chambers*, 20 USPQ2d 1470, 1476 (Comr.Pat. 1991):

> "It is noted that a third party has no right to comment or participate in a reexamination proceeding beyond the rights specifically provided for by the reexamination statute, i.e., file a request for reexamination and comment on any statement filed by a patent owner."

**B. Decision:**

Part 1

To the extent that the petition requests unsealing, restoring of e-files, and publication of the materials related to the Notice of Abandonment, this is not participation in the conduct of the reexamination proceeding. Rather, it is a non-substantive response to the patent owner's prior request for sealing and expungement, which has nothing to do with the conduct of the reexamination itself. Thus, such a requester paper is not barred by the statute. Rather, such a matter is appropriate for consideration where, as is the case here, justice requires that requester be granted an opportunity to be heard as to patent owner's request for sealing and expungement. In the same manner that a waiver of the rules was granted for consideration of patent owner's request for sealing and expungement, and for consideration of patent owner's present request as to how the requester petition should be dealt with, justice requires that a waiver of the rules be granted for consideration of requester's position on the matter.

Patent owner is referred to Manual of Patent Examining Procedure (MPEP) § 2246 where it is stated that consideration is given to a patent owner petition to vacate an *ultra vires* reexamination order even at a point where a patent owner petition would otherwise not have an entry right. In that situation, the third party requester is given an opportunity file a single submission in opposition to the petition, even though a requester paper would otherwise not have an entry right. The present situation is analogous to that of MPEP § 2246.

Part 2

At page 10 of the requester petition, it is stated:

> "As previously noted, Thomson has attached a copy of the January 18,2001 Notice of Abandonment to the present petition as Exhibit A. Even a brief review of the contents of the Notice of Abandonment indicates areas of potential and/or actual overlap with issues include issues that may or will arise during the reexamination proceedings."

The items that requester perceives as such are then set forth.

The discussion by requester of the overlap of the Notice with issues of the case is clearly substantive; it amounts to an argument/statement of relevance of the information of record (the Notice). This would be a supplement to the request for reexamination, which is prohibited. Such participation by the requester is barred by the statute for the reasons set forth above. The determination as to relevance of the Notice **is for the examiner to make**, and the requester is not, at this stage, permitted to file information on the issue.

Additionally, it is to be noted that there is no need for the presentation of Exhibit A, the attached copy of the January 18, 2001, Notice of Abandonment. There is already a sealed copy of the Notice of record, to which the Office may refer as needed. Providing another copy is surplusage, and would require the needless sealing and storage of another paper in an already extensive record.

In view of the presence of the inappropriate contents of the petition, the requester petition is being returned to requester with a copy of this decision.

If requester wishes to retain of record the portions of the requester petition other than Exhibit A and the argument/statement of relevance directed to the Notice, requester must provide a redacted petition omitting Exhibit A and the argument/statement of relevance. Such would retain requestor's other materials, arguments, positions taken, points made, etc. of record.

A redacted copy as set forth above is required from requester within ONE MONTH from the date of this decision. If the redacted copy is not received within the one month period set, the paper will no longer have an entry right.

It is to be noted that while ordinarily the petition containing the improper subject matter might not be addressed on the merits and simply returned for correction, the issues of requester's petition have been addressed on the merits in this decision. This was done in view of the number of cases involved, the different stages of the cases, and the various time constraints involved. [14]

As to patent owner's alternative request for sealing of the petition, such is moot, since the requester petition is being returned. Thus, there is no need to address this alternative relief that was requested.

**CONCLUSION**

1. The requester and patent owner petitions are granted under 37 CFR 1.183, such that the requester and patent owner petition papers have been considered and addressed above.

2. The requester petition under 37 CR 1.182 is dismissed.

3. The patent owner petition under 37 CR 1.182 is dismissed to the extent that the requester petition has been considered on its merits, and is granted to the extent that the requester petition is being returned to requestor to redact it to remove the improper content identified below.

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[14] As stated in the first footnote of the requester petition, "[t]he patent owner has filed such papers in connection with Thomson's Requests for Reexamination of U.S. Patent Nos. 4,965,825 [Reexam Control No. 90/006,536 filed February 4, 2003], 5,335,277 [Reexam Control No. 90/006,563 filed March 14, 2003], 5,233,654 [Reexam Control No. 90/006,606 filed April 18, 2003], and 5,887 ,243 [Reexam Control No. 90/006,688 filed June 30, 2003]." The determination on the request has not yet been made for one of these proceedings.

4. The requester petition papers are being returned with this decision. A redacted copy of the requester petition pursuant to the instructions set forth above is required from requester within ONE MONTH from the date of this decision. If such a redacted copy is not received within the one month period set, the paper will no longer have an entry right.

5. The reexamination file is being returned to Technology Center 2600 for forwarding to the examiner who will prepare an appropriate Office action consistent with this decision.

6. If the redacted copy of the requester petition pursuant to the instructions set forth above is timely received from requester, the file should be forwarded to the Office of Patent Legal Administration to the attention of Kenneth M. Schor, Senior Legal Advisor.

7. Any questions regarding this decision should be directed to Kenneth M. Schor at (703) 308-6710.

8. Telephone inquiries related to the examination of the reexamination proceeding should be directed to Examiner David E. Harvey of Art Unit 2614 at 703-305-4635.

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

September 11, 2003
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(For Patent Owner)

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(For Third Party Requester)

Harvey et al :
Reexamination Proceeding : DECISION
Control No. 90/006,536 : GRANTING
Filed: February 4, 2003 : PETITION
For: U.S. Patent No. 4,965,825 :

This is a decision addressing the October 2, 2003, third party requester submission titled REQUESTER THOMSON INC.'S SUBMISSION OF REDACTED VERSION OF PETITION TO UNSEAL. Due to the nature of the submission, it is taken as a renewed petition under 37 CFR 1.183 directed solely to waiver of the rules to provide an entry right for making the re-submitted **previously addressed** requester petition papers of record in redacted format.

The petition under 37 CFR 1.183 is granted.

**DECISION**

As pointed out in the present submission, the decision issued by this office in September of 2003 stated:

> "If requester wishes to retain of record the portions of the requester petition other than Exhibit A and the argument/statement of relevance directed to the Notice, petitioner must provide a redacted petition omitting Exhibit A and the argument/statement of relevance. Such would retain requestor's other materials, arguments, positions taken, points made, etc. of record."

The present submission is responsive to that statement of the September decision, and has timely provided the suggested redacted petition. Accordingly, the submission is granted entry for the reasons set forth in the September decision. The reasons for waiver of the rules set forth therein continue to apply to the present submission.

The redacted requester petition, which was previously addressed in the September decision of this office, will be made of record in the present proceeding.

**CONCLUSION**

1. The requester petition under 37 CFR 1.183 is granted.

2. The October 2, 2003, third party requester submission will be entered into the record and scanned into the Reexamination Processing System Scanning Data Base of the Central Reexamination Unit.

3. The reexamination file is being returned to Technology Center 2600 for forwarding to the examiner.

4. Any questions regarding <u>this decision</u> should be directed to the undersigned at (703) 308-6710.

5. Telephone inquiries related to <u>the examination of the reexamination proceeding</u> should be directed to Examiner David E. Harvey of Art Unit 2614 at 703-305-4635.

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

October 4, 2003
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| | | |
|---|---|---|
| In re John C. Harvey et al. | : | DECISION DISMISSING |
| Reexamination Proceeding | : | PETITION AND SEALING |
| Control No.: 90/006,536 | : | PAPERS, AND |
| Filed: February 4, 2003 | : | ORDER *RE* SHOWING |
| For: U.S. Patent No. 4,965,825 | : | CAUSE TO UNSEAL |

This is a decision on the September 6, 2005 petition titled PETITION TO EXPUNGE PAPERS FROM PATENT REEXAMINATION FILES.

The petition is considered in three respects:

(1) Under 37 CFR 1.183 as a request to waive the rules and allow entry of the petition paper.

(2) Under 37 CFR 1.182 as a request to expunge materials submitted by the patent owner with the Information Disclosure Statement (IDS) of August 22, 2005.[1]

(3) Under 37 CFR 1.182 as a request to seal materials submitted by the patent owner with the Information Disclosure Statement (IDS) of August 22, 2005.

---

[1]The instant petition states that the IDS was filed on August 19, 2005. However, the USPTO has no record of any IDS filed on that date. The petition is considered to be directed to the IDS filed August 22, 2005.

At the end of the first paragraph of the instant petition, the petitioner authorizes the Office to charge the petition fee to a deposit account number 19-0733. The $400 fee set forth in 37 CFR 1.17(f) for a petition under 37 CFR 1.182 has been charged.

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

## SUMMARY

The petition under 37 CFR 1.183 is granted, such that the present petition paper will be permitted entry and will be addressed.

The petition under 37 CFR 1.182 to expunge materials is dismissed as not ripe for decision.

The petition under 37 CFR 1.182 to seal materials is granted to the extent that:

(a) The Office is placing the documents identified by the petitioner in Exhibit 1 attached to the instant petition at least temporarily under seal.

(b) The patent owner is being provided with an opportunity to show cause why the documents identified by the petitioner in Exhibit 1 should be available to the public, and thus unsealed.

## REVIEW OF FACTS

1. U.S. Patent No. 4,965,825 (hereinafter, the '825 patent) issued on October 23, 1990.

2. On March 28, 2002 the patent owner Personalized Media Communications, LLC (PMC) brought a patent infringement suit against the petitioner Scientific-Atlanta, Inc. (S-A) in the United States District Court for the Northern District of Georgia.[2] As of the mail date of this decision, the litigation is ongoing.

3. On May 2, 2003, the court issued an Order prohibiting public disclosure of certain information.

4. On February 4, 2003 Thomson, Inc. filed a request for reexamination of the '825 patent. The request for reexamination was assigned control number 90/006,536, and it was granted.

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[2] *Personalized Media Communications,LLC v. Scientific-Atlanta, Inc.*, No.1:02-CV -824 (N.D. Ga. filed Mar. 28, 2002).

5. On August 22, 2005, PMC filed an IDS in reexamination control number 90/006,536.

6. On September 6, 2005, S-A (which is not a party to the reexamination proceeding) filed the instant petition, alleging that PMC's IDS improperly included certain documents subject to the court's protective Order.

DECISION

I. The Petition Under 37 CFR 1.183 for Entry of the Petition Paper

The instant petition is not entitled to entry. According to 37 CFR 1.550(g):

According to 37 CFR 1.550(g):

> [N]o submissions on behalf of any third parties will be acknowledged or considered unless such submissions are:
>
> (1) in accordance with § 1.510 or § 1.535; or
>
> (2) entered in the patent file prior to the date of the order for *ex parte* reexamination pursuant to § 1.525.

The petitioner S-A is not a party to the instant reexamination proceeding. The present petition is not a request for reexamination under 37 CFR 1.510, and S-A is not a third party requester subject to the provisions of 37 CFR 1.535. In addition, the instant petition was filed after the date of the order for *ex parte* reexamination (37 CFR 1.552(g)(2)), and it is clearly not a submission of a prior art citation under 37 CFR 1.502. Thus, the S-A petition does not have an entry right in the instant proceeding. Although the Office does accept submissions from third parties pursuant to MPEP § 2282 that are limited to bare notice of prior or concurrent litigation involving the patent undergoing reexamination, such notice is not the subject of the instant petition. S-A fails to suggest any provision of the regulations which could provide a basis for entry of its petition, and the Office can identify none. Thus, by rule, S-A is not entitled to consideration of the instant petition.

Pursuant to 37 CFR 1.183, however:

> 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.

In the present instance, the petition alleges that significant property rights are at stake, and because it may be possible for the Office to act to protect those rights, the interests

of justice require that the reexamination entry right rules be waived, and the Office will enter and consider S-A's petition. Entry of the present petition in the reexamination proceeding is akin to entry of bare notice of prior or concurrent litigation in a reexamination proceeding (pursuant to MPEP § 2282), as both serve a legitimate interest, and both do not go to the merits of the proceeding, and as such, do not involve prohibited participation in the proceeding.

Accordingly, the petition, as it is taken under 37 CFR 1.183, is granted to permit entry and consideration of the petition paper.

II. The Petition Under 37 CFR 1.182 to Expunge

S-A's petition cannot be considered under 37 CFR 1.59, since 37 CFR 1.59, by its terms, applies to "applications" and not to reexamination proceedings.

However, 35 U.S.C. 305 provides:

> After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title.

This provision of 35 U.S.C. 305 has been interpreted to permit a petition for expungement in reexamination proceedings. Since there is no rule that provides for expungement in reexamination proceedings, S-A's petition to expunge is taken as a petition under 37 CFR 1.182 to expunge documents from the record of the reexamination proceeding.[3] In deciding such petitions for expungement in reexamination, the guidelines for deciding petitions filed under 37 CFR 1.59 (see MPEP 724-724.06) are followed insofar as they may be applied to the facts at hand. Such will be the case for the present petition.

MPEP 724.04(c) sets forth the guidelines for a petition to expunge "Materials Submitted in Reexamination File Open to the Public Under 37 CFR 1.11(d)." When the reexamination proceeding is considered for action on the merits, the examiner (and/or other appropriate Office personnel responsible for considering the information) will review the protected information that has been sealed, and will make a determination as to whether or not any portion or all of that information is "important to a reasonable

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[3] 37 CFR 1.182 states:

> 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).

examiner in deciding whether or not a claim is patentable." The examiner may issue a determination on the issue of importance of the sealed information in the first Office action on the merits, or in an Office action issued any time thereafter as appropriate, but in no event later than the close of prosecution.

It is not appropriate to make, in this decision, a final determination of whether or not the material requested to be expunged is "important to a reasonable examiner in deciding whether or not a claim is patentable." Rather, such a decision is issued by the examiner no later than the close of prosecution. Thus, a decision on the petition to expunge would be premature at this time. Therefore the petition, as it relates to the expungement issue, is dismissed.

III. The Petition Under 37 CFR 1.182 to Seal

S-A alleges that certain documents, identified in Exhibit 1 attached to the instant petition and submitted to the Office by PMC with the IDS of August 22, 2005, are subject to the court's May 2, 2003 protective order. S-A has provided the Office with a copy of the court Order as Exhibit 2. According to S-A, the Exhibit 1 documents are S-A's trade secrets and are within the scope of the May 2, 2003 protective order, and S-A would be harmed by their public release. By way of the present petition, S-A seeks to avert this perceived harm.

It is found that S-A provides a reasonable basis upon which to conclude that the Exhibit 1 documents may be subject to the protective order, and that their availability to the public may cause harm to S-A. The practitioner signing the instant petition has done so subject to the Patent and Trademark Office Code of Professional Responsibility, including 37 CFR 10.23(c)(2)(ii) which prohibits giving false or misleading information to the Office. It is noted that 37 CFR 1.11(d) states:

> All papers or copies thereof relating to a reexamination proceeding which have been entered of record in the patent or reexamination file are open to inspection by the general public, and copies may be furnished upon paying the fee therefor.

However, in the interest of justice under 37 CFR 1.183, the Office hereby waives the public access provision of 37 CFR 1.11(d) *sua sponte*, as it applies to the IDS of August 22, 2005, subject to the right of patent owner to show cause why the information should be made public, as per the next section of this decision. The IDS and its accompanying documents will be sealed from public view. Such sealing furthers the interest in mitigating any damage which may already have been incurred by S-A as to retaining the confidentiality of S-A's documents, which appear to be subject to the protective court order of May 2, 2003. It is to be noted, however, that even if the patent owner does not show cause why the information should be made public, the information would be made public in the event that it is determined by the Office that the information is "important to a reasonable examiner in deciding whether or not a claim is patentable." See the discussion above in this decision.

As a final point, although the information which is the subject of this decision will now be at least temporarily sealed, that information has already been made available to the public and has been subject to copying under 37 CFR 1.11(d). Accordingly, the Office cannot guarantee that the materials being sealed as a result of this decision were not previously accessed by the public.

IV. Order Providing Opportunity to Show Cause

Patent owner PMC is hereby provided with an opportunity to show cause why the materials sealed in accordance with this decision should be unsealed, such that the documents identified in S-A's Exhibit 1 would be made accessible to the public. If PMC believes that public access to the documents is appropriate and the seal should be lifted, PMC must explain why such is the case, in light of S-A's allegations and the protective order of record. PMC is given a **one month time period from the date of this decision** to respond to this Order. If no response to this Order is received within one month, or if sufficient cause is not shown in the response, the Office will resume examination of the reexamination proceeding, with the materials remaining sealed.

CONCLUSION

1. The petition under 37 CFR 1.183 is granted, such that the present petition paper has been entered and addressed.

2. The petition under 37 CFR 1.182 to expunge materials is dismissed as not ripe for decision.

3. The petition under 37 CFR 1.182 to seal materials is granted to the extent that the Office is placing the documents identified by the petitioner in Exhibit 1 attached to the instant petition at least temporarily under seal.

4. The patent owner is provided with **ONE (1) MONTH** from the date of this decision, to show cause why the materials sealed in accordance with this decision should be unsealed.

5. The instant reexamination proceeding is being forwarded to the Central Reexamination Unit to sale the documents identified in Exhibit 1 attached to the instant petition, and mail the present decision.

6. After mailing of this decision, jurisdiction over the instant reexamination proceeding will be retained by the Office of Patent Legal Administration until either:

> (1) The time expires for response to the Show Cause Order without any response having been received. Where no response is received and the time for same has expired, jurisdiction will automatically transfer to Technology Center 2600, and the examiner will prepare an Office action

for the proceeding; OR

(2) A response to the Show Cause Order is received and the issue of sealing is resolved, after which jurisdiction will be transfered to Technology Center 2600 for preparation of an Office action

7. Telephone inquiries related to this decision should be directed to Kathleen Kahler Fonda, Legal Advisor, at (571) 272-7754 or in her absence, to the undersigned, at (571) 272-7710.

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

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October 18, 2005

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In re John C. Harvey et al.
Reexamination Proceeding
Control No.: 90/006,536
Filed: February 4, 2003
For: U.S. Patent No. 4,965,825

DECISION DISMISSING PETITION AND UNSEALING PAPERS

This is a decision on the patent owner's October 11, 2005 petition titled PATENT OWNER'S PETITION TO RETURN MATERIALS SUBMITTED BY THIRD PARTY IN *EX PARTE* PROCEEDING. This decision is also responsive to the patent owner's November 1, 2005 submission titled PATENT OWNER'S RESPONSE TO ORDER PROVIDING OPPORTUNITY TO SHOW CAUSE.

The instant petition is treated as a petition under 37 CFR 1.182.[1] On page 2 of the petition, the patent owner authorizes the Office to charge fees associated with the

[1] 37 CFR 1.182 states:

> 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).

petition to deposit account number 50-0206. The $400 fee set forth in 37 CFR 1.17(f) for a petition under 37 CFR 1.182 has been charged.

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

## SUMMARY

The patent owner's petition under 37 CFR 1.182 is dismissed in view of the patent owner's request that it be withdrawn.

The documents placed under temporary seal by the Office decision of October 21, 2005 titled DECISION DISMISSING PETITION AND SEALING PAPERS, AND ORDER *RE* SHOWING CAUSE TO UNSEAL are hereby unsealed.

## REVIEW OF FACTS

1. U.S. Patent No. 4,965,825 (hereinafter, the '825 patent) issued on October 23, 1990.

2. On March 28, 2002 the patent owner, Personalized Media Communications, LLC (PMC), brought a patent infringement suit against Scientific-Atlanta, Inc. (S-A) in the United States District Court for the Northern District of Georgia. As of the mail date of this decision, the litigation has been stayed pending conclusion of the ongoing reexamination proceeding.[2]

3. The court issued an Order prohibiting public disclosure of certain information on May 2, 2003.

4. On February 4, 2003 Thomson, Inc. filed a request for reexamination of the '825 patent. Reexamination control number 90/006,536 was assigned to the proceeding, and the request for reexamination was granted.

5. On August 19, 2005, PMC filed an information disclosure statement (IDS) in reexamination control number 90/006,536.

6. On September 6, 2005, S-A (which is not a party to the reexamination proceeding) filed a petition alleging that PMC's IDS improperly included certain documents subject to the court's protective Order.

7. On October 11, 2005, the patent owner filed the instant petition to return materials submitted by a third party, i.e., the September 6, 2005 S-A petition.

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[2] *Personalized Media Communications,LLC v. Scientific-Atlanta, Inc.*, No.1:02-CV -824 (N.D. Ga. filed Mar. 28, 2002) (order to stay all proceedings pending PTO reexamination issued Feb. 6, 2006).

8. The Office of Patent Legal Administration issued a decision on S-A's petition on October 21, 2005. The decision allowed entry of S-A's petition, dismissed the request to expunge as untimely, and temporarily sealed certain documents alleged by S-A to be covered by the court's protective order. The decision also provided the patent owner with an opportunity to show cause why the documents should be unsealed. At the time of that decision, the Office of Patent Legal Administration was unaware of the instant petition.

9. On October 28, 2005, the court issued an order denying S-A's motion to hold the patent owner in contempt for disclosing to the Office certain documents alleged by S-A to be within the scope of the court's May 2, 2003 protective order.

10. On November 1, 2005, the patent owner submitted the instant response to the Office's decision of October 21, 2005.

## DECISION

I. The Petition Under 37 CFR 1.182 for Return of S-A's Petition

The Office of Patent Legal Administration regrets that it was unaware of the patent owner's instant petition at the time the decision on S-A's petition was made.

The patent owner's petition requests that S-A's petition be returned without consideration, or in the alternative, that the Office stay S-A's petition pending a determination of confidentiality by the district court.

The decision of October 21, 2005 recognized that S-A's petition was not entitled as a matter of right to entry under 37 CFR 1.550(g), but nevertheless allowed entry of the petition in the interest of justice pursuant to 37 CFR 1.183. The decision also placed certain documents under temporary seal, and afforded the patent owner an opportunity to show cause why the documents should be unsealed.

The patent owner's petition is dismissed as moot in view of the issuance of the decision Office of October 21, 2005. The petition is further mooted as to any future action by the Office in regard to the relief requested, since a determination of confidentiality by the district court has now been made, i.e., the court's decision was issued October 28, 2005 as a court Order.

II. The Reponse to the Order Providing Opportunity to Show Cause

S-A's petition of September 6, 2005 had alleged that certain documents, identified in Exhibit 1 attached to S-A's petition and submitted to the Office by the patent owner with the IDS of August 19, 2005, were subject to the court's May 2, 2003 protective order. In the decision of October 21, 2005, the Office placed the documents under temporary seal. Acting in the interest of justice under 37 CFR 1.183, the Office *sua sponte* waived the public access provision of 37 CFR 1.11(d) for a limited period of time because a

reasonable question had been raised as to whether the documents were subject to the protective court order of May 2, 2003.

The court has now determined, by way of the Order dated October 28, 2005, that the documents in question were not subject to the protective order of May 2, 2003, and that the patent owner's submission of the documents to the Office was not in contempt of the Order. For this reason the patent owner now requests that the documents be unsealed.

In view of the court Order and the patent owner's request, it is directed by way of this decision, that the documents be unsealed. The documents are to again be available to the public in accordance with 37 CFR 1.11(d).

## REQUESTER'S ADDRESS

The patent owner's communications were served on the requester at the following address:

A. J. Usher, IV
BOSE MCKINNEY & EVANS LLP
2700 First Indiana Plaza
Indianapolis, IN 46204

The address of record is:

Arthur J. Usher, IV
WOODARD EMHARDT NAUGHTON MORIARTY & MCNETT LLP
Bank One Center/Tower
111 Monument Circle, Suite 3700
Indianapolis, IN 46204-51387

The instant decision is being mailed to both the address of record and the address at which the requester was served.

The patent owner is directed to take any needed steps to ensure that the copies of the patent owner papers identified above are, or have been, served on the requester.

The requester is directed to file an appropriate change of address, if the address of record is no longer correct.

## CONCLUSION

1. The petition under 37 CFR 1.182 is dismissed.

2. The patent owner's showing of cause to unseal the documents temporarily placed under seal in accordance with the decision of October 21, 2005, is found

to be sufficient; accordingly the documents will be unsealed.

3. This decision is a final agency action within the meaning of 5 U.S.C. § 704.

4. Jurisdiction over the instant reexamination proceeding is being returned to Technology Center 2600. The Technology Center is directed to unseal the information disclosure statement filed August 19, 2005, by the patent owner, prior to taking any other appropriate action.

5. Telephone inquiries related to this decision should be directed to Kathleen Kahler Fonda, Legal Advisor, at (571) 272-7754, or in her absence, to the undersigned, at (571) 272-7710.

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

C:\kiva\kenpet6\expung\6536 Resp by Owner Re Unseal_grant.wpd
March 29, 2006

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COMMISSIONER FOR PATENTS
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ALEXANDRIA, VA 22313-1450
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HUNTLON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K Street N.W.
Suite 1200
Washington, DC 20006-1109

(For Patent Owner)

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MAY 18 2006
REEXAM UNIT

Arthur J. Usher, IV
WOODARD EMHARDT NAUGHTON
MORIARITY & MCNETT LLP
Bank One Center/Tower
111 Monument Circle, Suite 3700
Indianapolis, IN 46204-5137

(For Requester)

DECISION DISMISSING
PETITION TO EXCERCISE
SUPERVISORY AUTHORITY
37 CFR § 1.181 (a)(3)

*In re* John C. Harvey
*Ex Parte* Reexamination Proceeding
Control No. 90/006,536
Filed: February 4, 2003
For: US Patent No. 4,965,825

This is a decision on the patent owner's petition dated 9 February 2006, titled PETITION TO EXERCISE SUPERVISORY AUTHORITY UNDER 37 CFR § 1.181 (a)(3)

## REVIEW OF FACTS

1. U. S. Patent No. 4,965,825 issued on October 23 , 1990.

2. A request was filed by a third party requester for reexamination of US Patent No. 4,965,825 on February 4, 2003.

3. The Order granting reexamination is dated April 10, 2003.

4. A non-final Office action was mailed on June 15, 2005.

5. The patent owner response was received on August 15, 2005.

## DISCUSSION REGARDING EXERCISING SUPERVISORY AUTHORITY

**§ 1.181 Petition to the Director.**

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances.

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

After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office.

**MPEP 2209 Ex Parte Reexamination**

The intent of the reexamination procedures covered in this chapter include the following:

(A) To provide procedures for reexamination of patents;

(B) To implement reexamination in an essentially ex parte manner;

(C) To minimize the processing costs and complexities of reexamination;

(D) To maximize respect for the reexamined patent;

(E) To provide procedures for prompt and timely determinations by the Office in accordance with the "special dispatch " requirements of 35 U.S.C. 305.

## DECISION EXERCISING SUPERVISORY AUTHORITY

The patent owner requests that the supervisory authority establish a schedule for completion of this proceeding, declare the current rejections final, and alternatively that the examiner assigned instant proceeding, 90/006,536, be removed from the proceeding.

The Office makes every effort to provide procedures for prompt and timely determinations in accordance with "special dispatch" requirements. Each proceeding must be evaluated on a proceeding-by-proceeding basis with consideration to the number of claims, complexity of the prior art and technology of the instant proceeding. Each prior art submission, which fully complies with the requirements of citation must be considered to the extent appropriate to the fact situation. Each proceeding is thus handled with "special dispatch" according to the fact basis before the Office.

The patent owner requests that the present proceeding establish a schedule for completion. It is noted that on balance the patent owner has not provided sufficient evidence that the examiner responsible for this proceeding has not made every effort to address each issue raised in the request for reexamination, while considering the prior art fully and preparing appropriate response to each paper received in the instant proceeding. Further it is noted that the proceedings are complex and to respond appropriately requires that the examiner fully develop each issue so that the public record is thorough and complete.

The petitioner proffers no convincing reason, nor is it apparent, which would cause the Office to alter its normal work assignment procedure for reexamination proceedings. There is no evidence proffered which would indicate arbitrary or capricious treatment and/or abusive conduct buy the examiner. Accordingly the petition is **denied**. The reexamination proceeding is being forwarded to the examiner for appropriate action.

The patent owner alleges "that Examiner David Harvey be removed from the present reexamination proceeding and that the Director reassign this reexamination to a new, objective, unbiased, and competent examiner who is not committed to systematically delaying all matters respecting PMC's patents and pending applications." The patent owner is reminded that derogatory remarks regarding the examiner are in appropriate in correspondence to the USPTO. The patent owner papers provide highly negative remarks with respect to Office employees. The patent owner is reminded that derogatory remarks made in the proceeding regarding the examiner are inappropriate.

Pursuant to 37 CFR 1.3:

> "Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Director and will not be entered. A notice of the non-entry of the paper will be provided. Complaints against examiners and other employees must be made in correspondence separate from other papers."

## CONCLUSION

1. By way of instant decision, the Petition to Exercise Supervisory Authority is hereby **denied**.

2. No response is required on the part of the Patent Owner.

3. 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

5. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, Special Program Examiner in the Central Reexamination Unit, Art Unit 3992, at (571) 272-1611

MReinhart
SPRE CRU 3992
for

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

UNITED STATES
PATENT AND
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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
PO BOX 1450, ALEXANDRIA, VA 22313-1450
WWW.USPTO GOV

7/22/03
#11

JANIS K. FRASER, ESQ.
FISH AND RICHARDSON
225 FRANKLIN STREET
BOSTON MA 02110-2804

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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ALEXANDRIA, VA 22313-1450
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Paper No. 17 AR

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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<br>Reexamination Proceeding<br>Control No.: 90/006,227<br>Filed: February 27, 2002<br>For: U.S. Patent No.<br>6,228,875 | : | DECISION<br>DISMISSING<br>PETITION |
| In re Tsai et al<br>Reexamination Proceeding<br>Control No.: 90/006,539<br>Filed: February 6, 2003<br>For: U.S. Patent No.<br>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:

Please type a plus sign (+) inside this box →

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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ALEXANDRIA, VA 22313-1450
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Bruce Dickens (For Patent Owner)
DICKENS - SOEDER 2000, LLC
3892 Cedron Street
Irvine, CA 92606

Paul E. Crawford (For Requester #1)
CONNOLLY BOVE LODGE & HUTZ, LLP
1200 Market Street
Wilmington, DE 19801

Ross F. Hunt, Jr. (For Requester #2)
LARSON & TAYLOR
1199 North Fairfax St., Suite 900
Alexandria, VA 22314

Stanley B. Green (For Requester #3)
CONNOLLY BOVE LODGE & HUTZ, LLP
1990 M Street, NW
Suite 800
Washington, D.C. 20036

MAILED
MAR 12 2004
REEXAM UNIT

In re reissue application of
Dickens
Serial No. 09/512,592
Filed: February 23, 2000
For: U.S. Patent No. 5,806,063

In re Dickens
Reexamination Proceeding
Control No. 90/005,592
Filed: December 21, 1999
For: U.S. Patent No. 5,806,063

In re Dickens
Reexamination Proceeding
Control No. 90/005,628
Filed: February 2, 2000
For: U.S. Patent No. 5,806,063

In re Dickens
Reexamination Proceeding
Control No. 90/005,727
Filed: May 16, 2000
For: U.S. Patent No. 5,806,063

In re Dickens
Reexamination Proceeding
Control No. 90/006,541
Filed: February 2, 2003
For: U.S. Patent No. 5,806,063

**DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION AND REISSUE PROCEEDINGS**

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

## REVIEW OF FACTS

1. U.S. Patent No. 5,806,063 issued to Bruce M. Dickens on September 8, 1998, and a certificate of correction issued in the '063 patent on November 30, 1998.

2. The Commissioner of the USPTO ordered, on his own initiative, reexamination of the '063 patent on December 21, 1999, and the resulting reexamination proceeding was assigned Control No. 90/005,592.

3. On February 2, 2000, a third party requester (requester #1), Paul E. Crawford, filed a request for reexamination, and the request was assigned Control No. 90/005,628.

4. On February 18, 2000, patent owner filed in the '5592 proceeding, a statement under 37 CFR § 1.530 in response to the Commissioner's order for reexamination.

5. On February 23, 2000, patent owner filed a reissue application which was assigned Application No. 09/512,592.

6. Reexamination was ordered in the '5628 proceeding on March 10, 2000.

7. On May 16, 2000, a third party requester (requester #2), Ross F. Hunt, Jr., filed a request for reexamination, and the request was assigned Control No. 90/005,727.

8. Reexamination was ordered in the '5727 proceeding on August 10, 2000.

9. On October 10, 2000, patent owner filed in the '5727 proceeding, a statement under 37 CFR § 1.530 in response to the order for reexamination. The patent owner statement contained a Certificate of Service dated October 10, 2000.

10. A requester's reply under 37 CFR § 1.535 was not received from requester #2, and the time for filing same has expired.

Page 2 of 5 pages

11. Reexamination Control Nos. 90/005,592, 90/005,628, 09/005,727 and Reissue Application No. 09/512,592 were merged in a decision mailed on November 6, 2000.

12. A housekeeping amendment was filed in the 4 merged proceedings on January 5, 2001, placing the same claims in all 4 cases.

13. On February 7, 2003, a third party requester (requester #3), Stanley B. Green, filed a request for reexamination, and the request was assigned Control No. 90/006,541.

14. Prosecution ensued and a final rejection was mailed in the 4 merged proceedings on April 16, 2003.

15. On April 21, 2003, reexamination was ordered in the '6541 proceeding.

16. A Notice of Appeal was filed in the 4 merged proceedings on August 11, 2003.

17. On October 15, 2003, a Request for Continued Examination (RCE) was filed, along with the fee, a substitute specification, reissue declaration, response to the outstanding Office action, and an affidavit/declaration, in the 4 merged proceedings.

## DISCUSSION REGARDING MERGER

Under 37 CFR § 1.565(d):

> (d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings....

As evidenced by the above review of facts, the reissue application and the four reexamination proceedings are currently pending. Since the Order has been mailed pursuant to § 1.525 in the '6541 reexamination proceeding, and a response to the outstanding Office action has been filed in the 4 merged proceedings (Reexamination Control Nos. 90/005,592, 90/005,628, 09/005,727 and Reissue Application No. 09/512,592), a decision under § 1.565(d) is timely.

The general policy of the Office is that examination of reissue and reexamination proceedings will not be conducted separately and at the same time for a single patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the multiple proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of

expediting the prosecution of all of the proceedings. In making a decision on whether or not to merge the multiple proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

A review of the prosecution history of the files shows that (a) the '6541 reexamination has been ordered and is awaiting a first Office action by the examiner and (b) the '5592, '5628, and'5727 reexaminations are merged with the reissue Application No. 09/512,592, and a response to the outstanding rejection was received, and the 4 merged proceedings are awaiting the next Office action. More specifically, on October 15, 2003 a Request for Continued Examination (RCE) was filed, along with a substitute specification, reissue declaration, response to the outstanding Office action, and an affidavit/declaration, in the merged proceeding. Also, the original patent abstract has been amended. Further, in addition to the original unamended patent claims 1-9 and 11-15 in the merged proceeding, applicant/patent owner has amended original patent claim 10, and submitted new claims 16-76 for consideration. In the '6541 reexamination proceeding, no amendments have been filed.

Accordingly, the specification, abstract and claims are <u>not</u> identical in all five proceedings. In order to provide efficient and prompt handling of all five proceedings, and to prevent inconsistent and possibly conflicting amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue application and the four reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the first, second, third and fourth reexamination proceedings will be conducted in accordance with the decision set forth below.

## <u>DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS</u>

### I. <u>Merger of Proceedings</u>

In accordance with 37 C.F.R. 1.565 § , the above-identified reissue and reexamination proceedings are, *sua sponte*, merged. A joint examination will be conducted in accordance with the guidelines and requirements which follow.

### II. <u>Requirement for Same Amendments in All Proceedings</u>

The patent owner is required to maintain identical amendments in the reissue application and four reexamination files for purposes of the merged proceeding. The maintenance of identical amendments in all five files is required as long as the proceedings remain merged. See 37 CFR § 1.565(d). **An appropriate housekeeping amendment is required within <u>ONE (1)</u>**

**MONTH of this decision placing the same amendments in all five cases**, specifically, Application No. 09/512,592, and Control Numbers 90/005,592, 90/005,628, 90/005,727 and 90/006,541. The response to the requirement must be limited to placing the same amendments in all cases, and patent owner must **not** address the issues of any of the proceedings in the housekeeping amendment.

III. Conduct of the Merged Reissue and Reexamination Proceedings

Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application, examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. However, periods of response should be set at 2 months to comply with the statutory requirement for special dispatch in reexamination(35 U.S.C. 305).

Each Office action issued by the examiner will take the form of a *single action* which jointly applies to the reissue application and the four reexamination proceedings. Each action will contain identifying data *for all of the cases*, i.e, the reissue application and the four reexamination proceedings. Each action will be physically entered into all five files (which will be maintained as separate files).

Any response by the applicant/patent owner must consist of a single response, with five copies being filed for entry in the five files, with each of the five bearing a signature. Any such responses must be served on the requesters, who will also be sent copies of Office actions. See 37 CFR § 1.550(e).

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

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

If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 CFR § 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding *as to the reissue application*, and continue examination as to the four reexamination proceedings

that will remain merged as one proceeding. Any grounds of rejection which are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (*e.g.*, improperly broadened claims) would be made by the examiner upon dissolution of the merged proceeding as to the reissue application. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 CFR § 1.552(c).

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

Copies of all Office actions must be provided by the Office to all of the third party requesters. Further, any paper filed by the patent owner/applicant in the merged reissue/reexamination proceeding must be served on all of the third party requesters.

If a final rejection is mailed, the patent owner/applicant may then file "after-final" submissions (*e.g.*, amendment-after-final, affidavit(s), notice of appeal), all as appropriate to patent owner's situation and they will be dealt with as they are dealt with in a reissue application that is not merged.

Application/Control Number: 09/512,592
Art Unit: 3993

## CONCLUSION

1. The above-identified reissue application and first, second, third and fourth reexamination proceedings ARE MERGED into a single consolidated proceeding.

2. A copy of this decision will be placed into each of the five files.

3. The reissue application file and the four reexamination files are being forwarded to the Group Director of Technology Center 2100. All further examination should be conducted in accordance with this decision.

4. Pursuant to Part II of this decision, a housekeeping amendment is required **within ONE (1) MONTH of this decision**, placing the same amendments in all five cases of the present merged proceeding.

5. The examiner should issue an Office action for the present merged proceeding of the reissue application and the four

reexamination proceedings **after** the following events have occurred:

The earlier of

(a) the submission of the housekeeping amendment to place the same amendments in both cases, or

(b) the expiration of the ONE (1) month period from the mailing of this decision for filing the amendment.

6. It should be noted that failure to submit an appropriate "housekeeping amendment" **within <u>one month</u> of this decision** placing the same amendments in all five files will result in the Office's rejection of any claim that does not contain identical text in all five merged proceedings under 35 U.S.C. 112, second paragraph, as being indefinite as to the content of the claims, and therefore failing to particularly point out the invention.

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/006,541 | 02/07/2003 | 5806063 | 22058-00003-US | 8322 |

7590 05/13/2004

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

| EXAMINER | |
|---|---|
| Jean Homere | |
| ART UNIT | PAPER NUMBER |
| 2177 | 39 |

DATE MAILED: 05/13/2004

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

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

| APPLICATION NO./ CONTROL NO. | FILING DATE | FIRST NAMED INVENTOR / PATENT IN REEXAMINATION | ATTORNEY DOCKET NO. |
|---|---|---|---|
| 90/006541 | 02/07/03 | 5,806,063 | |

STANLEY B. GREEN
CONNOLLY BOVE LODGE AND HUTZ LLP
1990 M STREET N.W. SUITE 800
WASHINGTON DC 20036

| EXAMINER |
|---|
| JEAN HOMERE |

| ART UNIT | PAPER |
|---|---|
| 2177 | 39 |

DATE MAILED: MAY 13, 2004

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

**Commissioner of Patents and Trademarks**

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATEN
UNITED STATES PATENT AND TRADEMARK OFFI
WASHINGTON, D.C. 2023
www.uspto g

Paper No. 39

Bruce Dickens
Dickens-Soeder 2000 LLC
3892 Cedron Street
Irvine, California 92606

**FOR PATENT OWNER**

MAY 13 2004

Paul E. Crawford
Connolly Bove Loge & Hutz, LLP
1200 Market Street
Wilmington, Delaware 19801

**FOR THIRD PARTY REQUESTOR ['5628]**

Stanley B. Green
Connolly Bove Loge & Hutz, LLP
1990 M Street, NW
Washington, DC 20036

**FOR THIRD PARTY REQUESTOR ['6541]**

Ross F. Hunt, Jr.
Larson & Taylor
1199 North Fairfax Street, Suite 900
Alexandria, Virginia 22314

**FOR THIRD PARTY REQUESTOR ['5727]**

In re Reexamination of:
U.S. Patent No. 5,806,063
Reexamination Control No.
90/005,592; 90/005,628;
90/005,727; 90/006,541
Reissue Serial No. 09/512,591
For: DATE FORMATTING AND SORTING FOR DATES SPANNING THE TURN OF THE CENTURY

**DECISION TO ACCEPT PAPERS AS TIMELY FILED AND NOTICE OF NON-COMPLIANT AMENDMENT**

This is a decision accepting papers as timely filed and thereby preventing premature termination of this reexamination proceeding. A copy of the papers which Patent Owner seeks to have accepted was faxes to the undersigned on May 11, 2004. The submission is being treated as a petition to accept papers as timely filed.

The petition is **GRANTED**.

## BACKGROUND

A Decision merging all the above-identified proceedings and setting a 1-month period for submitting a housekeeping amendment was mailed March 12, 2004. As of May 10, 2004 no response had been received. The undersigned called Patent Owner to inquire as to the status and was informed that a response had been submitted on April 12, 2003.

## DECISION

Patent Owner provides a copy of the submission filed in response to the Office mailing of March 12, 2004, consisting of a Housekeeping Amendment, a Cover letter, Certificate of Service, and a certificate of mailing; a copy of the post card with a PTO stamp indicating receipt at the USPTO of the aforementioned submission on April 12, 2004[1]; a copy of the U.S. Express Mail label, number ER567448678US;; and a statement by Bruce Dickens attesting that the papers submitted are copies of the response to the merger order of March 12, 2004.

The post card receipt is prima facie evidence of the receipt in the USPTO of the documents listed thereon. Accordingly, the papers are being entered in the file.

## NONCOMPLIANCE OF THE HOUSEKEEPING AMENDMENT

1. Receipt is acknowledged of a housekeeping amendment filed on April 12, 2004.

2. The amendment is informal/nonresponsive because it fails to comply with 37 C.F.R. §1.121(j) and 37 C.F.R. §1.530(d) and (f). See 37 C.F.R. §1.121(j) wherein it is stated that 37 C.F.R. §1.121 does not apply to reexamination proceedings. Amendments must continue to be filed pursuant to 37 C.F.R. §1.530.

a. The amendment to the abstract does not include markings pursuant to paragraph (f) of 37 CFR §1.530 as required by 37 CFR §1.530(d)(1). Specifically, there is no underlining and/or bracketing with respect to the patent as issued[2].

---

[1] The PTO stamp carries the date granted on the date in field of the Express mail label.

[2] All references to "the patent as issued" include the certificate of correction of November 30, 1998.

b. The amendment to the specification does not include markings pursuant to paragraph (f) of 37 CFR §1.530 as required by 37 CFR §1.530(d)(1). Specifically, there is no underlining and/or bracketing with respect to the patent as issued.

c. The amendment to claim 10 does not include markings pursuant to paragraph (f) of 37 CFR §1.530 as required by 37 CFR §1.530(d)(2). Specifically, the claim should be presented with underlining and bracketing with respect to the issued patent.

d. Newly presented claims 16-75 must be underlined in their entirety as per 37 CFR §1.530(f)(2);

e. Further, presenting all claims is unnecessary. Presentation only of claims currently being amended or newly added, and directions to cancel claims currently to be canceled, suffices.

As amendments cannot be entered in part, ***a substitute amendment is required.***

The undersigned recommends that the housekeeping amendment be made so as to incorporate into the '6541 proceeding all amendments to the original patent currently entered in the reissue application. This should be done by presenting the amendment with underlining and bracketing with respect to the issued patent. Any further amendments desired should be submitted as a separate amendment which can then be entered in each of the 5 files.

Patent Owner is given a **ONE MONTH** time period to file an amendment which complies with 37 C.F.R. §1.530. This time period may be extended ONLY pursuant to 37 C.F.R. §1.550(c). The newly filed amendment must be served on the third party Requesters, see 37 C.F.R. §1.550(f).

Any inquiries with respect to this communication may be directed to the undersigned.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/006,546 | 02/12/2003 | 5640859 | MAT 3K8R | 4149 |

21967 7590 01/27/2005

HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON, DC 20006-1109

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

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

Hunton & Williams LLP
1900 K Street, NW, Suite 1200
Washington, DC 20006-1109 : (for Patent Owner)

Mathews Collins Shepherd & McKay PA
100 Thanet Circle, Suite 306
Princeton, NJ 08540 : (for Patent Owner)

Charles H. DeVoe, Esq.
Kolisch Hartwell, PC
520 S.W. Yamhill Street, Suite 200
Portland, OR 97204 : (for Third Party)

In re Fromm
Reexamination Proceeding
Control No. 90/006,546
Filed: February 12, 2003
For: U.S. Patent 5,640,859 : **DECISION MERGING REEXAMINATION PROCEEDINGS**

In re Fromm
Reexamination Proceeding
Control No. 90/007,236
Filed: October 6, 2004
For: U.S. Patent 5,640,859

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 5,640,859, issued June 24, 1997, is the subject of Reexamination Control Nos. 90/006,546 and 90/007,236. Reexamination Certificate 5,640,859 C1 issued on November 27, 2001.

2. A first request for reexamination, assigned Reexamination Control No. 90/006,546 ('6546), was filed February 12, 2003 by Charles H. DeVoe of Kolisch Hartwell, PC. The request urged that a substantial new question of patentability was raised by the teachings of (a) 1994 Mattel catalog showing "Tie & Dye™ Barbie® Fashions"; (b) 1993 Mattel packaging accompanying "Barbie® Tie & Dye™ Fashions"; (c) 1984 Surface Design for Fabric; (d) 1973 Contemporary Batik and Tie-Dye; (e) 1977 Arts and Crafts for the classroom; (f) The Gazette (Montreal); and (g) U.S. Patent 4,981,516 to Kluger.

3. Reexamination was ordered for '6546 on April 1, 2003.

4. A first Office action for '6546 was mailed on September 29, 2003.

5. Patent owner responded to the first Office action on December 1, 2003.

6. A final Office action for '6546 was mailed on May 26, 2004.

7. Patent owner responded to the final Office action on July 26, 2004.

8. An advisory action for '6546 was mailed on August 30, 2004.

9. Patent owner responded to the advisory action on October 26, 2004.

10. A Notice of Appeal for '6546 was filed on November 24, 2004.

11. An advisory action for '6546 was mailed on November 26, 2004.

12. A second request for reexamination, assigned Reexamination Control No. 90/007,236 ('7236), was filed October 6, 2004 by Charles H. DeVoe of Kolisch Hartwell, PC. The request urged that a substantial new question of patentability was raised by the teachings of (a) TYCO Dolls Color Me Kente Kenya, from a TYCO Toys catalog and price list (copyright 1994); (b) U.S. Trademark Registration No. 1922987 for the mark COLOR ME KENTE KENYA; (c) TYCO Activity Toys Fashion Pace from a TYCO Toys catalog (copyright 1990); (d) TYCO Tie Dye Deluxe Bear and TYCO Doodle Bear Feature, documents form 1994 and (e) other prior art previously cited by or to the Office.

13. Reexamination was ordered for '7236 on December 6, 2004.

14. Patent owner indicated that no patent owner statement was being submitted on December 22, 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 90/006,546 and 90/007,236 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. 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

An Office action will be issued in due course which applies to Reexamination Nos. 90/006,546 and 90/007,236. 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 duplicate**, 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. 90/006,546 as:

Brian Buroker
Hunton & Williams LLP
1900 K Street, NW
Suite 1200
Washington, DC 20006-1109

Note also that all correspondence from the USPTO will be addressed to the patent owner's representative listed in Reexamination Control No. 90/007,236 as:

Mathews Collins Shepherd & McKay PA
100 Thanet Circle, Suite 306
Princeton, NJ 08540

*A new power of attorney and revocation of power of attorney has been submitted in Reexamination Control No. 90/006,546, but no such paper has been submitted in Reexamination Control No. 90/007,236.

**CONCLUSION**

Reexamination Control Nos. 90/006,546 and 90/007,236 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

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United States Patent and Trademark Office
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www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/006,547 | 02/12/2003 | 5922333 | 117645-1031 | 4150 |

7590 08/27/2003

Michael A. O'Neil
Michael A. O'Neil PC
5949 Sherry Lane Suite 820
Dallas, TX 75225

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

#13

DATE MAILED: 08/27/2003

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

90006547 20030827

UNITED STATES
PATENT AND
TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
PO BOX 1450, ALEXANDRIA, VA 22313-1450
WWW USPTO.GOV

#13

MICHAEL A. O'NEIL
MICHAEL A. O'NEIL PC
5949 SHERRY LANE SUITE 820
DALLAS TX 75225

FOR PATENT OWNER

SPIRO BEREVESKOS
WOODARD, EMHARDT, MORIARITY,
McNETT & HENRY LLP
BANK ONE CENTER/TOWER
111 MONUMENT CIRCLE, SUITE 300
INDIANAPOLIS, IN 46204

FOR REQUESTER 1

PETER S. WEISSMAN
BLANK ROME LLP
600 NEW HAMPSHIRE AVENUE, NW
WASHINGTON, DC 20037

FOR REQUESTER 2

In re Laughlin
Reexamination Proceeding
Control No.: 90/006,547
Filed: February 12, 2003
For: U.S. Patent No. 5,922,333

In re Laughlin
Reexamination Proceeding
Control No.: 90/006,663
Filed: June 10, 2003
For: U.S. Patent No. 5,922,333

In re Laughlin
Reexamination Proceeding
Control No.: 90/006,711
Filed: July 14, 2003
For: U.S. Patent No. 5,922,333

: DECISION MERGING
: REEXAMINATION
: PROCEEDINGS

The above noted reexamination files are before the director of Technology Center 1600 for consideration of merger of the proceedings under 37 CFR 1.656(c).

## BACKGROUND

1. Patent No. 5,922,333 issued July 13, 1999.

2. A first request for reexamination, Control No. 90/006,547, was filed by patent owner as requester on February 12, 2003.

3. Reexamination was ordered In the '547 reexamination proceeding on March 12, 2003.

4. A second request for reexamination, Control No. 90/006,663, was filed by a first third party requester on June 10, 2003.

5. Reexamination was ordered In the '663 reexamination proceeding on July 28, 2003.

6. A third request for reexamination, Control No. 90/006,711, was filed by a second third party requester on July 14, 2003.

7. Reexamination was ordered In the '711 reexamination proceeding on August 20, 2003.

8. Patent Owner filed statements In '663 and '711 proceedings on August 25, 2003, indicating that no Patent Owner's statement would be filed.

Control No. 90/006,547

## DISCUSSION

Under 37 CFR 1.565(c):

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

As noted In the above review of facts, reexamination has been ordered In all of the above noted reexamination proceedings. Accordingly, merger of the proceedings under 37 CFR 1.565(c) is appropriate.

## DECISION

Merger of Proceedings.

In accordance with 37 CFR 1.565(c), the '547, '663 and '711 reexamination proceedings are merged. The merged proceeding will be conducted In accordance with the following guidelines and requirements.

Requirement for Same Amendments In Both Proceedings.

Patent Owner is required to maintain the same claims and specification In all files. In view of the granted one month extension of time to respond to the outstanding Office action In the '547 proceeding, Patent Owner is given until the end of that time period (October 15, 2003) to provide a "housekeeping" amendment In the '663 and '711 proceedings to provide identical claims In each of the three proceedings. Amendments must be In accordance with 37 CFR 1.530 (see M.P.E.P. 2250).

Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to all proceedings. All papers issued by the Office or filed by the Patent Owner will contain the identifying data for all files and will be physically entered In each reexamination file. All papers filed by the Patent Owner must consist of a single response, filed In triplicate, each bearing an original signature, for entry In each file. All papers filed by the Patent Owner must be served on each third party requester and each requester will be sent copies of all papers mailed by the Office.

CONCLUSION

Reexamination Control Nos. 90/006,547, 90/006,663 and 90/006,711 are merged. The merged files will be retained In TC 1600 to await reply to the outstanding Office action In the '547 proceeding. (Note - copies of the reply must be provided for each proceeding and must be served on each third party requester.)

John Doll
Director, Technology Center 1600

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www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/006,550 | 02/19/2003 | 6367952 | J5460.0014/P014 | 8242 |

7590 07/18/2005

| EXAMINER | |
|---|---|

| ART UNIT | PAPER NUMBER |
|---|---|

Michael A Mann Esq.
Nexsen Pruet Jacobs & Pollard LLC
1441 Main Street 15th Floor
P O Drawer 2426
Columbia, SC 29202

DATE MAILED: 07/18/2005

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
Washington, D.C. 20231
www.uspto.gov

Michael A. Mann, Esq.
Nexsen Pruet Jacobs & Pollard LLC
ONE OXFORD CENTRE
301 GRANT STREET,
20TH FLOOR
PITTSBURGH, PA 15219

(For Patent Owner)

MAILED

JUL 18 2005

REEXAM UNIT

Stephen A. Soffen
Dickstein Shapiro Morin & Oshinsky LLP
2101 L Street NW
Washington, DC 20037-1526

(For Requester)

Enclosure: Copy of patent owner's June 15, 2005 Petition ... Under 37 CFR 1.137(b) and Response to Office Action in Reexamination Under 37 CFR 1.530

In re Ventur Research & Development, Inc.
Reexamination Proceeding
Control No. 90/006,550
Filed: February 19, 2003
For: U.S. Patent No. 6,367,952

**DECISION GRANTING PETITION**

This is a decision on patent owner's "Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b) (Small Entity)" filed on June 15, 2005.[1] The petition is before the Office of Patent Legal Administration for decision.

The petition fee of $750.00 (small entity) 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. 08-0719 in accordance with petitioner's authorization on page two of the instant petition.

[1]The instant proceeding is not an abandoned application. However, 37 CFR 1.137(b) also provides a petition right for entry of late papers to revive a reexamination proceeding terminated under 37 CFR 1.550(d), and is, therefore, applicable here. See MPEP § 2268.

## DECISION

A grantable petition under 37 CFR 1.137(b) must be accompanied by:

(1) The reply[2] 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.

Petitioner has attempted to satisfy items (1)-(3). With respect to item (1), it is noted that the response filed by petitioner does NOT comply with 37 CFR 1.530(d)(2) because it is not limited to directing that proposed specified changes be made, but instead presents all of the claims notwithstanding that only claims 8 and 21 are to be amended. However, the response will be accepted as proper because it can be readily determined what the record claims are following entry of the amendment. Therefore, item (1) is satisfied. Patent owner should note that there is no assurance that any future response containing an amendment which does not comply with the requirements of 37 CFR 1.530(d) will be accepted by the Office.

As noted, *infra*, the petition fee has been paid. Therefore, item (2) is satisfied.

With respect to item (3), the statement on page 3 of the instant petition is considered to be equivalent to the required statement, and is, therefore, accepted as satisfying the regulation.

However, it is also noted that neither the petition nor the accompanying response reflect service on the third party requester as required by 37 CFR § 1.550(f). As indicated, *infra*, in this instance service will be perfected by means of the Office attaching a copy of the petition and response to the copy of this Decision that is being mailed to the third party requester. There is no assurance that any document subsequently filed in this proceeding which fails to reflect proof of service as required by 37 CFR 1.550(f) will be accepted by the Office. Failure to comply with this regulation may result in a document being refused consideration by the Office.[3]

## CONCLUSION

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

2. The reexamination file is being returned to Technology Center 2800 for issuance of an Office action in due course.

3. Any further communications as to the merits of the reexamination proceeding should

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[2]For reexamination proceedings, the word "reply" is to be replaced by "response." See 37 CFR 1.550(d)and (e)(2).

[3]37 CFR 1.550(f), last sentence.

be directed to the examiner, Alan Cariaso, in Technology Center Art Unit 2875, at (571) 272-2366.

4. Telephone inquiries related to this decision should be directed to the Stephen Marcus, Legal Advisor, at (571) 272-7743.

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

sm
July 14, 2005

#7

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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. |
|---|---|---|---|---|
| 90/006,551 | 02/15/2003 | D426289 | | 8809 |

28249 7590 12/03/2003

DILWORTH & BARRESE, LLP
HELENE HARRISON
333 EARLE OVINGTON BLVD.
UNIONDALE, NY 11553

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 12/03/2003 7

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

90006551.052903

PTO-90C (Rev. 10/03)

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Paper No. 7

Dilworth & Barrese (Patent Owner)
Helene Harrison
333 Earle Ovington Blvd.
Uniondale, NY 11553

(Enclosures: Copy of third party requester response filed May 26, 2003 and Form PTO-892 NOTICE OF REFERENCES CITED with reference copy)

CHARLES WANG (Requester)
235 P.O. BOX 8-24 CHUNG HO
TAIPEI HSIEN R.O.C., 235
TAIWAN

(Enclosure: Form PTO-892 NOTICE OF REFERENCES CITED)

| | |
|---|---|
| In re Levine | : |
| Reexamination Proceeding | : DECISION GRANTING |
| Control No. 90/006,551 | : PETITION UNDER |
| Filed: February 15, 2003 | : 37 CFR 1.181 AND 37 CFR 1.515(C) |
| For: U.S. Patent No. D426,289 | : |

This is a decision on the May 26, 2003, third party requester response which is being taken as a petition under 37 CFR 1.181 and 37 CFR 1.515(c), requesting review of the April 28, 2003, order denying the request for reexamination

The petition is before the Director of Technology Center 3700/2900 for decision.

The petition is **GRANTED**.

## REVIEW OF THE RECORD

A review of the record shows that an Order Denying the Request for Reexamination was mailed on April 28, 2003. The reason set forth for the denial was that the drawings submitted with the request and identified as "Attachment 2" (as a basis for finding the existence of a substantial new question of patentability) did not include any identifying information thereon to substantiate that

they were from Taiwan patent publication No. 334226. Thus the Taiwan patent publication was not established as prior art available against the D426,289 patent claim.

A refund of $1,690 was subsequently made to the reexamination requester, pursant to 37CFR1.26(c).

A response to the order denying reexamination (i.e., requesting review of the order) was filed May 26, 2003, and matched with the reexamination file subsequent to the refund. The May 26, 2003, response includes a copy of the cover page of the Taiwan patent certificate and a report of the patent certificate establishing a publication date of June 11, 1998 for Taiwan patent publication No. 334226. The copy of the certificate and report are accompanied by the drawings for Taiwan patent publication No. 334226.

## DECISION

It is agreed that the consideration of Taiwan patent publication No. 334226 raises a substantial new question of patentability as to the claim of the D426,289 patent. A review of the Taiwan patent's drawings shows eight views of a faucet handle fixture having an overall shape and appearance substantially identical to the 2 embodiments of the claimed design of the D426,289 patent. Furthermore, any differences between the faucet handle fixture shown in the Taiwan patent publication and the claimed design of the D426,289 patent are seen to be immaterial or minor. This much was not present in the prosecution of the application which became the D426,289 patent. Further, there is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not the claim is patentable.

Also, Taiwan patent publication No. 334226 was published more than 1 year before the issuance of theD426,289, and as such, it qualifies as prior art under 35 U.S.C. 102(b).

Hence, a substantial new question of patentability affecting the claim of United States Patent No. D426,289 is raised by the request for reexamination.

Since the Taiwan patent publication No. 334226 was not cited on a form PTO-1449 accompanying the original request for reexamination, it has been cited on a form PTO-892 NOTICE OF REFERENCES CITED, which is attached to this decision.

Although a substantial new question of patentability affecting the claim of the D426,289 is raised by the request, the status of the request for reexamination **is incomplete**. As pointed out above, a refund of $1,690 was made to the reexamination requester, pursant to 37CFR1.26(c) prior to the response filed May 26, 2003, being associated with the reexamination file. **The third party requester must return the $1,690 within two months from the mailing of this decision, in order to avoid this reexamination being vacated.**

The patent owner is advised that no action need be taken at this point, as the request is incomplete. If the return of the $1,690 is appropriately made by the requester, the patent owner will be notified at that point as to the time period for filing a patent owner's statement under 37 CFR 1.530.

## LACK OF SERVICE

The requester's May 26, 2003, response (which is being taken as a petition) is deficient for failure to reflect service of the response on the patent owner 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 patent owner (a Certificate of Service) was not included with the instant petition papers.

Any future communications filed by third party requester in this proceeding must include proof of service on the patent owner in accordance with 37 CFR 1.550(f).

Since a certificate of service is not included with the response, a copy of the third party requester response is being enclosed with the patent owner's copy of this decision

## CONCLUSION

1. The requester's petition is **granted** to the extent that a substantial new question of patentability affecting the claim of United States Patent No. D426,289 has been found to be raised by the request for reexamination.

2. The status of the request for reexamination is, however, **incomplete**, and the portion of the reexamination fee which was refunded to the requester ($1,690) **must be returned to the U.S. Patent and Trademark Office within two months. Failure to do so will result in the reexamination proceeding being vacated.**

3. No action need be taken by the patent owner at this point, as the request is incomplete. If the return of the $1,690 is appropriately made by the requester, the patent owner will be notified at that point as to the time period for filing a patent owner's statement under 37 CFR 1.530.

4. Any questions with regard to this decision should be directed to 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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United States Patent and Trademark Office
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/006,551 | 02/15/2003 | D426289 | | 8809 |

28249 7590 12/09/2004

DILWORTH & BARRESE, LLP
333 EARLE OVINGTON BLVD.
UNIONDALE, NY 11553

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
| | 8 |

DATE MAILED: 12/09/2004

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

| *Ex Parte Reexamination Communication* | Control No.<br>90/006,551 | Patent Under Reexamination<br>D426289 ET AL. | |
|---|---|---|---|
| | Examiner | Art Unit<br>2914 | |

~~A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE _____ MONTH(S) FROM THE MAILING DATE OF THIS LETTER. EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c). If the specified period for response is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.~~

This reexamination proceeding is being vacated in view of the third party requester's failure to return the partial refund of the reexamination request filing fee within two months as required in the petition decision under 37 CFR 1.181 and 37 CFR 1.515(c) mailed December 3, 2003.

JAMES GANDY
SUPERVISORY PATENT EXAMINER
GROUP 2900

cc: Requester (if third party requester)

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/006,552 | 02/20/2003 | 4849228 | 4673.35 | 1505 |

7590 11/05/2003

EXAMINER

Harold C. Wegner
Foley and Lardner
Washington Harbour
3000 K Street NW Suite 500
Washington, DC 20007-5143

| ART UNIT | PAPER NUMBER |
|---|---|
| | 10 |

DATE MAILED: 11/05/2003

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DO NOT ENTER

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Paper No. 10

HAROLD C. WEGNER
FOLEY & LARDNER
WASHINGTON HARBOUR
3000 K STREET NW, SUITE 500
WASHINGTON DC 20007-5143

FOR PATENT OWNER

WATTS, HOFFMAN, FISHER
& HEINKE CO., LPA
P. O. BOX 99839
CLEVELAND, OH 44199-0839

FOR REQUESTER 1

SUSAN P. PETRAGLIA, ESQ.
116 SIXTH STREET, NE
NO. 303
WASHINGTON, D.C. 20002

FOR REQUESTER 2

In re Yamamoto et al
Reexamination Proceeding
Control No.: 90/006,552
Filed: February 20, 2003
For: U.S.Patent No. 4,849,228

In re Yamamoto et al
Reexamination Proceeding
Control No.: 90/006,674
Filed: June 23, 2003
For: U.S.Patent No. 4,849,228

: 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.4,849,228 issued July 18, 1989.

2. A first request for reexamination, Control No. 90/006,552, was filed by the third party Requester 1 on February 20, 2003.

3. Reexamination was ordered in the '552 reexamination proceeding on April 4, 2003.

4. A second request for reexamination, Control No. 90/006,674, was filed by the third party Requester 2 on June 23, 2003.

5. Reexamination was ordered in the '674 reexamination proceeding on July 31, 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 '552 and '674 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 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 each third party Requester and each Requester will be sent copies of all papers mailed by the Office.

CONCLUSION

Reexamination Control Nos. 90/006,552 and 90/006,674 are merged. A reply to the first Office action in the '552 proceeding has been received and the merged files will be forwarded to the examiner for further action.

John Doll
Director, Technology Center 1600

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/006,552 | 02/20/2003 | 4849228 | 4673.35 | 1505 |

7590 11/05/2003

EXAMINER

Harold C. Wegner
Foley and Lardner
Washington Harbour
3000 K Street NW Suite 500
Washington, DC 20007-5143

| ART UNIT | PAPER NUMBER |
|---|---|
| | 10 |

DATE MAILED: 11/05/2003

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Paper No. 10

HAROLD C. WEGNER
FOLEY & LARDNER
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WASHINGTON DC 20007-5143

FOR PATENT OWNER

WATTS, HOFFMAN, FISHER
& HEINKE CO., LPA
P. O. BOX 99839
CLEVELAND, OH 44199-0839

FOR REQUESTER 1

SUSAN P. PETRAGLIA, ESQ.
116 SIXTH STREET, NE
NO. 303
WASHINGTON, D.C. 20002

FOR REQUESTER 2

In re Yamamoto et al
Reexamination Proceeding
Control No.: 90/006,552
Filed: February 20, 2003
For: U.S.Patent No. 4,849,228

In re Yamamoto et al
Reexamination Proceeding
Control No.: 90/006,674
Filed: June 23, 2003
For: U.S.Patent No. 4,849,228

: 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.4,849,228 issued July 18, 1989.

2. A first request for reexamination, Control No. 90/006,552, was filed by the third party Requester 1 on February 20, 2003.

3. Reexamination was ordered in the '552 reexamination proceeding on April 4, 2003.

4. A second request for reexamination, Control No. 90/006,674, was filed by the third party Requester 2 on June 23, 2003.

5. Reexamination was ordered in the '674 reexamination proceeding on July 31, 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 '552 and '674 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 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 each third party Requester and each Requester will be sent copies of all papers mailed by the Office.

CONCLUSION

Reexamination Control Nos. 90/006,552 and 90/006,674 are merged. A reply to the first Office action in the '552 proceeding has been received and the merged files will be forwarded to the examiner for further action.

John Doll
Director, Technology Center 1600

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/006,894 | 12/23/2003 | 5578684 | 253808 | 3206 |

22850 7590 05/14/2004

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

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 05/14/2004 16

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Kenyon & Kenyon
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New York, NY 10004

(for Patent Owner)

Oblon, Spivak, McClelland, Maier & Neustadt, PC
1940 Duke Street
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(for Patent Owner)

John C. McNett
Woodard Emhardt Moriarty McNett & Henry LLP
111 Monument Circle
Bank One Ctr/Twr Ste 3700
Indianapolis, IN 46204

(for Third Party Requester)

In re Schade et al
Reexamination Proceeding
Control No. 90/006,554
Filed: February 22, 2003
For: U.S. Patent 5,578,684

In re Schade et al
Reexamination Proceeding
Control No. 90/006,894
Filed: December 23, 2003
For: U.S. Patent 5,578,684

**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 5,578,684, issued November 26, 1996, is the subject of Reexamination Control Nos. 90/006,554 and 90/006,894.

2. A first request for reexamination, assigned Reexamination Control No. 90/006,554 ('6554), was filed February 22, 2003 by John C. McNett of Woodard, Emhardt, Naughton, Moriarty & McNett, LLP. The request urged that a substantial new question of patentability was raised by the teachings of US Patent 3,047,579 to Witman, either alone or in combination with US Patent 3,159,611 to Dunn et al.

3. Reexamination was ordered for '6554 on April 11, 2003.

4. A first Office action for '6554 was mailed on September 5, 2003.

5. Patent owner responded to the first Office action on November 5, 2003.

6. A second request for reexamination, assigned Reexamination Control No. 90/006,894 ('6894), was filed December 23, 2003 by Edward E. Sowers of Woodard, Emhardt, Moriarty, McNett & Henry, LLP. The request urged that a substantial new question of patentability was raised by the teachings of (a) UK 1,079,846 to Pieper et al, (b) DE 1,495,819 to Pieper, (c) US Patent 3,047,579 to Witman, (d) Abramovitch, "Pyridine and Its Derivatives, Supplement Part Two and (e) US Patent 3,960,542 to Plant et al.

7. Reexamination was ordered for '6894 on February 27, 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:

> 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 90/006,554 and 90/006,894 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 and Response by the patent owner in the '6554 reexamination proceeding, as well as consideration of the Request for Reexamination in the '6894 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 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 parties are reminded that any paper which is filed in this merged proceeding must be served on every other party in the merged proceeding per 37 CFR 1.550.

All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control No. 90/006,554 as:

Paul M. Richter, Jr.
Kenyon & Kenyon
One Broadway
New York, NY 1004

Note also that all correspondence from the USPTO will be addressed to the patent owner's representative listed in Reexamination Control No. 90/006,894 as:

Oblon, Spivak, McClelland, Maier & Neustadt, PC
1940 Duke Street
Alexandria, VA 22314

* A new power of attorney and revocation of power of attorney has been submitted in Reexamination Control No. 90/006,554, but no such paper has been submitted in Reexamination Control No. 90/006,894.

**CONCLUSION**

Reexamination Control Nos. 90/006,554 and 90/006,894 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. |
|---|---|---|---|---|
| 90/006,554 | 02/22/2003 | 5578684 | 6012-1160 | 3034 |

7590 03/25/2005

| EXAMINER | |
|---|---|

Paul M Richter Jr
Kenyon & Kenyon
One Broadway
New York, NY 10004

| ART UNIT | PAPER NUMBER |
|---|---|

DATE MAILED: 03/25/2005

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CST

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John C. McNett
Woodard Emhardt Moriarty McNett & Henry LLP
111 Monument Circle
Bank One Ctr/Twr Ste 3700
Indianapolis, IN 46204

(for Third Party Requester)

In re Schade et al
Reexamination Proceeding
Control No. 90/006,554
Filed: February 22, 2003
For: U.S. Patent 5,578,684

**DECISION ON PETITION TO WITHDRAW THE FINALITY OF THE PREVIOUS OFFICE ACTION**

In re Schade et al
Reexamination Proceeding
Control No. 90/006,894
Filed: December 23, 2003
For: U.S. Patent 5,578,684

This is a decision on the PETITION UNDER 37 CFR § 1.181 TO WITHDRAW FINAL REJECTION, filed February 17, 2005. Petitioner states that the finality of the Office action mailed December 17, 2004 is premature and based on new grounds. In particular, petitioner refers to the response to the final rejection submitted concurrently with the present petition.

A review of the file history of Reexamination Control No. 90/006,554 ('6554) shows that claims 1-6 were finally rejected as being unpatentable over Dunn in combination with Witman, optionally as evidenced by Watts, Greenspan, Hopkins and Willard. Also, a

review of the non-final action mailed September 5, 2003 in the same reexamination proceeding reveals that claims 1-6 were also rejected over the same group of references, that is Dunn in combination with Witman, optionally as evidenced by Watts, Greenspan, Hopkins and Willard.

While there was no non-final rejection in Reexamination Control No. 90/006,894 ('6894), it is noted that MPEP 2283, Section II specifically states:

> Once the files are returned to the examiner for issuance of an Office action, the examiner should prepare an Office action at the most advanced point possible for the first proceeding. Thus, if the first proceeding is ready for a final rejection and the second proceeding does not provide any new information which would call for a new ground of rejection, the examiner should issue a final rejection for the merged proceeding using the guidelines for the prosecution stage set forth below.

Accordingly, as the first proceeding ('6554) was ready for final rejection and as the second proceeding ('6894) did not provide any new information which would call for a new ground of rejection, the examiner properly issued a final rejection for the merged proceeding.

Patent owner's attorney further argues that it appears that new grounds were formed in the final Office action on which to base the *prima facie* rejection of claims 1-6 over Dunn in combination with Witman. Specifically, it is argued that as the examiner appears to state that the oxidation results of the instantly claimed process cannot properly be compared to Witman and Example V, a new ground of rejection was made. Upon review of the final Office action of December 17, 2004, however, it appears that the examiner was commenting that the declaration submitted was not sufficient to overcome the rejection of record. The examiner's comments on the insufficiency of the declaration are not sufficient to withdraw finality of the final action mailed December 17, 2004.

The petition is **DENIED**.

The response to the final office action submitted February 17, 2005 will be forwarded to the examiner for prompt consideration.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

APR 12 2005

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Michael J. Keenan (For Patent Owner) Paper No. 8
Nixon and Vanderhye P. C.
1100 North Glebe Road 8th Floor
Arlington, VA 22201-4714

Edward J. Sternberger, Esq. (For Requester)
Manelli, Denison & Selter pllc
2000 M Street N.W., 7th Floor
Washington, DC 20036-3307

*In re* Priestly :
Reexamination Proceeding : **DECISION ON PETITION**
Control No.: 90/006,555 :
Filed: February 24, 2003 :
For US Patent Number 6,481,212

This is a decision on petitioner's request filed November 24, 2004, requesting the continuance of the reexamination proceeding of the above-identified proceeding because the applicant did not receive the Office communication mailed on February 17, 2004 at the correspondence address of record.

The petition is granted.

In support of the request, petitioner has provided a showing of non-receipt of the Office action in accordance with Official Gazette Notice 1156 O.G. 53 (November 16, 1993). MPEP 711.03(c) IA.

In addition, a review of the file reveals that the office action mailed on February 17, 2004 was returned to the USPTO despite have the correct mailing address.

In view of the above, the reexamination proceeding will continue with the remailing of the February 17, 2004 office action.

The Office communication will be remailed and the shortened statutory period that was originally set forth in the Office communication shall be restarted to run from the mail date of the newly supplied Office action or notice.

Summary: Reexamination proceeding is continued.

Richard A. Bertsch, Director
Technology Center 3700

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
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NOV 17 2003

Reexamination Control No. 90/006,561 – Paper No. 9
Reexamination Control No. 90/006,615 – Paper No. 8

MAILED

NOV 17 2003

OFFICE OF THE DIRECTOR
TC 3600

**FOR PATENT OWNER:**

Marlin R. Smith
Konneker & Smith
660 N. Central Expressway, Suite 2
Plano, TX 75074

**DECISION ON REEXAMINATION MERGER**
37 CFR 1.565(c)

**FOR FIRST REQUESTER;**

Joseph L. Johnson
Lathrop & Gage, LC
1845 S. National, P.O. Box 4288
Springfield, MO 65808

**FOR SECOND REQUESTER;**

Jeffrey D. Harty
McKee, Voorhees & Sease PLC
801 Grand Ave., Suite 3200
Des Moines, IA 50309

DO NOT ENTER

## NOTICE OF CONSOLIDATION OF REEXAMINATION PROCEEDINGS

Background

1. U.S. Letters Patent No. 5,865,452 issued on February 2, 1999.

2. A first request for reexamination was filed by a third party requester, Joseph L. Johnson, on March 10, 2003, and was assigned Reexamination Control No. 90/006,561.

3. On April 30, 2003, a second request for reexamination of U.S. Letters Patent No. 5,865,452 was filed by a third party requester, Jeffrey D. Harty and was assigned Reexamination Control No. 90/006,615.

4. Reexamination was ordered in Reexamination Control No. 90/006,561 on June 2, 2003.

5. Reexamination was ordered in Reexamination Control No. 90/006,615 on July 17, 2003.

6. In Reexamination Control No. 90/006,561 the patent owner submitted, on August 26, 2003, a preliminary amendment that amended claim 17 and added new claims 20-66. On that same date the patent owner also submitted an Information Disclosure Statement and a Notice of Concurrent Litigation.

7. In Reexamination Control No. 90/006,615 the patent owner submitted, on August 26, 2003, an Information Disclosure Statement and a Notice of Concurrent Litigation.

Page 2 of 5

## Discussion

Under 37 CFR 1.565(c):

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

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

## Decision

Under the provisions of 37 CFR 1.565(c), reexamination proceedings designated as Reexamination Control Nos. 90/006,561 and 90/006,615 are merged for consolidated proceedings. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

### I. Requirements for Same Amendments in All Files

As noted above, claim 17 was amended and new claims 20-66 added in Reexamination Control No. 90/006,561 in the amendment of August 26, 2003. Patent owner must maintain the same claims and the same description/specification in both files. Therefore, patent owner is required to submit an appropriate "housekeeping" amendment within **ONE MONTH** from the mailing date of this decision, placing the same amendment proffered during the first reexamination proceeding in the second reexamination proceeding, i.e. Reexamination Control No. 90/006,615. Since the time period for submission of a patent owner's statement has expired, and the submission of the required "housekeeping" amendment prior to a first Office action does not invoke the provisions of 37 CFR 1.535, prosecution will proceed *ex parte*. No reply or other submission will be considered in the merged reexamination proceeding filed by the third party requester.

### II. Conduct of Merged Proceeding

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

requesters and such requesters will be sent copies of all papers mailed by the Office during these merged proceedings.

Conclusion

Reexamination Control Nos. 90/006,561 and 90/006,615 are hereby merged and an Office action will be issued by the examiner for *ex parte* prosecution of the merged proceeding. Appropriate submissions by the patent owner, as set forth above, are required within **ONE MONTH** from the mailing date of this decision.

Steven N. Meyers
Special Programs Examiner
Technology Center 3600
(703) 308-3868

Concur:

Robert Oberleitner, Director,
Technology Center 3600
(703) 308-1134

snm: 11/8/03

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(For Patent Owner)

MAILED

AUG 0 5 2003

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(For Third Party Requester)

Harvey et al
Reexamination Proceeding
Control No. 90/006,563
Filed: March 14, 2003
For: U.S. Patent No. 5,335,277

: DECISION
: GRANTING-IN-PART
: PETITION

This is a decision on the June 10, 2003, patent owner petition titled PETITION TO EXPUNGE PAPERS FROM THE REQUEST FOR REEXAMINATION, and the supplemental July 9, 2003, petition titled SUPPLEMENTAL PETITION TO SEAL PAPERS FROM THE REQUEST FOR REEXAMINATION.

The petitions are addressed in four respects:

(1) Under 37 CFR 1.183 as a request to waive the rules and provide an entry right for the petition paper.

(2) Under 37 CFR 1.59(b) as a request to expunge or redact the request for reexamination or papers therefrom.

(3) Under 37 CFR 1.182 as a request that papers from the request for reexamination be sealed, i.e., a situation not specifically provided for in the regulations.

(4) Under 37 CFR 1.182 as a request that the Office contact any parties that may have accessed the materials that petitioner has stated to be protected, and request return of such materials.

Pursuant to 37 CFR 1.17(h), a petition fee of $130.00 is required for a petition under 37 CFR 1.59(b), 37 CFR 1.182 and/or 37 CFR 1.183. The required petition fee of $130.00 has been charged to Deposit Account No. 50-0206 for the present petition under 37 CFR 1.59(b), 37 CFR 1.182 and/or 37 CFR 1.183, as authorized in the second paragraph of the petition.

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

The petition under 37 CFR 1.183 is granted, such that the present petition paper will be permitted entry and will be addressed.

The petition under 37 CFR 1.59(b) is granted to the extent that materials will be expunged from the Reexamination Processing System (REPS) Scanning Data Base of the Central Reexamination Unit (CRU). It is dismissed as to the request for expungement of the reexamination request, and is otherwise held in abeyance for the reasons set forth below.

The petition under 37 CFR 1.182 to seal papers is granted to seal the originally filed request for reexamination, the originally filed Exhibit A1 and Exhibit E. The redacted copy of the request for reexamination, and that of Exhibit A1 (both submitted with supplemental July 9, 2003, petition) will replace the originally filed request and Exhibit A1, and the redacted copies will be open to the public. The redacted copies will be scanned into the REPS Scanning Data Base of the CRU.

The petition under 37 CFR 1.182, as it relates to the request for contacting any parties that may have accessed unprotected materials, is dismissed, for the reasons set forth below.

**REVIEW OF FACTS**

1. U.S. patent No. 5,335,277 issued on August 2, 1994.

2. A request for reexamination, assigned control No. 90/006,563, was filed by a third party requester on March 14, 2003.

3. Reexamination was ordered for the '6563 reexamination proceeding on May 14, 2003.

4. A patent owner paper was filed June 10, 2003, to inform the Office that no statement under 37 CFR 1.530 will be filed.

5. Also on June 10, 2003, patent owner filed the present petition titled "PETITION TO EXPUNGE PAPERS FROM THE REQUEST FOR REEXAMINATION."

6. On July 9, 2003, patent owner filed the present supplemental petition to seal papers from the request for reexamination. A redacted copy of the request for reexamination and a redacted copy of Exhibit A1 are submitted with the supplemental petition.

**DECISION**

Addressing the present petitions requires a decision as to three areas of relief, provided for by 37 CFR 1.183, 37 CFR 1.59(b), and 37 CFR 1.182, respectively. Each will be presented in its own section below.[1]

**I. DECISION ON PETITION UNDER 37 CFR 1.183**

As pointed out above, patent owner filed a paper on June 10, 2003, informing the Office that no statement under 37 CFR 1.530 will be filed. In addition, the original petition (page 2) makes it clear that:

> "PMC is not submitting this petition as a 'patent owner's statement' under 37 C.F.R. § 1.530, and it should not be construed to be a patent owner's statement."

Thus, the present petition papers are clearly not a patent owner's statement under 37 CFR 1.530.

Yet, pursuant to 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."

Accordingly, the present petition papers do not have an entry right under the reexamination rules.

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[1] Two aspects of 37 CFR 1.182 relief will be addressed separately.

A right of entry for the petition papers would require a waiver of the above-quoted provision of 37 CFR 1.540, such a waiver being available only pursuant to 37 CFR 1.183.[2] Accordingly, the present composite (original and supplemental) petition is taken to provide, as one of its requests for relief, a request under 37 CFR 1.183 for a waiver of the rules.

In addressing the request for a waiver of the rules, it is noted that, in the paragraph bridging pages 2 and 3 of the original petition, petitioner provides grounds for waiver of the rules as follows:

> "PMC believes that the unusual circumstances related to Thomson's Request dictate the filing of the instant petition to protect PMC's important and statutorily recognized interest in maintaining the confidentiality of its abandoned patent applications. [Footnote omitted] See 35 U.S.C. § 122; 37 C.F.R. § 1.14; see also M.P.E.P. § 724.05."

This argument by petitioner is found to be persuasive to waive the above-quoted provision of 37 CFR 1.540. The interest in maintaining the confidentiality of the patent owner's abandoned patent application, and giving effect to the May 2, 2003, Order of the District Court [3] granting patent owner's motion for a protective order, are deemed to provide an extraordinary situation, when justice requires waiver of the rules to protect rights. Patent owner's rights could be prejudiced if a decision on the matter presented is delayed until the examination stage of this reexamination proceeding.

Accordingly, the petition, as it relates to relief under 37 CFR 1.183, is granted.

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[2] 37 CFR 1.183 states as follows:
"In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(h)."

[3] Issued in *Personalized Media Communications,LLC v. Scientific-Atlanta, Inc., et al.*, Civil Action File No.1:02-CV -824-CAP, (United States District Court for the Northern District of Georgia) in Atlanta before Judge Charles A. Pannell, Jr. (the Atlanta Litigation). See Exhibit 4 of the present petition.

**II. PETITION UNDER 37 CFR 1.59(b)**

In the first page of the original petition, it is stated:

> "The patent owner, Personalized Media Communication LLC (PMC) hereby petitions the Commissioner to expunge or appropriately redact the Request for Reexamination from the file of U.S. Patent 4,965,825, the reexamination file, the electronic copy of the reexamination file made available to the public, and any other publicly available file in which Exhibit E of the Request resides."

(1) To the extent that the petition is taken as a petition for expungement of **the reexamination request, including all exhibits,** the petition is **dismissed**.

It is stated in 35 U.S.C. 302 that:

> "*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." (emphasis added)

The violation of confidentiality set forth in the petition is not a proper basis for expunging a reexamination. A request for reexamination can be terminated only based upon statute or rule. The present patent owner petition does not cite any statute or rule that would call for termination of a reexamination as a result of the protected nature of the "confidential" materials. Accordingly, the patent owner's petition for expungement of the reexamination request is **dismissed**.

(2) Pursuant to 37 CR 1.59(b):

> "An applicant may request that the Office expunge and return information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge and return information from an application must include the fee set forth in § 1.17(h) and establish to the satisfaction of the Commissioner that the return of the information is appropriate."

To the extent that the present petition is taken as a petition for expungement under 37 CR 1.59(b) of **the confidential materials** entirely from the record, the petition is **premature**.

MPEP 724.04(c) sets forth the guidelines for a petition to expunge "Materials Submitted in Reexamination File Open to the Public Under 37 CFR 1.11(d)." When the application is considered for action on the merits, the examiner (and/or other appropriate Office official responsible for considering the information) will review the sealed information, and will make a determination as to whether or not any portion or all of the information submitted is "important to a reasonable examiner in deciding whether or not a claim is patentable." The examiner may issue a determination on the issue of importance of the sealed information in the first Office action on the merits, or in an Office action issued any time thereafter that is appropriate, but, *in no event, later than the close of prosecution.*

It is not appropriate to make, in this decision, a final determination of whether or not the material requested to be expunged is "important to a reasonable examiner in deciding whether or not a claim is patentable." Rather, such a decision is issued by the examiner, and is issued no later than the close of prosecution. Thus, the decision on the petition to expunge is premature and must be held in abeyance at this time. **After the examiner has issued a determination on the issue of importance of the sealed information in an Office action on the merits** (as discussed above), **the petition to expunge may be renewed by patent owner. If the petition to expunge is renewed by patent owner, the requirements of MPEP 724.05 should be carefully reviewed to make certain that the petition to expunge is complete as to all requirements for same.**[4] Any such future petition should be should be addressed as follows:

By mail: Central Reexamination Unit
Office of Patent Legal Administration
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (703) 305-1013
Central Reexamination Unit
Attn: Kenneth Schor

By HAND: Central Reexamination Unit
Crystal Plaza Three-Four, 3D68
2201 South Clark Place
Arlington, VA

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[4] The (D) statement set forth therein will need to be modified to indicate on behalf of whom the petition is being submitted.

**Patent owner is cautioned** that a failure to **timely** renew the petition to expunge prior to the point at which the file is forwarded for issuance of the reexamination certificate will result in the sealed material being unsealed and made of record in the reexamination file and thus becoming open to the public.

While the petition to expunge the confidential materials from the file will not be granted, *it is, however, appropriate* that the confidential materials of the reexamination paper file be sealed from public view. Such sealing would further the interest in maintaining the confidentiality of the patent owner's abandoned patent application, and give effect to the May 2, 2003, Order of the District Court [5] granting patent owner's motion for a protective order. Accordingly, the unredacted original request for reexamination, the unredacted original of Exhibit A1, and Exhibit E are being sealed by the present decision; see Section III below.

(3) To the extent that the petition is taken as a petition for expungement of the request for reexamination containing the confidential material from the REPS Scanning Data Base of the CRU, the petition is granted. This expungement would serve the interest in maintaining the confidentiality of the patent owner's confidential materials as pointed out in the previous paragraph. Accordingly, the electronic copy of the request for reexamination (and its attachments) will be deleted by the CRU, pursuant to Section IV of this decision, below. The redacted copy of the request for reexamination and redacted copy of Exhibit A1 submitted with the supplemental petition will be scanned into the REPS Scanning Data Base together with the attachments other than Exhibit E and the original of Exhibit A1, and will be available to the public.

## III. DECISION ON PETITION UNDER 37 CFR 1.182

It is stated in the last paragraph of page 7 of the original petition:

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[5] The order was issued in *Personalized Media Communications, LLC v.Scientific-Atlanta, Inc., et al.,* Civil Action File No.1:02-CV -824-CAP (United States District Court for the Northern District of Georgia.

> "PMC respectfully requests that the PTO expunge the Request for Reexamination **from all files accessible to the public** to comply with its statutory obligation to keep PMC's abandoned applications confidential and prevent public disclosure of PMC's confidential abandoned patent applications."[Emphasis added]

This is a request under 37 CFR 1.182 that papers from the request for reexamination be **sealed**, so that such papers are no longer "accessible to the public."

At page 8 of the original petition, it is stated:

> If the PTO is not inclined to expunge Thomson's entire Request for Reexamination, PMC alternatively requests that the PTO **expunge or redact Exhibit E, and all quotations from Exhibit E,** [Footnote omitted] from the publicly available files which include Thomson's Request. [Emphasis added]

At the top of page 3 of the original petition it is pointed out that "Thomson's Request for Reexamination gratuitously included a copy of a withdrawn notice of abandonment (Confidential Notice) from one of PMC's confidential applications.[Footnote omitted] See Exhibit E to Thomson's Request."

At page 5 of the supplemental petition, it is pointed out that Exhibit A1 is an index of the exhibits filed with the request, and it identifies the document attached as Exhibit E.

In addition, the supplemental petition provides a redacted copy of request for reexamination, a redacted copy of Exhibit A1.

While it would be premature to *expunge* materials from the paper file of the proceeding for the reasons set forth above, it is appropriate to ***seal*** the unredacted original request for reexamination, the unredacted original of Exhibit A1, and Exhibit E pending a final determination as to whether the sealed papers should be expunged, and the present petition is granted to that extent.

## IV. ACTION TO BE TAKEN BY THE CENTRAL REEXAMINATION UNIT

The appropriate Central Reexamination Unit (CRU) personnel will immediately:

1. Expunge, *in toto*, the electronic images of the request for reexamination and its attachments from the REPS Scanning Data Base;

2. Scan into the REPS Scanning Data Base the redacted copy of the request for reexamination and the redacted copy of Exhibit A1 submitted with the supplemental petition, together with the attachments other than Exhibit E and the original of Exhibit A1; and then

3. Forward the file to the Technology Center for sealing of documents.

## V. ACTION TO BE TAKEN BY THE TECHNOLOGY CENTER TO SEAL MATERIALS

Upon return of the present file to the Technology Center, the appropriate personnel thereof will immediately:

1. Seal the paper copy of the unredacted original request for reexamination, the unredacted original Exhibit A1, and Exhibit E as follows:

   A. Place documents in a sealed, clearly labeled, envelope or container.

   B. Provide a label, or enter information, on the envelope:

      1) Label the envelope or container as "Proprietary Documents Subject To Confidentiality/Protective Order."

      2) Set forth the tribunal issuing the protective order, i.e., the Federal District Court, on the label. The tribunal will be identified as follows:

         *"Personalized Media Communications, LLC v. Scientific-Atlanta, Inc., et al.*, Civil Action File No. 1:02-CV -824-CAP, United States District Court for the Northern District of Georgia"

3) Set forth the appropriate reexamination information (reexamination control number, filing date, patent owner, inventors, examiner, Art Unit) for the present reexamination.

C. Store the sealed envelope or container in a place separate from the present reexamination file, and not available to the public. [This sealed envelope or container will be forwarded to the examiner with the file, when the file is forwarded to the examiner for action on the proceeding.]

D. Place a notation on the face of the file to indicate that confidential/protective order materials are present. The location of the materials, i.e., in the envelope or container, will also be specified. The words "CONFIDENTIAL/PROTECTIVE ORDER MATERIALS FILED WHICH ARE NOT OPEN TO PUBLIC" are sufficient to indicate the presence of such materials.

2. Forward the file in the examiner for action, with instructions to follow the procedure set forth in MPEP 724.04(c).

**VI. THE REQUEST TO CONTACT PERSONS WHO ACCESSED THE INFORMATION STATED TO BE CONFIDENTIAL, WHILE THE INFORMATION HAS BEEN AVAILABLE TO THE PUBLIC:**

The information which patent owner has requested to be expunged/sealed has already been made available to the public and subject to copying (of the file by the public) by the *filing* of the present reexamination request, 37 CFR 1.11(d). Accordingly, the Office cannot guarantee that the materials being sealed as a result of this decision were not previously accessed by the public.

At page 6 of the supplemental petition, it is requested that the Office contact any persons who accessed the information stated to be confidential (protected) while the information has been available to the public, and request return of same. This request will not be granted, and the petition is dismissed as to this request.

Pursuant to 37 CFR 1.11(c), *Files open to the public.*, requests for reexamination are announced in the *Official Gazette.* Reexamination proceedings are then open to the public, i.e.,

access is permitted to reexamination proceedings.[6] See also MPEP 2232. Thus, any persons who accessed the information stated to be confidential (protected) did so while the information was appropriately available to the public. The public cannot be asked to return what it legitimately had access to.

Petitioner refers to the January 2, 2003, letter from Karin Ferriter, a copy of which was filed as an attachment to the original petition. In that letter, the patent owner was notified that parties who were known to have accessed patent owner's applications had been contacted by the Office and asked to return materials. It is to be noted, however, that applications are maintained confidential as required by 35 U.S.C. 122, and access to applications is strictly limited since they are to be maintained in confidence as per the statute. In the instance referred to by the letter, any party that should not have been entitled to access was requested to return proprietary materials, because such party would have obtained materials that should not have legitimately been open to access. In the present instance, reexaminations, are open to the public, and thus any party who obtained access did so within the statute and rules.

It is noted that the request for reexamination in this proceeding was filed by the third party requester on March 14, 2003, and patent owner was served with a copy of same at that time. Yet, the patent owner did not file the initial petition addressing the materials stated to be protected until June 10, 2003, almost three months after March 14, 2003. Thus, the Office did not have notice that protected materials might be present in the proceeding until almost three months after the request for reexamination was filed. During that period, any member of the public could have legitimately accessed the proceeding. Now that the Office has been made aware of the matter, relief is being provided. Such relief cannot, however, be provided retroactively.

**CONCLUSION**

1. The petition under 37 CFR 1.183 is granted, such that the present petition papers have been entered and addressed above.

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[6] In practice, any member of the public desiring a copy of all or part of a reexamination file may obtain such in the Office's Public Search Room from the reexamination database via REPS (Reexamination Processing System) terminals in the Public Search Room.

2. The petition under 37 CR 1.59(b) is granted as to the request for expungement of the materials of the reexamination from the REPS Scanning Data Base. It is dismissed as to the request for expungement of the reexamination request. It is otherwise is held in abeyance, pending renewal of same by patent owner at an appropriate time. As pointed out above, **the patent owner is cautioned that a failure to timely renew the petition to expunge prior to the point at which the file is forwarded for issuance of the reexamination certificate will result in the sealed material being unsealed and made of record in the reexamination file and thus becoming open to the public.**

3. The petition to seal materials under 37 CR 1.182 is granted to seal the originally filed request for reexamination, the originally filed Exhibit A1 and Exhibit E.

4. The petition, as it relates to the request for contacting any parties that may have accessed unprotected materials, is dismissed.

5. The reexamination file is being forwarded to the CRU to:

(A) Expunge *in toto*, the electronic images of the originally filed request for reexamination and its attachments from the REPS Scanning Data Base; and

(B) Scan into the Data Base - the original petition filed June 10, 2003, the supplemental petition filed July 9, 2003, the patent owner paper filed June 10, 2003, to inform the Office that no statement under 37 CFR 1.530 will be filed, and the redacted copy of the request for reexamination and the redacted copy of Exhibit A1 submitted with the supplemental petition, together with the attachments other than Exhibit E and the original of Exhibit A1.

6. The reexamination file will then be returned by the CRU to Technology Center 2600. The Technology Center will:

(A) Seal materials as directed by part V of this decision.

(B) Enter the redacted copy of the request for reexamination, and that of Exhibit A1 (both submitted with supplemental July 9, 2003, petition) into the file to replace the originally filed request and Exhibit A1.

7. The reexamination file will then be forwarded to the examiner who will prepare an Office action in due course.

8. Any questions regarding this decision should be directed to the undersigned at (703) 308-6710.

9. Telephone inquiries related to the examination of the reexamination proceeding should be directed to Examiner David E. Harvey of Art Unit 2614 at 703-305-4635.

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

August 4, 2003
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Paper No. 12

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1900 K STREET, N.W.
SUITE 1200
WASHINGTON, DC 20006-1109

MAILED
SEP 12 2003
REEXAM UNIT

Arthur J. Usher, Esquire (For Third Party Requester)
WOODARD, EMHARDT, NAUGHTON,
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BANK ONE CENTER/TOWER
111 MONUMENT CIRCLE, SUITE 3700
INDIANAPOLIS, IN 46204-5137

Enclosure: August 11, 2003, third party requester petition and attachments.

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| Harvey et al | : |
| Reexamination Proceeding | : DECISION |
| Control No. 90/006,563 | : GRANTING-IN-PART |
| Filed: March 14, 2003 | : PETITIONS |
| For: U.S. Patent No. 5,335,277 | : |

This is a decision on (A) the August 11, 2003, third party requester petition titled REQUESTER THOMSON INC.'S PETITION TO UNSEAL PAPERS FROM THE REQUEST FOR REEXAMINATION and (B) the patent owner August 21, 2003, petition titled PETITION TO SEAL AND IN OPPOSITION TO REQUESTER THOMSON'S PETITION TO UNSEAL PAPERS FROM THE REQUEST FOR REEXAMINATION.

The requester petition is addressed in three respects:

(1) Under 37 CFR 1.183 as a request to waive the rules and provide an entry right for the requester petition papers.

(2) Under 37 CFR 1.182 [1] as a request to restore the electronic images expunged from the request for reexamination, and a request to unseal the paper documents sealed in the present reexamination proceeding.

(3) Under 37 CFR 1.182 as a request that all the request materials originally submitted by requester be publicly available in accord with 37 CFR 1.11.

The patent owner petition is addressed in three respects:

(1) Under 37 CFR 1.183 as a request to waive the rules and provide an entry right for the opposition petition papers.

(2) Under 37 CFR 1.182 as a request that requester's petition be denied consideration and returned to requester, or that the petition should be denied and sealed.

(3) As an opposition to the requester's position that the document attached as exhibit A of requester's petition should be open to the public in the present proceeding.

DETAILED ACTION

Pursuant to 37 CFR 1.17(h), a petition fee of $130.00 is required for a petition under 37 CFR 1.182 and/or 37 CFR 1.183. The required petition fees of $130.00 have been received from both requester and patent owner in the form of checks.

The petitions are before the Office of the Patent Legal Administration of the United States Patent and Trademark Office for decision.

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[1] All the requests in the requester and patent owner petitions directed to situations not specifically provided for in the regulations are addressed under 37 CFR 1.182.

**SUMMARY OF ACTION TAKEN**

The requester and patent owner petitions under 37 CFR 1.183 are granted, such that both petition papers will be will be considered and addressed.

The requester petition under 37 CFR 1.182 is dismissed and the materials previously expunged and sealed will not be restored and unsealed (respectively) for the reasons set forth below.

The patent owner petition under 1.182 is dismissed to the extent that the requester petition has been considered on its merits, and is granted to the extent that the requester petition is being returned to requestor to redact it to remove the improper content identified below.[2]

90/006,563

**REVIEW OF FACTS**

1. U.S. patent No. 5,335,277 issued on August 2, 1994.

2. A request for reexamination, assigned control No. 90/006,563, was filed by a third party requester on March 14, 2003.

3. Reexamination was ordered for the '6563 reexamination proceeding on May 14, 2003.

4. A patent owner paper was filed June 10, 2003, to inform the Office that no statement under 37 CFR 1.530 will be filed.

5. Also on June 10, 2003, patent owner filed a petition titled "PETITION TO EXPUNGE PAPERS FROM THE REQUEST FOR REEXAMINATION."

6. On July 9, 2003, patent owner filed a supplemental petition to seal papers from the request for reexamination. A redacted copy of the request for reexamination and a redacted copy of Exhibit A1 were submitted with the supplemental petition.

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[2] Since the requester petition is being returned, there is no need to address the alternatively requested sealing of the petition.

7. A decision was mailed August 5, 2003, in which:

A. The petition, as taken under 37 CFR 1.183, was granted to enter and address the petition paper.

B. The petition under 37 CR 1.59(b) was granted to expunge the materials of the original reexamination request papers from the REPS Scanning Data Base. It was dismissed as to the request for expungement of the reexamination request, and it was otherwise held in abeyance.

C. The petition to seal materials under 37 CR 1.182 was granted to the extent that (1) originally filed Exhibits A1 and E were sealed, (2) the redacted paper copy of the request for reexamination, and that of Exhibit A1, were physically entered into the file to replace the originally filed request and Exhibit A1, and (3) the redacted copy of the request and the redacted copy of Exhibit A1 were scanned into the REPS Scanning Data Base together with the attachments other than Exhibit E and the original of Exhibit A1.

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8. On August 11, 2003, requester filed the instant petition *sub silentio* requesting waiver of the rules to provide an entry right for the petition paper, and specifically requesting that the electronic images expunged from the request for reexamination be restored, that the paper documents sealed in the present reexamination proceeding be unsealed, and that all the request materials originally submitted by requester be publicly available in accord with 37 CFR 1.11. The petition addresses the June 10, 2003, patent owner petition titled PETITION TO EXPUNGE PAPERS FROM THE REQUEST FOR REEXAMINATION, and the supplemental July 9, 2003, petition which was titled SUPPLEMENTAL PETITION TO SEAL PAPERS FROM THE REQUEST FOR REEXAMINATION.

9. On August 21, 2003, the patent owner filed a petition in opposition to requester's August 11, 2003, petition, and request for return of same to requester. This patent owner paper will also require a waiver of the rules to provide it with an entry right, as will be discussed below.

**DECISION ON PETITIONS UNDER 37 CFR 1.183**

**I. Requester Petition Under 37 CFR 1.183:**

Pursuant to 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."

In addition, 37 CFR 1.550(g) provides:

> "(g) The active participation of the *ex parte* reexamination requester ends with the reply pursuant to § 1.535, and no further submissions on behalf of the reexamination requester will be acknowledged or considered. Further, no submissions on behalf of any third parties will be acknowledged or considered unless such submissions are:
>
> (1) in accordance with § 1.510 or § 1.535; or
>
> (2) entered in the patent file prior to the date of the order for *ex parte* reexamination pursuant to § 1.525."

Accordingly, the present requester petition paper does not have an entry right under the reexamination rules.

A right of entry for the petition paper would require a waiver of the above-quoted provisions of 37 CFR 1.540 and 37 CFR 1.550(g), such a waiver being available only pursuant to 37 CFR 1.183.[3] Accordingly, the present requester petition is taken to provide, as one of its requests for relief, a request under 37 CFR 1.183 for a waiver of the rules.

With respect to the sealing and expungement issue, patent owner's (composite) petition papers were entered, considered, and acted upon via the decision dated August 5, 2003. The rule (37 CFR 1.540) was waived because patent owner's rights could be

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[3] 37 CFR 1.183 states as follows:
"In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(h)."

prejudiced if a decision on the matter presented was delayed until the examination stage of this reexamination proceeding.

In the interest of fairness, justice requires that the rule be likewise waived to permit requester's "response" to patent owner's petition to be considered and addressed.

Accordingly, the requester petition, as it relates to relief under 37 CFR 1.183, is granted.

**II. Patent Owner Petition Under 37 CFR 1.183:**

Pursuant to 37 CFR 1.540, the patent owner opposition petition paper also does not have an entry right under the reexamination rules. Accordingly, the patent owner petition is also taken to provide a request under 37 CFR 1.183 for a waiver of the rules.

Once again, in the interest of fairness, justice requires that the rule be likewise waived to permit patent owner's "opposition" to requester's petition to be considered and addressed.

Accordingly, the patent owner petition, as it relates to relief under 37 CFR 1.183, is granted.

**DECISION ON REQUESTER PETITION UNDER 37 CFR 1.182**

**I. The Requester Petition, as it Relates to the Requests to Restore Expunged Materials and Unseal Materials:**

At page 4 of the third party requester petitioner petition (hereinafter "requester petition"), it is urged that:

> "Thomson properly obtained copies of the Notice of Abandonment from several sources such that Thomson is free to publicly disseminate the Notice of Abandonment. These sources include: (1) discovery in the Delaware Litigation, (2) the public record of other court proceedings involving PMC's patents, and, (3) from third parties who requested a file history containing the Notice Abandonment and received it from the PTO. PMC's petitions to expunge and/or seal devote extensive argument to the latter two sources but fail to fully address the first."

As to sources (2) and (3), petitioner requester (hereinafter "requester") has not provided a showing that any of the copies of the "Notice of Abandonment" referred to at page 4 of the petition were other than the "fruits" of the original improper access to the application involved.

As to source (1), it is apparently requester's position that the documents were obtained via discovery in the Delaware Litigation [4] in a manner that legitimately places the documents in the public domain. In order to address this position of requester, a review of the history of the matter is in order.

In November of 2001, as part of the "Delaware Litigation" procedure, a conference was conducted with Judge Sleet and the parties as to whether the Notice of Abandonment (hereinafter "the Notice") should be protected by protective order. [5] Requester points out that, after the conference:

> "Ultimately, pursuant to Thomson's November 2002 challenge to the confidentiality of various documents (Thomson' s objection stated that the Notice of Abandonment should be treated as public ), and as a result of the negotiation between the parties, PMC agreed to treat the Notice of Abandonment as public." Indeed, PMC's June 10,2003 PETITION TO EXPUNGE PAPERS FROM THE REQUEST FOR REEXAMINATION admits as much (see page 7), acknowledging that "PMC wrote Thomson that PMC would allow Thomson to treat the document as public." [Requester Petition at 7]

Requester bolsters this point (agreement to treat the Notice as public) by reference to an e-mail dated December 20, 2003 (attached as Exhibit D) from patent owner's counsel to requester's counsel.

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[4] *Pegasus Development Corporation & Personalized Media Communications, LLC v. DIRECTV, Inc., et al.*, Civil Action File No.1:02-CV -824-CAP, (United States District Court for the Northern District of Georgia) in Atlanta before Judge Sleet (the Delaware Litigation).

[5] A review of pages 18-20 of the transcript of the conference appears to indicate that the Judge directed the parties to reach a compromise as to the dissemination of the Notice, and the Judge closed with advice to counsel for patent owner that if counsel would not be reasonable in making a compromise, the Notice would be designated as public. Requester has characterized the result of the conference otherwise at page 6 of the petition.

In an e-mail dated January 9, 2003,[6] patent owner notified requester that patent owner withdrew its consent to making the notice public a "change of circumstances" warranted "treatment of the Notice of Abandonment as confidential." [7] The "change of circumstances" referred to in the patent owner's notification is the January 2, 2003, letter authored by Karin Ferriter (a Senior Legal Adviser of the Office of Patent Legal Administration) holding that the access which was granted by the Office to the Notice should not have been granted.

Then, in a January 13, 2003, letter, requester informed the patent owner that requester rejected patent owner's attempt to renege on what requester characterized as an agreement that the Notice "was to be treated as public." [8]

Pages 7-8 of the requester petition go on to state that

> "Thomson [requester] has maintained this position and has distributed copies of the Notice of Abandonment to third parties with no restriction of confidentiality. Despite its knowledge of Thomson's position and unrestricted distribution of the Notice of Abandonment, the patent owner has made absolutely no attempt to raise this issue with the Delaware Court"

As to requester's contention that patent owner has not approached the Delaware Court for a modification of the protective order which did not protect the Notice of Abandonment, patent owner, on pages 9 and 10 of the patent owner petition, disputes this. Patent owner argues that, pursuant to Judge Sleet's Standing Order for resolving the matter, patent owner took steps in January of 2003 to arrange for contact with "chambers" to schedule a telephone conference with the Court.

On May 2, 2003, Order of the Atlanta District Court [9] granted patent owner's motion for a protective order to protect the

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[6] Exhibit E of the requester petition.

[7] *See* Exhibit E, second paragraph.

[8] *See* Exhibit F of the requester petition.

[9] Issued in *Personalized Media Communications,LLC v. Scientific-Atlanta, Inc., et al.*, Civil Action File No. 00-1020 (GMS), (United States District Court for the District of Delaware) in Wilmington before Judge Pannell (the Atlanta Litigation).

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Notice. Requester is not a party to that action and there is no indication that requester made any attempt to intervene in that action.

It is initially noted that the Order of the Atlanta District Court granting patent owner protection of the Notice was issued after all of the above history; yet, in spite of the history the Atlanta District Court found that the Notice could not be made public. Thus, at the very least there exists a conflict of District Court findings on the confidentiality of the Notice.[10] The Office is not about to arbitrate that dispute, especially since, petitioner has not provided a showing as to how the materials remaining sealed and the redacted request being publicly available will prejudice the decision made on the reexamination request, and/or the examination of the reexamination proceeding. MPEP 724.04(c) sets forth the guidelines for a petition to expunge "Materials Submitted in Reexamination File Open to the Public Under 37 CFR 1.11(d)." When the application is considered for action on the merits, the examiner (and/or other appropriate Office official responsible for considering the information) **will review the sealed information, and will make a determination as to whether or not any portion or all of the information submitted is "important to a reasonable examiner in deciding whether or not a claim is patentable."** Thus, a full review of requester's submissions will be made, and there is no reason to grant this request of the third party requester which is not provided for in the rules and is at least open to dispute by the courts. The Office does not need to arbitrate the matter, when it can satisfy its mission of reexamining patents without arbitrating the matter (see the discussion of this below), and accordingly will not do so. [11]

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[10] It is to be noted that the interaction with Delaware District Court as to the Notice took place prior to the Office's January 2, 2003, letter by the Senior Legal Adviser holding that the access which was granted by the Office to the Notice should not have been granted, and that statutory issues of patent application confidentiality (35 U.S.C. 122) were involved. It is not entirely clear as to the approach the Delaware District Court will have subsequent to the Office's letter.

[11] Stated another way, when balancing the interests here, the statutorily recognized (35 U.S.C. 122) interest in maintaining the confidentiality of material present in patent owner abandoned patent applications far outweighs the requester's interest in making the material present, since the examination of the proceeding will not be impeded by the Notice not being available to the public via the reexamination.

Thus, the petition, as it relates to the requests to **restore expunged materials and to unseal materials**, is dismissed.

At page 4 of the requester petition, requester states its request for relief in terms of public policy:

> "Thomson asks that this petition be given consideration so that its due process rights can be met, and the public can be served by learning of the contents of the Notice of Abandonment."

In response, the present decision does not aide nor hinder the dissemination of the Notice of Abandonment outside the Office. Nor does it affect any remedies that parties may have and may exercise as to action/conduct by parties in regard to dissemination of the Notice by parties to the public. Such matters are left to the courts, and, as pointed out in the requester petition, "Thomson continues to freely distribute copies of the Notice of Abandonment to others...."[12] The present decision is merely a statement that the Office can accomplish its mission in reexamining the patent of the present proceeding while the papers are under seal, because the Office has access to those papers as needed. Requester is not being prejudiced in any manner as to the examination that will be provided and the consideration of the materials submitted by requester. It is the purpose of reexamination to determine whether the patent claims are patentable over the patents and printed publications; it is not the purpose of reexamination to make, or ensure that, the submitted materials are public. Whether dissemination of the Notice is appropriate or not is a matter left to the courts. The Office is simply refusing to be the agent by which dissemination is carried out (via filing the Notice of Abandonment in the reexamination proceedings) until it becomes clear that there is a right for such dissemination. Given the above-discussed history, the matter is far from being clear.

As a final point, it is not clear what prompted requester to ask for a copy of the Notice of Abandonment in the discovery stage of the litigation. If such were prompted by knowledge of its existence obtained as a result of the improper access to the Notice in the application (and subsequent dissemination thereof), then the "publication" of the Notice via the Delaware litigation would also be fruits of the improper access, and as such, the Office could not permit the Notice to remain available to the public.

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[12] Requester petition at 14.

**II. The Requester Petition, as it Relates to the Request That All Materials Originally Submitted by Requester Be Publicly Available in Accord with 37 CFR 1.11:**

The requests for unsealing and restoring expunged materials to make the materials publicly available in accord with 37 CFR 1.11 have already been addressed in the preceding section of this decision. To the extent that this request is a repetition of the first two requests, it is dismissed for the reasons set forth in the preceding section.

Other than unsealing the sealed materials and restoring the expunged electronic materials, it is not clear what action the Office can take to address this request. If petitioner desires a statement that such materials are in the public domain, such a statement would not be addressed to providing relief in the present proceeding, and is dismissed as such. In any event, as pointed out above, there has not been any showing of the existence of a copy of the materials not obtained in some manner as the fruit of the original improper access, thus there would be no basis to make the materials public.

**III. Other Requester Arguments:**

A. At pages 12 and 13 of the requester petition, it is argued that the patent owner has no right to expunge and/or seal material from Thomson's third party request for reexamination under the governing law.

In response, 37 CFR 1.182 provides relief to parties in "situations not specifically provided for in the regulations" such relief being provided "in accordance with the merits of each situation." In this instance, the patent owner has an interest in maintaining the confidentiality of it's confidential material. Such an interest can be protected by sealing the materials, as has been done. It is to be noted that prior to the promulgation of 37 CFR 1.59 for expungement of papers, such relief was also provided by 37 CFR 1.182 based on the interest of protecting confidential material.

B. At pages 13 and 14 of the requester petition, it is argued that:

> "[T]he procedure sought to be invoked by PMC results in a denial of due process to Requester, in that it contemplates a striking of the material without the Requester having an appropriate role in the matter. Whether material should be struck from any paper a requester files with the PTO is a matter in which the requester must be given an opportunity to be heard, and not resolved solely between the PTO and some other party who believes it might be impacted by the contents of the filing. At best, PMC's request can be viewed as a public request to have the PTO strike matter filed by another party. If the PTO desires to inquire further as to the merits of the request, it should then deal directly with the filer of the papers, Thomson, allowing an opportunity for Thomson to be heard on the merits."

In response, requester has not indicated that it was not served with a copy of patent owner's initial petition to expunge; [13] yet, requester failed to file an opposition to patent owner's initial petition - not in this proceeding nor in any of the related proceedings identified in the first footnote of the requester petition. In addition, by way of the present requester petition (and this decision), requester has in fact been heard on the merits.

**DECISION ON PATENT OWNER PETITION UNDER 37 CFR 1.182 AND RETURN OF THE REQUESTER PETITION FOR REDACTION**

**A. Discussion:**

At pages 3-6 of the patent owner petition, it is argued that requester's petition should be denied consideration and returned to the requester, or denied and sealed.

As pointed out by patent owner, neither the rules nor any provision of the statute provide authority for a third party to participate in a reexamination proceeding by filing a paper directed to the substantive issues of the proceeding. *See In re Amp*, 212 USPQ 826 (Comr. Pats. 1981). The statute and its intent

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[13] And a certificate of service of the petitions (that accompanied the filing of the petitions) *prima facie* establishes that requester was served.

are clear that a reexamination proceeding requested under 35 U.S.C. 302 must be *ex parte*. In this regard, the Court of Appeals for the Federal Circuit stated in *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 882 F.2d 1570, 1573, 11 USPQ2d 1866, 1868, 1869 (Fed. Cir. 1989):

> "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."

*Also see In re Chambers*, 20 USPQ2d 1470, 1476 (Comr.Pat. 1991):

> "It is noted that a third party has no right to comment or participate in a reexamination proceeding beyond the rights specifically provided for by the reexamination statute, i.e., file a request for reexamination and comment on any statement filed by a patent owner."

**B. Decision:**

Part 1

To the extent that the petition requests unsealing, restoring of e-files, and publication of the materials related to the Notice of Abandonment, this is not participation in the conduct of the reexamination proceeding. Rather, it is a non-substantive response to the patent owner's prior request for sealing and expungement, which has nothing to do with the conduct of the reexamination itself. Thus, such a requester paper is not barred by the statute. Rather, such a matter is appropriate for consideration where, as is the case here, justice requires that requester be granted an opportunity to be heard as to patent owner's request for sealing and expungement. In the same manner that a waiver of the rules was granted for consideration of patent owner's request for sealing and expungement, and for consideration of patent owner's present request as to how the requester petition should be dealt with, justice requires that a waiver of the rules be granted for consideration of requester's position on the matter.

Patent owner is referred to Manual of Patent Examining Procedure (MPEP) § 2246 where it is stated that consideration is given to a patent owner petition to vacate an *ultra vires* reexamination order even at a point where a patent owner petition would otherwise not have an entry right. In that situation, the third party requester is given an opportunity file a single submission in opposition to the petition, even though a requester paper would otherwise not have an entry right. The present situation is analogous to that of MPEP § 2246.

Part 2

At page 10 of the requester petition, it is stated:

> "As previously noted, Thomson has attached a copy of the January 18,2001 Notice of Abandonment to the present petition as Exhibit A. Even a brief review of the contents of the Notice of Abandonment indicates areas of potential and/or actual overlap with issues include issues that may or will arise during the reexamination proceedings."

The items that requester perceives as such are then set forth.

The discussion by requester of the overlap of the Notice with issues of the case is clearly substantive; it amounts to an argument/statement of relevance of the information of record (the Notice). This would be a supplement to the request for reexamination, which is prohibited. Such participation by the requester is barred by the statute for the reasons set forth above. The determination as to relevance of the Notice **is for the examiner to make**, and the requester is not, at this stage, permitted to file information on the issue.

Additionally, it is to be noted that there is no need for the presentation of Exhibit A, the attached copy of the January 18, 2001, Notice of Abandonment. There is already a sealed copy of the Notice of record, to which the Office may refer as needed. Providing another copy is surplusage, and would require the needless sealing and storage of another paper in an already extensive record.

In view of the presence of the inappropriate contents of the petition, the requester petition is being returned to requester with a copy of this decision.

If requester wishes to retain of record the portions of the requester petition other than Exhibit A and the argument/statement of relevance directed to the Notice, requester must provide a redacted petition omitting Exhibit A and the argument/statement of relevance. Such would retain requestor's other materials, arguments, positions taken, points made, etc. of record.

A redacted copy as set forth above is required from requester within ONE MONTH from the date of this decision. If the redacted copy is not received within the one month period set, the paper will no longer have an entry right.

It is to be noted that while ordinarily the petition containing the improper subject matter might not be addressed on the merits and simply returned for correction, the issues of requester's petition have been addressed on the merits in this decision. This was done in view of the number of cases involved, the different stages of the cases, and the various time constraints involved. [14]

As to patent owner's alternative request for sealing of the petition, such is <u>moot</u>, since the requester petition is being returned. Thus, there is no need to address this alternative relief that was requested.

**CONCLUSION**

1. The requester and patent owner petitions are <u>granted</u> under 37 CFR 1.183, such that the requester and patent owner petition papers have been considered and addressed above.

2. The requester petition under 37 CR 1.182 is <u>dismissed</u>.

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[14] As stated in the first footnote of the requester petition, "[t]he patent owner has filed such papers in connection with Thomson's Requests for Reexamination of U.S. Patent Nos. 4,965,825 [Reexam Control No. 90/006,536 filed February 4, 2003], 5,335,277 [Reexam Control No. 90/006,563 filed March 14, 2003], 5,233,654 [Reexam Control No. 90/006,606 filed April 18, 2003], and 5,887 ,243 [Reexam Control No. 90/006,688 filed June 30, 2003]." The determination on the request has not yet been made for one of these proceedings.

3. The patent owner petition under 37 CR 1.182 is dismissed to the extent that the requester petition has been considered on its merits, and is granted to the extent that the requester petition is being returned to requestor to redact it to remove the improper content identified below.

4. The requester petition papers are being returned with this decision. A redacted copy of the requester petition pursuant to the instructions set forth above is required from requester within ONE MONTH from the date of this decision. If such a redacted copy is not received within the one month period set, the paper will no longer have an entry right.

5. The reexamination file is being returned to Technology Center 2600 for forwarding to the examiner who will prepare an appropriate Office action consistent with this decision.

6. If the redacted copy of the requester petition pursuant to the instructions set forth above is timely received from requester, the file should be forwarded to the Office of Patent Legal Administration to the attention of Kenneth M. Schor, Senior Legal Advisor.

7. Any questions regarding this decision should be directed to Kenneth M. Schor at (703) 308-6710.

8. Telephone inquiries related to the examination of the reexamination proceeding should be directed to Examiner David E. Harvey of Art Unit 2614 at 703-305-4635.

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

September 11, 2003
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Paper No. 14 AWR

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INDIANAPOLIS, IN 46204-5137

Harvey et al :
Reexamination Proceeding : DECISION
Control No. 90/006,563 : GRANTING
Filed: March 14, 2003 : PETITION
For: U.S. Patent No. 5,335,277 :

This is a decision addressing the October 2, 2003, third party requester submission titled REQUESTER THOMSON INC.'S SUBMISSION OF REDACTED VERSION OF PETITION TO UNSEAL. Due to the nature of the submission, it is taken as a renewed petition under 37 CFR 1.183 directed solely to waiver of the rules to provide an entry right for making the re-submitted **previously addressed** requester petition papers of record in redacted format.

The petition under 37 CFR 1.183 is granted.

**DECISION**

As pointed out in the present submission, the decision issued by this office in September of 2003 stated:

> "If requester wishes to retain of record the portions of the requester petition other than Exhibit A and the argument/statement of relevance directed to the Notice, petitioner must provide a redacted petition omitting Exhibit A and the argument/statement of relevance. Such would retain requestor's other materials, arguments, positions taken, points made, etc. of record."

The present submission is responsive to that statement of the September decision, and has timely provided the suggested redacted petition. Accordingly, the submission is granted entry for the reasons set forth in the September decision. The reasons for waiver of the rules set forth therein continue to apply to the present submission.

The redacted requester petition, which was previously addressed in the September decision of this office, will be made of record in the present proceeding.

**CONCLUSION**

1. The requester petition under 37 CFR 1.183 is granted.

2. The October 2, 2003, third party requester submission will be entered into the record and scanned into the Reexamination Processing System Scanning Data Base of the Central Reexamination Unit.

3. The reexamination file is being returned to Technology Center 2600 for forwarding to the examiner.

4. Any questions regarding this decision should be directed to the undersigned at (703) 308-6710.

5. Telephone inquiries related to the examination of the reexamination proceeding should be directed to Examiner David E. Harvey of Art Unit 2614 at 703-305-4635.

Control - 90/006,563

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

October 4, 2003
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/006,698<br>+ 90/006,563 | 07/07/2003 | 5335277 | 001263.00016 | 9278 |

| EXAMINER |
|---|

| ART UNIT | PAPER NUMBER |
|---|---|

21967 7590 12/03/2004

HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
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DATE MAILED: 12/03/2004 #16

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

cc: Third Party Requester as attached.

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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Washington DC 20001-4597

# *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/006,563 90/006,698

PATENT NO. 5335277.

ART UNIT 2600.

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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# *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/006,698* 90/006,563

PATENT NO. *5335277*.

ART UNIT *2600*.

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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Paper No. 16

| | | |
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| Arthur J. Usher IV, Esquire<br>Woodard, Emhardt, Naughton, Moriarty & McNett LLP<br>Bank One Center/Tower<br>111 Monumental Circle, Suite 3700<br>Indianapolis, Indiana 46204-5137 | ) | FOR FIRST THIRD PARTY REQUESTOR |
| Thomas L. Peterson, Esq.<br>Banner & Witcoff, Ltd.<br>1001 G Street NW 11th Floor<br>Washington DC 20001-4597 | ) | FOR SECOND THIRD PARTY REQUESTOR |
| In Re Harvey, et al.<br>Reexamination Proceeding<br>Control No. 90/006,563<br>Filed 3-14-03<br>For U.S. Patent No. 5,335,277 | ) | DECISION SUA SPONTE MERGING REEXAMINATION PROCEEDINGS |
| In Re Harvey, et al.<br>Reexamination Proceeding<br>Control No. 90/006,698<br>Filed 7-7-03<br>For U.S. Patent No. 5,335,277 | ) | |

The above noted reexamination proceedings are before the Director of Technology Center 2600 for consideration of merger of the proceedings under 37 CFR 1.56(c).

**BACKGROUND**

1. Patent No. 5,335,277 issued on August 2, 1994.

2. A first request for reexamination, Control No. 90/006,563 ('563) was filed by the First Third Party Requestor on March 14, 2003.

3. Reexamination was ordered on the '563 reexamination proceedings on May 14, 2003.

4. A statement of non-submission of Patent Owner's statement was filed on June 10, 2003.

5. A second request for reexamination, Control No. 90/006, 698 ('698) was filed by the Second Third Party Requestor on July 7, 2003.

6. Reexamination was ordered on the '698 reexamination proceedings on September 10, 2003.

7. A statement of non-submission of Patent Owner's statement was filed on November 5, 2003.

**DISCUSSION**

37 CFR 1.565(c) states:

> "If reexamination is ordered while a prior reexaminations is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under section 1.570".

**DECISION**

I. Merger of Proceedings

In accordance with 37 CFR 1.565(c), the '563 and '698 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for the same amendment's in all proceedings.

The Patent Owner is required to maintain the same claims and specification in 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 must contain the identifying data for each proceeding and will be physically entered in each reexamination proceeding 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 proceeding file. All papers filed by the Patent Owner must be served on the requestor and requestor will be sent copies of all papers mailed by the Office. See MPEP §2283.

A review of these reexamination files finds that both proceedings currently contain the same claims and specification and therefore the Patent Owner need not take any action.

The merged proceedings are being forwarded to the examiner for appropriate action. An Office action will be mailed in due course.

Reinhard Eisenzopf, Acting Director
Technology Center 2600
Communications & Information Processing

UNITED STATES PATENT AND TRADEMARK OFFICE

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OCT 21 2005

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In re John C. Harvey et al.
Reexamination Proceeding
Control No.: 90/006,698
Filed: July 7, 2003
For: U.S. Patent No. 5,335,277

In re John C. Harvey et al.
Reexamination Proceeding
Control No.: 90/006,563
Filed: March 14, 2003
For: U.S. Patent No. 5,335,277

DECISION DISMISSING PETITION AND SEALING PAPERS, AND ORDER *RE* SHOWING CAUSE TO UNSEAL

This is a decision on the September 6, 2005 third party requester's petition titled PETITION TO EXPUNGE PAPERS FROM PATENT REEXAMINATION FILES.

The petition is considered in three respects:

(1) Under 37 CFR 1.183 as a request to waive the rules and allow entry of the petition paper.

(2) Under 37 CFR 1.182 as a request to expunge materials submitted by the patent owner with the Information Disclosure Statement (IDS) of August 22, 2005.

(3) Under 37 CFR 1.182 as a request to seal materials submitted by the patent owner with the Information Disclosure Statement (IDS) of August 22, 2005.

At the end of the first paragraph of the instant petition, the petitioner authorizes the Office to charge the petition fee to deposit account number 19-0733. The $400 fee set forth in 37 CFR 1.17(f) for a petition under 37 CFR 1.182 and under 37 CFR 1.183 has accordingly been charged.

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

## SUMMARY

The petition under 37 CFR 1.183 is granted, such that the present petition paper will be permitted entry and will be addressed.

The petition under 37 CFR 1.182 to expunge materials is dismissed as not ripe for decision.

The petition under 37 CFR 1.182 to seal materials is granted to the extent that:

(a) The Office is placing the documents identified by the petitioner in Exhibit 1 attached to the instant petition at least temporarily under seal.

(b) The patent owner is being provided with an opportunity to show cause why the documents identified by the petitioner in Exhibit 1 should be available to the public, and thus unsealed.

## REVIEW OF FACTS

1. U.S. Patent No. 5,335,277 (hereinafter, the '277 patent) issued on August 2, 1994.

2. On March 28, 2002, the patent owner, Personalized Media Communications, LLC (PMC), brought a patent infringement suit against the petitioner Scientific-Atlanta, Inc. (S-A) in the United States District Court for the Northern District of Georgia.[1] As of the mail date of this decision, the litigation is ongoing.

3. On May 2, 2003, the court issued a protective Order prohibiting public disclosure of certain information.

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[1] *Personalized Media Communications,LLC v. Scientific-Atlanta, Inc.*, No.1:02-CV -824 (N.D. Ga. filed Mar. 28, 2002).

4. On March 14, 2003, Thomson, Inc. filed a first request for reexamination of the '277 patent. The Thomson request for reexamination was assigned control number 90/006,563, and it was granted. The petitioner S-A then filed a second request for reexamination of the '277 patent, on July 7, 2003. The S-A request for reexamination was assigned control number 90/006,698, and it too was granted. The two granted reexamination proceedings were subsequently merged under 37 CFR 1.565(c).

5. On August 22, 2005, the patent owner filed an IDS in reexamination control numbers 90/006,698 and 90/006,563.

6. On September 6, 2005, S-A, the requester of one of the two merged proceedings, filed the instant petition alleging that PMC's IDS improperly included certain documents subject to the court's protective Order.

## DECISION

I. The Petition Under 37 CFR 1.183 for Entry of the Petition Paper

The instant petition is not entitled to entry. According to 37 CFR 1.550(g):

> The active participation of the *ex parte* reexamination requester ends with the reply pursuant to § 1.535, and no further submissions on behalf of the reexamination requester will be acknowledged or considered. Further, no submissions on behalf of any third parties will be acknowledged or considered unless such submissions are:
>
> (1) in accordance with § 1.510 or § 1.535; or
>
> (2) entered in the patent file prior to the date of the order for *ex parte* reexamination pursuant to § 1.525.

The petitioner S-A is one of the two third party requesters in the instant merged reexamination proceeding. However, the present petition is not a reply pursuant to 37 CFR 1.535. Furthermore, the petition is not a request for reexamination under 37 CFR 1.510, it was filed after the date of the order for *ex parte* reexamination (37 CFR 1.552(g)(2)), and it is clearly not a submission of a prior art citation under 37 CFR 1.502. Thus, the requester S-A petition does not have an entry right in the instant proceeding. Although the Office does accept submissions from third parties pursuant to MPEP § 2282 that are limited to bare notice of prior or concurrent litigation involving the patent undergoing reexamination, such notice is not the subject of the instant petition. S-A fails to suggest any provision of the regulations which could provide a basis for entry of its petition, and the Office can identify none. Thus, by rule, S-A is not entitled to consideration of the instant petition.

Pursuant to 37 CFR 1.183, however:

> 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.

In the present instance, the petition alleges that significant property rights are at stake, and because it may be possible for the Office to act to protect those rights, the interests of justice require that the reexamination entry right rules be waived. Therefore, the Office will enter and consider S-A's petition. Entry of the present petition in the reexamination proceeding is akin to entry of bare notice of prior or concurrent litigation in a reexamination proceeding (pursuant to MPEP § 2282), as both serve a legitimate interest, and neither goes to the merits of the proceeding. As such, submission of the present petition does not constitute prohibited participation in the proceeding.

Accordingly, the petition, as it is taken under 37 CFR 1.183, is granted to permit entry and consideration of the petition paper.

II. The Petition Under 37 CFR 1.182 to Expunge

S-A's petition cannot be considered under 37 CFR 1.59, since 37 CFR 1.59, by its terms, applies to "applications" and not to reexamination proceedings.

However, 35 U.S.C. 305 provides:

> After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title.

This provision of 35 U.S.C. 305 has been interpreted to permit a petition for expungement in reexamination proceedings. Since there is no rule that provides for expungement in reexamination proceedings, S-A's petition to expunge is taken as a petition under 37 CFR 1.182 to expunge documents from the record of the reexamination proceeding.[2] In deciding such petitions for expungement in

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[2] 37 CFR 1.182 states:

> 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).

reexamination, the guidelines for deciding petitions filed under 37 CFR 1.59 (see MPEP 724-724.06) are followed insofar as they may be applied to the facts at hand. Such will be the case for the present petition.

MPEP 724.04(c) sets forth the guidelines for a petition to expunge "Materials Submitted in Reexamination File Open to the Public Under 37 CFR 1.11(d)." When the reexamination proceeding is considered for action on the merits, the examiner (and/or other appropriate Office personnel responsible for considering the information) will review the protected information that has been sealed, and will make a determination as to whether or not any portion or all of that information is "important to a reasonable examiner in deciding whether or not a claim is patentable." The examiner may issue a determination on the issue of importance of the sealed information in the first Office action on the merits, or in an Office action issued any time thereafter as appropriate, but in no event later than the close of prosecution.

It is not appropriate to make, in this decision, a final determination of whether or not the material requested to be expunged is "important to a reasonable examiner in deciding whether or not a claim is patentable." Rather, such a decision is issued by the examiner no later than the close of prosecution. Thus, a decision on the petition to expunge would be premature at this time. Therefore the petition, as it relates to the expungement issue, is dismissed.

III. The Petition Under 37 CFR 1.182 to Seal

S-A alleges that certain documents, identified in Exhibit 1 attached to the present petition and submitted to the Office by PMC with the IDS of August 22, 2005, are subject to the court's May 2, 2003 protective order. S-A has provided the Office with a copy of the court Order as Exhibit 2. According to S-A, the Exhibit 1 documents are S-A's trade secrets and are within the scope of the May 2, 2003 protective order, and S-A would be harmed by their public release. By way of the present petition, S-A seeks to avert this perceived harm.

It is found that S-A provides a reasonable basis upon which to conclude that the Exhibit 1 documents may be subject to the protective order, and that their availability to the public may cause harm to S-A. The practitioner signing the instant petition has done so subject to the Patent and Trademark Office Code of Professional Responsibility, including 37 CFR 10.23(c)(2)(ii) which prohibits giving false or misleading information to the Office. It is noted that 37 CFR 1.11(d) states:

> All papers or copies thereof relating to a reexamination proceeding which have been entered of record in the patent or reexamination file are open to inspection by the general public, and copies may be furnished upon paying the fee therefor.

However, in the interest of justice under 37 CFR 1.183, the Office hereby waives the public access provision of 37 CFR 1.11(d) *sua sponte*, as it applies to the IDS of August 22, 2005, subject to the right of patent owner to show cause why the information should be made public, as per the next section of this decision. The IDS and its accompanying documents will be sealed from public view. Such sealing furthers the interest in mitigating any damage which may already have been incurred by S-A as to retaining the confidentiality of S-A's documents, which appear to be subject to the protective court order of May 2, 2003. It is to be noted, however, that even if the patent owner does not show cause why the information should be made public, the information would be made public in the event that it is determined by the Office that the information is "important to a reasonable examiner in deciding whether or not a claim is patentable." See the discussion above in this decision.

As a final point, although the information which is the subject of this decision will now be at least temporarily sealed, that information has already been made available to the public and has been subject to copying under 37 CFR 1.11(d). Accordingly, the Office cannot guarantee that the materials being sealed as a result of this decision were not previously accessed by the public.

IV. Order Providing Opportunity to Show Cause

Patent owner PMC is hereby being provided with an opportunity to show cause why the materials sealed in accordance with this decision should be unsealed, such that the documents identified in S-A's Exhibit 1 would be made accessible to the public. If PMC believes that public access to the documents is appropriate and the seal should be lifted, PMC must explain why such is the case, in light of S-A's allegations and the protective order of record. PMC is given a **one month time period from the date of this decision** to respond to this Order. If no response to this Order is received within one month, or if sufficient cause is not shown in the response, the Office will resume examination of the reexamination proceeding, with the materials remaining sealed.

## CONCLUSION

1. The petition under 37 CFR 1.183 is granted, such that the present petition paper has been entered and addressed.

2. The petition under 37 CFR 1.182 to expunge materials is dismissed as not ripe for decision.

3. The petition under 37 CFR 1.182 to seal materials is granted to the extent that the Office is placing the documents identified by the petitioner in Exhibit 1 attached to the instant petition at least temporarily under seal.

4. The patent owner is provided with **ONE (1) MONTH** from the date of this decision, to show cause why the materials sealed in accordance with this decision should be unsealed.

5. The instant reexamination proceeding is being forwarded to the Central Reexamination Unit to seal the documents identified in Exhibit 1 attached to the instant petition, and mail the present decision.

6. After mailing of this decision, jurisdiction over the instant reexamination proceeding will be retained by the Office of Patent Legal Administration until either:

(1) The time expires for response to the Show Cause Order without any response having been received. Where no response is received and the time for same has expired, jurisdiction will automatically transfer to Technology Center 2600, and the examiner will prepare an Office action for the proceeding; OR

(2) A response to the Show Cause Order is received and the issue of sealing is resolved, after which jurisdiction will be transfered to Technology Center 2600 for preparation of an Office action

7. Telephone inquiries related to this decision should be directed to Kathleen Kahler Fonda, Legal Advisor, at (571) 272-7754 or in her absence, to the undersigned, at (571) 272-7710.

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

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October 18, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Requester Thomson, Inc.)

MAILED
MAR 31 2006
REEXAM UNIT

Nina L. Medlock
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1001 G Street NW
Washington, DC 20001

(For Requester Scientific-Atlanta, Inc.)

In re John C. Harvey et al. :
Reexamination Proceeding : DECISION DISMISSING
Control Nos.: 90/006,563 filed March 14, 2003 : PETITION AND UNSEALING
90/006,698 filed July 7, 2003 : PAPERS
For: U.S. Patent No. 5,335,277 :

This is a decision on the patent owner's October 11, 2005 petition titled PATENT OWNER'S PETITION TO RETURN MATERIALS SUBMITTED BY THIRD PARTY IN *EX PARTE* PROCEEDING. This decision is also responsive to the patent owner's November 1, 2005 submission titled PATENT OWNER'S RESPONSE TO ORDER PROVIDING OPPORTUNITY TO SHOW CAUSE.

The instant petition is treated as a petition under 37 CFR 1.182.[1] On page 2 of the petition, the patent owner authorizes the Office to charge fees associated with the

[1]37 CFR 1.182 states:

> 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).

petition to deposit account number 50-0206. The $400 fee set forth in 37 CFR 1.17(f) for a petition under 37 CFR 1.182 has been charged.

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

## SUMMARY

The patent owner's petition under 37 CFR 1.182 is dismissed in view of the patent owner's request that it be withdrawn.

The documents placed under temporary seal by the Office decision of October 21, 2005 titled DECISION DISMISSING PETITION AND SEALING PAPERS, AND ORDER *RE* SHOWING CAUSE TO UNSEAL are hereby unsealed.

## REVIEW OF FACTS

1. U.S. Patent No. 5,335,277 (hereinafter, the '277 patent) issued on August 2, 1994.

2. On March 28, 2002 the patent owner, Personalized Media Communications, LLC (PMC), brought a patent infringement suit against Scientific-Atlanta, Inc. (S-A) in the United States District Court for the Northern District of Georgia. As of the mail date of this decision, the litigation has been stayed pending conclusion of the ongoing reexamination proceeding.[2]

3. The court issued an Order prohibiting public disclosure of certain information on May 2, 2003.

4. On March 14, 2003 Thomson, Inc. filed a request for reexamination of the '243 patent. Reexamination control number 90/006,563 was assigned to the proceeding. The petitioner S-A filed a request for reexamination of the '277 patent on July 7, 2003, and reexamination control number 90/006,698 was assigned to that proceeding. The request for reexamination was granted, and the two proceedings have been merged under 37 CFR 1.565(c).

5. On August 22, 2005, PMC filed an IDS in reexamination control numbers 90/006,563 and 90/006,698.

6. On September 6, 2005, S-A filed a petition alleging that PMC's IDS improperly included certain documents subject to the court's protective Order.

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[2] *Personalized Media Communications, LLC v. Scientific-Atlanta, Inc.*, No.1:02-CV -824 (N.D. Ga. filed Mar. 28, 2002) (order to stay all proceedings pending PTO reexamination issued Feb. 6, 2006).

7. On October 11, 2005, the patent owner filed the instant petition to return materials submitted by a third party, i.e., the September 6, 2005 S-A petition.

8. The Office of Patent Legal Administration issued a decision on S-A's petition on October 21, 2005. The decision allowed entry of S-A's petition, dismissed the request to expunge as untimely, and temporarily sealed certain documents alleged by S-A to be covered by the court's protective order. The decision also provided the patent owner with an opportunity to show cause why the documents should be unsealed. At the time of that decision, the Office of Patent Legal Administration was unaware of the instant petition.

9. On October 28, 2005, the court issued an order denying S-A's motion to hold the patent owner in contempt for disclosing to the Office certain documents alleged by S-A to be within the scope of the court's May 2, 2003 protective order.

10. On November 1, 2005, the patent owner submitted the instant response to the Office's decision of October 21, 2005.

## DECISION

I. The Petition Under 37 CFR 1.182 for Return of S-A's Petition

The Office of Patent Legal Administration regrets that it was unaware of the patent owner's instant petition at the time the decision on S-A's petition was made.

The patent owner's petition requests that S-A's petition be returned without consideration, or in the alternative, that the Office stay S-A's petition pending a determination of confidentiality by the district court.

The decision of October 21, 2005 recognized that S-A's petition was not entitled as a matter of right to entry under 37 CFR 1.550(g), but nevertheless allowed entry of the petition in the interest of justice pursuant to 37 CFR 1.183. The decision also placed certain documents under temporary seal, and afforded the patent owner an opportunity to show cause why the documents should be unsealed.

The patent owner's petition is dismissed as moot in view of the issuance of the decision Office of October 21, 2005. The petition is further mooted as to any future action by the Office in regard to the relief requested, since a determination of confidentiality by the district court has now been made, i.e., the court's decision was issued October 28, 2005 as a court Order.

II. The Reponse to the Order Providing Opportunity to Show Cause

S-A's petition of September 6, 2005 had alleged that certain documents, identified in Exhibit 1 attached to S-A's petition and submitted to the Office by the patent owner with the IDS of August 22, 2005, were subject to the court's May 2, 2003 protective order. In

the decision of October 21, 2005, the Office placed the documents under temporary seal. Acting in the interest of justice under 37 CFR 1.183, the Office *sua sponte* waived the public access provision of 37 CFR 1.11(d) for a limited period of time because a reasonable question had been raised as to whether the documents were subject to the protective court order of May 2, 2003.

The court has now determined, by way of the Order dated October 28, 2005, that the documents in question were not subject to the protective order of May 2, 2003, and that the patent owner's submission of the documents to the Office was not in contempt of the Order. For this reason the patent owner now requests that the documents be unsealed.

In view of the court Order and the patent owner's request, it is directed by way of this decision, that the documents be unsealed. The documents are to again be available to the public in accordance with 37 CFR 1.11(d).

## REQUESTER THOMSON'S ADDRESS

The patent owner's communications were served on requester Thomson at the following address:

A. J. Usher, IV
BOSE MCKINNEY & EVANS LLP
2700 First Indiana Plaza
Indianapolis, IN 46204

The address of record is:

Arthur J. Usher, IV
WOODARD EMHARDT NAUGHTON MORIARTY & MCNETT LLP
Bank One Center/Tower
111 Monument Circle, Suite 3700
Indianapolis, IN 46204-51387

The instant decision is being mailed to both the address of record and the address at which requester Thomson was served.

The patent owner is directed to take any needed steps to ensure that the copies of the patent owner papers identified above are, or have been, served on the requester.

Requester Thomson is directed to file an appropriate change of address, if the address of record is no longer correct.

## CONCLUSION

1. The petition under 37 CFR 1.182 is dismissed.

2. The patent owner's showing of cause to unseal the documents temporarily placed under seal in accordance with the decision of October 21, 2005, is found to be sufficient; accordingly the documents will be unsealed.

3. This decision is a final agency action within the meaning of 5 U.S.C. § 704.

4. Jurisdiction over the instant reexamination proceeding is being returned to Technology Center 2600. The Technology Center is directed to unseal the information disclosure statement filed August 22, 2005, by the patent owner, prior to taking any other appropriate action.

5. Telephone inquiries related to this decision should be directed to Kathleen Kahler Fonda, Legal Advisor, at (571) 272-7754, or in her absence, to the undersigned, at (571) 272-7710.

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

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March 29, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Second Third Party Requester)

DECISION DISMISSING PETITION TO EXCERCISE SUPERVISORY AUTHORITY
37 CFR § 1.181 (a)(3)

*In re* John C. Harvey
*Ex Parte* Reexamination Proceeding
Control No. 90/006,563
Filed: March 14, 2003
For: US Patent No. 5,335,277

*In re* John C. Harvey
*Ex Parte* Reexamination Proceeding
Control No. 90/006,698
Filed: July 7, 2003
For: US Patent No. 5,335,277

This is a decision on the patent owner's petition dated 9 February 2006, titled PETITION TO EXERCISE SUPERVISORY AUTHORITY UNDER 37 CFR § 1.181 (a)(3)

## REVIEW OF FACTS

1. U. S. Patent No. 5,335,277 issued on August 2, 1994.

2. Requests were filed by third party requesters for reexamination of US Patent No. 5,233,654 on March 14, 2003 and July 7, 2003.

3. The proceedings were merged on December 3, 2004.

4. A non-final Office action was mailed on May 31, 2005.

5. The patent owner response was received on August 1, 2005.

## DISCUSSION REGARDING EXERCISING SUPERVISORY AUTHORITY

**§ 1.181 Petition to the Director.**

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances.

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

After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office.

**MPEP 2209 Ex Parte Reexamination**

The intent of the reexamination procedures covered in this chapter include the following:

(A) To provide procedures for reexamination of patents;

(B) To implement reexamination in an essentially ex parte manner;
(C) To minimize the processing costs and complexities of reexamination;
(D) To maximize respect for the reexamined patent;
(E) To provide procedures for prompt and timely determinations by the Office in accordance with the "special dispatch " requirements of 35 U.S.C. 305.

## DECISION EXERCISING SUPERVISORY AUTHORITY

The patent owner requests that the supervisory authority establish a schedule for completion of this proceeding, declare the current rejections final, and alternatively that the examiner assigned instant proceeding be removed from the proceeding.

The Office makes every effort to provide procedures for prompt and timely determinations in accordance with "special dispatch" requirements. Each proceeding must be evaluated on a proceeding-by-proceeding basis with consideration to the number of claims, complexity of the prior art and technology of the instant proceeding. Each prior art submission, which fully complies with the requirements of citation must be considered to the extent appropriate to the fact situation. Each proceeding is thus handled with "special dispatch" according to the fact basis before the Office.

The patent owner requests that the present proceeding establish a schedule for completion. It is noted that on balance the patent owner has not provided sufficient evidence that the examiner responsible for this proceeding has not made every effort to address each issue raised in the request for reexamination, while considering the prior art fully and preparing appropriate response to each paper received in the instant proceeding. Further it is noted that the proceedings are complex and to respond appropriately requires that the examiner fully develop each issue so that the public record is thorough and complete.

The petitioner proffers no convincing reason, nor is it apparent, which would cause the Office to alter its normal work assignment procedure for reexamination proceedings. There is no evidence proffered which would indicate arbitrary or capricious treatment and/or abusive conduct buy the examiner. Accordingly the petition is **denied**. The reexamination proceeding is being forwarded to the examiner for appropriate action.

The patent owner alleges "that Examiner David Harvey be removed from the present reexamination proceeding and that the Director reassign this reexamination to a new, objective, unbiased, and competent examiner who is not committed to systematically delaying all matters respecting PMC's patents and pending applications." The patent owner is reminded that derogatory remarks regarding the examiner are in appropriate in correspondence to the USPTO. The patent owner papers provide highly negative remarks with respect to Office employees. The patent owner is reminded that derogatory remarks made in the proceeding regarding the examiner are inappropriate.

Pursuant to 37 CFR 1.3:

> "Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy. Papers

presented in violation of this requirement will be submitted to the Director and will not be entered. A notice of the non-entry of the paper will be provided. Complaints against examiners and other employees must be made in correspondence separate from other papers."

## CONCLUSION

1. By way of instant decision, the Petition to Exercise Supervisory Authority is hereby **denied.**

2. No response is required on the part of the Patent Owner.

3. Jurisdiction over the reexamination proceeding is being returned to the examiner for further handling and examination consistent with this decision.

4. 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

5. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, Special Program Examiner in the Central Reexamination Unit, Art Unit 3992, at (571) 272-1611

MReinhart
SPRE CRU 3992
for

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

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COMMISSIONER FOR PATENTS
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Paper No. 9

Pillsbury Winthrop, LLP
P.O. Box 10500
McLean, VA 22102

(For Patent Owner)

John F. Gallagher
Dilworth & Barrese LLP
333 Earle Ovington Blvd
Uniondale, NY 11553

(For Third Party Requester)

MAILED

SEP 13 2004

REEXAM UNIT

In re Ritchie et al. :
*Ex parte* Reexamination Proceeding : DECISION DISMISSING
Control No. 90/006,566 : PETITION
Filed: March 14, 2003 :
For: U.S. Patent No. 6,371,503 :

This is a decision on the March 22, 2004, patent owner petition requesting that a reference submitted after the issuance of the Notice of Intent to Issue a Reexamination Certificate (NIRC) be considered prior to the issuance of the reexamination certificate. The petition is before the Office of Patent Legal Administration.

The petition is dismissed for the reasons set forth below.

[redacted]

## DECISION

A review of the record shows that the examiner terminated prosecution on the merits and issued an NIRC on December 10, 2003. The file was forwarded to the Office of Publications on January 16, 2004, for issuance of the reexamination certificate. The certificate issued on April 20, 2004.

On March 22, 2004, (three months after the NIRC and four weeks prior to the publication of the certificate) patent owner filed the present petition to have the publication of the certificate delayed and have the examiner consider the submitted reference. The petition, however, was not matched to the reexamination file until after the certificate had issued. Accordingly, the petition is dismissed as moot.

It is noted for the record, however, that had the petition been timely considered it would have been dismissed because it was filed very late in the examination of the reexamination, and further because patent owner states that "no admission is made that this reference qualifies as prior art." It would not have been appropriate to withdraw the reexamination from the printing cycle for consideration of material which may not be prior art.

## CONCLUSION

1. The patent owner petition filed March 22, 2004, is **dismissed**.

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

Gerald A. Dost
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner for Patent Examination Policy



[redacted]

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1/19/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

John M. Bradshaw

Woodward Emhardt Naughton Moriarty & McNett L

111 Monument Circle, Suite 3700

Indianapolis, IN 46204

# *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/006567

PATENT NO. 6,223,548

ART UNI 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 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

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. |
|---|---|---|---|---|
| 90/006,567 | 03/20/2003 | 6223548 | 3470-2 | 4568 |

54487 7590 01/19/2007

JONES & SMITH, LLP
THE RIVIANA BUILDING
2777 ALLEN PARKWAY, SUITE 800
HOUSTON, TX 77019-2141

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 01/19/2007

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
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Alexandria, VA 22313-1450
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JOHN WILSON JONES
JONES & SMITH, LLP
THE RIVIANA BUILDING
2777 ALLEN PARKWAY, SUITE 800
HOUSTON, TX 77019-2141

(For Patent Owner)

MAILED

JAN 19 2007

CENTRAL REEXAMINATION UNIT

JOHN M. BRADSHAW, ESQ.
WOODARD, EMHARDT, NAUGHTON,
MORIARTY & MCNETT
111 MONUMENT CIRCLE, SUITE 3700
INDIANAPOLIS, INDIANA 46204-5137

(For Third Party Requester)

In re Reexamination Proceeding :
Phillip Calvert :
Control No. 90/006,567 : DECISION GRANTING PETITION
Filed: March 20, 2003 :
U.S. Patent No. 6,223,5448 :
Attorney Docket No. 016672-00173 :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on January 3, 2007, for entry of late papers based upon unintentional delay.

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

37 CFR 1.137(b) states:

> *"Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by: (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in § 1.17(m); (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section."

The present petition under 37 CFR 1.137(b) includes, inter alia, the requisite response (item 1), 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.

The petition for entry of the late papers is granted.

Jurisdiction over the reexamination proceeding is being returned to Central Reexamination Unit (CRU) Art Unit 3993 for further examination and consideration of the response filed January 3, 2007, along with the present petition, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Jeffrey Jastrzab, in CRU Art Unit 3993, who can be reached at 571-272-4947.

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

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ALEXANDRIA, VA 22313-1450
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Paper No. 8

M. Paul Barker (For Patent Owner)
Finnegan, Henderson, Farabow,
Garrett & Dunner LLP
1300 I Street, Nw
Washington DC 20005

MAILED
JAN 30 2004
REEXAM UNIT

Enclosures: (1) Patent Owner Opposition to petition filed on August 6, 2003.
(2) Copy of third party submitter petition filed by patent owner on August 18, 2003.

KATE H. MURASHIGE, (For Third Party Requester)
Morrison & Foerster, LLP
3811 Valley Centre Drive
Suite 500
San Diego, CA 92130

John P. Pegram (For Third Party **Submitter**)
Fish & Richardson PC
45 Rockefeller Plaza
Suite 2800
New York, NY 10111

In re Sorge et al :
Reexamination Proceeding : DECISION
Control No. 90/006,571 : RETURNING
Filed: March 20, 2003 : PETITION
For: U.S. Patent No. 5,556,772 :

This is a decision on the third party petition under 37 CFR 1.181 - 1.182, titled REQUEST BY TAKARA BIO INC. FOR LEAVE TO PARTICIPATE IN THIS REEXAMINATION AS A PARTIAL ASSIGNEE (CO-OWNER). A copy of the petition was filed by patent owner on August 18, 2003, and the petition was stated by the patent owner to have been filed with the Office on July 18, 2003. The patent owner filed a paper in opposition to the petition on August 6, 2003.

Pursuant to 37 CFR 1.17(h), a petition fee of $130.00 is required for a petition under 37 CFR 1.182 and/or 37 CFR 1.183. The required petition fee of $130.00 has been charged to Deposit Account No. 06-1050 for the petition under 37 CFR 1.182 and 37 CFR 1.183, as authorized in the third paragraph of the petition.

The petition and opposition are before the Office of Patent Legal Administration for decision.

The petition is dismissed.

The petition and opposition are being returned to the patent owner for the reasons set forth below.

Control No. 90/006,571

**REVIEW OF FACTS**

1. U.S. Patent No. 5,556,772 (the '772 patent), issued to Joseph A. Sorge and Rebecca L. Mullinax, on September 17, 1996.

2. A request for reexamination of the '772 patent was filed by a third party requester on March 20, 2003, and was assigned reexamination Control No. 90/006,571 ('571 proceeding).

3. Reexamination was ordered May 22, 2003, for the '571 reexamination proceeding.

4. On August 6, 2003, the patent owner filed an opposition in response to a petition by a third party that was not the requester, i.e., Takara Bio Inc. (Takara). The file records for the present reexamination did not, however, indicate that the original submission by third party submitter Takara was ever received by the Office. Counsel for the patent owner was contacted by Special Program Examiner William Dixon of Technology Center 1600, and informed of this.

5. Accordingly, on August 18, 2003, the patent owner filed a copy of the Takara petition. Patent owner states this petition to have been filed by Takara with the Office on July 18, 2003. The petition requests that (Takara) be granted leave to participate in this reexamination as a partial assignee (co-owner) of the '772 patent. The petition contains a showing and documentation directed to a request that (1) Dr. Wayne M. Barnes be added as an inventor of the '772 patent, and (2) Takara be recognized as a partial assignee of the patent by virtue of Dr. Barnes' assignment of patent rights to Takara. Among the other papers attached to the petition are a "Response to Order Granting Reexamination..." by Takara.

**DECISION ON PETITION**

Takara Bio Inc. (Takara) requests participation rights in this reexamination proceeding as a partial assignee (co-owner) of the '772 patent. This request is grounded on an assignment to Takara of the rights in the '772 patent of Wayne M. Barnes. Takara states that Dr. Barnes is an inventor of the '772 patent, and seeks to have Dr. Barnes added as an inventor based upon the materials attached to the petition. Takara has not, however, satisfied the requirements for adding Dr. Barnes as an inventor, as will be discussed below. Thus, Takara does not have an ownership interest in the '772 patent, and the petition must accordingly be dismissed.

The petition is incomplete as follows:

Initially it is to be noted that there is no provision in the reexamination statute for changing the inventorship of a patent. Rather, such a correction of the patent is permitted during a reexamination proceeding by virtue of the first paragraph of 35 U.S.C. 256 which states:

> "Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his part, the Director may, **on application of all the parties and assignees**, with proof of the facts and such other requirements as may be imposed, issue a certificate correcting such error." [Emphasis added]

This statutory provision is implemented via 37 CFR 1.530(l), titled "Correction of inventorship in an *ex parte* or *inter partes* reexamination proceeding." 37 CFR 1.530(l) states as follows:

> "(1) When it appears in a patent being reexamined that the correct inventor or inventors were not named through error without deceptive intention on the part of the actual inventor or inventors, the Commissioner may, **on petition of all the parties set forth in § 1.324(b)(1)-(3), including the assignees,** and satisfactory proof of the facts and payment of the fee set forth in § 1.20(b), or on order of a court before which such matter is called in question, include in the reexamination certificate to be issued under § 1.570 or § 1.977 an amendment naming only the actual inventor or inventors. **The petition must be submitted as part of the reexamination proceeding and must satisfy the requirements of § 1.324.**" [Emphasis added]

Pursuant to 37 CFR 1.324:

> "(a) Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued **patent** and such error arose without any deceptive intention on his or her part, the Commissioner may, on petition, or on order of a court before which such matter is called in question, issue a certificate naming only the actual inventor or inventors. A petition to correct inventorship of a patent involved in an interference must comply with the requirements of this section and must be accompanied by a motion under § 1.634.
>
> "(b) Any petition pursuant to paragraph (a) of this section must be accompanied by:
>
> (1) *****
>
> (2) A statement **from the current named inventors who have not submitted a statement under paragraph (b)(1)** of this section **either agreeing to the change of inventorship or stating that they have no disagreement in regard to the requested change;**
>
> (3) **A statement from all assignees of the parties submitting a statement under paragraphs (b)(1) and (b)(2)** of this section agreeing to the change of inventorship in the patent, which statement must comply with the requirements of § 3.73(b) of this chapter; and
>
> (4) *****."
>
> [Emphasis added]

In the present instance, the Takara petition is not a petition of "all the parties....including the assignees." The petition fails to supply a "statement from the current named inventors who have not submitted a statement under paragraph (b)(1)" of 37 CFR 1.324 either agreeing to the change of inventorship or stating that they have no disagreement in regard to the requested change." In addition, it fails to supply a "statement from all assignees of the parties submitting a statement under paragraph[s] ... (b)(2) of" 37 CFR 1.324.

The Takara petition is thus incomplete as to satisfying the requirements for a correction of inventorship, and it is dismissed as such.

**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."

Further, under 37 CFR 1.550(g):

> "[N]o submissions on behalf of **any third parties** will be acknowledged or considered unless such submissions are:
>
> (1) in accordance with § 1.510 or § 1.535; or
> (2) entered in the patent file prior to the date of the order for *ex parte* reexamination pursuant to § 1.525."
>
> [Emphasis added]

The present petition is submitted by a third party, Takara, which is not the third party requester, and it has been filed prior to the start of the examination on the merits. The Takara petition is not a statement by the patent owner under 37 CFR 1.530 (Takara has not been established as the patent owner; see the above discussion), nor is it a reply by the third party requester under 37 CFR 1.535 (Takara is not the requester of the reexamination). In addition, the petition paper inappropriately includes argument and discussion going

to the merits of the '772 patent, as for example, page 4 the attached "Response to Order Granting Reexamination..." which requests the Examiner to "reexamine the claims of the '772 patent with respect to the '149 patent" in light of Takara's insight as to a declaration offered by the inventors, and Dr. Barns' assertion of inventorship. Finally, the petition is not a request for reexamination under 37 CFR 1.510, nor was it entered in the patent file prior to the date of the order for *ex parte* reexamination pursuant to 37 CFR 1.525.

Accordingly, the petition is an improper submission under §§ 1.540 and 1.550(g), and the petition will not be made of record in the reexamination file.

As to the opposition filed by the patent owner, it too is not a statement by the patent owner under 37 CFR 1.530, nor is it a reply by the third party requester under 37 CFR 1.535. Further, the return of the petition makes the opposition moot.

Accordingly, the opposition paper is an improper submission under § 1.540, and it will not be made of record in the reexamination file.

The petition and opposition papers are being returned to the patent owner, because it was the patent owner who submitted both papers to the Office. As pointed out above, the file records do not indicate that the original submission by third party submitter Takara was ever received by the Office.

This decision will be made of record in the file.

It is to be noted that the petition has been addressed to the extent set forth above (despite the fact that the file records do not indicate receipt of original petition submission) in order to save the third party submitter the trouble of submitting another copy of the original petition, only to have it returned.

**CONCLUSION**

1. The petition is dismissed.

2. The petition and opposition papers submitted to the Office on August 18, 2003, and August 6, 2003, respectively, are being returned to the patent owner with the instant decision.

3. This decision will be made of record in the reexamination file.

4. The reexamination file is being forwarded to Technology Center 1600.

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

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

January 29, 2004
C:\kiva\kenpet5\6571assgnee.wpd

Application/Control Number: 90/006,571

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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Paper No. 14
Mailed: August 19, 2004

FINNEGAN HENDERSON FARABOW
GARRETT & DUNNER LLP
1300 I STREET NW
WASHINGTON DC 20005

: FOR PATENT OWNER

KATE H. MURASHIGE
MORRISON & FOERSTER, LLP
3811 VALLEY CENTRE DRIVE
SUITE 500
SAN DIEGO, CA 92130

: FOR THRID PARTY REQUESTER

In re Sorge
Reexamination Proceeding
Control No.: 90/006,571
Filed: March 20, 2003
For: U.S.Patent No. 5,556,772

In re Sorge
Reexamination Proceeding
Control No.: 90/007.004
Filed: April 9, 2004
For: U.S.Patent No. 5,556,772

: DECISION MERGING
: REEXAMINATION
: PROCEEDINGS

The above noted reexamination files are before the director of Technology Center 1600 for consideration of merger of the proceedings under 37 CFR 1.656(c).

BACKGROUND

1. Patent No. 5,556,772 issued September 17, 1996.

2. A first request for reexamination, Control No. 90/006,571, was filed by third party requester on March 20, 2003.

3. Reexamination was ordered in the '571 reexamination proceeding on May 22, 2003.

4. A second request for reexamination, Control No. 90/007,004, was filed by third party Requester on April 9, 2004.

5. Reexamination was ordered in the '004 reexamination proceeding on May 28, 2004.

6. Patent Owner did not file a Patent Owner statement, in the '004 proceeding.

DISCUSSION

Under 37 CFR 1.565(c):

> If reexamination is ordered while a prior reexamination proceeding is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under 37 CFR 1.570.

As noted in the above review of facts, reexamination has been ordered in both of the 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 '571 and '004 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 '004 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 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. 90/006,571 and 90/007,004 are merged.

The files will be forwarded to the examiner for further action thereon.

Jasemine C. Chambers
Director, Technology Center 1600

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Finnegan Henderson Farabow
Garrett & Dunner LLP
1300 I Street NW
Washington, DC 20005

(For Patent Owner)

MAILED

DEC 22 2005

REEXAM UNIT

Kate H. Murashige, Esq.
Morrison & Foerster LLP
3811 Valley Centre Drive
Suite 500
San Diego, CA 92130

(For Third Party Requester)

Enclosure: Third Party Requester's October 18, 2005 petition.

In re Sorge *et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/006,571
Filed: March 20, 2003
For: U.S. Patent No. 5,556,772

In re Sorge *et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/007,004
Filed: April 9, 2004
For: U.S. Patent No. 5,556,772

**DECISION DISMISSING AND RETURNING PETITION**

This is a decision on the October 18, 2005 third party requester petition entitled "PETITION UNDER 37 CFR 1.181(a)(3) TO THE DIRECTOR IN PERSON REQUESTING WITHDRAWAL OF IMPROPER NOTICE OF INTENT TO ISSUE REEXAMINATION CERTIFICATE." The third party requester petitions for review of the Primary Examiner's September 26, 2005 Notice of Intent to Issue *Ex Parte* Reexamination Certificate which held that patent claims 1-13 are patentable, as amended. [1]

The petition is before the Office of Patent Legal Administration for consideration. Petitioner's request that the Director of the United States Patent and Trademark Office personally intervene and decide this matter is dismissed. A party to a proceeding in the Patent and Trademark Office has a right to petition, and may expect to receive a decision by either the Office official delegated authority to render the decision, or the delegating official. [2] While a higher level official, at the request of a party, may further review a decision rendered pursuant to delegated

[1] A review of the record shows that while patent claim 1 was amended and patent claims 2 and 8-13 dependent from claim 1 are therefore also amended, patent claims 3-7 are confirmed as patentable without amendment.
[2] See *In re Arnott*, 19 USPQ2d 1049, 1052 (Comm'r Pat. 1991).

authority, such review is a matter that lies within the sound discretion of that higher level official, and is not a matter of right. [3] Although the petition is addressed to the Director of the United States Patent and Trademark Office in person, inasmuch as the authority for deciding petitions requesting withdrawal of allegedly improper papers in reexamination proceedings has been delegated to the Office of Patent Legal Administration, [4] and as there has been no prior decision on a petition requesting the relief requested by the instant petition, the decision will be rendered by the official having delegated authority.

The petition is returned to the requester, without consideration on its merits, for the reasons set forth below.

## REVIEW OF SALIENT FACTS

1. U.S Patent number 5,556,772 (hereafter the '772 patent) issued to Sorge *et al* on November 13, 2001, from an application filed on February 16, 1994.

2. On March 23, 2003, a request for ex *parte* reexamination of the '772 patent was filed in the Office by a third party requester, resulting in reexamination proceeding control number 90/006,571 (hereinafter the '571 reexamination proceeding).

3. On May 22, 2003, the Office issued an order in the '571 reexamination proceeding, granting the request for *ex parte* reexamination of the '772 patent.

4. On April 9, 2004, a second request for ex parte reexamination of the '772 patent was filed in the Office by the same third party requester. The second request resulted in reexamination proceeding control number 90/007,004 (hereinafter the '004 reexamination proceeding). [5]

5. Patent owner did not file a patent owner's statement pursuant to 37 CFR 1.530 in either of the '571 or '004 reexamination proceedings.

6. On August 19, 2004, the Office issued a decision merging the '571 and '004 *ex parte* reexamination proceedings into a combined merged proceeding. The decision provided, *inter alia,* that the specification and claims were to be maintained as identical in each of the '571 and '004 files. [6]

7. **A Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) was mailed for the merged proceeding on September 26, 2005. The mailing of the NIRC terminated prosecution in the merged proceeding.** [7,8]

## DECISION

I. Relevant Statutory and Regulatory Provisions

---

[3] *Id.*

[4] See MPEP § 1002.02(b)(3).

[5] It is noted that in a footnote on page 1 of the present petition, the third party requester incorrectly identifies the second reexamination proceeding as reexamination control number 90/007,904.

[6] It is noted that third party requester has apparently not filed a copy of the present petition directed to the '004 reexamination file.

[7] A copy of the NIRC does not appear in the Image File Wrapper (IFW) of either the '571 or the'004 reexamination proceeding. A copy of the NIRC has been obtained from both the patent owner and the third party requester and will be entered into each the IFW for each proceeding.

[8] The record shows that on September 28, 2005, patent owner filed a notice of appeal in the merged proceedings. The Notice of appeal is without effect inasmuch as prosecution was terminated by the NIRC mailed on September 26, 2005.

**35 U.S.C. 304 states:**

> If, in a determination made under the provisions of subsection 303(a) of this title, the Director finds that a substantial new question of patentability affecting any claim of a patent is raised, the determination will include an order for reexamination of the patent for resolution of the question. The patent owner will be given a reasonable period, not less than two months from the date a copy of the determination is given or mailed to him, within which he may file a statement on such question, including any amendment to his patent and new claim or claims he may wish to propose, for consideration in the reexamination. If the patent owner files such a statement, he promptly will serve a copy of it on the person who has requested reexamination under the provisions of section 302 of this title. Within a period of two months from the date of service, that person may file and have considered in the reexamination a reply to any statement filed by the patent owner. That person promptly will serve on the patent owner a copy of any reply filed.

**37 CFR 1.530(b) states:**

> The order for *ex parte* reexamination will set a period of not less than two months from the date of the order within which the patent owner may file a statement on the new question of patentability, including any proposed amendments the patent owner wishes to make.

**37 CFR 1.535 states:**

> A reply to the patent owner's statement under § 1.530 may be filed by the *ex parte* reexamination requester within two months from the date of service of the patent owner's statement. Any reply by the *ex parte* requester must be served upon the patent owner in accordance with § 1.248. **If the patent owner does not file a statement under § 1.530, no reply or other submission from the *ex parte* reexamination requester will be considered.** (Emphasis added.)

**37 CFR 1.550(g) states**

> 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.

**MPEP § 2251 [9] provides, in pertinent part, that:**

> The third party requester is not permitted to file any further papers after his or her reply to the patent owner's statement. **Any further papers will not be considered and will be returned to the requester.** (Emphasis added.)

II. Findings and Analysis

[9] MPEP § 2251 is based on, and cites, 37 CFR 1.535

The record shows that the '571 and '004 reexamination proceedings were merged into a single proceeding on August 19, 2004, well after the expiration of the period for filing a patent owner's statement in either of the '571 or the '004 reexamination proceedings. The record also shows that no patent owner's statement was filed in either the '571 reexamination proceeding or the '004 reexamination proceeding. It is clear from a plain reading of 35 U.S.C. § 304 and 37 CFR 1.535, last sentence, that in the absence of the filing of a patent owner's statement under 37 CFR 1.530, a third party requester is not entitled to consideration of a reply under 37 CFR 1.535 or any other submission in the merged reexamination proceeding. The record confirms that no third party requester reply was in fact filed in this instance.

It is clear from a consideration of 37 CFR 1.550(g) that any submission on behalf of the third party requester that is filed subsequent to the 37 CFR 1.535 period for filing a reply to a patent owner statement under 37 CFR 1.530 (if patent owner had in fact filed a patent owner's statement) will not be acknowledged or considered. It follows that the present petition requesting withdrawal of the NIRC mailed on September 26, 2005 does not enjoy an entry right. Therefore, the present petition will not be entered into the record in the merged reexamination proceeding.

Stated another way, the present petition submitted by third party requester was filed after the examination on the merits had started, i.e., after the period for active participation of the third party requester had ended. The petition is not a request for reexamination in compliance with the requirements of 37 CFR 1.510, and it is not a reply pursuant to 37 CFR 1.535. Nor does the petition qualify as a prior art statement under 37 CFR 1.501 (the petition is directed to activity in the present merged proceeding. Accordingly, pursuant to 37 CFR 1.550(g), the petition does not have an entry right and is not considered.

MPEP § 2267, 8th Ed., rev. 4 (October 2005) provides, at page 2200-108, that third party requester submissions that do not enjoy an entry right due to the provisions of 37 CFR 1.550(g) will be *returned* to the third party requester without consideration thereof on the merits. Accordingly, the third party requester of October 18, 2005 is being returned to the third party requester. The present decision will, however, be made of record in the file history.

## CONCLUSION

1. The third party requester petition filed on October 18, 2005, requesting withdrawal of the NIRC mailed on September 26, 2005, including all exhibits attached thereto, is being returned to the third party requester without consideration on the merits.

2. A copy of this decision is being made of record in the merged reexamination proceeding, and the decision will therefore appear in the IFW file history of *ex parte* reexamination proceeding 90/006,571 and in the IFW file history of *ex parte* reexamination proceeding 90/007,004.

3. Telephone inquiries with regard to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or, in his absence, to the undersigned at (571) 272-7710.

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

sm
December 16, 2005

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(For Patent Owner)

Enclosure: Third Party Requester's January 4, 2006 petition.

Kate H. Murashige, Esq.
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(For Third Party Requester)

Enclosure: Third Party Requester's January 4, 2006 petition.

MAILED

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REEXAM UNIT

In re Sorge *et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/006,571
Filed: March 20, 2003
For: U.S. Patent No. 5,556,772

**DECISION DISMISSING AND RETURNING PETITION**

In re Sorge *et al*
*Ex Parte* Reexamination Proceeding
Control No. : 90/007,004
Filed: April 9, 2004
For: U.S. Patent No. 5,556,772

This is a decision on the January 4, 2006 third party requester petition under 37 CFR 1.183, entitled "RENEWED PETITION UNDER 37 CFR § 1.183 REQUESTING WITHDRAWAL OF IMPROPER NOTICE OF INTENT TO ISSUE REEXAMINATION CERTIFICATE."

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 03-1952 pursuant to the authorization for same in the last paragraph of the petition and in the transmittal form.

The petition is dismissed and returned for the reasons set forth below.

## DECISION ON PETITION

**1. Deciding Official:**

In addition to the request for withdrawal of the Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) issued for the proceeding, it is also requested that the petition be decided by the Director of the USPTO in person. Although the petition is addressed to the Director of the USPTO in person, the authority for deciding petitions under 37 CFR 1.183 relating to reexamination proceedings has been delegated to the Office of the Deputy Commissioner for Patent Examination Policy. [1] Accordingly, the term "in person" is treated as a request for review of the present petition under 37 CFR 1.183 by the Office of the Deputy Commissioner for Patent Examination Policy. It is to be noted that, although the petition is styled as a renewed petition under 37 CFR 1.183, the third party requester's previous petition was filed pursuant to 37 CFR 1.81, and this is the *first* petition submitted under 37 CFR 1.183. Accordingly, the decision on the present petition is rendered by the Senior Legal Advisor of the Office of the Deputy Commissioner for Patent Examination Policy.

**2. Dismissal of the 37 CFR 1.183 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. Thus, 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:

> "In the interests of justice and in order to avoid a violation of administrative law, Invitrogen now requests that the rules be suspended and that the merits of the previous petition be considered."

This request for waiver of the rules will now be addressed.

---

[1] Pursuant to MPEP § 1002.02(b), part 20, "[p]etitions relating to reexamination proceedings and/or reissue proceedings under 37 CFR 1.182 and 1.183" are delegated to the Office of the Deputy Commissioner for Patent Examination Policy.

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)." [Emphasis added.]

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 petition which contains a discussion of an alleged procedural error at pages 2-3 of the petition. The discussion addresses the application of certain regulations governing the examiner's treatment of the art and issuance of the NIRC. Such is directed to the issues and 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.

**3. Return of Paper:**

Two copies of the petition paper have been submitted, as the petition relates to a merged proceeding. Based upon the above, the present third party requester petition of January 4, 2006, is an improper submission under 37 CFR 1.550(g), and both copies would ordinarily be returned to the third party requester. However, based on the absence of "proof of service" discussed in the next section, one of the two copies is being returned to the requester, while the second copy of the petition paper is being forwarded to the patent owner with this decision. Any copy of the petition papers appearing in the electronic Image File Wrapper for the present reexamination proceeding will be closed by the Central Reexamination Unit. A copy of this decision will, however, be placed in the file.

**4. 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 it was accompanied by copies of the original 37 CFR 1.181 petition filed on October 18, 2005 and the attachments to that petition consisting of the NIRC mailed September 26, 2005 and various prosecution papers of record in this merged reexamination proceeding. However, the requisite proof of service (of the instant petition) by the third party requester on the patent owner 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.

Accordingly, the copy of the petition submitted by the requester is being forwarded to the patent owner together with all attachments thereto. Any future communications filed by the third party requester in the present reexamination proceeding must include proof of service on the patent owner pursuant to 37 CFR 1.550(f).

## CONCLUSION

1. The third party requester's petition under 37 CFR 1.183 filed January 6, 2005, is dismissed.

2. The petition filed January 6, 2005, does not have an entry right for the reasons discussed above. One of the copies of the petition filed by the requester is being returned to the requester, while the second copy is being forwarded to the patent owner, in view of the absence of proof of service on the patent owner. A copy of the transmittal form is being retained, to retain the authorization to charge the petition fee.

3. No copy of the petition papers filed January 6, 2005 will be maintained in the electronic Image File Wrapper. Any copy of the renewed petition papers inadvertently added to the electronic Image File Wrapper for the present proceeding will be closed by the Central Reexamination Unit (CRU) and marked "non-public."

4. A copy of this decision will be made of record in the reexamination file.

5. Telephone inquiries related to the present decision should be directed to the Stephen Marcus, Legal Advisor, at 571-272-7743, or, in his absence, 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

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January 23, 2006

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CENTRAL REEXAMINATION UNIT

In re Stratagene California
*Ex Parte* Reexamination Proceeding
Control No.: 90/006,571
Filed: March 20, 2003
For: U.S. Patent No. 5,556,772

In re Stratagene California
*Ex Parte* Reexamination Proceeding
Control No.: 90/007,004
Filed: April 9, 2004
For: U.S. Patent No. 5,556,772

**DECISION DISMISSING AND RETURNING PETITION**

This is a decision on the September 8, 2006 third party requester petition entitled "PETITION UNDER 37 CFR §§ 1.181 AND 1.183 REQUESTING WITHDRAWAL OF IMPROPER NOTICE OF INTENT TO ISSUE REEXAMINATION CERTIFICATE."

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

The petition is dismissed and is being "returned" to the third party requester for the reasons set forth below.

**FEES**

No fee is required for a petition under 37 CFR 1.181. For the petition under 37 CFR 1.183, a single petition fee of $400.00 has been charged to Deposit Account No. 03-1952 as authorized in the present petition.

## REVIEW OF SALIENT FACTS

1. U.S. Patent No. 5,556,772 (the '772 patent) issued on September 17, 1996.

2. A first request for *ex parte* reexamination of the '772 patent was filed by a third party requester on March 20, 2003, and was assigned Control No. 90/006,571 (the '571 reexamination proceeding).

3. Reexamination was ordered in the '571 reexamination proceeding on May 22, 2003.

4. A second request for *ex parte* reexamination of the '772 patent was filed by the same third party requester on April 9, 2004, and was assigned control number 90/007,004 (the '004 reexamination proceeding).

5. Reexamination was ordered in the '004 reexamination proceeding on May 28, 2004.

6. Patent owner did not file a patent owner's statement under 37 CFR 1.530 in either the '571 reexamination proceeding or the '004 reexamination proceeding.

7. On August 19, 2004, the '571 and '004 reexamination proceedings were merged into a single combined proceeding (the merged proceeding) by decision of the Technology Center Director having jurisdiction over both proceedings, acting pursuant to 37 CFR 1.565(c).

8. Examination of the merged proceeding in accordance with 37 CFR 1.550(a) commenced on December 20, 2004 with the mailing of a non-final Office action in the merged proceeding.

9. On February 22, 2005, patent owner filed a response to the December 20, 2004 non-final Office action.

10. On March 28, 2005, a final rejection was mailed in the merged proceeding.

11. A Notice of Intent to Issue Reexamination Certificate (NIRC) was mailed on September 26, 2005.

12. On March 23, 2006, a non-final Office action was mailed, in which action it was stated that the September 26, 2005 NIRC was withdrawn.

13. On May 23, 2006, patent owner filed a response to the March 23, 2006 non-final Office action.

14. On July 20, 2006, a new NIRC was mailed.

15. The present third party requester petition was filed on September 8, 2006.

## DECISION ON PETITION

### I. Statutes, Regulations and Practice

35 U.S.C. § 303(a) provides, in pertinent part:

> "Within 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. § 304 provides:

> "If, in a determination made under the provisions of subsection 303(a) of this title, the Director finds that a substantial new question of patentability affecting any claim of a patent is raised, the determination will include an order for reexamination of the patent for resolution of the question. The patent owner will be given a reasonable period, not less than two months from the date a copy of the determination is given or mailed to him, within which he may file a statement on such question, including any amendment to his patent and new claim or claims he may wish to propose, for consideration in the reexamination. If the patent owner files such a statement, he promptly will serve a copy of it on the person who has requested reexamination under the provisions of section 302 of this title. Within a period of two months from the date of service, that person may file and have considered in the reexamination a reply to any statement filed by the patent owner. That person promptly will serve on the patent owner a copy of any reply filed."

35 U.S.C. § 305 provides:

> "After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office."

37 CFR 1.181(a) provides, in part:

> "Petition may be taken to the Director:
> *****
> (3) To invoke the supervisory authority of the Director in appropriate circumstances."

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 1.535 provides:

> "A reply to the patent owner's statement under § 1.530 may be filed by the *ex parte* reexamination requester within two months from the date of service of the patent owner's statement. Any reply by the *ex parte* requester must be served upon the patent owner in accordance with § 1.248. If the patent owner does not file a statement under § 1.530, no reply or other submission from the *ex parte* reexamination requester will be considered."

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."

MPEP § 2267 provides in pertinent part:

> "The return of inappropriate submissions complies with the regulations that certain papers will not be considered and also reduces the amount of paper which would ultimately have to be scanned into the record.
> **I. DISPOSITION OF PAPERS**
> Where papers are filed during reexamination proceedings which are inappropriate because of some defect, such papers will either be returned to the sender or forwarded to one of three files, ...."
>
> **II. TYPES OF PAPERS RETURNED WITH DIRECTOR OF THE USPTO OR CRU/TC DIRECTOR'S APPROVAL REQUIRED**
>
> ...
>
> **Filed by Requester**
> A. No Statement Filed by Owner -
> § 1.535 If a patent owner fails to file a statement within the prescribed limit, any reply by the requester is inappropriate and will be returned and will not be considered."

## II. Findings and Analysis

### A. No Entry Right for the Paper

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. The present petition does not qualify as a prior art citation under 37 CFR 1.501.

Accordingly, the present petition does not have an entry right under the rules.

### B. Suspension of the Regulations

It is requested that, despite the absence of a rule permitting entry and consideration of the petition, the underlying relief sought should be provided by suspension of the rules pursuant to 37 CFR 1.183. Although third party requester has not identified the specific rule(s) for which suspension under 37 CFR 1.183 is sought, it is presumed that third party requester is seeking

suspension of the provisions of 37 CFR 1.535 and/or 37 CFR 1.550(g) in order to obtain entry of the present 37 CFR 1.181 petition into the record, to permit petitioner third party requester to invoke the Director's supervisory authority under 37 CFR 1.181(a)(3) in order to obtain certain relief specified in the petition. [1]

37 CFR 1.550(g) expressly states that the active participation of a third party requester in an *ex parte* reexamination proceeding ends with the filing of a reply by the third party requester under 37 CFR 1.535. [2] 37 CFR 1.535 expressly provides that if the optional patent owner's statement pursuant to 37 CFR 1.530 is not filed in an *ex parte* reexamination proceeding, no reply or other submission filed by a third party requester will be considered in that *ex parte* reexamination proceeding. Thus, the regulatory scheme is such that where a patent owner files the optional patent owner's statement provided for by 37 CFR 1.530, a third party requester may file a reply thereto pursuant to 37 CFR 1.535, but in accordance with 37 CFR 1.550(g), may not thereafter participate in the *ex parte* reexamination proceeding. If patent owner elects not to file the optional patent owner's statement provided for by 37 CFR 1.530, then 37 CFR 1.535 expressly precludes consideration of any reply or other submission that the third party requester thereafter files in the *ex parte* reexamination proceeding. Therefore, consideration of the present third party requester petition, a paper filed in an *ex parte* reexamination proceeding in which a patent owner's statement under 37 CFR 1.535 was not filed, would require waiver of 37 CFR 1.535 as well as 37 CFR 1.550(g).

C. The Statute Precludes Participation By A Third Party Requester During The Examination Phase Of An *Ex Parte* Reexamination Proceeding

It has been judicially determined in *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 882 F.2d 1570, 11 USPQ2d 1866 (Fed. Cir. 1989) that the *ex parte* reexamination statute itself precludes participation of a third party requester during the examination phase, (*i.e.*, after the period in which the parties may file comments directed to the order granting reexamination). [3] The Federal Circuit has determined that the language and intent of the *ex parte* reexamination statute are clear that in a reexamination proceeding requested under 35 U.S.C. § 302, the patentability determination and the prosecution attendant thereto must be an *ex parte* proceeding. Therefore, the Office cannot grant a waiver of the regulations that implement the statutory mandate that precludes participation by a third party requester in the patentability determination and the prosecution attendant thereto.

In *Syntex*, third party requester (Syntex) of an *ex parte* reexamination filed a petition seeking to invoke the supervisory authority of the USPTO Commissioner [4] following the issuance of a NIRC. In its petition, the third party requester alleged that it was injured because it was deprived of a properly conducted reexamination proceeding due to certain procedural irregularities. *Id*, at 1571, at 1867. The petition was returned by the Office as being an improper

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[1] See items 3-5 at pages 1 and 2 of the petition filed on September 8, 2006. See also Section III at page 8 of the petition.

[2] A third party requester's ability to file a 37 CFR 1.535 reply by is predicated on the prior filing of a patent owner's statement under 37 CFR 1.530. However, the filing of a patent owner's statement under 37 CFR 1.530 is entirely optional.

[3] See also *Boeing Co. v. Commissioner of Patents and Trademarks*, 853 F.2d 878, 871, USPQ2d 1487, 1489-1490 (Fed. Cir. 1988) ("[Third party requester] Cegedur's contentions that it has standing as a consequence of its status as the reexamination requestor (*sic*, requester) are also unpersuasive. While Cegedur had a right to file a request for reexamination under 35 U.S.C. § 302 and a contingent right to file a reply statement under 35 U.S.C. § 304, it had no right thereafter to participate in the reexamination process, 35 U.S.C. § 305."

[4] Now the USPTO Director referenced in 37 CFR 1.181(a)(3).

paper not provided for by 37 CFR 1.550(e). [5] After the Reexamination Certificate issued to the patent owner, the third party requester sought relief in the district court. On appeal from a dismissal of the third party requester's action by the district court, the U.S. Court of Appeals for the Federal Circuit affirmed the district court's decision, finding that:

> "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)." *Id.*, at 1573, at 1868-1869. [Emphasis added in bold]

The Federal Circuit also reviewed the legislative history of the *ex parte* reexamination statute, and concluded that:

> "... contrary to Syntex's view, the legislative history provides no support for Syntex's position that it has a right to challenge the reexamination decision." *Id.*, at 1574, at 1869

In the present merged reexamination proceeding, the third party requester has filed a petition in which it is alleged that the Office has reached an erroneous result on the merits, and requests that the proceeding be reopened so that the examiner can reach a different result. The petition, therefore, attempts to convert the instant merged (*ex parte*) reexamination proceeding into other than an *ex parte* proceeding, at a point in the proceeding beyond which the active participation of the requester has ended. Thus, the petition seeks to go beyond the reexamination statute. Relief cannot, therefore, be provided, either through waiver of the rules or otherwise. The Office cannot waive the *ex parte* reexamination statute.

It is stated in 37 CFR 1.183, "...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...on petition of the interested party...." [Emphasis added.] The requester seeks waiver of a rule that implements a statutory requirement, and the petition must accordingly be dismissed.

D. Disposition Of Petition Papers

Based on the above, the third party requester petition of September 8, 2006, is an improper submission under the *ex parte* reexamination statute, as well as being an improper submission under 37 CFR 1.535 and 37 CFR 1.550(g). The petition papers filed on September 8, 2006 will not be entered into the record. Inasmuch as the petition papers have been scanned into the electronic Image File Wrapper (IFW) and cannot be removed from the IFW, the petition papers will be "returned" to the third party requester by being marked "closed" and "non-public." The petition papers will not be part of the official record of the present merged *ex parte* reexamination proceeding. A copy of this decision will, however, be placed in the two files of the merged proceeding.

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[5] The language of present 37 CFR 1.550(g) was at that time embodied in 37 CFR 1.550(e), which read "The active participation of the reexamination requester ends with the reply pursuant to 37 CFR 1.535, and no further submissions on behalf the reexamination requester will be acknowledged or considered."

## CONCLUSION

1. The petition is dismissed.

2. The third party requester petition papers filed September 8, 2006, are being "returned" to the third party requester. The "return" will take the form of closing the petition papers in the IFW files of the *ex parte* reexamination proceeding and marking the petition papers as "not public." No copy of the petition papers will be maintained elsewhere in the Office.

3. A copy of this decision will be made of record in the reexamination file.

4. Telephone inquiries related to the present decision should be directed to the Stephen Marcus, Legal Advisor, at 571-272-7743, or, in his absence, to the undersigned at 571-272-7710.

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

sm
October 10, 2006

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3/28/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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## *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/006571 & 90/007,004

PATENT NO. 5,556,772

ART UNI 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/007,004 + 90/006 571 | 04/09/2004 | 5556772 | 548640000100 | 2342 |

7590 03/28/2007

| EXAMINER |
|---|

Finnegan Henderson Farabow Garrett & Dunner LLP
1300 I Street NW
Washington, DC 20005

| ART UNIT | PAPER NUMBER |
|---|---|

DATE MAILED: 03/28/2007

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Michael Albrecht
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1301 I Street NW
Washington, DC 2005

(Patent Owner)

Morrison & Foerster
Attn: Kate H. Murashige
3811 Valley Centre Drive, Suite 500
San Diego, CA 92130

(Third Party Requester)

MAILED

MAR 28 2007

CENTRAL REEXAMINATION UNIT

In re Sorge et al.
Reexamination Proceeding
Control No.: 90/006,571
Filed: March 20, 2003
For: U.S. Patent No.: 5,556,772

In re Sorge et al.
Reexamination Proceeding
Control No.: 90/007,004
Filed: April 9, 2004
For: U.S. Patent No.: 5,556,772

**DECISION ON PETITION UNDER 37 CFR 1.182**

This is a decision on the January 30, 2007 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 merged reexamination proceeding.

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

The petition is dismissed for the reasons set forth below.

**Thus, the IDS filed January 30, 2007, has not been entered for consideration by the examiner.**

## BACKGROUND

1. Patent number 5,556,772 issued on September 17, 1996.
2. A first request for reexamination, assigned control No. 90/006,571 (the '571 proceeding), was filed on March 20, 2003 by a third party requestor.
3. An order granting the '571 reexamination request was mailed May 22, 2003.
4. A second request for reexamination, assigned control No. 90/007,004 (the '004 proceeding) was filed by the same third party requestor on April 9, 2004.
5. An order granting the '004 reexamination request was mailed May 28, 2004.

6. The '571 proceeding and '004 proceeding were merged by a decision mailed August 19, 2004.

7. A Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the merged '571/'004 proceeding on July 20, 2006.

8. A Supplemental Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the merged '571/'004 proceeding on January 8, 2007, to correct the status of claims and included copies of initialed citation listings from two IDS statements.

9. The instant petition was filed on January 30, 2006, accompanied by a new IDS, which the patent owner requests the Office to consider.

10. 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 2256**

.....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 present merged 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, in an analogous manner, to requests for withdrawal of reexamination proceedings from the printing cycle. This policy is explicitly set forth in 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). **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 might be of interest to the instant examiner because of an alleged grammatical error in certain claims, as asserted by an examiner of another application. Although the alleged grammatical error is directed to a term that also appears in the claims of the instant proceeding, there is no discussion in the petition as to how this alleged grammatical error is pertinent to the patentability of the claims. Moreover, the patent owner does not provide a discussion of the substance of any of the other items of information, and has not applied the teachings of the same to the claim limitations in the present merged reexamination proceeding.

Furthermore, there is no factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier. The Office action in the '917 application was mailed on June 2, 2006. There is no factual accounting whatsoever as to why patent owner waited over 7 months to file the instant IDS. Therefore, the present petition does not satisfy the requirements for a petition submitted for consideration of an IDS after the NIRC has been mailed, even if the IDS had been submitted before the proceeding entered the publication cycle.

For *ex parte* reexamination, 35 U.S.C. 305 provides 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 provision for special dispatch, and such criteria must certainly be complied with for a reexamination proceeding *where there is a statutory mandate for special dispatch*. This is explicitly set forth in 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 July 20, 2006, and the proceeding has now entered the final stages of the publication process. The proceeding is clearly not scheduled to come up for further action on the merits. In order to provide the requested relief, the present proceeding would need to be withdrawn from the publication process, thus significantly 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 a request for reexamination. In view of the submission of the IDS information after termination of the prosecution in this reexamination proceeding, the failure to identify a question of patentability of the claims, and the failure to provide the requisite discussion (explanation) of the submitted art citations, the present merged reexamination proceeding will 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 reference(s).

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 January 30, 2007.

2. The IDS papers have not been entered for consideration by the examiner. A copy of the IDS submission will, however, be placed in the electronic file for the proceeding.

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
03/22/07

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/006,572 | 03/25/2003 | 6251537 | 1568.1061RE | 3636 |

49455 7590 07/28/2005

STEIN, MCEWEN & BUI, LLP
1400 EYE STREET, NW
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WASHINGTON, DC 20005

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|---|---|
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1400 Eye Street, NW
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Washington, DC 20005

(for Patent Owner)

In re Kim et al
Reexamination Proceeding
Control No. 90/006,572
Filed: March 25, 2003
For: U.S. Patent 6,251,537

**DECISION ON PETITION**

This is a decision on the PETITION UNDER 37 CFR 1.181 filed July 11, 2005. Petitioner requests that the Declaration under 37 CFR 1.132 filed on May 12, 2005 should be entered and considered by the examiner.

**BACKGROUND**

1. Reexamination was ordered for 90/006,572 on May 28, 2003.

2. On July 22, 2003, patent owner filed a timely patent owner's statement in which new claims 9-20 were added.

3. A non-final Office action was mailed on November 6, 2003.

4. On December 2, 2003, an interview was held in which WO 97/08762 to Moulton et al was discussed.

5. On January 5, 2004, patent owner filed a timely response to the Office action mailed on November 6, 2003. This response included amendments to the claims and a declaration under 37 CFR 1.132.

6. A final Office action was mailed on January 14, 2005.

7. On March 14, 2005, patent owner filed a timely amendment after final rejection.

8. An advisory action was mailed on March 29, 2005 indicating that the amendments filed after final rejection would not be entered.

9. On April 26, 2005, an interview was held in which a demonstration was conducted.

10. On May 9, 2005 and May 12, 2005, patent owner filed timely responses after final rejection. The response of May 9, 2005 included amendments to the claims. The response of May 12, 2005 included a declaration under 37 CFR 1.132.

11. A Notice of Appeal was filed on May 13, 2005.

12. An advisory action was mailed on May 27, 2005 indicating that the amendments after final would not be entered and that the declaration under 37 CFR 1.132 would not be entered because patent owner failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

13. On May 27, 2005 and June 13, 2005, patent owner filed a timely amendment after final rejection.

14. An advisory action was mailed on June 17, 2005 indicating that the amendment after final rejection of May 27, 2005 would not be entered, and that the amendment after final rejection of June 13, 2005 would be entered.

15. An Appeal Brief was filed on July 12, 2005.

**DISCUSSION**

Patent owner requests that the declaration submitted May 12, 2005 be entered because this declaration reflects an experiment not conducted until just prior to the Examiner Interview of April 26, 2005, wherein the declaration was provided to clarify the information and evidence presented during the interview.

It is noted that the Examiner Interview of April 26, 2005 was held after the final Office action was mailed, and after the advisory action of March 29, 2005 was mailed. MPEP 2281 specifically sets forth that the general procedure for conducting interviews is described at MPEP § 713.01- § 713.04. MPEP § 713.01, in turn, references MPEP 713.09 for interviews after final rejection. Note that MPEP 713.09 specifically states that interviews after final rejection may be granted "if the examiner is convinced that disposal or clarification for appeal may be accomplished with only nominal further consideration".

In the present petition, patent owner argues that the declaration was presented in order to clarify and explain the movies and pictures presented during the Interview of April 26, 2005, and since the interview was not conducted until April 26, 2005, it was not possible to present the evidence at an earlier time.

As noted in MPEP 713.09, an interview after final should not present issues that require more than a nominal further consideration. A review of the file shows that the evidence provided at the interview raised issues that did require more than nominal further consideration. Furthermore, MPEP 2272 specifically sets forth that 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.

Thus, since it appears that the evidence provided at the Examiner Interview of April 26, 2005 raised issues that required more than a nominal further consideration, and as the declaration submitted May 12, 2005 was the third submission after final rejection, the declaration submitted May 12, 2005 has not been entered.

The petition is **DENIED**.

This reexamination file is being forwarded to the examiner for consideration of the Appeal Brief submitted July 12, 2005.

JMStone

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

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49455 7590 03/05/2008

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(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

*In re Kim et al.*
Reexamination Proceeding
Control No.: 90/006,572
Filed: March 25, 2003
For: U.S. Patent No.: 6,251,537

DECISION ON PETITION
UNDER 37 CFR 1.181
TO INVOKE THE SUPERVISORY
AUTHORITY OF THE DIRECTOR

This is a decision on a petition filed by the patent owner on June 7, 2006[1]. The petition is entitled PETITION UNDER 37 CFR 1.181, and is a request to the Director to exercise his/her discretion pursuant to 37 CFR 1.181 and enter the reply brief filed on December 5, 2005.

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

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated June 7, 2006 is granted with respect to entering the reply brief filed on December 5, 2005.

[1] It is noted that a duplicate petition was filed on January 12, 2007. The Office regrets the delay in responding to the petitions.

## REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,251,537 (hereinafter, the '*537* patent) issued on June 26, 2001.

2. A request for e*x parte* reexamination, assigned control No. 90/006,572, was filed by patent owner, on March 25, 2003.

3. *Ex parte* reexamination was ordered for the '6,572 reexamination proceeding on May 28, 2003.

4. On November 6, 2003, a non-final Office action, which rejection all the claims (claims 1-20), was mailed in the '6,572 reexamination proceeding.

5. On December 2, 2003, a personal interview was conducted at the Office.

6. On January 5, 2004, the patent owner filed a response to the non-final Office action. Along with the response, patent owner filed a declaration under 37 CFR 1.132 by Hyung-gon Noh (hereinafter "entered declaration"), and a patent owner's summary of the interview of December 2, 2003.

7. On January 14, 2005, the Office issued a Final rejection Office action, which rejection all the claims (claims 1-142).

8. On March 3, 2005, the patent owner filed a response to the Final Office action, which was not entered because it raised issues of new matter. See the advisory action dated March 29, 2005.

9. On April 26, 2005, a second personal interview was conducted at the Office. According to the examiner's interview summary, possible amendments to claims 22, 43, and 78 and to the specification to overcome new matter objections. During the interview, several exhibits, including a computer movie showing the battery of Moulton (the prior art reference applied against the claims) and battery of the claimed invention placed in a sealing simulation, pictures showing the battery of Moulton (as manufactured by the patent owner), were shown. See the examiner's interview summary dated 4/26/2005.

10. On May 9, 2005, the patent owner filed a second after-final rejection response, and the patent owner's summary of the interview, which include attachments in

the form of exhibits A-D[2]. According to the patent owner's summary, exhibits A and B provide a copy of the pictures presented during the interview and an explanation of the method of manufacture of the battery of Moulton discussed during the interview. Exhibits C and D are the screen shots of the computer movie shown during the interview.

11. On May 12, 2005, the patent owner filed a supplemental response to the May 9, 2005 response, which included a declaration under 37 CFR 1.132 by Hyung-goh Noh (hereinafter "the unentered declaration"). This declaration provided details with respect to the movies and pictures shown in the interview of April 26, 2005, but the declaration itself was not presented during the April 26, 2005 interview.

12. On May 13, 2005, the patent owner filed a Notice of Appeal.

13. On May 27, 2005, the patent owner filed another response after-final rejection.[3]

14. Also, on May 27, 2005, the examiner mailed an advisory action indicating that the amendments of May 9, 2005 will not be entered because they raise new issues and new matter issues, and that the evidence submitted will not be entered because the patent owner failed to provide a showing of good and sufficient reasons why the evidence is necessary and was not earlier presented.

15. On June 10, 2005, a telephone interview occurred.

16. On June 13, 2005, patent owner filed another after-final response and a patent owner's summary of the June 10, 2005 telephone interview. This response did not include any amendments to claim 22 (and like claims), but otherwise was the same of the May 27, 2005 response.

17. On June 27, 2005, the examiner mailed an advisory action indicating that the amendment of May 27, 2005 would not be entered because it raises new issues, but the amendment of June 13, 2005 would be entered for purposes of appeal.

18. On July 11, 2005, the patent owner filed a petition under 37 CFR 1.181 to request entry of the unentered declaration of May 12, 2005.

---

[2] On May 23, 2005, patent owner filed a duplicate copy of the papers filed May 9 and 12, 2005.
[3] On June 2, 2005, patent owner filed a duplicate copy of the papers filed May 27, 2005.

19. On July 28, 2005, a TC 1700 director denied the above-mentioned petition.

20. On October 6, 2005, an examiner's answer to the appeal brief was mailed.

21. On December 5, 2005, the patent owner filed a reply brief.

22. On April 7, 2006, the Office notified the patent owner that the reply brief is not entered because the reply brief contains a discussion of new or non-admitted evidence (e.g., the unentered declaration of May 12, 2005).

23. On June 7, 2006, the patent owner filed the petition under 37 CFR 1.181 (hereinafter "the instant petition") to invoke the supervisory authority of the Director and requesting the reply brief be entered.

## DECISION

The patent owner (petitioner) actually advance the following four issues in the instant petition:

1. Whether the Examiner properly and within her authority denied the existence of the interview through removal of the associated interview summary?
2. Whether the Examiner properly and within her authority denied the entry of the interview summary by the patent owner?
3. Whether the Examiner properly and within her authority denied entry of the Reply Brief for referring to the substance of the April 26, 2005 interview?
4. Whether the Examiner properly and within her authority denied entry of the Reply Brief for referring to the entered declaration of January 5, 2004?

Issues 1 & 2: re the April 26, 2005 interview

In response to patent owner's two issues regarding the alleged denial of entry of the interview summary by the examiner and the patent owner, both interview summaries are currently part of the record. The Office regrets if patent owner misconstrued that examiner's statements in the April 7, 2006 advisory action to infer that such papers are being removed from the record. This is simply not the case. The record still clearly reflects the April 26, 2005 interview as summarized by the examiner's interview summary and the patent owner's interview summary. While the patent owner has a right to have their interview summary entered into the file of the proceedings, the patent owner does not have an absolute right to have evidence (e.g., the exhibits shown during the interview) considered by the examiner after a final rejection. See 37 CFR 1.116 for admission of evidence after a final rejection. See also MPEP 713.08, which states that "[a] model of exhibit [demonstrated during an interview] will not generally be admitted as

part of the record" unless it complies with 37 CFR 1.191. 37 CFR 1.191 requires that in order for the exhibit to be admitted it must:

(1) substantially conform to the requirements of 37 CFR 1.52 or 1.84
(2) be specifically required by the Office; or
(3) be filed with a petition under this section including a fee under 37 CFR 1.17(h) and an explanation of why entry of the exhibit is necessary to demonstrate patentability.

The exhibits shown during the interview were not required by the Office, and entry was not requested via a petition under 37 CFR 1.191(a)(3). Even if the exhibits A-D comply with the requirements of 37 CFR 1.191, such exhibits would have to comply with 37 CFR 1.116 in order to be admitted to the record for consideration by the examiner after a final rejection. The examiner has stated that the evidence filed on May 12, 2005 did not comply with the requirements of 37 CFR 1.116, and therefore, would not be entered. See the advisory action dated May 27, 2005. Upon petition, the technology center director agreed with the examiner's position that, in compliance with 37 CFR 1.116, the evidence will not be entered. See the petition decision dated July 28, 2005. Patent owner did not request reconsideration of this decision.

Furthermore, it is noted that the exhibits attached to the patent owner's interview summary and the exhibits attached to the unentered declaration of May 12, 2005 are substantially similar. Therefore, to require that the examiner fully consider and address the evidence in the form of exhibits attached to the patent owner's interview summary, while the record of the proceeding has already clearly determined that substantially the same evidence attached to a declaration under 37 CFR 1.132 is properly not entered, would be rewarding form over substance. Accordingly, while the exhibits A-D attached to the patent owner's interview summary dated May 9, 2005 are indeed entered in the record, such entry is made only to the extent that it is necessary to give a full description as to what was demonstrated during the April 26, 2005 as required by MPEP 713.08.

To reiterate, the interview of April 26, 2005 is of record, and is documented by both the examiner's interview summary and the patent owner's interview summary dated May 9, 2005.

Issues 3 & 4: re entry of the Reply Brief

Turning to the facts regarding entry of the reply brief, patent owner argues that the reply brief does not include any new or non-admitted affidavit or other evidence, and accordingly, should be entered. Patent owner points out that the declaration of January 5, 2004 was entered into the record, and therefore, is properly referred to in the reply brief. Patent owner also states that the interview of April 26, 2005 as documented by both the examiner's interview summary and the patent owner's interview summary filed May 9, 2005 are of record, and therefore, the interview is properly referenced in the reply brief.

Upon review of the reply brief, it is determined that the reply brief does not include any new or non-admitted affidavit or other evidence. The reply brief does not refer to the unentered declaration of May 12, 2005 except for page 2, which states that such a declaration was filed but it is not entered. As stated by the patent owner, the reply brief properly includes references to the entered declaration of January 5, 2004. The reply brief does refer to the interview of April 26, 2005 on pages 6, 10-16, 19, 22, and 23, and basically limits the reference to the interview to the observations noted by the examiner in the examiner's interview summary. This is not a reference to new or non-admitted evidence, because, as discussed above, both the examiner's interview summary and the patent owner's interview summary are of record.

Accordingly, the reply brief is entered in the reexamination proceeding and the patent owner's petition, as it relates to entry of the reply brief of December 5, 2005 in the instant reexamination proceeding, is granted.

**CONCLUSION**

1. The petition under 37 CFR 1.181 for entry of the reply brief of December 5, 2005 in the '6,572 reexamination proceeding is granted.

2. The examiner of record will be notified of this decision, and will review of the reply brief in due course.

3. Patent owner is advised that a petition under 37 CFR 1.182 requesting continuing reexamination may be filed. The petition should explain how the granting of continuing reexamination would further prosecution of the reexamination rather than delay it, such as a request for entry of a submission that provides a *bona fide* effort to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate. The petition should also explain why the patent owner did not become aware of the need for the new amendment or evidence earlier in the prosecution. Given the amount of prosecution occurring after the final rejection, a grantable petition under 37 CFR 1.182 would allow for further clarification of the issues regarding patentability.

If patent owner is considering filing a petition under 37 CFR 1.182 to request continuing reexamination, the patent owner is strongly encouraged to call Special Program Examiner, Deborah Jones, at (571) 272-1535 to advise her of this fact in order not to waste Office resources in furthering the appeal.

4. Telephone inquiries related to this decision should be directed to Deborah Jones, Special Program Examiner, at (571) 272-1535 or Jeanne Clark at (571) 272-7714, or in their absence to the undersigned at (571) 272-1596.

Deborah Jones

for Lissi Mojica Marquis, Director
Central Reexamination Unit

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MAR 11 2008

CENTRAL REEXAMINATION UNIT

STEIN MCEWEN & BUI LLP
1400 Eye Street, NW
Suite 300
Washington, DC 20005

(For Patent Owner)

| | | |
|---|---|---|
| *In re Kim et al.* | : | |
| Reexamination Proceeding | : | DECISION ON PETITION |
| Control No.: 90/006,572 | : | UNDER 37 CFR 1.181 |
| Filed: March 25, 2003 | : | TO INVOKE THE SUPERVISORY |
| For: U.S. Patent No.: 6,251,537 | : | AUTHORITY OF THE DIRECTOR |

This is a decision on a petition filed by the patent owner on June 7, 2006[1]. The petition is entitled PETITION UNDER 37 CFR 1.181, and is a request to the Director to exercise his/her discretion pursuant to 37 CFR 1.181 and enter the reply brief filed on December 5, 2005.

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

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated June 7, 2006 is granted with respect to entering the reply brief filed on December 5, 2005.

[1] It is noted that a duplicate petition was filed on January 12, 2007. The Office regrets the delay in responding to the petitions.

## REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,251,537 (hereinafter, the '*537* patent) issued on June 26, 2001.

2. A request for e*x parte* reexamination, assigned control No. 90/006,572, was filed by patent owner, on March 25, 2003.

3. *Ex parte* reexamination was ordered for the '6,572 reexamination proceeding on May 28, 2003.

4. On November 6, 2003, a non-final Office action, which rejection all the claims (claims 1-20), was mailed in the '6,572 reexamination proceeding.

5. On December 2, 2003, a personal interview was conducted at the Office.

6. On January 5, 2004, the patent owner filed a response to the non-final Office action. Along with the response, patent owner filed a declaration under 37 CFR 1.132 by Hyung-gon Noh (hereinafter "entered declaration"), and a patent owner's summary of the interview of December 2, 2003.

7. On January 14, 2005, the Office issued a Final rejection Office action, which rejection all the claims (claims 1-142).

8. On March 3, 2005, the patent owner filed a response to the Final Office action, which was not entered because it raised issues of new matter. See the advisory action dated March 29, 2005.

9. On April 26, 2005, a second personal interview was conducted at the Office. According to the examiner's interview summary, possible amendments to claims 22, 43, and 78 and to the specification to overcome new matter objections. During the interview, several exhibits, including a computer movie showing the battery of Moulton (the prior art reference applied against the claims) and battery of the claimed invention placed in a sealing simulation, pictures showing the battery of Moulton (as manufactured by the patent owner), were shown. See the examiner's interview summary dated 4/26/2005.

10. On May 9, 2005, the patent owner filed a second after-final rejection response, and the patent owner's summary of the interview, which include attachments in

the form of exhibits A-D[2]. According to the patent owner's summary, exhibits A and B provide a copy of the pictures presented during the interview and an explanation of the method of manufacture of the battery of Moulton discussed during the interview. Exhibits C and D are the screen shots of the computer movie shown during the interview.

11. On May 12, 2005, the patent owner filed a supplemental response to the May 9, 2005 response, which included a declaration under 37 CFR 1.132 by Hyung-goh Noh (hereinafter "the unentered declaration"). This declaration provided details with respect to the movies and pictures shown in the interview of April 26, 2005, but the declaration itself was not presented during the April 26, 2005 interview.

12. On May 13, 2005, the patent owner filed a Notice of Appeal.

13. On May 27, 2005, the patent owner filed another response after-final rejection.[3]

14. Also, on May 27, 2005, the examiner mailed an advisory action indicating that the amendments of May 9, 2005 will not be entered because they raise new issues and new matter issues, and that the evidence submitted will not be entered because the patent owner failed to provide a showing of good and sufficient reasons why the evidence is necessary and was not earlier presented.

15. On June 10, 2005, a telephone interview occurred.

16. On June 13, 2005, patent owner filed another after-final response and a patent owner's summary of the June 10, 2005 telephone interview. This response did not include any amendments to claim 22 (and like claims), but otherwise was the same of the May 27, 2005 response.

17. On June 27, 2005, the examiner mailed an advisory action indicating that the amendment of May 27, 2005 would not be entered because it raises new issues, but the amendment of June 13, 2005 would be entered for purposes of appeal.

18. On July 11, 2005, the patent owner filed a petition under 37 CFR 1.181 to request entry of the unentered declaration of May 12, 2005.

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[2] On May 23, 2005, patent owner filed a duplicate copy of the papers filed May 9 and 12, 2005.
[3] On June 2, 2005, patent owner filed a duplicate copy of the papers filed May 27, 2005.

19. On July 28, 2005, a TC 1700 director denied the above-mentioned petition.

20. On October 6, 2005, an examiner's answer to the appeal brief was mailed.

21. On December 5, 2005, the patent owner filed a reply brief.

22. On April 7, 2006, the Office notified the patent owner that the reply brief is not entered because the reply brief contains a discussion of new or non-admitted evidence (e.g., the unentered declaration of May 12, 2005).

23. On June 7, 2006, the patent owner filed the petition under 37 CFR 1.181 (hereinafter "the instant petition") to invoke the supervisory authority of the Director and requesting the reply brief be entered.

## DECISION

The patent owner (petitioner) actually advance the following four issues in the instant petition:

1. Whether the Examiner properly and within her authority denied the existence of the interview through removal of the associated interview summary?
2. Whether the Examiner properly and within her authority denied the entry of the interview summary by the patent owner?
3. Whether the Examiner properly and within her authority denied entry of the Reply Brief for referring to the substance of the April 26, 2005 interview?
4. Whether the Examiner properly and within her authority denied entry of the Reply Brief for referring to the entered declaration of January 5, 2004?

Issues 1 & 2: re the April 26, 2005 interview

In response to patent owner's two issues regarding the alleged denial of entry of the interview summary by the examiner and the patent owner, both interview summaries are currently part of the record. The Office regrets if patent owner misconstrued that examiner's statements in the April 7, 2006 advisory action to infer that such papers are being removed from the record. This is simply not the case. The record still clearly reflects the April 26, 2005 interview as summarized by the examiner's interview summary and the patent owner's interview summary. While the patent owner has a right to have their interview summary entered into the file of the proceedings, the patent owner does not have an absolute right to have evidence (e.g., the exhibits shown during the interview) considered by the examiner after a final rejection. See 37 CFR 1.116 for admission of evidence after a final rejection. See also MPEP 713.08, which states that "[a] model of exhibit [demonstrated during an interview] will not generally be admitted as

part of the record" unless it complies with 37 CFR 1.191. 37 CFR 1.191 requires that in order for the exhibit to be admitted it must:

(1) substantially conform to the requirements of 37 CFR 1.52 or 1.84
(2) be specifically required by the Office; or
(3) be filed with a petition under this section including a fee under 37 CFR 1.17(h) and an explanation of why entry of the exhibit is necessary to demonstrate patentability.

The exhibits shown during the interview were not required by the Office, and entry was not requested via a petition under 37 CFR 1.191(a)(3). Even if the exhibits A-D comply with the requirements of 37 CFR 1.191, such exhibits would have to comply with 37 CFR 1.116 in order to be admitted to the record for consideration by the examiner after a final rejection. The examiner has stated that the evidence filed on May 12, 2005 did not comply with the requirements of 37 CFR 1.116, and therefore, would not be entered. See the advisory action dated May 27, 2005. Upon petition, the technology center director agreed with the examiner's position that, in compliance with 37 CFR 1.116, the evidence will not be entered. See the petition decision dated July 28, 2005. Patent owner did not request reconsideration of this decision.

Furthermore, it is noted that the exhibits attached to the patent owner's interview summary and the exhibits attached to the unentered declaration of May 12, 2005 are substantially similar. Therefore, to require that the examiner fully consider and address the evidence in the form of exhibits attached to the patent owner's interview summary, while the record of the proceeding has already clearly determined that substantially the same evidence attached to a declaration under 37 CFR 1.132 is properly not entered, would be rewarding form over substance. Accordingly, while the exhibits A-D attached to the patent owner's interview summary dated May 9, 2005 are indeed entered in the record, such entry is made only to the extent that it is necessary to give a full description as to what was demonstrated during the April 26, 2005 as required by MPEP 713.08.

To reiterate, the interview of April 26, 2005 is of record, and is documented by both the examiner's interview summary and the patent owner's interview summary dated May 9, 2005.

Issues 3 & 4: re entry of the Reply Brief

Turning to the facts regarding entry of the reply brief, patent owner argues that the reply brief does not include any new or non-admitted affidavit or other evidence, and accordingly, should be entered. Patent owner points out that the declaration of January 5, 2004 was entered into the record, and therefore, is properly referred to in the reply brief. Patent owner also states that the interview of April 26, 2005 as documented by both the examiner's interview summary and the patent owner's interview summary filed May 9, 2005 are of record, and therefore, the interview is properly referenced in the reply brief.

Upon review of the reply brief, it is determined that the reply brief does not include any new or non-admitted affidavit or other evidence. The reply brief does not refer to the unentered declaration of May 12, 2005 except for page 2, which states that such a declaration was filed but it is not entered. As stated by the patent owner, the reply brief properly includes references to the entered declaration of January 5, 2004. The reply brief does refer to the interview of April 26, 2005 on pages 6, 10-16, 19, 22, and 23, and basically limits the reference to the interview to the observations noted by the examiner in the examiner's interview summary. This is not a reference to new or non-admitted evidence, because, as discussed above, both the examiner's interview summary and the patent owner's interview summary are of record.

Accordingly, the reply brief is entered in the reexamination proceeding and the patent owner's petition, as it relates to entry of the reply brief of December 5, 2005 in the instant reexamination proceeding, is granted.

## CONCLUSION

1. The petition under 37 CFR 1.181 for entry of the reply brief of December 5, 2005 in the '6,572 reexamination proceeding is granted.

2. The examiner of record will be notified of this decision, and will review of the reply brief in due course.

3. Patent owner is advised that a petition under 37 CFR 1.182 requesting continuing reexamination may be filed. The petition should explain how the granting of continuing reexamination would further prosecution of the reexamination rather than delay it, such as a request for entry of a submission that provides a *bona fide* effort to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate. The petition should also explain why the patent owner did not become aware of the need for the new amendment or evidence earlier in the prosecution. Given the amount of prosecution occurring after the final rejection, a grantable petition under 37 CFR 1.182 would allow for further clarification of the issues regarding patentability.

If patent owner is considering filing a petition under 37 CFR 1.182 to request continuing reexamination, the patent owner is strongly encouraged to call Supervisory Patent Examiner, Deborah Jones, at (571) 272-1535 to advise her of this fact in order not to waste Office resources in furthering the appeal.

4. Telephone inquiries related to this decision should be directed to Deborah Jones, Supervisory Patent Examiner, at (571) 272-1535 or Jeanne Clark at (571) 272-7714, or in their absence to the undersigned at (571) 272-1596.

/Deborah Jones/ for

Lissi Mojica Marquis, Director
Central Reexamination Unit

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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.

90006573 . 051903

PTO-90C (Rev. 07-01)

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Paper No. 30/9

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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.

Control No: 90/006,573

## 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 REQUESTER'S CORRESPONDENCE ADDRESS)

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# REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/006160, 90/006,445, 90/005,975, 90/006,573

PATENT NO. 6,190,018

ART UNIT 2875

Enclosed is a copy of the latest communication from the Patent and Trademark Office in the above identified reexamination proceeding. 37 C.F.R. 1.550(e).

Where this copy is supplied after the reply by requester, 37 C.F.R. 1.535, or the time for filing a reply has passed, no submissions on behalf of the reexamination requester will be acknowledged or considered. 37 C.F.R. 1.550(e).

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

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

MARK E. TETREAULT
BARLOW, JOSEPHS & HOLMES, LTD.
101 DYER STREET, 5TH FLOOR
PROVIDENCE, RI 02903-3908

# REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/006,445 & 90/005,975, 90/006,160, 90/006,573

PATENT NO. 6,190,018

ART UNIT 2875

Enclosed is a copy of the latest communication from the Patent and Trademark Office in the above identified reexamination proceeding. 37 C.F.R. 1.550(e).

Where this copy is supplied after the reply by requester, 37 C.F.R. 1.535, or the time for filing a reply has passed, no submissions on behalf of the reexamination requester will be acknowledged or considered. 37 C.F.R. 1.550(e).

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P.O. BOX 160727
AUSTIN TX 78716-0727

TODD P. BLAKELY (For Third Party Requester)
SHERIDAN ROSS PC
1560 BROADWAY
SUITE 1200
DENVER, CO 80202-5141

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JUN 2 3 2005

REEXAM UNIT

In re Reexamination Proceeding :
Farhan Ali et al. :
Control No. 90/006,575 : DECISION GRANTING PETITION
Filed: March 25, 2003 :
U.S. Patent No. 5,896,411 :
Attorney Docket No. RR2195X :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on May 9, 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 - Patent Owner's Statement of Interview Substance), a $1500.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3).

The petition is granted.

The reexamination file is being returned to Technology Center Art Unit 2634 for further examination and consideration of the Patent Owner's Statement of Interview Substance filed May 9, 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, Shuwang Liu, in Technology Center Art Unit 2634, who can be reached at 571-272-3036.

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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Paper No. 6

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MAILED
AUG 2 8 2003
REEXAM UNIT

In re reissue application of
Leung, et al.,
Application No. 10/370,794
Filed: February 21, 2003
For: U.S. Patent No. 6,195,546

In re Leung, et al.,
Reexamination Proceeding
Control No. 90/006,577
Filed: March 25, 2003
For: U.S. Patent No. 6,195,546

**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. 6,195,546 issued to Leung, et al., on February 27, 2001.

2. Patent owner filed a reissue application based on the '546 patent, on February 21, 2003, which was assigned Application No. 10/370,794. Claims 7-8 were amended.

3. A request for reexamination of the '546 patent was filed by a third party requester on March 25, 2003, and the resulting reexamination proceeding was assigned Control No. 90/006,577.

4. On May 1, 2003, reexamination was ordered in the '6577 proceeding.

5. Notice of the filing of the reissue application was published in the *Official Gazette* on May 27, 2003.

DOCKET ALARM

## DISCUSSION REGARDING MERGER

Under 37 C.F.R. § 1.565(d):

> (d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings....

As evidenced by the above review of facts, the reissue application and the reexamination proceeding are currently pending. Since the Order has been mailed pursuant to § 1.525 in the '6577 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 '6577 reexamination file shows that no amendments were made in the reexamination file.

A review of the reissue (Application No. 10/370,794) prosecution history shows that the reissue application was published in the *Official Gazette* on May 27, 2003. In the reissue application, patent owner has amended claims 7-8. 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. 10/370,794, and Control Number 90/006,577. 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 2600. All further examination should be conducted in accordance with this decision.

3. Pursuant to Part II of this decision, a housekeeping amendment is required **within ONE (1) MONTH of this decision**, placing the same amendments in both cases of the present merged proceeding.

4. The examiner should 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.

90006577 - 08182003

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

August 18, 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. |
|---|---|---|---|
| 10/370,794 | 02/21/2003 | Leung, Yau-Fan | |

| PATENT NUMBER | DATE OF THIS NOTICE |
|---|---|
| 6195546 | 08/28/2003 |

| PAPER NUMBER |
|---|
| 7 |

NOTICE OF MERGED REEXAM - REISSUE PROCEEDING

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

Control No. 90/ 006577 Filing Date: 03/25/2003

Requester (name, address) Todd P. Blakely
SHERIDAN ROSS PC
1560 Broadway Suite 1200
Denver CO 80202-5141

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

REEXAMINATION RESULTS

The questions raised in reexamination request No. 90/ 006577, filed 03/25/2003, 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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JUL 23 2004

Reexamination Control No. 90/006,579 – Paper No. 13
Reexamination Control No. 90/006,975 – Paper No.'s 8-13

MAILED
JUL 23 2004
OFFICE OF THE DIRECTOR
TC 3600

**FOR PATENT OWNER:**

David E. Dougherty
Dennison, Schultz, Dougherty & MacDonald
1727 King Street, Suite 105
Alexandria, VA 22314

**DECISION ON REEXAMINATION MERGER**
37 CFR 1.565(c)

**Reexam Control Nos. 90/006,579 and 90/006,975**

**FOR REQUESTER;**

C. Douglas McDonald
Carlton Fields, P.A.
P.O. Box 3239
Tampa, Fl 34698-3239

DOCKET ALARM

## NOTICE OF CONSOLIDATION OF REEXAMINATION PROCEEDINGS

### Background

1. U.S. Letters Patent No. 5,842,433 issued on December 1, 1998.

2. A first request for reexamination was filed by the patent owner on March 27, 2003, and was assigned Reexamination Control No. 90/006,579.

3. Reexamination was ordered in Reexamination Control No. 90/006,579 on May 5, 2003.

4. In Reexamination Control No. 90/006,579 the examiner issued a first Office action on December 15, 2003, rejecting claims 1-4 and indicating claims 5-12 confirmed.

5. In Reexamination Control No. 90/006,579 the patent owner submitted, on February 11, 2004, a request for reconsideration of the examiner's holding that claims 1-4 were unpatentable. On that same date the patent owner also submitted an affidavit under 37 CFR 1.132.

6. On March 25, 2004, a second request for reexamination of U.S. Letters Patent No. 5,842,433 was filed by a third party requester, C. Douglas McDonald and was assigned Reexamination Control No. 90/006,975.

7. Reexamination was ordered in Reexamination Control No. 90/006,975 on May 5, 2004.

DO NOT ENTER

## Discussion

Under 37 CFR 1.565(c):

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

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

## Decision

Under the provisions of 37 CFR 1.565(c), reexamination proceedings designated as Reexamination Control Nos. 90/006,579 and 90/006,975 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. Patent owner is normally 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. However, since no amendment has been made in either case, no such "housekeeping" amendment is required in this proceeding.

Since the time period for submission of a patent owner's statement has expired, and the submission of the "housekeeping" amendment (when required) prior to a first Office action does not invoke the provisions of 37 CFR 1.535, prosecution will proceed *ex parte*. No reply or other submission will be considered in the merged reexamination proceeding filed by the third party requester.

II. Conduct of Merged Proceeding

All papers mailed by the Office will take the form of a single action which applies to both reexamination proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for both files and will be physically entered in each separate reexamination file. Any papers filed by the patent owner subsequent to this decision 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. 90/006,579 and 90/006,975 are hereby merged and an Office action will be issued by the examiner for *ex parte* prosecution of the merged proceeding.

Steven N. Meyers
Special Programs Examiner
Technology Center 3600
(703) 308-3868

Concur:

Robert Oberleitner
Director
Technology Center 3600

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BACHMAN & LaPOINTE
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SUITE 1201
NEW HAVEN, CT 06510

(For Patent Owner)

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FEB 11 2005

OFFICE OF PETITIONS

In re Emil Simmler et al
Reexamination Proceeding
Control No. 90/006,580
Filed: March 28, 2003
For: U.S. Patent No. 6,319,352

**DECISION GRANTING PETITION**

This is a decision on the January 7, 2005,[1] patent owner PETITION FOR ENTRY OF LATE PAPERS 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 the appropriate statement pursuant to 37 CFR 1.137(b)(3). In addition, the Appeal Brief was filed with patent owner's August 19, 2004, 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 $1,330 has been received, thereby providing the "petition fee as set forth

[1] The petition is accompanied by a copy of a stamped return postcard which acknowledges receipt by the U.S. Patent and Trademark Office (USPTO) on August 19, 2004 of an Appeal Brief (in triplicate), a Petition for Entry of Late Papers, and a check for $330 and $1,330. Unfortunately, the papers filed on August 19, 2004 have not to date been associated with the instant file. However, in view of the evidence submitted, the instant petition will be treated as having been received in the USPTO on August 19, 2004.

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 file is being returned to Technology Center 1700 to, in due course, take appropriate action on the Appeal Brief filed with the instant petition.

3. Any further communications as to the merits of the reexamination proceeding should be directed to Examiner Geoffrey L. Knable in Technology Center 1700, who can be reached at (571) 272-1220.

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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Commissioner for Patents
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www.uspto.gov

APR 19 2006

Blank Rome LLP
The Watergate Building
600 New Hampshire Avenue, NW
Washington, DC 20037

(For Patent Owner)

| | |
|---|---|
| In re | : David R. Williams et al |
| Reexamination Proceeding | |
| Control No. | : 90/006,558 |
| Filed: | : April 4, 2003 |
| For U.S. Patent No. | : 5,777,719 |

DECISION ON REQUEST
FOR EXTENSION OF TIME

The above noted *ex parte* reexamination proceeding is before the Director of the Central Reexamination Unit for consideration of Patent Owner's petition for an extension of time in which to file a reply to the final Office action dated September 19, 2005, which Office action set a two month period for filing a reply thereto. The petition was timely filed on November 17, 2005 together with the $200.00 fee required by 37 CFR 1.550(c). Patent Owner requests an extension of time of one month. The petition is the first request for an extension of time with respect to the outstanding Office letter.

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 a sufficient cause and for a reasonable time specified. Any request for such an extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of the request effect any extension. Any request for such extension must be accompanied by the petition fee set forth in Sec. 1.17(g). 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 filed November 17, 2005 states that after Patent Owner's representative reviewed the final Office action and held discussions with Patent Owner, it was decided that a personal interview with the examiner would be beneficial in preparing the reply to the Office action. An interview was scheduled for and held November 9, 2005. During the interview, the examiner suggested that a declaration under 37 CFR 1.132 be prepared and filed to make of record the arguments presented during the interview[1]. Thus, it is requested by Patent Owner's

[1] See Ex Parte Reexamination Interview Summary dated November 9, 2005.

representative that a one-month extension of time is necessary to prepare the declaration under 37 CFR 1.132 and to have such a declaration reviewed and executed by the appropriate declarant or declarants.

In view of the circumstances outlined above, sufficient cause for an extension for the time requested has been established. The request is therefore granted *nunc pro tunc.*

The period for filing a response to the final Office action dated September 19, 2005 is extended to extended to run to an including December 19, 2005.

A response to the final Office action was filed December 13, 2005. The examiner has found that the response overcomes the rejection set forth in the final Office action and has prepared a "Notice of Intent to Issue *Ex Parte* Reexamination Certificate" (NIRC) that will be mailed concurrently with this decision or soon thereafter. As a result of the issuance of the NIRC, the petitions for extensions of time filed January 19, 2006; February 21, 2006; and March 20, 2006 are deemed unnecessary and are dismissed as being moot.

Any inquiry concerning this decision should be directed to Andres Kashnikow, Special Programs Examiner, at telephone No. (571) 272-4361.

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

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David J. Edmondson
Blank Rome LLP
600 New Hampshire Ave., N.W., Suite 400
Washington, D.C. 20037-2485

(Patent Owner)

MAILED

JUL 05 2007

CENTRAL REEXAMINATION UNIT

In re Williams et al.
Reexamination Proceeding
Control No.: 90/006,591
Filed: April 3, 2003
For: U.S. Patent No.: 6,379,005

**DECISION**
**ON PETITION**
**UNDER 37 CFR 1.182**

This is a decision on the May 18, 2007 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.

**Thus, the IDS filed May 18, 2007, has not been entered for consideration by the examiner.**

## REVIEW OF SALIENT FACTS

1. Patent number 6,379,005 issued on April 30, 2002 with 26 claims.
2. A request for reexamination, assigned control No. 90/006,591 (the '591 proceeding), was filed on April 3, 2003, by the patent owner.
3. An order granting the reexamination request was mailed June 6, 2003.
4. The '591 proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the '591 proceeding on May 2, 2006.
5. An Information Disclosure Statement (IDS) was filed by the patent owner on June 13, 2006.
6. The Office mailed a communication for the '591 proceeding on May 9, 2007, stating that the IDS filed on June 13, 2006 was not considered because it lacked an entry right.
7. The instant petition was filed on May 18, 2007, accompanied by a new IDS (i.e. a resubmission of the information in the June 13, 2006 IDS, along with additional references), 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 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 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, and the requisite amendment to address that unpatentability. To the contrary, patent owner merely states that the items of information were either "not available" or were not submitted earlier because some items had "inadvertently not been cited." Patent owner does not provide a discussion of the substance of any of the items of information, except for a sweeping statement that the prior art "mentions the detection or correction of wavefront aberrations." The patent owner has not applied the teachings of the prior art to the claim limitations in the present reexamination proceeding. Indeed, patent owner explicitly stated on page 3 of the instant petition: "The petitioner makes no representations that the cited prior art renders unpatentable any of the pending claims of the present reexamination proceeding..."

Patent owner provides information that one reference, WO 92/01417 A1, listed on the IDS submitted May 18, 2007, was cited and considered by the examiner in the application that matured into the present patent, but that for some reason was not listed on the face of the patent. While Office policy provides that all patents and printed publications of record in the patent file are considered by the examiner in the reexamination proceeding, that does not give petitioner the right to have such printed on the reexamination certificate unless it is timely submitted on an IDS in the proceeding, with explanation and amendment where such is required. Thus, even if the IDS had been solely limited to the '417 reference, the relief requested would not be appropriate in this case. As pointed out above, the reexamination proceeding has already entered the reexamination certificate printing cycle.

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 MPEP as pointed out above.

A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on May 2, 2006, 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.

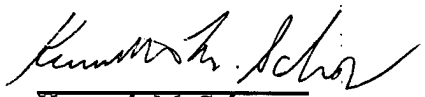
## CONCLUSION

1. The petition is dismissed as to the request for consideration of the IDS filed on May 18, 2007.

2. The IDS papers have not been entered for consideration by the examiner. A copy of the IDS submission will, however, be placed in the electronic image file wrapper (IFW) for the proceeding.

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
7/2/07

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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. |
|---|---|---|---|---|
| 90/006,594<br>+ 90/007,153 | 04/08/2003 | 5637930 | 6232-113 RX1 (183875) | 8226 |

23973 7590 01/26/2005

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| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
| | 13 |

DATE MAILED: 01/26/2005

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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January 2005

Gregory J. Lavorgna
Drinker, Biddle & Reath LLP
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Philadelphia, PA 19103-6996

(For Patent Owner)

Ostrager Chong Flaherty & Broitman P.C.
250 Park Avenue, Suite 825
New York, NY 10177-0899

(For Third Party Requester)

In re Michael J. Rowen et al.
Reexamination Proceeding
Control No. 90/006,594
Filed: April 8, 2003
For U.S. Patent No. 5,637,930

In re Michael J. Rowen et al.
Reexamination Proceeding
Control No. 90/007,153
Filed: August 3, 2004
For U.S. Patent No. 5,637,930

DECISION MERGING
REEXAMINATION
PROCEEDINGS

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

## BACKGROUND

1. U.S. Patent No. 5,637,930 issued on June 10, 1997.

2. Reexamination Control No. 90/006,594 was filed by the patent owner on April 8, 2003.

3. Reexamination was ordered in the '594 reexamination proceeding on June 26, 2003.

4. The '594 reexamination proceeding is currently awaiting an Office action based upon the response that was filed on June 16, 2004. Prosecution was suspended in the '594 reexamination proceeding on October 15, 2004. There have been no amendments filed in the '594 reexamination proceeding.

5. Reexamination Control No. 90/007,153 was filed by a third party requester on August 3, 2004.

6. Reexamination was ordered in the '153 reexamination proceeding on October 20, 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* 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 37 CFR § 570.

As noted in the "BACKGROUND" section 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

In accordance with 37 C.F.R. § 1.565(c), the '594 and '153 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

Patent owner is required to maintain the same claims and specification in both files.

## 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

An Office action will be issued in due course.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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OSTRAGER CHONG FLAHERTY & BROITMAN P.C.
250 Park Avenue, Suite 825
New York, NY 10177-0899

# *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/007,153*. + 90/006,594

PATENT NO. *5637930*.

ART UNIT *2836*.

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)).

mail

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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ALEXANDRIA, VA 22313-1450
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Paper No. 10

MUELLER & SMITH, LPA
MUELLER-SMITH Building
7700 Rivers Edge Drive
Columbus, OH 43235

(For Patent Owner)

MAILED

JUL 28 2004

REEXAM UNIT

In re Capoccia
Reexamination Proceeding
Control No. 90/006,595
Filed: April 9, 2003
For: U.S. Patent No. 6,289,548

**DECISION DISMISSING PETITION**

This is a decision on the May 25, 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 deposit account no. 13-4830, as instructed on page 1 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)(III)(C) and (D).

The instant petition is accompanied by the petition fee, as well as a response to the non-final Office action of November 12, 2003.

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

The instant petition lacks item (3) above. The petition includes a statement that the "lateness was due to a docketing error and any abandonment of the above-identified patent application 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).

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. 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
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (703) 308-6916
Attn: Office of Patent Legal Administration

By hand: Crystal Plaza Three-Four, Suite 3D68
2100 Crystal Drive
Arlington, VA

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

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

July 20, 2004

mcw

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MUELLER-SMITH Building
7700 Rivers Edge Drive
Columbus, OH 43235

(For Patent Owner)

In re Capoccia
Reexamination Proceeding
Control No. 90/006,595
Filed: April 9, 2003
For: U.S. Patent No. 6,289,548

**DECISION GRANTING PETITION**

MAILED

MAR 0 8 2005

REEXAM UNIT

This is a decision on the August 4, 2004, patent owner renewed petition for entry of belated papers filed under 37 C.F.R. § 1.137(b), based upon unintentional delay. The petition is before the Office of Patent Legal Administration for decision.

The petition fee pursuant to 37 C.F.R. § 1.17(m) for the petition under 37 C.F.R. § 1.137(b) was paid with the previous petition.

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

## DECISION

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

(1) the required reply, unless previously filed;

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

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

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

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

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

The petition fee was paid with the previous petition, and it was accompanied by a response to the outstanding non-final rejection, which meets the criteria of 37 C.F.R. § 1.137(b)(1).

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

The petition is **granted**.

**CONCLUSION**

1. The petition is **granted**.

2. The reexamination file will be forwarded to Technology Center 1700 for consideration of the response to the outstanding non-final rejection, and preparation of the next Office action.

3. Any inquiries with regard to the merits of this proceeding should be directed to Primary Examiner Mark Spisich, of Group Art Unit 1744.

4. Any telephone inquiries with regard to this decision should be directed to the undersigned at (571) 272-7722.

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

March 7, 2005

UNITED STATES PATENT 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. |
|---|---|---|---|---|
| 90/006,595 | 04/09/2003 | 6289548 | TXS 2-016-2-5 | 8995 |

266 7590 10/28/2005

MUELLER AND SMITH, LPA
MUELLER-SMITH BUILDING
7700 RIVERS EDGE DRIVE
COLUMBUS, OH 43235

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 10/28/2005

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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COLUMBUS OH 43235

MAILED
OCT 28 2005
REEXAM UNIT

In re Reexamination Proceeding :
John Capoccia :
Control No. 90/006,595 : DECISION GRANTING PETITION
Filed: April 9, 2003 :
U.S. Patent No. 6,289,548 :
Attorney Docket No. TXS 2-016-2-5 :

This is a decision on the petitions under 37 CFR 1.137(b) filed by the patent owner on August 29, 2005, by facsimile transmission, and on September 14, 2005, for entry of late papers based upon unintentional delay.

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

37 CFR 1.137(b) states:

> *"Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by: (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in § 1.17(m); (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section."

37 CFR 1.550(c) states:

> The time for taking any action by a patent owner in an ex parte reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. 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.

In the petition filed August 29, 2005, petitioner requested additional time to schedule an interview due to a misunderstanding between petitioner and the examiner. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension.. See 37 CFR 1.550(c). The 4 month

period expired at midnight on August 19, 2005. As the petition was filed after the day on which action by the patent owner was due, no extension of time is granted.

In the present petition under 37 CFR 1.137(b) filed September 14, 2005, petitioner requests entry of late papers (Notice of Appeal) based upon unintentional delay. The petition includes the requisite response (item 1-Notice of Appeal and an authorization to charge the Notice of Appeal fee), a request to charge counsel's deposit account for the requisite petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3).

The petition for entry of the late papers filed September 14, 2005, is granted.

The small entity petition fee of $750.00 and the small entity Notice of Appeal fee of $250.00 will be charged to counsel's deposit account No. 13-4830 in accordance with the present petition

Thereafter, the reexamination proceeding will be returned to Technology Center Art Unit 1744 for further examination and consideration of the Notice of Appeal filed September 14, 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, Mark Spisich, in Technology Center Art Unit 1744, who can be reached at 571-272-1278.

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

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/006206 90/006,596 | 04/08/2003 | 6260050 | 16499D-000300US | 1704 |

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

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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

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WASHINGTON, D.C 20231
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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 22 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, Director
Technology Center 2100
Computer Architecture, Software, and Information Security

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PATENT AND
TRADEMARK OFFICE

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HERBERT GOODMAN, ESQ.
FRISHAUF, HOLTZ, GOODMAN,
LANGER & CHICK, P.C.
767 THIRD AVENUE - 25TH FLOOR
NEW YORK NY 10017-2023

FOR PATENT OWNER

CHALIIN A. SMITH
SMITH PATENT CONSULTING
P. O. BOX 2726
ALEXANDRIA, VA 22301-2726

FOR REQUESTER

In re Olefsky
Reexamination Proceeding
Control No.: 90/006,062
Filed: July 19, 2001
For: U.S. Patent No. 5,478,852

In re Olefsky
Reexamination Proceeding
Control No.: 90/006,599
Filed: April 14, 2003
For: U.S. Patent No. 5,478,852

: DECISION MERGING
: REEXAMINATION
: PROCEEDINGS

The above noted reexamination files are before the director of Technology Center 1600 for consideration of merger of the proceedings under 37 CFR 1.656(c).

## BACKGROUND

1. Patent No.5,478,852 issued December 26, 1995.

2. A first request for reexamination, Control No. 90/006,062, was filed by third party requester on July 19, 2001.

3. Reexamination was ordered In the '062 reexamination proceeding on October 1, 2001.

4. A second request for reexamination, Control No. 90/006,599, was filed by third party requester on April 14, 2003.

5. Reexamination was ordered In the '599 reexamination proceeding on May 21, 2003.

6. Patent Owner filed a statement in the '599 proceeding on July 17, 2003.

7. Requester filed a reply to Patent Owner's statement on September 17, 2003.

## DISCUSSION

Under 37 CFR 1.565(c):

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

As noted In the above review of facts, reexamination has been ordered In all of the above noted reexamination proceedings. Accordingly, merger of the proceedings under 37 CFR 1.565(c) is appropriate.

## DECISION

Merger of Proceedings.

In accordance with 37 CFR 1.565(c), the '062, and '599 reexamination proceedings are merged. The merged proceeding will be conducted In accordance with the following guidelines and requirements.

Requirement for Same Amendments In Both Proceedings.

Patent Owner is required to maintain the same claims and specification in all files. Patent Owner is given one month within which to provide a "housekeeping" amendment in the '599 proceeding. Amendments must be In accordance with 37 CFR 1.530 (see M.P.E.P. 2250).

Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to all proceedings. All papers issued by the Office or filed by the Patent Owner will contain the identifying data for all files and will be physically entered In each reexamination file. All papers filed by the Patent Owner must consist of a single response, filed in duplicate, each bearing an original signature, for entry in each file. All papers filed by the Patent Owner must be served on third party requester and requester will be sent copies of all papers mailed by the Office.

## CONCLUSION

Reexamination Control Nos. 90/006,062, and 90/006,599 are merged.

John Doll
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

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TECHNOLOGY CENTER 3600

Commissioner for Patents
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**For the Patent Owner:**

Buchanan Ingersoll, PC
Post Office Box 1404
Alexandria, VA 22313-1404

**For the Requester:**

Stephen W. Palan
Burns, Doane, Swecker & Mathis, LLP
1737 King Street Suite 500
Alexandria, VA 22314

DECISION ON PETITION
FOR EXTENSION OF TIME

In re Ex Parte Reexamination proceeding 90/006,600
Filed: April 10, 2003
For: LOAN REPAY ENFORCEMENT SYSTEM

This is a decision on the request for an extension of time filed by the Patent Owner under 37 CFR 1.956 on March 1, 2006.

The petition is **DENIED**.

A non-final Office action was mailed on February 8, 2006 wherein a shortened statutory period for response of one month was set. Patent Owner requests an extension of time of one month to submit a response to the non-final rejection. The request is requested "in order to confer with experts in preparing the response" and "to possibly submit an expert declaration".

A petition under 37 CFR 1.550 can be granted for a showing of "sufficient cause". MPEP 2665 provides that "Evaluation of whether "sufficient cause" has been shown for an extension must be made by balancing the desire to provide the patent owner with a fair opportunity to respond against the requirement of the statute, 35 U.S.C. 314(c), that the proceedings be conducted with special dispatch". Historically, it has been held that sufficient cause has been shown when a petitioner outlines an unusual or unique situation that would hamper a proper response.

In this case, the argument that time is needed to confer with experts in preparing a response is not a persuasive one for granting an extension. It is not known when and

what efforts were made to contact such experts or why such experts were needed. Further, the "possibility" of submitting an expert declaration is insufficient to grant an extension of time. No unusual or unique circumstances have been set forth in patent owner's petition.

Patent Owner's period for response continues to run 1 month from the February 8, 2006 mail date of the non-final Office action in this Ex Parte Reexamination Proceeding.

Questions concerning this decision should be directed to Special Programs Examiner Kenneth J. Dorner at (571) 272-6587.

Wynn Coggins, Director
Patent Technology Center 3600
(571) 272-5350

KJD/KJD: 3/13/06

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Re-exam #

Patent

Attorney's Docket No. 032693-106

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

| | |
|---|---|
| In re Re-Examination Application of | |
| Frank Simon et al. | Group Art Unit: 3624 |
| Application No.: 90/006,600 | Examiner: R. Weisberger |
| Filed: April 10, 2003 | Confirmation No.: 9167 |
| For: LOAN REPAY ENFORCEMENT SYSTEM | |

## REQUEST FOR EXTENSION OF TIME

NF 2/8/06 1MO.

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

Sir:

In accordance with 37 C.F.R. § 1.550, Applicants hereby request a one-month extension of time in order to confer with expert(s) in preparing a response to the Office Action mailed February 8, 2006, and to possibly submit an expert declaration in response thereto. This is a first request for an extension of time. This Request is being filed before the day on which action by the patent owner is due, March 10, 2006, and is accompanied by the petition fee set forth in § 1.17(g) ($200.00). Favorable consideration is respectfully requested.

Respectfully submitted,

BUCHANAN INGERSOLL PC

Date: March 1, 2006

By: _____
E. Joseph Gess
Registration No. 28,510

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/006,600 | 04/10/2003 | 6195648 | 03497.0003.RXUS00 | 9167 |

21839 7590 07/03/2006

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| EXAMINER | |
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| ART UNIT | PAPER NUMBER |

DATE MAILED: 07/03/2006

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7/3/06

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Matthew Rainey

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301 Ravenswood Avenue

Menlo Park, CA 94025

# *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/006600

PATENT NO. 6,195,648

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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CENTRAL REEXAMINATION UNIT

Stephen W. Palan (For Requester)
Burns, Doane, Swecker & Mathis, LLP
1737 King Street, Suite 500
Alexandria, VA 22314

In re Frank Simon et al :
Reexamination Proceeding : **DECISION**
Control No.: 90/006,600 : **DISMISSING**
Filed: April 10, 2003 : **PETITION**
For: U.S. Patent No.: 6,195,648 :

This is a decision on the May 17, 2006, patent owner petition titled PETITION UNDER 37 C.F.R. 1.182

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. Patent number 6,195,648 (the '648 patent) issued February 27, 2001.

2. On April 10, 2003, a request for reexamination of the '648 patent was filed. The resulting proceeding was assigned control No. 90/006,600 (the '6600 proceeding).

3. On July 3, 2003, the Office issued an order granting the requests for reexamination in the '6600 reexamination proceeding.

4. The proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed on April 26, 2006.

5. On May 17, 2006, the patent owner filed the present petition under 37 CFR 1.182 for consideration of an Information Disclosure Statement filed with the petition.

6. The reexamination proceeding is in the final phase of being prepared for printing of the reexamination certificate (it is in the "printing cycle").

## DECISION DISMISSING THE PETITION TO CONSIDER INFORMATION DISCLOUSRE STATEMENT

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 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) will be applied analogously to the requirements for withdrawal of the present reexamination proceeding from the printing cycle.

37 CFR 1.313 states (emphasis added):

"(a) **Applications** may be withdrawn from issue for further action at the initiative of the Office or upon petition by the **applicant**. To request that the Office withdraw an application from issue, applicant must file a petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why withdrawal of the application from issue is necessary....

(b) Once the issue fee has been paid, **the Office will not withdraw the application from issue at its own initiative for any reason except:**

(1) A mistake on the part of the Office;

(2) A violation of § 1.56 or illegality in the application;

(3) Unpatentability of one or more claims; or

(4) For interference.

(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;

(2) Consideration of a request for continued examination in compliance with § 1.114; or

(3) Express abandonment of the application. Such express abandonment may be in favor of a continuing application."

In the present instance, the fact situation fails to satisfy any grounds that would be analogous to those of 37 CFR 1.313(b) or (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 items of information were made of record in applications that bear a "child" relationship with the '648 patent, and patent owner calls such child applications to the Office's attention. Patent owner does not provided a discussion of the substance of any of the items of information or the child applications, and has not applied the teachings of the same to the claim limitations in the present reexamination proceeding.

For 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." If it is required that the withdrawal criteria of 37 CFR 1.313(b) or (c) be complied with for an application, in which there is no statutory requirement for special dispatch, then such criteria must certainly be complied with for a reexamination proceeding where there is a statutory requirement for special dispatch.

Accordingly, the present proceeding will not be withdrawn from the publication process for consideration of the IDS submitted with the petition, and the petition must be dismissed. If, however, the patent owner believes that one or more of the submitted information items (art citations) raises a substantial question of patentability as to at least one claim of the '648 patent which is different than already raised and considered thus far, then the patent owner can always file a new request for reexamination for consideration of such information item(s).

The following is provided for advisory purposes:

As to any IDS that is submitted after a Notice of Intent to Issue a Reexamination Certificate (NIRC) has been mailed, even where the reexamination proceeding has not entered the printing cycle, consideration of an IDS 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." This statutory provision is grounded on the need for certainty and finality as to the question of patentability raised by the request for reexamination. Accordingly, once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. The granting of a petition to consider an IDS filed after the NIRC would require withdrawal of the reexamination proceeding from the publication process, evaluation of the citations, and issuance of another action. This clearly would not carry out the special dispatch mandated by the statute. In order to justify a withdrawal from the publication process to consider an IDS, in the face of the mandate for special dispatch, there is a need for the patent owner (submitting the IDS) to assert that the information submitted raises a question of patentability as to the claims, and to apply the information to the claims' limitations - to facilitate consideration and to further the statutory mandate for special dispatch. If the patent owner fails to do so, it is not appropriate that the reexamination proceeding should be reopened at this late point in the proceeding for consideration of the information. Instead, the patent owner can file a new request for reexamination for consideration of the information, where the patent owner believes that the submitted information raises a substantial question of patentability (as to at least one claim of the patent) which is different than already raised and considered,

## CONCLUSION

1. The patent owner petition to consider the Information Disclosure Statement filed with the petition is dismissed.

2. The Information Disclosure Statement is however entered into the file for the present reexamination proceeding.

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 the undersigned at 571-272-7710.

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

July 3, 2006
C:\Kiva\kenids\decisions\6600 IDS - in printing cycle.doc

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MAILED FEB 05 2008

In re Application of: KELLY et al.
Appl. No.: 90/006601
Filed: April 15, 2003
Patent No. : 5,816,918
Issued: October 6, 1998
Filed: November 14, 1996
For: **PRIZE REDEMPTION SYSTEM FOR GAMES**

: DECISION ON PETITION

This is a decision on the petition filed on September 7, 2007 by which petitioners request the Director exercise supervisory authority to intervene in the prosecution of the reexamination and confirm all pending claims. In the alternative, petitioner seeks relief under 37 CFR 1.182-1.183 in a suspension of the rules. Thus, the petition appears stylized as being under 37 CFR 1.181, 1.182 and 1.183. A fee of $400 has been submitted. Pursuant to 37 CFR 1.4(c) petitioner is reminded different matters may be considered by different branches or sections of the USPTO. In order to avoid confusion and delay, each distinct subject, inquiry or order must be contained in a separate paper. In order to expedite matters the Technology Center has construed the petition as a request for supervisory review under 37 CFR 1.181. No fee is required. Petitioner may request refund.

The petition is dismissed.

Review of FACTS

US Patent No 5, 816,918 issued on October 6, 1998 and based upon application serial no. 08/746755 filed November 14, 1996.

On April 14, 2003, reexamination control no. 90/006601 was filed requesting reexamination of the 5,816,918 patent based at least upon US Patent No. 5,711,715 to Ringo, which issued January 27, 1998 based upon application serial no. 08/555,218 filed November 8, 1995.

Reexamination was granted on June 3, 2003.

Prosecution has progressed to: claims 1-33 and 46-76 are patentable and/or confirmed and claims 34-45 and 78-82 stand rejected. All rejections stand on a foundation of the Ringo reference applied under both 35 USC 102 and 35 USC 103.

Owner has attempted to "swear behind" the Ringo reference using 37 CFR 1.131. The examiner found the evidence ineffective to overcome Ringo in that, in the examiner's determination, Ringo is claiming the same invention rendering the evidence inappropriate.

Owner now petitions for relief.

Analysis

Owner opines a perceived inconsistency in the regulatory scheme of Title 37 in as much as owner appears precluded from "swearing behind" the applied reference under 37 CFR 1.131 as the examiner has determined the claims under reexamination and the claims of the applied reference are directed to the same patentable invention while simultaneously owner appears precluded from pursuit of an interference proceeding in that interference proceedings are only available to applications and not available to reexamination proceedings. Owner feels placed in a situation in which the regulatory scheme places a duly issued patent in jeopardy and provides no remedy and argues "on this point, the regulations clash with the enabling statute". Owner submits the solution is to waive the rules, intervene in the prosecution and confirm the unconfirmed (rejected) claims.

Owner notes a further perceived inconsistency for which the Director's intervention and/or guidance is requested in that various of the dependent claims are rejected based upon Ringo in view of additional prior art. Owner appears to query how Ringo can claim the same invention while not anticipating. Owner suggests the director intervene in the prosecution and confirm these unconfirmed (rejected) claims for these reasons.

Owner's points are not well taken.

At the onset it is noted the examiner's determination that the instant claims and the claims of Ringo are claiming the same patentable invention rendering consideration of prior invention by owner inappropriate has direct impact upon the rejection of the claims under 35 USC 102 (e). As such, the propriety of this determination is subject matter appropriate for appeal and can not be resolved via petition.

As to owner's perceived inconsistency in that Ringo can not be said to be "claiming the same invention" if secondary prior art is necessary to reject owner's claims under 35 USC 103, owner is directed to MPEP 715.05 and MPEP chapter 2300. A 37 CFR 1.131 affidavit is ineffective to overcome a United States patent not only were there is verbatim correspondence between the claims of the application and of the patent, but also where there is no patentable distinction between the respective claims. Such includes establishing the differences between the claims would have been obvious to one of ordinary skill in the art at the time of the invention. Additional prior art may be used to show the differences would have been obvious and establish

the claims of the proceeding and the claims or the prior art patent are directed to patentably indistinct inventions.

Respectfully, patent owner is reminded that his patent is under reexamination. The patent is in jeopardy not because of any inconsistency between the regulations and the law: the patent is in jeopardy because it is under reexamination and rejected in view of newly discovered prior art. It is incumbent upon patentees to protect their inventions. The regulatory scheme and the law both provide remedy for situations where conflicting claims are issued to two different parties: any patent owner may up to one year after the issuance of a conflicting patent to another, seek relief by filing a reissue application in order to provoke interference. 35 USC 251 and 35 USC 135. That patent owner failed to take such actions in a timely manner is no basis for intervening in the prosecution of this reexamination proceeding. Owner is reminded that amendment of the instant patent claims is an available remedy to overcome the rejections based upon Ringo.

Pursuant to 37 CFR 1.4(c) owner is again reminded different matters may be considered by different branches or sections of the USPTO. In order to avoid confusion and delay, each distinct subject, inquiry or order must be contained in a separate paper. As this petition has been treated under 37 CFR 1.181, consideration of this petition under 37 CFR 1.182 or 37 CFR 1.183 will not be entertained herein.

PETITION DISMISSED

Karen M. Young

Karen M. Young, Director
Technology Center 3700

cc: 3rd party requestor

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# *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/006,601*.

PATENT NO. *5816918*.

ART UNIT *3714*.

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. |
|---|---|---|---|---|
| 90/006,601 | 04/15/2003 | 5816918 | BLLYP026.RE01 | 9274 |

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| ART UNIT | PAPER NUMBER |

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CENTRAL REEXAMINATION UNIT

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For Third Party Requester

In re *Ex Parte* Reexamination
Proceeding 90/006,601
U.S. Patent No. 5,816,918 to Kelly et al.
Filed: April 15, 2003
For: PRIZE REDEMPTION SYSTEM FOR GAMES

**DECISION ON PETITION UNDER 37 CFR 1.181 FOR DIRECTOR TO INVOKE SUPERVISORY AUTHORITY**

This is a decision on Patent Owner's petition filed April 7, 2008, under 37 CFR 1.181 requesting that the Director invoke supervisory authority and intervene in the prosecution of the above identified reexamination proceeding to confirm all of the pending claims of the subject patent.

The petition is granted to the extent that the prior decision has been fully reconsidered, and is **denied** as to the underlying relief requested. Thus, the request that the Director intervene in the prosecution of the reexamination proceeding 90/006,601 is **denied.**

## BACKGROUND

1. On April 15, 2003, a third party requested *ex parte* reexamination of claims 34, 35, and 37-46 of U.S. Patent 5,816,918 (the '918 patent) issued October 6, 1998. The resulting reexamination proceeding was assigned control number 90/006,601 (the '601 proceeding).

2. Reexamination of claims 34, 35, and 39-44 of the '918 patent was ordered on June 3, 2003.

3. Prosecution in the '601 proceeding has progressed to the point where the Office, on February 2, 2008, issued a final Office action rejecting claims 34-45 and 78-82 of the '918 patent. Claims 1-33 and 46-77 of the '918 stand patentable and/or confirmed.

   a. The rejections of the claims are based on U.S. Patent 5,711,715 to Ringo applied under 35 U.S.C. § 102(e) and under 35 U.S.C. § 103(a) in combination with other prior art references.

   b. Ringo was filed Nov. 8, 1995, issued on Jan. 27, 1998, and expired due to non-payment of maintenance fees on March 5, 2002.

   c. A declaration was filed May 14, 2004, and supplemented Dec. 7, 2004, under 37 CFR 1.131 for the purpose of establishing priority of invention to overcome the rejections based on Ringo.

   d. The declaration was considered by the examiner, but it was not deemed to be effective in overcoming the rejections, because Ringo claims the same invention as in the rejected claims of the '918 patent. The examiner stated that Ringo can only be overcome by establishing priority of invention through interference proceedings (if not commonly owned) or with a declaration under 37 CFR 1.130 (if commonly owned).

4. A petition under 37 CFR §§ 1.181 – 1.183 was filed on Sept. 7, 2007, requesting the Director to invoke supervisory authority and/or to suspend the rules in order to waive the requirements of 37 CFR 1.131 or suspend the rules to allow confirmation of the unconfirmed claims in proceeding '601. A decision on the petition from the Director of Technology Center 3700 was mailed on February 5, 2008, dismissing the request.

5. A notice of appeal of the final rejection was filed April 5, 2008.

6. The subject petition was filed April 7, 2008, along with a petition to the Director under 37 CFR § 1.183 to suspend the rules. On the same date an amendment after final rejection was filed, which has not been entered. A decision on the petition under §1.183 is being mailed concurrently herewith.

## STATUTE, REGULATION, AND EXAMINING PROCEDURE

37 CFR 1.181 states:

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § **41.3** of this title.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(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.

(d) Where a fee is required for a petition to the Director the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.

(e) Oral hearing will not be granted except when considered necessary by the Director.

(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.

(g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

37 CFR 1.131 states:

(a) 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. The effective date of a U.S. patent, U.S. patent application publication, or international application publication under PCT Article **21(2)** is the earlier of its publication date or date that it is effective as a reference under 35 U.S.C. **102(e)**. Prior invention may not be established under this section in any country other than the United States, a NAFTA country, or a WTO member country. Prior invention may not be established under this section before December 8, 1993, in a NAFTA country other than the United States, or before January 1, 1996, in a WTO member country other than a NAFTA country. Prior invention may not be established under this section if either:

(1) The rejection is based upon a U.S. patent or U.S. patent application publication of a pending or patented application to another or others which claims the same patentable invention as defined in § **41.203**(a) of this title, in which case an applicant may suggest an interference pursuant to §**41.202**(a) of this title; or

(2) The rejection is based upon a statutory bar.

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

MPEP § 1201 Appeal Introduction states (in part):

> The United States Patent and Trademark Office (Office) in administering the Patent Laws makes many decisions of a substantive nature which the applicant may feel deny him or her the patent protection to which he or she is entitled. The differences of opinion on such matters can be justly resolved only by prescribing and following judicial procedures. Where the differences of opinion concern the denial of patent claims because of prior art or other patentability issues, the questions thereby raised are said to relate to the merits, and appeal procedure within the Office and to the courts has long been provided by statute (35 U.S.C. **134**).
>
> The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Director of the U.S. Patent and Trademark Office (Director) should be carefully observed. The Board will not ordinarily hear a question that should be decided by the Director on petition, and the Director will not ordinarily entertain a petition where the question presented is a matter appealable to the Board.

MPEP § 2284 Copending *Ex Parte* Reexamination and Interference Proceedings states:

> Although a *patent* being reexamined via a reexamination proceeding may become involved in an interference proceeding, the reexamination proceeding itself can never be involved in an interference proceeding. See 35 U.S.C. **135** subsection (a) which states that "[w]henever an application is made for a patent which, in the opinion of the Director, would interfere with any pending *application*, or with any unexpired *patent*, an interference may be declared" (emphasis added). The reexamination proceeding is neither an application nor a patent.

## DECISION

Petitioner requests that the Director intervene in the prosecution of the '601 proceeding to confirm all of the pending claims of the '918 patent. Petitioner states that there is no regulatory remedy for the prosecution situation in the '601 proceeding, because the Office asserts that a declaration under 37 CFR § 1.131 cannot be used to show priority of invention over the Ringo reference because the patent and the Ringo reference claim the same invention, yet the Ringo reference cannot be shown to interfere with the '918 patent as it is expired.

Petitioner requests that the Ringo reference be applied only as a publication and not as a patent, since it is expired, or that an interference be declared between the claims of Ringo and the '918 patent claims at issue. Petitioner also asserts that Ringo is an improper reference under 35 U.S.C. § 102(e) as it does not anticipate the claims as evidenced by the addition of other prior art references under the obviousness rejections also present in the '601 proceeding. Additionally, petitioner argues that the Office may not require patent owners to police the issuance of potentially interfering patents.

For the Director to intervene, petitioner must show that the February 5, 2008 decision by the Group Director, mailed in response to the last petition on this ground, was made in clear error. Petitioner has not provided a showing of clear error. A petition under 37 CFR 1.181, requesting that the Director of the USPTO exercise his or her supervisory authority and vacate the examiner's decision, will not be entertained except where there is a showing of clear error. See

*Ex parte Hartley*, 1908 C.D. 224, 136 O.G. 1767 (Comm'r Pat. 1908). The Technology Center Director's ultimate decision is entitled to an administrative presumption of correctness in the absence of a convincing showing of error. A review of the record indicates that the Technology Center Director did not abuse her discretion, or act in an arbitrary and capricious manner, in the petition decision of February 5, 2008. The record establishes that the Technology Center Director had a reasonable basis to support her findings and conclusion.

Specifically, the February 5, 2008 decision appropriately responds to petitioner's arguments, noting that the propriety of the Ringo reference as it is applied under 35 U.S.C. § 102(e) and/or § 103 is an issue that should be addressed by appeal and is inappropriate for a petition. See MPEP § 1201. The propriety of the proffered declaration under 37 CFR 1.131 depends on the resolution of that appealable issue. As for the possibility of declaring an interference, a reexamination proceeding may never be involved in an interference, as it is neither an application nor a patent. See MPEP § 2284. Moreover, the Office does not have jurisdiction to declare an interference between issued patents. The owner of an interfering patent may request relief against the owner of another patent by civil action. 35 U.S.C. § 291.

Finally, the February 5, 2008 decision notes that petitioner patent owner has had several remedies for relief to which patent owner did not avail itself. The petitioner states that the Office is requiring that a patent owner police the issuance of potentially interfering patents. However, this is not the case. The prior decision merely notes that any patent owner **may,** up to one year after issuance of a conflicting patent to another, seek relief by filing a reissue application in order to provoke an interference. This is a remedy that was clearly available to patent owner. The present situation in which an interference cannot be declared by the Office due in the present reexamination proceeding and the lack of jurisdiction over interfering issued patents is the consequence of patent owner's failure to avail itself of the reissue remedy noted above. The decision also points out that another remedy for this situation could be to amend the claims in the '601 proceeding to overcome the rejections based on Ringo; no error is found with respect to that point.

For the reasons set forth above, the petition will not be granted as to the request that the Director invoke supervisory authority and confirm the patent claims.

## CONCLUSION

1. The petition under 37 CFR 1.181 is granted to the extent that the prior decision has been fully reconsidered, and is **denied** as to the underlying relief requested. The Director will not intervene in the prosecution of the reexamination proceeding 90/006,601.

2. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit for further handling and examination not inconsistent with this decision.

3. This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP § 1002.02.

4. Telephone inquiries concerning this decision should be directed to Caroline Dennison at (571) 272-7729 or in her absence, Kenneth Schor at 571-272-7710.

Robert A. Clarke

Robert Clarke
Director, Office of Patent Legal Administration

June 13, 2008
C:\kiva\kenpet 7\CRU+TC\6601_181 deny supr authority -131 re interfering claims

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| 90/006,601 | 04/15/2003 | 5816918 | BLLYP026.RE01 | 9274 |

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| EXAMINER | |
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| ART UNIT | PAPER NUMBER |

DATE MAILED: 06/17/2008

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
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MARC S. KAUFMAN
NIXON PEABODY LLP
401 9TH ST., NW, SUITE 900
WASHINGTON, DC 20004-2128

Date:
MAILED
JUN 17 2008
CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90006601
PATENT NO. : 5816918
ART UNIT : 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 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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JUN 17 2008

CENTRAL REEXAMINATION UNIT

For Patent Owner

Marc S. Kaufman
Nixon Peabody LLP
401 9th St., NW, Suite 900
Washington, DC 20004-2128

For Third Party Requester

In re *Ex Parte* Reexamination
Proceeding 90/006,601
U.S. Patent No. 5,816,918 to Kelly et al.
Filed: April 15, 2003
For: PRIZE REDEMPTION SYSTEM FOR GAMES

**DECISION ON PETITION UNDER 37 CFR 1.183 FOR DIRECTOR TO SUSPEND THE RULES**

This is a decision on Patent Owner's petition filed April 7, 2008, under 37 CFR 1.183 requesting that the Director suspend the rules. The petition is titled as a petition under 37 CFR 1.183, but the body of the document repeatedly refers to 37 CFR 1.182. As a request for suspension of the rules is appropriately filed under § 1.183, the petition is being treated under the rule in which the document is titled.

This petition is before the Office of Patent Legal Administration. The fee under 37 CFR 1.17(f) of $400 has been charged to applicant's deposit account.

The petition requesting that the Director suspend the rules in the reexamination proceeding 90/006,601 is **DISMISSED**.

## BACKGROUND

1. On April 15, 2003, a third party requested *ex parte* reexamination of claims 34, 35, and 37-46 of U.S. Patent 5,816,918 (the '918 patent) issued October 6, 1998. The resulting reexamination proceeding was assigned control number 90/006,601 (the '601 proceeding).

2. Reexamination of claims 34, 35, and 39-44 of the '918 patent was ordered on June 3, 2003.

3. Prosecution in the '601 proceeding has progressed to the point where the Office, on February 2, 2008, issued a final Office action, rejecting claims 34-45 and 78-82 of the '918 patent. Claims 1-33 and 46-77 of the '918 stand patentable and/or confirmed.

   a. The rejections of the claims are based on U.S. Patent 5,711,715 to Ringo applied under 35 U.S.C. § 102(e) and under 35 U.S.C. § 103(a) in combination with other prior art references.

   b. Ringo was filed Nov. 8, 1995, issued on Jan. 27, 1998, and expired due to non-payment of maintenance fees on March 5, 2002.

   c. A declaration was filed May 14, 2004, and supplemented Dec. 7, 2004, under 37 CFR 1.131 for the purpose of establishing priority of invention to overcome the rejections based on Ringo.

   d. The declaration was considered by the examiner, but it was not deemed to be effective in overcoming the rejections, because Ringo claims the same invention as in the rejected claims of the '918 patent. The examiner stated that Ringo can only be overcome by establishing priority of invention through interference proceedings (if not commonly owned) or with a declaration under 37 CFR 1.130 (if commonly owned).

4. A petition under 37 CFR §§ 1.181 – 1.183 was filed on Sept. 7, 2007, requesting the Director to invoke supervisory authority and/or to suspend the rules in order to waive the requirements of 37 CFR 1.131, or to suspend the rules to allow confirmation of the unconfirmed claims in proceeding '601. A decision on the petition from the Director of Technology Center 3700 was mailed on February 5, 2008 dismissing the request.

5. A notice of appeal of the final rejection was filed April 5, 2008.

6. The subject petition was filed April 7, 2008, along with a petition to the Director under 37 CFR 1.181 to invoke supervisory authority. On the same date an amendment after final rejection was filed, which has not been entered. A decision on the petition under § 1.181 is being mailed concurrently herewith.

## STATUTE, REGULATION, AND EXAMINING PROCEDURE

37 CFR 1.183 states:

> In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the 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 1.131 states:

(a) 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. The effective date of a U.S. patent, U.S. patent application publication, or international application publication under PCT Article **21(2)** is the earlier of its publication date or date that it is effective as a reference under 35 U.S.C. **102(e)**. Prior invention may not be established under this section in any country other than the United States, a NAFTA country, or a WTO member country. Prior invention may not be established under this section before December 8, 1993, in a NAFTA country other than the United States, or before January 1, 1996, in a WTO member country other than a NAFTA country. Prior invention may not be established under this section if either:

(1) The rejection is based upon a U.S. patent or U.S. patent application publication of a pending or patented application to another or others which claims the same patentable invention as defined in §**41.203**(a) of this title, in which case an applicant may suggest an interference pursuant to §**41.202**(a) of this title; or

(2) The rejection is based upon a statutory bar.

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

MPEP § 1201 Appeal Introduction states (in part):

The United States Patent and Trademark Office (Office) in administering the Patent Laws makes many decisions of a substantive nature which the applicant may feel deny him or her the patent protection to which he or she is entitled. The differences of opinion on such matters can be justly resolved only by prescribing and following judicial procedures. Where the differences of opinion concern the denial of patent claims because of prior art or other patentability issues, the questions thereby raised are said to relate to the merits, and appeal procedure within the Office and to the courts has long been provided by statute (35 U.S.C. **134**).

The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Director of the U.S. Patent and Trademark Office (Director) should be carefully observed. The Board will not ordinarily hear a question that should be decided by the Director on petition, and the Director will not ordinarily entertain a petition where the question presented is a matter appealable to the Board.

MPEP § 2284 Copending *Ex Parte* Reexamination and Interference Proceedings states:

Although a *patent* being reexamined via a reexamination proceeding may become invdved in an interference proceeding, the reexamination proceeding itself can never be involved in an interference proceeding. See 35 U.S.C. **135** subsection (a) which states that "[w]henever an application is made for a patent which, in the opinion of the Director, would interfere with any pending *application*, or with any

unexpired *patent*, an interference may be declared" (emphasis added). The reexamination proceeding is neither an application nor a patent.

## DECISION

Petitioner requests confirmation of the unconfirmed claims and requests that the Director "suspend the rules." Specifically, patent owner requests suspension of the rules to either confirm the claims or declare an interference between Ringo and the '918 patent. Petitioner has not specified the particular rule or rules for which suspension is requested. Therefore the petition is incomplete. For at least this reason, the petition is dismissed.

Additionally, it is not apparent that the suspension of any rule could result in the relief requested. The petition requests that the Office declare an interference in the present '601 reexamination proceeding and the claims of Ringo. First, an interference cannot be declared in the '601 proceeding, because a reexamination proceeding may never be involved in an interference, as it is neither an application nor a patent. Second, the Office does not have jurisdiction to declare an interference between issued patents. Rather, the owner of an interfering patent may request relief against the owner of another patent by a civil action. 35 U.S.C. § 291. There is no rule that could be waived or suspended to effect relief for an issue over which the Office lacks jurisdiction.

The petition also requests that use of Ringo as a reference under 35 U.S.C. § 102 and/or § 103 be reconsidered and that the declaration under 37 CFR 1.131 be deemed effective to show priority of invention. The propriety of the Ringo reference as it is applied under 35 U.S.C. § 102(e) and/or § 103 is an issue to be addressed by appeal and is inappropriate for a petition. See MPEP § 1201. The propriety of the declaration under 37 CFR 1.131 depends on the resolution of that appealable issue. Thus, there is no rule that could be waived or suspended to effect relief of an issue that should be appealed.

In addition, it is to be noted that, in order for grant of any petition under 37 CFR 1.183, a petitioner must show (1) that this is an extraordinary situation where (2) justice requires waiver of the rule. *In re Sivertz*, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985). Petitioner has not shown that either conditions (1) and (2) exist in this case.

As for the failure of the patent owner to timely avail himself of filing a reissue application in order to possibly invoke an interference prior to the expiration of the Ringo patent, such circumstances resulting from petitioner's, or petitioner's counsel's, failure to exercise due care, or lack of knowledge of, or failure to properly apply, the patent statutes or rules of practice are not, in any event, extraordinary circumstances where the interests of justice require the granting of relief. *See In re Tetrafluor, Inc.*, 17 USPQ2d 1160, 1162 (Comm'r Pats. 1990); *In re Bird & Son, Inc.* 195 USPQ 586, 588 (Comm'r Pats. 1977). While petitioner urges that a patent owner

has no "duty" to police its patents, the exercise of due care and prudence would certainly call for a patent owner to do so.

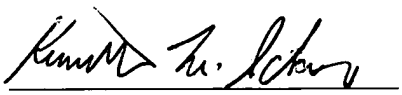
For the reasons set forth above, the petition will not be granted as to the request for waiver of the rules.

## CONCLUSION

1. The petition under 37 CFR 1.183 to suspend the rules is **dismissed**.

2. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit for further handling and examination not inconsistent with this decision.

3. Telephone inquiries concerning this decision should be directed to Caroline Dennison at (571) 272-7729 or in her absence, Kenneth Schor at 571-272-7710.



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

June 13, 2008
C:\kiva\kenpet 7\6601_183 not suspend re 131 re interfering claims

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CENTRAL REEXAMINATION UNIT

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For Third Party Requester

In re *Ex Parte* Reexamination
Proceeding 90/006,601
U.S. Patent No. 5,816,918 to Kelly et al.
Filed: April 15, 2003
For: PRIZE REDEMPTION SYSTEM FOR GAMES

**DECISION ON PETITION UNDER 37 CFR 1.183 DENYING REQUEST FOR DIRECTOR TO SUSPEND THE RULES**

This is a decision on patent owner's Renewed Petition to Director Under 37 CFR § 1.183 filed August 18, 2008, requesting that the Director suspend the rules.

This petition is before the Office of Patent Legal Administration. The fee under 37 CFR 1.17(f) of $400 has been charged to applicant's deposit account.

The petition requesting that the Director suspend the rules in the reexamination proceeding 90/006,601 is **DENIED**.

## BACKGROUND

1. On April 15, 2003, a third party requested *ex parte* reexamination of claims 34, 35, and 37-46 of U.S. Patent 5,816,918 (the '918 patent) issued October 6, 1998. The resulting reexamination proceeding was assigned control number 90/006,601 (the '601 proceeding).

2. In an Order Granting Request for *Ex parte* Reexamination mailed June 3, 2003, it was determined that a substantial new question of patentability of claims 34, 35, and 39-44 of

the '918 patent was raised. The order stated that the remainder of the patent claims would also be reexamined, i.e., claims 1-77 would be reexamined.

3. Prosecution in the '601 proceeding has progressed to appeal, during which claims 78-82 were added. A final Office action rejecting claims 34-45 and 78-82 and confirming claims 1-33 and 46-77 of the '918 patent was issued on February 2, 2008. The rejection of claims 34-35 and 78-82 was appealed on April 5, 2008, and is detailed below. . For the purpose of this decision, the relevant facts pertaining to the prosecution are as follows:

   a. All of the outstanding rejections are based on U.S. Patent 5,711,715 to Ringo, which is applied under 35 U.S.C. § 102(e) and also under 35 U.S.C. § 103(a) in combination with other prior art references.

   b. Ringo was filed Nov. 8, 1995, and issued as a patent on Jan. 27, 1998. The Ringo patent expired due to non-payment of maintenance fees on March 5, 2002.

   c. A declaration under 37 CFR 1.131 was filed by patent owner on May 14, 2004, and supplemented on Dec. 7, 2004, for the purpose of establishing priority of invention of the claims of record (in the present '601 proceeding) to overcome the rejections based on Ringo.

   d. The declaration was considered by the examiner, but it was not deemed to be effective in overcoming the rejections, because Ringo claims the same invention as do the rejected claims of the '918 patent. The examiner's Office action states that Ringo can only be overcome by establishing priority of invention through interference proceedings (if not commonly owned) or with a declaration under 37 CFR 1.130 (if commonly owned).

4. On Sept. 7, 2007, prior to the final rejection, patent owner filed a petition under 37 CFR §§ 1.181 – 1.183 requesting the Director to invoke supervisory authority and/or to suspend the rules in order to waive the requirements of 37 CFR 1.131, or to suspend the rules to allow confirmation of the unconfirmed claims in the present '601 proceeding. A decision dismissing the petition from the Director of Technology Center 3700 was mailed on February 5, 2008, after the final rejection was mailed.

5. On April 7, 2008, an amendment after final rejection was filed. On the same date, a petition under 37 CFR 1.183 requesting that the Director suspend the rules (the Rule 1.183 petition) and a petition under 37 CFR 1.181 requesting that the Director invoke supervisory authority (the Rule 1.181 petition) were filed.

6. An appeal brief was filed June 5, 2008.

7. On June 17, 2008, a decision dismissing the Rule 1.183 petition and a decision denying the Rule 1.181 petition were issued by the Office.

8. On June 20, 2008, an advisory action was issued indicating that the April 7, 2008 amendment did not overcome all of the rejections and that the amendment would not be entered for purposes of appeal.

9. A notification that the appeal brief filed June 5 was non-compliant was mailed July 3, 2008. In response, a corrected appeal brief was filed Aug. 8, 2008.[1]

10. The subject "Renewed Petition to Director Under 37 CFR § 1.183" was filed Aug. 18, 2008.

## STATUTE, REGULATION, AND EXAMINING PROCEDURE

37 CFR 1.183 states:

> In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the 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 1.131 states:

> (a) 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. The effective date of a U.S. patent, U.S. patent application publication, or international application publication under PCT Article **21(2)** is the earlier of its publication date or date that it is effective as a reference under 35 U.S.C. **102(e)**. Prior invention may not be established under this section in any country other than the United States, a NAFTA country, or a WTO member country. Prior invention may not be established under this section before December 8, 1993, in a NAFTA country other than the United States, or before January 1, 1996, in a WTO member country other than a NAFTA country. Prior invention may not be established under this section if either:
>
> (1) The rejection is based upon a U.S. patent or U.S. patent application publication of a pending or patented application to another or others which claims the same patentable invention as defined in § **41.203**(a) of this title, in which case an applicant may suggest an interference pursuant to § **41.202**(a) of this title; or
>
> (2) The rejection is based upon a statutory bar.
>
> (b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

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[1] A certificate of mailing showing a mail deposit date of Monday, August 4, 2008 was included in the filing.

MPEP § 1201 Appeal Introduction states (in part):

> The United States Patent and Trademark Office (Office) in administering the Patent Laws makes many decisions of a substantive nature which the applicant may feel deny him or her the patent protection to which he or she is entitled. The differences of opinion on such matters can be justly resolved only by prescribing and following judicial procedures. Where the differences of opinion concern the denial of patent claims because of prior art or other patentability issues, the questions thereby raised are said to relate to the merits, and appeal procedure within the Office and to the courts has long been provided by statute (35 U.S.C. **134**).
>
> The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Director of the U.S. Patent and Trademark Office (Director) should be carefully observed. The Board will not ordinarily hear a question that should be decided by the Director on petition, and the Director will not ordinarily entertain a petition where the question presented is a matter appealable to the Board.

MPEP § 2284 Copending *Ex Parte* Reexamination and Interference Proceedings states:

> Although a *patent* being reexamined via a reexamination proceeding may become involved in an interference proceeding, the reexamination proceeding itself can never be involved in an interference proceeding. See 35 U.S.C. **135** subsection (a) which states that "[w]henever an application is made for a patent which, in the opinion of the Director, would interfere with any pending *application*, or with any unexpired *patent*, an interference may be declared" (emphasis added). The reexamination proceeding is neither an application nor a patent.

## DECISION

Petitioner patent owner requests confirmation of the unconfirmed claims and requests that the Director "suspend the rules." Specifically, patent owner requests suspension of the rules to either confirm the claims or declare an interference between Ringo and the '918 patent. Petitioner further requests suspension of the requirement of 37 CFR 1.131 that an affidavit not be applicable against a U.S. patent claiming the same invention, or a suspension of requirements of "various regulations" excluding reexamination proceedings from interferences. Petitioner has only specifically identified 37 CFR 1.131 in the request for suspension.

I. The request for suspension of requirements of "various regulations":

Requesting suspension of requirements of "various regulations" to confirm the claims or declare an interference does not sufficiently identify the vehicle for providing the relief which petitioner requests. This inadequacy was identified in the June 17, 2008 decision and has not been remedied herein. Since the "various regulations" have not been identified, such relief cannot be granted.

In addition, no suspension of any rule could result in the relief requested. The petition requests that the Office declare an interference in the present '601 reexamination proceeding and the claims of Ringo. First, an interference cannot be declared in the '601 proceeding, because a

reexamination proceeding may never be involved in an interference, as it is neither an application nor a patent. 35 U.S.C. § 135. Second, the Office does not have jurisdiction to declare an interference between issued patents. Rather, the owner of an interfering patent may request relief against the owner of another patent by a civil action. 35 U.S.C. § 291. There is no rule that could be waived or suspended to effect relief for an issue over which the Office lacks jurisdiction.

Petitioner cites *Regents of University of California v. University of Iowa Research Foundation*, 455 F.3d 1371, 79 USPQ2d 1687 (Fed. Cir. 2006) for the proposition that when the regulations prohibit an interference, the Commissioner should declare the interference and thus (implicitly) suspend the rules. Petitioner states that this situation is no different. This is not correct. First, *Regents* related to declaring an interference between an application and a patent where an interference exists. In this proceeding, no application exists. Second, *Regents* does not involve an implicit suspension of the rules. Rather, the case relates to the proper interpretation of the interference statute, specifically § 135(b)(1) and the required demonstration of a nexus between pre- and post-critical date claims.

II. The request for suspension of the requirements of 37 CFR 1.131:

The petition also requests that use of Ringo as a reference under 35 U.S.C. § 102 and/or § 103 be reconsidered and that the requirements of 37 CFR 1.131 be suspended so that the declaration can be used to show priority of invention. The propriety of the rejection under 35 U.S.C. § 102(e) and/or § 103 as the Ringo reference is applied is an issue to be addressed by appeal and is inappropriate for a petition. See MPEP § 1201. The effectiveness of the declaration under 37 CFR 1.131 depends on the resolution of that appealable issue. It is not directed to a petitionable issue. Moreover, patent owner has already filed the notice of appeal and appeal brief relating to this issue.

In addition, it is to be noted that, in order for grant of any petition under 37 CFR 1.183, a petitioner must show (1) that this is an extraordinary situation where (2) justice requires waiver of the rule. *In re Sivertz*, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985). Petitioner has not shown that either conditions (1) and (2) exists in this case. Although petitioner states that the extraordinary nature of the facts requires suspension of the rules, the rejection of the claims is not extraordinary and is well handled in the ordinary course of an appeal. In fact, petitioner has already availed himself of this remedy by commencing an appeal of the examiner's rejection to the Board of Patent Appeals & Interferences.

III. Additional point:

Also, as to any question of declaring an interference between Ringo and the '918 patent, and establishing priority of invention, petitioner patent owner's failure to request an interference proceeding with Ringo when the '918 patent was an application does not provide an extraordinary situation, when justice requires rule waiver. Ringo issued as a patent on Jan. 27,

1998. The '918 patent did not issue until October 6, 1998. Petitioner patent owner's failure to timely request an interference proceeding with Ringo when the '918 patent was an application is an exercise of a lack of diligence, and such does not provide an extraordinary situation, when justice would require Office intervention, even if there was petition-relief available in this instance (which there is not, as discussed above).

For the reasons set forth above, the present petition will not be granted.

## CONCLUSION

1. The petition under 37 CFR 1.183 to suspend the rules is **denied**.

2. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit for further handling and reexamination not inconsistent with this decision.

3. This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP § 1002.02.

4. Telephone inquiries concerning this decision should be directed to Caroline Dennison at (571) 272-7729 or, in her absence, Kenneth M. Schor at 571-272-7710.

Robert A. Clarke
Director, Office of Patent Legal Administration

September 5, 2008
C:\kiva\kenpet 7\6601_183 not suspend re 131 re interfering claims-denial

UNITED STATES PATENT AND TRADEMARK OFFICE

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APR 22 2009

CENTRAL REEXAMINATION UNIT

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Marc S. Kaufman : (For Third-Party Requester)
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WASHINGTON, DC 20004-2128 :

*In re Kelly et al.* : DECISION ON
Reexamination Proceeding : PETITION UNDER 37 CFR
Control No. 90 / 006,601 : 1.137 (b) FOR ENTRY OF
Request Deposited: April 13, 2003 : REPLY BRIEF
For: U.S. Patent No.5,816,918 :

This is a decision on the petition filed on February 27, 2009 by which Patent Owner requests entry of the Reply Brief which was received untimely by the Office. The petition was filed under 37 CFR 1.550(e)(2) and 37 CFR 1.137(b) and was accompanied by the requisite fee under 37 CFR 1.17(m). The petition is being construed as a request for reconsideration of the decision of the examiner and relief is granted.

## REVIEW OF RELEVANT FACTS

1. On April 15, 2003, a third party requested *ex parte* reexamination of claims 34, 35, and 37-46 of U.S. Patent 5,816,918 (the '918 patent) issued October 6, 1998. The resulting reexamination proceeding was assigned control number 90/006,601 (the '601 proceeding).

2. Reexamination of claims 34, 35, and 39-44 of the '918 patent was ordered on June 3, 2003.

3. A notice of appeal of the final rejection was filed on April 5, 2008.

4. An acceptable appeal brief was received from patent owner on August 8, 2008.

5. On December 12, 2008 the Office issued an examiner's answer to the appeal brief.

6. On February 10, 2009 the office received a reply brief from patent owner.

7. An advisory action was issued by the examiner on February 19, 2009 indicating non-entry of the reply brief as untimely received.

## DECISION

Owner's reply brief, if filed, was due February 9, 2009. The reply brief was received via EFS web at 2:58:31 am on February 10, 2009. No certificate of transmission was included with the paper. At 3:01:57 am February 10, 2009 a certificate of transmission was received by the Office. This certificate was not accompanied by any paper. On February 19, 2009 the examiner issued an advisory action notifying owner of the non-entry of the reply brief. Owner's petition admits these facts, submits the delay in filing the reply brief was unintentional and requests entry of the paper.

The applicable regulations germane to the issue include:

***§ 41.41 Reply brief.***

*(a)*

*(1) Appellant may file a reply brief to an examiner's answer within two months from the date of the examiner's answer.*

*(2) A reply brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.*

*(b) A reply brief that is not in compliance with paragraph (a) of this section will not be considered. Appellant will be notified if a reply brief is not in compliance with paragraph (a) of this section.*

*(c) Extensions of time under § 1.136 (a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136 (b) of this title for extensions of time to reply for patent applications and § 1.550 (c) of this title for extensions of time to reply for ex parte reexamination proceedings.*

***§ 1.550 Conduct of ex parte reexamination proceedings.***

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*(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 prosecution in the ex parte reexamination proceeding will be a terminated prosecution, and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under § 1.570 in accordance with the last action of the Office.*

***§ 1.137 Revival of abandoned application, terminated or limited reexamination prosecution, or lapsed patent.***

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*(b) 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 prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(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.*

As can be appreciated, 37 CFR 1.550(e) and 37 CFR 1.137(b) relate to reexamination proceedings which become terminated due to untimely reply. As a reply brief is not a required response to an office action, failure to timely file a reply brief does not operate to terminate a reexamination proceeding. Accordingly, there is no basis to consider revival under 37 CFR 1.137(b) in the instant proceeding as there has been no termination of the '601 proceeding.

However in the interest of justice and special dispatch, the petition is being treated as a request for reconsideration of the examiner's decision to deny entry of the reply brief. On a bare record, the examiner is compelled to deny entry. However, MPEP 710.02(d) outlines the difference between shortened statutory periods for reply and specified time limits. Section (C) therein states: "Where an applicant replies a day or two after the specified time, the delay may be excused by the examiner if satisfactorily explained." Review of the record in light of owner's petition statements makes clear the response was filed via EFS web just prior to midnight local time on the due date of the response and from west coast. The response omitted the certificate of transmission, thus was received three hours later in local time on the east coast. Realizing the omission, owner supplied the missing certificate of transmission but failed to include a second copy of the response. Owner then called the USPTO admitting his error and sought proper corrective action. The delay has been satisfactorily explained, the delay is excused, and the reply brief will be entered into the '601 record.

## CONCLUSION

1. Petitioner's request is **GRANTED.** The reply brief received February 10, 2009 will be entered. Petitioner's deposit account will be credited for the overpayment of the petition fee under 37 CFR 1.17(m). The proceeding will be forwarded to the examiner of record for acknowledgement of the reply brief and any appropriate response thereto.

2. **All** correspondence relating to this *ex parte* reexamination proceeding should be directed:

By EFS: Registered users may submit via the electronic filing system EFS-Web, at **https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html**.

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

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

3. Telephone inquiries related to this decision should be directed Jessica Harrison at (571) 272-4449.

Gregory Morse
Director, Central Reexamination Unit

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

1/19/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Issac A. Molnar, Esq.

Jones Day

North Point 901 Lakeside Avenue

Cleveland, OH 44114

## *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/006603

PATENT NO. 6,105,871

ART UNI 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/006,603 | 04/16/2003 | 6105871 | 967298600005 | 9272 |

23623 7590 01/19/2007

AMIN, TUROCY & CALVIN, LLP
1900 EAST 9TH STREET, NATIONAL CITY CENTER
24TH FLOOR,
CLEVELAND, OH 44114

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 01/19/2007

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

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Commissioner for Patents
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Himanshu S. Amin
Amin & Turocy, LLP
1900 9th Street
Cleveland, OH 44114

(For Patent Owner)

MAILED

JAN 19 2007

CENTRAL REEXAMINATION UNIT

Issac A. Molnar
Jones, Day, Reeves & Pogue
North Point
901 Lakeside Avenue
Cleveland, OH 44114

(For Third Party Requester)

In re Reexamination Proceedings :
CAMPO, James A. et al. :
Control No. 90/006603 :
Filed: April 16, 2003 :
Attorney Docket No. 967298600005 :

DECISION ON PETITION

This is a decision on the December 21, 2006 patent owner (a) petition under 37 CFR 1.137(b) for entry of late papers based upon unintentional delay and (b) request for waiver of the fees required for such entry.

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

The petition for entry of late papers is **granted.**

The request for waiver of the fees required for entry of late papers is not granted, and it is **dismissed.**

## DECISION

37 CFR 1.137(b) states:

> "(b) *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 §§ 1.55(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."

1. A review of the present petition reveals that it includes correspondence denoted as a Notice of Appeal submitted December 21, 2006. As such, petitioner has provided the response required by 37 CFR 1.137(b) (item 1). In addition, payment of the requisite unintentional delay fee for other than small entity was made (item 2). Finally, the petition contains the proper statement for unintentional delay in filing the required response (item 3).

Accordingly, the present petition under 37 CFR 1.137(b) includes the requisite response (item 1), the $1500.00 petition fee under 37 CFR 1.17(m) (item 2), and the requisite statement (item 3), and will be granted.

2. The terminal disclaimer proffered with the instant petition is not required for the granting of the petition, since it is not applicable in reexamination proceedings. 37 CFR 1.137(d)(3) states (emphasis added):

> "**The provisions of paragraph (d)(1) of this section do not apply** to applications for which revival is sought solely for purposes of copendency with a utility or plant application filed on or after June 8, 1995, to lapsed patents, to reissue applications, **or to reexamination proceedings**."

See also the text appearing in MPEP Section 711.03(c) (8th Edition Rev. 5, August 2006) under the heading "G. Terminal Disclaimer Requirement."

Because the proffered terminal disclaimer and its accompanying fee are inapplicable in reexamination proceedings: (1) the terminal disclaimer has not been entered, and (2) the terminal disclaimer fee of $130 paid with the petition is hereby returned to petitioner, by crediting petitioner's deposit account # 50-1063.

3. Petitioner asserts that a refund of the fee required for entry of late papers is proper due to Office delay in mailing an advisory Office action responsive to petitioner's May 2, 2006 After Final Response. Petitioner's request for a waiver of fee under 37 CFR § 1.17(m), will not be granted.

A proper response to a final rejection in an *ex parte* reexamination proceeding must be either an appeal (Notice of Appeal) or an amendment that places the proceeding in *prima facia* condition for allowance. Submission of an after-final amendment that does not place the case *prima facia* in condition for allowance is permitted under the rules, but entry of such an amendment is not a matter or right. While the Office attempts to promptly respond to an amendment after final rejection, there are those instances where delays do occur, e.g. the instant reexamination. However, it is clear from 37 CFR 1.116 that termination of the prosecution of the reexamination proceeding is risked when an amendment after a final Office action is mailed. 37 CFR 1.116(c) states:

> "The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the ... reexamination proceeding from its condition as subject to appeal or to save ... the reexamination prosecution from termination under § 1.550(d) or § 1.957(b) or limitation of further prosecution under § 1.957(c)."

The rule clearly indicates that the mere filing of an amendment does not relieve petitioner of the duty of taking appropriate action to avoid expiration of the statutory term. Therefore, even though petitioner did not receive an Advisory Office Action prior to the expiration of the six-month statutory period, the only right petitioner was entitled to was that of appealing the final rejection. The statutory period lapsed for failure on the part of petitioner to file an appeal. When petitioner did not receive a response before the expiration of the six-month statutory period, the appropriate action would have been to (1) inquire as that the status of the reexamination,[1] or (2) file a Notice of Appeal to maintain the pendency of the reexamination.

See MPEP 711.03(c)(III)(c)(2) which explicates a parallel rationale as to why failure to maintain pendency of an application in the face of Office delay in issuance of an Advisory Office Action for an After Final Response does not merit "unavoidable delay" and the lower fees associated with "unavoidable delay". If such a circumstance does not merit the lower fees associated with unavoidable delay and must be petitioned as "unintentional delay," then the present situation certainly does not merit waiver of the unintentional delay petition fee under 37 CFR 1.17(m).

Accordingly, petitioner's request for a refund of an unintentional abandonment of a pending application will not be granted.

## CONCLUSION

1. The petition for entry of late papers is **granted.**

2. The request for a waiver of the fees required for entry of late papers is **dismissed.**

3. The time period for filing an appeal brief and the appeal brief fee is set to run two (2) months from the date of this decision.

4. Jurisdiction over the reexamination proceeding is being returned to the Central Reexamination Unit (CRU).

5. Any further communication as to the merits of the reexamination proceeding should be directed to examiner Margaret Rubin in the CRU, who can be reached at (571) 272-1756.

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[1] E.g., the patent owner could have telephoned the examiner prior to the expiration of the statutory period for response to find out whether the proffered amendment after final rejection placed the proceeding in condition for allowance, without the need for further action by patent owner, to thereby obtain an indication of such in writing prior to the expiration of the statutory period.

6. Telephone inquiries with regard 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

1-16-07
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Paper No. 7

Mark Pohl
PHARMACEUTICAL PATENT ATTORNEYS
POHL & ASSOCIATES
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(For Patent Owner)

Stephen P. McNamara, Esq.
ST. ONGE, STEWARD, JOHNSON & REENS, LLC
986 Bedford Street
Stamford, CT 06905

(For Requester)

MAILED
DEC 01 2003
REEXAM UNIT

In re Fleischner
Reexamination Proceeding
Control No. 90/006,605
Filed: April 17, 2003
For: U.S. Patent No. 6,503,529

In re reissue application of
Fleischner
Application No. 10/641,549
Filed: August 18, 2003
For: U.S. Patent No. 6,503,529

**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. 6,503,529 issued to Fleischner, on January 7, 2003.

2. A request for reexamination of the '529 patent was filed by a third party requester on April 17, 2003, and the resulting reexamination proceeding was assigned Control No. 90/006,605.

3. On June 12, 2003, reexamination was ordered in the '6605 proceeding.

4. Patent owner filed a reissue application based on the '529 patent, on August 18, 2003, which was assigned Application No. 10/641,549. Claims 3-18 were added.

5. Notice of the filing of the reissue application was published in the *Official Gazette* on November 4, 2003.

DO NOT ENTER

## 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 '6605 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 '6605 reexamination file shows that no amendments were made in the reexamination file.

A review of the reissue (Application No. 10/641,549) prosecution history shows that the reissue application was published in the *Official Gazette* on November 4, 2003. In the reissue application, patent owner has added claims 3-18. 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. 10/641,549, and Control Number 90/006,605. 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.

DO NOT ENTER

It should be noted that the preliminary amendment filed on August 18, 2003, adding claims 3-18 in the reissue application, is **not** in the proper format for reissue applications, because the newly added claims are **not** underlined. **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).

## CONCLUSION

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

2. The reissue application file and the reexamination file are being forwarded to the Group Director of Technology Center 1600. All further examination should be conducted in accordance with this decision.

3. Pursuant to Part II of this decision, a housekeeping amendment is required **within ONE (1) MONTH of this decision**, placing the same amendments in both cases of the present merged proceeding, 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

December 1, 2003

DOCKET ALARM

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 |
|---|---|---|---|
| 10/641,549 | 08/18/2003 | Albert M. Fleischner | |

| PATENT NUMBER | DATE OF THIS NOTICE | PAPER NUMBER |
|---|---|---|
| 6,503,529 | 12/01/2003 | 8 |

NOTICE OF MERGED REEXAM - REISSUE PROCEEDING

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

Control No. 90/006605 Filing Date: 04/17/2003

Requester (name, address) Stephen P. McNamara
St. Onge, Steward, Johnson & Reens
986 Bedford Street
Stamford CT 06905

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

REEXAMINATION RESULTS

The questions raised in reexamination request No. 90/006605, filed 04/17/2003, 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).

90006605 - 6503529

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. |
|---|---|---|---|---|
| 90/006,605 | 04/17/2003 | 6503529 | 3334-P10A | 9270 |

22925 7590 11/28/2005

| EXAMINER | |
|---|---|

PHARMACEUTICAL PATENT ATTORNEYS, LLC
55 MADISON AVENUE
4TH FLOOR
MORRISTOWN, NJ 07960-7397

| ART UNIT | PAPER NUMBER |
|---|---|

DATE MAILED: 11/28/2005

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

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4TH FLOOR
MORRISTOWN, NJ 07960-7397

| | |
|---|---|
| In re Application of<br>Albert M. Fleishner<br>Serial No.: 10/641,549<br>Filed: August 18, 2003<br>Attorney Docket No.: Vitamerica | : PETITION DECISION |
| In re Reexamination Proceeding<br>Control No.: 90/006,605<br>Filed: April 17, 2003<br>For Patent No.: 6,503,529<br>Attorney Docket No.: 3334-P10A | |

This is in response to the petition under 37 CFR 1.181, filed September 19, 2005, requesting withdrawal of abandonment based on non-receipt of an Office action.

A review of the file history shows that the examiner mailed a Notice of Defective Appeal Brief in the merged Reexamination/Reissue proceeding to applicants on February 28, 2005, setting a one month shortened statutory period for reply. Applicant states that the Notice, concurrently mailed in each file, was not received and provides a description of the docketing system utilized for incoming correspondence and provides evidence of non-receipt. A Notice of Abandonment has not been mailed to applicants however, the merged proceeding became abandoned as of March 29, 2005, for failure to file a corrected Appeal Brief with no extension of time requested. In view of the evidence and statement provided it is concluded that the Notice was not received. In view thereof the abandoned status is withdrawn and the merged proceeding is restored to pending status with the mailing of this decision.

The petition is **GRANTED**.

**As applicant has provided a request for RCE and a request to consider the Appeal Brief as a further reply to the Final Office action, the proceeding will be forwarded for proper entry and consideration by the examiner.**

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, 571-273-8300.

Bruce M. Kisliuk
Director, Technology Center 1600

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Paper No. 8

AR

HUNTON & WILLIAMS
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON, DC 20006-1109

(For Patent Owner)

MAILED

AUG 0 5 2003

REEXAM UNIT

Arthur J. Usher, Esquire
WOODARD, EMHARDT, NAUGHTON,
MORIARTY & MC NETT
BANK ONE CENTER/TOWER
111 MONUMENT CIRCLE, SUITE 3700
INDIANAPOLIS, IN 46204-5137

(For Third Party Requester)

Harvey et al
Reexamination Proceeding
Control No. 90/006,606
Filed: April 18, 2003
For: U.S. Patent No. 5,233,654

: DECISION
: GRANTING-IN-PART
: PETITION

This is a decision on the July 9, 2003, patent owner petition titled PETITION TO EXPUNGE AND SEAL PAPERS FROM THE REQUEST FOR REEXAMINATION.

The petition is addressed in four respects:

(1) Under 37 CFR 1.183 as a request to waive the rules and provide an entry right for the petition paper.

(2) Under 37 CFR 1.59(b) as a request to expunge papers from the request for reexamination.

(3) Under 37 CFR 1.182 as a request that papers from the request for reexamination be sealed, i.e., a situation not specifically provided for in the regulations.

(4) Under 37 CFR 1.182 as a request that the Office contact any parties that may have accessed the materials that petitioner has stated to be protected, and request return of such materials.

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

The petition under 37 CFR 1.183 is granted, such that the present petition paper will be permitted entry and will be addressed.

The petition under 37 CFR 1.59(b) is granted to the extent that materials will be expunged from the Reexamination Processing System (REPS) Scanning Data Base of the Central Reexamination Unit (CRU). It is otherwise held in abeyance for the reasons set forth below.

The petition under 37 CFR 1.182 to seal papers is granted to seal the originally filed request for reexamination, the originally filed Exhibit A1 and Exhibit E. The redacted copy of the request for reexamination, and that of Exhibit A1 (both submitted with the petition) will replace the originally filed request and Exhibit A1, and the redacted copies will be open to the public. The redacted copies will be scanned into the REPS Scanning Data Base of the CRU.

The petition under 37 CFR 1.182, as it relates to the request for contacting any parties that may have accessed unprotected materials, is dismissed, for the reasons set forth below.

**REVIEW OF FACTS**

1. U.S. patent No. 5,233,654 issued on August 3, 1993.

2. A request for reexamination, assigned control No. 90/006,606, was filed by a third party requester on April 18, 2003.

3. Reexamination was ordered for the '6606 reexamination proceeding on July 9, 2003.

4. On July 9, 2003 (the day reexamination was ordered), patent owner filed the present petition to expunge and seal papers from the request for reexamination. A redacted copy of the request for reexamination and a redacted copy of Exhibit A1 are submitted with the petition. The petition informs the Office that it is not a statement under 37 CFR 1.530.

## DECISION

Addressing the present petitions requires a decision as to three areas of relief, provided for by 37 CFR 1.183, 37 CFR 1.59(b), and 37 CFR 1.182, respectively. Each will be presented in its own section below.[1]

### I. DECISION ON PETITION UNDER 37 CFR 1.183

Pursuant to 37 CFR 1.530(a):

> "Except as provided in § 1.510(e), no statement or other response by the patent owner in an *ex parte* reexamination proceeding shall be filed prior to the determinations made in accordance with § 1.515 or § 1.520."

Pursuant to 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."

Accordingly, the present petition paper, which was filed on the date reexamination was ordered, does not have an entry right under the reexamination rules, regardless of whether it is considered as having been filed before or after the date of order of reexamination. [2]

A right of entry for the petition papers would require a waiver of the above-quoted provisions of the rules, such a waiver being available only pursuant to 37 CFR 1.183.[3] Accordingly, the

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[1] Two aspects of 37 CFR 1.182 relief will be addressed separately.

[2] The petition clearly informs the Office that it is not a statement under 37 CFR 1.530, and thus cannot be entered as such. In addition, papers filed on the day an Office action is issued are deemed to have been "before the examiner at the time he made his action." *See Ex Parte Miller*, 1922 C.D. 36, 305 O.G. 419 (April 8, 1922). Thus, the present petition papers would have been a premature statement, even if filed as a statement.

[3] 37 CFR 1.183 states as follows:
"In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(h)."

present petition is taken to provide, as one of its requests for relief, a request under 37 CFR 1.183 for a waiver of the rules.

In addressing the request for a waiver of the rules, it is noted that, at page 7 of the petition, petitioner provides grounds for waiver of the rules as follows:

> "PMC believes that the unusual circumstances related to Thomson's Request dictate the filing of the instant petition to protect PMC's important and statutorily recognized interest in maintaining the confidentiality of its abandoned patent applications. [Footnote omitted] See 35 U.S.C. § 122; 37 C.F.R. § 1.14; see also M.P.E.P. § 724.05."

This argument by petitioner is found to be persuasive to waive the above-quoted provisions of the rules. The interest in maintaining the confidentiality of the patent owner's abandoned patent application, and giving effect to the May 2, 2003, Order of the District Court [4] granting patent owner's motion for a protective order, are deemed to provide an extraordinary situation, when justice requires waiver of the rules to protect rights. Patent owner's rights could be prejudiced if a decision on the matter presented is delayed until a stage of this reexamination proceeding is reached where patent owner would have an entry right pursuant to the rules.

Accordingly, the petition, as it relates to relief under 37 CFR 1.183, is granted.

## III. PETITION UNDER 37 CFR 1.59(b)

In the second page of the petition, it is requested that the Commissioner to expunge from the file and REPS Scanning Data Base of the CRU, Exhibit E of the Request for Reexamination, and all quotations and descriptions thereof in the record. In the petition, the request for reexamination and Exhibit A1 are identified as the papers containing such quotations and descriptions.

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[4] Issued in *Personalized Media Communications,LLC v. Scientific-Atlanta, Inc., et al.,* Civil Action File No.1:02-CV -824-CAP, (United States District Court for the Northern District of Georgia) in Atlanta before Judge Charles A. Pannell, Jr. (the Atlanta Litigation).

(1) Pursuant to 37 CR 1.59(b):

> "An applicant may request that the Office expunge and return information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge and return information from an application must include the fee set forth in § 1.17(h) and establish to the satisfaction of the Commissioner that the return of the information is appropriate."

To the extent that the present petition is taken as a petition for expungement under 37 CR 1.59(b) of **the confidential materials** entirely from the record, the petition is **premature**.

MPEP 724.04(c) sets forth the guidelines for a petition to expunge "Materials Submitted in Reexamination File Open to the Public Under 37 CFR 1.11(d)." When the application is considered for action on the merits, the examiner (and/or other appropriate Office official responsible for considering the information) will review the sealed information, and will make a determination as to whether or not any portion or all of the information submitted is "important to a reasonable examiner in deciding whether or not a claim is patentable." The examiner may issue a determination on the issue of importance of the sealed information in the first Office action on the merits, or in an Office action issued any time thereafter that is appropriate, but, *in no event, later than the close of prosecution.*

It is not appropriate to make, in this decision, a final determination of whether or not the material requested to be expunged is "important to a reasonable examiner in deciding whether or not a claim is patentable." Rather, such a decision is issued by the examiner, and is issued no later than the close of prosecution. Thus, the decision on the petition to expunge is premature and must be held in abeyance at this time. **After the examiner has issued a determination on the issue of importance of the sealed information in an Office action on the merits** (as discussed above), **the petition to expunge may be renewed by patent owner. If the petition to expunge is renewed by patent owner, the requirements of MPEP 724.05 should be carefully reviewed to make certain that the petition to expunge is complete**

**as to all requirements for same.**[5] Any such future petition should be should be addressed as follows:

By mail: Central Reexamination Unit
Office of Patent Legal Administration
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (703) 305-1013
Central Reexamination Unit
Attn: Kenneth Schor

By HAND: Central Reexamination Unit
Crystal Plaza Three-Four, 3D68
2201 South Clark Place
Arlington, VA

**Patent owner is cautioned** that a failure to **timely** renew the petition to expunge prior to the point at which the file is forwarded for issuance of the reexamination certificate will result in the sealed material being unsealed and made of record in the reexamination file and thus becoming open to the public.

While the petition to expunge the confidential materials from the file will not be granted, *it is, however, appropriate* that the confidential materials of the reexamination paper file be sealed from public view. Such sealing would further the interest in maintaining the confidentiality of the patent owner's abandoned patent application, and give effect to the May 2, 2003, Order of the District Court [6] granting patent owner's motion for a protective order. Accordingly, the unredacted original request for reexamination, the unredacted original of Exhibit A1, and Exhibit E are being sealed by the present decision; see Section III below.

(2) To the extent that the petition is taken as a petition for expungement of the request for reexamination containing the confidential material from the REPS Scanning Data Base of the CRU, the petition is granted. This expungement would serve the interest in maintaining the confidentiality of the patent owner's

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[5] The (D) statement set forth therein will need to be modified to indicate on behalf of whom the petition is being submitted.

[6] The order was issued in *Personalized Media Communications, LLC v. Scientific-Atlanta, Inc., et al.*, Civil Action File No.1:02-CV -824-CAP (United States District Court for the Northern District of Georgia.

confidential materials as pointed out in the previous paragraph. Accordingly, the electronic copy of the request for reexamination (and its attachments) will be deleted by the CRU, pursuant to Section IV of this decision, below. The redacted copy of the request for reexamination and redacted copy of Exhibit A1 submitted with the supplemental petition will be scanned into the REPS Scanning Data Base together with the attachments other than Exhibit E and the original of Exhibit A1, and will be available to the public.

## III. DECISION ON PETITION UNDER 37 CFR 1.182

At page 2 of the petition, it is requested under 37 CFR 1.182, in the event the petition to expunge is held in abeyance, that the unredacted original request for reexamination, the unredacted original of Exhibit A1, and Exhibit E be sealed pending a final determination as to whether the sealed papers should be expunged, and the present petition is granted to that extent. Accompanying the present petition is a redacted copy of the request for reexamination and a redacted copy of Exhibit A1, to replace the unredacted copies to be sealed.

While it would be premature to *expunge* materials from the paper file of the proceeding for the reasons set forth above, it *is appropriate to seal* the unredacted original request for reexamination, the unredacted original of Exhibit A1, and Exhibit E pending a final determination as to whether the sealed papers should be expunged, and the present petition is granted to that extent.

## IV. ACTION TO BE TAKEN BY THE CENTRAL REEXAMINATION UNIT

The appropriate Central Reexamination Unit (CRU) personnel will immediately:

1. Expunge, *in toto*, the electronic images of the request for reexamination and its attachments from the REPS Scanning Data Base;

2. Scan into the REPS Scanning Data Base the redacted copy of the request for reexamination and the redacted copy of Exhibit A1 submitted with the supplemental petition, together with the attachments other than Exhibit E and the original of Exhibit A1; and then

3. Forward the file to the Technology Center for sealing of documents.

## V. ACTION TO BE TAKEN BY THE TECHNOLOGY CENTER TO SEAL MATERIALS

Upon return of the present file to the Technology Center, the appropriate personnel thereof will immediately:

1. Seal the paper copy of the unredacted original request for reexamination, the unredacted original Exhibit A1, and Exhibit E as follows:

   A. Place documents in a sealed, clearly labeled, envelope or container.

   B. Provide a label, or enter information, on the envelope:

      1) Label the envelope or container as "Proprietary Documents Subject To Confidentiality/Protective Order."

      2) Set forth the tribunal issuing the protective order, i.e., the Federal District Court, on the label. The tribunal will be identified as follows:

         *"Personalized Media Communications, LLC* v. *Scientific-Atlanta, Inc., et al.,* Civil Action File No. 1:02-CV -824-CAP, United States District Court for the Northern District of Georgia"

      3) Set forth the appropriate reexamination information (reexamination control number, filing date, patent owner, inventors, examiner, Art Unit) for the present reexamination.

   C. Store the sealed envelope or container in a place separate from the present reexamination file, and not available to the public. [This sealed envelope or container will be forwarded to the examiner with the file, when the file is forwarded to the examiner for action on the proceeding.]

D. Place a notation on the face of the file to indicate that confidential/protective order materials are present. The location of the materials, i.e., in the envelope or container, will also be specified. The words "CONFIDENTIAL/PROTECTIVE ORDER MATERIALS FILED WHICH ARE NOT OPEN TO PUBLIC" are sufficient to indicate the presence of such materials.

2. Forward the file in the examiner for action, with instructions to follow the procedure set forth in MPEP 724.04(c).

## VI. THE REQUEST TO CONTACT PERSONS WHO ACCESSED THE INFORMATION STATED TO BE CONFIDENTIAL, WHILE THE INFORMATION HAS BEEN AVAILABLE TO THE PUBLIC:

The information which patent owner has requested to be expunged/sealed has already been made available to the public and subject to copying (of the file by the public) by the *filing* of the present reexamination request, 37 CFR 1.11(d). Accordingly, the Office cannot guarantee that the materials being sealed as a result of this decision were not previously accessed by the public.

In the petition (page 2, for example), it is requested that the Office contact any persons who accessed the information stated to be confidential (protected) while the information has been available to the public, and request return of same. This request will not be granted, and the petition is dismissed as to this request.

Pursuant to 37 CFR 1.11(c), *Files open to the public.*, requests for reexamination are announced in the *Official Gazette*. Reexamination proceedings are then open to the public, i.e., access is permitted to reexamination proceedings.[7] See also MPEP 2232. Thus, any persons who accessed the information stated to be confidential (protected) did so while the information was appropriately available to the public. The public cannot be asked to return what it legitimately had access to.

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[7] In practice, any member of the public desiring a copy of all or part of a reexamination file may obtain such in the Office's Public Search Room from the reexamination database via REPS (Reexamination Processing System) terminals in the Public Search Room.

At page 13 of the petition, reference is made to the January 2, 2003, letter from Karin Ferriter, a copy of which was filed as an attachment to the petition. In that letter, the patent owner was notified that parties who were known to have accessed patent owner's applications had been contacted by the Office and asked to return materials. It is to be noted, however, that applications are maintained confidential as required by 35 U.S.C. 122, and access to applications is strictly limited since they are to be maintained in confidence as per the statute. In the instance referred to by the letter, any party that should not have been entitled to access was requested to return proprietary materials, because such party would have obtained materials that should not have legitimately been open to access. In the present instance, reexaminations, are open to the public, and thus any party who obtained access did so within the statute and rules.

It is noted that the request for reexamination in Control Number 90/006,5**63** was filed by the third party requester on March 14, 2003, a request for reexamination in Control Number 90/006,5**36** was filed by a third party requester on February 4, 2003. The patent owner was served with a copy of the request in each instance, and each request contained the same materials for which patent owner has requested expungement/sealing in this proceeding. Yet, the patent owner did not file the initial petition addressing the materials stated to be protected until May 30, 2003, in the '65**36** proceeding, and June 10, 2003, in the '65**63** proceeding. Thus, the Office did not have notice that protected materials might be present in the proceeding until about three months after each request for reexamination was filed. During that period, any member of the public could have legitimately accessed the proceedings, and the same materials for which patent owner has requested expungement/sealing in this proceeding would have been copied. Now that the Office has been made aware of the matter, relief is being provided in all the proceedings. Such relief cannot, however, be provided retroactively.

## CONCLUSION

1. The petition under 37 CFR 1.183 is granted, such that the present petition paper has been entered and addressed above.

2. The petition under 37 CR 1.59(b) is granted as to the request for expungement of the materials of the reexamination from the REPS Scanning Data Base. It is otherwise is held in abeyance, pending renewal of same by patent owner at an appropriate time. As pointed out above, **the patent owner is cautioned that a failure to timely renew the petition to expunge prior to the point at which the file is forwarded for issuance of the reexamination certificate will result in the sealed material being unsealed and made of record in the reexamination file and thus becoming open to the public.**

3. The petition to seal materials under 37 CR 1.182 is granted to seal the originally filed request for reexamination, the originally filed Exhibit A1 and Exhibit E.

4. The petition, as it relates to the request for contacting any parties that may have accessed unprotected materials, is dismissed.

5. The reexamination file is being forwarded to the CRU to:

(A) Expunge *in toto*, the electronic images of the originally filed request for reexamination and its attachments from the REPS Scanning Data Base; and

(B) Scan into the Data Base - the petition filed July 9, 2003, the redacted copy of the request for reexamination and the redacted copy of Exhibit A1 submitted with the supplemental petition, together with the attachments other than Exhibit E and the original of Exhibit A1.

6. The reexamination file will then be returned by the CRU to Technology Center 2600. The Technology Center will:

(A) Seal materials as directed by part V of this decision.

(B) Enter the redacted copy of the request for reexamination, and that of Exhibit A1 (both submitted with the petition) into the file to replace the originally filed request and Exhibit A1.

7. The reexamination file will then be forwarded to the examiner who will issue an Office action in due course.

8. Any questions regarding this decision should be directed to the undersigned at (703) 308-6710.

9. Telephone inquiries related to the examination of the reexamination proceeding should be directed to Examiner David E. Harvey of Art Unit 2614 at 703-305-4635.

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

August 4, 2003
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U.S. Patent and Trademark Office

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. 12

HUNTON & WILLIAMS
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON, DC 20006-1109

(For Patent Owner)

MAILED

SEP 1 2 2003

REEXAM UNIT

Arthur J. Usher, Esquire
WOODARD, EMHARDT, NAUGHTON,
MORIARTY & MC NETT
BANK ONE CENTER/TOWER
111 MONUMENT CIRCLE, SUITE 3700
INDIANAPOLIS, IN 46204-5137

(For Third Party Requester)

Enclosure: August 11, 2003, third party requester petition and attachments.

DO NOT ENTER

Harvey et al
Reexamination Proceeding
Control No. 90/006,606
Filed: April 18, 2003
For: U.S. Patent No. 5,233,654

: DECISION
: GRANTING-IN-PART
: PETITION

This is a decision on (A) the August 11, 2003, third party requester petition titled REQUESTER THOMSON INC.'S PETITION TO UNSEAL PAPERS FROM THE REQUEST FOR REEXAMINATION and (B) the patent owner August 21, 2003, petition titled PETITION TO SEAL AND IN OPPOSITION TO REQUESTER THOMSON'S PETITION TO UNSEAL PAPERS FROM THE REQUEST FOR REEXAMINATION.

The requester petition is addressed in three respects:

(1) Under 37 CFR 1.183 as a request to waive the rules and provide an entry right for the requester petition papers.

(2) Under 37 CFR 1.182 [1] as a request to restore the electronic images expunged from the request for reexamination, and a request to unseal the paper documents sealed in the present reexamination proceeding.

(3) Under 37 CFR 1.182 as a request that all the request materials originally submitted by requester be publicly available in accord with 37 CFR 1.11.

The patent owner petition is addressed in three respects:

(1) Under 37 CFR 1.183 as a request to waive the rules and provide an entry right for the opposition petition papers.

(2) Under 37 CFR 1.182 as a request that requester's petition be denied consideration and returned to requester, or that the petition should be denied and sealed.

(3) As an opposition to the requester's position that the document attached as exhibit A of requester's petition should be open to the public in the present proceeding.

Pursuant to 37 CFR 1.17(h), a petition fee of $130.00 is required for a petition under 37 CFR 1.182 and/or 37 CFR 1.183. The required petition fees of $130.00 have been received from both requester and patent owner in the form of checks.

The petitions are before the Office of the Patent Legal Administration of the United States Patent and Trademark Office for decision.

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[1] All the requests in the requester and patent owner petitions directed to situations not specifically provided for in the regulations are addressed under 37 CFR 1.182.

## SUMMARY OF ACTION TAKEN

The requester and patent owner petitions under 37 CFR 1.183 are granted, such that both petition papers will be considered and addressed.

The requester petition under 37 CFR 1.182 is dismissed and the materials previously expunged and sealed will not be restored and unsealed (respectively) for the reasons set forth below.

The patent owner petition under 1.182 is dismissed to the extent that the requester petition has been considered on its merits, and is granted to the extent that the requester petition is being returned to requestor to redact it to remove the improper content identified below.[2]

## REVIEW OF FACTS

1. U.S. patent No. 5,233,654 issued on August 3, 1993.

2. A request for reexamination, assigned control No. 90/006,606, was filed by a third party requester on April 18, 2003.

3. Reexamination was ordered for the '6606 reexamination proceeding on July 9, 2003.

4. On July 9, 2003 (the day reexamination was ordered), patent owner filed a petition to expunge and seal papers from the request for reexamination. A redacted copy of the request for reexamination and a redacted copy of Exhibit A1 are submitted with the petition. The petition informed the Office that it is not a statement under 37 CFR 1.530.

5. A decision was mailed August 5, 2003, in which:

   A. The petition, as taken under 37 CFR 1.183, was granted to enter and address the petition paper.

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[2] Since the requester petition is being returned, there is no need to address the alternatively requested sealing of the petition.

B. The petition under 37 CR 1.59(b) was granted to expunge the materials of the original reexamination request papers from the REPS Scanning Data Base. It was otherwise held in abeyance.

C. The petition to seal materials under 37 CR 1.182 was granted to the extent that (1) originally filed Exhibits A1 and E were sealed, (2) the redacted paper copy of the request for reexamination, and that of Exhibit A1, were physically entered into the file to replace the originally filed request and Exhibit A1, and (3) the redacted copy of the request and the redacted copy of Exhibit A1 were scanned into the REPS Scanning Data Base together with the attachments other than Exhibit E and the original of Exhibit A1.

6. On August 11, 2003, requester filed the instant petition *sub silentio* requesting waiver of the rules to provide an entry right for the petition paper, and specifically requesting that the electronic images expunged from the request for reexamination be restored, that the paper documents sealed in the present reexamination proceeding be unsealed, and that all the request materials originally submitted by requester be publicly available in accord with 37 CFR 1.11. The instant requester petition addresses the July 9, 2003, patent owner petition.

7. On August 21, 2003, the patent owner filed a petition in opposition to requester's August 11, 2003, petition, and request for return of same to requester. This patent owner paper will also require a waiver of the rules to provide it with an entry right, as will be discussed below.

## DECISION ON PETITIONS UNDER 37 CFR 1.183

### I. Requester Petition Under 37 CFR 1.183:

Pursuant to 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."

In addition, 37 CFR 1.550(g) provides:

> "(g) The active participation of the *ex parte* reexamination requester ends with the reply pursuant to § 1.535, and no further submissions on behalf of the reexamination requester will be acknowledged or considered. Further, no submissions on behalf of any third parties will be acknowledged or considered unless such submissions are:
>
> (1) in accordance with § 1.510 or § 1.535; or
>
> (2) entered in the patent file prior to the date of the order for *ex parte* reexamination pursuant to § 1.525."

Accordingly, the present requester petition paper does not have an entry right under the reexamination rules.

A right of entry for the petition paper would require a waiver of the above-quoted provisions of 37 CFR 1.540 and 37 CFR 1.550(g), such a waiver being available only pursuant to 37 CFR 1.183.[3] Accordingly, the present requester petition is taken to provide, as one of its requests for relief, a request under 37 CFR 1.183 for a waiver of the rules.

With respect to the sealing and expungement issue, patent owner's petition papers were entered, considered, and acted upon via the decision dated August 5, 2003. The rule (37 CFR 1.540) was waived because patent owner's rights could be prejudiced if a decision on the matter presented was delayed until the examination stage of this reexamination proceeding.

In the interest of fairness, justice requires that the rule be likewise waived to permit requester's "response" to patent owner's petition to be considered and addressed.

Accordingly, the requester petition, as it relates to relief under 37 CFR 1.183, is <u>granted</u>.

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[3] 37 CFR 1.183 states as follows:
"In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(h)."

**II. Patent Owner Petition Under 37 CFR 1.183:**

Pursuant to 37 CFR 1.540, the patent owner opposition petition paper also does not have an entry right under the reexamination rules. Accordingly, the patent owner petition is also taken to provide a request under 37 CFR 1.183 for a waiver of the rules.

Once again, in the interest of fairness, justice requires that the rule be likewise waived to permit patent owner's "opposition" to requester's petition to be considered and addressed.

Accordingly, the patent owner petition, as it relates to relief under 37 CFR 1.183, is granted.

**DECISION ON REQUESTER PETITION UNDER 37 CFR 1.182**

**I. The Requester Petition, as it Relates to the Requests to Restore Expunged Materials and Unseal Materials:**

At page 4 of the third party requester petitioner petition (hereinafter "requester petition"), it is urged that:

> "Thomson properly obtained copies of the Notice of Abandonment from several sources such that Thomson is free to publicly disseminate the Notice of Abandonment. These sources include: (1) discovery in the Delaware Litigation, (2) the public record of other court proceedings involving PMC's patents, and, (3) from third parties who requested a file history containing the Notice Abandonment and received it from the PTO. PMC's petitions to expunge and/or seal devote extensive argument to the latter two sources but fail to fully address the first."

As to sources (2) and (3), petitioner requester (hereinafter "requester") has not provided a showing that any of the copies of the "Notice of Abandonment" referred to at page 4 of the petition were other than the "fruits" of the original improper access to the application involved.

As to source (1), it is apparently requester's position that the documents were obtained via discovery in the Delaware Litigation [4] in a manner that legitimately places the documents in the public domain. In order to address this position of requester, a review of the history of the matter is in order.

In November of 2001, as part of the "Delaware Litigation" procedure, a conference was conducted with Judge Sleet and the parties as to whether the Notice of Abandonment (hereinafter "the Notice") should be protected by protective order. [5] Requester points out that, after the conference:

> "Ultimately, pursuant to Thomson's November 2002 challenge to the confidentiality of various documents (Thomson' s objection stated that the Notice of Abandonment should be treated as public ), and as a result of the negotiation between the parties, PMC agreed to treat the Notice of Abandonment as public." Indeed, PMC's June 10,2003 PETITION TO EXPUNGE PAPERS FROM THE REQUEST FOR REEXAMINATION admits as much (see page 7), acknowledging that "PMC wrote Thomson that PMC would allow Thomson to treat the document as public." [Requester Petition at 6, 7]

Requester bolsters this point (agreement to treat the Notice as public) by reference to an e-mail dated December 20, 2003 (attached as Exhibit D) from patent owner's counsel to requester's counsel.

In an e-mail dated January 9, 2003,[6] patent owner notified requester that patent owner withdrew its consent to making the notice public a "change of circumstances" warranted "treatment of the Notice of Abandonment as confidential." [7] The "change of

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[4] *Pegasus Development Corporation & Personalized Media Communications, LLC v. DIRECTV, Inc., et al.,* Civil Action File No.1:02-CV -824-CAP, (United States District Court for the Northern District of Georgia) in Atlanta before Judge Sleet (the Delaware Litigation).

[5] A review of pages 18-20 of the transcript of the conference appears to indicate that the Judge directed the parties to reach a compromise as to the dissemination of the Notice, and the Judge closed with advice to counsel for patent owner that if counsel would not be reasonable in making a compromise, the Notice would be designated as public. Requester has characterized the result of the conference otherwise at page 6 of the petition.

[6] Exhibit E of the requester petition.

[7] *See* Exhibit E, second paragraph.

circumstances" referred to in the patent owner's notification is the January 2, 2003, letter authored by Karin Ferriter (a Senior Legal Adviser of the Office of Patent Legal Administration) holding that the access which was granted by the Office to the Notice should not have been granted.

Then, in a January 13, 2003, letter, requester informed the patent owner that requester rejected patent owner's attempt to renege on what requester characterized as an agreement that the Notice "was to be treated as public." [8]

Page 7 of the requester petition goes on to state that

> "Thomson [requester] has maintained this position and has distributed copies of the Notice of Abandonment to third parties with no restriction of confidentiality. Despite its knowledge of Thomson's position and unrestricted distribution of the Notice of Abandonment, the patent owner has made absolutely no attempt to raise this issue with the Delaware Court"

As to requester's contention that patent owner has not approached the Delaware Court for a modification of the protective order which did not protect the Notice of Abandonment, patent owner, on pages 9 and 10 of the patent owner petition, disputes this. Patent owner argues that, pursuant to Judge Sleet's Standing Order for resolving the matter, patent owner took steps in January of 2003 to arrange for contact with "chambers" to schedule a telephone conference with the Court.

On May 2, 2003, Order of the Atlanta District Court [9] granted patent owner's motion for a protective order to protect the Notice. Requester is not a party to that action and there is no indication that requester made any attempt to intervene in that action.

It is initially noted that the Order of the Atlanta District Court granting patent owner protection of the Notice was issued after all of the above history; yet, in spite of the history the Atlanta District Court found that the Notice could not be made

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[8] *See* Exhibit F of the requester petition.

[9] Issued in *Personalized Media Communications,LLC v. Scientific-Atlanta, Inc., et al.*, Civil Action File No. 00-1020 (GMS), (United States District Court for the District of Delaware) in Wilmington before Judge Pannell (the Atlanta Litigation).

public. Thus, at the very least there exists a conflict of District Court findings on the confidentiality of the Notice.[10] The Office is not about to arbitrate that dispute, especially since, petitioner has not provided a showing as to how the materials remaining sealed and the redacted request being publicly available will prejudice the decision made on the reexamination request, and/or the examination of the reexamination proceeding. MPEP 724.04(c) sets forth the guidelines for a petition to expunge "Materials Submitted in Reexamination File Open to the Public Under 37 CFR 1.11(d)." When the application is considered for action on the merits, the examiner (and/or other appropriate Office official responsible for considering the information) **will review the sealed information, and will make a determination as to whether or not any portion or all of the information submitted is "important to a reasonable examiner in deciding whether or not a claim is patentable."** Thus, a full review of requester's submissions will be made, and there is no reason to grant this request of the third party requester which is not provided for in the rules and is at least open to dispute by the courts. The Office does not need to arbitrate the matter, when it can satisfy its mission of reexamining patents without arbitrating the matter (see the discussion of this below), and accordingly will not do so. [11]

Thus, the petition, as it relates to the requests to **restore expunged materials and to unseal materials**, is dismissed.

EFTPO 90006606

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[10] It is to be noted that the interaction with Delaware District Court as to the Notice took place prior to the Office's January 2, 2003, letter by the Senior Legal Adviser holding that the access which was granted by the Office to the Notice should not have been granted, and that statutory issues of patent application confidentiality (35 U.S.C. 122) were involved. It is not entirely clear as to the approach the Delaware District Court will have subsequent to the Office's letter.

[11] Stated another way, when balancing the interests here, the statutorily recognized (35 U.S.C. 122) interest in maintaining the confidentiality of material present in patent owner abandoned patent applications far outweighs the requester's interest in making the material present, since the examination of the proceeding will not be impeded by the Notice not being available to the public via the reexamination.

At pages 3 and 4 of the requester petition, requester states its request for relief in terms of public policy:

> "Thomson asks that this petition be given consideration so that its due process rights can be met, and the public can be served by learning of the contents of the Notice of Abandonment."

In response, the present decision does not aide nor hinder the dissemination of the Notice of Abandonment outside the Office. Nor does it affect any remedies that parties may have and may exercise as to action/conduct by parties in regard to dissemination of the Notice by parties to the public. Such matters are left to the courts, and, as pointed out in the requester petition, "Thomson continues to freely distribute copies of the Notice of Abandonment to others...."[12] The present decision is merely a statement that the Office can accomplish its mission in reexamining the patent of the present proceeding while the papers are under seal, because the Office has access to those papers as needed. Requester is not being prejudiced in any manner as to the examination that will be provided and the consideration of the materials submitted by requester. It is the purpose of reexamination to determine whether the patent claims are patentable over the patents and printed publications; it is not the purpose of reexamination to make, or ensure that, the submitted materials are public. Whether dissemination of the Notice is appropriate or not is a matter left to the courts. The Office is simply refusing to be the agent by which dissemination is carried out (via filing the Notice of Abandonment in the reexamination proceedings) until it becomes clear that there is a right for such dissemination. Given the above-discussed history, the matter is far from being clear.

As a final point, it is not clear what prompted requester to ask for a copy of the Notice of Abandonment in the discovery stage of the litigation. If such were prompted by knowledge of its existence obtained as a result of the improper access to the Notice in the application (and subsequent dissemination thereof), then the "publication" of the Notice via the Delaware litigation would also be fruits of the improper access, and as such, the Office could not permit the Notice to remain available to the public.

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[12] Requester petition at 14.

## II. The Requester Petition, as it Relates to the Request That All Materials Originally Submitted by Requester Be Publicly Available in Accord with 37 CFR 1.11:

The requests for unsealing and restoring expunged materials to make the materials publicly available in accord with 37 CFR 1.11 have already been addressed in the preceding section of this decision. To the extent that this request is a repetition of the first two requests, it is dismissed for the reasons set forth in the preceding section.

Other than unsealing the sealed materials and restoring the expunged electronic materials, it is not clear what action the Office can take to address this request. If petitioner desires a statement that such materials are in the public domain, such a statement would not be addressed to providing relief in the present proceeding, and is dismissed as such. In any event, as pointed out above, there has not been any showing of the existence of a copy of the materials not obtained in some manner as the fruit of the original improper access, thus there would be no basis to make the materials public.

## III. Other Requester Arguments:

A. At pages 12 and 13 of the requester petition, it is argued that the patent owner has no right to expunge and/or seal material from Thomson's third party request for reexamination under the governing law.

In response, 37 CFR 1.182 provides relief to parties in "situations not specifically provided for in the regulations" such relief being provided "in accordance with the merits of each situation." In this instance, the patent owner has an interest in maintaining the confidentiality of it's confidential material. Such an interest can be protected by sealing the materials, as has been done. It is to be noted that prior to the promulgation of 37 CFR 1.59 for expungement of papers, such relief was also provided by 37 CFR 1.182 based on the interest of protecting confidential material.

B. At page 13 of the requester petition, it is argued that:

> "[T]he procedure sought to be invoked by PMC results in a denial of due process to Requester, in that it contemplates a striking of the material without the Requester having an appropriate role in the matter. Whether material should be struck from any paper a requester files with the PTO is a matter in which the requester must be given an opportunity to be heard, and not resolved solely between the PTO and some other party who believes it might be impacted by the contents of the filing. At best, PMC's request can be viewed as a public request to have the PTO strike matter filed by another party. If the PTO desires to inquire further as to the merits of the request, it should then deal directly with the filer of the papers, Thomson, allowing an opportunity for Thomson to be heard on the merits."

In response, requester has not indicated that it was not served with a copy of patent owner's initial petition to expunge; [13] yet, requester failed to file an opposition to patent owner's initial petition - not in this proceeding nor in any of the related proceedings identified in the first footnote of the requester petition. In addition, by way of the present requester petition (and this decision), requester has in fact been heard on the merits.

**DECISION ON PATENT OWNER PETITION UNDER 37 CFR 1.182 AND RETURN OF THE REQUESTER PETITION FOR REDACTION**

**A. Discussion:**

At pages 3-5 of the patent owner petition, it is argued that requester's petition should be denied consideration and returned to the requester, or denied and sealed.

As pointed out by patent owner, neither the rules nor any provision of the statute provide authority for a third party to participate in a reexamination proceeding by filing a paper directed to the substantive issues of the proceeding. *See In re Amp*, 212 USPQ 826 (Comr. Pats. 1981). The statute and its intent are clear that a reexamination proceeding requested under 35 U.S.C. 302 must be *ex parte*. In this regard, the Court of Appeals

[13] And a certificate of service of the petitions (that accompanied the filing of the petitions) *prima facie* establishes that requester was served.

for the Federal Circuit stated in *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 882 F.2d 1570, 1573, 11 USPQ2d 1866, 1868, 1869 (Fed. Cir. 1989):

> "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."

*Also see In re Chambers*, 20 USPQ2d 1470, 1476 (Comr.Pat. 1991):

> "It is noted that a third party has no right to comment or participate in a reexamination proceeding beyond the rights specifically provided for by the reexamination statute, i.e., file a request for reexamination and comment on any statement filed by a patent owner."

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**B. Decision:**

Part 1

To the extent that the petition requests unsealing, restoring of e-files, and publication of the materials related to the Notice of Abandonment, this is not participation in the conduct of the reexamination proceeding. Rather, it is a non-substantive response to the patent owner's prior request for sealing and expungement, which has nothing to do with the conduct of the reexamination itself. Thus, such a requester paper is not barred by the statute. Rather, such a matter is appropriate for consideration where, as is the case here, justice requires that requester be granted an opportunity to be heard as to patent owner's request for sealing and expungement. In the same manner that a waiver of the rules was granted for consideration of patent owner's request for sealing and expungement, and for consideration of patent owner's present request as to how the requester petition should be dealt with, justice requires that a waiver of the rules be granted for consideration of requester's position on the matter.

Patent owner is referred to Manual of Patent Examining Procedure (MPEP) § 2246 where it is stated that consideration is given to a patent owner petition to vacate an *ultra vires* reexamination order even at a point where a patent owner petition would otherwise not have an entry right. In that situation, the third party requester is given an opportunity file a single submission in opposition to the petition, even though a requester paper would otherwise not have an entry right. The present situation is analogous to that of MPEP § 2246.

Part 2

At page 10 of the requester petition, it is stated:

> "As previously noted, Thomson has attached a copy of the January 18,2001 Notice of Abandonment to the present petition as Exhibit A. Even a brief review of the contents of the Notice of Abandonment indicates areas of potential and/or actual overlap with issues include issues that may or will arise during the reexamination proceedings."

The items that requester perceives as such are then set forth.

The discussion by requester of the overlap of the Notice with issues of the case is clearly substantive; it amounts to an argument/statement of relevance of the information of record (the Notice). This would be a supplement to the request for reexamination, which is prohibited. Such participation by the requester is barred by the statute for the reasons set forth above. The determination as to relevance of the Notice **is for the examiner to make**, and the requester is not, at this stage, permitted to file information on the issue.

Additionally, it is to be noted that there is no need for the presentation of Exhibit A, the attached copy of the January 18, 2001, Notice of Abandonment. There is already a sealed copy of the Notice of record, to which the Office may refer as needed. Providing another copy is surplusage, and would require the needless sealing and storage of another paper in an already extensive record.

In view of the presence of the inappropriate contents of the petition, the requester petition is being returned to requester with a copy of this decision.

If requester wishes to retain of record the portions of the requester petition other than Exhibit A and the argument/statement of relevance directed to the Notice, requester must provide a redacted petition omitting Exhibit A and the argument/statement of relevance. Such would retain requestor's other materials, arguments, positions taken, points made, etc. of record.

A redacted copy as set forth above is required from requester within ONE MONTH from the date of this decision. If the redacted copy is not received within the one month period set, the paper will no longer have an entry right.

It is to be noted that while ordinarily the petition containing the improper subject matter might not be addressed on the merits and simply returned for correction, the issues of requester's petition have been addressed on the merits in this decision. This was done in view of the number of cases involved, the different stages of the cases, and the various time constraints involved. [14]

As to patent owner's alternative request for sealing of the petition, such is moot, since the requester petition is being returned. Thus, there is no need to address this alternative relief that was requested.

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**CONCLUSION**

1. The requester and patent owner petitions are granted under 37 CFR 1.183, such that the requester and patent owner petition papers have been considered and addressed above.

2. The requester petition under 37 CR 1.182 is dismissed.

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[14] As stated in the first footnote of the requester petition, "[t]he patent owner has filed such papers in connection with Thomson's Requests for Reexamination of U.S. Patent Nos. 4,965,825 [Reexam Control No. 90/006,536 filed February 4, 2003], 5,335,277 [Reexam Control No. 90/006,563 filed March 14, 2003], 5,233,654 [Reexam Control No. 90/006,606 filed April 18, 2003], and 5,887 ,243 [Reexam Control No. 90/006,688 filed June 30, 2003]." The determination on the request has not yet been made for one of these proceedings.

3. The patent owner petition under 37 CR 1.182 is dismissed to the extent that the requester petition has been considered on its merits, and is granted to the extent that the requester petition is being returned to requestor to redact it to remove the improper content identified below.

4. The requester petition papers are being returned with this decision. A redacted copy of the requester petition pursuant to the instructions set forth above is required from requester within ONE MONTH from the date of this decision. If such a redacted copy is not received within the one month period set, the paper will no longer have an entry right.

5. The reexamination file is being returned to Technology Center 2600 for forwarding to the examiner who will prepare an appropriate Office action consistent with this decision.

6. If the redacted copy of the requester petition pursuant to the instructions set forth above is timely received from requester, the file should be forwarded to the Office of Patent Legal Administration to the attention of Kenneth M. Schor, Senior Legal Advisor.

7. Any questions regarding this decision should be directed to Kenneth M. Schor at (703) 308-6710.

8. Telephone inquiries related to the examination of the reexamination proceeding should be directed to Examiner David E. Harvey of Art Unit 2614 at 703-305-4635.

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

September 11, 2003
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Paper No. 14 AUTH

HUNTON & WILLIAMS
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON, DC 20006-1109

(For Patent Owner)

MAILED

NOV 0 7 2003

REEXAM UNIT

Arthur J. Usher, Esquire
WOODARD, EMHARDT, NAUGHTON,
MORIARTY & MC NETT
BANK ONE CENTER/TOWER
111 MONUMENT CIRCLE, SUITE 3700
INDIANAPOLIS, IN 46204-5137

(For Third Party Requester)

Harvey et al :
Reexamination Proceeding : DECISION
Control No. 90/006,606 : GRANTING
Filed: April 18, 2003 : PETITION
For: U.S. Patent No. 5,233,654 :

This is a decision addressing the October 2, 2003, third party requester submission titled REQUESTER THOMSON INC.'S SUBMISSION OF REDACTED VERSION OF PETITION TO UNSEAL. Due to the nature of the submission, it is taken as a renewed petition under 37 CFR 1.183 directed solely to waiver of the rules to provide an entry right for making the re-submitted **previously addressed** requester petition papers of record in redacted format.

The petition under 37 CFR 1.183 is granted.

**DECISION**

As pointed out in the present submission, the decision issued by this office in September of 2003 stated:

> "If requester wishes to retain of record the portions of the requester petition other than Exhibit A and the argument/statement of relevance directed to the Notice, petitioner must provide a redacted petition omitting Exhibit A and the argument/statement of relevance. Such would retain requestor's other materials, arguments, positions taken, points made, etc. of record."

The present submission is responsive to that statement of the September decision, and has timely provided the suggested redacted petition. Accordingly, the submission is granted entry for the reasons set forth in the September decision. The reasons for waiver of the rules set forth therein continue to apply to the present submission.

The redacted requester petition, which was previously addressed in the September decision of this office, will be made of record in the present proceeding.

**CONCLUSION**

1. The requester petition under 37 CFR 1.183 is granted.

2. The October 2, 2003, third party requester submission will be entered into the record and scanned into the Reexamination Processing System Scanning Data Base of the Central Reexamination Unit.

3. The reexamination file is being returned to Technology Center 2600 for forwarding to the examiner.

4. Any questions regarding this decision should be directed to the undersigned at (703) 308-6710.

5. Telephone inquiries related to the examination of the reexamination proceeding should be directed to Examiner David E. Harvey of Art Unit 2614 at 703-305-4635.

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

October 4, 2003
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/006,606<br>+90/006,703<br>+90/006,839 | 04/18/2003 | 5233654 | 6011-226 | 9269 |

21967 7590 12/03/2004

EXAMINER

HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON, DC 20006-1109

| ART UNIT | PAPER NUMBER |
|---|---|
| | 16 |

DATE MAILED: 12/03/2004

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

Cc: third party requester as attached.

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Thomas L. Peterson, Esq.
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1001 G Street NW 11th Floor
Washington DC 20001-4597

# *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/006,703 + 90/006,604 + 90/006,839

PATENT NO. 5233654.

ART UNIT 2600.

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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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Arthur J. Usher IV, Esquire
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# *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/006,606 + 90/006,703 + 90/006,839

PATENT NO. 5233654.

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Paper No. 16

| | |
|---|---|
| Thomas Scott<br>HUNTON & WILLIAMS LLP<br>INTELLECTUAL PROPERTY DEPARTMENT<br>1900 K STREET, N.W.<br>SUITE 1200<br>WASHINGTON DC 20006-1109 | FOR OWNER |
| Arthur J. Usher IV, Esquire<br>Woodard, Emhardt, Naughton, Moriarty & McNett LLP<br>Bank One Center/Tower<br>111 Monumental Circle, Suite 3700<br>Indianapolis, Indiana 46204-5137 | FOR FIRST THIRD PARTY REQUESTOR |
| Thomas L. Peterson, Esq.<br>Banner & Witcoff, Ltd.<br>1001 G Street NW 11th Floor<br>Washington DC 20001-4597 | FOR SECOND THIRD PARTY REQUESTOR |
| In Re Harvey, et al.<br>Reexamination Proceeding<br>Control No. 90/006,606<br>Filed 4-18-03<br>For U.S. Patent No. 5,233,654 | DECISION SUA SPONTE MERGING REEXAMINATION PROCEEDINGS |
| In Re Harvey, et al.<br>Reexamination Proceeding<br>Control No. 90/006,703<br>Filed 7-7-03<br>For U.S. Patent No. 5,233,654 | |
| In Re Harvey, et al.<br>Reexamination Proceeding<br>Control No. 90/006,839<br>Filed 10-31-03<br>For U.S. Patent No. 5,233,654 | |

The above noted reexamination proceedings are before the Director of Technology Center 2600 for consideration of merger of the proceedings under 37 CFR 1.56(c).

**BACKGROUND**

1. Patent No. 5,233,654 issued on August 3, 1993.

2. A first request for reexamination, Control No. 90/006,606 ('606) was filed by the First Third Party Requestor on April 18, 2003.

3. Reexamination was ordered on the '606 reexamination proceedings on July 9, 2003.

4. No Patent Owner's statement was filed in the '606 reexamination proceeding.

5. A second request for reexamination, Control No. 90/006,703 ('703) was filed by the Second Third Party Requestor on July 7, 2003.

6. Reexamination was ordered on the '703 reexamination proceedings on September 26, 2003.

7. A statement of non-submission of Patent Owner's statement was filed on November 5, 2003.

8. A third request for reexamination, Control No. 90/006,839 ('839) was filed by the Second Third Party Requestor on October 31, 2003.

9. Reexamination was ordered on the '839 reexamination proceedings on January 9, 2004.

10. A statement of non-submission of Patent Owner's statement was filed on February 2, 2004.

**DISCUSSION**

37 CFR 1.565(c) states:

> "If reexamination is ordered while a prior reexaminations is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under section 1.570".

**DECISION**

**I.** Merger of Proceedings

In accordance with 37 CFR 1.565(c), the '606, '703 and '839 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

**II.** Requirements for the same amendment's in all proceedings.

The Patent Owner is required to maintain the same claims and specification in all three 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 must contain the identifying data for each proceeding 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 requestor and requestor will be sent copies of all papers mailed by the Office. See MPEP §2283.

A review of these reexamination files finds that both proceedings currently contain the same claims and specification and therefore the Patent Owner need not take any action.

The merged proceedings are being forwarded to the examiner for appropriate action. An Office action will be mailed in due course.

Reinhard Eisenzopf, Acting Director
Technology Center 2600
Communications & Information Processing

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(For Requester Thomson, Inc.)

In re John C. Harvey et al.
Reexamination Proceeding
Control No.: 90/006,606
Filed: April 18, 2003
For: U.S. Patent No. 5,233,654

In re John C. Harvey et al.
Reexamination Proceeding
Control No.: 90/006,703
Filed: July 7, 2003
For: U.S. Patent No. 5,233,654

In re John C. Harvey et al.
Reexamination Proceeding
Control No.: 90/006,839
Filed: October 31, 2003
For: U.S. Patent No. 5,233,654

DECISION DISMISSING PETITION AND SEALING PAPERS, AND ORDER *RE* SHOWING CAUSE TO UNSEAL

This is a decision on the September 6, 2005 third party requester petition titled PETITION TO EXPUNGE PAPERS FROM PATENT REEXAMINATION FILES.

The petition is considered in three respects:

(1) Under 37 CFR 1.183 as a request to waive the rules and allow entry of the petition paper.

(2) Under 37 CFR 1.182 as a request to expunge materials submitted by the patent owner with the Information Disclosure Statement (IDS) of August 22, 2005.

(3) Under 37 CFR 1.182 as a request to seal materials submitted by the patent owner with the Information Disclosure Statement (IDS) of August 22, 2005.

At the end of the first paragraph of the instant petition, the petitioner authorizes the Office to charge the petition fee to deposit account number 19-0733. The $400 fee set forth in 37 CFR 1.17(f) for a petition under 37 CFR 1.182 and under 37 CFR 1.183 has accordingly been charged.

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

## SUMMARY

The petition under 37 CFR 1.183 is granted, such that the present petition paper will be permitted entry and will be addressed.

The petition under 37 CFR 1.182 to expunge materials is dismissed as not ripe for decision.

The petition under 37 CFR 1.182 to seal materials is granted to the extent that:

(a) The Office is placing the documents identified by the petitioner in Exhibit 1 attached to the instant petition at least temporarily under seal.

(b) The patent owner is being provided with an opportunity to show cause why the documents identified by the petitioner in Exhibit 1 should be available to the public, and thus unsealed.

## REVIEW OF FACTS

1. U.S. Patent No. 5,233,654 (hereinafter, the '654 patent) issued on August 3, 1993.

2. On March 28, 2002 the patent owner Personalized Media Communications, LLC (PMC) brought a patent infringement suit against the petitioner Scientific-Atlanta,

Inc. (S-A) in the United States District Court for the Northern District of Georgia.[1] As of the mail date of this decision, the litigation is ongoing.

3. On May 2, 2003, the court issued an Order prohibiting public disclosure of certain information.

4. On April 18, 2003, Thomson, Inc. filed a first request for reexamination of the '654 patent. The Thomson request for reexamination was assigned control number 90/006,606, and it was granted. The petitioner S-A then filed second and third requests for reexamination of the '654 patent, on July 7, 2003 and October 31, 2003. The S-A requests for reexamination were assigned control numbers 90/006,703 and 90/006,839, respectively, and they too were granted. The three granted reexamination proceedings were subsequently merged under 37 CFR 1.565(c).

5. On August 22, 2005, PMC filed an IDS in reexamination control numbers 90/006,606, 90/006,703, and 90/006,839.

6. On September 6, 2005, S-A, the requester of two of the three merged proceedings, filed the instant petition alleging that PMC's IDS improperly included certain documents subject to the court's protective Order.

## DECISION

I. The Petition Under 37 CFR 1.183 for Entry of the Petition Paper

The instant petition is not entitled to entry. According to 37 CFR 1.550(g):

> The active participation of the *ex parte* reexamination requester ends with the reply pursuant to § 1.535, and no further submissions on behalf of the reexamination requester will be acknowledged or considered. Further, no submissions on behalf of any third parties will be acknowledged or considered unless such submissions are:
>
> (1) in accordance with § 1.510 or § 1.535; or
>
> (2) entered in the patent file prior to the date of the order for *ex parte* reexamination pursuant to § 1.525.

The petitioner S-A is one of the two third party requesters in the instant merged reexamination proceeding. However, the present petition is not a reply pursuant to 37 CFR 1.535. Furthermore, the petition is not a request for reexamination under 37 CFR

---

[1] *Personalized Media Communications,LLC v. Scientific-Atlanta, Inc.*, No.1:02-CV -824 (N.D. Ga. filed Mar. 28, 2002).

1.510, it was filed after the date of the order for *ex parte* reexamination (37 CFR 1.552(g)(2)), and it is clearly not a submission of a prior art citation under 37 CFR 1.502. Thus, the requester S-A petition does not have an entry right in the instant proceeding. Although the Office does accept submissions from third parties pursuant to MPEP § 2282 that are limited to bare notice of prior or concurrent litigation involving the patent undergoing reexamination, such notice is not the subject of the instant petition. S-A fails to suggest any provision of the regulations which could provide a basis for entry of its petition, and the Office can identify none. Thus, by rule, S-A is not entitled to consideration of the instant petition.

Pursuant to 37 CFR 1.183, however:

> 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.

In the present instance, the petition alleges that significant property rights are at stake, and because it may be possible for the Office to act to protect those rights, the interests of justice require that the reexamination entry right rules be waived. Therefore, the Office will enter and consider S-A's petition. Entry of the present petition in the reexamination proceeding is akin to entry of bare notice of prior or concurrent litigation in a reexamination proceeding (pursuant to MPEP § 2282), as both serve a legitimate interest, and neither goes to the merits of the proceeding. As such, submission of the present petition does not constitute prohibited participation in the proceeding.

Accordingly, the petition, as it is taken under 37 CFR 1.183, is granted to permit entry and consideration of the petition paper.

II. The Petition Under 37 CFR 1.182 to Expunge

S-A's petition cannot be considered under 37 CFR 1.59, since 37 CFR 1.59, by its terms, applies to "applications" and not to reexamination proceedings.

However, 35 U.S.C. 305 provides:

> After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title.

This provision of 35 U.S.C. 305 has been interpreted to permit a petition for expungement in reexamination proceedings. Since there is no rule that provides for expungement in reexamination proceedings, S-A's petition to expunge is taken as a petition under 37 CFR 1.182 to expunge documents from the record of the

reexamination proceeding.[2] In deciding such petitions for expungement in reexamination, the guidelines for deciding petitions filed under 37 CFR 1.59 (see MPEP 724-724.06) are followed insofar as they may be applied to the facts at hand. Such will be the case for the present petition.

MPEP 724.04(c) sets forth the guidelines for a petition to expunge "Materials Submitted in Reexamination File Open to the Public Under 37 CFR 1.11(d)." When the reexamination proceeding is considered for action on the merits, the examiner (and/or other appropriate Office personnel responsible for considering the information) will review the protected information that has been sealed, and will make a determination as to whether or not any portion or all of that information is "important to a reasonable examiner in deciding whether or not a claim is patentable." The examiner may issue a determination on the issue of importance of the sealed information in the first Office action on the merits, or in an Office action issued any time thereafter as appropriate, but in no event later than the close of prosecution.

It is not appropriate to make, in this decision, a final determination of whether or not the material requested to be expunged is "important to a reasonable examiner in deciding whether or not a claim is patentable." Rather, such a decision is issued by the examiner no later than the close of prosecution. Thus, a decision on the petition to expunge would be premature at this time. Therefore the petition, as it relates to the expungement issue, is dismissed.

III. The Petition Under 37 CFR 1.182 to Seal

S-A alleges that certain documents, identified in Exhibit 1 attached to the instant petition and submitted to the Office by PMC with the IDS of August 22, 2005, are subject to the court's May 2, 2003 protective order. S-A has provided the Office with a copy of the Order as Exhibit 2. According to S-A, the Exhibit 1 documents are S-A's trade secrets, and S-A would be harmed by their public release. By way of the instant petition, S-A seeks to avert this perceived harm.

S-A provides a reasonable basis upon which to conclude that the Exhibit 1 documents may be subject to the protective order, and that their availability to the public may cause harm to S-A. The practitioner signing the instant petition has done so subject to the Patent and Trademark Office Code of Professional Responsibility, including 37 CFR 10.23(c)(2)(ii) which prohibits giving false or misleading information to the Office. It is

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[2] 37 CFR 1.182 states:

> 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).

noted that 37 CFR 1.11(d) states:

> All papers or copies thereof relating to a reexamination proceeding which have been entered of record in the patent or reexamination file are open to inspection by the general public, and copies may be furnished upon paying the fee therefor.

However, in the interest of justice under 37 CFR 1.183, the Office hereby takes the extraordinary step of waiving the public access provision of 37 CFR 1.11(d) *sua sponte* for a period of one month from the date of this decision, as it applies to the IDS of August 22, 2005. The IDS and its accompanying documents will be sealed from public view. Such sealing furthers the interest in maintaining the confidentiality of S-A's documents, which appear to be subject to the protective court order of May 2, 2003.

It is to be noted that the documents which are the subject of the instant petition have already been made available to the public and have been subject to copying under 37 CFR 1.11(d). Accordingly, the Office cannot guarantee that the materials being sealed as a result of this decision were not previously accessed by the public.

IV. Order Providing Opportunity to Show Cause

Patent owner PMC is hereby being provided with an opportunity to show cause why the materials sealed in accordance with this decision should be unsealed, such that the documents identified in S-A's Exhibit 1 would be made accessible to the public. If PMC believes that public access to the documents is appropriate and the seal should be lifted, PMC must explain why such is the case, in light of S-A's allegations and the protective order of record. PMC is given a **one month time period from the date of this decision** to respond to this Order. If no response to this Order is received within one month, or if sufficient cause is not shown in the response, the Office will resume examination of the reexamination proceeding, with the materials remaining sealed.

CONCLUSION

1. The petition under 37 CFR 1.183 is granted, such that the present petition paper has been entered and addressed.

2. The petition under 37 CFR 1.182 to expunge materials is dismissed as not ripe for decision.

3. The petition under 37 CFR 1.182 to seal materials is granted to the extent that the Office is placing the documents identified by the petitioner in Exhibit 1 attached to the instant petition at least temporarily under seal.

4. The patent owner is provided with **ONE (1) MONTH** from the date of this decision, to show cause why the materials sealed in accordance with this decision should be unsealed.

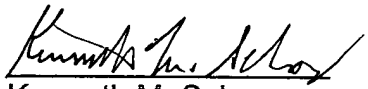
5. The instant reexamination proceeding is being forwarded to the Central Reexamination Unit to seal the documents identified in Exhibit 1 attached to the instant petition, and mail the present decision.

6. After mailing of this decision, jurisdiction over the instant reexamination proceeding will be retained by the Office of Patent Legal Administration until either:

(1) The time expires for response to the Show Cause Order without any response having been received. Where no response is received and the time for same has expired, jurisdiction will automatically transfer to Technology Center 2600, and the examiner will prepare an Office action for the proceeding; OR

(2) A response to the Show Cause Order is received and the issue of sealing is resolved, after which jurisdiction will be transfered to Technology Center 2600 for preparation of an Office action

7. Telephone inquiries related to this decision should be directed to Kathleen Kahler Fonda, Legal Advisor, at (571) 272-7754 or in her absence, to the undersigned, at (571) 272-7710.



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

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October 18, 2005

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

Thomas Scott
HUNTON & WILLIAMS
1751 Pinnacle Drive
Suite 1700, Tysons Corner
McLean, VA 22102

(For Patent Owner Personalized Media Communications, LLC)

MAILED
MAR 31 2006
REEXAM UNIT

Arthur J. Usher, IV
WOODARD EMHARDT NAUGHTON
MORIARTY & MCNETT LLP
Bank One Center/Tower
111 Monument Circle, Suite 3700
Indianapolis, IN 46204-51387

(For Requester Thomson, Inc.)

Nina L. Medlock
BANNER & WITCOFF, LTD
1001 G Street NW
Washington, DC 20001

(For Requester Scientific-Atlanta, Inc.)

In re John C. Harvey et al.
Reexamination Proceeding
Control Nos.: 90/006,606 filed April 18, 2003
90/006,703 filed July 7, 2003
90/006,839 filed October 31, 2003
For: U.S. Patent No. 5,233,654

DECISION DISMISSING PETITION AND UNSEALING PAPERS

This is a decision on the patent owner's October 11, 2005 petition titled PATENT OWNER'S PETITION TO RETURN MATERIALS SUBMITTED BY THIRD PARTY IN *EX PARTE* PROCEEDING. This decision is also responsive to the patent owner's November 1, 2005 submission titled PATENT OWNER'S RESPONSE TO ORDER PROVIDING OPPORTUNITY TO SHOW CAUSE.

The instant petition is treated as a petition under 37 CFR 1.182.[1] On page 2 of the

[1] 37 CFR 1.182 states:

> 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

petition, the patent owner authorizes the Office to charge fees associated with the petition to deposit account number 50-0206. The $400 fee set forth in 37 CFR 1.17(f) for a petition under 37 CFR 1.182 has been charged.

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

## SUMMARY

The patent owner's petition under 37 CFR 1.182 is dismissed in view of the patent owner's request that it be withdrawn.

The documents placed under temporary seal by the Office decision of October 21, 2005 titled DECISION DISMISSING PETITION AND SEALING PAPERS, AND ORDER *RE* SHOWING CAUSE TO UNSEAL are hereby unsealed.

## REVIEW OF FACTS

1. U.S. Patent No. 5,233,654 (hereinafter, the '654 patent) issued on March 10, 1992.

2. On March 28, 2002 the patent owner, Personalized Media Communications, LLC (PMC), brought a patent infringement suit against Scientific-Atlanta, Inc. (S-A) in the United States District Court for the Northern District of Georgia. As of the mail date of this decision, the litigation has been stayed pending conclusion of the ongoing reexamination proceeding.[2]

3. The court issued an Order prohibiting public disclosure of certain information on May 2, 2003.

4. On April 18, 2003 Thomson, Inc. filed a request for reexamination of the '654 patent. Reexamination control number 90/006,606 was assigned to the proceeding. The petitioner S-A filed requests for reexamination of the '654 patent on July 7, 2003 and October 31, 2003, and reexamination control numbers 90/006,703 and 90/006,839, respectively, were assigned to the proceedings. The request for reexamination was granted, and the three proceedings have been merged under 37 CFR 1.565(c).

5. On August 22, 2005, PMC filed an IDS in reexamination control numbers 90/006,606, 90/006,703, and 90/006,839.

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set forth in § 1.17(f).

[2] *Personalized Media Communications, LLC v. Scientific-Atlanta, Inc.*, No.1:02-CV -824 (N.D. Ga. filed Mar. 28, 2002) (order to stay all proceedings pending PTO reexamination issued Feb. 6, 2006).

6. On September 6, 2005, S-A filed a petition alleging that PMC's IDS improperly included certain documents subject to the court's protective Order.

7. On October 11, 2005, the patent owner filed the instant petition to return materials submitted by a third party, i.e., the September 6, 2005 S-A petition.

8. The Office of Patent Legal Administration issued a decision on S-A's petition on October 21, 2005. The decision allowed entry of S-A's petition, dismissed the request to expunge as untimely, and temporarily sealed certain documents alleged by S-A to be covered by the court's protective order. The decision also provided the patent owner with an opportunity to show cause why the documents should be unsealed. At the time of that decision, the Office of Patent Legal Administration was unaware of the instant petition.

9. On October 28, 2005, the court issued an order denying S-A's motion to hold the patent owner in contempt for disclosing to the Office certain documents alleged by S-A to be within the scope of the court's May 2, 2003 protective order.

10. On November 1, 2005, the patent owner submitted the instant response to the Office's decision of October 21, 2005.

## DECISION

I. The Petition Under 37 CFR 1.182 for Return of S-A's Petition

The Office of Patent Legal Administration regrets that it was unaware of the patent owner's instant petition at the time the decision on S-A's petition was made.

The patent owner's petition requests that S-A's petition be returned without consideration, or in the alternative, that the Office stay S-A's petition pending a determination of confidentiality by the district court.

The decision of October 21, 2005 recognized that S-A's petition was not entitled as a matter of right to entry under 37 CFR 1.550(g), but nevertheless allowed entry of the petition in the interest of justice pursuant to 37 CFR 1.183. The decision also placed certain documents under temporary seal, and afforded the patent owner an opportunity to show cause why the documents should be unsealed.

The patent owner's petition is dismissed as moot in view of the issuance of the decision Office of October 21, 2005. The petition is further mooted as to any future action by the Office in regard to the relief requested, since a determination of confidentiality by the district court has now been made, i.e., the court's decision was issued October 28, 2005 as a court Order.

II. The Reponse to the Order Providing Opportunity to Show Cause

S-A's petition of September 6, 2005 had alleged that certain documents, identified in Exhibit 1 attached to S-A's petition and submitted to the Office by the patent owner with the IDS of August 22, 2005, were subject to the court's May 2, 2003 protective order. In the decision of October 21, 2005, the Office placed the documents under temporary seal. Acting in the interest of justice under 37 CFR 1.183, the Office *sua sponte* waived the public access provision of 37 CFR 1.11(d) for a limited period of time because a reasonable question had been raised as to whether the documents were subject to the protective court order of May 2, 2003.

The court has now determined, by way of the Order dated October 28, 2005, that the documents in question were not subject to the protective order of May 2, 2003, and that the patent owner's submission of the documents to the Office was not in contempt of the Order. For this reason the patent owner now requests that the documents be unsealed.

In view of the court Order and the patent owner's request, it is directed by way of this decision, that the documents be unsealed. The documents are to again be available to the public in accordance with 37 CFR 1.11(d).

## REQUESTER THOMSON'S ADDRESS

The patent owner's communications were served on requester Thomson at the following address:

A. J. Usher, IV
BOSE MCKINNEY & EVANS LLP
2700 First Indiana Plaza
Indianapolis, IN 46204

The address of record is:

Arthur J. Usher, IV
WOODARD EMHARDT NAUGHTON MORIARTY & MCNETT LLP
Bank One Center/Tower
111 Monument Circle, Suite 3700
Indianapolis, IN 46204-51387

The instant decision is being mailed to both the address of record and the address at which requester Thomson was served.

The patent owner is directed to take any needed steps to ensure that the copies of the patent owner papers identified above are, or have been, served on the requester.

Requester Thomson is directed to file an appropriate change of address, if the address of record is no longer correct.

## CONCLUSION

1. The petition under 37 CFR 1.182 is dismissed.

2. The patent owner's showing of cause to unseal the documents temporarily placed under seal in accordance with the decision of October 21, 2005, is found to be sufficient; accordingly the documents will be unsealed.

3. This decision is a final agency action within the meaning of 5 U.S.C. § 704.

4. Jurisdiction over the instant reexamination proceeding is being returned to Technology Center 2600. The Technology Center is directed to unseal the information disclosure statement filed August 19, 2005, by the patent owner, prior to taking any other appropriate action.

5. Telephone inquiries related to this decision should be directed to Kathleen Kahler Fonda, Legal Advisor, at (571) 272-7754, or in her absence, to the undersigned, at (571) 272-7710.

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

C:\kiva\kenpet6\expung\6606 & 6703 & 6839 Resp by Owner Re Unseal_grant.wpd
March 29, 2006

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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HUNTLON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K Street N.W.
Suite 1200
Washington, DC 20006-1109

(For Patent Owner)

MAILED

MAY 1 8 2006

REEXAM UNIT

Arthur J. Usher, IV
WOODARD EMHARDT NAUGHTON
MORIARITY & MCNETT LLP
Bank One Center/Tower
111 Monument Circle, Suite 3700
Indianapolis, IN 46204-5137

(For First Third Party Requester)

Nina L. Medlock
BANNER & WITCOFF, LTD
1001 G Street NW
Washington, DC 20001

(For Second Third Party Requester)

DECISION DISMISSING PETITION TO EXCERCISE SUPERVISORY AUTHORITY
37 CFR § 1.181 (a)(3)

*In re* John C. Harvey
*Ex Parte* Reexamination Proceeding
Control No. 90/006,606
Filed: April 18, 2003
For: US Patent No. 5,233,654

*In re* John C. Harvey
*Ex Parte* Reexamination Proceeding
Control No. 90/006,703
Filed: July 7, 2003
For: US Patent No. 5,233,654

*In re* John C. Harvey
*Ex Parte* Reexamination Proceeding
Control No. 90/006,839
Filed: October 31, 2003
For: US Patent No. 5,233,654

This is a decision on the patent owner's petition dated 9 February 2006, titled PETITION TO EXERCISE SUPERVISORY AUTHORITY UNDER 37 CFR § 1.181 (a)(3)

## REVIEW OF FACTS

1. U. S. Patent No. 5,233,654 issued on August 3, 1993.

2. Requests were filed by third party requesters for reexamination of US Patent No. 5,233,654 on April 18, 2003; July 7, 2003 and October 31, 2003.

3. The proceedings were merged on December 3, 2004.

4. A non-final Office action was mailed on July 11, 2005.

5. The patent owner response was received on September 12, 2005.

## DISCUSSION REGARDING EXERCISING SUPERVISORY AUTHORITY

**§ 1.181 Petition to the Director.**

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances.

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

After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office.

**MPEP 2209 Ex Parte Reexamination**

The intent of the reexamination procedures covered in this chapter include the following:

(A) To provide procedures for reexamination of patents;
(B) To implement reexamination in an essentially ex parte manner;
(C) To minimize the processing costs and complexities of reexamination;
(D) To maximize respect for the reexamined patent;
(E) To provide procedures for prompt and timely determinations by the Office in accordance with the "special dispatch " requirements of 35 U.S.C. 305.

## DECISION EXERCISING SUPERVISORY AUTHORITY

The patent owner requests that the supervisory authority establish a schedule for completion of this proceeding, declare the current rejections final, and alternatively that the examiner assigned instant proceeding be removed from the proceeding.

The Office makes every effort to provide procedures for prompt and timely determinations in accordance with "special dispatch" requirements. Each proceeding must be evaluated on a proceeding-by-proceeding basis with consideration to the number of claims, complexity of the prior art and technology of the instant proceeding. Each prior art submission, which fully complies with the requirements of citation must be considered to the extent appropriate to the fact situation. Each proceeding is thus handled with "special dispatch" according to the fact basis before the Office.

The patent owner requests that the present proceeding establish a schedule for completion. It is noted that on balance the patent owner has not provided sufficient evidence that the examiner responsible for this proceeding has not made every effort to address each issue raised in the request for reexamination, while considering the prior art fully and preparing appropriate response to each paper received in the instant proceeding. Further it is noted that the proceedings are complex and to respond appropriately requires that the examiner fully develop each issue so that the public record is thorough and complete.

The petitioner proffers no convincing reason, nor is it apparent, which would cause the Office to alter its normal work assignment procedure for reexamination proceedings. There is no evidence proffered which would indicate arbitrary or capricious treatment and/or abusive conduct buy the examiner. Accordingly the petition is **denied**. The reexamination proceeding is being forwarded to the examiner for appropriate action.

The patent owner alleges "that Examiner David Harvey be removed from the present reexamination proceeding and that the Director reassign this reexamination to a new, objective, unbiased, and competent examiner who is not committed to systematically delaying all matters respecting PMC's patents and pending applications." The patent owner is reminded that derogatory remarks regarding the examiner are in appropriate in correspondence to the USPTO. The patent owner papers provide highly negative remarks with respect to Office employees. The patent owner is reminded that derogatory remarks made in the proceeding regarding the examiner are inappropriate.

Pursuant to 37 CFR 1.3:

> "Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Director and will not be entered. A notice of the non-entry of the paper will be provided. Complaints against examiners and other employees must be made in correspondence separate from other papers."

## CONCLUSION

1. By way of instant decision, the Petition to Exercise Supervisory Authority is hereby **denied.**

2. No response is required on the part of the Patent Owner.

3. Jurisdiction over the reexamination proceeding is being returned to the examiner for further handling and examination consistent with this decision.

4. 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

5. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, Special Program Examiner in the Central Reexamination Unit, Art Unit 3992, at (571) 272-1611

MReinhart
SPRE CRU 3992
for

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

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. |
|---|---|---|---|---|
| 90/006,606 | 04/18/2003 | 5233654 | 6011-226 | 9269 |

70813 7590 12/27/2007

GOODWIN PROCTER LLP
901 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20001

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 12/27/2007

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. |
|---|---|---|---|---|
| 90/006,703 | 07/07/2003 | 5233654 | 001263.00015 | 9271 |

70813 7590 12/27/2007

GOODWIN PROCTER LLP
901 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20001

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 12/27/2007

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

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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. |
|---|---|---|---|---|
| 90/006,839 | 10/31/2003 | 5233654 | 01263.00020 | 6921 |

70813 7590 12/27/2007

GOODWIN PROCTER LLP
901 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20001

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 12/27/2007

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
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ALEXANDRIA, VA 22313-1450
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DEC 27 2007

CENTRAL REEXAMINATION UNIT

Thomas Scott (Patent Owner)
Goodwin Procter LLP
901 New York Ave., NW
Washington, DC 20001

Nina L. Medlock (for Third Party Requester)
Banner & Witcoff, Ltd.
1001 G Street NW
Washington, DC 20001

Arthur J. Usher, IV (for Third Party Requester)
Krieg DeVault LLP
One Indiana Square
Indianapolis, IN 46204

*In re John C. Harvey et al.*
Reexamination Proceeding
Control No. 90/006,606
Filed: April 18, 2003
For: U.S. Patent No. 5,233,654

*In re John C. Harvey et al.*
Reexamination Proceeding
Control No. 90/006,703
Filed: July 7, 2003
For: U.S. Patent No.: 5,233,654

*In re John C. Harvey et al.*
Reexamination Proceeding
Control No. 90/006,839
Filed: October 31, 2003
For: U.S. Patent No.: 5,233,654

DECISION
GRANTING
PETITION

This is a decision on the November 2, 2007 patent owner "Renewed Petition to Expunge Papers from the Request for Reexamination Pursuant to 37 C.F.R. § 1.59(b)".

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

The petition is **granted**, and the information under MPEP 724.06 and 37 CFR 1.59 will be expunged.

## BACKGROUND

1. U.S. Patent No. 5,233,654 to Harvey et al. (the '654 patent) issued on August 3, 1993.

2. On December 4, 2000 patent owner, Personalized Media Communications, LLC (PMC) brought a patent infringement suit against Thomson Consumer Electronics, Inc. (Thomson) in the United States District Court for Delaware. As of the issue date of this decision, the litigation is on going.

3. On March 28, 2002 the patent owner PMC brought a patent infringement suit against Scientific-Atlanta, Inc. (S-A) in the United States District Court for the Northern District of Georgia.

4. The two courts have issued protective orders prohibiting public disclosure of certain types of information.

5. On April 18, 2003, Thomson filed a first request for *ex parte* reexamination of the '654 patent, which resulted in a reexamination proceeding assigned reexamination control number 90/006,606 (the '6606 proceeding).

6. On July 7, 2003, S-A filed a request for *ex parte* reexamination of the '654 patent, which resulted in a reexamination proceeding assigned reexamination control number 90/006,703 (the '6703 proceeding).

7. On July 9, 2003, the Office granted Thomson's '6606 request, issuing an order for reexamination.

8. On July 9, 2003 (the day reexamination was ordered), the patent owner PMC filed a petition in the '6606 proceeding. Among other things the petition requested the Office to expunge Exhibit E of the '6606's original request for reexamination along with all references to the content of Exhibit E. The petition also requested that Exhibit E be sealed if a decision of expungement was held in abeyance.

9. On August 5, 2003, the Office issued a decision regarding patent owners July 9, 2003 petition. The Office granted patent owner's petition in part, holding a final determination of expungement of Exhibit E in abeyance until the examiner of record could make a determination as to whether or not Exhibit E was "material to patentability by a reasonable examiner within a reexamination proceeding". Pending such a determination, Exhibit E would be sealed and redacted copies of the reexamination request papers would be scanned into the record eliminating references to Exhibit E.

10. On August 11, 2003 Thomson filed a petition to unseal the papers from their request for reexamination.

11. On August 23, 2003 patent owner PMC submitted a petition to seal and opposition to requester's petition to unseal papers from the request for reexamination.

12. On September 12, 2003 the Office issued a decision granting in part patent owner PMC's petition, dismissing Thomson's petition and returning Thomson's petition papers with a thirty day time period to submit a redacted copy of their August 11, 2003 petition papers.

13. On September 26, 2003 the Office granted S-A's '6703 request, issuing an order for reexamination.

14. On October 2, 2003, Thomson submitted a redacted version of their August 11, 2003 petition papers in accordance with the Office's September 12, 2003 decision.

15. On October 31, 2003, S-A filed a request for *ex parte* reexamination of the '654 patent, which resulted in a reexamination proceeding assigned reexamination control number 90/006,839 (the '6839 proceeding).

16. On November 7, 2003 the Office issued a decision entering Thomson's redacted August 11, 2003 petition papers.

17. On January 9, 2004, the Office granted S-A's '6839 request, issuing an order for reexamination.

18. On December 3, 2004, the Office issued a decision merging the '6606, '6703 and '6839 *ex parte* proceedings into a single merged proceeding (the merged proceeding).

19. On July 11, 2005, an Office Action issued by the examiner of record set forth that, upon a review of the redacted materials, it was found that a reasonable examiner would not consider the content of the redacted materials to be material to patentability within the jurisdiction of a reexamination proceeding.

20. On October 2, 2007, the Office issued a Notice of intent to Issue a Reexamination Certificate for the merged *ex parte* proceeding of '6606, '6703 and '6839.

21. On November 2, 2007, patent owner PMC filed the instant petition, titled "Renewed Petition to Expunge Papers from the Request for Reexamination Pursuant to 37 C.F.R. § 1.59(b)."

## DECISION

37 CFR 1.59 provides:

> (a)(1) Information in an application will not be expunged, except as provided in paragraph (b) of this section or § 41.7(a) of this title.
> (2) Information forming part of the original disclosure (*i.e.*, written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under §§1.63 and 1.175 will not be expunged from the application file.

> (b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a) (2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

MPEP 724.05 I provides (in part):

> Such petition must contain:
>
> (A) a clear identification of the information to be expunged without disclosure of the details thereof;
>
> (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;
>
> (D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information;
>
> (E) the fee as set forth in 37 CFR 1.17(g) for a petition under 37 CFR 1.59(b).

## Petition to Expunge under 37 CFR 1.59

In the petition decisions of August 5, 2003, September 12, 2003 and November 7, 2003, decided in accordance with MPEP 724.02, it was required that papers containing proprietary (protected) information submitted in the '6606 request be redacted, and the papers containing proprietary (protected) information were provisionally sealed.

MPEP 724.04(c) sets forth the guidelines for treatment of proprietary "Materials Submitted in Reexamination File Open to the Public Under 37 CFR 1.11(d)." Where papers containing proprietary information are provisionally sealed, a petition to expunge the proprietary information must be submitted in sufficient time that it can be acted on before the reexamination proceeding enters the reexamination certificate printing process.[1] If not, the papers will be unsealed. When reexamination proceeding is considered on the merits, the examiner (and/or other appropriate Office personnel responsible for considering the information) reviews the sealed information, and makes a determination as to whether or not any portion or all of the information submitted is "important to a reasonable examiner in deciding whether or not a claim is patentable."

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[1] If the reexamination is merged with a reissue application, the petition is to be submitted such that it can be acted upon prior to the application's entry into the patent publication stage or the issuance of the notice of abandonment for the reissue application.

In this instance, an original petition to expunge/seal was timely filed on July 9, 2003, concurrent with the day the Office issued an order in the '6606 reexamination proceeding, granting Thomson's request for reexamination. Petitioner has now renewed the petition to expunge on November 2, 2007, shortly after a NIRC issued for the now merged reexamination proceeding. Patent owner, in the renewed petition to expunge, identifies the information to be expunged as the information supplied in Exhibit E filed with Thomson's request for examination on April 18, 2003. Patent owner has complied with the requirements of MPEP 724.05, part I, (A)-(E), to the extent such requirements are applicable to this reexamination proceeding. Patent owner PMC states that Exhibit E contained protected information, *inter alia*, that is was subject to protection under 37 CFR 1.14, thus obviating any need for a commitment of retention. The petitioner indicated that the petition was being submitted by or on behalf of the real party in interest, PMC, who originally petitioned to have the information provisionally sealed. Petitioner authorized payment of the necessary fees under 37 CFR 1.17(g) for a petition under 37 CFR 1.59(b) in their transmittal. Finally, in an Office Action on July 11, 2005 the examiner determined the references in question were not found to be important to a reasonable examiner in deciding whether or not a claim is patentable.

Accordingly, there is compliance with all the necessary criteria set forth in MPEP 724.05. Thus, the petition is **granted.**

## CONCLUSION

1. The petition to expunge information under MPEP 724.06 and 37 CFR 1.59 is **granted.**

2. No copy of the expunged documents will be maintained of record in the Office.

3. A copy of this decision will be made of record in the '6606, '6703 and '6839 *ex parte* reexamination files.

4. Patent owner is **required to retain the expunged material** for the life of the 5,233,654 patent.

5. Jurisdiction over the present merged reexamination proceedings is being returned to the Central Reexamination Unit.

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

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

12/26/07

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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
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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. 90/006,395
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

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| APPLICATION NO | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/006,395<br>490/006,609 | 10/11/2002 | 4866349 | 400100 | 3307 |

27717 7590 04/22/2004

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55 EAST MONROE STREET
SUITE 4200
CHICAGO, IL 60603-5803

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
| | 20 |

DATE MAILED: 04/22/2004

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

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Paper No. 20

Seyfarth Shaw (For Patent Owner)
55 East Monroe Street
Suite 4200
Chicago, IL 60603-5803

E. Thomas Wheelock (For Third Party Requester)
Morrison & Foerster LLP
755 Page Mill Road
Palo Alto, CA 94304

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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Paper No. 13/7

JUL 31 2003

Seyfarth Shaw
55 East Monroe Street
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(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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#9

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NOV 17 2003

Reexamination Control No. 90/006,561 – Paper No. 9
Reexamination Control No. 90/006,615 – Paper No. 8

MAILED

NOV 17 2003

OFFICE OF THE DIRECTOR
TC 3600

**FOR PATENT OWNER:**

Marlin R. Smith
Konneker & Smith
660 N. Central Expressway, Suite 2
Plano, TX 75074

**DECISION ON REEXAMINATION MERGER**
37 CFR 1.565(c)

**FOR FIRST REQUESTER;**

Joseph L. Johnson
Lathrop & Gage, LC
1845 S. National, P.O. Box 4288
Springfield, MO 65808

**FOR SECOND REQUESTER;**

Jeffrey D. Harty
McKee, Voorhees & Sease PLC
801 Grand Ave., Suite 3200
Des Moines, IA 50309

DO NOT ENTER

## NOTICE OF CONSOLIDATION OF REEXAMINATION PROCEEDINGS

Background

1. U.S. Letters Patent No. 5,865,452 issued on February 2, 1999.

2. A first request for reexamination was filed by a third party requester, Joseph L. Johnson, on March 10, 2003, and was assigned Reexamination Control No. 90/006,561.

3. On April 30, 2003, a second request for reexamination of U.S. Letters Patent No. 5,865,452 was filed by a third party requester, Jeffrey D. Harty and was assigned Reexamination Control No. 90/006,615.

4. Reexamination was ordered in Reexamination Control No. 90/006,561 on June 2, 2003.

5. Reexamination was ordered in Reexamination Control No. 90/006,615 on July 17, 2003.

6. In Reexamination Control No. 90/006,561 the patent owner submitted, on August 26, 2003, a preliminary amendment that amended claim 17 and added new claims 20-66. On that same date the patent owner also submitted an Information Disclosure Statement and a Notice of Concurrent Litigation.

7. In Reexamination Control No. 90/006,615 the patent owner submitted, on August 26, 2003, an Information Disclosure Statement and a Notice of Concurrent Litigation.

09/15/2003

## 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 "Background", reexamination has been ordered in two reexamination proceedings simultaneously. Accordingly, merging of the two reexamination proceedings is mandated by 37 CFR 1.565(c).

## Decision

Under the provisions of 37 CFR 1.565(c), reexamination proceedings designated as Reexamination Control Nos. 90/006,561 and 90/006,615 are merged for consolidated proceedings. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

### I. Requirements for Same Amendments in All Files

As noted above, claim 17 was amended and new claims 20-66 added in Reexamination Control No. 90/006,561 in the amendment of August 26, 2003. Patent owner must maintain the same claims and the same description/specification in both files. Therefore, patent owner is required to submit an appropriate "housekeeping" amendment within **ONE MONTH** from the mailing date of this decision, placing the same amendment proffered during the first reexamination proceeding in the second reexamination proceeding, i.e. Reexamination Control No. 90/006,615. Since the time period for submission of a patent owner's statement has expired, and the submission of the required "housekeeping" amendment prior to a first Office action does not invoke the provisions of 37 CFR 1.535, prosecution will proceed *ex parte*. No reply or other submission will be considered in the merged reexamination proceeding filed by the third party requester.

### II. Conduct of Merged Proceeding

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

requesters and such requesters will be sent copies of all papers mailed by the Office during these merged proceedings.

## Conclusion

Reexamination Control Nos. 90/006,561 and 90/006,615 are hereby merged and an Office action will be issued by the examiner for *ex parte* prosecution of the merged proceeding. Appropriate submissions by the patent owner, as set forth above, are required within **ONE MONTH** from the mailing date of this decision.

Steven N. Meyers
Special Programs Examiner
Technology Center 3600
(703) 308-3868

Concur:
Robert Oberleitner, Director,
Technology Center 3600
(703) 308-1134

snm: 11/8/03

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Mailed: December 6, 2004

GREGG C. BENSON
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PATENT DEPARTMENT MS 4159
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: FOR PATENT OWNER

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP
1300 I STREET, NW, SUITE 700
WASHINGTON, DC 20005

: FOR THIRD PARTY REQUESTER, #1

LARRY S. NIXON
NIXON & VANDERHYE, PC
1100 NORTH GLEBE ROAD, 8TH FLOOR
ARLINGTON, VA 22201

: FOR THIRD PARTY REQUESTER #2

In re Ellis et al
Reexamination Proceeding
Control No.: 90/006,617
Director Ordered: September 29, 2003
For: U.S. Patent No. 6,469,012

In re Ellis et al
Reexamination Proceeding
Control No.: 90/006,886
Filed: December 15, 2003
For: U.S. Patent No. 6,469,012

In re Ellis et al
Reexamination Proceeding
Control Number 90/007,110
Filed: July 7, 2004
For: U.S. Patent No. 6,469,012

: 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. 6,469,012 issued October 22, 2002.

2. A first reexamination, Control No. 90/006,617, was ordered by the Director of the US Patent and Trademark Office on September 29, 2003

3. A second request for reexamination, Control No. 90/006,886, was filed by third party Requester, #1, on December 15, 2003.

5. Reexamination was ordered in the '886 reexamination proceeding on February 6, 2004.

6. A third request for reexamination, Control NO. 90/007,110, was filed by third party requester, #2, on July 7, 2004.

7. Reexamination was ordered in the '110 reexamination proceeding on September 13, 2004.

8. A Patent Owner statement was filed with respect to the first reexamination proceeding only.

DISCUSSION

Under 37 CFR 1.565(c):

> If reexamination is ordered while a prior reexamination proceeding is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under 37 CFR 1.570.

As noted in the above review of facts, reexamination has been ordered in all of the above noted reexamination proceedings. Accordingly, merger of the proceedings under 37 CFR 1.565(c) is appropriate.

DECISION

Merger of Proceedings.

In accordance with 37 CFR 1.565(c), the '617, '886 and '110 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

Requirement for Same Amendments in All Proceedings.

Patent Owner is required to maintain the same claims and specification in all files. It appears that no amendments have been made in any of the proceedings as of the date of merger.

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. (It is suggested that the file to which each paper is directed be highlighted in some manner, such as bold and/or underlined proceeding number or other highlighting, in order to avoid confusion as to which file each paper is directed to.)

CONCLUSION

Reexamination Control Nos. 90/006,617, 90/006,886 and 90/007,110 are merged.

The files will be forwarded to the examiner for further action thereon.

Bruce M. Kisliuk
Director, Technology Center 1600

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

FINNEGAN HENDERSON, FARABOW, GARRETT & DUNNER, LL
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# *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/006,886*.

PATENT NO. *6469012*.

ART UNIT *1600*.

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. |
|---|---|---|---|---|
| 90/006,617 | 09/29/2003 | 6469012 | | 9808 |

7590 08/19/2005

Gregg C. Benson
Pfizer, Inc.
Patent Department MS 4159
Eastern Point Road
Groton, CT 06340

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 08/19/2005

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

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Mailed: August 19, 2005

GREGG C. BENSON
PFIZER, INC.
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: FOR PATENT OWNER

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1300 I STREET, NW, SUITE 700
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: FOR THIRD PARTY REQUESTER, #1

LARRY S. NIXON
NIXON & VANDERHYE, PC
1100 NORTH GLEBE ROAD, 8TH FLOOR
ARLINGTON, VA 22201

: FOR THIRD PARTY REQUESTER, #2

ICOS CORPORATION
ATTN: SEAN W. O'DEA, ESQ
22021 20TH AVENUE, SE
BOTHELL, WA 98021

: FOR THIRD PARTY REQUESTER #3

In re Ellis et al
Reexamination Proceeding
Control No.: 90/006,617
Director Ordered: September 29, 2003
For: U.S. Patent No. 6,469,012

In re Ellis et al
Reexamination Proceeding
Control No.: 90/006,886
Filed: December 15, 2003
For: U.S. Patent No. 6,469,012

In re Ellis et al
Reexamination Proceeding
Control Number 90/007,110
Filed: July 7, 2004
For: U.S. Patent No. 6,469,012

In re Ellis et al
Reexamination Proceeding
Control Number 90/007,478
Filed: March 23, 2005
For: U.S. Patent No. 6,469,012

: 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. 6,469,012 issued October 22, 2002.

2. A first reexamination, Control No. 90/006,617, was ordered by the Director of the US Patent and Trademark Office on September 29, 2003

3. A second request for reexamination, Control No. 90/006,886, was filed by third party Requester, #1, on December 15, 2003.

5. Reexamination was ordered in the '886 reexamination proceeding on February 6, 2004.

6. A third request for reexamination, Control No. 90/007,110, was filed by third party requester, #2, on July 7, 2004.

7. Reexamination was ordered in the '110 reexamination proceeding on September 13, 2004.

8. A fourth request for reexamination, Control No. 90/007,478, was filed by third party requester #3 on March 23, 2005.

9. Reexamination was ordered in the '478 reexamination proceeding on May 16, 2005.

10. A Patent Owner statement was filed with respect to the first reexamination proceeding only.

## DISCUSSION

Under 37 CFR 1.565(c):

> If reexamination is ordered while a prior reexamination proceeding is pending, the reexamination proceedings will be consolidated and result in the issuance of a single certificate under 37 CFR 1.570.

As noted in the above review of facts, reexamination has been ordered in all of the above noted reexamination proceedings. Accordingly, merger of the proceedings under 37 CFR 1.565(c) is appropriate.

## DECISION

Merger of Proceedings.

In accordance with 37 CFR 1.565(c), the '617, '886 and '110 reexamination proceedings were previously merged. The '478 proceeding is now merged with the three previously merged proceedings. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

Requirement for Same Amendments in All Proceedings.

Patent Owner is required to maintain the same claims and specification in all files. It appears that no amendments have been made in any of the proceedings as of the date of merger.

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. (It is suggested that the file to which each paper is directed be highlighted in some manner, such as bold and/or underlined proceeding number or other highlighting, in order to avoid confusion as to which file each paper is directed to.)

CONCLUSION

Reexamination Control Nos. 90/006,617, 90/006,886, 90/007,110 and 90/007,478 are merged.

The files will be forwarded to the examiner for further action thereon.

Bruce M. Kisliuk
Director, Technology Center 1600

maw

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Enclosure: Copy of present August 22, 2005 patent owner petition.

LARRY S. NIXON (For Requester Bayer AG)
NIXON & VANDERHYE-PC
1100 NORTH GLEBE ROAD, 8TH FLOOR
ARLINGTON, VA 22201

Enclosure: Copy of present August 22, 2005 patent owner petition.

ICOS CORPORATION (For Requester ICOS Corporation)
ATTN: SEAM W. O'DEA, ESQ
22021 20th AVENUE, SE
BOTHELL, WA 98021

Enclosure: Copy of present August 22, 2005 patent owner petition.

MAILED

NOV 0 8 2005

REEXAM UNIT

*In re Ellis et al.*
Reexamination Proceeding
Control No.: 90/007,614
Filed: July 05, 2005
For: U.S. Patent No. 6,469,012

*In re Ellis et al.*
Reexamination Proceeding
Control No.: 90/007, 478
Filed: March 23, 2005
For: U.S. Patent No. 6,469,012

*In re Ellis et al.*
Reexamination Proceeding
Control No.: 90/007,110
Filed: July 7, 2004
For: U.S. Patent No. 6,469,012

: DECISION
: DISMISSING
: PETITION

*In re Ellis et al.*
Reexamination Proceeding
Control No.: 90/006,886
Filed: December 15, 2003
For: U.S. Patent No. 6,469,012

*In re Ellis et al.*
Reexamination Proceeding
Control No.: 90/006,617 ✓
Filed: September 29, 2003
For: U.S. Patent No. 6,469,012

This is a decision on the August 22, 2005 patent owner PETITION UNDER 37 C.F.R. § 1.182 FOR PRESERVATION OF *EX PARTE* REEXAMINATION PROCEDURE.

On a page titled "Authorization to Charge Fees," petitioner authorizes payment of a $130 fee "which is due in accordance with 37 C.F.R. § 1.17(h)," as well as "any additional fees that may be owed." 37 CFR 1.182 states that "[a]ny petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f)." Pursuant to 37 CFR 1.17(f), the fee for filing a petition under 37 CFR § 1.182 is $400. Accordingly, the required petition fee of $400 is being charged to petitioner's Deposit Account No. 16-1445.

The present petition 37 CFR 1.182 is before the Office of Patent Legal Administration.

The petition is dismissed for the reasons set forth below.

## BACKGROUND

This decision is issued in response to the petition under 37 CFR 1.182, filed August 30, 2005, with regard to newly filed Reexamination Proceeding 90/006,714, filed July 5, 2005 as to the interface of the '6714 proceeding with the merged proceeding of reexamination Control Nos. 90/006,617, 90/006,886, and 90/007,110, for reexamination of U.S. Patent 6,469,012. It is noted that Reexamination Proceeding 90/007,478, filed March 23, 2005, has also been merged with the '6617, '6886 and '7110 proceedings.

As the patent owner points out on page 2 of the petition, the '6617 reexamination proceeding was a Director initiated proceeding, that was initiated on September 29, 2003. On December 15, 2003, Lilly Corporation filed a first third party requester request for reexamination of the '012 patent, resulting in the '6886 proceeding. On July 7, 2004, Bayer AG filed a second third party requester request for reexamination of the '012 patent, resulting in the '7110 proceeding. Both third party requester reexamination proceedings were ordered, and the three reexamination proceedings were subsequently merged. Each proceeding raised a substantial new question of patentability (SNQ) based on a number of different references. The SNQs were similar, but not identical.

Following merger of the three proceedings, a first Office action on the merits issued for the merged proceeding on February 10, 2005, setting a two month shortened statutory time period for response. The patent owner replied to the Office action on April 8, 2005, traversing the sole ground of rejection of record. Prior to the patent owner's response, ICOS Corporation filed a new (the fourth) third party requester request for reexamination of the '012 patent, resulting in the 90/007,478 proceeding, and citing several new references which raised a new and different SNQ of the pending claims. The new proceeding was ordered, and it was subsequently merged with the previously merged proceedings on August 19, 2005. It is noted that the patent owner appears to equate Lilly Corporation and ICOS Corporation as the same entity; however, persuasive evidence has not been provided to support this apparent assertion, and the correspondence addresses are different.

On July 5, 2005, Lilly Corporation filed a fifth request for reexamination of the '012 patent, the present 90/007614 proceeding, This request was determined by the Office not to cite any new and different patents or printed publications which would raise a new SNQ not already of record in the merged reexamination proceeding then pending. Accordingly, the request for reexamination was denied in the Order mailed August 18, 2005. The present petition appears to have been filed by the patent owner prior to receiving the Order denying the '7614 request.

## DECISION

Patent Owner's petition requests that: (1) the evaluation of the '7614 request should be assigned to a different examiner not involved with the consideration of the merged proceeding; (2) if reexamination is ordered, the proceeding should be kept separate from the merged proceeding; (3) the IDS filed with the '7614 request should not be considered in the merged proceeding; (4) the examiner of the merged proceeding should be instructed to disregard the '7614 request or proceeding; and (5) that ICOS be directed to not file any further reexamination requests.

As to the examiner assignment of the '7614 request for determination of whether to order reexamination or not, a decision not to order reexamination was already made prior to the filing of this petition and was made by the examiner conducting the merged proceeding. Accordingly, the issue of providing this requested relief is moot.

With respect to maintaining the '7614 request separate from the merged proceedings, if granted, this request by petitioner is also moot, since the order for reexamination for the '7614 request was not granted.

As to not considering the IDS of the '7614 request in the merged proceedings and disregarding the '7614 request or proceeding, the IDS and request were already considered by the examiner in connection with the denial for reexamination, and the examiner cannot ignore any information bearing on the patentability of the claims of which the examiner is aware. It is noted, however, that the examiner found that the '7614 request failed to raise a substantial new question of patentability which was not previously raised in the prior reexamination proceedings.

As to the request that ICOS be directed not to file any other reexamination requests, this request cannot be granted because the statute confers such a right of filing on ICOS, as well as any other potential requester of reexamination. It is to be observed, however, that any further request for reexamination of the '012 patent will be evaluated to determine whether such a request raises a substantial new question of patentability which was not previously raised in the prior reexamination proceedings (in the same manner as the '7614 request was evaluated).

In view of the discussion above the patent owner's petition is dismissed.

## SERVICE OF COPIES

37 CFR 1.550(f) states as follows:

> After filing of a request for *ex parte* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party in the reexamination proceeding in the manner provided by § 1.248. The document must reflect service or the document may be refused consideration by the Office.

The requisite proof of service on the third party requesters is not included with the instant petition papers, nor with its attachments. Since there is no indication that the third party requesters were provided with a copy of these papers, a copy of the present August 22, 2005 patent owner petition is being provided to the requesters with this decision.

Any future communications filed by the patent owner in this proceeding, or the '6617, '6886, '7110 and '7478 proceedings, must include proof of service on the third party requesters in accordance with 37 CFR 1.550(f).

## CONCLUSION

1. The present petition under 37 CFR 1.182 is dismissed.

2. A copy of the present petition is being provided to the requester with this decision.

3. The '7614 reexamination proceeding remains in a terminated status.

4. The merged proceeding for the '6617, '6886, '7110 and '7478 proceedings will continue.

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

11-8-05
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/006,621 | 05/06/2003 | 5694604 | Reiffin Reexam | 8099 |

1473 7590 12/14/2005

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NEW YORK, NY 10020-1105

| EXAMINER | |
|---|---|
| Banankhah, Majid | |
| **ART UNIT** | **PAPER NUMBER** |
| 2195 | |

DATE MAILED: 12/14/2005

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

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**TECHNOLOGY CENTER 2100**

Fish & Neave IP Group
Ropes & Gray, LLP
1251 Avenue of the Americas, FL C3
New York, New York 10020-1105

**FOR PATENT OWNER**

In re Reexamination of:
U.S. Patent No. 5,694,604
Reexamination Control No. 90/006,621
For: PREEMPTIVE MULTITHREADING COMPUTER SYSTEM WITH CLOCK ACTIVATED INTERRUPT

**DECISION ON PETITION INVOKING SUPERVISORY AUTHORITY UNDER 37 C.F.R. § 1.181**

This decision is in response to the petition filed September 19, 2005 under 37 C.F.R. § 1.181 requesting the Group Director to exercise supervisory authority with respect to the Primary Examiner's actions in the March 4, 2005 Final rejection and the May 24, 2005 Advisory action.

The Petition is **DENIED**.

## PROSECUTION HISTORY

| | | |
|---|---|---|
| May 6, 2003 | - | Patent Owner files request for Reexamination which includes selected declarations and papers from related court proceedings. |
| July 8, 2003 | - | Order granting request for Reexamination mailed. |
| July 24, 2003 | - | Patent Owner's response filed which includes: (a) amendments to the specification; (b) amendments to original claims 1, 4, 6, 7, 14, 18, 22, 24, 26, 27, 31, and 33; (c) newly added claims 37-62; (d) a copy of a motion filed May 6, 2003 with a list of Exhibits. |
| August 21, 2003 | - | Patent Owner files a statement under 37 CFR §1.565(a). |
| August 23, 2003 | - | Patent Owner files a second statement under 37 CFR §1.565(a). |
| September 2, 2003 | - | IDS filed. Presents two references, and an explanation referring to attached selected pages from a January 9, 2002 deposition of Dr. Ligler with respect to the submitted references. |

| | | |
|---|---|---|
| September 22, 2003 | - | Patent Owner files a third statement under 37 CFR §1.565(a). |
| October 10, 2003 | - | Patent Owner files a paper styled "supplement to third statement in compliance with 37 CFR §1.565(a)". |
| October 14, 2003 | - | Patent Owner files a fourth statement under 37 CFR §1.565(a). |
| October 14, 2003 | - | Examiner mails interview summary detailing October 8, 2003 interview. |
| October 25, 2003 | - | Applicant files record of October 8, 2003 telephone interview. |
| October 31, 2003 | - | Patent Owner submits paper styled "Petition to the Commissioner" requesting the examiner to expand on the reexamination order. |
| November 5, 2003 | - | Patent Owner submits supplement to the October 31, 2005 petition. |
| November 12, 2003 | - | In response to Interview recorded above, Patent Owner supplies a complete copy of the "5th declaration of Dr. Sabin Head dated August 2, 2000". |
| November 12, 2003 | - | Patent Owner submits a response to Examiner's Interview record. The response seeks to clarify the substance of the interview which took place on October 8, 2003 and takes issue with the language used in the examiner's summary mailed October 14, 2003. |
| November 21, 2003 | - | Patent Owner files a fifth statement under 37 CFR §1.565(a). |
| January 23, 2004 | - | Patent Owner files a sixth statement under 37 CFR §1.565(a). |
| January 26, 2004 | - | Patent Owner files a seventh statement under 37 CFR §1.565(a). |
| February 10, 2004 | - | Office action issued which addresses all papers submitted prior to January 23, 2004, including those styled as petitions. The 6th and 7th submissions under 37 CFR §1.565(a) were not matched to the file before the action was prepared. The action addressed the priority date afforded each claim and rejected all pending claims under 35 U.S.C. 102 or 103. The action also rejected amended claims 1, 4, 6, 7, 14, 18, 24, 26, 27, 31, 33 and newly presented claims 37-62 under 35 UCS 112 as new matter. |
| April 12, 2004 | - | Patent Owner files response which includes a declaration of inventor M. Reiffin (60 pages); plural declarations of Dr. Ligler (approximately 70 |

pages), supporting exhibits (approximately 900 pages), remarks (140 pages) with supporting claim tables (128 pages), and an amendment to the claims which does not comply with Reexamination amendment practice.

April 22, 2004 - Notice of non-compliant amendment mailed.

April 30, 2004 - Amendment resubmitted in proper format. Original patent claims 1, 4, 6, 7, 14, 18, 22, 24, 26, 27, 31, and 33 are twice amended. Added claims 41, 42, 48, 52, and 53 are amended, and Claims 63-83 are newly added in this amendment.

October 19, 2004 - Examiner's Interview summary record of October 7, 2004 interview is mailed.

October 25, 2004 - Patent Owner's record of October 7, 2004 Interview filed

November 23, 2004 - Patent Owner files a eighth statement under 37 CFR §1.565(a).

March 4, 2005 - Office action finally rejecting all pending claims. Newly added claims 63-83 are rejected solely as new matter - not over art.

May 4, 2005 - Patent Owner files a response to final rejection under 37 CFR §1.116. The response: (a) proposes a further amendment to the specification (in improper format), (b) discusses possible additional claim amendments; (c) includes a Declaration [executed April 24, 2005] by Dr. Jan Narkiewicz; (d) includes a "sixth" declaration of Dr. Sabin Head [dated September 14, 2000] with supporting documents; (e) Part IV of the remarks (page 19) is entitled "Disclosure Pursuant to 37 CFR 1.565(a)" and refers to a March 7, 2005 decision by the BPAI in[1] 07/711,957. This decision is also submitted as part of the response.

May 6, 2005 - Patent Owner files ninth statement under 37 CFR §1.565(a), providing the Request for Rehearing in 07/711,957 filed May 5, 2005.

May 24, 2005 - Advisory action mailed, indicating that the amendment would not be

---

[1] Application 07/711,957 claims c-i-p status from 06/719,507 which claims c-i-p benefit from 06/425,612. The '604 patent which is the subject of the current reexamination proceeding claims benefit as a continuation from 07/496,282 (which matured into the '603 patent) which in turn claims benefit as continuations from both 06/425,612 and 06/719,507. Patent Owner presumably relies upon this relationship to designate the '957 as a related proceeding.

entered upon Appeal, responding at length to the remarks, and refusing entry of the April 24, 2005 declaration of Jan Narkiewicz submitted May 24, 2005.

May 31, 2005 - Patent Owner files a second response to final rejection under 37 CFR §1.116. The response proposes an amendment to the specification.

June 3, 2005 - Notice of Appeal filed.

June 28, 2005 - Advisory action mailed informing Patent Owner that the amendment would not be entered upon Appeal.

August 3, 2005 - Appeal Brief filed. The brief is accompanied by copies of litigation papers filed July 21 and 26, 2005.

August 5, 2005 - Supplemental Appeal Brief filed correcting typographical errors in original filed August 3, 2005.

August 18, 2005 - Examiner issues a Notice of Non-Compliance with 37 CFR 41.37(c).

September 6, 2005 - Patent Owner files eleventh statement under 37 CFR §1.565(a), providing (a) August 31, 2005 Memorandum of Law in Request for Rehearing of BPAI decision in 07/711,957; (b) August 24, 2005 declaration of Jan D. Narkiewicz and (c) August 31, 2005 Order denying Patent Owner's Petition for Writ of Mandamus

September 16, 2005 - New Appeal Brief filed.

September 16, 2005 - Patent Owner files the instant petition.

## BASIS OF OPINION

The relevant portions of the Statutes and Rules are reproduced below. Emphasis is added to draw attention to the critical phrases.

**37 CFR § 1.113 Final rejection or action.**

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's, or for *ex parte* reexaminations filed under §1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§41.31 of this title), or to amendment as specified in §1.114 or §1.116.

Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§1.181). ***Reply to a final rejection or action must comply with §1.114 or paragraph (c) of this section.*** For final actions in an *inter partes* reexamination filed under §1.913, see §1.953.

(c) Reply to a final rejection or action ***must include cancellation of, or appeal from the rejection of, each rejected claim.*** If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

**37 CFR § 1.116 Amendments after final action or appeal.**

(a) An amendment after final action must comply with §1.114 or this section.

(c) ***The admission of, or refusal to admit,*** any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings ***will not operate to relieve the application*** or reexamination proceeding from its condition as subject to appeal or to save the application ***from abandonment under §1.135***, or the reexamination prosecution from termination under §1.550(d) or §1.957(b) or limitation of further prosecution under §1.957(c).

(e) An affidavit or other evidence submitted 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), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

**37 CFR § 1.181 Petition to the Commissioner.**

(f) Except as otherwise provided in these rules, any such petition not filed within 2 months from the action complained of, may be dismissed as untimely. ***The mere filing of a petition will not*** stay the period for reply to an Examiner's action which may be running against an application, nor ***act as a stay of other proceedings***.

**37 CFR §1.565 Concurrent office proceedings which include an ex parte reexamination proceeding.**

(a) In an ex parte reexamination proceeding before the Office, the patent owner must inform the Office of any prior or concurrent proceedings ***in which the patent is or was involved*** such as interferences, reissues, ex parte reexaminations, inter partes reexaminations, or litigation and the results of such proceedings. See §1.985 for notification of prior or concurrent proceedings in an inter partes reexamination proceeding.

## MPEP 2282 [R-2] Notification of Existence of Prior or Concurrent Proceedings and Decisions Thereon

*****

It is important for the Office to be aware of any prior or concurrent proceedings in

which a patent undergoing > ex parte< reexamination is or was involved, such as interferences, reissues, > inter partes reexaminations, other ex parte< reexaminations or litigations, and any results of such proceedings.

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. Ordinarily, no submissions of any kind by third parties filed after the date of the order are placed in the reexamination or patent file while the reexamination proceeding is pending. However, in order to ensure a complete file, with updated status information regarding prior or concurrent proceedings regarding the patent under reexamination, the Office will, at any time, accept >from any parties,< for placement in the reexamination file>,< copies ** of notices of suits and other proceedings involving the patent and copies of decisions or papers filed in the court from litigations or other proceedings involving the patent.

Persons making such submissions ***must limit the submissions to the notification***, and ***must not include further arguments or information***.

Where a submission is not limited to bare notice of the prior or concurrent proceedings (in which a patent undergoing reexamination is or was involved), the submission will be returned by the Office. Any proper submission pursuant to 37 CFR 1.565(a) will be promptly placed of record in the reexamination file>, and will be considered by the examiner as to its content, when the proceeding comes up for action on the merits. Thus, for example, if the patent owner properly files in a reexamination proceeding, pursuant to 37 CFR 1.565(a), an Information Disclosure Statement (IDS) that was submitted by a third party in the discovery stage of litigation of the patent being reexamined, the IDS would be placed in the reexamination file and considered by the examiner, the next time the proceeding comes up for action on the merits<. See MPEP § 2286 for Office investigation for prior or concurrent litigation.

## RELIEF REQUESTED

The petition is unclear as to what relief applicant is requesting. The introductory paragraph requests the following relief:

1. "Leave to reply in Patent Owner's appeal brief to new grounds of rejection first raised in the Examiner's Final Office action";

2. Leave to rely in the Appeal Brief on a declaration "improperly rejected by the examiner ..."; and

3. Leave to rely in the Appeal Brief on "recently filed papers from related proceedings

timely submitted in compliance with 37 CFR. 1.565(a) ...".

while, the section entitled "Action Requested" (on page 4) requests that either (I) the original Appeal Brief and the accompanying affidavit be entered or in the alternative (II) the finality of the rejection be withdrawn - thus effectively allowing the evidence to be admitted.

A review of the entire petition suggests that what Patent Owner is seeking is to be allowed to enter the Narkiewicz declaration and to rely on the declaration and subsequently filed papers in the brief on Appeal.

## OPINION

Patent Owner's request for relief is based on contentions that (1) the Office action of March 4, 2005 was improperly made final; (2) that the Examiner was required to enter the affidavit submitted with the response after final on May 4, 2005 and (3) that reliance on the related proceedings, in the Appeal brief, would result in a more complete record. These positions are argued on pages 5 through 6 of the petition.

As a preliminary matter, the petition to review either the propriety of the final rejection and the non-entry of the affidavit are untimely. In any event, as will be explained below, the final rejection was proper and the non-entry of the evidence submitted after final rejection was also in accordance with Office practice. Furthermore, although creating "a more complete record" may have some merit, in this instance it does not outweigh the overarching goal of moving a proceeding to a conclusion.

This decision proceeds to address Patent Owner's arguments and then discuss how they relate to the requested relief.

### A. Is the Final rejection proper?

Patent Owner contends that the Examiner "relied on the March 31, 2003 decision of the district court" in the final rejection and that this reliance constitutes new grounds of rejection.

As a preliminary matter, the Final rejection was issued on March 4, 2005. If Patent Owner desired supervisory review of this Office action to consider whether the finality was proper, then a petition or request for reconsideration raising this issue should have been filed promptly. *(See*, 37 CFR §1.181(f) reproduced above.) This Petition raising the issue is filed a full five (5) months after the action complained of. Patent Owner, in the interim, has proceeded with prosecution filing both a Notice of Appeal and a Brief on Appeal.

Furthermore, Patent Owner's contention is without merit. Neither the statutory basis of the rejection nor the art relied upon in the rejection changed.

Patent Owner attempts to characterize the final rejection as a new grounds by claiming that the Examiner had rejected the District Court's orders in the first Office action and then "suddenly reversed position and relied on the March 31, 2003 decision of the district court..".

A review of the record reveals a different situation. The Examiner, in response to Patent Owner's repeated remarks, made clear in numerous places in the first Office action and the final Office action that the District Court's findings were not binding upon the Office. The only finding which would limit the Examiner's discretion would be a final holding of invalidity of one or more claims. In response to arguments by Owner, the Examiner used language of the district court. The Examiner's position on these points was similar to that of the judge. That the Examiner chose to incorporate the carefully crafted language of the court as opposed to attempting to rewrite it in a different manner does not amount to new grounds of rejection. In addition, had the examiner redrafted the wording, Patent Owner may have been left to puzzle out where the differences lay between the Examiner's position and that expressed by the court.

Patent Owner makes rash allegations without any factual underpinnings in accusing the Examiner of selectively considering only those portions of the submissions which support the Examiner's position. (Page 5, first paragraph number 2). Examiner's detailed response to Patent Owner's arguments including multiple depositions and affidavits indicate careful consideration of the entire record. The Final Office action of March 2005 contains almost 170 pages of direct response as well as response couched within the statements of rejection. Furthermore, the introductory portion of each Office action specifically acknowledges Patent Owner's submissions.

**B. Was refusal to enter the April 24, 2005 Declaration submitted (May 4, 2005) with the amendment after final rejection under 37 CFR §1.116 proper?**

Patent Owner submitted an amendment after final under 37 CFR §1.116 on May 4, 2005, that included a declaration by Jan D. Narkiewicz (executed on 24 April 2005) addressing the Examiner's contentions as to the meaning of "thread".

In the Advisory action (mailed May 24, 2005) the Examiner relied on 37 CFR §1.116 (e) and refused entry of this declaration. As Patent Owner correctly states (Page 5, second paragraph 1) refusal under 1.116(e) to enter evidence is proper when there is no showing of "good and sufficient cause" for entry. As no showing was made, the Examiner properly refused entry.

Owner, at this late date - more than five months after the submission, attempts to provide the "cause" by alleging that the Examiner newly relied on the district court order in the final and that the declaration is therefore necessary to refute the new arguments. As discussed above, this is a distortion of the record. In any event, the issue which is addressed in the declaration - the meaning of "thread" - was not newly raised in the final. Furthermore, the time to make the showing is when entry of the evidence was originally requested.

In this section as well, Owner makes intemperate remarks and baseless allegations regarding Examiner actions. (Page 5, second paragraphs 2 & 3) Patent Owner is advised that such remarks have no place in proceedings before the Office.

**C. Reliance on the papers "recently submitted".**

This request is couched in two different forms: (1) leave to rely on the papers recently submitted and (2) a request to enter the original Brief on Appeal.

> A Notice of Appeal was filed in this proceeding June 3, 2005.
>
> Subsequently, on July 21, 2005 Patent Owner filed a Motion to vacate the district court's March 31, 2003 order. This Motion was supported by a Declaration of Jan D. Narkiewicz executed on June 6, 2005 and supporting documentation.
>
> On July 26, 2005 Patent Owner filed a petition to the Federal Circuit for a writ of Mandamus to the District Court predicated on the June 5, 2000 Federal Circuit decision in Reiffin v Microsoft.
>
> Patent Owner filed a Brief on Appeal in this proceeding on August 3, 2005 accompanied by the papers referenced in the preceding 2 paragraphs. Because the Brief relied on the declaration of June 6, 2005 it was held non-compliant.
>
> Patent Owner filed a new Brief on Appeal September 16, 2005 which substantially cured the defect noted in the original Brief.

Patent Owner argues that since under 37 CFR §1.565(a) the paper is entitled to entry, it may be relied upon in the Appeal Brief.

It is agreed that a proper and timely submission of such papers under 37 CFR § 1,565(a) would result in entry of the papers into the record. It is noted however, that although Patent Owner has filed numerous submissions under 37 CFR §1.565 earlier in the proceeding, the submission filed with the appeal brief was not proper.

Under Rule 565(a) the Patent Owner is obligated to keep the Office apprised of the ***existence*** of proceedings and the ***results*** (if known). There is no requirement to file each individual paper that has been entered in the record in related or concurrent proceedings. The purpose of this rule is to make the Examiner aware of related proceedings so that the Examiner may consider them appropriately.

The Office will accept (from any party) a submission of papers in a related proceeding provided there is no further argument or information. The information is then considered by the Examiner the next time the proceeding comes up for action on the merits. However, If the submission is not limited to

"bare notice" the submission will not be made of record in the file.

In this instance, Patent Owner submitted papers in related proceedings and referenced them in the Appeal Brief filed concurrently therewith. Thus, the submission was not limited to bare notice and was not a proper submission under 37 CFR §1.565(a). Accordingly, the papers were not made of record (and perforce could not be relied upon in the Appeal Brief).

Insofar as this petition can be construed as a request to accept the documents submitted August 3, 2005 and have them entered in the file, the request is **GRANTED**. Because there is no further argument or information relating to these submissions currently in the record the papers may be entered.

However, Patent Owner's request to rely on these papers in the Brief on Appeal or to have the original Brief reinstated is **DENIED.**

First, to reinstate the original Brief would bring us full circle - the submission would be improper and would be discarded.

Second, if Patent Owner were allowed to submit the papers in proper fashion under 37 CFR §1.565(a) and then follow up with arguments relating to that submission the interpretation of the rule as set out in MPEP §2282 would be gutted.

Patent Owner will not be permitted to rely on papers filed after the final rejection in the Brief on Appeal.

**D. More complete record**

Patent Owner argues that reliance on the related proceedings, in the Appeal brief, would result in a more complete record.

Although the completeness of the record for decision is an important consideration, it must be weighed against the necessity of closure and expedited prosecution. Owner has submitted multiple papers over the course of this proceeding and continues to file papers from other proceedings (both before the Office and in various other venues) which Patent Owner deems to be related.

The Office has taken a liberal approach to these filings, and has not questioned whether they were truly within the scope of 37 CFR §1.565(a), as a means of allowing the Patent Owner to present his case in the manner of his choosing. However, the Office procedures create a legal framework for moving an application or Reexamination proceeding toward closure and ultimately a final agency decision.

The record reveals that Patent Owner filed additional papers on September 6, 2005, a full month after the filing of the original Appeal Brief. If papers submitted after final rejection for the benefit of completing the record, could then be newly argued then there would be no ability to move forward until

all related Court proceedings and related applications before the Office had been resolved.

Furthermore, the papers at issue here were generated by Patent Owner for submission in a concurrent proceeding. Patent Owner is in control of when this submission was made to the court. To allow such filings to delay this proceeding from moving forward would prevent the Office from completing the examination of this proceeding.

## CONCLUSION

Patent Owners requests are decided as follows:

(1) Leave to respond to new grounds in final.

As explained above, there are no new grounds in the final rejection. Irrespective of whether the grounds of rejection in the Office action are "new", Patent Owner is free to respond in the Brief to any and all grounds of rejection which are maintained and from which Patent Owner appeals.

(2) Leave to rely on a declaration "improperly rejected .."

As explained in Section B above, the Examiner acted properly in refusing entry of the declaration. That is, it was not "improperly rejected". Therefore, leave to rely on the declaration is **DENIED**.

(3) Leave to rely on recently-filed papers (under 37 CFR §1.565) in the Brief.

As explained in Section C above, reliance on these papers would violate 37 CFR §1.565(a). Therefore leave to rely on the recently-filed papers is **DENIED.**

(4) Withdrawal of Finality

As explained in Section A above, the final rejection was proper. Accordingly, the petition to withdraw the finality of the Office action is **DENIED**.

(5) Reinstatement of the August 3, 2005 Appeal Brief

As explained in Section C above, reinstatement of the Appeal Brief would result in the submission under 565(a) being improper; and without entry of the 565(a) submission, the Brief may not properly reference the evidence (37 CFR §41.37). Accordingly, the petition to reinstate the August 3, 2005 Appeal Brief is **DENIED**.

The Proceeding is being forwarded to the Examiner for an appropriate response to the Brief on Appeal.

Peter S. Wong, Group Director
Technology Center 2100
Computer Architecture, Software, and Information Security
(571) 272-1400

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MARTIN G. REIFFIN
47 Pheasant Run Terrace
Danville CA 94506

(Patent Owner)

DECISION DISMISSING PETITION TO THE COMMISSIONER UNDER 37 CFR § 1.181 AND THIRD PETITION TO THE COMMISSIONER UNDER 37 CFR § 1.181

*In re* Martin G. Reiffin
*Ex Parte* Reexamination Proceeding
Control No. 90/006,621
Filed: May 6, 2003
For: US Patent No. 5,694,604

MAILED

OCT 11 2006

CENTRAL REEXAMINATION UNIT

This is a decision on the patent owner's petition dated August 8, 2006 titled PETITION TO THE COMMISSIONER UNDER 37 CFR 1.181 and the petitioned dated September 22, 2006, titled THIRD PETITION TO THE COMMISSIONER UNDER 37 CFR § 1.181.

## REVIEW OF FACTS

1. U. S. Patent No. 5,694,604 issued on December 2, 1997.

2. A request was filed by the patent owner for reexamination of US Patent No. 5,694,604 on May 6, 2003.

3. The Order granting reexamination was mailed July 8, 2003.

4. A non-final Office action was mailed on February 10. 2004.

5. An Office action making final was mailed on March 4, 2005.

6. The patent owner submitted an Appeal Brief on August 3, 2005.

7. An Examiner's Answer was mailed March 15, 2006.

8. The patent owner submitted a Reply Brief May 15, 2006.

9. A Supplemental Examiner's Answer was mailed August 2, 2006.

10. The patent owner petitioned the Commissioner under 37 CFR 1.181 on August 8, 2006.

11. The patent owner petitioned the Commissioner under 37 CFR 1.181 on September 22, 2006.

12. The patent owner submitted a supplemental reply brief September 25, 2006.

## DISCUSSION REGARDING EXERCISING SUPERVISORY AUTHORITY

**§ 1.181 Petition to the Director.**

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances.

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

After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office.

**MPEP 2209 Ex Parte Reexamination**

The intent of the reexamination procedures covered in this chapter include the following:

(A) To provide procedures for reexamination of patents;

(B) To implement reexamination in an essentially ex parte manner;
(C) To minimize the processing costs and complexities of reexamination;
(D) To maximize respect for the reexamined patent;
(E) To provide procedures for prompt and timely determinations by the Office in accordance with the "special dispatch " requirements of 35 U.S.C. 305.

## DECISION EXERCISING SUPERVISORY AUTHORITY

**The patent owner petitions in the petition dated August 8, 2006 the following:**

1. That the Examiner respond with "special dispatch."

The Office makes every effort to provide procedures for prompt and timely determinations in accordance with "special dispatch" requirements. Each proceeding must be evaluated on a proceeding-by-proceeding basis with consideration to the number of claims, complexity of the prior art and technology of the instant proceeding. Each proceeding is thus handled with "special dispatch" according to the fact basis before the Office. Accordingly, absent any convincing evidence to the contrary, the fact basis suggests that this proceeding has been handled with "special dispatch."

2. That the Examiner's response modify the final rejection according to pending 711,957.

An Examiner's Answer is written to address points raised in the Appeal Brief. The determination of the outcome of those issues are addressed by the Board of Patent Appeals and Interferences. It is premature to address any such issues by petition prior to the decision by the Board of Patent Appeals and Interferences. Further, it is unclear how any the outcome of an application, which is unrelated to the instant proceeding, could have any bearing whatsoever to the instant proceeding. In any event, the determination of what, if any, significance the may be to the unrelated application will be made by the Board of Patent Appeals and Interferences.

3. That the case (*sic*) be transmitted to the Board of Patent Appeals and Interferences with special dispatch.

Proceeding 90/006,621 will be forwarded to the Board of Patent Appeals and Interferences as soon as this communication is mailed and the examiner responds to the current Supplemental Reply Brief. As such this proceeding is handled with "special dispatch."

**The patent owner petitions in the petition dated September 22, 2006 the following:**

1. That the examiner's contention in his supplemental Examiner's Answer that no new ground for rejection is raised.

The Board of Patent Appeals and Interferences will determine the factual basis of this allegation of the patent owner whether to be supported by fact and whether there is any bearing on this proceeding.

2, 3, 4, 5. That the decision of the Board of Patent Appeal and Interferences 711,957 held that the instant proceeding patent under reexamination is entitled to any particular effective filing date.

Since 711,957 is not a part of the priority the patent under reexamination it is unclear how any decision in the 711,957 application have any bearing on the instant proceeding. In any event, all such issues are appropriately addressed by the Board of Patent Appeals and Interferences.

6. That the examiner abide by the *Phillips v. AWH Corp* decision.

Issues addressing this or any other case law and how it may be applied in a proceeding is addressed by the Board of Patent Appeals and Interferences following the Examiner's Answer.

7. That the examiner respond with "special dispatch."

This issue has been addressed *supra*.

8. That the Examiner's response include a corrected Supplemental Examiner's Answer involving 711,957.

This issue has been addressed *supra*.

The petitioner proffers no convincing reason, nor is it apparent, which would cause the Office to alter its normal work assignment procedure for reexamination proceedings. There is no evidence proffered which would indicate arbitrary or capricious treatment and/or abusive conduct buy the examiner. Accordingly the petition is **dismissed**. The reexamination proceeding is being forwarded to the examiner for appropriate action following the mailing of this decision.

## CONCLUSION

1. By way of instant decision, the Petition to Exercise Supervisory Authority is hereby **dismissed**

2. No response is required on the part of the Patent Owner.

3. Future 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

5. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, Special Program Examiner in the Central Reexamination Unit, Art Unit 3992, at (571) 272-1611

MRein for

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Charmasson, Buchaca & Leach, LLP (For Patent Owner)
1545 Hotel Circle South
Suite 150
San Diego, CA 92108-3426

MAILED

MAY 01 2006

REEXAM UNIT

Steve P. Hassid (For Third Party Requester)
Sheppard, Mullin, Richter & Hampton LLP
333 South Hope Street
48th Floor
Los Angeles, CA 90071

| | |
|---|---|
| In re Reexamination Proceeding | : |
| Lockwood | : |
| Control No. 90/006,625 | : DECISION GRANTING PETITION |
| Filed: May 5, 2003 | : |
| U.S. Patent No. 5,576,951 | : |
| Attorney Docket No. 040021 | : |

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on March 30, 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 - Notice of Appeal and $250.00 Appeal Fee (item 1), a $750.00 petition fee under 37 CFR 1.17(m) (item 2), the requisite statement (item 3), and a Terminal Disclaimer (TD) and fee.

A review of the record reveals that the TD is not needed as the patent has already issued and the

term of the patent is already set. Accordingly, the TD has not been entered and the TD fee will be refunded.

The petition for entry of the late papers is granted.

The $65.00 TD fee will be refunded in due course.

Jurisdiction over the reexamination proceeding is being returned to Technology Center Art Unit 3625 for further examination and consideration of the Notice of Appeal filed March 30, 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, Robert Pond, in Technology Center Art Unit 3625, who can be reached at 571-272-6760.

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

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FROM DIRECTOR'S OFFICE

JUN 13 2006

TECHNOLOGY CENTER 3600

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Charmasson, Buchaca & Leach, LLP (For Patent Owner)
1545 Hotel Circle South
Suite 150
San Diego, CA 92108-3426

**REQUEST FOR EXTENSION OF TIME**
37 CFR 1.550(c)

Steve P. Hassid (For Requestor)
Sheppard, Mullin, Richter & Hampton LLP
333 South Hope Street
48th Floor
Los Angeles, CA 90071

In re Ex Parte Reexamination proceeding 90/006,625
Filed: May 5, 2003
For: U.S. Patent No. 5,576,951
Attorney Docket No. 040021

This is a decision on the request for extension of time filed by the Patent Owner under 37 CFR 1.550(c) on May 25, 2006.

Patent Owner filed a petition under 37 CFR 1.137(b) for entry of late papers based on unintentional delay on March 30, 2006. That petition was accompanied by a Notice of Appeal and $250.00 Appeal Fee. The petition was granted on May 1, 2006 and jurisdiction was returned to Technology Center Art Unit 3625 for further examination and consideration of the Notice of Appeal.

Patent Owner requests an extension of time of one month to file an Appeal Brief. The reason for the request is that the Appeal Brief is due two months from the filing of the Notice of Appeal, i.e. May 30, 2006 and the decision granting the petition under 37 CFR 1.137(b) was not mailed until May 1, 2006. Thus, patent owner did not enjoy the full two months within which to file the Appeal Brief and/or an amendment.

An extension of time for the Patent Owner to submit a response is granted for a period of one month. The period for response will expire on June 30, 2006.

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

**SUMMARY**: Request **granted**.

Kenneth J. Dorner
Special Programs Examiner
Technology Center 3600
(571) 272-6587

Concur:

Wynn Coggins, Director
Technology Center 3600
(571) 272-5350

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 13
Mailed: February 8, 2005

ROSEMARY M. MIANO
PATENT DEPARTMENT, COLGATE-PALMOLIVE COMPANY
909 RIVER ROAD, P. O. BOX 1343
PISCATAWAY NJ 08855

: FOR PATENT OWNER

LAWRENCE P. HOBBES
ROBERTS, MLOTKOWSKI & HOBBES
8270 GREENSBORO DRIVE
SUITE 850
McLEAN, VA 22102

: FOR THRID PARTY REQUESTER

In re Guenin et al
Reexamination Proceeding
Control No.: 90/006,628
Filed: May 6, 2003
For: U.S. Patent No. 6,503,491

In re Guenin et al
Reexamination Proceeding
Control No.: 90/007,071
Filed: June 9, 2004
For: U.S. Patent No. 6,503,491

: 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. 6,503,491 issued January 7, 2003.

2. A first request for reexamination, Control No. 90/006,628, was filed by third party Requester on May 6, 2003.

3. Reexamination was ordered in the '628 reexamination proceeding on July 14, 2003.

4. A second request for reexamination, Control No. 90/007,071, was filed by third party Requester on June 9, 2004.

5. Reexamination was ordered in the '071 reexamination proceeding on July 22, 2004.

## 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 ə 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 '628 and '071 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 required to file a Housekeeping Amendment in the '071 file within 30 DAYS of the mailing of this decision.**

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. 90/006,628 and 90/007,071 are merged.

The files will be forwarded to the examiner for further action thereon.

Bruce M. Kisliuk
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/006,633 | 09/24/2003 | 5933841 | | 5475 |

757 7590 05/26/2006

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 05/26/2006

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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Joseph F. Hetz
BRINKS HOFER GILSON & LIONE
P.O. Box 10395
Chicago, Illinois 60610

For Patent Owner

Arnold Turk
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191

For Patent Owner

In re: Robert M. Schumacker et al
*Ex Parte* Reexamination Proceeding
Control No. 90/006,633
Filed: September 24, 2003
For: US Patent No. 5,933,841

DECISION DISMISSING PETITION FOR WITHDRAWAL OF PREMATURE FINAL REJECTION

This is a decision on the petition filed May 4, 2006 to request the withdrawal of the finality of the Office action mailed March 6, 2006.

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

The petition is **DISMISSED** for the reasons set forth below.

**Decision**

Upon further consideration of the Office Action mailed March 6, 2006, said Office Action is hereby vacated and further communication from the Examiner will be forthcoming. The Petition for Withdrawal of Premature Final Rejection, filed May 4, 2006, is dismissed. No further action is required by Patent Owner at this time.

## Conclusion

1. The Office action of March 6, 2006 is vacated.

2. The Patent Owners' petition for withdrawal of the finality of the Office action mailed March 16, 2006 is **DISMISSED**.

3. Jurisdiction over the proceeding is being forwarded to the Examiner for action on the proceeding in due course.

4. Any further communication as to the merits of the reexamination proceeding should be directed to Examiner Charles Craver in the Central Reexamination Unit (CRU) at (571) 272-7849.

5. Telephone inquiries with regard to this decision should be directed to Deborah Jones, Special Program Examiner in the Central Reexamination Unit, at (571) 272-1535.

for Lissi M. Marquis,
Director,
Central Reexamination Unit

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. |
|---|---|---|---|---|
| 90/006,634 | 09/24/2003 | 6442574 | | 5470 |

757 7590 05/26/2006

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 05/26/2006

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Joseph F. Hetz
BRINKS HOFER GILSON & LIONE
P.O. Box 10395
Chicago, Illinois 60610

For Patent Owner

Arnold Turk
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191

For Patent Owner

In re: Robert M. Schumacker et al
*Ex Parte* Reexamination Proceeding
Control No. 90/006,634
Filed: September 24, 2003
For: US Patent No. 56,442,574

DECISION DISMISSING PETITION FOR WITHDRAWAL OF PREMATURE FINAL REJECTION

This is a decision on the petition filed May 4, 2006 to request the withdrawal of the finality of the Office action mailed March 6, 2006.

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

The petition is **DISMISSED** for the reasons set forth below.

**Decision**

Upon further consideration of the Office Action mailed March 6, 2006, said Office Action is hereby vacated and further communication from the Examiner will be forthcoming. The Petition for Withdrawal of Premature Final Rejection, filed May 4, 2006, is dismissed. No further action is required by Patent Owner at this time.

**Conclusion**

1. The Office action of March 6, 2006 is vacated.

2. The Patent Owners' petition for withdrawal of the finality of the Office action mailed March 16, 2006 is **DISMISSED**.

3. Jurisdiction over the proceeding is being forwarded to the Examiner for action on the proceeding in due course.

4. Any further communication as to the merits of the reexamination proceeding should be directed to Examiner Charles Craver in the Central Reexamination Unit (CRU) at (571) 272-7849.

5. Telephone inquiries with regard to this decision should be directed to Deborah Jones, Special Program Examiner in the Central Reexamination Unit, at (571) 272-1535.

Lissi M. Marquis,
Director,
Central Reexamination Unit

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Paper no. 12

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(For Patent Owner)

In re Schouhamer Immink et al. :
Reexamination Proceeding : **DECISION**
Control No. 90/006,637 : **GRANTING**
Filed: May 14, 2003 : **PETITION**
For: U.S. Patent No. 5,696,505 :
:

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REEXAM UNIT

This is a decision on the August 9, 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 deposit account 19-3320, per the 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)(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 from the due date of the reply to the outstanding Office Action until the filing of this 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 response to the outstanding nonfinal Office action of July 7, 2004, 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**.

**CONCLUSION**

1. The petition is **granted**.

2. The reexamination file will be returned to Technology

Center 2800, for the examiner's immediate consideration of the response to the nonfinal Office action of August 9, 2004.

3. Any inquiries with regard to the merits of this proceeding should be directed to Examiner Jean Bruner Jeanglaude, of Group Art Unit 2819.

4. 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 1, 2005

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Paper No. 8

John D. Carpenter (For Patent Owner)
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Enclosure: Patent owner petition filed September 29, 2003

Irah H. Donner (For Third Party Requester)
Hale and Dorr, LLP
1455 Pennsylvania Avenue, N.W.
Washington, DC 20004

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REEXAM UNIT

DECISION

| | | |
|---|---|---|
| In re Bernard | : | |
| Reexamination Proceeding | : | DECISION |
| Control No. 90/006,638 | : | RETURNING |
| Filed: May 16, 2003 | : | PETITION |
| For: U.S. Patent No. 5,164,444 | : | |
| | : | |

This is a decision on the September 29, 2003, patent owner petition under 37 CFR 1.182, titled "PETITION TO THE COMMISSIONER UNDER 37 CFR 1.182."

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

The petition is being returned to the patent owner for the reasons set forth below.

## REVIEW OF FACTS

1. U.S. Patent No. 5,164,444 (the '444 patent), issued to Bernard, on November 17, 1992.

2. A request for reexamination (assigned control No. 90/006,638) was filed by a third party requester on May 16, 2003.

3. Reexamination was ordered July 29, 2003, for the '638 reexamination proceeding.

4. On September 29, 2003, the patent owner filed the present petition under 37 CFR 1.182, seeking an order vacating the July 29, 2003, Order granting reexamination, and enjoining the third party requester and real party in interest from requesting a further reexamination of the '444 patent unless the conditions set forth at page 12 of the petition are satisfied.

## 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 an order vacating the grant of reexamination, and that the third party requester be enjoined from requesting a further reexamination of the '444 patent unless certain conditions are satisfied.

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 returned to the patent owner with the present decision. The present decision will be made of record in the reexamination file.

Beginning at page 9, the petition urges that the request "does not... raise a substantial new question of patentability of any claim in the patent." It is to be noted, however, that such argument was not filed as part of the patent owner's statement, and thus, the third party requester cannot address the patent owner's argument by way of a reply under 37 CFR 1.535.

CONCLUSION

1. The patent owner petition filed September 29, 2003, is being returned to the patent owner with the instant decision.

2. The reexamination file is being forwarded to Technology Center 1700.

3. 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

December 11, 2003
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Paper No. 9

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MAILED
MAR 09 2004
REEXAM UNIT

Irah H. Donner (For Third Party Requester)
Hale and Dorr, LLP
1455 Pennsylvania Avenue, N.W.
Washington, DC 20004

Enclosure: Requester petition filed November 25, 2003

In re Bernard :
Reexamination Proceeding : DECISION
Control No. 90/006,638 : RETURNING
Filed: May 16, 2003 : PETITION
For: U.S. Patent No. 5,164,444 :

This is a decision on the November 25, 2003, requester petition under 37 CFR 1.182, titled "Response to Petition to the Commissioner Under 37 CFR § 1.182."

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

The petition is being returned to the requester for the reasons set forth below.

## REVIEW OF FACTS

1. U.S. Patent No. 5,164,444 (the '444 patent), issued to Bernard, on November 17, 1992.

2. A request for reexamination (assigned control No. 90/006,638) was filed by a third party requester on May 16, 2003.

3. Reexamination was ordered July 29, 2003, for the '638 reexamination proceeding.

4. On September 29, 2003, the patent owner filed a petition under 37 CFR 1.182, seeking an order vacating the July 29, 2003, Order granting reexamination, and enjoining the third party requester and real party in interest from requesting a further reexamination of the '444 patent unless certain conditions are satisfied.

5. The patent owner's September 29, 2003, petition was returned to the patent owner via the December 15, 2003, decision of the OPLA Senior Legal Advisor.

6. Prior to the mailing of the December 15, 2003, decision, the requester filed, on November 25, 2003, the present petition under 37 CFR 1.182 in response to the patent owner's September 29, 2003, petition. The requester's response petition was not, however, matched with the present file until after the mailing of the December 15, 2003, decision of the Senior Legal Advisor.

## 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 November 25, 2003, petition paper is improper under 37 CFR 1.540 because it is not a statement pursuant to 37 CFR 1.530, and it is not a reply pursuant to 37 CFR 1.535.

Accordingly, the paper will not be made of record in the reexamination file, and it is being returned with this decision. MPEP 2267. This decision returning the paper will, however, be made of record in the reexamination.

It is additionally to be noted that the patent owner's September 29, 2003, "Petition to the Commissioner Under 37 CFR 1.182." was returned to the patent owner as an improper paper on December 15, 2003. Accordingly, the present paper responding to that petition is moot, and it is not appropriate, since it responds to a petition which has been returned to patent owner and is no longer of record.

CONCLUSION

1. The requester petition paper filed November 25, 2003, is being <u>returned</u> to the requester with the instant decision.

2. The reexamination file is being forwarded to Technology Center 1700.

3. 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

March 5, 2004
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FROM DIRECTORS OFFICE

JUN 10 2005

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In re Reexamination of :
U.S. Patent No. 6,135,675 :
Northstar Vinyl Products LLC (Owner) : **DECISION ON PETITION**
Control No. 90/006,640 : **FOR THE ACCEPTANCE**
Filed: May 16, 2003 : **OF LATE PAPERS**
Attorney Docket No. CMI 1840-002 :
For: SHEETPILE SYSTEM INCLUDING FULL PLASTIC EXTERIOR

This is in reply to petitioner's Re-sending of Response to Office Action Dated 10/29/2004, which will be treated as a Petition for the Acceptance of Late Papers, filed on April 15, 2005 and supplemented with a Statement Under 37 CFR 1.8(b)(3), filed May 4, 2005. There is no fee required for this petition.

The petition is **GRANTED**.

A review of the file record indicates that a response to the Office action dated October 29, 2004 was mailed on December 29, 2004. This response was not received by the Office. The petition includes a copy of the response with a certificate of mailing dated December 29, 2004. A statement under 37 CFR 1.8(b)(3), supporting the certificate of mailing, was filed on May 4, 2005. This is sufficient evidence of a timely response.

This file is being forwarded to the Supervisory Legal Instruments Examiner for entry of the response filed with the petition, then to the examiner for prompt action on the response.

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

RAR/dgd: 6/7/05

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APR 14 2005

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(For Requester in 7,212)

In re I G T
Reexamination Proceeding
Control No. 90/006,655
Filed: May 29, 2003
For: U.S. Patent No. 5,885,158

In re I G T
Reexamination Proceeding
Control No. 90/007,212
Filed: September 20, 2004
For: U.S. Patent No. 5,885,158

: DECISION, *SUA SPONTE*,
: MERGING REEXAMINATION
: PROCEEDINGS

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 90/006,655 and 90/007,212 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

On June 16, 2004, Owner filed an amendment in control No. 90/006,655, which has been entered in that proceeding. Therefore, Owner is **required** to file a housekeeping amendment in control No. 90/007,212 entering the identical claims therein, as well as making the specification and drawings in the '212 proceeding identical to the specification and drawings in the '655 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 § 2283, subsection entitled "Merger of Reexaminations", last paragraph.

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 filed subsequent to the housekeeping amendment discussed in Section III above will contain the identifying data for **both** files and will be physically entered in each reexamination file. All such 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 added by amendment that do not appear in the text of the patent are always underlined, and all words being deleted from the text of the patent appear must always appear in brackets. Words that had been added to the text of the patent, but are then subsequently canceled, are not shown in brackets because they were not part of the text of the patent. 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 action will be that appropriate to the status of the merged proceeding, i.e. a second action on the merits of the claims. When preparing the action, 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 to place the files in that condition as part of the next action in order.

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. Owner must file the amendment **not later than one month from the date of this decision.**

VI. Extensions of Time

Owner is reminded that extensions of time are governed by 37 CFR 1.550(c) and **must** be requested prior to the expiration of the running statutory period for which the extension is requested. Effective November 22, 2004, extensions of time in reexamination proceedings **must** be accompanied by the petition fee set forth in 37 CFR 1.17(g).

E. R. Kazenske, Director
Technology Center 3700

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JUN 28 2007

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Larry K. Roberts (Third Party Requester)
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In re Torango et al.
Reexamination Proceeding
Control No.: 90/006,655
Filed: May 29, 2003
For: U.S. Patent No.: 5,885,152

**DECISION**

In re Torango et al.
Reexamination Proceeding
Control No.: 90/007,212
Filed: September 20, 2004
For: U.S. Patent No.: 5,885,152

**ON PETITION**

**UNDER 37 CFR 1.182**

This is a decision on the June 6, 2007 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.

**Thus, the IDS filed June 6, 2007, has not been entered for consideration by the examiner.**

## BACKGROUND

1. U.S. Patent 5,885,158 issued on March 23, 1999.
2. A request for reexamination, assigned control No. 90/006,655 (the '655 proceeding), was filed on May 29, 2003 by a first third party requester.
3. An order granting the '655 reexamination request was mailed August 13, 2003.

4. A request for reexamination, assigned control No. 90/007,212 (the '212 proceeding), was filed on September 20, 2004 by a second third party requester.

5. An order granting the '212 reexamination request was mailed December 6, 2004.

6. On April 14, 2005, the Office *sua sponte* merged the '655 and '212 reexamination proceedings (hereinafter, "the merged proceeding").

7. The merged proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed on February 22, 2007.

8. The instant petition was filed on June 06, 2007, and is accompanied by a new Information Disclosure Statement (IDS), which the patent owner requests the Office to consider.

9. The reexamination proceeding is being processed for the issuance and publication of the reexamination certificate.

## 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 2256**

.....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

In a reexamination proceeding, there is no 37 CFR 1.313 withdrawal 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 present proceeding from the publication process, for consideration of the accompanying IDS papers, has been appropriately filed under 37 CFR 1.182.

While there is no regulatory provision for withdrawal of a reexamination proceeding from the publication process for consideration of an IDS, the policy for withdrawal from the publication process, after the NIRC has been mailed but before the proceeding has actually entered the printing cycle, is explicitly set forth in MPEP 2256 as follows:

> ...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.

In the present instance, the submission fails to satisfy both item (A) and item (B). Patent owner has made no factual accounting to provide any explanation of why the information submitted could not have been submitted earlier. Nor does patent owner provide any explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. The instant petition was filed very late in the examination of the reexamination, and it is devoid of any statements to satisfy either (A) or (B). Patent owner merely states that a number of new references have come to its attention and cites MPEP § 2287, which outlines the procedure by which the petition maybe filed. The patent owner does not provide a discussion of the substance the facts and circumstances about why the references were not submitted earlier, nor has patent owner explained the relevance of the same references (i.e., has not applied them) with respect to the claim limitations in the present reexamination proceeding.

In summary, there is no factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and there is no explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. Therefore, the present petition does not satisfy the requirements for a petition submitted for consideration of an IDS after the NIRC has been mailed.

For *ex parte* reexamination, 35 U.S.C. 305 provides that all *ex parte* reexamination proceedings "will be conducted with special dispatch within the Office." A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on February 22, 2007, and the proceeding is being prepared to enter the final stages of the publication process. The proceeding is clearly not scheduled to come up for further action on the merits. In order to provide the requested relief, the present proceeding would need to be withdrawn from the publication process, thus significantly 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 a request for reexamination. In view of the

submission of the IDS information after termination of the prosecution in this reexamination proceeding, and the failure to provide the requisite information about the submitted art citations, the present reexamination proceeding will 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.

If, however, the patent owner in fact believes that any reference 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 reference(s).

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 examiner will not consider the IDS.

## CONCLUSION

1. The petition is **dismissed** as to the request for consideration of the IDS filed on June 6, 2007.

2. The IDS papers have not been entered for consideration by the examiner. A copy of the IDS submission will, however, be placed in the electronic image file wrapper (IFW) for the proceeding.

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 Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759.

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

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(For Requester)

MAILED

JUL 12 2005

REEXAM UNIT

In re Reissue Application of
Keen *et al*
Application No.: 10/995,010
Filed: November 22, 2004
For: U.S. Patent No. 5,633,162

In re GLAXOSMITHKLINE
Reexamination Proceeding
Control No.: 90/006,656 ✓
Filed: June 2, 2003
For: U.S. Patent No.: 5,633,162

: 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. 5,633,162 (the '162 patent) issued on May 27, 1997.

2. A request for reexamination, assigned control No. 90/006,656 (the '656 reexamination proceeding), was filed by a third party requester on June 2, 2003.

3. Reexamination was ordered in the '656 reexamination proceeding on August 20, 2003.

4. A non-final Office action was mailed in the '656 reexamination proceeding on September 21, 2004.

6. A response to the non-final Office action in the '656 reexamination proceeding was received from the patent owner on November 22, 2004.

7. A reissue application for the '162 patent was filed on November 22, 2004 and assigned application number 10/995,010 (the '010 reissue application).

8. A preliminary amendment was filed in the reissue application concurrently with the filing of the reissue application.

9. Notice of the filing of the reissue application was published in the *Official Gazette* on January 25, 2005.

10. The reissue application has been assigned to an examiner and docketed for examination.

**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. 10/995,010 and reexamination control No. 90/006,656 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, 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 both 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 Identical Specifications, Claims and Drawings in Both Proceedings

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

2. A review of the reexamination file for the '656 reexamination proceeding shows that (a) original patent claims 2-13 and 16-18 are present and not amended, (b) original patent claims 1, 14 and 15 have been amended, (c) no patent claims have been canceled, (d) no new claims have been added, and (e) the specification has been amended. A review of the file of the '010 reissue application shows that (a) original patent claims 2-13 and 16-18 are present and not amended, (b) original patent claims 1, 14 and 15 have been amended, (c) no patent claims have been canceled, (d) no new claims have been added, and (e) the specification has been amended. Accordingly, the claims are identical in number, but may or may not be identical as to content in both proceedings. The specifications have been amended in both proceedings, but may or may not be identical in content in both proceedings. Each proceeding includes the same number of drawing figures, but the drawings may or may not be identical.

If the claims and/or the specifications and/or drawings are different as to content in the above captioned reissue and reexamination proceedings, then an appropriate housekeeping amendment is required within ONE (1) MONTH of this decision - rendering the claims, specifications and drawings in the '656 and '010 proceedings identical.

If the claims, specifications and drawings are identical as to text, a patent owner statement to that effect is required to be filed in each proceeding within ONE (1) MONTH of this decision.

The response to this requirement **must** be limited to either:

a) Amendment of one or both of the proceedings - placing identical claims, specifications and drawings in both proceedings; or

b) A patent owner statement filed in both proceedings that the claims, specifications and drawings are identical in both proceedings.

*The patent owner must not address any issue of patentability in the response.*

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

1. After the appropriate patent owner response as per Part II above is received, or after the time set for filing the response expires, the examiner should promptly prepare an Office action.

2. In the event that any necessary housekeeping amendment(s) is/are not timely submitted, any claim that does not contain identical text in both proceedings should be rejected under 35 U.S.C. § 112, paragraph 2, as being indefinite as to the content of the claims, and thus failing to particularly point out the invention.

3. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue-application examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. However, any shortened statutory period set for the filing of response to an Office action 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). Extensions of time will be governed by 37 CFR 1.136.

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 proceedings, i.e., the '010 reissue application and the '656 reexamination proceeding (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. Pursuant to MPEP 2285:

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

Thus, the filing of any amendments to the drawings, specification, or claims must comply with the provisions of 37 CFR 1.173 and the guidelines of MPEP 1453. It is to be noted that **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), 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 the 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. Attention is invited to MPEP § 1453.

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 that are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner upon dissolution of the merged proceeding. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 CFR 1.552(c).

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. 10/995,010 and reexamination control No. 90/006,656 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 and/or specifications and or drawings differ between the two proceedings, patent owner is required to file any housekeeping amendment(s) that is/are required within ONE MONTH of this decision, placing the same claims, specifications and drawings in both the '656 reexamination proceeding and the '010 reissue application, in view of the fact that these proceedings are

presently merged. **If the claims, specifications and drawings are identical as to text and content in both proceedings, then patent owner is required to submit a statement to that effect in each proceeding within ONE MONTH of this decision.**

3. The reissue and reexamination files are being forwarded to the examiner via the Director of Technology Center 1600. Upon receipt of same, the examiner should not issue an Office after the earlier of:

   (a) The submission of a patent owner response which is either (i) a housekeeping amendment (or amendments) to place identical specifications, claims and drawings in both cases or (ii) a statement that the claims, specification and drawings of both proceedings are identical as to text and content, or

   (b) The expiration of the ONE MONTH period (from the mailing of this decision) set in this decision for the patent owner to respond.

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 Stephen Marcus, Legal Advisor, at (571) 272-7743.

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

SM
July 11, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/006,659 | 06/09/2003 | 5365690 | Para. 6 | 9653 |

23552 7590 09/17/2004

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

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 09/17/2004 #8

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

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Paper No. 8

(For Patent Owner)

Dennis R. Daley
Merchant & Gould PC
Minneapolis, MN 55402-0903

Enclosures: Petition filed March 12, 2004
Reply of Patent Owner filed May 6, 2004
Reply of Patent Owner filed June 4, 2004

(For Third Party Requester)

James J. Hill
Enrich & Dithmar
300 South Wacker Drive
Chicago, IL 60606

Enclosures: Letter to Examiner filed February 10, 2004
Requester Response to Petition filed April 26, 2004
Requester Response to Patent Owner Reply filed May 20, 2004.

| | | |
|---|---|---|
| In re Nelson et al. | : | |
| *Ex parte* Reexamination Proceeding | : | DECISION GRANTING |
| Control No. 90/006,659 | : | PETITION AND RETURNING |
| Filed: June 9, 2003 | : | IMPROPER PAPERS |
| For: U.S. Patent No. 5,365,690 | : | |

This is a decision on the March 12, 2004, patent owner petition entitled PETITION TO THE COMMISSIONER REGARDING MISCONDUCT OF THIRD PARTY REEXAMINATION REQUESTOR. The petition is before the Office of Patent Legal Administration. Patent owner alleges that on February 10, 2004, the requester filed a letter addressed to the reexamination examiner which letter refers to an earlier discussion between the examiner and requester, and further addresses and summarizes an attached decision of the Court of Appeals for the Federal Circuit which issued in litigation related to the patent undergoing reexamination. Patent owner urges that the third party requester letter and earlier discussion with the examiner are improper in an *ex parte* reexamination proceeding and requests the following relief:

A. Dismissal of the reexamination.

B. Or, in the alternative petitioner requests the Director to:

1. Remove the letter and any copies of it from the possession of any examiner involved in the reexamination.

2. Instruct the examiner not to consider the arguments set forth in the letter.

3. Require the examiner to provide a written summary of any interview that has occurred between the examiner and the requester including the interview specifically referenced in the letter.

4. Order the USPTO to cease accepting phone calls, personal appearances and substantive written submissions from the requester about this reexamination case, and to reply to any requests for status information only if they are in writing, filed officially with the USPTO, and simultaneously served on the patent owner.

5. Issue a decision from the USPTO stating that the letter provided to the examiner on February 10, 2004, is an unauthorized submission and that the examiner will not consider this letter.

The petition is granted to the extent set forth below.

## BACKGROUND

1. On June 9, 2003, the third party requester filed the present request for reexamination which was assigned control No. 90/006,659.

2. On August 8, 2003, reexamination was ordered and on September 26, 2003, the Office issued a letter clarifying the reexamination order. Patent owner elected not to file a statement.

**It is noted that the above listed documents have been scanned into an electronic data base and have been available to the public from that database. The paper reexamination file itself, however, has not available to the public. Public copying of the reexamination file is available solely from the electronic database. The papers listed below have not been entered into the reexamination file and, accordingly, have not been accessible to the public.**

3. On February 10, 2004, the reexamination requester filed a letter addressed to the examiner referring to an earlier discussion between the examiner and requester which occurred on Monday, February 9, 2004 relating to the status of the reexamination. The letter does not elaborate on the substance of this earlier discussion. The letter also addresses and summarizes an attached decision of the Court of Appeals for the Federal Circuit which issued in litigation related to the patent undergoing reexamination.

4. On March 12, 2004, the patent owner filed the present petition. The petition contains two attachments: (1) a copy of the "service of copy" letter notifying patent owner of the filing of requester's letter sent to the examiner; and (2) a copy of the letter which requester sent to the examiner.

5. On April 28, 2004, the requester filed a response to patent owner's petition to the Commissioner.

6. On May 6, 2004, the patent owner filed a reply to requester's response to the petition.

7. On May 6, 2004, the patent owner filed an Information Disclosure Statement (IDS).

8. On May 20, 2004, the requester filed a response to the reply of the patent owner.

9. On June 4, 2004, the patent owner filed a reply stating that additional arguments will not be filed.

**DECISION**

I. Return of Improper Papers

37 CFR 1.540 provides (in part):

> " ... 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."

None of the papers filed in Nos. 3-6, 8 and 9 above prior to the examination on the merits are a statement under § 1.530 or a reply under § 1.535. Accordingly, these papers are all improper submissions, will not be considered, will not be made of record in the reexamination file and are being returned along with this decision. This decision will be made of record in the reexamination file.

The IDS (No. 7 above) filed by the patent owner on May 6, 2004, will be entered into the reexamination file. This is because § 1.555(a) states that an IDS may be filed by the patent owner

"within two months of the date of the order for reexamination, or as soon thereafter as possible." This time period would include the time prior to the first Office action.

II. Request for Dismissal of Reexamination Proceeding

Petitioner's request that the reexamination proceeding be dismissed is denied. As noted above, the papers relating to requester's contact with the examiner have not been entered into the reexamination file, will not be considered by the examiner, and have not been seen by the public. Petitioner has set forth no reasons, nor has petitioner set forth any authority why the reexamination should not continue. Accordingly, the reexamination proceeding will continue along the relief set forth below.

III. Removal of Letter and all Copies

Petitioner's request that the February 9, 2004, letter from requester to the examiner (and any copies) be removed from the possession of the examiner is granted. As noted above, the letter is being returned along with decision. Further, the examiner will destroy any copy of the letter in his possession. It is also noted that the copy of the letter attached to this petition is also being returned to petitioner.

IV. Consideration of Arguments set forth in Letter

Petitioner's request that the examiner not consider the arguments set forth in the letter is granted. The examiner is instructed not to consider any arguments set forth in the letter and in addition, not to consider any arguments set forth in any interview with the requester.

V. Request for Interview Summary

Petitioner's request for a written summary of any interview that has occurred between the examiner and the requester including the interview specifically referenced in the letter is granted. The examiner will prepare, prior to the next Office action, an Interview Summary Sheet setting forth a summary of any and all interviews which have occurred between the examiner and the requester. The date of all interviews should be specifically noted and the substance of each interview summarized. The Interview Summary Sheet shall be made of record in the reexamination file and attached to the next Office action.

VI. Request for Office to Cease Personal Contact with Requester

Petitioner's request for the Office to cease accepting phone calls, personal appearances and substantive written submissions from the requester about this reexamination case, and to reply to any requests for status information only if they are in writing, filed officially with the USPTO, and simultaneously served on the patent owner is granted only to the extent such contact relates to substantive issues. Requester has the right and will retain the right to contact the Office on matters relating to formal matters relating to the reexamination.

## CONCLUSION

1. The patent owner petition filed March 12, 2004, is **granted to the extent noted above**.

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

Robert J. Spar
Director
Office of Patent Legal Administration
Office of Deputy Commissioner for Patent Examination Policy

C:\zJerry\90_6659 pat owner petition re requester involvement in case.wpd

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DEC 0 8 2005

TECHNOLOGY CENTER 3600

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Merchant & Gould PC
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Minneapolis, MN 55402-0903

(For Patent Owner)

James J. Hill
Emrich & Dithmar
300 South Wacker Drive, Suite 3000
Chicago, IL 60606

(For Third Party Requester)

In re Reexamination Proceeding No. 90/006,659 : **REQUEST FOR**
Filed: June 9, 2003 : **EXTENSION OF TIME**
For: U.S. Patent No. 5,365,690 : *37 CFR 1.550(c)*

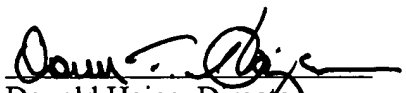
This is a decision on the request for extension of time filed by the Patent Owner under 37 CFR §1.550(c) on November 22, 2005 and resubmitted on December 5, 2005.

A final Office action on the merits was mailed on August 10, 2005 which set a two month shortened statutory period for response. A Notice of Appeal was filed on October 13, 2005 having a certificate of mailing dated October 11, 2005 (October 10 being a federal holiday). Without an extension of time, Patent Owner's appeal brief would be due on December 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 due to the fact that "...the attorney providing the primary representation in this matter recently left the law firm of Merchant & Gould. Although Merchant & Gould will continue to provide representation in this matter, the transition to other attorneys within the firm requires additional time."

An extension of time for Patent Owner to submit an appeal brief is granted for a period of one month. The period for submission of the brief expires on January 13, 2006.

Further extensions of time 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:12/8/05

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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

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

Lisa M. Caldwell
Klarquist Sparkman LLP
One World Trade Center, Suite 1600
121 S. W. Salmon Street
Portland, OR 97204

DATE MAILED. 10/14/2003

12

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90006363 20031014

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CST

Paper No. 12

Lisa M. Caldwell
Klarquist Sparkman LLP
One World Trade Center, Suite 1600
121 SW Salmon Street
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(for Patent Owner)

Martin M. Zoltick
Rothwell Figg Ernst & Manbeck, PC
Suite 800, 1425 K Street, NW
Washington, DC 20005

(for Third Party)

DOCKET ALARM

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

90/006,363 - 90/006,662

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/006,663 | 06/10/2003 | 5922333 | 8004-644 | 9693 |

7590 08/27/2003

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Dallas, TX 75225

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 08/27/2003 #13

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90006663 20030827

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AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
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#13

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FOR REQUESTER 1

PETER S. WEISSMAN
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600 NEW HAMPSHIRE AVENUE, NW
WASHINGTON, DC 20037

FOR REQUESTER 2

In re Laughlin
Reexamination Proceeding
Control No.: 90/006,547
Filed: February 12, 2003
For: U.S. Patent No. 5,922,333

In re Laughlin
Reexamination Proceeding
Control No.: 90/006,663
Filed: June 10, 2003
For: U.S. Patent No. 5,922,333

In re Laughlin
Reexamination Proceeding
Control No.: 90/006,711
Filed: July 14, 2003
For: U.S. Patent No. 5,922,333

: DECISION MERGING
: REEXAMINATION
: PROCEEDINGS

The above noted reexamination files are before the director of Technology Center 1600 for consideration of merger of the proceedings under 37 CFR 1.656(c).

## BACKGROUND

1. Patent No. 5,922,333 issued July 13, 1999.

2. A first request for reexamination, Control No. 90/006,547, was filed by patent owner as requester on February 12, 2003.

3. Reexamination was ordered In the '547 reexamination proceeding on March 12, 2003.

4. A second request for reexamination, Control No. 90/006,663, was filed by a first third party requester on June 10, 2003.

5. Reexamination was ordered In the '663 reexamination proceeding on July 28, 2003.

6. A third request for reexamination, Control No. 90/006,711, was filed by a second third party requester on July 14, 2003.

7. Reexamination was ordered In the '711 reexamination proceeding on August 20, 2003.

8. Patent Owner filed statements In '663 and '711 proceedings on August 25, 2003, indicating that no Patent Owner's statement would be filed.

## DISCUSSION

Under 37 CFR 1.565(c):

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

As noted In the above review of facts, reexamination has been ordered In all of the above noted reexamination proceedings. Accordingly, merger of the proceedings under 37 CFR 1.565(c) is appropriate.

## DECISION

Merger of Proceedings.

In accordance with 37 CFR 1.565(c), the '547, '663 and '711 reexamination proceedings are merged. The merged proceeding will be conducted In accordance with the following guidelines and requirements.

Requirement for Same Amendments In Both Proceedings.

Patent Owner is required to maintain the same claims and specification In all files. In view of the granted one month extension of time to respond to the outstanding Office action In the '547 proceeding, Patent Owner is given until the end of that time period (October 15, 2003) to provide a "housekeeping" amendment In the '663 and '711 proceedings to provide identical claims In each of the three proceedings. Amendments must be In accordance with 37 CFR 1.530 (see M.P.E.P. 2250).

Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to all proceedings. All papers issued by the Office or filed by the Patent Owner will contain the identifying data for all files and will be physically entered In each reexamination file. All papers filed by the Patent Owner must consist of a single response, filed In triplicate, each bearing an original signature, for entry In each file. All papers filed by the Patent Owner must be served on each third party requester and each requester will be sent copies of all papers mailed by the Office.

CONCLUSION

Reexamination Control Nos. 90/006,547, 90/006,663 and 90/006,711 are merged. The merged files will be retained In TC 1600 to await reply to the outstanding Office action In the '547 proceeding. (Note - copies of the reply must be provided for each proceeding and must be served on each third party requester.)

John Doll
Director, Technology Center 1600

#15

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/006,664 | 06/12/2003 | 5537135 | | 2094 |

90/007,322

7590 04/13/2005

| EXAMINER | |
|---|---|
| H. PHAM | |
| ART UNIT | PAPER NUMBER |
| 2861 | |

Joseph J. Catanzaro
ABELMAN, FRAYNE & SCHWAB
150 East 42nd Street
New York, NY 10017-5612

DATE MAILED: 04/13/2005

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Charles Gorenstein
BIRCH, STEWART, KOLASH & BIRCH
8110 Gatehouse Road, Suite 100 East
Falls Church, VA 22042-1248.

# REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/006,664, 90/007,322

PATENT NO. 5,537,135 .

ART UNIT 2861 .

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

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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Paper No. 15

Joseph J. Catanzaro
ABELMAN FRAYNE & SCHWAB (for Patent Owner)
185 Asylum Street
150 East 42nd Street
New York NY 10017-5612

Charles Gorenstein (for Third Party Requester)
BIRCH, STEWART, KOLASH & BIRCH, LLP
8110 Gatehouse Road, Suite 100 East
Falls Church, VA 22042-1248

In re Charles M. Hevener *et al.*
Reexamination Proceeding
Control No. 90/006,664
Filed: June 12, 2003
For: U.S. Patent No. 5,537,135

In re Charles M. Hevener *et al.*
Reexamination Proceeding
Control No. 90/007,322
Filed: November 30, 2004
For: U.S. Patent No. 5,537,135

DECISION MERGING
REEXAMINATION PROCEEDINGS

The above-identified reexamination files are before the Director of Examining Group 2850, Technology Center 2800, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

## BACKGROUND

1. Patent No. 5,537,135 issued on July 16, 1996.

2. Reexamination Control No. 90/006,664 was filed by the third party requester on

June 12, 2003.

3. Reexamination was ordered in the '6664 reexamination proceeding on August 29, 2003.

4. A non-final Office action was issued on April 5, 2004, setting a two-month shortened statutory period for filing a reply.

5. A request for extension of time was filed on June 3, 2004.

6. The request for extension of time was granted in a decision mailed June 9, 2004, extending the shortened statutory period for filing a reply to July 5, 2004.

7. A further request for another extension of time of two weeks was filed on July 1, 2004.

8. The further request for extension of time was granted in a decision mailed July 8, 2004, extending the shortened statutory period for filing a reply to July 19, 2004.

9. A response to the Office action of April 5, 2004 was filed on July 16, 2004. This response contained no amendment to the patent.

10. Reexamination Control No. 90/007,322 was filed by the same third party requester on November 30, 2004.

11. Reexamination was ordered in the '7322 reexamination proceeding on February 4, 2005. The patent owner had the option of filing a patent owner's statement within two months of the date reexamination was ordered. 37 C.F.R. § 1.550(c). The two-month time period for filing a patent owner's statement expired April 4, 2005. No patent owner's statement has been received.

## 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

**I. Merger of Proceedings:**

In accordance with 37 C.F.R. § 1.565(c), the '6664 and '7322 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

**II. Conduct of Merged Proceeding:**

All papers mailed by the Office will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for both files and will be 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. '6664 and '7322 are merged. An Office action will be issued in due course.

Any inquiry concerning this decision should be directed to Hien H. Phan, Special Program Examiner, at telephone No. (571) 272-1606.

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

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Paper No. 10

ROBERT BERLINER
FULBRIGHT & JAWORSKI L.L.P.
865 S. FIGUEROA STREET
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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Paper No. 10

ROBERT BERLINER
FULBRIGHT & JAWORSKI L.L.P.
865 S. FIGUEROA STREET
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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| 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

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Application Processing

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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 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 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. 90/006,211 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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| APPLICATION NO | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO | CONFIRMATION NO |
|---|---|---|---|---|
| 90/006,211 | 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

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WASHINGTON, D.C. 20231
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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 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 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. 90/006,211 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

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. |
|---|---|---|---|---|
| 90/006,552 | 02/20/2003 | 4849228 | 4673.35 | 1505 |

7590 11/05/2003

EXAMINER

Harold C. Wegner
Foley and Lardner
Washington Harbour
3000 K Street NW Suite 500
Washington, DC 20007-5143

| ART UNIT | PAPER NUMBER |
|---|---|
| | 10 |

DATE MAILED: 11/05/2003

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Paper No. 10

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WASHINGTON DC 20007-5143

FOR PATENT OWNER

WATTS, HOFFMAN, FISHER
& HEINKE CO., LPA
P. O. BOX 99839
CLEVELAND, OH 44199-0839

FOR REQUESTER 1

SUSAN P. PETRAGLIA, ESQ.
116 SIXTH STREET, NE
NO. 303
WASHINGTON, D.C. 20002

FOR REQUESTER 2

In re Yamamoto et al
Reexamination Proceeding
Control No.: 90/006,552
Filed: February 20, 2003
For: U.S.Patent No. 4,849,228

In re Yamamoto et al
Reexamination Proceeding
Control No.: 90/006,674
Filed: June 23, 2003
For: U.S.Patent No. 4,849,228

: 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.4,849,228 issued July 18, 1989.

2. A first request for reexamination, Control No. 90/006,552, was filed by the third party Requester 1 on February 20, 2003.

3. Reexamination was ordered in the '552 reexamination proceeding on April 4, 2003.

4. A second request for reexamination, Control No. 90/006,674, was filed by the third party Requester 2 on June 23, 2003.

5. Reexamination was ordered in the '674 reexamination proceeding on July 31, 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 '552 and '674 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 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 each third party Requester and each Requester will be sent copies of all papers mailed by the Office.

CONCLUSION

Reexamination Control Nos. 90/006,552 and 90/006,674 are merged. A reply to the first Office action in the '552 proceeding has been received and the merged files will be forwarded to the examiner for further action.

John Doll
Director, Technology Center 1600

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/006,552 | 02/20/2003 | 4849228 | 4673.35 | 1505 |

7590 11/05/2003

EXAMINER

Harold C. Wegner
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Washington Harbour
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Washington, DC 20007-5143

| ART UNIT | PAPER NUMBER |
|---|---|
| | 10 |

DATE MAILED: 11/05/2003

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Paper No. 10

HAROLD C. WEGNER
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FOR PATENT OWNER

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FOR REQUESTER 1

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FOR REQUESTER 2

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5. Reexamination was ordered in the '674 reexamination proceeding on July 31, 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 '552 and '674 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.

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CONCLUSION

Reexamination Control Nos. 90/006,552 and 90/006,674 are merged. A reply to the first Office action in the '552 proceeding has been received and the merged files will be forwarded to the examiner for further action.

John Doll
Director, Technology Center 1600

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO | CONFIRMATION NO |
|---|---|---|---|---|
| 90/006,675 | 06/24/2003 | 5436960 | | 5436 |

20457 7590 11/24/2003

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| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 11/24/2003

#6

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Electronic Patent Application Fee Transmittal

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Paper No. __

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Enclosure: Copy of Requester 37 CFR 1.183 petition filed July 31, 2003

David L. Stewart (For Requester)
ALLEN DYER DOPPELT MILBRATH
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Suite 1401
Orlando, FL 32802

MAILED
NOV 24 2003
REEXAM UNIT

In re Campana, Jr. et al.
Reexamination Proceeding
Control No. 90/006,675
Filed: June 24, 2003
For: U.S. Patent No. 5,436,960

DECISION DISMISSING
AND RETURNING
PETITION UNDER
37 CFR 1.183

DECISION MAILED

This is a decision on the July 31, 2003, third party requester petition under 37 CFR 1.183, to suspend the rules, to permit third party requester participation in the examination stage of the instant *ex parte* reexamination proceeding.

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

Petitioner has paid the $130.00 fee associated with this type of petition, in accordance with 37 CFR 1.17(h).

The petition is dismissed.

The petition paper will not be entered in the file, but rather will be forwarded to the patent owner, because the Office records fail to indicate that the owner was ever served with a copy of the paper.

## REVIEW OF FACTS

1. U.S. Patent No. 5,436,960 (hereinafter, the '960 patent), issued to Campana, Jr. et al., on July 25, 1995, from an application filed on May 20, 1991.

2. On January 30, 2003, a request for *ex parte* reexamination of the '960 patent was filed and was assigned control number 90/006,533. Reexamination was ordered April 17, 2003.

3. On April 17, 2003, a request for *inter partes* reexamination of the '960 patent was deposited in the Office by the third party requester. The '960 patent was held not to be eligible for *inter partes* reexamination, and a decision of the Director of Office of Patent Legal Administration (OPLA) was mailed on June 6, 2003 (and supplemented on June 12, 2003), in which the requestor's May 6, 2003, petition under 37 CFR 1.181 for a determination of eligibility was denied.[1]

4. On June 24, 2003, the requester of the *inter partes* reexamination filed the present request for an ***ex parte*** reexamination of the '960 patent, which was assigned control number 90/006,675.

5. On July 31, 2003, the requester filed the present petition under 37 CFR 1.183 requesting waiver of 37 CFR §§ 1.535, 1.550(g) and 1.560, to permit third party requester participation in the examination stage of this *ex parte* reexamination proceeding.[2]

6. Also on July 31, 2003, the requester filed a petition under 37 CFR 1.181, for review of the decision of the Director of OPLA denying requester's May 6, 2003, petition. The petition under 37 CFR 1.181 is being addressed in a concurrently issued decision.

7. Reexamination was ordered September 9, 2003, for this reexamination proceeding.

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[1] Some of the issues raised in the May 6th petition were found not to be ripe for decision due to how they were presented, and were not decided.

[2] As noted at page 3 of the present petition, the decision of the Director of the OPLA found that "the issue of waiver of the rules under 37 C.F.R. 183 was required to be raised in a separate paper. Accordingly, this petition [under §1.183] renews a request made in the Petitions of May 6, 2003 in a separate paper."

**DECISION ON PETITION**

1. The present petition urges (at page 4) that the Office has the "authority to permit a Requester to participate in 'Ex Parte' reexamination." Accordingly, the third party requester seeks a waiver of 37 CFR §§ 1.535, 1.550(g) and 1.560 to permit the requestor to participate in the examination stage of the *ex parte* reexamination proceeding that will be conducted.

At page 4 of the petition, it is argued that:

> "The requirement that 'Ex Parte' reexamination under 35 U.S.C. §301-§307 be 'Ex Parte' is not statutory."

And further that:

> "The only prohibition to such a practice *[prohibiting requester participation]* might be found in 37 C.F.R. §1.535 and § 1.550(g) [both limiting participation by 'Ex Parte' requesters] and § 1.560 [limiting participation in interviews]."

At the bottom of page 4 of the petition, the Office's position on this matter is correctly characterized by petitioner as:

> "[T]he requirement that '*Ex Parte*' Reexamination be *Ex Parte* is a statutory requirement. Statutory requirements cannot be waived, only rules. The Director of the Office Of Patent Legal Administration relies on *In re Amp* (*Amp*), 212 USPQ 826 (Comr. Pats. 1981) and on *Syntex (U.S.A.) v U.S. Patent and Trademark Office* (*Syntex*), 11 U.S.P.Q. 2d 1866 (Fed. Cir. 1989).

On this point, *see also In re Chambers* 20 USPQ2d 470, 1476 (Comr. Pat. 1991), where it is stated:

> "It is noted that a third party has no right to comment or participate in a reexamination proceeding beyond the rights specifically provided for by the reexamination statute, i.e., file a request for reexamination and comment on any statement filed by a patent owner. The statutory provisions regarding the reexamination of a patent, and the rules promulgated in support thereof, do not provide for opposition to the grant of a reexamination certificate by a third party. *Yuasa Battery Co. v. Commissioner,* 3 USPQ2d 1143 (D.D.C. 1987). *See also In re Etter, supra,* 756 F.2d at 858 n.6, 225 USPQ at 5-6 n.6 (the reexamination per se of the claims is entirely ex parte); *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office,* 882 F.2d 1570, 1573, 11 USPQ2d 1866, 1868 (Fed. Cir. 1989) (a reexamination is conducted *ex parte* after it is instituted) (original emphasis); *In re Opprecht,* 868 F.2d 1264, 10 USPQ2d 1718 (Fed. Cir. 1989) (a third party does not participate before PTO in a reexamination); *Animal Legal Defense Fund v. Quigg,* - F.2d -, -, 18 USPQ2d 1677, 1685 (Fed. Cir. 1991) (five judge court) (third party may not protest grant of a patent)."

2. In spite of this case law, petitioner urges that:

> "Both *Amp* and *Syntex* were prior to the introduction of Inter Partes reexamination by the AIPA and prior to the Justice Department Reauthorization Act." [3]

It is apparently petitioner's position that this enacted legislation changed the nature of the examination provided for by 35 U.S.C. 305, such that *inter partes* participation can now be permitted for a reexamination requested under 35 U.S.C. 302. Petitioner's position will now be addressed.

Beginning in the early 1990's, Congress began a process to expand reexamination to provide an increased level of third party requester participation in a reexamination proceeding. All of the bills drafted by Congress to this end modified the existing *ex partes* reexamination Chapter 30 to increase the level of third party requester participation in the various ways proposed in the bills.[4] This methodology for expanding third party requester participation did not change until optional *inter partes* reexamination was enacted as law via S. 1948 [5] and the American Inventors Protection Act of 1999 (AIPA).[6] When Congress drafted this legislation for *inter partes* reexamination, it provided an entirely new Chapter 31, directed to increased third party requester participation. The existing Chapter 30, on the other hand, was not changed other than to revise the Chapter heading by inserting "EX PARTE" before "REEXAMINATION OF PATENTS." [7]

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[3] See *Id.*; the petitioner's contention also holds true for the *Chambers* decision, and the cases cited therein.

[4] See, for example, H.R. 1732, 104th Cong., 1st Sess. (1995).

[5] See also H.R.1907, which was passed by the House of Representatives on August 4, 1999.

[6] The American Inventors Protection Act of 1999 (AIPA), was enacted on November 29, 1999, as Pub. L. 106-113, 113 Stat. 1501, 1501A-552 through 1501A-591 (1999). The AIPA was part of the conference report (H. Rep. 106-479) on H.R. 3194, Consolidated Appropriations Act, Fiscal Year 2000. The text of the AIPA is contained in Title IV of **S. 1948**, the Intellectual Property and Communications Omnibus Reform Act of 1999 (Pub. L. 106-113), the Act which is incorporated by reference in Division B of the conference report.

[7] Subtitle F, SEC. 4602 (EX PARTE REEXAMINATION OF PATENTS) stated:
"The chapter heading for chapter 30 of title 35, United States Code, is amended by inserting `EX PARTE' before `REEXAMINATION OF PATENTS'."

The Congressional shift in methodology/mechanism from that of simply modifying existing Chapter 30, to that of providing separate Chapters 30 and 31 *shows a specific intent on the part of Congress to retain Chapter 30 as-is with respect to third party requester participation.* The insertion of "EX PARTE" before "REEXAMINATION OF PATENTS" *drives the point home that Congress wanted to keep the examination stage of the Chapter 30 reexamination solely* ***ex parte.***

3. At page 6 of the petition, petitioner presents an interpretation of the reexamination appeal provisions of Public Law 107-273 [8] that is argued to statutorily permit a third party requester appeal in a Chapter 30 *ex parte* reexamination proceeding. Sections 13106(d) and 13202(d) of Public Law 107-273 are relied upon.

In response, it is pointed out that relied-upon Section 13106(d) of P.L. 107-273 is directed to the effective date of expansion of third party requester rights of appeal in an *inter partes* reexamination proceeding; it provides no rights as to *ex parte* reexamination. Further, relied-upon Section 13202(d) is directed solely to the effective date of the *ex parte* reexamination appeals amendments made by section 4605 (b), (c), and (e) of the AIPA; it adds no third party participation rights as to *ex parte* reexamination appeals, or otherwise. Because neither of Sections 13106(d) or 13202(d), nor any other provision of P.L. 107-273, is directed to expansion of third party requester participation rights in Chapter 30 *ex parte* reexamination, the "appeal" argument presented at page 6 of the petition is not persuasive.

4. It is also to be noted that the Federal Circuit has strictly enforced the legislatively set limits on the Office's jurisdiction in Chapter 30 *ex parte* reexamination. *See In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996), and *In re Portola Packaging Inc.*, 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997). Accordingly, the Office does not expect that the Federal Circuit would be receptive to an attempt by the Office to expand third party requester participation rights in *ex parte* reexamination without a clear mandate to do so, and certainly not where the legislative action in drafting what would become part of the AIPA showed an intent to the contrary, as pointed out above.

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[8] *See* the 21st Century Department of Justice Appropriations Authorization Act, TITLE III- INTELLECTUAL PROPERTY, Subtitle A - the "Patent and Trademark Office Authorization Act of 2002" - Enacted as part of Pub. L. 107-273, 116 Stat. 1758, 1899-1906 (2002). The Act was enacted on November 2, 2002, and it contained technical corrections to the AIPA as well as other technical amendments to title 35, U.S.C.

DO NOT ENTER

5. As a final point to be addressed, pages 5 and 6 of the petition present an argument that:

> "The PTO cites *Syntex* as authority for a statutory basis for the *Ex Parte* nature of reexamination, and *Syntex* cites *Etter*, and *Etter* cites a rule, namely 37 C.F.R § 1.550(a) ( 1983 ). In short, the PTO argument for the statutory nature of a requirement that '*Ex Parte*' reexamination be '*Ex Parte*' is circular. Ultimately, the requirement that '*Ex Parte*' reexamination be '*Ex Parte*' is based on a rule and such a requirement may be waived."

This argument ignores the plain language of *Syntex* that -

> "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").[9]

This statement of the Federal Circuit was grounded solely on the statute. It is true that the *Syntex* court makes reference to *In re Etter* [10] which does refer to 37 CFR 1.550(a). That reference, however, is only for the purpose of illustrating the rule that was drafted in compliance with the requirement of the statute. It is to be observed that 35 U.S.C. §§ 132 and 133 are cited in *Etter* (just prior to the citation of the rule discussed by petitioner) as to the *ex parte* nature of the reexamination proceeding that was incorporated into 35 U.S.C. 305. Note that §§ 132 and 133 are directed to an applicant and an application, in which a third party is not permitted to comment on an applicant's responses to Office actions. Accordingly, the *ex parte* nature of the application examination is incorporated into the *ex parte* reexamination statute via 35 U.S.C. 305.

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[9] *Syntex*, 11 USPQ 2d at 1868, 1869, the paragraph bridging the pages

[10] See *In re Etter*, 756 F.2d 852, 859 n.6, 225 USPQ 1,5-6 n.6 (Fed. Cir.) ( *en banc), cert. denied,* 474 U.S. 828 (1985).

## LACK OF SERVICE

The requester's petition is deficient for failure to reflect service of the response on the patent owner 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 patent owner (a Certificate of Service) was not included with the instant petition papers.

Any future communications filed by patent owner in this proceeding must include proof of service on the third party requester in accordance with 37 CFR 1.550(f).

## 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 third party requester 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. In addition, to the extent that the petition might be construed as an *ultra vires* request for the Office to exercise additional jurisdiction over the patent by authorizing third party requester participation, it has been dismissed as an inappropriate avenue of relief. Accordingly, the petition is an improper submission under § 1.540, and it will not be made of record in the reexamination file.

While ordinarily the petition would be returned to the third party requester, in this instance it is being forwarded to the patent owner, since there is no indication that the patent owner was provided with a copy of the papers, as discussed above.

The present decision will be made of record in the reexamination file.

## IMPROPER CAPTION

The present petition is captioned to identify the patent number, but not the reexamination Control Number. While the petition has been matched to this reexamination proceeding, in the future, any papers submitted as to this reexamination proceeding should include the Control Number identified in the caption of this decision.

## CONCLUSION

1. The third party requester petition under 37 CFR 1.183 filed July 31, 2003, is **dismissed**.

2. The original of the petition is being sent to the patent owner, along with this decision.

3. A copy of this decision is being made of record in the reexamination file.

4. The reexamination file is being forwarded to the Group Director of Technology Center 2600.

5. Telephone inquiries related to this decision should be directed to Kenneth M. Schor, Senior Legal Advisor, at (703) 308-6710.

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

November 19, 2003
C:\kiva\kenpet4\6675no.3pr

DOCKET ALARM

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/006,533<br>+ 90/006675 | 01/30/2003 | 5436960 | | 4340 |

803 7590 08/23/2004

| EXAMINER | |
|---|---|

STURM & FIX LLP
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| ART UNIT | PAPER NUMBER |
|---|---|

DATE MAILED: 08/23/2004 # 13

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

Cc'd: Third Party Requester, as on attached decision

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Paper No. 13

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|---|---|---|
| Sturm & Fix LLP<br>206 Sixth Avenue<br>Suite 1213<br>Des Moines, IA 50309-4076 | ) | For Patent Owner |
| David Stewart<br>Allen Dyer Doppelt Milbrath & Gilchrist, PA<br>255 S. Orange Avenue<br>Suite 1401<br>Orlando, FL 32801 | ) | For Third Party Requester |
| In re Campana et al.<br>Reexamination Proceeding<br>Control No.: 90/006,533<br>Filed: January 30, 2003<br>For: U.S. Patent 5,436,960 | ) | DECISION *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS |
| In re Campana et al.<br>Reexamination Proceeding<br>Control No.: 90/006,675<br>Filed: June 24, 2003<br>For: U.S. Patent 5,436,960 | ) | |

The above noted reexamination proceedings are before the Director of Technology Center 2600 for consideration of merger of the proceedings under 37 CFR 1.56(c).

## BACKGROUND

1. Patent 5,436,960 issued on July 25, 1995.

2. A request for reexamination, Control No. 90/006,533 ('533) was filed by the Third Party Requester on January 30, 2003.

3. Reexamination was ordered on the '533 reexamination proceeding on April 17, 2003.

4. A request for reexamination, Control No. 90/006,675 ('675) was filed by the Third Party Requester on June 24, 2003.

5. Reexamination was ordered on the '675 reexamination proceeding on September 3, 2003.

6. No Patent Owner Statement was filed in the '675 reexamination proceeding.

7. A waiver to file Patent Owner Statement was filed in the '533 reexamination proceeding on August 14, 2003. Certificate of Service on the Third Party Requester for this paper was filed on February 25, 2004.

## 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 '533 and '675 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 all proceedings.

The Patent Owner is required to maintain the same claims and specification in both files.

**III.** Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action, which applies to both proceedings. All papers issued by the Office or filed by the Patent Owner must contain the identifying data for both proceedings and will be physically entered in each reexamination file which will be separately maintained. All papers filed by the Patent Owner must also consist of a single response, filed in duplicate, each bearing an original signature, for entry into each file. All papers filed by the Patent Owner must be served on the requestor and requestor will be sent copies of all papers mailed by the Office. See MPEP 2283.

A review of these reexamination files finds that both proceedings currently contain the same claims and specification and therefore the Patent Owner need not take any action.

The merged proceedings are being forwarded to the examiner for appropriate action. An Office action will be mailed in due course.

Mark Powell, Director
Technology Center 2600
Communications

UNITED STATES PATENT AND TRADEMARK OFFICE

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JAN 17 2006

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(For Requester)

In re Thomas J. Campana, Jr. et al.
*Inter partes* Reexamination Proceeding
Control No. 90/006,675
Filed: June 24, 2003
For: U.S. Patent No. 5,436,960

In re Thomas J. Campana, Jr. et al.
Director Ordered
*Ex parte* Reexamination Proceeding
Control No. 90/006,533
Filed: January 30, 2003
For: U.S. Patent No. 5,436,960

: DECISION GRANTING PETITION
: FOR EXTENSION OF TIME

This is a decision on the January 12, 2006, patent owner petition titled "REVISED PETITION FOR THE OFFICE TO FOLLOW ANNOUNCED POLICY AND PROVIDE EQUAL TREATMENT TO PATENT OWNER BY GRANTING A TWO-MONTH PERIOD OF TIME TO RESOND TO THE OFFICE ACTION DATED DECEMBER 30, 2005 " The present petition (1) urges that a two month period should have been set by the Office Action of December 15, 2005, and should be re-set accordingly, and (2) revises its request for an additional month to respond to the Office Action of December 15, 2005, to thereby extend the deadline for response to be February 15, 2006.

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

The petition is granted as to the request for an additional month to respond to the Office Action of December 15, 2005, for the reasons set forth below.

The petition is dismissed as to the request that the time period set in the Office action be reset, since such request is now moot for the reasons set forth below.

## DISCUSSION

The patent owner on January 03, 2006, submitted a petition that urged that a two month period should have been set by the Office Action of December 15, 2005, and should be re-set accordingly, and (2) requested an additional month to respond to the Office Action of December 15, 2005, to thereby extend the deadline for response to be February 15, 2006. The January 03, 2006 petition for extension of time was accompanied by an authorization to debit a deposit account, accordingly the $200.00 petition fee required by 37 CFR 1.515(c) has been charged to Account No. 05-02-06. Thus, the appropriate fee has been paid.

The instant revised petition seeks an additional month in which to file a response to the Office action dated December 15, 2005, which action set a one month date for filing a response thereto. The Office action in question is a non-final action.

37 CFR 1.550 (c ) states:

> (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.

Addressing the requirement of 37 CFR 1.550 (c) to make a showing of "sufficient cause" to grant an extension of time request, MPEP 2265 states, in pertinent part:

> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. 305) 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 patent owner in this revised request, positively states that its expert, Dr. Rhyne, will be available the week of January 23 , 2006, to work on the response for the above identified proceedings. In addition the patent owner states that "With the extremely short availability window Dr. Rhyne presently has, an additional month is needed to accomplish that without seriously prejudice to NTP's ability to present all of the facts necessary to make its record."

Patent owner further states in the renewed petition for extension of time that the option of engaging another expert instead of Dr. Rhyne has been considered, but at present, patent owner has determined that this option is unrealistic and impractical. The renewed petition states that, aside from Dr. Rhyne's familiarity evaluating the patent that is the subject of this merged reexamination proceeding and other related patents, any other expert having the appropriate qualifications who might be found would need to spend several weeks, or perhaps months, getting up to the level of understanding of the Campana patents and the art generally that equals Dr. Rhyne's.

It is considered that the renewed petition expressly states the steps taken by patent owner, and expressly states when Dr. Rhyne will be available to provide an analysis and formulate an expert opinion on the instant proceedings, thereby providing sufficient basis as to why an extension of time should be granted. Thus, when balancing the needs for special dispatch with the need to provide the patent owner with an opportunity to have its expert evaluate the response of record it has been determined that the need for the expert, at this time and under the instant circumstances, contravenes the requirement for "special dispatch." However, the patent owner is advised that unavailability of Dr. Rhyne beyond the deadline as extended by one month, or the difficulty of securing the services of a second expert meeting patent owner's criteria, and the difficulty of bringing a second expert "up to speed" in advance of the time necessary to prepare a response by the deadline, as extended by one month, will **not** be considered to present a compelling reason establishing an extraordinary situation in support of the grant of a second extension of time.

## DECISION

I. For the reasons stated above, the petition has established sufficient cause to extend the time period, and is granted.

II. Since the petition has been granted for an extension for one month of time, the patent owner request that the time period set in the Office action be reset is dismissed as moot, and need not be addressed further in this decision.

III. Future requests for extensions of time will be strictly evaluated for compliance with 37 CFR 1.550. In light of the length of the pendency of this proceeding and the similar issues shared with other pending proceedings, future petitions for extension of time will be granted only upon a showing of sufficient cause that takes into account the related reexamination proceedings and the statutory requirement that reexamination proceedings must be conducted with "special dispatch."

## CONCLUSION

1. The petition is granted as to the request for an additional month to respond to the Office Action of December 15, 2005. The patent owner's period for response set in the December 15, 2005 Office action is hereby extended to expire on February 15, 2006.

2. The petition is dismissed as to the request that the time period set in the Office action be reset, since such request is now moot.

3. Patent owner is reminded that following the Office's prior guidance on where to submit papers may avoid delays in processing future on. **Future correspondence is to be submitted via one of the following options**:

By Mail to: Mail Stop *Inter Partes* 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
Attention: Central Reexamination Unit
Randolph Building
401 Dulany St.
Alexandria, VA 22314

4. Telephone inquiries with regard to this decision should be directed to Mark Reinhart of the Central Reexamination Unit Art Unit at (571)-272-1611, and in his absence to the undersigned at (571) 272-1596.

Lissi Mojica Marquis, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

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REEXAM UNIT

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(For Third Party Requester)

In re Thomas J. Campana, Jr. *et al*
Reexamination Proceeding
Control No. 90/006,533
Filed: January 30, 2003
For U.S. Patent No.5,436,960

In re Thomas J. Campana, Jr. *et al*
Reexamination Proceeding
Control No. 90/006,675
Filed: June 24, 2003
For U.S. Patent No. 5,436,960

In re Thomas J. Campana, Jr. *et al*
Reexamination Proceeding
Control No. 90/007,731
Filed: September 27, 2005
For U.S. Patent No. 5,436,960

DECISION,
*SUA SPONTE,*
MERGING
REEXAMINATION
PROCEEDINGS
PURSUANT TO
37 C.F.R. § 1.565(c)

The above-identified reexamination files are before the Director of the Central Reexam Unit 3999, for consideration of merger of reexamination control number 90/007,731 (the '731 proceeding) with the previously merged reexamination control numbers 90/006,533 (the '533 proceeding) and 90/006,675 (the '675 proceeding) pursuant to 37 C.F.R. § 1.565(c).

## BACKGROUND

1. Patent No. 5,436,960 issued on July 25, 1995.

2. The '533 reexamination proceeding, filed on January 30, 2003, is a reexamination proceeding that was requested by a third party requester.

3. An order granting reexamination in the '533 reexamination proceeding was mailed on April 17, 2003.

4. The '675 reexamination proceeding, filed on June 24, 2003, is a reexamination proceeding that was requested by a third party requester.

5. An order granting reexamination in the '675 reexamination proceeding was mailed on September 3, 2003.

6. The '533 and '675 proceedings were merged to provide a single consolidated proceeding on August 23, 2004.

7. A non-final Office action was mailed on April 19, 2005 in the previously merged proceedings.

8. A response to the April 19, 2005, Office action was timely filed on July 19, 2005. The response added claims 90 to 182 to the merged proceedings. However, the amendment was canceled following notification of fee deficiency in the Interview Summary mailed on November 18, 2005.

9. An amendment with proper fee was filed on November 25, 2005 in the '533 and '675 reexamination proceedings. The amendment canceled claims 90 to 182 and added claims 183 to 200.

10. A non-final Office action was mailed on December 15, 2005 in the previously merged proceedings.

11. A response to the December 15, 2005 Office action was timely filed on February 15, 2006. The response added claims 201 to 233.

12. A Final Office action was mailed on February 24, 2006 in the previously merged proceedings.

13. The '731 proceeding was filed on September 27, 2005 by a third party requester.

14. The third party requester's correspondence address is the same in each of the above mentioned proceedings.

15. An order granting reexamination in the '731 reexamination proceeding was mailed on October 14, 2005.

16. There are no amendments to the '731 reexamination proceeding.

## 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 , *supra*, reexamination was previously ordered in the '533 and '675 reexamination proceedings, and these proceedings have previously been merged. Reexamination has been ordered in the '731 proceeding.

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 90/006,533, 90/006,675 and 90/007,731 reexamination proceedings are hereby 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 '6,533 and '6,675 reexamination proceeding. Patent owner is required to maintain the same claims and specification in all merged 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.

### 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. 90/006,533, 90/006,675 and 90/007,731 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.

All correspondence regarding these proceedings should 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

Telephone inquiries with regard to this decision should be directed to Mark Reinhart, Special Program Examiner in the Central Reexamination Unit, Art Unit 3992, at (571) 272-1611

M Reinhart SPRE-CRU- 3992
Lissi M. Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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(For Third Party Requester)

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CENTRAL REEXAMINATION UNIT

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/006,533
Filed: January 30, 2003
For: U.S. Patent No. 5,436,960

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No. : 90/006,675
Filed: June 24, 2003
For: U.S. Patent No. 5,436,960

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/007,731
Filed: September 27, 2005
For: U.S. Patent No. 5,436,960

**DECISION, *SUA SPONTE*, DISMISSING PETITION AND "RETURNING" IMPROPER PAPERS**

This is a decision on the June 23, 2006 patent owner petition styled "Petition Pursuant to 37 CFR 1.181 or Alternatively, 37 CFR 1.182 OR Alternatively 37 CFR 1.183 to Reconsider Decision Returning Paper and Enter the Papers into the Official Record." [1]

The petition and the above-captioned reexamination proceedings are before the Office of Patent Legal Administration for consideration.

The petition is dismissed and its attachments are returned to the patent owner for the reasons discussed below.

[1] The present petition is, facially, fully treatable pursuant to the provisions of 37 CFR 1.181. Accordingly, it is manifestly unnecessary to consider the petition under either 37 CFR 1.182 or 37 CFR 1.183. No fee is required.

## REVIEW OF SALIENT FACTS

1. U.S Patent number 5,436,960 ("the '960 patent") issued to Campana *et al* on July 25, 1995 from an application filed on May 20, 1991.

2. On January 30, 2003, a request for *ex parte* reexamination of the '960 patent was filed by a third party requester and assigned control number 90/006,533 ("the '533 reexamination proceeding").

3. On April 17, 2003, the examiner's Order Granting *Ex Parte* Reexamination for the '533 reexamination proceeding was mailed.

4. On June 24, 2003, a second request for ex *parte* reexamination of the '960 patent was filed by the same third party requester, and assigned control number 90/006,675 ("the '675 reexamination proceeding").

5. On September 3, 2003, the examiner's Order Granting *Ex Parte* Reexamination for the '675 reexamination proceeding was mailed.

6. On August 23, 2004, the Technology Center Director issued a decision, *sua sponte*, by which the '533 reexamination proceeding and the '675 reexamination proceeding were merged into a single combined reexamination proceeding.

7. On September 27, 2005, third party requester filed a third request for *ex parte* reexamination of the '960 patent, which was assigned control number 90/007,731 ("the '731 reexamination proceeding").

8. On October 14, 2005, the examiner's Order Granting *Ex Parte* Reexamination for the '731 reexamination proceeding was mailed.

9. On January 4, 2006, a Freedom of Information Act ("FOIA") Request was made to the Office requesting the Office's communications with third parties regarding the present reexamination proceedings and pending reexamination proceedings being conducted on other of patent owner's patents.

10. The Office responded to the FOIA request through letters dated between February 8 and March 24, 2006. [2]

11. Following prosecution on the patentability of the '960 patent claims, a final rejection Office action was issued in the merged reexamination proceeding on February 24, 2006.

12. On March 1, 2006, the Central Reexamination Unit (CRU) Director issued a decision, *sua sponte*, by which the '533 reexamination proceeding, the '675 reexamination proceeding and the '731 reexamination proceeding were merged into a single merged reexamination proceeding. [3]

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[2] An additional response to the FOIA request was mailed by the Office on June 15, 2006 and received by patent owner on June 16, 2006.

[3] Jurisdiction of the merged '533 and '675 reexamination proceedings had previously been transferred from the Technology Center to the CRU.

13. On April 24, 2006, patent owner filed both a notice of appeal and an information disclosure statement (IDS) in the single combined reexamination proceeding.

14. Also on April 24, 2006, patent owner filed a paper styled as a response to the final rejection, which included a traverse of the final rejection, copies of material obtained as a result of the FOIA request, and a number of statements in support of patent owner's traverse.

15. On May 17, 2006, the CRU Director mailed a decision returning the April 24, 2006 patent owner response to the final rejection noted in Fact 14 above without consideration on the merits. The return was based on the grounds that the papers filed were improper because they were not limited to consideration of prior patents and printed publications and also because portions were not in compliance with the 37 CFR 1.3 requirements for decorum and courtesy. Accordingly, the returned response was not entered into the record.

16. On May 22, 2006, patent owner filed a redacted version of the April 24, 2006 response, limited to material addressing the outstanding final rejection Office action, which has been entered into the IFW record.

17. On June 23, 2006, patent owner filed the present petition requesting reconsideration of the CRU Director's May 17, 2006 decision. Patent owner has attached to the petition the material that was refused entry and returned (by the CRU Director's May 17, 2006 decision), for entry into the record as part of patent owner's response to the February 24, 2006 final Office action.

## DECISION DISMISSING THE THIRD PARTY REQUESTER PETITION AND RETURNING PAPERS FILED WITH THE PETITION

I. Relevant Statutes, Regulations and Practice

35 U.S.C. § 132 provides:

> "(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.
>
> (b) The Director shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant. The Director may establish appropriate fees for such continued examination and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under section 41(h)(1) of this title."

35 U.S.C. § 134(b) provides:

> "A patent owner in any reexamination proceeding may appeal from the final rejection of any claim by the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal."

35 U.S.C. § 305 provides, in part:

"After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent."

35 U.S.C. § 306 provides:

"The patent owner involved in a reexamination proceeding under this chapter may appeal under the provisions of section 134 of this title, and may seek court review under the provisions of sections 141 to 145 of this title, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent."

37 CFR 1.3 provides:

"Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Director and will not be entered. A notice of the non-entry of the paper will be provided. **Complaints against examiners and other employees must be made in correspondence separate from other papers.**" [Emphasis added.]

37 CFR 1.4(c) provides:

"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."

37 CFR 1.113(a) provides, in part:

"On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon ... for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. **Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181).** ..." [Emphasis added.]

37 CFR 1.116(a)-(e) provide, in part:

"(a) An amendment after final action must comply with § 1.114 or this section.

(b) After a final rejection or other final action (§ 1.113) ... in an ex parte reexamination filed under § 1.510 ... 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 ... patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

(c) The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the ... reexamination proceeding from its condition as subject to appeal or to save ... the reexamination prosecution from termination under § 1.550(d) ... .

(d) (1) ...
(2) Notwithstanding the provisions of paragraph (b) of this section, an amendment made after a final rejection or other final action (§ 1.113) in an ex parte reexamination filed under §1.510 ... may not

cancel claims where such cancellation affects the scope of any other pending claim in the reexamination proceeding except ... as permitted by § 41.77(b)(1) of this title.

(e) An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) ... in an ex parte reexamination filed under § 1.510 ... but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented."

37 CFR 1.181(a)(1) provides that petition may be taken to the Director:

"**From any action** or requirement of any examiner in the ex parte prosecution of an application, or **in ex parte** or inter partes prosecution **of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court.**" [Emphasis added.]

37 CFR 1.550(a) and (b) provide, in part:

"(a) All *ex parte* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office. **After issuance of the *ex parte* reexamination order and expiration of the time for submitting any responses, the examination will be conducted in accordance with §§ 1.104 through 1.116** and will result in the issuance of an *ex parte* reexamination certificate under § 1.570. [Emphasis added.]

(b) The patent owner in an *ex parte* reexamination proceeding will be given at least thirty days to respond to any Office action. **In response to any rejection**, such response may include further statements and/or proposed amendments or new claims to place the patent in a condition where all claims, if amended as proposed, would be patentable." [Emphasis added.]

MPEP § 2267 provides in part:

"The return of inappropriate submissions complies with the regulations that certain papers will not be considered and also reduces the amount of paper which would ultimately have to be scanned into the record.

I. DISPOSITION OF PAPERS

Where papers are filed during reexamination proceedings which are inappropriate because of some defect, such papers will either be returned to the sender or forwarded to one of three files, the "Reexamination File" (paper file or IFW file history), the "Patent File" (paper file or IFW file history), or the "Storage File" (paper file). Any papers returned to the sender from a Technology Center (TC) must be accompanied by a letter indicating signature and approval of the TC Director." [4]

## II. Findings and Analysis

On April 24, 2006, patent owner filed a response to the final action dated February 24, 2006. That paper was returned to patent owner by the decision of the CRU Director dated May 17, 2006, on the grounds that the response was an improper paper. The basis of this holding was that the response included statements and documents that were improper because they were not limited to consideration of prior patents and printed publications, and also because portions were not in compliance with 37 CFR 1.3 requirements for decorum and courtesy. Patent owner was invited, in the May 17, 2006 decision returning papers, to submit a redacted response, and patent owner has in fact filed a redacted version of that response (the redacted version has been entered into the record).

Patent owner has now attached to the present petition - a set of papers to be added to the record as a part of the response to the February 24, 2006 final action, which would be available for the examiner's consideration in evaluating the patent owner's response. Patent owner

[4] When the CRU has jurisdiction, as in the case of this merged proceeding, the CRU Director would approve and sign the letter accompanying returned papers.

requests by way of the present petition that these papers be entered into the IFW record to provide a complete administrative record.[5] It is patent owner's position that:

(1) There was no legal basis for the CRU Director's return of the April 24, 2006 response papers;

(2) The grounds for such return as expressed in the CRU Director's decision returning the papers were erroneous;

(3) The patent owner is entitled to argue and provide documents to allege that the February 24, 2006 final action is an improper action based on allegations of misconduct and bias.

(4) Due process requires that the Office accept the unredacted response and related FOIA evidence. [6]

It is also noted that patent owner argues that the CRU Director's decision returning the April 24, 2006 response to the final action dated February 24, 2006 was inconsistent with a prior petition decision dated March 20, 2006 denying a patent owner petition filed on January 23, 2006. [7] This argument will be separately addressed, *infra*.

A. The April 24, 2006 Response Was An Improper Paper, The Response Attached To The Present Petition Is An Improper Paper, And Both Papers Lack An Entry Right In The Merged Reexamination Proceeding

Pursuant to 35 U.S.C. § 306, an issue directed to the merits of a final rejection in an *ex parte* reexamination proceeding is appealable to the Patent and Trademark Office Board of Patent Appeals and Interferences. On the other hand, pursuant to 37 CFR 1.181(a), a petition to the USPTO Director is the appropriate vehicle to resolve matters not subject to appeal. It is further to be noted that, pursuant to 37 CFR 1.4(c), different matters raised in a given proceeding must be raised in separate papers. Finally, pursuant to 37 CFR 1.3, complaints against examiners and other Office employees "must be made in correspondence separate from other papers" which are not directed to complaints against examiners and other Office employees.

In the present instance, a review of the papers attached to the present petition indicates that (1) the papers are essentially the same as, if not identical to, the papers that were returned by the CRU Director's May 17, 2006 decision, and (2) these papers purport to be a response to the examiner's treatment of the pending claims in light of the prior art patents and publications applied to the claims by the examiner in the final action dated February 24, 2006. Pursuant to 37 CFR 1.550(a) (the rule that implements 35 U.S.C. § 305), *ex parte* reexamination proceeding is "conducted in accordance with [37 CFR] §§ 1.104 through 1.116." Therefore, the appropriate content of a 37 CFR 1.550(b) response to a final Office action in an *ex parte* reexamination proceeding is defined by 37 CFR 1.113(a) and 37 CFR 1.116. These regulations do not (contrary to petitioner's argument) provide for "further statements" that are unrestricted as to content. Instead, 37 CFR 1.113(a) and 37 CFR 1.116 require that a response to a final action address the issue of patentability of the pending claims with respect to the outstanding rejection, which, in this instance, is the examiner's treatment of the patentability of the claims in light of prior

[5] This would result in the commingling of the now-proffered set of papers with material that the examiner will have to consider.

[6] Petition at pages 10 *et. seq*.

[7] The petition and decision thereon referenced by patent owner are apparently those in the file records of *ex parte* reexamination control number 90/006,495 and *inter partes* reexamination proceeding 95/000,020, which have been merged into a single reexamination proceeding.

patents and printed publications. In contrast, the papers attached to the present petition include material directed to issues other than the examiner's treatment of the patentability of the claims in light of prior patents and printed publications. In fact, large portions of the remarks contained in the response to the final action [8] and documents cited in support are directed to the conduct of Office employees/officials. Thus, large portions of the papers attached to the present petition, are not directed to issues of patentability of the pending claims in light of the applied prior art patents and printed publications. Therefore, these papers clearly constitute responses to the outstanding final Office action that are not proper under 37 CFR 1.550(b) and do not fall within the jurisdiction of the examiner. Accordingly, each of these papers submitted in response to the Office action lacks an entry right in the present merged reexamination proceeding for consideration by the examiner.

Further, 37 CFR 1.3 expressly precludes "complaints against examiners and other employees" submitted as part of papers directed to other matters. Thus, the patent owner's submission of documents in support of its allegations of misconduct and bias could not properly be included with papers directed to the question of patentability in view of prior art, because the clear and unequivocal language of 37 CFR 1.3 expressly requires that "employee conduct" issues are to be raised in correspondence separate from other papers. Here, patent owner improperly raises allegations of employee misconduct incorporated within papers directed to the merits of the examiner's position on the patentability of the pending claims in light of patents and printed publications as set forth in the final Office action. Therefore, the originally filed April 24, 2006 response and the response attached to the present petition are both improper for the reason that they fail to comply with the requirements of 37 CFR 1.3. Accordingly, each paper further lacks an entry right in the present merged reexamination proceeding for consideration by the examiner.

Moreover, 37 CFR 1.4(c) requires that different matters in a given proceeding appropriate for consideration by different branches within the Office must be raised in separate papers. However, patent owner's April 24, 2006 response to the final action improperly presented, in the same paper, both:

> (1) arguments and materials directed to the patentability of the claims in view of the patents and printed publications applied in the final Office action, and
>
> (2) allegations of employee misconduct and bias.

The patentability arguments are properly considered by the examiner. In contrast, allegations of employee misconduct and bias are considered by way of a petition to the appropriate Office official for the exercise of supervisory authority pursuant to 37 CFR 1.181(a), because alleged employee misconduct and bias relate to non appealable subject matter. Thus both the originally filed April 24, 2006 response and the response attached to the present petition are improper for the additional reason that they fail to comply with the requirements of 37 CFR 1.4(c).

Therefore, for the foregoing reasons, the April 24, 2006 patent owner response, and the June 23, 2006 response attached to the present patent owner petition are deemed improper and therefore these papers lack an entry right in the present merged reexamination proceeding. The disposition of improper papers will be treated as discussed in Section C., *infra*.

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[8] See, *e.g.*, the arguments at page 74-92 of the response. Note that even a single instance of an argument directed to matters that are not part of a proper response to a final action within the meaning of 37 CFR 1.113(a) and 37 CFR 1.116 would suffice to preclude entry of the entire response as lacking an entry right.

B. Further Discussion

1. While the patent owner's April 24, 2006 response to the Feb 24, 2006 final action and the response to the final action attached to the present petition each lack an entry right for consideration by the examiner as explained in Section II(A), patent owner may raise the issue of alleged employee misconduct by way of petition under 37 CFR 1.181(a). Note is taken of patent owner's statement that on March 20, 2006, the Office issued a decision in a separate proceeding, such decision denying a patent owner petition filed on January 23, 2006. [9] Patent owner correctly states that the January 23, 2006 petition was denied because it did not provide sufficient details. However, if patent owner is able to now supply those details, they must be submitted in a separate petition under 37 CFR 1.181, but cannot be submitted as part of a paper submitted for consideration by the examiner.

2. Patent owner's characterization of the May 17, 2006 decision issued by the CRU Director returning the April 24, 2006 response to the final Office action of February 24, 2006 is not wholly accurate. In actuality, the CRU Director's May 17, 2006 decision did not mean to imply that the FOIA papers would be barred from submission for any and all purposes. Rather, it properly points out that the papers were returned because they raised issues unrelated to patentability and therefore are not appropriate for consideration by the examiner. Therefore, the submitted papers did not comply with the regulations and practice regarding the submission of response papers. [10]

3. To the extent that patent owner disagrees with some or all of the rationale set forth in support of the CRU Director's decision, Section II(A) of the present decision amplifies the reasons in support of the conclusion reached in the CRU Director's May 17, 2006 decision to refuse entry and return the April 24, 2006 response with attached papers. Section II(A) of the present decision explains that the patent owner may indeed raise alleged employee misconduct and bias issues, but must do so via a separate petition under 37 CFR 1.181. Such a petition must conform to the governing regulations and practice, i.e., the petition regarding alleged employee misconduct must not be attached to papers directed to the substantive issue of claim patentability in light of the prior patents and printed publication. See 37 CFR 1.3 and 37 CFR 1.4(c).

4. As a final point on this matter, patent owner is not being deprived of due process by a refusal to accept papers that mingle allegations of misconduct (and documents supporting those allegations) with papers that are directed to other matters. Papers raising issues of alleged misconduct, and documents proffered in support of such allegation, are admissible in the Office only if they are provided in a manner that complies with the regulations.

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[9] See footnote 7, *supra*.

[10] Considering the fact that the papers in question were styled as a response to a final Office action, the material beginning at the last paragraph of page 2 of the May 17, 2006 CRU Director's decision and running through page 3 thereof indicates to the undersigned that the CRU Director was concerned with the mingling of prior art patent and printed publication patentability issues with the procedural issues raised by the allegations of misconduct and bias of raised in papers.

C. Disposition Of Papers

1. In this instance: (1) the April 24, 2006 presentation of the FOIA papers, (2) the April 24, 2006 declaration of Keith Anderson directed the FOIA papers, and (3) the remarks directed to the conduct of Office employees/officials that were included within the April 24, 2006 response to the final action have previously been found to be improper, and lacking an entry right in the present merged proceeding. These papers were previously returned, and a redacted form of these papers was entered into the record, as discussed above.

2. In addition, the patent owner has attached to the present petition the material that was refused entry and returned (by the CRU Director's May 17, 2006 decision), for entry into the record as part of patent owner's response to the February 24, 2006 Office action. These papers have now been found to be improper and therefore lack an entry right in the present merged proceeding to which they are directed. As these papers are determined to lack an entry right in the present merged reexamination proceeding, they will be returned in accordance with provisions of MPEP § 2267. In this instance it would be unduly burdensome to either physically return the large bulk of papers, or expend significant Office resources scanning the documents into the record and then closing them from view. [11] Therefore, the papers are being temporarily held for "pick up" in the Central Reexamination Unit (CRU). If the patent owner desires the physical return of the papers, then patent owner should promptly make arrangements to pick up the papers from the CRU **within one month** of the mailing date of this decision. Patent owner should immediately notify Norma Amador of the CRU, at telephone number (571) 272-6474, of any arrangements that have been made to pick up the papers. If the papers are **not** picked up **within one month** of the mailing date of this decision, **the CRU will dispose of the papers**, note being taken that the patent owner presumably has the originals.

3. As to the present petition, the petition contains facial allegations of employee misconduct and bias. Accordingly, though the petition itself will be retained of record in the IFW file, it is being marked as "non-public."

## CONCLUSION

1. The June 23, 2006 patent owner petition is dismissed.

2. The (1) the April 24, 2006 presentation of the FOIA papers, (2) the April 24, 2006 declaration of Keith Anderson directed the FOIA papers, and (3) the remarks directed to the conduct of Office employees/officials that were included within the April 24, 2006 response to the final action have been found to be improper papers lacking an entry right in the present merged proceeding to which they are directed. These papers were properly returned to patent owner.

3. The papers attached to the present petition that appear to be the material that was refused entry and returned by the CRU Director's May 17, 2006 decision will be held for one month in the CRU in a single storage location, and thereafter will be discarded if not picked up by patent owner.

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[11] Patent owner has filed at least six other petitions corresponding to the present petition, and provided such papers as attachments to each filed petition.

4. The present petition will be retained of record in the IFW file and is being marked as "non-public."

5. A copy of this decision is being made of record in the merged reexamination proceeding, and the decision will therefore appear in the IFW record of *ex parte* reexamination proceedings 90/006,533, 90/006,675 and 90/007,731.

6. **All correspondence relating to an *inter partes* reexamination proceeding should be directed to:**

By Mail to: Mail Stop *Ex Parte* Reexam
ATTN: 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) 273-9900
Central Reexamination Unit

By hand: Customer Service Window
ATTN: Central Reexamination Unit
Randolph Building
401 Dulany St.
Alexandria, VA 22314

8. Telephone inquiries with regard to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or, in his absence, to the undersigned at (571) 272-7710.

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

sm
July 31, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

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REEXAMINATION UNIT

Novak Druce & Quigg LLP
1300 Eye Street NW
Suite 400 East Tower
Washington, DC 20005

(For Third Party Requester)

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/006,533
Filed: January 30, 2003
For: U.S. Patent No. 5,436,960

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/006,675
Filed: June 24, 2003
For: U.S. Patent No. 5,436,960

*In re Campana, Jr. et al*
*Ex Parte* Reexamination Proceeding
Control No.: 90/007,731 ✓
Filed: September 27, 2005
For: U.S. Patent No. 5,436,960

**DECISION DENYING PETITION**

This is a decision on the October 23, 2006 patent owner petition styled "Petition Pursuant to 37 CFR 1.181 or Alternatively, 37 CFR 1.182 Or Alternatively 37 CFR 1.183 to Reconsider Decision, *Sua Sponte*, 'Returning' Improper Papers and Alternatively That the Commissioner Declare His Decision A Final Agency Action." [1,2]

The petition and the above-captioned reexamination proceedings are before the Office of Patent Legal Administration for consideration.

The petition is granted to the extent that (1) the "Decision, *Sua Sponte*, Dismissing Petition and 'Returning' Improper Papers" [3] dated August 23, 2006, has been reconsidered, and (2) the

[1] The present petition paper is fully treatable pursuant to 37 CFR 1.181, and it is thus unnecessary to consider the petition paper under either 37 CFR 1.182 or 37 CFR 1.183. A petition fee is not required.
[2] The present paper will hereinafter be referred to as "Petition for Reconsideration."
[3] Hereinafter "Decision Dismissing Petition."

present decision has been designated as a final agency action under 35 U.S.C. § 704. For the reasons discussed below, the underlying relief requested by petitioner patent owner is denied.

## REVIEW OF SALIENT FACTS

1. U.S Patent number 5,436,960 ("the '960 patent") issued to Campana *et al* on July 25, 1995 from an application filed on May 20, 1991.

2. On January 30, 2003, a request for *ex parte* reexamination of the '960 patent was filed by a third party requester. The resulting *ex parte* reexamination proceeding was assigned control number 90/006,533 ("the '533 reexamination proceeding").

3. On April 17, 2003, the examiner's Order Granting *Ex Parte* Reexamination for the '533 reexamination proceeding was mailed.

4. On June 24, 2003, a request for a second ex *parte* reexamination of the '960 patent was filed by the same third party requester, and the resulting proceeding was assigned control number 90/006,675 ("the '675 reexamination proceeding").

5. On September 3, 2003, the examiner's Order Granting *Ex Parte* Reexamination was mailed for the '675 reexamination proceeding.

6. On August 23, 2004, the Technology Center Director issued a decision, *sua sponte*, by which the '533 reexamination proceeding and the '675 reexamination proceeding were merged into a single consolidated reexamination proceeding.

7. On September 27, 2005, third party requester filed a third request for *ex parte* reexamination of the '960 patent, which was assigned control number 90/007,731 ("the '731 reexamination proceeding").

8. On October 14, 2005, the examiner's Order Granting *Ex Parte* Reexamination for the '731 reexamination proceeding was mailed.

9. On January 4, 2006, a Freedom of Information Act ("FOIA") Request was made to the Office requesting the Office's communications with third parties regarding the present reexamination proceedings and pending reexamination proceedings being conducted on other of patent owner's patents.

10. The Office responded to the FOIA request through letters dated between February 8 and March 24, 2006. [4]

11. Following prosecution on the patentability of the '960 claims, a final rejection Office action was issued in the merged '533 - '675 reexamination proceeding on February 24, 2006.

12. On March 1, 2006, the Central Reexamination Unit (CRU) Director issued a decision, *sua sponte*, by which the '533 reexamination proceeding, the '675 reexamination proceeding and the '731 reexamination proceeding were merged into a single consolidated reexamination

[4] An additional response to the FOIA request was mailed by the Office on June 15, 2006, and received by patent owner on June 16, 2006.

proceeding. [5]

13. On April 24, 2006, patent owner filed both a notice of appeal and an information disclosure statement (IDS) in the single combined reexamination proceeding.

14. Also on April 24, 2006, patent owner filed a paper styled as a response to the final rejection, which included a traverse of the final rejection, copies of material obtained as a result of the FOIA request, and a number of statements in support of patent owner's traverse.

15. On May 17, 2006, the CRU Director mailed a decision returning the April 24, 2006 patent owner response to the final rejection without consideration on the merits. The return was grounded on the impropriety of the papers, because they were not limited to consideration of prior patents and printed publications, and also because portions of the submission were not in compliance with the requirements of 37 CFR 1.3. Accordingly, the returned supplemental response was not entered into the record.

15. On May 22, 2006, patent owner filed a redacted version of the April 24, 2006 supplemental amendment/response, which is limited to material addressing the outstanding nonfinal rejection Office action, and which has been entered into the IFW record for the merged proceeding.

16. On June 23, 2006, patent owner filed a petition requesting reconsideration of the CRU Director's May 17, 2006 decision. Patent owner attached to the petition the material that had been refused entry and returned (by the CRU Director's May 17, 2006 decision), and requested entry of that material into the record, as part of patent owner's supplemental response to the December 30, 2005 nonfinal Office action.

17. On August 23, 2006, the June 23, 2006 patent owner petition was dismissed, [6] and was "returned" to petitioner by permitting petitioner to schedule a time to pick up the material (together with similar material from other concurrently filed related petitions). [7]

18. On October 23, 2006, petitioner patent owner filed the present Petition for Reconsideration of the August 23, 2006 petition decision.

## DECISION

### I. Relevant Statutes, Regulations and Practice

35 U.S.C. § 132 provides:

> "(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

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[5] Jurisdiction of the merged '533 and '675 reexamination proceedings had previously been transferred from the Technology Center to the CRU.

[6] See discussion at pages 5-7, *infra*.

[7] No such pick up was scheduled, and none was made.

(b) The Director shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant. The Director may establish appropriate fees for such continued examination and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under section 41(h)(1) of this title."

35 U.S.C. § 301 provides in pertinent part:

"Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent."

35 U.S.C. § 302 provides 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. § 303(a) provides in pertinent part:

"Within 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. § 305 provides, in pertinent part:

"After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent."

35 U.S.C. § 306 provides:

"The patent owner involved in a reexamination proceeding under this chapter may appeal under the provisions of section 134 of this title, and may seek court review under the provisions of sections 141 to 145 of this title, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent."

37 CFR 1.3 provides:

"Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Director and will not be entered. A notice of the non-entry of the paper will be provided. **Complaints against examiners and other employees must be made in correspondence separate from other papers.**" [Emphasis added.]

37 CFR 1.4(c) provides:

"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."

37 CFR 1.113(a) provides, in part:

"On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon ... for *ex parte* reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. **Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181).** ..." [Emphasis added.]

37 CFR 1.116(a)-(e) provide, in part:

"(a) An amendment after final action must comply with § 1.114 or this section.

(b) After a final rejection or other final action (§ 1.113) ... in an *ex parte* reexamination filed under § 1.510 ... 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 ... patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

(c) The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the ... reexamination proceeding from its condition as subject to appeal or to save ... the reexamination prosecution from termination under § 1.550(d) ... .

(d) (1) ...
(2) Notwithstanding the provisions of paragraph (b) of this section, an amendment made after a final rejection or other final action (§ 1.113) in an ex parte reexamination filed under §1.510 ... may not cancel claims where such cancellation affects the scope of any other pending claim in the reexamination proceeding except ... as permitted by § 41.77(b)(1) of this title.

(e) An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) ... in an ex parte reexamination filed under § 1.510 ... but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. "

37 CFR 1.181(a)(1) provides that petition may be taken to the Director:

"**From any action** or requirement of any examiner in the *ex parte* prosecution of an application, or **in *ex parte*** or *inter partes* prosecution **of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court.**" [Emphasis added.]

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

"(a) All *ex parte* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office. **After issuance of the *ex parte* reexamination order and expiration of the time for submitting any responses, the examination will be conducted in accordance with §§ 1.104 through 1.116** and will result in the issuance of an *ex parte* reexamination certificate under § 1.570. [Emphasis added.]

(b) The patent owner in an *ex parte* reexamination proceeding will be given at least thirty days to respond to any Office action. **In response to any rejection**, such response may include further statements and/or proposed amendments or new claims to place the patent in a condition where all claims, if amended as proposed, would be patentable." [Emphasis added.]

MPEP § 2267 provides in pertinent part:

"The return of inappropriate submissions complies with the regulations that certain papers will not be considered and also reduces the amount of paper which would ultimately have to be scanned into the record.

I. DISPOSITION OF PAPERS
Where papers are filed during reexamination proceedings which are inappropriate because of some defect, such papers will either be returned to the sender or forwarded to one of three files, the "Reexamination File" (paper file or IFW file history), the "Patent File" (paper file or IFW file history), or the "Storage File" (paper

file). Any papers returned to the sender from a Technology Center (TC) must be accompanied by a letter indicating signature and approval of the TC Director." [8]

## II. Basis For The August 23, 2006 Decision

On April 24, 2006, patent owner filed a response to an outstanding final Office action dated February 24, 2006. That paper was returned to patent owner without consideration on the merits as an inappropriate submission. [9] The paper was considered to be inappropriate by the Central Reexamination Unit Director, (1) because the paper was not limited to consideration of prior patents and printed publications, [10] and (2) because portions of that paper were not in compliance with the requirements of 37 CFR 1.3. On June 23, 2006, patent owner requested reconsideration of the return of those papers by way of a petition for reconsideration. Patent owner attached to that petition for reconsideration the material that had previously been refused entry. A decision issued August 23, 2006, setting forth in detail the basis for refusing the underlying relief requested in the June 23, 2006 request for reconsideration, and for again returning the material that was not proper for entry into the record of the present merged reexamination proceeding.

It was pointed out in the August 23, 2006 decision, in explanation of why the underlying relief requested by petitioner would not be appropriate, that:

> A) Pursuant to 35 U.S.C. § 306, an issue directed to the merits of a rejection in an *ex parte* reexamination proceeding is ultimately appealable to the Patent and Trademark Office Board of Patent Appeals and Interferences (the Board). On the other hand, pursuant to 37 CFR 1.181(a), a petition to the USPTO Director is the appropriate vehicle to resolve matters not subject to appeal.
>
> B) Pursuant to 37 CFR 1.3, complaints against examiners and other Office employees "must be made in correspondence separate from other papers" which are not directed to complaints against examiners and other Office employees.
>
> C) Pursuant to 37 CFR 1.4(c), different matters raised in a given proceeding must be raised in separate papers.

These points have not been persuasively addressed in the present request for reconsideration.

### A. The April 24, 2006 Papers Did Not Comply With 37 CFR 1.113(a) and 37 CFR 1.116

The April 24, 2006 papers purported to be a response directed to the outstanding final Office action dated February 24, 2006. Pursuant to 37 CFR 1.550(a), the present merged reexamination proceeding is to be conducted in accordance with sections 1.104 through 1.116 of Title 37 of the Code of Federal Regulations. Those regulations implement the provisions of 35 U.S.C § 132. 37 CFR 1.113(a) and 37 CFR 1.116 specifically require that a response to a final Office action address issues of patentability of the pending claims that are subject to an outstanding final rejection. The April 24, 2006 papers did contain material directed to the issue of the patentability of the claims of the patents being reexamined that are required to be resolved by appeal to the Board. However, in direct contravention of 37 CFR 1.113(a), the April 24, 2006

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[8] When the CRU has jurisdiction, as in the case of this merged proceeding, the CRU Director would approve and sign the letter accompanying returned papers.

[9] See MPEP § 2267.

[10] See 35 U.S.C. §§ 301-303.

papers also contained comments and documents that were not directed to the merits of the outstanding rejection (*i.e.*, not directed to appealable matters). These additional comments and documents were instead directed to matters of alleged misconduct on the part of Office employees/officials, and requested relief that is only available by way of petition to the USPTO Director, and not by an appeal to the Board.[11] Accordingly, the April 24, 2006 papers failed to comply with 37 CFR 1.113(a) and 37 CFR 1.116.

Petitioner is also referred to MPEP § 1201 which states, in pertinent part:

> Where the differences of opinion concern the denial of patent claims because of prior art or other patentability issues, the questions thereby raised are said to relate to the merits, and appeal procedure within the Office and to the courts has long been provided by statute (35 U.S.C. 134).
> The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Director of the U.S. Patent and Trademark Office (Director) should be carefully observed. The Board will not ordinarily hear a question that should be decided by the Director on petition, and the Director will not ordinarily entertain a petition where the question presented is a matter appealable to the Board.

In this instance, the entry of the additional comments and documents directed to matters of alleged misconduct on the part of Office employees/officials would inappropriately place materials unrelated to the merits of patentability before the examiner. Not only would entry of these materials confuse and overburden the record, but also these materials simply are not permitted to be, and will not be, made available for consideration by the examiner in determining the patentability of the claims.

B. The April 24, 2006 Papers Did Not Comply With 37 CFR 1.3

37 CFR 1.3, last sentence, prohibits the submission of "complaints against examiners and other employees" of the Office as a part of papers directed to other matters before the Office. The "returned" April 24, 2006 papers included complaints regarding the conduct of Office employees, and these complaints were submitted as part of papers directed to other matters, *i.e.*, the issues of claim patentability in this merged proceeding. Accordingly, the April 24, 2006 papers are barred by 37 CFR 1.3.

C. The April 24, 2006 Papers Did Not Comply With 37 CFR 1.4(c)

37 CFR 1.4(c) requires that, within a given proceeding, material directed to matters that will be considered by different branches within the Office be raised in separate papers. Yet, the April 24, 2006 papers included complaints regarding conduct together with material directed to the issues of claim patentability, notwithstanding that these separate issues are decided by different branches of the Office and resolved by different appellate review tribunals: (1) decision on petition to the USPTO Director and (2) consideration by the Primary Examiner which may ultimately be reviewed by the Board. Accordingly, the April 24, 2006 papers are barred by 37 CFR 1.4(c).

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[11] See, for example, the arguments at page 74-92 of the supplemental response filed April 24, 2006, that was to be disposed of if not "picked up" by the patent owner in accordance with the August 23, 2006 Decision on Petition. Note that even a single instance of an argument directed to matters that are not part of a proper response to a nonfinal action within the meaning of 37 CFR 1.111(b) would suffice to preclude entry of the entire supplemental response as lacking an entry right.

## III. Findings And Analysis With Respect To The Present Petition For Reconsideration

### A. Patent Owner's Position Is Fundamentally Flawed

Petitioner patent owner argues that there has been improper conduct on the part of Office employees. [12] Patent owner apparently also believes that it has evidence of bias specifically on the part of one or more examiners, [13] and that this evidence, as previously submitted on April 24, 2006, should not be barred from examiner consideration because it bears on issues of patentability. Thus, petitioner patent owner urges that 37 CFR 1.3 should not preclude presentation to the examiner of the material alleging bias (even where bias alleged on the part of the examiner is alleged), because bias bears on patentability issues. Similarly, patent owner argues that 37 CFR 1.4(c) is inapplicable, because evidence of bias addresses the same patentability issues as the remainder of patent owner's substantive reply. [14]

Initially, patent owner has not shown how bias will change whether a claim is patentable over a reference or not. If the patent owner believes that there is a bias that would influence an examiner involved, or another Office employee conducting the examination of the claims for patentability, the proper avenue to address that would be via a 37 CFR 1.182 petition to remove the examiner or other Office employee, not by presenting the allegation of bias to the accused examiner for determination. Also, patent owner's position **assumes** that the evidence presented by patent owner **actually establishes bias**. However, the question of whether the material presented by patent owner in support of patent owner's allegations of bias in fact establishes bias on the part of any Office personnel is an open question that has not yet been decided. Patent owner further assumes that the examiner is the appropriate Office employee to view alleged evidence of bias on the part of Office officials (and on the part of the examiner) in order to make a finding that bias in fact existed. However, the examiner's authority extends to making patentability determinations. The examiner does not exercise supervisory authority with respect to the alleged bias or misconduct on the part of other Office employees.

Pursuant to 35 U.S.C. § 306, an issue directed to the merits of a rejection in an *ex parte* reexamination proceeding is ultimately appealable to the Board, and then to the courts. All matters not subject to appeal to the Board under 35 U.S.C. § 306 are subject to resolution by way of petition under 37 CFR 1.181. Further, 37 CFR 1.3 prohibits complaints about employee conduct to be included within the same papers addressing the merits of patentability. Therefore, the proper avenue for obtaining review of an allegation of procedural impropriety, misconduct or bias on the part of Office personnel would be through petition to appropriate Office officials (as pointed out above). Any decision on such a petition that is adverse to patent owner would be subject to court review in the same manner as any other question of administrative procedure would be reviewed. [15] It is not reasonable to state that the evidence **alleged** to support bias on the part of Office officials, and/or on the part of the examiner, should be placed into the record of the present merged reexamination proceeding before the examiner for review and evaluation by the examiner as part of a patentability determination. Further, some of the allegations of bias are directed to the conduct of the examiner, making it far from clear that the examiner could objectively evaluate the allegations of the examiner's own bias. Yet, as noted above, patent owner appears to have raised the argument that the evidence of examiner bias should be forwarded to the examiner for consideration. Such consideration

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[12] See pages 3-4 of the present Petition for Reconsideration.

[13] See, for example, the headings on pages 4 and 7 of the present Petition for Reconsideration.

[14] See pages 7-9 of the present Petition for Reconsideration.

[15] Non-appealable subject matter reviewed by petition under 37 CFR 1.181 is subject to judicial review under the Administrative Procedures Act.

has, to date, been refused solely on the basis that patent owner has filed a single paper that conflated and intermingled these issues, rather than filing two separate papers that are each directed only to the area of the Office that would properly consider only that paper. [16]

By way of expansion on the above discussion, patent owner is reminded that patent examiners are Office personnel who are charged with evaluating evidence bearing on questions of patentability. In the present merged reexamination proceeding, the examiner's consideration of patentability is limited by 35 U.S.C. §§ 301 - 303 to a consideration of prior patents and printed publications. [17] Examiners are not charged with evaluating evidence of impropriety, misconduct or bias, by examiners or other Office personnel. Also, until the patent owner's evidence and allegations of misconduct are properly evaluated by the appropriate Office personnel, they cannot have any affect on action taken by the Office.

As a final point, patent owner is not being deprived of due process by a refusal to accept papers that co-mingle allegations of misconduct (and documents supporting those allegations) with papers that are directed to other matters. Papers raising issues of alleged misconduct, and documents proffered in support of such allegation, are admissible in the Office, and can properly be submitted for consideration by the Office, but only if they are provided in a manner that complies with the regulations.

B. 37 CFR 1.3 and 37 CFR 1.4(c) Each Precludes The Relief Requested By Petitioner Patent Owner

It is manifestly clear that both 37 CFR 1.3 and 37 CFR 1.4(c) each prohibit patent owner from co-mingling arguments directed to issues of the patentability of the claims with arguments and evidence in support of allegations of procedural impropriety and bias on the part of Office personnel. Those allegations are as yet unproven, and cannot be properly considered to presently establish any basis for reassignment of examining responsibilities. This is not the same as concluding that the regulations preclude **the presentation** of evidence of bias, as patent owner argues, [18] (notwithstanding that the Office has never taken such position [19]). The Office is not refusing to consider patent owner's alleged evidence, but simply is requiring that patent owner's evidence and allegations be presented in accordance with its rules which require them to be directed to the appropriate Office personnel for consideration and evaluation.

To the extent that the present petition again presents the allegation that 37 CFR 1.3 is inapplicable because patent owner has not violated decorum or been discourteous in this proceeding, [20] and also cites case law that is alleged to establish that 37 CFR 1.3 is inapplicable on the facts in this proceeding, patent owner is reminded that the August 23, 2006 Decision on Petition was in no manner based upon patent owner's conduct. Rather, 37 CFR 1.3 was applied because it requires that complaints of misconduct on the part of examiners and Office personnel "must be made in correspondence separate from other papers." [21] This language manifestly includes, as part of the class of "other papers" in which complaints of misconduct may not be

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[16] Given reexaminations that are conducted with special dispatch, it is puzzling that patent owner has not seen fit to comply with the relatively straightforward and simple requirements of the 37 CFR 1.3 and 1.4(c) by filing two separate papers, since by doing so, patent owner would have immediately placed before the proper areas of the Office both the conduct issues and the substantive patentability issues for consideration by the appropriate Office personnel.

[17] Extrinsic evidence explaining the content of prior patents and printed publications may be considered as well.

[18] See page 5 of the present petition, last sentence in the paragraph bridging pages 4 and 5.

[19] See for example, Decision Dismissing Petition dated August 23, 2006, section II(B), items 1 and 4.

[20] See the present petition, beginning at the bottom of page 4 and running through page 5.

[21] See Decision on Petition, August 23, 2006, page 7, first full paragraph.

raised, "papers directed to the merits of claim patentability in any proceeding in which the misconduct is alleged to have occurred."

Moreover, none of the case law cited by patent owner at page 5 of the present petition supports patent owner's position that 37 CFR 1.3 has been misapplied. Here, the Office is not prohibiting the patent owner from submitting evidence regarding its allegations; rather, the Office is simply directing material to the appropriate Office official for review of patent owner's complaint in accordance with the requirements established by 37 CFR 1.3 that employee conduct complaints "must be made in correspondence separate from other papers." None of the cases relied upon by patent owner demonstrate that the Office may not enforce the clear language of 37 CFR 1.3 by requiring papers containing complaints about the conduct of Office officials and personnel to be filed separately from other papers related to the merits of patentability.

Patent owner's argument that 37 CFR 1.4(c) should not prohibit examiner consideration of the merits of patent owner's arguments regarding the existence of bias is similarly fatally flawed. First, 37 CFR 1.4(c) does not preclude consideration of the merits of patent owner's allegations of bias, impropriety or misconduct on the part of Office officials and employees. The record does not show that the Office has taken the position that the allegations raised by patent owner cannot or will not be considered. 37 CFR 1.4(c) merely directs the orderly manner in which such allegations, and the evidence in support of such allegations, must be presented to the Office - for consideration by the proper Office officials. In this instance, 37 CFR 1.4(c) applies, because it requires that matters such as questions of bias or inappropriate conduct by Office personnel, which matters are appropriate for consideration by an Office official in one particular area of the Office, be submitted in a paper *separately* from papers containing substantive patentability issues, which are properly decided by a different Office official of employee in a different area of the Office. As pointed out above, the patent examiner is not the proper Office official to consider and rule on patent owner's allegations of bias, impropriety and misconduct; and thus, such allegations and materials supporting such allegations, are not proper for inclusion in the IFW record as a part of papers otherwise directed to patentability issues. The fact that the "examiner" is one of the employees that is accused of misconduct further highlights the appropriateness of the procedural safeguards provided by the rules. Clearly, the employee accused of alleged misconduct cannot be the official who will decide the issue. Moreover, the rule protects the integrity of the file history by separating employee complaints from the merits of examination.

Thus, 37 CFR 1.4(c) precludes entry of the papers submitted as a part of the June 23, 2006 petition, because the regulation properly requires that:

> matters bearing on the determination of patentability in this proceeding, and
>
> matters directed to a determination of the propriety of the allegations of misconduct, bias or impropriety on the part of Office officials and the examiner

be submitted in separate papers inasmuch as these issues are decided by different Office officials/employees in different areas of the Office.

C. 37 CFR 1.113(a) and 37 CFR 1.116 Preclude The Relief Requested By Patent Owner

37 CFR 1.111(a) and 37 CFR 1.116 provide that a response to a final Office action must, *inter alia*, specifically point out supposed errors in the examiner's action, and point out the specific distinctions believed to render the claims patentable over the prior art. The regulation does not

provide for "further statements" that address matters other than the issues of patentability raised in the outstanding Office action. The failure of the April 24, 2006 patent owner submission to comply with 37 CFR 1.113(a) and 37 CFR 1.116 was discussed at pages 6-7 of the Decision Dismissing Petition dated August 23, 2006. It was pointed out that the April 24, 2006 patent owner submission was not confined to responding to the nonfinal Office action as required by 37 CFR 1.111(b), but instead intermingled matter directed to other issues (the issues of alleged misconduct on the part of Office personnel).

In the present petition patent owner has not directly addressed this point. To the extent that patent owner's general argument that the allegations of misconduct are in fact relevant to the issues of patentability, those arguments are wholly unpersuasive for the reasons set forth in Section III (A) above. Therefore, it is again concluded that the August 23, 2006 Decision Dismissing Petition properly refused entry of the April 24, 2006 patent owner as being non-compliant with 37 CFR 1.113(a) and 37 CFR 1.116.

## CONCLUSION

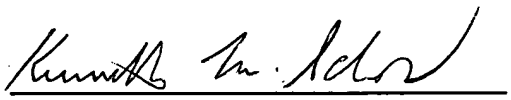
1. The October 23, 2006 patent owner petition is granted to the extent that the August 23, 2006 Decision Dismissing Petition has been fully reconsidered, and that the present decision will be designated as a final agency decision.

2. The October 23, 2006 patent owner petition is denied with respect to disturbing the holding of the August 23, 2006 Decision Dismissing Petition which refused to enter the papers attached to patent owner's June 23, 2006 Petition and which "returned" those papers.

3. A copy of this decision is being made of IFW record for the merged reexamination proceeding, and the decision will therefore appear in the IFW record of *ex parte* reexamination proceedings 90/006,533, 90/006,675 and 90/007,731.

4. Telephone inquiries with regard to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or, in his absence, to the undersigned at (571) 272-7710.

5. This decision is a final agency action within the meaning of 5 U.S.C. § 704.



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

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February 22, 2007