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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,676	06/24/2003	5438611		5438

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ANTONELLI, TERRY, STOUT & KRAUS, LLP
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ARLINGTON, VA 22209-9889

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED. 11/24/2003

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

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Paper No. __

Donald E. Stout (For Patent Owner)
Antonelli, Terry, Stout & Kraus
Suite 1800
1300 N. 17th Street
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
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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. 90/006,676 Filed: June 24, 2003 For: U.S. Patent No. 5,438,611	DECISION DISMISSING AND RETURNING PETITION UNDER 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 <u>dismissed</u>.

The petition paper <u>will not be entered</u> 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. 5,438,611 (hereinafter, the '611 patent), issued to Campana, Jr. et al., on August 1, 1995, from an application filed on May 23, 1994.

2. On April 17, 2003, a request for *inter partes* reexamination of the '611 patent was deposited in the Office by the third party requester. The '611 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 '611 patent, which was assigned control number 90/006,676.

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.

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
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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	:	DECISION GRANTING PETITION
Control No. 90/006,676	:	FOR EXTENSION OF TIME
Filed: June 24, 2003	:	
For: U.S. Patent No. 5,438,611	:	

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

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(For Patent Owner)

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(For Third Party Requester)

MAILED

AUG 23 2006

CENTRAL REEXAMINATION UNIT

In re Campana, Jr. et al
Ex Parte Reexamination Proceeding
Control No.: 90/006,676
Filed: June 24, 2003
For: U.S. Patent No. 5,438,611

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 5,438,611 ("the '472 patent") issued to Campana *et al* on April 29, 1997 from an application filed on May 18, 1995.

2. On June 24, 2003, a request for ex *parte* reexamination of the '472 patent was filed by a third party requester, and assigned control number 90/006,676 ("the '676 reexamination proceeding").

3. On September 3, 2003, the examiner's Order Granting *Ex Parte* Reexamination for the '676 reexamination proceeding was mailed.

[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.

4. Following prosecution on the patentability of the '472 patent claims, a nonfinal rejection Office action was issued in the merged reexamination proceeding on December 30, 2005.

5. 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.

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

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

8. 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.

9. 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 9 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 supplemental response was not entered into the record.

10. 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.

11. 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 30, 2005 Office action.

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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 '676 reexamination proceedings had previously been transferred from the Technology Center to the CRU.

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 response to the supplemental 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

[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.

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 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. [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 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. [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 December 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 December 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."

[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 supplemental 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 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 and the supplemental response attached to the

[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.

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 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. [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 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. [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 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

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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.

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" by being marked "closed" and "non-public" in the Image File Wrapper (IFW) of the '676 reexamination proceeding. 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. [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 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 proceeding 90/006,676.

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 14, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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William R. Wright
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Des Moines, IA 50309-4076

(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.: 90/006,676
Filed: June 24, 2003
For: U.S. Patent No. 5,438,611

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.

REVIEW OF SALIENT FACTS

1. U.S Patent number 5,438,611 ("the '611 patent") issued to Campana *et al* on August 1, 1995, from an application filed on May 23, 1994.

2. On June 24, 2003, a request for ex *parte* reexamination of the '611 patent was filed by a third party requester, and assigned control number 90/006,676 ("the '676 reexamination proceeding").

[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."

3. On September 3, 2003, an examiner's Order Granting *Ex Parte* Reexamination was mailed for the '676 reexamination proceeding.

4. On November 30, 2005, a nonfinal rejection Office action was issued in the '676 *ex parte* reexamination proceeding.

5. 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.

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

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

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

9. 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 <u>not</u> 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.

10. 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 proceeding.

11. 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 November 30, 2005 nonfinal Office action.

12. 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]

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

DECISION

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

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

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 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." [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

[7] When the CRU has jurisdiction, as in the case of this proceeding, the CRU Director would approve and sign the letter accompanying returned papers.
[8] See MPEP § 2267.

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 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 <u>not</u> 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 <u>must be raised in separate papers</u>.

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

<u>A. The April 28, 2006 Papers Did Not Comply With 37 CFR 1.111</u>

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 present 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 <u>also contained</u> 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.

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[9] See 35 U.S.C. §§ 301-303.

[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.

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 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. [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

[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.

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**. <u>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.</u> 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. <u>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.</u>

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 reexamination proceeding before the examiner for review and evaluation by the examiner <u>as part of a patentability determination</u>. 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 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

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[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.

[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.

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 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.

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

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. 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 reexamination proceeding, and the decision will therefore appear in the IFW record of *ex parte* reexamination proceeding 90/006,676.

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

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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 2005	:	For Requester
In re Campana, Jr. et al. *Ex Parte* Reexamination Proceeding Control No. 90/006,676 Filed: June 24, 2003 For: US Patent No.5,438,611	:	DECISION GRANTING PETITION

MAILED

JUN 14 2007

CENTRAL REEXAMINATION UNIT

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,
Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
90/006,677	06/24/2003	5479472		5442

20457 7590 11/24/2003

ANTONELLI, TERRY, STOUT & KRAUS, LLP
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/24/2003

AG

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

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Paper No. __

Donald E. Stout (For Patent Owner)
Antonelli, Terry, Stout & Kraus
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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
& GILCHRIST, P.A.
Suite 1401
Orlando, FL 32802

MAILED
NOV 24 2003
REEXAM UNIT

In re Campana, Jr. et al. Reexamination Proceeding Control No. 90/006,677 Filed: June 24, 2003 For: U.S. Patent No. 5,479,472	DECISION DISMISSING AND RETURNING PETITION UNDER 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 <u>dismissed</u>.

The petition paper <u>will not be entered</u> 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. 5,479,472 (hereinafter, the '472 patent), issued to Campana, Jr. et al., on December 26, 1995, from an application filed on May 20, 1991.

2. On April 17, 2003, a request for *inter partes* reexamination of the '472 patent was deposited in the Office by the third party requester. The '472 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 '472 patent, which was assigned control number 90/006,677.

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.

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\6677no.3pr

UNITED STATES PATENT AND TRADEMARK OFFICE

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Des Moines, IA 50309-4076

(For Patent Owner)

MAILED

AUG 23 2006

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.: 90/006,677
Filed: June 24, 2003
For: U.S. Patent No. 5,479,472

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 5,479,472 ("the '472 patent") issued to Campana *et al* on April 29, 1997 from an application filed on May 18, 1995.

2. On June 24, 2003, a request for ex *parte* reexamination of the '472 patent was filed by a third party requester, and assigned control number 90/006,677 ("the '677 reexamination proceeding").

3. On September 3, 2003, the examiner's Order Granting *Ex Parte* Reexamination for the '677 reexamination proceeding was mailed.

[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.

4. Following prosecution on the patentability of the '472 patent claims, a nonfinal rejection Office action was issued in the merged reexamination proceeding on November 30, 2005.

5. 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.

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

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

8. 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.

9. 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 9 above without consideration on the merits. [3] The return was based on the grounds that the papers filed were improper because they were <u>not</u> 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.

10. 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.

11. 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 November 30, 2005 Office action.

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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 '677 reexamination proceedings had previously been transferred from the Technology Center to the CRU.

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 supplemental response, and patent owner has

[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.

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 November 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. [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 supplemental 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 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 and the supplemental response attached to the

[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.

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 November 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. [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 supplemental 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 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

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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.

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" by being marked "closed" and "non-public" in the Image File Wrapper (IFW) of the '677 reexamination proceeding. 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 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 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 proceeding 90/006,677.

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

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(For Patent Owner)

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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.: 90/006,677
Filed: June 24, 2003
For: U.S. Patent No. 5,479,472

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.

REVIEW OF SALIENT FACTS

1. U.S Patent number 5,479,472 ("the '472 patent") issued to Campana *et al* on December 26, 1995, from an application filed on May 20, 1991.

2. On June 24, 2003, a request for ex *parte* reexamination of the '472 patent was filed by a third party requester, and assigned control number 90/006,677 ("the '677 reexamination proceeding").

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[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."

3. On September 3, 2003, an examiner's Order Granting *Ex Parte* Reexamination was mailed for the '677 reexamination proceeding.

4. On November 30, 2005, a nonfinal rejection Office action was issued in the '677 *ex parte* reexamination proceeding.

5. 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.

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

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

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

9. 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 <u>not</u> 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.

10. 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 proceeding.

11. 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 November 30, 2005 nonfinal Office action.

12. 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]

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

DECISION

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

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

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 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." [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

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

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 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 <u>not</u> 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 <u>must be raised in separate papers</u>.

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

<u>A. The April 28, 2006 Papers Did Not Comply With 37 CFR 1.111</u>

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 present 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 <u>also contained</u> 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.

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[8] See MPEP § 2267.

[9] See 35 U.S.C. §§ 301-303.

[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

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 the present 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. [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

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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.

[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.

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**. <u>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.</u> 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. <u>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.</u>

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 reexamination proceeding before the examiner for review and evaluation by the examiner <u>as part of a patentability determination</u>. 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 reexamination proceeding, the examiner's consideration of

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[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.

[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.

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 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

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

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. 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 reexamination proceeding, and the decision will therefore appear in the IFW record of *ex parte* reexamination proceeding 90/006,677.

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

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

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED 11/24/2003

#7

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

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Paper No. __

Donald E. Stout (For Patent Owner)
Antonelli, Terry, Stout & Kraus
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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
& GILCHRIST, P.A.
Suite 1401
Orlando, FL 32802

MAILED
NOV 24 2003
REEXAM UNIT

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

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."

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

> 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.

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.

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).

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\6678no.3pr

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.
90/006,678 and 90/006491	06/24/2003	5625670		5441

803 7590 05/26/2004

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/26/2004

#19

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

90006491.052604

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
www.uspto.gov

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(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

90/006491 and

REEXAMINATION CONTROL NO. *90/006,678*.

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)).

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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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.: 90/006,491 Filed: December 26, 2002 For: U.S. Patent 5,625,670	)))))	DECISION *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS
In re Campana et al. Reexamination Proceeding Control No.: 90/006,678 Filed: June 24, 2003 For: U.S. Patent 5,625,670	)))))	

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.

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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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. 90/006,678
Filed: June 24, 2003
For: U.S. Patent No. 5,625,670

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

: 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 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 <u>the grant of a second extension of time</u>.

DECISION

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

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 <u>dismissed as moot</u>, 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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ms

William R. Wright
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(For Patent Owner)

Novak Druce & Quigg LLP
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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.: 90/006,491
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 <u>not</u> 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."

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[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:

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[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
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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 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 90/006678

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
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(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

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COMMISSIONER FOR PATENTS
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ALEXANDRIA, VA 22313-1450
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William R. Wright
Sturm & Fix LLP
206 Sixth Avenue
Des Moines, IA 50309-4076

(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.: 90/006,491
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 <u>not</u> 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 <u>must be raised in separate papers</u>.

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.

<u>A. The April 28, 2006 Papers Did Not Comply With 37 CFR 1.111</u>

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 <u>also contained</u> 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).

[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

[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
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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO.
90/006,679	06/24/2003	5631946		5440

803 7590 11/24/2003

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/24/2003

#6

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

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Paper No. __

Donald E. Stout (For Patent Owner)
Antonelli, Terry, Stout & Kraus
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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
& GILCHRIST, P.A.
Suite 1401
Orlando, FL 32802

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REEXAM UNIT

In re Campana, Jr. et al. Reexamination Proceeding Control No. 90/006,679 Filed: June 24, 2003 For: U.S. Patent No. 5,631,946	DECISION DISMISSING AND RETURNING PETITION UNDER 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.

REVIEW OF FACTS

1. U.S. Patent No. 5,631,946 (hereinafter, the '946 patent), issued to Campana, Jr. et al., on May 20, 1997, from an application filed on May 16, 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 90/006,492.

3. On April 17, 2003, a request for *inter partes* reexamination of the '946 patent was deposited in the Office by the third party requester. The '946 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 '946 patent, which was assigned control number 90/006,679.

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."

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

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.

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.

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).

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\6679no.3pr

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.
90/006,679 and 90/006492	06/24/2003	5631946		5440

803 7590 05/26/2004

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

EXAMINER

ART UNIT	PAPER NUMBER
	#19

DATE MAILED: 05/26/2004

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

90006679 .052604

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
www.uspto.gov

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

David L. Stewart
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255 S. Orange Avenue
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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
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.: 90/006,492 Filed: December 26, 2002 For: U.S. Patent 5,631,946	)))))	DECISION *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS
In re Campana et al. Reexamination Proceeding Control No.: 90/006,679 Filed: June 24, 2003 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

90006679 .052601

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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 <u>not</u> 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

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August 10, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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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.: 90/006,492
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 <u>not</u> 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 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." [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

[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, <u>but only if</u> they are provided in a manner that complies with the regulations.

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

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

2/23/07
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,680	06/24/2003	5819172		5439

803 7590 11/24/2003

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/24/2003

#7

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Paper No. __

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

(For Patent Owner)

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

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

(For Requester)

MAILED
NOV 24 2003
REEXAM UNIT

In re Campana, Jr. et al. Reexamination Proceeding Control No. 90/006,680 Filed: June 24, 2003 For: U.S. Patent No. 5,819,172	DECISION DISMISSING AND RETURNING PETITION UNDER 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 <u>dismissed</u>.

The petition paper <u>will not be entered</u> 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. 5,819,172 (hereinafter, the '172 patent), issued to Campana, Jr. et al., on October 6, 1998, from an application filed on April 23, 1997.

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 90/006,493.

3. On April 17, 2003, a request for *inter partes* reexamination of the '172 patent was deposited in the Office by the third party requester. The '172 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 '172 patent, which was assigned control number 90/006,680.

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."

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

> 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.

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.

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).

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\6680no.3pr

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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

EXAMINER

ART UNIT	PAPER NUMBER

803 7590 05/26/2004

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

DATE MAILED: 05/26/2004

#19

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cc: Third Party Requester, as attached

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(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)).

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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	)))))	DECISION *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS
In re Campana et al. Reexamination Proceeding Control No.: 90/006,680 Filed: June 24, 2003 For: U.S. Patent 5,819,172	)))))	

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

90006493 . 052604

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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

Commissioner for Patents
United States Patent and Trademark Office
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(For Patent Owner)

MAILED
MAR 0 1 2006
REEXAM UNIT

Donald J. Quigg
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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

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MAILED

AUG 23 2006

CENTRAL REEXAMINATION UNIT

In re Campana, Jr. et al
Ex Parte Reexamination Proceeding
Control No.: 90/006,493
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]

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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 '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 <u>response</u> 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. **<u>All</u> 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*

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[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

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February 22, 2007

2/23/07
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,680	06/24/2003	5819172		5439

803 7590 06/14/2007

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/14/2007

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6/15/07

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 90/006493

PATENT NO. 5,819,172

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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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 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	:	

MAILED

JUN 14 2007

CENTRAL REEXAMINATION UNIT

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
90/006,681	06/24/2003	6067451		5437

803 7590 11/24/2003

STURM & FIX LLP
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DES MOINES, IA 50309-4076

EXAMINER

ART UNIT	PAPER NUMBER

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Paper No. __

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

(For Patent Owner)

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

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

(For Requester)

MAILED
NOV 24 2003
REEXAM UNIT

In re Campana, Jr. et al. Reexamination Proceeding Control No. 90/006,681 Filed: June 24, 2003 For: U.S. Patent No. 6,067,451	DECISION DISMISSING AND RETURNING PETITION UNDER 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.

REVIEW OF FACTS

1. U.S. Patent No. 6,067,451 (hereinafter, the '451 patent), issued to Campana, Jr. et al., on May 23, 2000, from an application filed on September 28, 1998.

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 90/006,494.

3. On April 17, 2003, a request for *inter partes* reexamination of the '451 patent was deposited in the Office by the third party requester. The '451 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 '451 patent, which was assigned control number 90/006,681.

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."

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

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.

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.

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).

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\6681no.3pr

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,681 and 90/006494	06/24/2003	6067451		5437

803 7590 05/26/2004

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/26/2004 #19

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90006494 052604

cc: Third Party Requester, as attached.

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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)).

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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.: 90/006,494 Filed: December 26, 2002 For: U.S. Patent 6,067,451	)))))	DECISION *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS
In re Campana et al. Reexamination Proceeding Control No.: 90/006,681 Filed: June 24, 2003 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

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Commissioner for Patents
United States Patent and Trademark Office
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(For Patent Owner)

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MAR 0 1 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. 90/006,494
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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(For Third Party Requester)

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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.

---

[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.

---

[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. **<u>All</u> 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 Patent Owner)

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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 <u>not</u> 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 <u>must be raised in separate papers</u>.

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

[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).

[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

2/23/07
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte Campana et al.

Appeal No. 2008-1116
Reexamination Control Nos. 90/006,494,
90/006,681 and 90/007,726
Patent No. 6,067,451

Mailed: June 24, 2008

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

Counsel for Patent Owner:
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United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
90/005,942	03/01/2001	5288393	4215-4000	9918

7590 04/19/2004

Gregory F Wirzbicki
C/O Ingrid Impink Unocal Corporation
1150 Connecticut Avenue N W
Suite 1025
Washington, DC 20036

EXAMINER

ART UNIT	PAPER NUMBER
	34

DATE MAILED 04/19/2004

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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Mailed: CST

Paper No. 34

Gregory F. Wirzbicki C/O Ingrid Impink Unocal Corporation 1150 Connecticut Avenue, N.W. Suite 1025 Washington, DC 20036	(for Patent Owner)
Michael S. Marcus Morgan & Finnegan, L.L.P. 1775 Eye Street, N.W., Suite 400 Washington, DC 20006	(for Third Party Requester)
In re Jessup et al Reexamination Proceeding Control No. 90/005,942 Filed: March 1, 2001 For: U.S. Patent 5,288,393	
In re Jessup et al Reexamination Proceeding Control No. 90/006,295 Filed: May 20, 2002 For: U.S. Patent 5,288,393	**DECISION MERGING REEXAMINATION PROCEEDINGS**
In re Jessup et al Reexamination Proceeding Control No. 90/006,683 Filed: June 25, 2003 For: U.S. Patent 5,288,393	

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

BACKGROUND

1. United States Patent 5,288,393, issued February 22, 1994, is the subject of Reexamination Control Nos. 90/005,942, 90/006,295 and 90/006,683.

2. A first request for reexamination, assigned Reexamination Control No. 90/005,942 ('5942), was filed March 1, 2001 by Michael S. Marcus of Morgan & Finnegan, LLP. The request urged that a substantial new question of patentability was raised by the teachings of (a) the GM RFG specifications, in view of the EPA proposed RVP limits; (b) Auto/Oil unleaded gasoline Fuel 1111, in view of the GM RFG specifications and the EPA proposed RVP limits; (c) CRC unleaded gasoline Fuel No. 6, in view of the GM RFG specifications.

3. Reexamination was ordered for '5942 on May 22, 2001.

4. A first Office action for '5942 was mailed on February 12, 2002.

5. Patent owner responded to the first Office action on April 15, 2002 (certificate of mailing April 11, 2002).

6. A second request for reexamination, assigned Reexamination Control No. 90/006,295 ('6295), was filed May 20, 2002 by Michael S. Marcus of Morgan & Finnegan, LLP. The request urged that a substantial new question of patentability was raised by the teachings of (a) SAE Report No. 730836, Fuel C; (b) SAE Report No. 730836, Fuel C, in view of the 1984 Annual Book of ASTM Standards; (c) SAE Report No. 730836, Fuel C, in view of the 1984 Annual Book of ASTM Standards and U.S. Patent 2,818,417 to Brown et al; (d) Fuel 14 of CRC Report No. 461, in view of the 1984 Annual Book of ASTM Standards; (e) Fuel F-1 of SAE Report No. 770811, in view of the 1984 Annual Book of ASTM Standards.

7. A petition to void the '6295 proceeding (for lack of service on patent owner) was filed by the patent owner on June 4, 2002.

8. A "Notice of Service of Replacement Copy" of the present reexamination was then filed by the requester on June 7, 2002.

9. Also on June 7, 2002, the patent owner filed a petition to withdraw patent owner's June 4, 2002 petition.

10. A decision was issued by a Senior Legal Advisor of the Office of Patent Legal Administration on June 14, 2002 returning the two patent owner petitions and retaining the requester paper in the record as an information paper.

11. A petition under 37 CFR 1.182 to deny the second reexamination request was filed by the patent owner on June 24, 2002.

12. A decision was issued by a Senior Legal Advisor of the Office of Patent Legal Administration on July 3, 2002 returning the petition of June 24, 2002.

13. Reexamination was ordered for '6295 on July 3, 2002.

14. A Decision Merging Reexamination Control Nos. 90/005,942 and 90/006,295 was mailed on September 20, 2002.

15. A non-final Office action for the merged proceeding was mailed on December 20, 2002.

16. Patent owner responded to the non-final Office action on March 13, 2003 by filing a Notice of Appeal, an Appeal Brief and a Declaration under 37 CFR 1.132.

17. A third request for reexamination, assigned Reexamination Control No. 90/006,683 ('6683) was filed June 25, 2003 by Michael S. Marcus of Morgan & Finnegan, LLP. The request urged that a substantial new question of patentability was raised by the teachings of (a) the January 17, 1972 Oil and Gas Journal publication describing GM's proposal for reduced emission motor gasoline ("GM-1"), either alone or in view of an August 1987 Notice of Proposed Rule Making published by the EPA concerning, *inter alia*, RVP limits for reduced emission motor gasoline ("the EPA RVP limits") and (b) the October 2, 1972 Oil and Gas Journal publication dscribing a second GM proposal for reduced emissions motor gasoline ("GM-2"), either alone or in view of the May 1973 Adams API publication discussing GM's proposals and/or the EPA RVP limits.

18. Reexamination was ordered for '6683 on September 10, 2003.

DISCUSSION

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

> If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* proceeding has not been terminated, the *ex parte* reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570.

As noted in the above review of facts, reexamination has been ordered in each of the above reexamination proceedings. Accordingly, merger of the proceedings under 37 C.F.R. 1.565(c) is appropriate. MPEP 2283 further sets forth:

> If the second request is based upon essentially the *same* patents or publications as in the first request or on patents or printed publications which raise essentially the same issues as those raised in the first

request, and if reexamination is ordered, the examination of the merged proceeding will continue at the point reached in the first reexamination proceeding. If, however, *new* patents or printed publications are presented in the second request which raise different questions than those raised in the first request, then prosecution in the merged reexamination proceeding will be reopened, if applicable, to the extent necessary to fully treat the questions raised.

DECISION

I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. 1.565(c), the 90/005,942, 90/006,295 and 90/006,683 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. Since the claims are the same in both files, a "housekeeping amendment" is NOT needed. See MPEP 2283, "Merger of Reexaminations."

III. CONDUCT OF MERGED PROCEEDING

The reexamination files shall be forwarded to the examiner for consideration of the Request for Reexamination in the '6683 reexamination proceeding, as well as consideration of the Appeal Brief and Declaration under 37 CFR 1.132, submitted March 13, 2003 in the '5942 and '6295 merged reexamination proceeding.

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for all files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, **filed in triplicate**, each bearing a signature and identifying data for all files, for entry into each file.

All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control Nos. 90/005,942, 90/006,295 and 90/006,683 as:

Gregory F. Wirzbicki
C/O Ingrid Impink
Unocal Corporation
1150 Connecticut Avenue, NW
Suite 1025
Washington, D.C. 20036

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control Nos. 90/005,942, 90/006,295 and 90/006,683 as:

Michael S. Marcus
Morgan & Finnegan, L.L.P.
1775 Eye Street, N.W., Suite 400
Washington, DC 20006

Also, until further notice, courtesy copies of all correspondence from the USPTO will be mailed to the California Attorney General's Office at the following address:

Marc N. Melnick
Deputy Attorney General
California Attorney General's Office
1515 Clay Street, 20th Floor
P.O. Box 70550
Oakland, CA 94612-1413.

CONCLUSION

Reexamination Control Nos. 90/005,942, 90/006,295 and 90/006,683 are merged. The merged reexamination files are being forwarded to the examiner for preparation of an Office action, to be issued in due course.

JMStone

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

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8/3/05

CST

3M Innovative Properties Company
PO Box 33427
St. Paul, MN 55133-3427

(for Patent Owner)

In re Ho et al
Reexamination Proceeding
Control No. 90/006,686
Filed: June 27, 2003
For: U.S. Patent 6,258,918

DECISION RETURNING IMPROPER PAPER

Jean Lown, attorney for patent owner, has submitted a paper dated July 19, 2005. A Notice of Intent to Issue Ex Parte Reexamination Certificate, "NIRC", was mailed on June 21, 2005.

MPE 2287 states:

> A NIRC informs the patent owner and any third party requester that the reexamination proceeding has been terminated. The rules do not provide for an amendment to be filed in a reexamination proceeding after prosecution has been terminated. The provisions of 37 CFR 1.312 do not apply in reexamination. Any amendment, information disclosure statement, or other paper related to the merits of the reexamination proceeding filed after prosecution has been terminated must be accompanied by a petition under 37 CFR 1.182 to have the amendment considered.

As the Notice of Intent to Issue Ex Parte Reexamination Certificate, "NIRC", was mailed on June 21, 2005, and as the paper submitted July 19, 2005 has not been accompanied by a petition under 37 CFR 1.182, the paper submitted July 19, 2005 will not be made of record in the electronic reexamination file. The decision returning the improper paper, however, will be made of record in the electronic reexamination file.

JMStone

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

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DUANE MORRIS LLP
3200 SOUTHWEST FREEWAY
SUITE 3150
HOUSTON, TX 77027

(For Patent Owner)

COPY MAILED

MAR 0 2 2005

OFFICE OF PETITIONS

In re Richard et al
Reexamination Proceeding
Control No. 90/006,687
Filed: June 30, 2003
For: U.S. Patent No. 6,263,972

DECISION GRANTING PETITION
UNDER 37 CFR 1.181

This is a decision on the February 17, 2005 patent owner's "Petition to Accept Late Papers," which is being treated as a petition under 37 CFR 1.181 (no fee required).

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

The petition under 37 CFR 1.181 is **granted**.

ISSUE

Petitioner herein (Mr. Greg R. Maze) requests that the response to the July 1, 2004 Office action be accepted as having been filed on August 13, 2004. In support, petitioner has proffered a copy of a stamped postcard which acknowledges receipt on August 13, 2004 by the U.S. Patent and Trademark Office (USPTO) of the following items: "Transmittal, Amendment, Certificate of Mailing, Postcard," for the above-identified reexamination proceeding. Petitioner states that it was learned in a telephone conversation with the Examiner on February 11, 2005 that the response filed on August 13, 2004 was not received by the USPTO.

DECISION ON PETITION

The response (amendment) acknowledged as having been received in the USPTO on August 13, 2004 is not of record in the instant reexamination proceeding and to date has not been located. However, MPEP 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 USPTO of all the items listed thereon on the date stamped thereon by the USPTO." Accordingly, it is concluded that the response (amendment) was timely received in the USPTO but misplaced after receipt thereof.

In view of the above, the response to the July 1, 2004 Office action will be accepted as having been received in the USPTO on August 13, 2004.

CONCLUSION

1. The petition under 37 CFR 1.181 is **granted**.

2. The reexamination matter is being returned to Technology Center AU 3672 for action, in due course, on the copy of the response filed with the instant petition.

3. Any further communications as to the merits of the reexamination proceeding should be directed to Examiner William P. Neuder, in Technology Center AU 3672, who can be reached at (703) 308-2150.

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

March 2005
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Paper No. 6 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	: DECISION
Control No. 90/006,688	: GRANTING-IN-PART
Filed: June 30, 2003	: PETITION
For: U.S. Patent No. 5,887,243	:

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, 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.

(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. 5,887,243 issued on March 23, 1999.

2. A request for reexamination, assigned control No. 90/006,688, was filed by a third party requester on June 30, 2003.

3. On July 9, 2003, 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.

4. A decision on the '6,688 request for reexamination has not yet been rendered.

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."

Accordingly, the present petition paper does not have an entry right under the reexamination rules.

A right of entry for the petition papers would require a waiver of the above-quoted provision of 37 CFR 1.530(a), such a waiver being available only pursuant to 37 CFR 1.183.[2] Accordingly, the 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:

---

[1] Two aspects of 37 CFR 1.182 relief will be addressed separately.

[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)."

> "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 1.530. 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 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.

II. PETITION UNDER 37 CFR 1.59(b)

In the second page of the petition, it is requested that the Commissioner 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.

(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."

---

[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).

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

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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.

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 [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.

(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 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.

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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.

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 <u>granted</u> 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.[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.

In the paragraph bridging pages 12 and 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

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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.

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 90/006,563 was filed by the third party requester on March 14, 2003, a request for reexamination in Control Number 90/006,536 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 '6536 proceeding, and June 10, 2003, in the '6563 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 <u>timely</u> 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 **promptly prepare a decision on the request for reexamination**.

8. Any questions regarding <u>this decision</u> 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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UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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Paper No. 9

HUNTON & WILLIAMS (For Patent Owner)
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MAILED
SEP 11 2003
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Enclosure: August 11, 2003, third party requester petition and attachments.

Harvey et al	:
Reexamination Proceeding	: DECISION
Control No. 90/006,688	: GRANTING-IN-PART
Filed: June 30, 2003	: PETITION
For: U.S. Patent No. 5,887,243	:

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. 5,887,243 issued on March 23, 1999.

2. A request for reexamination, assigned control No. 90/006,688, was filed by a third party requester on June 30, 2003.

3. On July 9, 2003, 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 informs the Office that it is not a statement under 37 CFR 1.530.

4. 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 otherwise held in abeyance.

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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.

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.

5. 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.

6. 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.

7. A decision on the '6,688 request for reexamination has not yet been rendered.

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)...[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."

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 1.530(a)) 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 1.530(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."

Accordingly, the patent owner opposition petition paper also does not have an entry right under the reexamination rules. Thus, 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 circumstances" referred to in the patent owner's notification is

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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.

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 8 and 9 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 public. Thus, at the very least there exists a conflict of

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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).

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 <u>dismissed</u>.

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."

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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.

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.

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

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[12] Requester petition at 13, 14.

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 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."

---

[13] And a certificate of service of the petitions (that accompanied the filing of the petitions) *prima facie* establishes that requester was served.

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.

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.

---

[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 the present reexamination proceeding.**

5. The reexamination file is being returned to Technology Center 2600 for forwarding to the examiner who will promptly prepare a decision on the request for reexamination, and otherwise take 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 <u>this decision</u> should be directed to Kenneth M. Schor at (703) 308-6710.

8. 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

September 11, 2003
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Paper No. 12 AWR

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(For Patent Owner)

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NOV 0 7 2003
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WOODARD, EMHARDT, NAUGHTON,
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(For Third Party Requester)

Harvey et al
Reexamination Proceeding
Control No. 90/006,688
Filed: June 30, 2003
For: U.S. Patent No. 5,887,243

: DECISION
: GRANTING
: PETITION

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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OCT 21 2005

REEXAM UNIT

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1751 Pinnacle Drive
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(For Patent Owner)

Arthur J. Usher, IV
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(For Requester)

Nina L. Medlock
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(For Petitioner)

In re John C. Harvey et al.	:	DECISION DISMISSING
Reexamination Proceeding	:	PETITION AND SEALING
Control No.: 90/006,688	:	PAPERS, AND
Filed: June 30, 2003	:	ORDER *RE* SHOWING
For: U.S. Patent No. 5,887,243	:	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.

(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 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. 5,887,243 (hereinafter, the '243 patent) issued on March 23, 1999.

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.

4. On June 30, 2003 Thomson, Inc. filed a request for reexamination of the '243 patent. The request for reexamination was assigned control number 90/006,688, and it was granted.

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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).

5. On August 22, 2005, PMC filed an IDS in reexamination control number 90/006,688.

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.[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

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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).

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 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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(For Non-Party Scientific-Atlanta, Inc.)

In re John C. Harvey et al.	:	
Reexamination Proceeding	:	DECISION DISMISSING
Control No.: 90/006,688	:	PETITION AND UNSEALING
Filed: June 30, 2003	:	PAPERS
For: U.S. Patent No. 5,887,243	:	

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. 5,887,243 (hereinafter, the '243 patent) issued on March 23, 1999.

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 June 30, 2003 Thomson, Inc. filed a request for reexamination of the '243 patent. Reexamination control number 90/006,688 was assigned to the proceeding, and the request for reexamination was granted.

5. On August 22, 2005, PMC filed an information disclosure statement (IDS) in reexamination control number 90/006,688.

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 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 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'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

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March 29, 2006

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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HUNTLON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K Street N.W.
Suite 1200
Washington, DC 20006-1109

(For Patent Owner)

MAILED
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. 90/006,688
Filed: June 30, 2003
For: US Patent No. 5,887,243

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. 5,887,243 issued on March 23, 1999.

2. A request was filed by a third party requester for reexamination of US Patent No. . 5,887,243 on June 30, 2003.

3. The Order granting reexamination is dated September 23, 2003.

4. A non-final Office action was mailed on May 16, 2005.

5. The patent owner response was received on July 18, 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. 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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JAN 03 2006

REEXAM UNIT

IRELL & MANELLA LLP (For Patent Owner)
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LOS ANGELES CA 90067

KEITH V. ROCKEY (For Third Party Requester)
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311 SOUTH WACKER DRIVE, 53RD FLOOR
CHICAGO, ILLINOIS 60606-6630

In re Reissue Application of	:	
Reid et al.	:	
Application No. 11/264,813	:	
Filed: November 1, 2005	:	
For: U.S. Patent No. 6,074,544	:	DECISION
	:	TO MERGE
In re Novellus Systems, Inc.	:	REISSUE AND
Reexamination Proceeding	:	REEXAMINATION
Control No. 90/006,689	:	PROCEEDINGS
Filed: July 1, 2003	:	
For: U.S. Patent No. 6,074,544	:	

This is a decision on the November 1, 2005 patent owner petition under 37 CFR 1.182, to merge the above-captioned reissue and reexamination proceedings.

The petition fee for a petition under 37 CFR 1.182 is $400.00. See 37 CFR 1.17(f). The petition fee of $400.00 is being charged to Deposit Account No. 09-0946 pursuant to the authorization provided in the last paragraph of the petition.

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

REVIEW OF FACTS

1. U.S. patent No. 6,074,544 issued on June 13, 2000, with 7 claims.

2. A request for reexamination was filed by a third party requester on July 1, 2003, and was assigned control No. 90/006,689 (hereinafter, the '6689 proceeding).

3. Reexamination was ordered for the '6689 reexamination proceeding on September 15, 2003.

4. An application for reissue, assigned application No. 11/264,813, was filed by the assignee on November 1, 2005.

5. On November 1, 2005, a patent owner notice of appeal pursuant to 37 CFR 41.02(b)(1) was filed in the '6689 proceeding.

6. Also on November 1, 2005, a patent owner Notice of Concurrent Proceedings under 37 CFR 1.565(a) was filed in the '6689 proceeding on.

7. Also on November 1, 2005, the patent owner filed the instant petition under 37 CFR 1.182, to merge the above-captioned reissue and reexamination proceedings.

8. Notification of the filing of the reissue application has not yet been published in the *Official Gazette*.

DISCUSSION REGARDING MERGER

Under 37 CFR 1.565(d):

> "If a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings."

As evidenced by the above review of facts, reissue application No. 11/264,813 and reexamination control No. 90/006,689 are currently pending. Since the order to reexamine has been mailed in the reexamination proceeding, a decision under 37 CFR 1.565(d) is timely.

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

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

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

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

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

II. Requirement for Same Amendments in Both Proceedings

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

2. A review of the reexamination file for reexamination control No. 90/006,689 shows that original patent claims 1-7 are present; claim 1 has been amended in the '6689 proceeding and additionally, new claims 8-204 have been added in the '6689 proceeding. In the '6689 proceeding, claims 1-204 have been rejected. A review of reissue application No. 11/264,183 shows that original patent claims 1-7 are present; claim 1 has been amended in the reissue application. Additionally, new claim 8 has been added in the reissue application. **Accordingly, the claims are not identical in both proceedings.**

   An appropriate housekeeping amendment is required within <u>ONE (1) MONTH</u> of this decision placing the same amendments in both cases, specifically, Application No. 11/264,813 and Reexamination Control Number 90/006,689. The response to the requirement must be <u>limited to</u> placing the same amendments in all cases, and patent owner must **not** address any issue of patentability in the housekeeping amendment. It is to be noted that, pursuant to MPEP 2285, amendments in a merged proceeding for a reissue and reexamination are submitted in accordance with the reissue practice under 37 CFR 1.173.

III. <u>Conduct of the Merged Reissue Application Examination and Reexamination Proceeding</u>

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

2. In the event that a housekeeping amendment is not timely submitted, any claim which does not contain identical text in both proceedings should be rejected under 35 U.S.C. 112, paragraph 2, as being indefinite as to the content of the claims, and thus failing to particularly point out the invention.

3. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. 305 relating to the conduct of *ex parte* reexamination proceedings, the merged examination will

be conducted on the basis of the rules relating to the broader, reissue-application examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. **However, periods of response should be set at TWO (2) months to comply with the statutory requirement for special dispatch in reexamination (35 U.S.C. 305).**

4. Each Office action issued by the examiner will take the form of a *single action* which jointly applies to the reissue application and the reexamination proceeding. Each action will contain identifying data *for both of the cases*, i.e, the reissue application and the reexamination proceeding, and each action will be entered into the file history for both files (which will be maintained as separate files).

5. Any response by the applicant/patent owner must consist of a single response, with two copies being filed for entry into the file history for 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 a reissue application. Accordingly, clean copies of the amended claims are not required, *and such clean copies are not to be submitted.* Instead, pursuant to 37 CFR 1.173(b)(2), amendments are to be presented via markings pursuant to 37 CFR 1.173(d), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.173(g), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the

date of filing the reissue application. *Amendments are not to be made relative to previous amendments*. Thus, for all amendments, all words not appearing in the *patent* are always underlined, and only words being deleted from the *patent* appear in brackets.

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

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

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

10. If the applicant/patent owner fails to file a timely and appropriate response to any Office action: The merged proceeding will be dissolved, and the reissue application will be held abandoned. The reexamination prosecution will be terminated, and a reexamination certificate under 37 CFR 1.570 will be issued in accordance with the last action of the Office, unless further action in the reexamination proceeding is needed as a result of the difference in the rules relating to reexamination and reissue proceedings. If further action in the reexamination proceeding is needed, any grounds of rejection which are not applicable under reexamination would be withdrawn (e.g., based on public use or on sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner, upon dissolution of the merged

proceeding. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper 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.

IV. Waiver of the Two Month Delay Period for the Reissue Application

MPEP 1441 ("Two-Month Delay Period") provides as follows:

> "Generally, a reissue application will not be acted on sooner than 2 months after announcement of the filing of the reissue has appeared in the *Official Gazette*. The 2-month delay is provided in order that members of the public may have time to review the reissue application and submit pertinent information to the Office before the examiner's action. The pertinent information is submitted in the form of a protest under 37 CFR 1.291(a)."

In the present instance, once the reissue application is announced in the *Official Gazette*, action would not be taken by the Office for the reissue application until two months from the announcement date, and action in the copending reexamination proceeding would be delayed accordingly. Waiver of the 2-month delay provision of MPEP 1441 is appropriate in view of the facts and circumstances in the present instance, taken with the statutory requirement that the '6689 reexamination proceeding be conducted with special dispatch within the Office, pursuant to 35 U.S.C. 305. The two-month delay period is therefore waived under 37 CR 1.182, and the present merger decision is being issued at this time.

The present action taken by the Office does not close

or remove the public's opportunity to protest the reissue application. Should a protest be filed in this application within two months from the date of the *Official Gazette* announcement, the examiner is instructed to proceed according to the provisions of 37 CFR 1.291, as well as MPEP §§ 1901.04 and 1901.06.

In the event that an early determination of allowable/patentable subject matter is made by the examiner and made known to the patent owner/applicant, the merged proceeding would be retained in the Technology Center pending expiration of the MPEP 1441 two-month delay period, prior to the mailing of a formal Notice of Allowance.

CONCLUSION

1. The patent owner petition for merger is granted. Reissue application No. 11/264,813 and reexamination control No. 90/006,689 **are merged** into a single proceeding.

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

3. Jurisdiction over the reissue and reexamination proceedings is being forwarded to the examiner via the Director of Technology Center 1700. The examiner **should not issue an Office action for the present merged proceeding of the reissue and reexamination proceeding until after the earlier of** (a) the submission of the housekeeping amendment to place the same amendments in both cases or (b) the expiration of the ONE MONTH period from the mailing of this decision for filing the amendment.

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 Elizabeth L. Dougherty, Senior Legal Advisor, at (571) 272-7733.

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

December 22, 2005
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MAILED
JAN 12 2005
REEXAM UNIT

In re Reissue Application of Nancy C. Lan et al. Application No. 10/429,764 Filed: May 6, 2003 For: U.S. Patent No. 6,479,484	:	DECISION, *SUA SPONTE*, TO MERGE REISSUE AND REEXAMINATION PROCEEDINGS
In re Nancy C. Lan et al. Reexamination Proceeding Control No. 90/006,692 Filed: July 2, 2003 For: U.S. Patent No. 6,479,484	:	

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

REVIEW OF FACTS

1. U.S. patent No. 6,479,484 issued on November 12, 2002, with 19 claims.

2. An application for reissue, assigned application No. 10/429,764, was filed by the patent owner on May 6, 2003.

3. A request for reexamination was filed by a third party requester on July 2, 2003, and was assigned control No. 90/006,692 (hereinafter, the '6692 proceeding).

4. Reexamination was ordered for the '6692 proceeding on August 13, 2003.

5. A patent owner's statement under 37 CFR 1.530 was not received in the '6692 proceeding.

DISCUSSION REGARDING MERGER

Under 37 CFR 1.565(d):

> "If a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings."

As evidenced by the above review of facts, reissue application No. 10/870,229 and reexamination control No. 90/006,953 are currently pending. Since the order to reexamine has been mailed in the reexamination proceeding, a decision under 37 CFR 1.565(d) is timely.

The general policy of the Office is that a reissue application examination and a reexamination proceeding will not be conducted separately at the same time as to a particular patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner.

Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of both proceedings. In making a decision on whether or not to merge the two proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

In order to provide efficient and prompt handling of the reissue and reexamination proceedings and to prevent inconsistent, and possibly conflicting, amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and 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-noted reissue and reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in Both Proceedings

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

2. A review of the reexamination file for reexamination control No. 90/006,692 shows that original patent claims 1-19 are present. A review of reissue application No. 10/429,764 shows that original patent claims 1, 2,5, 6 and 8-19 are present, patent claim 7 is canceled, and patent claims 3 and 4 are amended. In addition, new claims 20-24 have been added in the reissue application. **Accordingly, the claims are not identical in both proceedings.**

   An appropriate housekeeping amendment is required within <u>ONE (1) MONTH</u> of this decision placing the same amendments in both cases, specifically, Application No. 10/429,764, and Control Number 90/006,692. The response to this requirement must be limited to placing the same amendments in all cases, and patent owner must **not** address any issue of patentability in the housekeeping amendment.

III. <u>Conduct of the Merged Reissue Application Examination and Reexamination Proceedings</u>

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

2. In the event that a housekeeping amendment is not timely submitted, any claim which does not contain identical text in both proceedings should be rejected under 35 U.S.C. 112, paragraph 2, as being indefinite as to the content of the claims, and thus failing to particularly point out the invention.

3. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. 305 relating to the conduct of *ex parte* reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue-application examination. The examiner will apply the <u>reissue</u> statute, rules, and case law to the merged proceeding. **However, periods of response should be set at TWO (2) months to comply with the statutory requirement for special dispatch in reexamination (35 U.S.C. 305).**

4. Each Office action issued by the examiner will take the form of a *single action* which jointly applies to the reissue application and the reexamination proceeding. Each action will contain identifying data *for both of the cases*, i.e, the reissue application and the reexamination proceeding, and each action will be entered into both files (which will be maintained as separate files).

5. Any response by the applicant/patent owner must consist of a single response, with two copies being filed for entry in the two files, with each of the two bearing a signature. *Any such responses must be served on the requester*, who will also be sent copies of Office actions.

6. The filing of any amendments to the drawings, specification, or claims must comply with the provisions of 37 CFR 1.530 and the guidelines of MPEP 2250. It is to be noted that 37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required, *and such clean copies are not to be submitted.* Instead, amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

   Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments*. Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

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

the merged proceeding.

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

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

10. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be dissolved. The reissue application will be held abandoned. The reexamination prosecution will be terminated and a reexamination certificate under 37 CFR 1.570 will be issued in accordance with the last action of the Office, unless further action in the reexamination proceeding is needed as a result of the difference in the rules relating to reexamination and reissue proceedings. If further action in the reexamination proceeding is needed, any grounds of rejection which are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner, upon dissolution of the merged proceeding. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 CFR 1.552(c).

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

CONCLUSION

1. Reissue application No. 10/429,764 and reexamination control No. 90/006,692 **are merged** into a single proceeding.

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

3. The reissue and reexaminations 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 action for the present merged proceeding of the reissue and reexamination proceedings until after the earlier of** (a) the submission of the housekeeping amendment to place the same amendments in both cases or (b) the expiration of the ONE MONTH period from the mailing of this decision for filing the housekeeping amendment.

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

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

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

January 6, 2005
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(For Patent Owner)

MAILED

JAN 10 2006

REEXAM UNIT

Ivor R. Elrifi
Matthew J. Golden
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Glovsky and Popeo, PC
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New York, NY 10017

(For Third Party Requester)

In re reissue application of	:
Nancy C. Lan *et al*	:
Application No. 10/429,764	:
Filed: May 6, 2003	: **DECISION SEVERING**
For: U.S. Patent No. 6,479,484	: **PREVIOUSLY MERGED**
	: **REISSUE APPLICATION**
	: **AND *EX PARTE***
In re Nancy C. Lan *et al*	: **REEXAMINATION**
Reexamination Proceeding	: **PROCEEDING**
Control No. 90/006,692	:
Filed: July 2, 2003	:
For: US. Patent No. 6,479,484	:

The merged proceeding consisting of reissue application 10/429,764 and *ex parte* reexamination proceeding 90/006,692 is before the Office of Patent Legal Administration for issuance of a decision to *sua sponte* sever the merged proceeding, in order to permit separate prosecution and examination of the reissue application and the *ex parte* reexamination proceeding.

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 6,479,484 (the '484 patent) issued to Nancy C. Lan *et al* on November 12, 2002.

2. On May 6, 2003, the patent owner filed a "broadening" reissue application based on the '484 patent, which was assigned Application Number 10/429,764 (the '764 reissue application).

3. A request for *ex parte* reexamination of the '484 patent was filed by a third party requester on July 7, 2003, and the resulting reexamination proceeding was assigned Control Number 90/006,692 (the '692 reexamination proceeding).

4. On August 13, 2003, an order granting the reexamination request was mailed for the '081 proceeding.

5. The Office merged the '764 reissue application and the '692 reexamination proceeding into a single combined proceeding, in a merger decision mailed January 12, 2005.

6. The January 12, 2005 merger decision required, *inter alia*, that the specification and claims of the merged reissue application and reexamination proceeding be maintained as identical by the filing of identical amendments for so long as the reissue application and reexamination proceeding remained merged.

7. On February 11, 2005, a housekeeping amendment was filed in the '692 reexamination proceeding, which resulted in the specification and claims of the '692 reexamination proceeding being identical to the specification and claims of the '764 reissue application.

8. As necessitated by subsequent prosecution of the merged proceeding, identical amendments were filed in the '764 reissue application and the '692 reexamination proceeding on June 6, 2005. [1]

9. On September 16, 2005, papers were filed in the '764 reissue application and the '692 reexamination proceeding which resulted in acceptance of the June 6, 2005 amendment as being in compliance with the regulations governing the format of amendments filed in reissue and reexamination proceedings. [2]

10. On October 26, 2005, a "Predecisional Memorandum Suggested Interference Referral" [3] was forwarded to the Board of Patent Appeals and Interferences (Board) regarding the '764 reissue application. This forwarding is a representation that examination has been completed and all pending claims have been allowed, finally rejected or canceled, and that appeal from a final rejection has been completed including any judicial review. [4]

---

[1] The amendment appearing in the Image File Wrapper (IFW) of the '764 reissue application has been coded with a date of June 3, 2005, but inspection of the paper shows that the paper bears an Office of Initial Patent Examining date stamp dated June 6, 2005.

[2] See 37 CFR 1.173 regarding amendments in reissue applications and 37 CFR 1.530(d) regarding amendments in *ex parte* reexamination proceedings.

[3] Formally known as an Initial Interference Memorandum

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

APPLICABLE STATUTORY AND REGULATORY PROVISIONS

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

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

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

> "(d) If a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will **normally** be made to merge the two proceedings or to suspend one of the two proceedings. Where merger of a reissue application and an *ex parte* reexamination proceeding is ordered, the merged examination will be conducted in accordance with §§ 1.171 through 1.179, and the patent owner will be required to place and maintain the same claims in the reissue application and the *ex parte* reexamination proceeding during the pendency of the merged proceeding. The examiner's actions and responses by the patent owner in a merged proceeding will apply to both the reissue application and the *ex parte* reexamination proceeding and be physically entered into both files.... "
>
> " (e) If a patent in the process of *ex parte* reexamination is or becomes involved in an interference, the Director may suspend the reexamination or the interference. The Director will not consider a request to suspend an interference unless a motion (§ 41.121(a)(3) of this title) to suspend the interference has been presented to, and denied by, an administrative patent judge, and the request is filed within ten (10) days of a decision by an administrative patent judge denying the motion for suspension or such other time as the administrative patent judge may set...." [Emphasis added.]

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

> (a) All *ex parte* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office.
>
> (g) The active participation of the *ex parte* reexamination requester ends with the reply pursuant to § 1.535, and no further submissions on behalf of the reexamination requester will be acknowledged or considered.

DECISION

The record shows that the instant merged proceeding has progressed to the point where all claims appear to be allowable, save for a question of priority of invention that has been referred to the Board for resolution in an interference proceeding.

Conducting an interference proceeding while the '764 reissue application and the '692 reexamination proceeding remain merged as a single combined proceeding would result in a lengthy delay of the conclusion of the reexamination proceeding. This would run counter to the statutory mandate of 35 U.S.C. § 305 that the reexamination proceeding be conducted with special dispatch. Further, the conduct of an interference proceeding is, by its nature, an *inter partes* proceeding. If the '764 reissue application and the '692 *ex parte* reexamination proceeding remain merged as a single proceeding, this would raise a question of whether the '692 reexamination proceeding were in fact being conducted as an *ex parte* proceeding as is required by the statute, which requirement is implemented in 37 CFR 1.565 (g). *See Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 11 USPQ2d 1866, 1868-1869 (Fed. Cir. 1989). [5]

It is therefore determined that the most expeditious avenue to satisfy the special dispatch requirement of 35 U.S.C. § 305 and, at the same time, expedite resolution of the question of priority of invention raised by the Predecisional Memorandum Suggested Interference Referral, is to sever the merged proceedings an take action on the '764 reissue application and '692 reexamination proceeding separately and concurrently.

Accordingly, the following action is taken:

1. To the extent that the October 26, 2005, forwarding to the Board of the "Predecisional Memorandum Suggested Interference Referral" for the '764 reissue application did not confer jurisdiction over the proceeding: Jurisdiction over the '764 reissue application is being returned to the Technology Center, for subsequent transfer to the Board for any action deemed appropriate with respect to the "Predecisional Memorandum Suggested Interference Referral". [6]

2. Jurisdiction over the '692 reexamination proceeding is being returned to the Technology Center for immediate action on the proceeding by the primary examiner. In the event that the pending claims in the '692 reexamination proceeding have been impermissibly broadened pursuant to the guidelines in MPEP § 2258(III)(A) and contrary to 35 U.S.C. § 305,

---

[5] 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]

[6] As a preliminary matter, the Administrative Patent Judge and the Technology Center Interference Practice Specialist may wish to review the record of the '764 reissue patent with respect to the necessity for the filing of a supplemental reissue declaration pursuant to 37 CFR 1.175(b) and/or (c) in view of the amendment to the claims filed on June 6, 2005 which appears to have subsequently been determined to be enterable into the record.

appropriate action should be taken to eliminate such broadening. [7] After the issue of any broadening has been resolved, if the claims remain in condition for confirmation/allowance, the preparation of a Notice of Intent to Issue *Ex Parte* Reexamination Certificate pursuant to the practice in § 2287 should be undertaken with special dispatch.

If the'692 reexamination proceeding is concluded by the issuance and publication of an *Ex Parte* Reexamination Certificate, the '484 patent would be modified by any change effected via the certificate. The '484 patent, as modified by any issued *Ex Parte* Reexamination Certificate, would be the patent that is surrendered (as required by statue) in favor of any reissue patent ultimately resulting from the '762 reissue application.

CONCLUSION

1. The merged proceeding consisting of the '762 reissue application and the '692 *ex parte* reexamination proceeding is hereby severed into a separate proceeding (the '762 reissue application) for reissue of the '484 patent, and a separate proceeding (the '692 *ex parte* reexamination) for reexamination of the '484 patent. The two proceedings will be carried on separately and concurrently.

2. Jurisdiction over the '692 reexamination proceeding is being returned to the Technology Center for immediate action on the proceeding by the primary examiner, toward resolution of the proceeding.

3. To the extent that the October 26, 2005, forwarding to the Board of the "Predecisional Memorandum Suggested Interference Referral" for the '764 reissue application did not confer jurisdiction over the proceeding: Jurisdiction over the '764 reissue application is being returned to the Technology Center, for subsequent transfer to the Board for any action deemed appropriate with respect to the "Predecisional Memorandum Suggested Interference Referral".

4. Telephone inquiries related to the '762 reissue proceeding should be directed to Cecilia Tsang, Interference Practice Specialist in Technology Center 1600, at (571) 272-0562.

[7] It is suggested that a thirty-day action be promulgated requiring patent owner to eliminate the broadening. It should be noted that restoring the claims in the '692 reexamination proceeding to the claims as they appear in the '484 patent would be one way to overcome the problem of broadened claims, if any exist.

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
Office of Patent Examination Policy

December 20, 2005
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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.
90/006,841	10/31/2003	4704725	001263.00021	6928

+ 90/006697

21967 7590 12/03/2004

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/03/2004

#8

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

cc'd: Third Party Requester, as attached

UNITED STATES PATENT AND TRADEMARK OFFICE

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/006,697*.

PATENT NO. *4704725*.

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. 8

Thomas Scott HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON DC 20006-1109	))))))	FOR OWNER
Thomas L. Peterson, Esq. Banner & Witcoff, Ltd. 1001 G Street NW 11th Floor Washington DC 20001-4597	))))	FOR THIRD PARTY REQUESTOR
In Re Harvey, et al. Reexamination Proceeding Control No. 90/006,697 Filed 7-7-03 For U.S. Patent No. 4,704,725	)))))	DECISION SUA SPONTE MERGING REEXAMINATION PROCEEDINGS
In Re Harvey, et al. Reexamination Proceeding Control No. 90/006,841 Filed 10-31-03 For: U.S. Patent No. 4,704,725	)))))	

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. 4,704,725 issued on November 3, 1987.

2. A first request for reexamination, Control No. 90/006,697 ('697) was filed by the Third Party Requestor on July 7, 2003.

3. Reexamination was ordered on the '697 reexamination proceedings on September 9, 2003.

4. A statement of non-submission of Patent Owner's statement was filed on November 5, 2003.

5. A second request for reexamination, Control No. 90/006,841 ('841) was filed by the Third Party Requestor on October 31, 2003.

6. Reexamination was ordered on the '841 reexamination proceedings on January 6, 2004.

7. 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 '697 and '841 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

Reinhard Eisenzopf, Acting Director
Technology Center 2600
Communications & Information Processing

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OCT 21 2005

REEXAM UNIT

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In re John C. Harvey et al.
Reexamination Proceeding
Control No.: 90/006,697
Filed: July 7, 2003
For: U.S. Patent No. 4,704,725

In re John C. Harvey et al.
Reexamination Proceeding
Control No.: 90/006,841
Filed: October 31, 2003
For: U.S. Patent No. 4,704,725

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 19, 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 19, 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 for expungement of 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. 4,704,725 (hereinafter, the '725 patent) issued on November 3, 1987.

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. The petitioner S-A filed two requests for reexamination of the '725 patent, on July 7, 2003 and October 31, 2003. Reexamination control numbers 90/006,697 and 90/006,841, respectively, were assigned to the proceedings. The requests for reexamination were granted, and the two proceedings have been merged under 37 CFR 1.565(c).

5. On August 19, 2005, PMC filed an IDS in reexamination control numbers 90/006,697 and 90/006,841.

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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).

6. S-A filed the instant petition on September 6, 2005, 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 a third party requester 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 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

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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).

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 19, 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 19, 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

C:\kiva\kenpet6\6697+6841_Expunge-PO-submission_by-3PR.wpd
October 18, 2005

mar

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)

Nina L. Medlock
BANNER & WITCOFF, LTD
1001 G Street NW
Washington, DC 20001

(For Requester Scientific-Atlanta, Inc.)

MAILED

MAR 30 2006

REEXAM UNIT

In re John C. Harvey et al.	:	
Reexamination Proceeding	:	DECISION DISMISSING
Control Nos.: 90/006,697 filed July 7, 2003	:	PETITION AND
90/006,841 filed October 31, 2003	:	UNSEALING PAPERS
For: U.S. Patent No. 4,704,725	:	

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 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 <u>dismissed</u> in view of the patent

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[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).

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. 4,704,725 (hereinafter, the '725 patent) issued on November 3, 1987.

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. S-A filed requests for reexamination of the '725 patent on July 7, 2003 and October 31, 2003, and reexamination control numbers 90/006,697 and 90/006,841, respectively, were assigned to the proceedings. The request for reexamination was granted, and the two proceedings have been merged under 37 CFR 1.565(c).

5. On August 19, 2005, PMC filed an IDS in reexamination control numbers 90/006,697 and 90/006,841.

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 PMC filed the instant petition to return materials submitted by S-A, 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.

---

[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).

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).

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

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March 29, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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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 18 2006
REEXAM UNIT

Nina L. Medlock
BANNER & WITCOFF, LTD
1001 G Street NW
Washington, DC 20001

(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. 90/006,697
Filed: July 7, 2003
For: US Patent No. 4,704,725

In re John C. Harvey
Ex Parte Reexamination Proceeding
Control No. 90/006,841
Filed: October 31, 2003
For: US Patent No. 4,704,725

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. 4,704,725 issued on November 3, 1987.

2. A request was filed by a third party requester for reexamination of US Patent No. 4,704,725 on July 7, 2003 and October 31, 2003.

3. The Order granting reexamination is dated September 9, 2004.

4. A decision merging the proceedings was mailed December 3, 2004.

5. A non-final Office action was mailed on April 20, 2005.

6. The patent owner response was received on June 20, 2005.

7. A final Office action was mailed July 22, 2005.

8. The patent owner's appeal brief was received December 27, 2005.

9. The examiner's answer was mailed April 21, 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 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

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Hunton & Williams LLP
Intellectual Property Department
1900 K Street NW
Suite 1200
Washington DC 20006-1109

(For Patent Owner Personalized Media)

COPY MAILED

SEP 19 2006

OFFICE OF PETITIONS

Nina L. Medlock
Banner & Witcoff
10012 G Street NW
Washington DC 20001

(For Requestor)

In re John C. Harvey :
Ex Parte Reexamination Proceeding :
Control No. 90/006,697 :
Filed: July 7, 2003 :
For: U.S. Patent No. 4,704,725 :

ON PETITION

In re John C. Harvey :
Ex Parte Reexamination Proceeding :
Control No. 90/0068417 :
Filed: October 31, 2003 :
For: U.S. Patent No. 4,704,725 :

This is a decision on the petition filed June 21, 2006, under 37 CFR 1.183 by patent owner to waive the applicable rules and permit the submission of new evidence with the reply brief.

The petition is granted.

Petitioner, in essence, complains that in each communication from the first Office action to the Advisory Action, the examiner has continued to expand the evidence relied upon to support the rejection. Petitioner further complains that while the examiner has not specifically identified that he has made a new ground of rejection, which would permit patent owner to submit new evidence, the examiner has taken a new position in his Examiner's Answer that the CBS petition includes Appendix B in a "single complete publication." Petitioner asserts that as the accompanying declaration of Kimberly Kellmel ("Kellmel") bears directly on this newly created issue, justice dictates waiver of the rules.

As noted in MPEP 1208.01, "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." While it is not asserted by petitioner nor is it apparent from the record that

the statutory ground for the rejection has changed, the record does suggest that the totality of the evidence surrounding the CPS petition to support the rejection has not remained unchanged; rather is has grown substantially with each Office communication.

That is, the CBS petition relied upon by the examiner has grown from an exhibit of 5 pages in the first Office action to an exhibit now subtending some 150 pages in the Answer. It thus seems, without deciding the issue, that the quantum of evidence relied upon in support of the rejection has increased. As noted in In re Hilmer, 53 CCPA 1288, 1313, 359 F.2d 859, 879, 149 USPQ 480, 496 (CCPA 1966):

> Much confused thinking could be avoided by realizing that rejections are based on statutory provisions, not on references, and that the references merely supply the evidence of lack of novelty, obviousness, loss of right or whatever may be the ground of rejection.

As of the first Office action, the evidence provided by and from the CBS petition reference was but 5 pages; now it is 150 pages. On the other hand, the mere citation of new information after appeal has been taken does not *ipso facto* constitute a change in the evidence relied upon, such that a new grounds of rejection has been made. See In re Kronig, 539 F.2d 1300, 190 USPQ 425 (CCPA 1976); In re Ahlert, 424 F.2d 1088, 165 USPQ 418 (CCPA 1970); MPEP 1208.01. The issue is whether applicant has had a fair opportunity to react to the thrust of the rejection. Kronig, supra. Since the challenge raised by petitioner to the citation of the CBS Petition has remained substantially unchanged over time, it appears that petitioner has had that fair opportunity.

However, as the CBS petition now totals some 150 pages of citation, and in light of the examiner's first-time assertion in the Answer that such constitutes "a single complete publication", it is agreed that justice would be served by waiving the rules that would prohibit entry of the Kellmel declaration.

Petitioner should note, for future reference, that if he should feel that he has been subjected to a new ground of rejection, which has not been appropriately so designated, his remedy is a timely petition requesting supervisory review under 37 CFR 1.181, and not a belated petition under CFR 1.183 seeking to level the playing field. 37 CFR 1.183 is not a mechanism for avoiding the diligence requirement of 37 CFR 1.181(f).

This reexamination proceeding is being referred to the Technology Center for further action consistent with this decision.

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3217.

Brian Hearn
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,698 + 90/006,563	07/07/2003	5335277	001263.00016	9278

21967 7590 12/03/2004

HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON, DC 20006-1109

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/03/2004 #16

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

Cc: Third Party Requestor 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
www.uspto.gov

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Thomas L. Peterson, Esq.
Banner & Witcoff, Ltd.
1001 G Street NW 11th Floor
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)).

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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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Arthur J. Usher IV, Esquire
Woodard, Emhardt, Naughton, Moriarty & McNett LLP
Bank One Center/Tower
111 Monumental Circle, Suite 3700
Indianapolis, Indiana 46204-5137

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)).

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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Paper No. 16

Thomas Scott HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON DC 20006-1109	)	FOR OWNER
Arthur J. Usher IV, Esquire Woodard, Emhardt, Naughton, Moriarty & McNett LLP Bank One Center/Tower 111 Monumental Circle, Suite 3700 Indianapolis, Indiana 46204-5137	)	FOR FIRST THIRD PARTY REQUESTOR
Thomas L. Peterson, Esq. Banner & Witcoff, Ltd. 1001 G Street NW 11th Floor Washington DC 20001-4597	)	FOR SECOND THIRD PARTY REQUESTOR
In Re Harvey, et al. Reexamination Proceeding Control No. 90/006,563 Filed 3-14-03 For U.S. Patent No. 5,335,277	)	DECISION SUA SPONTE MERGING REEXAMINATION PROCEEDINGS
In Re Harvey, et al. Reexamination Proceeding Control No. 90/006,698 Filed 7-7-03 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

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OCT 21 2005

REEXAM UNIT

Thomas Scott
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1751 Pinnacle Drive
Suite 1700, Tysons Corner
McLean, VA 22102

(For Patent Owner)

Nina L. Medlock
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1001 G Street NW
Washington, DC 20001

(For Requester Scientific-Atlanta, Inc.)

Arthur J. Usher, IV
WOODARD EMHARDT NAUGHTON
MORIARTY & MCNETT LLP
Bank One Center/Tower
111 Monument Circle, Suite 3700
Indianapolis, IN 46204-5137

(For Requester Thomson, Inc.)

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.

---

[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

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)

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.)

MAILED
MAR 3 1 2006
REEXAM UNIT

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	:	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

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[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

C:\kiva\kenpet6\expung\6563 & 6698 Resp by Owner Re Unseal_grant.wpd
March 29, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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MAILED
MAY 22 2006
REEXAM UNIT

HUNTLON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K Street N.W. Suite 1200 Washington, DC 20006-1109	:	(For Patent Owner)
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. 90/006,563 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

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.
90/006,606 + 90/006,703 + 90/006,839	04/18/2003	5233654	6011-226	9269

21967 7590 12/03/2004

HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON, DC 20006-1109

EXAMINER

ART UNIT	PAPER NUMBER

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.

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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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Arthur J. Usher IV, Esquire
Woodard, Emhardt, Naughton, Moriarty & McNett LLP
Bank One Center/Tower
111 Monumental Circle, Suite 3700
Indianapolis, Indiana 46204-5137

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/006,606* + 90/006,703 + 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)

Thomas L. Peterson, Esq.
Banner & Witcoff, Ltd.
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)).

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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Paper No. 16

Thomas Scott HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON DC 20006-1109	)	FOR OWNER
Arthur J. Usher IV, Esquire Woodard, Emhardt, Naughton, Moriarty & McNett LLP Bank One Center/Tower 111 Monumental Circle, Suite 3700 Indianapolis, Indiana 46204-5137	)	FOR FIRST THIRD PARTY REQUESTOR
Thomas L. Peterson, Esq. Banner & Witcoff, Ltd. 1001 G Street NW 11th Floor Washington DC 20001-4597	)	FOR SECOND THIRD PARTY REQUESTOR
In Re Harvey, et al. Reexamination Proceeding Control No. 90/006,606 Filed 4-18-03 For U.S. Patent No. 5,233,654	)	DECISION SUA SPONTE MERGING REEXAMINATION PROCEEDINGS
In Re Harvey, et al. Reexamination Proceeding Control No. 90/006,703 Filed 7-7-03 For U.S. Patent No. 5,233,654	)	
In Re Harvey, et al. Reexamination Proceeding Control No. 90/006,839 Filed 10-31-03 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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MAILED

OCT 21 2005

REEXAM UNIT

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(For Patent Owner)

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(For Requester Scientific-Atlanta, Inc.)

Arthur J. Usher, IV
WOODARD EMHARDT NAUGHTON
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Indianapolis, IN 46204-5137

(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

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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).

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 <u>granted</u> to permit entry and consideration of the petition paper.

II. <u>The Petition Under 37 CFR 1.182 to Expunge</u>

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

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(For Patent Owner Personalized Media Communications, LLC)

MAILED
MAR 31 2006
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(For Requester Thomson, Inc.)

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(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

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[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

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MAILED
MAR 31 2006
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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

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[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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MAY 18 2006
REEXAM UNIT

HUNTLON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K Street N.W.
Suite 1200
Washington, DC 20006-1109

(For Patent Owner)

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
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.

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.
90/006,606	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
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P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,839	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
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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

MAILED

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	:	DECISION GRANTING PETITION
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	:	

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."

[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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Paper No. 7

Mark Pohl
PHARMACEUTICAL PATENT ATTORNEYS
POHL & ASSOCIATES
55 Madison Avenue, 4th Floor
Morristown, NJ 07960-6397

(For Patent Owner)

MAILED
DEC 10 2003
REEXAM UNIT

In re Szynalski
Reexamination Proceeding
Control No. 90/006,704
Filed: June 30, 2003
For: U.S. Patent No. 6,431,874

In re reissue application of
Szynalski
Application No. 10/613,590
Filed: June 30, 2003
For: U.S. Patent No. 6,431,874

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. 6,431,874 issued to Szynalski, on August 13, 2002.

2. A request for reexamination of the '874 patent was filed by patent owner on June 30, 2003, and the resulting reexamination proceeding was assigned Control No. 90/006,704.

3. Patent owner filed a reissue application based on the '874 patent, also on June 30, 2003, which was assigned Application No. 10/613,590. Claims 9-45 were added.

4. Reexamination was ordered in the '6704 proceeding on August 27, 2003.

5. A patent owner's statement was filed in the '6704 proceeding on October 8, 2003.

6. Notice of the filing of the reissue application was published in the *Official Gazette* on October 21, 2003.

7. A certificate of correction was issued in U.S. Patent No. 6,431,874 on November 18, 2003, in which Col. 12, lines 26-27 and 45, were amended.

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 '6704 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 '6704 reexamination file shows that no amendments were made in the reexamination file.

A review of the reissue (Application No. 10/613,590) prosecution history shows that the reissue application was published in the *Official Gazette* on October 21, 2003. In the reissue application, patent owner has added claims 9-45. Therefore, the claims are **not** identical in both proceedings.

Also, since a certificate of correction was issued in U.S. Patent No. 6,431,874 on November 18, 2003, in which Col. 12, lines 26-27 and 45, were amended, the specifications in both the reissue application and the reexamination proceeding need to be updated to reflect such changes to the original patent.

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. As also noted above, the specifications need to be updated to reflect the changes to Col. 12 of the patent made via certificate of correction. **An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both cases**, specifically, Application No. 10/613,590, and Control Number 90/006,704. The response to the requirement must be limited to placing the same amendments in both cases, and patent owner must **not** address the issues of either of the proceedings in the housekeeping amendment. The housekeeping amendment should be submitted as a single paper, including the identifying data for both files (*i.e,* the reissue Application No. and the reexamination proceeding Control No.) and a signature, and should be filed in duplicate for entry into each of the reissue and reexamination files.

It should be noted that the preliminary amendment filed on June 30, 2003, adding claims 9-45 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).

Note that the changes made to the specification via certificate of correction constitute part of the original patent, therefore these changes need to be incorporated in the specifications of the reissue and reexamination proceedings, but **without** any bracketing and underlining since the changes are **not** being made via the reissue application or the reexamination proceeding.

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 3600. All further examination should be conducted in accordance with this decision.

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

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

   (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 9, 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.
10/613,590	06/30/2003	Alexander G. Szynalski	

PATENT NUMBER	DATE OF THIS NOTICE	PAPER NUMBER
6,431,874	12-10-2003	8

NOTICE OF MERGED REEXAM - REISSUE PROCEEDING

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

Control No. 90/006,704 Filing Date: 06/30/2003

Requester (name, address) None, (Patent Owner Filed Reexam)

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

REEXAMINATION RESULTS

The questions raised in reexamination request No. 90/006,704, filed 06/30/2003, 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).

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COMMISSIONER FOR PATENTS
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P.O. BOX 1450
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Paper No. 7

Mark Pohl
PHARMACEUTICAL PATENT ATTORNEYS
POHL & ASSOCIATES
55 Madison Avenue, 4th Floor
Morristown, NJ 07960-6397

(For Patent Owner)

MAILED
DEC 10 2003
REEXAM UNIT

In re Szynalski
Reexamination Proceeding
Control No. 90/006,704
Filed: June 30, 2003
For: U.S. Patent No. 6,431,874

In re reissue application of
Szynalski
Application No. 10/613,590
Filed: June 30, 2003
For: U.S. Patent No. 6,431,874

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. 6,431,874 issued to Szynalski, on August 13, 2002.

2. A request for reexamination of the '874 patent was filed by patent owner on June 30, 2003, and the resulting reexamination proceeding was assigned Control No. 90/006,704.

3. Patent owner filed a reissue application based on the '874 patent, also on June 30, 2003, which was assigned Application No. 10/613,590. Claims 9-45 were added.

4. Reexamination was ordered in the '6704 proceeding on August 27, 2003.

5. A patent owner's statement was filed in the '6704 proceeding on October 8, 2003.

6. Notice of the filing of the reissue application was published in the *Official Gazette* on October 21, 2003.

7. A certificate of correction was issued in U.S. Patent No. 6,431,874 on November 18, 2003, in which Col. 12, lines 26-27 and 45, were amended.

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 '6704 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 '6704 reexamination file shows that no amendments were made in the reexamination file.

A review of the reissue (Application No. 10/613,590) prosecution history shows that the reissue application was published in the *Official Gazette* on October 21, 2003. In the reissue application, patent owner has added claims 9-45. Therefore, the claims are **not** identical in both proceedings.

Also, since a certificate of correction was issued in U.S. Patent No. 6,431,874 on November 18, 2003, in which Col. 12, lines 26-27 and 45, were amended, the specifications in both the reissue application and the reexamination proceeding need to be updated to reflect such changes to the original patent.

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. As also noted above, the specifications need to be updated to reflect the changes to Col. 12 of the patent made via certificate of correction. **An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both cases**, specifically, Application No. 10/613,590, and Control Number 90/006,704. The response to the requirement must be limited to placing the same amendments in both cases, and patent owner must **not** address the issues of either of the proceedings in the housekeeping amendment. The housekeeping amendment should be submitted as a single paper, including the identifying data for both files (*i.e,* the reissue Application No. and the reexamination proceeding Control No.) and a signature, and should be filed in duplicate for entry into each of the reissue and reexamination files.

It should be noted that the preliminary amendment filed on June 30, 2003, adding claims 9-45 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).

Note that the changes made to the specification via certificate of correction constitute part of the original patent, therefore these changes need to be incorporated in the specifications of the reissue and reexamination proceedings, but **without** any bracketing and underlining since the changes are **not** being made via the reissue application or the reexamination proceeding.

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 3600. All further examination should be conducted in accordance with this decision.

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

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

   (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 9, 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.
10/613,590	06/30/2003	Alexander G. Szynalski	

PATENT NUMBER	DATE OF THIS NOTICE	PAPER NUMBER
6,431,874	12-10-2003	8

NOTICE OF MERGED REEXAM - REISSUE PROCEEDING

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

Control No. 90/006,704 Filing Date: 06/30/2003

Requester (name, address) None, (Patent Owner Filed Reexam)

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

REEXAMINATION RESULTS

The questions raised in reexamination request No. 90/006,704, filed 06/30/2003, 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).

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VIENNA, VA 22182-3817

MAILED

OCT 26 2006

CENTRAL REEXAMINATION UNIT

In re Reexamination Proceeding :
Priegnitz et al. :
Control No. 90/006,706 : DECISION DISMISSING PETITION
Filed: July 11, 2003 :
U.S. Patent No. 5,518,625 :
Attorney Docket No. JMYT-302US :

This is a decision on the petition under 37 CFR 1.183 filed by the patent owner on October 16, 2006, to waive the requirement under 37 CFR 41.37(b) (*sic,* 41.47(b)) that, an oral hearing for an appeal of a patent undergoing reexamination must be filed within two months of the date of the examiner's answer, and to accept appellant's (patent owner's) later filed request for an extension of time contrary to 37 CFR 1.550(c).

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

Inasmuch as the "the unavoidable delay" standard is statutory rather than merely regulatory, and because 37 CFR 1.183 does not empower the Commissioner to waive statutory requirements, petitions under § 1.183 concerning untimely responses in reexamination proceedings are dismissed as being inappropriate. Petitions concerning untimely responses in reexamination proceedings should rather be filed under 35 U.S.C. § 133, and not 37 CFR 1.183. The unavoidable delay provisions of 35 U.S.C. 133 are imported into, and are applicable to, *ex parte* reexamination proceedings by 35 U.S.C. 305. Accordingly, petitions concerning untimely responses in reexamination proceedings are treated under the provisions of 37 CFR 1.137 (a) or (b). See *In re Katrapat*, 6 USPQ2d 1863 (Comm'r Pat. 1988).

In view of the above, the petition is DISMISSED.

Petitioner may wish to consider seeking acceptance of the belated oral hearing papers based on either unintentional or unavoidable delay, as follows.

A grantable petition for entry of belated papers under 37 CFR 1.137(b) must be accompanied by

(1) the response required to the outstanding Office action or notice, unless previously filed; (2) the petition fee (set forth in § 1.17(m)) required by law; and (3) a proper statement that the entire delay in filing the required response from the due date for the response until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

A grantable petition for entry of belated papers under 37 CFR 1.137(a) must be accompanied by (1) the response required to the outstanding Office action or notice, unless previously filed; (2) the petition fee (set forth in § 1.17(l)) required by law; and (3) a showing to the satisfaction of the Director that the entire delay in filing the required response from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable.

Should petitioner choose to file a petition for entry of belated papers under 37 CFR 1.137(a), the following is to be noted. A review of the present petition reveals that petitioners assert docketing error as the cause of the delay. Such issues are usually included as part of petition filed under 37 CFR 1.137(a), as set forth in MPEP 711.03(c) below.

MPEP 711.03(c) (p. 700-202) states, in part, the following:

> A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:
> (A)the error was the cause of the delay at issue;
> (B)there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and
> (C)the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

MPEP 711.03(c) (pp. 700-191-700-192) states, in part, the following:

> Petitioner should note that petitions under 37 CFR 1.137(b) are less burdensome (statement(s) rather than a showing accompanied by documentary evidence) to file and are evaluated under the less stringent "unintentional delay" standard.
>
> Even if the Office requires further information in a petition under 37 CFR 1.137(b), such petition is still significantly less burdensome to prepare and prosecute than a petition under 37 CFR 1.137(a). The Office is almost always satisfied as to whether "the entire delay...was unintentional" on the basis of statement(s) by the applicant or representative explaining the cause of the delay (accompanied at most by copies of correspondence relevant to the period of delay). A showing of unavoidable delay will (in addition to the above) require: (1) evidence concerning the procedures in place that should have avoided the error resulting in the delay; (2) evidence concerning the training and experience of the persons responsible for the error; and (3) copies of any applicable docketing records to show thatthe error was in fact the cause of the delay. See MPEP § 711.03(c), subsection II.C.2. In addition, a petition under 37CFR 1.137(a) must establish that the delay was unavoidable, and not just that it was unintentional. Thus, many petitions originally filed under 37 CFR 1.137(a) end up being granted under 37CFR 1.137(b) when the applicant realizes that sufficient evidence concerning the delay is too difficult to obtain or the cause of delay simply does not amount to "unavoidable delay" within the meaning of 37 CFR 1.137(a).
>
> Since the requirements of 37 CFR 1.137(a) are more exacting than the corresponding requirements of 37 CFR 1.137(b), a petition under 37 CFR 1.137(a) is significantly less likely to be grantable as filed than is a petition under 37CFR 1.137(b). The Office usually must render a number of interlocutory decisions dismissing a petition under 37 CFR 1.137(a) and requesting additional evidence until either the applicant provides a satisfactory

> showing of unavoidable delay (in which case the petition can be granted) or the Office concludes that the applicant cannot provide a satisfactory showing of unavoidable delay (in which case the petition must be denied). Thus, the period between when an applicant first files a petition to revive and the Office renders a decision granting (or denying) that petition will, more often than not, be much longer if the petition is under 37 CFR 1.137(a) than it would have been if the petition were under 37 CFR 1.137(b).

If petitioner desires to make the required submissions in order that a petition under § 1.137 be granted, the submissions should be included in a cover letter entitled "Petition under 37 CFR 1.137(a)" or "Petition under 37 CFR 1.137(b)."

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

By U.S. Postal Service Mail:	Mail Stop *Ex Parte* Reexam Central Reexamination Unit United States Patent & Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450
By FAX to:	(571) 273-9900 Central Reexamination Unit
By Hand:	Customer Service Window Attn: Central Reexamination Unit Randolph Building, Lobby Level 401 Dulany St. Alexandria, VA 22314

Jurisdiction over the reexamination proceeding is being returned to the Board of Patent Appeals and Interferences (BPAI) for consideration of the previously filed Appeal Brief and Examiner's Answer, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the BPAI at 571-272-9797.

Telephone inquiries related to this decision should be directed to Fred A. Silverberg at 571-272-7719.

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

Kenneth M. Schor

Conferee: Kenneth M. Schor, Senior Legal Advisor

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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1/17/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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McGinn & Gibb, PLC

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Vienna, VA 22182-3817

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/006706

PATENT NO. 5,518,625

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.
90/006,706	07/11/2003	5518625	SUG.001	9747

7590 01/17/2007

RATNER PRESTIA
P.O. BOX 980
VALLEY FORGE, PA 19482-0980

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/17/2007

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

MAILED

JAN 17 2007

CENTRAL REEXAMINATION UNIT

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SEAN M. MCGINN, ESQ. (For Third Party Requester)
MCGINN & GIBB, PLC
8321 OLD COURTHOUSE ROAD, SUITE 200
VIENNA, VA 22182-3817

In re Reexamination Proceeding	:
Priegnitz et al.	:
Control No. 90/006,706	: DECISION GRANTING PETITION
Filed: July 11, 2003	:
U.S. Patent No. 5,518,625	:
Attorney Docket No. JMYT-302US	:

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on December 20, 2006, for entry of late papers (late filed request for oral hearing).

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

37 CFR 1.137(b) states:

> "*Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by: (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in § 1.17(m); (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section."

37 CFR 41.47(b) states:

> If appellant desires an oral hearing, appellant must file, as a separate paper captioned "REQUEST FOR ORAL HEARING," a written request for such hearing accompanied by the fee set forth in § 41.20(b)(3) within two months from the date of the examiner's answer or supplemental examiner's answer.

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.

37 CFR 1.550(e)(2) states:

> (e) If a response by the patent owner is not timely filed in the Office,
>
> (2) The response may nevertheless be accepted if the delay was unintentional; a petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b).

A review of the record reveals that neither a request for an oral hearing nor a request for extension of time were timely filed. 37 CFR 41.47(b) and 37 CFR 1.550(c).

In this instance, 37 CFR 1.550(e)(2) provides an avenue of relief for the patent owner, wherein the request for an oral hearing may be accepted under the guidelines of an unintentionally delayed response set forth in 37 CFR 1.137(b).

The present petition under 37 CFR 1.137(b) includes, inter alia, the requisite response - the Request For Oral Hearing (the fee for the oral hearing was previously paid) (item 1), an authorization to charge counsel's deposit account for the $1,500.00 petition fee under 37 CFR 1.17(m) (item 2), the requisite statement (item 3) and a Certificate of Service to the Third Party Requester.

The petition for entry of the late papers is granted.

The request for oral hearing will be entered as being timely filed. It is noted that the present decision only excuses the delay as to the filing of the request for oral hearing. The decision does not address nor decide whether an oral hearing is necessary. That determination remains at the discretion of the Board of Patent Appeals and Interferences (BPAI).

$1,500.00 has been charged to counsel's deposit account no. 18-0350 in accordance with the present petition.

Jurisdiction over the reexamination proceeding is being returned to the BPAI to address the proceeding in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the BPAI at 571-272-9797.

Telephone inquiries related to this decision should be directed to Fred A. Silverberg at 571-272-7719.

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

Conferee: Kenneth M. Schor, Senior Legal Advisor

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
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FROM DIRECTORS OFFICE

DEC 2 0 2006

TECHNOLOGY CENTER 3600

Venable LLP (For Patent Owner)
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Washington, DC 20043-9998

Jeffery L. Thompson (For Requestor)
310 4th Street
P.O. Box 166
Scandia, KS 66966-0166

In re Reexam Proceeding No. 90/006,707
Filed: July 11, 2003
For: U.S. Patent No. 5,505,464

DECISION ON PETITION
TO RESET A PERIOD
FOR REPLY

This is in reply to the Petition to Reset a Period for Reply Due to Office error, received in the Patent and Trademark Office on September 5, 2006. There is no fee required for this petition.

The petition is **GRANTED**.

A review of the file record reveals that an Examiner's Answer was mailed on April 6, 2006 to Venable, LLP, P.O. Box 34385, Washington, DC 20045-9998.

Petitioner states that the Examiner's Answer was never received and alleges that the Examiner's Answer was mailed to the wrong address. Specifically, petitioner states that the zip code on the mailing address to which the Examiner's Answer was sent is 20045-9998 whereas the correct zip code is 20043-9998.

A review of the file record supports petitioner's allegations. The correct address of record includes the zip code of 20043-9998. The Examiner's Answer was sent to the address with a zip code of 20045-9998.

The application is being forwarded to the Supervisory Legal Instruments Examiner to re-mail and re-date the Examiner's Answer of April 6, 2006.

Telephone inquiries relative to this decision should be directed to Kenneth J. Dorner at the phone number below.

Kenneth J. Dorner, Quality Assurance Specialist
Patent Technology Center 3600
(571) 272-6587
kjd:12/18/06

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SEP 28 2007

TECHNOLOGY CENTER 3600

Andrew C. Aitken
Veneable
P.O. Box 34385
Washington, D.C. 20043-9998

In re Reexam Proceeding No. 90/006707
Filed: July 11, 2003
For: U.S. Patent No. 5,505,464

:PETITION TO INVOKE
:SUPERVISORY AUTHORITY
:UNDER 37 CFR 1.181

This is a decision on applicant's petition filed June 21, 2007 under 37 CFR 1.181 requesting entry of the Reply Brief filed on March 30, 2007. There is no fee required for this petition.

The petition is **DENIED.**

After review of the above file, the file history shows that an Appeal Brief was filed on March 2, 2006. In response to the Appeal Brief, the examiner wrote an Examiner's Answer, which was mailed on April 6, 2006 and then again on January 31, 2007 in response to a petition to restart the response period. In response to the Examiner's Answer, the applicant filed a Reply Brief on March 30, 2007. After receiving the Reply Brief, the examiner then sent out an letter indicating that the Reply Brief would not be considered because it is not in compliance with 37 CFR 41.41(a). The reply brief has not been considered pursuant 41.41 because new evidence is prohibited in a reply brief. In response to the examiner's letter, the applicant then filed this Petition on June 21, 2007. The applicant is requesting to have the Reply Brief entered, to remove Exhibits A-C which contain the new evidence, and to forward Appellant's Reply Brief to the Board of Patent Appeals and Interferences.

The Appellant argues that the Examiner's refusal to consider the Reply Brief is contrary to law. The Appellant also argues that no evidence was submitted because the courts have considered the role of dictionaries in connection with claim interpretation exercises and endorsed their use. Therefore, the Appellant takes the position that the exhibits are not new evidence.

In response to the argument that the Examiner's refusal to consider the Reply Brief is contrary to law, the Appellant is directed to the rules section of the MPEP, specifically 37 CFR 41.41. The rule states in 37 CFR 41.41(b) that if the reply brief is not in compliance with paragraph (a) of the section, then the reply brief will not be considered. Therefore the Examiner followed the procedure of the MPEP and 37 CFR 41.41(b) and did not take a position that is contrary to law.

In response to the argument that a dictionary definition is not new evidence, the Appellant has cited several court decisions that state that judges may consult the dictionary at any time. However, the cases that the Appellant cite are all in reference to court proceedings and not to 37 CFR 41.41. Neither 37 CFR 41.2 the *Definitions*, nor 37 CFR 41.41(a) specifically defines the term *evidence*. Therefore, one would have to rely on the level of skill of one of ordinary skill in the art and the dictionary definition of evidence. Thus, according to www.dictionary.com, the term evidence means "A thing or things helpful in forming a conclusion or judgment". Dictionary.com also indicates that synonyms for evidence are "information, deposition, and affidavit". Therefore, it appears that the definition of evidence would encompass any information, deposition, or affidavit that would help one to form a conclusion or judgment. Thus, since dictionary definition would help one form a conclusion or judgment, it would clearly be considered as evidence. Hence, since Exhibits provided by the Appellant in the Reply Brief were not cited previously on any PTO-892 or PTO-1449 they are considered to be new evidence. Therefore, the examiner's position on the new evidence appears to be well founded and correct.

For the above reasons, it is believed that the Exhibits submitted in the appendices would constitute new evidence. Therefore, since a Reply Brief cannot contain new evidence, the Appellant's Reply Brief will not be entered on those grounds.

The Appellant's request to have the Reply Brief entered is **DENIED** for the reasons set forth above.

The request to remove the Exhibits from the prosecution history and to consider the Reply Brief is **DENIED** because it is part of the Reply Brief and the Reply Brief incorporates them in footnotes.

In conclusion, the application will be forwarded to the Board of Patent Appeals and Interferences so they may render their decision. Also, it is not believed that the applicant is owed any further relief at this time.

SUMMARY: The petition is **DENIED**

Any questions regarding this decision should be directed to Patricia Engle at 571-272-6660.

Donald T. Hajec
Director
Patent Technology Center 3600
571-272-5150

PLE/KD: 9/7/07

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,707	07/11/2003	5505464	GCI-001	3177

26694 7590 02/29/2008
VENABLE LLP
P.O. BOX 34385
WASHINGTON, DC 20043-9998

EXAMINER
PICKARD, ALISON K

ART UNIT	PAPER NUMBER
3676	

MAIL DATE	DELIVERY MODE
02/29/2008	PAPER

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

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

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TECHNOLOGY CENTER 3600

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For the Requester:

Jeffrey L. Thompson
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PETITION FOR RECONSIDERATION OF DENIAL OF PETITION TO ACCEPT REPLY BRIEF

In re Reexamination proceeding 90/006,707
Filed: July 11, 20013
For: MINIMUM DEAD VOLUME FITTING

This is a decision on Patent Owner's petition filed on October 25, 2007 for reconsideration of the denial of the petition filed June 21, 2007 under 37 CFR 1.181 requesting entry of the Reply Brief filed on March 30, 2007. There is no fee required for this petition.

The petition is **DENIED.**

After review of the above file, the file history shows that an Appeal Brief was filed on March 2, 2006. In response to the Appeal Brief, the examiner wrote an Examiner's Answer, which was mailed on April 6, 2006 and then again on January 31, 2007 in response to a petition to restart the response period. In response to the Examiner's Answer, the Patent Owner filed a Reply Brief on March 30, 2007. After receiving the Reply Brief, the examiner then sent out an letter indicating that the Reply Brief would not be considered because it is not in compliance with 37 CFR 41.41(a). The reply brief has not been considered pursuant 41.41 because new evidence is prohibited in a reply brief. In response to the examiner's letter, the Patent Owner then filed this Petition on June 21, 2007. The appellant requested to have the Reply Brief entered, to remove Exhibits A-C which contain the new evidence, and to forward Appellant's Reply Brief to the Board of Patent Appeals and Interferences. That petition was denied. Appellant is now requesting that the previous petition decision be reconsidered and the Reply Brief entered or that a redacted version of the Reply Brief be forwarded to the Board of Patent Appeals and Interferences.

The Appellant argues that the dictionary definitions and Exhibits presented in the Reply Brief of March 30, 2007 should not be considered new evidence and thus the Reply Brief should be considered. Appellant goes on to argue that when dealing with appeal proceedings, one of ordinary skill in the art would rely on the legal understanding of term "evidence" and not merely the colloquial meaning of the term or layman's understanding of the term as found in a dictionary.

In response to the argument that a dictionary definition is not new evidence, the position is maintained dictionary definitions are considered to be evidence and as the definitions and exhibits in question were first presented in the Reply Brief the decision to deny the previous petition followed the procedure of the MPEP and 37 CFR 41.41(a)(2) and (b) and did not take a position that is contrary to law.

In response to the argument that a layman's dictionary cannot be used to ascertain the meaning of terms in a legal proceeding such as appeals, while it is believed that the use of any dictionary to define the term evidence would be permissible, turning to legal/law dictionaries or judicial entities one can determine that a dictionary definition for the purposes of presenting facts to prove a fact, point, or allegation would be considered evidence. This is according to *Black's Law Dictionary* which defines "evidence" as "Any species of proof, or probative matter, legally presented at the trial of an issue, by the act of the parties and through the medium of witnesses, records, documents, exhibits, concrete objects, etc., for the purpose of inducing belief in the minds of the court or jury as to their contention." Evidence is also defined by Utah State Courts, www.utcourts.gov/resources/glossary.htm, as "Testimony, records, documents, material objects, or other things presented at a trial to prove the existence or nonexistence of a fact." and by the State of Arkansas, www.arkansasresearch.com/g-gloss.html, as "facts that indicate whether or not something is true; proof." Similar definitions are adopted by other states and court systems. Thus, since dictionary definitions would help one form a conclusion or judgment or prove a fact, point, or allegation, they would clearly be considered as evidence. Hence, since Exhibits provided by the Appellant in the Reply Brief were not cited previously on any PTO-892 or PTO-1449 they are considered to be new evidence. Therefore, the position in the previous petition decision on the new evidence is well founded and correct.

The Appellant argues that the definition of evidence adopted in the previous petition decision is too broad and would result in the preclusion of material that are obviously contemplated by the rules such as the reply brief itself. Appellant also argues that further evidence that the preclusion of dictionary definitions is inappropriate can be found in other aspects of the 37 CFR such as the rules that govern interference practices.

In response to the argument that the broad definition of evidence adopted in the previous petition decision was too broad and would preclude even a reply brief from

being considered, reply briefs are part of the appeal process and are not considered to be new evidence themselves when filed. Facts and documentation not previously submitted to the Office and relied upon by the Appellant in a reply brief as proof for their position is considered to be new evidence.

In response to the argument that preclusion of dictionary definitions is inappropriate as such evidence is allowed in interference proceedings, the practices and laws that govern appeal proceedings are different from those that apply to interference proceedings and as such their respective laws cannot be interchanged. When determining what is permissible and what is not in an appeal proceeding, specifically a reply brief, one must rely on what is stated in 37 CFR 41.41.

For the above reasons, it is believed that the decision rendered in the Petition Decision of September 28, 2007 was correct and it will be maintained. The Exhibits submitted in the appendices of the Reply Brief of March 30, 2007 would constitute new evidence. Therefore, since a Reply Brief cannot contain new evidence, the Appellant's Reply Brief will not be entered on those grounds. The Appellant's request to have the Reply Brief entered is **DENIED** for the reasons set forth above.

The request to have a redacted version of the Reply Brief filed with the instant petition is **DENIED** because the time period for filing a reply brief has expired. 37 CFR 41.41(a)(1) states that Appellant may file a reply brief within two months of the mailing of the examiner's answer and 37 CFR41.41(c) states that an extension of time is not applicable to the filing of reply briefs.

In conclusion, the Reexamination proceeding will be forwarded to the Board of Patent Appeals and Interferences so they may render their decision. Also, it is not believed that the Patent Owner is owed any further relief at this time.

SUMMARY: The petition is **DENIED**

Any questions regarding this decision should be directed to Jennifer H. Gay at 571-272-7029.

Donald T. Hajec
Director
Patent Technology Center 3600
571-272-5150

JHG/SM: 2/14/08

SM

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OFFICE OF PETITIONS

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For the Requester:

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ON PETITION

In re Reexamination proceeding 90/006,707
Filed July 11, 2003
For: MINIMUM DEAD VOLUME FITTING

This is a decision on Patent Owner's petitions filed April 25, 2008, (1) under 37 CFR 1.181(a)(3) requesting that the Director exercise his supervisory authority and overturn the decision of the Director, Technology Center 3600 (Technology Center Director), dated February 29, 2008, which refused to compel the entry of the reply brief filed March 30, 2007 and October 25, 2007, and (2) under 37 CFR 1.183 requesting waiver of the rules which prohibit entry of affidavits or other evidence filed after the date of filing an appeal, or permit entry of the reply brief or the redacted reply brief.

The petition to overturn the decision of the Technology Center Director dated February 29, 2008 and the petition requesting waiver of the rules are **DENIED**[1].

BACKGROUND

On March 2, 2006, an Appeal Brief was filed.

On April 6, 2006, an Examiner's Answer was mailed.

On January 31, 2007, the Examiner's Answer was remailed in response to a petition to restart the response period.

A reply brief was filed on March 30, 2007.

On June 4, 2007, a letter was mailed indicating the reply brief was not considered because it contained new evidence and thus, was not in compliance with 37 CFR 41.41(a).

On June 21, 2007, a petition requesting entry of the reply brief was filed.

On September 28, 2007, a decision denying the June 21, 2007 petition was mailed.

On October 25, 2007, a request for reconsideration of the petition decision of September 28, 2007 was filed along with a request to enter a redacted reply brief.

On February 29, 2008, a decision denying the October 25, 2007 request for reconsideration was mailed.

The instant petition was filed April 25, 2008.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

37 CFR 1.181(f) states:

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

37 CFR 1.183 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 41.33(c)(2) states:

All other affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1).

37 CFR 41.41 states:

(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.

37 CFR 41.152 states:

(a)Generally. Except as otherwise provided in this subpart, the Federal Rules of Evidence shall apply to contested cases.
(b)Exclusions. Those portions of the Federal Rules of Evidence relating to criminal proceedings, juries, and other matters not relevant to proceedings under this subpart shall not apply.

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).

MPEP 1208 I states:

> Any reply brief must also be in compliance with requirements set forth in 37 CFR 41.41. New or non-admitted affidavits, and/or other evidence are not permitted in a reply brief.

MPEP 2273 states:

> The normal *ex parte* appeal procedures set forth at 37 CFR 41.31 through 37 CFR 41.54 apply in ex parte reexamination, except as pointed out in this Chapter.

OPINION

Petitioner seeks reversal of the Technology Center Director's decision of February 29, 2008, on the grounds that the dictionary definitions cited in the reply brief were in response to new arguments first raised in the Examiner's Answer and are appropriate and that dictionary definitions are not considered to be "evidence" in patent matters but are rather considered as authority similar to legal citations. Accordingly, petitioner further contends that the reply brief filed March 30, 2007 should be entered and if not entered then a redacted copy of the reply brief which redacted copy was filed October 25, 2007 should be entered.

Petitioner argues that the reply brief of March 30, 2007 should be entered, as it did not present evidence filed after the date of filing an appeal, in that dictionary definitions are not evidence. Specifically, petitioner states: (1) the term "evidence" is vague and ambiguous and not defined by the rule; (2) Federal Circuit authority holds that dictionary definitions may be considered by the federal courts *sua sponte* and, as such, dictionaries are not characterized as "evidence" because dictionaries are not introduced into the respective evidentiary records; and (3) the USPTO has expressly adopted the Federal Rules of Evidence in reexamination and interference proceedings. Firstly the term "evidence," under the Federal Rules of Evidence, is information having any tendency to make the existence of any fact that is of consequence to the determination of the action more probable or less probable than it would be without the information. Accordingly, dictionary definitions would be considered evidence. In addition, the instant reexamination proceeding is currently under appeal to the Board of Patent Appeals and Interferences and the normal *ex parte* appeal procedures set forth at 37 CFR 41.31 through 37 CFR 41.54 apply in *ex parte* reexamination; 37 CFR 41.152, which addresses the Federal Rules of Evidence, only applies to the "Contested Cases" subpart of Part 41, which does not include either *ex parte* or *inter partes* reexamination. Even further, to the extent 37 CFR 41.152 addresses the Federal Rules of Evidence, they only apply if not otherwise provided for in the "Contested Cases" Subpart of Part 41; see 37 CFR 41.152, *supra*. The present situation is governed by 37 CFR

41.33(c)(2), and 37 CFR 41.41, *supra*, and it is the interpretation of those regulations that applies. As explained in MPEP 1208 I, new or non-admitted affidavits, and/or other evidence are not permitted in a reply brief. Therefore, the entry of a reply brief with any new or non-admitted dictionary definitions is not permitted.

For the reasons set forth above, the Technology Center Director's decision to refuse petitioners' request to compel the entry of the reply briefs filed March 30, 2007 and October 25, 2007 is not shown to be in clear error.

Petitioner further requests suspension of the rules to consider the reply brief or a redacted version of the reply brief which omits all substantive references to the exhibits and definitions.

The issue at hand is not whether petitioner in good faith followed the rules as he interpreted them; rather it is whether petitioner has properly followed the statutes and regulations with the exercise of reasonable care and diligence in this instance. In the instant case, petitioner filed a reply brief with new or non-admitted evidence therein and then, after receiving a decision dismissing a petition requesting entry of the reply brief, attempted to file a redacted version of the reply brief. As the Technology Center Director correctly noted in his decision of February 29, 2008 the redacted reply brief was filed after the time period for filing a reply brief had expired. No extension of time under 37 CFR 1.550(c) or 41.41 was timely filed. In order for grant of any petition under 37 CFR 1.183, 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 condition exists in this case. Petitioners' failure to timely file an acceptable reply brief is not an extraordinary situation which, when justice requires, waiver of the rules.

Circumstances resulting from petitioners', or petitioners' 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).

For the reasons set forth above, the petition will not be granted as to the request for waiver of the rules.

DECISION

A review of the record indicates that the Technology Center Director did not abuse his discretion or act in an arbitrary and capricious manner in the petition decision of February 29, 2008. The record establishes that the Technology Center Director had a

reasonable basis to support his findings and conclusion. In addition, petitioner has not shown the existence of an extraordinary situation in which justice requires, waiver of the rules to consider the proffered reply brief or a redacted version of the reply brief which omits all substantive references to the exhibits and definitions.

The petition is granted to the extent that the decision of the Technology Center Director of February 29, 2008 has been reviewed, but is denied with respect to making any change therein. As such, the decision of February 29, 2008 will not be disturbed. The refusal to enter the reply briefs of March 30, 2007 and October 25, 2007, will not be disturbed, and the rules will not be waived to provide for such entry. The petition is **denied**.

Telephone inquiries concerning this decision should be directed to David A. Bucci at (571) 272-7099.

John J. Love
Deputy Commissioner for
Patent Examination Policy

cp

[1] 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

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OFFICE OF PETITIONS

For the Patent Owner:

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ON PETITION

In re Reexamination proceeding 90/006,707
Filed July 11, 2003
For: MINIMUM DEAD VOLUME FITTING

This is a decision on Patent Owner's petition filed October 8, 2008 under 37 CFR 41.3(b) and 41.35(b) requesting the Chief Administrative Patent Judge withdraw the Notification of Non-compliant appeal brief dated June 4, 2007.

The petition is **DENIED.**

The Chief Administrative Patent Judge, in a petition decision mailed November 6, 2008, referred the instant petition to the Office of the Deputy Commissioner for Patent Examination Policy as it concerns an issue that arose in an *ex parte* reexamination proceeding while jurisdiction over the proceeding resided in the Technology Center and before jurisdiction had transferred to the Board of Patent Appeals and Interferences. As this petition arises from the decision of a Technology Center Director and as the authority for deciding petitions to review a decision of a Technology Center Director has been delegated to the Deputy Commissioner for Patent Examination Policy (MPEP 1002.02(b)(15)), the issue of withdrawing the Notification of Non-compliant appeal brief

dated June 4, 2007 is properly treated by the Deputy Commissioner for Patent Examination Policy.

The issue of withdrawing the Notification of Non-compliant appeal brief dated June 4, 2007 was fully and finally treated in the decision of June 2, 2008. The decision clearly stated it was a final agency action within the meaning of 5 U.S.C. § 704 for purposes of petitioner's seeking judicial review, and further, that the USPTO would not further consider or reconsider this matter.

Petitioner's currently argues that "on July 18, 2008 in *Ex parte Scroggie*, Appeal No. 2008-4478, Application No. 09/401,939 the Board of Appeals considered an analogous and almost identical issue and reached the opposite conclusion as the Commissioner." Petitioner states that in *Ex parte Scroggie* the Board held: (1) that 37 CFR 41.37(c)(1)(ix) which sets forth the types of evidence that must be presented in the evidence appendix of an appeal brief, does not identify that a dictionary definition that must be presented in the evidence appendix for such definitions to be considered by the Board in an *ex parte* appeal; and (2) that the merits panel was free to consider the dictionary definition recited in the Appellant's brief. Thus, petitioner concludes that "the Board held that dictionary definitions are not considered "evidence" in connection with the patent appeal process."

The Board of Patent Appeals and Interferences *in Ex parte Scroggie* does not address reply briefs and states in item 4 of the decision, "37 C.F.R. § 41.37 (c)(1)(ix), which sets forth the types of evidence that must be presented in the evidence appendix of an appeal brief, does not identify dictionary definitions as a type of evidence that must be presented in the evidence appendix for such definitions to be considered by the Board in an ex parte appeal." The decision in *Ex parte Scroggie* does not state, as petitioner incorrectly implies, that dictionary definitions are not evidence rather it states that dictionary definitions are a type of evidence that need not be in the evidence appendix. Accordingly, as set forth in the previous decision mailed June 2, 2008, dictionary definitions are a form of evidence and new evidence is not permitted in a reply brief.

Petitioner is reminded of the finality of the agency action mailed June 2, 2008. Any time limits for taking further action continue to run from the mail date of that final agency action.

John J. Love
Deputy Commissioner for
Patent Examination Policy

cp

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,707	07/11/2003	5505464	GCI-001	3177

7590 08/05/2009
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ART UNIT	PAPER NUMBER
3676	

MAIL DATE	DELIVERY MODE
08/05/2009	PAPER

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte McGARVEY

Appeal No. 2009-007210
Reexamination Control No. 90/006,707
Patent No. 5,505,464

Decided: August 4, 2009

DECISION ON PETITION

This is a decision on Patent Owner's "Petition to the Chief Administrative Patent Judge to Consider the Patentee's Reply Brief," filed June 23, 2009 ("Petition"), seeking entry and consideration of Patent Owner's Reply Brief containing dictionary definitions that were first presented in the Reply Brief filed March 30, 2007.

FINDINGS

1. Most of the lengthy proceedings leading up to the present Petition are described in the Decision on Petition by the Chief Administrative Patent Judge, dated November 6, 2008. In that Decision, Patent Owner's request to have the Reply Brief entered and considered was referred for decision to the Office of the Deputy Commissioner for Patent Examination Policy because

at that time jurisdiction over this reexamination resided with Technology Center 3600.

2. Upon referral of the matter to the Office of the Deputy Commissioner for Patent Examination Policy, the Deputy Commissioner, on December 22, 2008, entered a decision confirming his previous denial on June 2, 2008 of Patent Owner's request to have the Reply Brief considered.

3. In this reexamination on appeal, a docketing notice was issued on April 7, 2009, and jurisdiction over the appeal has now passed to the Board of Patent Appeals and Interferences ("Board").

4. Patent Owner cites and quotes from *Phillips v. AWH Corp.*, 415 F.3d 1303, 1324 (Fed. Cir. 2005) as follows:

> [A] judge who encounters a claim term while reading a patent might consult a general purpose or specialized dictionary to begin to understand the meaning of the term, before reviewing the remainder of the patent to determine how the patentee has used the term.

Petition at p. 5.

5. The Examiner, in the Examiner's Answer, cited for the first time a dictionary definition bearing on the interpretation of a claim term. Ans. at p. 5.

6. In a "Petition to the Office of Petitions for Reconsideration of the Director's Denial of Applicant's Petition to Accept Reply Brief," filed April 25, 2008, Patent Owner argued that the citation of dictionary definitions in the Reply Brief was in response to the citation of a dictionary definition and new arguments presented in the Examiner's Answer. Pet. at pp. 5-7.

7. The Decision of the Deputy Commissioner of Patents for Patent Examination Policy of June 2, 2008, states that:

> Petitioner seeks reversal of the Technology Center Director's decision . . . on the grounds that the dictionary definitions cited in the reply brief were in response to new arguments raised in the Examiner's Answer . . . .

Decision at p. 4.

DISCUSSION

A panel of administrative patent judges at the Board may consider dictionary definitions to assist it in determining the scope of claims under review. The panel may use a dictionary definition found *de novo* by the panel. This approach was sanctioned by the Federal Circuit in *Phillips, supra.*

As indicated, the Examiner cited a dictionary definition for the first time in the Examiner's Answer. FF 5. Thus, the Examiner recognized that the Board may rely *de novo* on a dictionary definition for determining claim scope.

DECISION

In view of the foregoing, the present Petition to the Chief Administrative Patent Judge is GRANTED. Patent Owner's Reply Brief, including the dictionary definitions included therein, shall be considered by the merits panel to which this appeal is assigned.

Michael R. Fleming
Chief Administrative Patent Judge

Patent Owner:

Andrew C. Aitken
Aitken Law Offices
P.O. Box 1810
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Third Party Requester:

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Cantor Colburn, LLP (For Patent Owner)
55 Griffin Road South
Bloomfield, CT 06002

Enclosure: Materials ("references A - D") stated to be proprietary, submitted with November 1, 2004 petition.

John C. Hilton (For Requester)
McCormick Paulding & Huber LLP
185 Asylum Street City Place 11
Hartford CT 06103

MAILED
MAY 10 2005
REEXAM UNIT

In re Swei et al.	:
Reexamination Proceeding	: DECISION
Control No. 90/006,708	: DISMISSING
Filed: July 14, 2003	: PETITION
For: U.S. Patent No. 5,312,576	:
	:

This is a decision on the November 1, 2004 patent owner petition titled PETITION UNDER 37 CFR 1.59(b) TO EXPUNGE ACCOMPANYING INFORMATION SUBMITTED UNDER M.P.E.P. § 742.02.

The petition is addressed in two respects:

(1) Under 37 CFR 1.59(b) as a request to expunge papers from the instant reexamination proceeding.

(2) Under 37 CFR 1.182 as a request that certain materials ("references A - D") submitted as proprietary during the reexamination proceeding be sealed, i.e., a situation not specifically provided for in the regulations.

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

SUMMARY

(1) The petition under 37 CFR 1.59(b) for expungement of materials is dismissed, since it is not ripe for decision. As will be discussed below, a decision as to whether the materials submitted as proprietary with the present petition should be expunged from the instant reexamination proceeding is premature at this point.

(2) The petition, as it is taken under 37 CFR 1.182 to seal papers, is granted to the extent that the materials submitted as proprietary (references A - D, which accompanied the present petition) will not be scanned into the file history for the instant reexamination proceeding, nor otherwise made available to the public.

(3) The materials that were submitted as proprietary (references A - D, which accompanied the present petition) are being returned to the patent owner with this decision for re-submission, if patent owner so desires, in compliance with MPEP 742.02.

REVIEW OF FACTS

1. U.S. patent No. 5,312,576 issued on May 17, 1994.

2. A request for reexamination, assigned control No. 90/005,169, was filed by a third party requester on November 25, 1998. A reexamination certificate (# 4041) was issued for the '5169 proceeding on April 18, 2000.

3. A request for reexamination, assigned control No. 90/006,708 (the instant '6708 proceeding), was filed by a third party requester on July 14, 2003.

3. Reexamination was ordered for the instant '6708 reexamination proceeding on September 30, 2003.

4. Prosecution has progressed to the point where a non-final Office action has been issued on March 21, 2005.

5. On November 1, 2004, the patent owner filed the present petition titled "PETITION UNDER 37 CFR 1.59(b) TO EXPUNGE ACCOMPANYING INFORMATION SUBMITTED UNDER M.P.E.P. § 742.02." "References A - D accompanied the petition. This petition was matched with the file history in late March of 2005, and the payment of the petition fee was entered into the Office records on March 24, 2005.

DECISION

Addressing the present petition requires a decision as to whether relief is appropriate in two areas, provided for by 37 CFR 1.59(b) and 37 CFR 1.182, respectively.

I. PETITION UNDER 37 CFR 1.59(b)

1. The first two sentences of the single paragraph of the petition state:

> "Applicant hereby petitions under 37 CFR § 1.59(b) to expunge the information submitted herewith under MPEP § 724.02. The information submitted herewith and for which Applicant petitions to be expunged is propriety, and the information has not otherwise bee made public to the knowledge of Applicant."

The present record **does not** reflect that the materials submitted with the petition as proprietary were submitted in compliance with MPEP 724.02. MPEP 724.02 states in part (Emphasis added):

> "Information which is considered by the party submitting the same to be either trade secret material or **proprietary material**, and any material subject to a protective order, **must be clearly labeled as such and be filed in a sealed, clearly labeled, envelope or container. Each document or item must be clearly labeled as** a "Trade Secret" document or item, **a "Proprietary" document or item,** or as an item or document "Subject To Protective Order." ... Of course, **the envelope or container, as well as each of the documents or items, must be labeled with complete identifying information for the file to which it is directed, including the Office or area to which the envelope or container is directed.**

"Examples of appropriate labels for such an envelope or container addressed to an application are as follows: (Appropriate changes would be made for papers filed in a reexamination file.)

A....

B. "PROPRIETARY MATERIAL NOT OPEN TO PUBLIC. TO BE OPENED ONLY BY EXAMINER OR OTHER AUTHORIZED U.S. PATENT AND TRADEMARK OFFICE EMPLOYEE.

DO NOT SCAN
In re Application of
Application No.
Filed:
For: (Title of Invention)
TC Art Unit:
Examiner:

C....

The envelope or container must be accompanied by a transmittal letter which also contains the same identifying information as the envelope or container. The transmittal letter must also state that the materials in the envelope or container are considered trade secrets or proprietary, or are subject to a protective order, and are being submitted for consideration under MPEP § 724."

In the present instance, the information from the Central Reexamination Unit clerical staff is that the present papers were received "loose," and not in an envelope or container. Also, the submitted "references A - D" are not clearly labeled as a "Proprietary" document or item, and are not labeled with identifying information for the file to which the "references" are directed.

Fortunately, the Central Reexamination Unit clerical staff noted petitioner's statement in the title of the transmittal (for the petition and the materials) that the materials were proprietary. Accordingly, the materials were not scanned into the electronic reexamination file, and were instead forwarded for the present decision.

Because the materials were not submitted in conformance with MPEP 742.02, while the patent owner states that the materials are proprietary, they are being returned to the patent owner with this decision, so that patent owner may re-submit the materials in compliance with MPEP 742.02, if the patent owner so desires.

Because "references A - D" are being returned, there is nothing to expunge, and the petition to expunge is premature. The petition must accordingly be dismissed.

2. Even if the submission were in compliance with MPEP 742.02, the petition for expungement of the "references"under 37 CR 1.59(b) would be premature, based on the following:

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 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.

Even if the submission were in compliance with MPEP 742.02, it would 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, a decision on the petition to expunge would be premature and would need to be held in abeyance at this point in time. If the patent owner re-submits the materials (references A - D) in compliance with MPEP 742.02, and if the examiner issues a determination in an Office action on the merits that the material requested to be expunged is not "important to a reasonable examiner in deciding whether

or not a claim is patentable, then 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 reviewed to make certain that the petition to expunge is complete as to all requirements for same.

3. If the patent owner re-submits the materials ("references A-D") in compliance with MPEP 742.02, a petition under 37 CR 1.59(b) to expunge is not to accompany them. As pointed out, the matter of expungment is held in abeyance, pending renewal of same by patent owner at an appropriate time. **The patent owner is, however, cautioned** that the petition under 37 CR 1.59(b) to expunge should be renewed after a Notice of Intent to Issue Reexamation Certificate is issued for the instant reexamination proceeding. **A failure to <u>timely</u> renew the petition to expunge after a Notice of Intent to Issue Reexamation Certificate is issued and 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.**

II. DECISION ON PETITION UNDER 37 CFR 1.182

The patent owner's statement that "references A - D" are proprietary is taken as a request under 37 CFR 1.182 that "references A - D," which were not submitted in an envelope or container, be **sealed**, so that such papers are no longer "accessible to the public."

While the petition to expunge the confidential materials from the file will not be granted, *it is appropriate* that the proprietary materials be "sealed" from public view prior to their return to the patent owner. Such sealing would further the interest in maintaining the confidentiality of the "references" stated by the patent owner to be proprietary. Accordingly, while the present petition and its transmittal will be scanned into the electronic reexamination file record, **the attached "references A - D" will not be scanned into the record**. "References A - D" will be held unavailable to the

public, until they are returned to the patent owner together with this decision. [1]

CONCLUSION

1. The petition under 37 CR 1.59(b) is dismissed as not being ripe for decision.

2. The petition to seal proprietary materials under 37 CR 1.182 is granted to the extent that the materials submitted as proprietary (accompanying the present petition) will not be scanned into the file history for the instant reexamination, nor otherwise made available to the public.

3. The materials submitted as proprietary (accompanying the present petition) are being returned to the patent owner with this decision, to provide an opportunity for re-submission in compliance with MPEP 742.02, if patent owner so desires. If the patent owner does re-submit the materials in compliance with MPEP 742.02, a petition under 37 CR 1.59(b) to expunge would not accompany them, but would rather be renewed after a Notice of Intent to Issue Reexamination Certificate is issued for the instant reexamination proceeding.

4. The present petition and its transmittal, as well as this decision will be scanned by the CRU into the record. **The "references A - D" submitted the petition will not be scanned in.**

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[1] It is to be noted that prior to the CRU's taking note of the patent owner's statement of the proprietary nature of the materials, they might have been made available to the public and subject to copying based upon the reexamination proceeding being open to the public, 37 CFR 1.11(d). Thus, the Office cannot guarantee that the materials were not previously accessed by the public.

5. **Patent owner is reminded that** the time for response to the non-final Office action of March 21, 2005, continues to run, and that the Office action must be timely responded to, in order to keep the proceeding pending.

6. The reexamination proceeding is being forwarded to the Technology Center (TC 1700).

7. Any questions regarding this decision should be directed to the undersigned at (571) 272-7710.

8. Telephone inquiries related to the examination of the reexamination proceeding should be directed to Examiner Allan Kuhns of Art Unit 1732 at (571) 272-1202.

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

May 9, 2005
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MAILED

JUN 21 2005

REEXAM UNIT

In re Swei et al.
Reexamination Proceeding
Control No. 90/006,708
Filed: July 14, 2003
For: U.S. Patent No. 5,312,576

DECISION IN RESPONSE TO
37 CFR 1.59(b) PETITIONS

This is a decision in response to the May 25, 2005, and June 6, 2005 patent owner petitions under 37 CFR 1.59(b) To expunge accompanying information submitted under MPEP § 742.02.

The petitions are before the Office of the Patent Legal Administration of the United States Patent and Trademark Office.

The petition fee for a petition under 37 CFR 1.59(b) is set to be $200 in 37 CFR 1.17(g). Accordingly, a total fee of $400 has been charged for the two petitions to petitioner's Deposit Account No. 06-1130, in accordance with petitioner's authorization in the sole paragraph of the two petition transmittals.

The decision on the two petitions will be held in abeyance until the examiner has issued a determination on the merits on the issue of importance of the sealed information submitted pursuant to MPEP 724.04(c), at which time the petitions to expunge may be renewed by the patent owner. **The patent owner is cautioned that if a Notice of Intent to Issue Reexamination Certificate (NIRC) is issued for the instant reexamination proceeding, both petitions under 37 CR 1.59(b) to expunge should be renewed promptly after the issuance of the NIRC.**

DECISION RESPONDING TO PETITIONS

In the May 25, 2005 petition, petitioner requests expungement from the record of the documents entitled "attached material references A-C," which were filed May 25, 2005, with the petition.

In the June 6, 2005 petition, petitioner requests expungement from the record of the document entitled "attached material reference A," which was filed June 6, 2005, with the petition.

Petitioner states that the information in the references contains material that is subject to a protective order, and that the information has not otherwise been made public ("to the knowledge of the Applicant"). The petition fee set forth in 37 CFR 1.17(g) has been paid for both petitions.

A decision on the two petitions for expungement of the references under 37 CFR 1.59(b) would be premature at this point, and the decision on each of the petitions is held in abeyance, in view of the following:

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 proceeding 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 submitted pursuant to MPEP 724.04(c), 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. Such a determination has not yet been issued by the examiner, for the references accompanying the two petitions.

Thus, a decision on the two petitions 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 (submitted pursuant to MPEP 724.04(c)) in an Office

action on the merits (as discussed above), the petitions to expunge **may be renewed** by patent owner. No further fee need be submitted upon renewal of the petitions, since the fee has been paid for the decisions. **The patent owner is cautioned** that if a Notice of Intent to Issue Reexamination Certificate (NIRC) is issued for the instant reexamination proceeding, the petitions under 37 CR 1.59(b) to expunge should be **promptly** renewed after the issuance of the NIRC. **A failure to timely renew the petitions to expunge after a Notice of Intent to Issue Reexamination Certificate is issued and 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.** If the petitions to expunge are renewed by patent owner, the paper renewing the petitions should be addressed to the Technology Center, and it is suggested that the patent owner also telephone a Technology Center Special Program Examiner to coordinate review of the renewed petitions prior to forwarding the proceeding for publication of the reexamination certificate.

SEALING OF PAPERS SUBMITTED WITH THE MAY 25, 2005 PETITION

1. In this instance, the information from the Central Reexamination Unit (CRU) clerical staff is that none of the papers accompanying the May 25, 2005 petition were received by the CRU in an envelope or container. The Central Reexamination Unit clerical staff noted petitioner's statement in the title of the transmittal (for the May 25, 2005 petition and the materials) that the materials were proprietary. Accordingly, the materials were not scanned into the electronic reexamination file, and were instead forwarded for the present decision.

2. Action to be taken by the Central Reexamination Unit (CRU) as to the May 25, 2005 petition and materials:

A. The appropriate CRU personnel will immediately seal the paper copy of references A - C as follows:

i. Place references A - C in a sealed, clearly labeled, envelope or container.

ii. Provide a label, or enter information, on the envelope:

1) Set forth on the envelope or container -- "PROPRIETARY MATERIAL NOT OPEN TO PUBLIC. TO BE OPENED ONLY BY EXAMINER OR OTHER AUTHORIZED PATENT AND TRADEMARK EMPLOYEE; DO NOT SCAN." [1]

2) Set forth the appropriate reexamination information (reexamination control number, filing date, patent owner, inventors, examiner, Art Unit) for the present reexamination.

iii. Forward the sealed envelope or container to the Technology Center.

B. The CRU will also ensure that the petition transmittal paper, and the petition are scanned into the Image File Wrapper (IFW) for the instant reexamination proceeding.

3. Action to be taken by the Technology Center (TC) as to the May 25, 2005 petition and materials:

Upon receipt of the envelope or container, the Technology Center will place the envelope or container in the Artifact folder for the instant reexamination proceeding.

SEALING OF PAPERS SUBMITTED WITH THE JUNE 6, 2005 PETITION

In this instance, the transmittal for the June 6, 2005 petition appears in the Image File Wrapper (IFW) for the instant reexamination proceeding. The petition itself does not. Accordingly, the CRU will ensure that the June 6, 2005 petition is scanned into the IFW for the instant reexamination proceeding.

As to the "reference A" that was submitted with the petition, the Technology Center has already placed the filed envelope containing that reference in an Artifact folder for the instant reexamination proceeding.

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[1] This is the label used by patent owner on the references A-C.

CONCLUSION

1. The decision on the two petitions under 37 CR 1.59(b) will be held in abeyance until the examiner has issued a determination (in an Office action on the merits) on the issue of importance of the sealed information, i.e., the "references," submitted pursuant to MPEP 724.04(c), at which time the petitions to expunge may be renewed by the patent owner. No fee will be required with the renewal, as it has already been paid.

2. **The patent owner is cautioned that if a Notice of Intent to Issue Reexamination Certificate (NIRC) is issued for the instant reexamination proceeding, the petitions under 37 CR 1.59(b) to expunge should be promptly renewed after the issuance of the NIRC.** Such a paper renewing the petitions should be addressed to the Technology Center, and it is suggested that the patent owner also telephone a Technology Center Special Program Examiner to coordinate review of the renewed petitions prior to forwarding the proceeding for publication of a reexamination certificate. **A failure to timely renew the petitions to expunge after a Notice of Intent to Issue Reexamination Certificate is issued and 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 reexamination proceeding is being forwarded to the CRU for processing.

   A. The May 25, 2005 petition and its transmittal, as well as this decision will be scanned by the CRU into the record. **The "references A-C" submitted with the petition will not be scanned in.**

   B. The paper copy of reference A-C (submitted with the May 25, 2005 petition) will be sealed in an envelope or container as provided for above.

   C. The June 6, 2005 petition will be scanned by the CRU into the record. **The "reference A" submitted with the petition will not be scanned in.**

4. The reexamination proceeding, and the sealed envelope or container containing references A-C (submitted with the May 25, 2005 petition) will then be forwarded to the Technology Center (TC 1700) for placement of the envelope or container in the Artifact folder for the instant reexamination proceeding, and consideration of all the "references" submitted with the two petitions in due course.

5. Any questions regarding this decision should be directed to the undersigned at (571) 272-7710.

6. Telephone inquiries related to the examination of the reexamination proceeding should be directed to Examiner Allan Kuhns of Art Unit 1732 at (571) 272-1202.

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

June 20, 2005
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UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,708	07/14/2003	5312576	5906-16	3178

23413 7590 07/14/2006

CANTOR COLBURN, LLP
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BLOOMFIELD, CT 06002

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/14/2006

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

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CST

Cantor Colburn, LLP 55 Griffin Road South Bloomfield, CT 06002	:	(for Patent Owner)
John C. Hilton McCormick, Paulding & Huber, LLP 185 Asylum Street, City Place II, 18th Floor Hartford, CT 06103	:	(for Third Party Requester)
In re Swei et al Reexamination Proceeding Control No. 90/006,708 Filed: July 14, 2003 For: U.S. Patent 5,312,576	:	**DECISION ON PETITION**

This is a decision on RENEWED PETITION UNDER 37 CFR 1.59(b) TO EXPUNGE INFORMATION SUBMITTED UNDER MPEP § 724.02, filed January 6, 2006, which has been accepted as a timely petition under 1.59(b) and MPEP 724.02 and is before the Group Director of Technology Center for consideration.

DECISION

Petitioner requests that the information submitted under MPEP § 724.02 on May 25, 2005 and June 6, 2005 be expunged. Each of the criteria for granting the request has been satisfied. See MPEP 724.05.

The petition is **GRANTED.**

Section 1.59 has been amended to eliminate references to returning documents that have been expunged to recognize that, with electronic Official files, there will be nothing to return when a paper is expunged.

The Office is capturing electronic images of all documents that form the Official file. Where the image is generated from a physical source document, the originating document may be disposed of once the electronic image accuracy is verified. The paper source document will eventually be destroyed under a United States National Archives

and Records Administration (NARA) approved schedule. Therefore, if a document is to be expunged from the record, the only operation that will be required will be removal of the image from the Official file.

Paragraph (a)(1) of §1.59 has been amended by deleting the phrase "and returned " from the first sentence, and deleting the second sentence. Paragraph (b) of §1.59 has been amended by deleting the phrase "and return" from each of the first and second sentences. The Office will continue to provide notice in the Official file that a paper has been expunged and the Office will send a decision to the applicant notifying the applicant that the paper has been expunged.

The image of the document will be removed from the Official file.

JMStone

Jacqueline M. Stone
Director, Technology Center 1700
Chemical and Materials Engineering

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,711	07/14/2003	5922333	112139-103	3181

7590 08/27/2003

Michael A. O'Neil
5949 Sherry Lane Suite 820
Dallas, TX 75225

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/27/2003 #13

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

90006711 .082503

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FOR REQUESTER 1

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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

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90/006,711	07/14/2003	5922333	112139-103	3181

7590 08/27/2003

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EXAMINER

ART UNIT	PAPER NUMBER

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#13

MICHAEL A. O'NEIL
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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.

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

90006711.082503

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UNITED STATES PATENT AND TRADEMARK OFFIC
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JUN 4 2004

Paper No. 15

Mark W. Hetzler (For Patent Owner)
Fitch Even Tabin & Flannery
120 South LaSalle Street
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Chicago IL 60603-3406

Jeffrey G. Toler, Esq. (For Third Party Requester)
TOLER, LARSON & ABEL, L.L.P.
P.O. Box 29567
Austin, TX 78755-9567

In re Jack E. Mott)
Reexamination Proceeding)
Control No. 90/006,720)
Filed: July 21, 2003) DECISION ACCEPTING PAPERS
For: U.S. Patent No. 4,937,763)
Title: METHOD OF SYSTEM STATE)
ANALYSIS)

This is a decision in response to the request to accept the papers filed on June 01, 2004, as having been timely filed on April 09, 2004.

The request is **granted.**

The petitioner asserts that a response, including, *inter alia,* a proposed after final amendment, a Certificate of Service and a supplemental Information Disclosure Statement, were timely filed in the U.S. Patent and Trademark Office (PTO), via Certificate of Mailing, on April 02, 2004. To support this assertion, the petitioner has submitted a copy of the response and a copy of a return postcard that properly identifies and acknowledges receipt of the response by the PTO on April 09, 2004.

A review of the application file record reveals that the above-identified response is not of record in the application file and cannot be located. However, M.P.E.P. § 503 states that a postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima*

facie evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO."

The copy of the response submitted with the instant request is accepted.

The reexamination file is being forwarded to the examiner for consideration of the after final amendment filed April 09, 2004.

Inquiries regarding this decision should be directed to Lissi Mojica Marquis at (571) 272-1596.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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.
90/007,013 AND 90/006720	04/22/2004	4937763	1439.G002	6476

22242 7590 10/04/2004

FITCH EVEN TABIN AND FLANNERY
120 SOUTH LA SALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406

EXAMINER

ART UNIT	PAPER NUMBER
	20

DATE MAILED: 10/04/2004

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

JEFFREY G. TOLER, ESQ.
TOLER, LARSON & ABEL, L.L.P.
P.O. BOX 29567
AUSTIN, TEXAS 78755-9567

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/007,013*, and 90/006,720

PATENT NO. *4937763*.

ART UNIT *2857*.

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 STAT PATENT AND TRADEMARK OFFICE

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Mark W. Hetzler
Fitch Even Tabin & Flannery
120 South LaSalle Street Suite 1600
Chicago IL 60603-3406

(For Patent Owner)

Toler Larson & Abel LLP
P.O. BOX 29567
Austin, TX 78755-9567

(For Third Party Requester)

In re Jack E. Mott. Reexamination Proceeding Control No. 90/007,013 Filed: April 22, 2004 For U.S. Patent No. 4,937,763	:	DECISION MERGING REEXAMINATION PROCEEDINGS
In re Jack E. Mott Reexamination Proceeding Control No. 90/006,720 Filed: July 21, 2003 For U.S. Patent No. 4,937,763	:	

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. 4,937,763 issued on December 8, 1998.

2. A first request for reexamination, Control No. 90/006,720 was filed by the third party requester on July 21, 2003.

3. Reexamination was ordered in the '6720 on October 16, 2003.

4. Amendments were filed in the '6720 reexamination on December 29, 2003 and June 03, 2004, which added new claims 5-23.

5. A second request for reexamination, Control No. 90/007,013, was filed by the same third party requester on April 22, 2004.

6. Reexamination was ordered in the '7013 reexamination proceeding was on July 15, 2004.

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

8. A request to waive the patent owner's rights to file a statement and proceed directly to Ex Parte reexamination proceeding was filed in the '7013 file on July 30, 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 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 noted facts, reexamination has been ordered in both of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is appropriate.

DECISION

I. Merger proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '6720 and '7013 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 that 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.

III. Requirements for Same Amendments in All Proceedings.

As noted above, the claims have been amended in the '6720 reexamination proceeding. The patent owner is required to maintain the same claims and specification in both files. Thus, the 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.

CONCLUSION

As a result of the patent owner's request to waive the patent owner's rights to file a statement and proceed directly to Ex Parte reexamination proceeding, the two-month waiting period is waived and the reexamination Control Nos. '6720 and '7013 are merged. The reexamination files will be held in storage to await submission of the amendment. After the amendment is received, it will be processed by the technical support staff and the file returned to the examiner, for appropriate action.

Inquiries related to this decision should be directed to Lissi Mojica Marquis at (571) 272-1596.

Howard N. Goldberg, Group Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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JAN 7 2004

Paper No. 30

Sofer & Haroun, LLP
317 Madison Avenue
Suite 910
New York, NY 10017

(For Patent Owner)

In re Protechna SA
Reexamination Proceeding
Control No. 90/005,524
Filed: September 30, 1999
For: U.S. Patent No. 4,909,387

In re Protechna SA
Reexamination Proceeding
Control No. 90/006,722
Filed: July 22, 2003
For: U.S. Patent No. 4,909,387

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 90/005,524 and 90/006,722 reexamination proceedings are hereby MERGED. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in Both Proceedings

Owner is required to maintain the same claims and specification in both files. The contents of each file will be hereafter be maintained identically, and all actions promulgated and papers filed subsequent to this Decision will bear the same paper number. This Decision is paper No. 30 in both files. There will be no paper Nos. 9-29 in Control No. 90/006,722.

III. Conduct of Merged Proceeding

All papers mailed by the Office will take the form of a single combined action which applies to both proceedings, and which will cross-reference the two proceedings. A separate action cover form for each proceeding will be printed by the PALM printer for each of the two reexamination control numbers. Owner will receive the body of the action and a copy of each cover sheet.

All papers filed by owner, (except for the housekeeping amendment and a copy of the new Schutz declaration as discussed in section IV below), will contain the identifying data for both files and will be physically entered in each reexamination file. Therefore, **all** papers filed by owner, (except for the housekeeping amendment, and a copy of the new Schutz declaration as discussed in section IV below), **must** consist of a single response bearing both control numbers, **filed in duplicate**, each having an original signature. One copy of the duplicate submission will be entered in each file.

Owner is asked to review 37 CFR 1.530 and MPEP § 2250 prior to filing any amendments to the drawings, specification or claims in order to make sure that the amendments are in proper

reexamination format. **Clean copies of the amended claims are not required; only so called "marked-up" claims and complete paragraphs in which specification amendments are requested** must be filed together with remarks satisfying the requirements of 37 CFR 1.530(e). Only currently proposed amendments adding amended or new material are to be presented; all pending claims are not to be represented in each successive amendment. Amendments are always made relative to the text of the patent. All added words that did not appear in the text of the patent are always underlined when presented by any amendment and continue to be underlined if the added words are presented of successive amendments. All words being deleted from the text of the patent appear in brackets and continue to appear in brackets if the words continue to be deleted in successive amendments. New drawing figures must be labeled "New", while amended drawing figures must be labeled "Amended".

IV. Housekeeping Amendment and Other Preliminary Papers

Prior to the commencement of *ex parte* examination under 37 CFR 1.550, owner is **required** to file a housekeeping amendment in control No. 90/006,722 **only**. The housekeeping amendment will render the specification and claims in control No. 90/006,722 identical to the specification and claims in control No. 90/005,525. The housekeeping amendment will be paper No. 31 in control No. 90/006,722.

In control No. 90/005,524 **only**, owner is **required** to file a copy of the declaration of Udo Schutz that was filed concurrently with control No. 90/006,722. The copy of the declaration will be entered in control No. 90/005,524 as paper No. 31 so that each file contains the declaration.

Owner **may elect** to file additionally file a preliminary amendment presenting additional claims and/or further amending the claims and/or amending the specification in this merged proceeding. If that is the case, the preliminary amendment **must** in filed in accordance with paragraph III above (i.e. single submission bearing both control numbers, filed in duplicate), must be based upon the record as presented in the housekeeping amendment, and must comply with the formatting requirements 37 CFR 1.530(e) as explained in MPEP § 2250. If filed, this paper would be entered as paper No. 32 in both proceedings.

Owner is required to file the housekeeping amendment (paper No. 31 in control No. 90/006,722) and the copy of the Schutz declaration (paper No. 31 in control No. 90/005,524) not later than ONE MONTH from the date of this decision. If owner elects to file a further preliminary amendment in the nature of additional claims and/or additional amendments to the existing claim and/or amendments to the specification, that amendment must also be filed within ONE MONTH from the date of this decision.

Attention is invited to 37 CFR 1.550(c) regarding extensions of time in reexamination proceedings.

V. Examiner's Action and Citation of Patents and Printed Publications

Following the filing of the papers discussed in section IV above, the examiner will promulgate an action on the merits of the claims in accordance with the guidelines in section III above. This action will expressly consider and address the new declaration of Udo Schutz (paper No. 2 in control No. 90/006,722; paper No. 31 in control No. 90/005,524). The examiner will review the files to insure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition. If the first *ex parte* action in this proceeding includes a rejection or objection, that action **cannot** be made final

The reexamination proceeding files are being returned to storage in the Technology Center 3700 Central Files awaiting the filing of the papers described section IV above. The papers must be filed by owner **not later than ONE MONTH from the date of this decision, unless an extension of time pursuant to 37 CFR 1.550(c) is obtained.**

E. Rollins-Cross, Director
Technology Center 3700

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SEP 15 2004

Paper No. 38

Sofer & Haroun, LLP
317 Madison Avenue
Suite 910
New York, NY 10017

(For Patent Owner)

In re Protechna SA
Reexamination Proceeding
Control No. 90/005,524
Filed: September 30, 1999
For: U.S. Patent No. 4,909,387

In re Protechna SA
Reexamination Proceeding
Control No. 90/006,722
Filed: July 22, 2003
For: U.S. Patent No. 4,909,387

DECISION ON PETITION

In response to a courtesy telephone call from the examiner prior to preparation of a Notice of Intent to Issue Reexamination Certificate due to a failure to reply to the Office action dated March 29, 2004, Patent Owner has filed a petition and a copy of a reply to that Office action. Patent Owner alleges that a timely reply to the Office action in question was in fact filed on June 29, 2004.

A review of the petition shows that Patent Owner has supported the allegation by furnishing a copy of the reply, and a copy of a post card receipt showing that the reply was actually received in the Office on June 29, 2004, within the period set by the Office action in question as extended by the Decision on Petition for Extension of Time dated July 1, 2004.

As it appears that a reply to the Office action dated March 29, 2004 was in fact timely filed, the attached copy of the reply will be treated as though filed on June 29, 2004, and entered in the record for examination purposes. The application will then be forwarded to the examiner for appropriate action.

PETITION GRANTED.

Stephen Marcus, Special Program Examiner
Technology Center 3700

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UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,724	07/24/2003	6402013	2022005-7031160001	4464

23639 7590 01/26/2006

BINGHAM, MCCUTCHEN LLP
THREE EMBARCADERO CENTER
18 FLOOR
SAN FRANCISCO, CA 94111-4067

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/26/2006

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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td

Mailed:
In re Patent No: :
6,402,013 : DECISION ON
Control No. 90/006,724 : PETITION
Filed: July 22, 2003 :
For: THERMOSETTING SOLDERING FLUX AND SOLDERING PROCESS.

This is a decision on the PETITION UNDER 37 CFR 1.181 FOR ENTRY OF THE AFTER FINAL AMENDMENT filed July 1, 2005.

On March 22, 2005, a final office action was mailed to Patentees, rejecting all of the pending claims. Patentees responded to this office action with an amendment after final which was filed on May 23, 2005. The examiner refused entry of the amendment in an advisory action mailed June 7, 2005. A second amendment after final amendment was submitted on July 1, 2005. The examiner refused entry of this amendment in an advisory action mailed July 13, 2005. The reason given for non-entry of the amendment was that the amendment raised new issues that would require further search and/or consideration and would lace the application in better form for appeal.

On November 21, 2005, the instant petition under 37 CFR 1.181 was timely filed to request the entry of the after final amendment of July 1, 2005.

Petitioner's position is that the amendment after final did not raise any new issues requiring further search and/or consideration as alleged by the examiner in the advisory action and that the amendment further reduces the issues for appeal.

DECISION

Section 714.13 of the MPEP states:

ENTRY NOT A MATTER OF RIGHT

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see 37 CFR 1.116) or reinstate previously canceled claims.
Except where an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner, compliance with the requirement of a showing under 37 CFR 1.116(c) is expected in all amendments after final rejection. Failure to properly reply under 37 CFR 1.113 to the final rejection results in abandonment.

An amendment filed at any time after final rejection, but before an appeal brief is filed, may be entered upon or after filing of an appeal brief provided the total effect of the amendment is to (A) remove issues for appeal, and/or (B) adopt examiner suggestions.

ACTION BY EXAMINER
See also MPEP § 706.07(f).
In the event that the proposed amendment does not place the case in better form for appeal, nor in condition for allowance, applicant should be promptly informed of this fact, whenever possible, within the statutory period. The refusal to enter the proposed amendment should not be arbitrary. The proposed amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified. Ordinarily, the specific deficiencies of the amendment need not be discussed. The reasons for nonentry should be concisely expressed. For example:

(A) The claims, if amended as proposed, would not avoid any of the rejections set forth in the last Office action, and thus the amendment would not place the case in condition for allowance or in better condition for appeal.
(B) The claims, if amended as proposed, would raise the issue of new matter.
(C) The claims as amended present new issues requiring further consideration or search.
(D) Since the amendment presents additional claims without canceling any finally rejected claims it is not considered as placing the application in better condition for appeal. *Ex parte Wirt*, 1905 C.D. 247, 117 O.G. 599 (Comm'r Pat. 1905).

Petitioner argues that the proposed amendment related to the newly presented temperature requirement would not require a further search. It is reasoned that because the prior art cited by the examiner fell within the claimed temperature range and no prior art was found having a temperature of greater than the upper range presented, such a limitation was already fully searched. This argument is persuasive in that it appears that this amendment would not require further searching and/or consideration. A second limitation was presented requiring the use of a conventional liquid organic solvent. It is argued that the broadest reasonable interpretation is consistent with the specification and is one that those skilled in the art would reach based on the meaning of terms in their ordinary usage. It is argued that an initial search would have encompassed this limitation. This argument is also persuasive.

Because the after final amendment does not present any new issues requiring further search and/ or consideration, and because the amendment reduces the issues for appeal, the denial of entry by the examiner was improper. Accordingly, the petition for entry of the after final amendment is **GRANTED.**

The application is being forwarded to the examiner for entry and consideration on the merits of the second after final amendment filed on July 1, 2005.

Jacqueline M. Stone, Director
Technology Center 1700
Chemical and Materials Engineering

BINGHAM, MCCUTCHEN LLP
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SAN FRANCISCO CA 94111-4067

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Bingham McCutchen LLP
2020 K. Street
Washington DC 20006

For Patent Owner

MAILED

DEC 2 1 2007

CENTRAL REEXAMINATION UNIT

Ex Parte Reexamination Proceeding
Control No. 90/006,704
Filed: August 27, 2003
For: US Patent No. 6,402,016

DECISION DISMISSING
PETITION FOR
EXTENSION OF TIME
[37 CFR 1.550(c)]

This is a decision on the petition filed November 21, 2007 to request a one-month extension of time pursuant to 37 CFR 1.550 to respond to the Office action dated September 21, 2007.

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

The petition is dismissed for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to respond to the Office action of September 21, 2007. The request is timely filed and includes authorization to debit a deposit account for the $200.00 petition fee as required by 37 CFR 1.515(c).

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. ...

Patent Owner's Showing of Sufficient Cause to Grant an Extension of Time

The petition for extension of time states that the number and complexity of the rejections and the issuance a new rejections in the most recent Office action will require additional time in which to formulate a response. Patent Owner requests that the period for response be extended to December 21, 2007 which would be equivalent to the normal shortened statutory period for response to an Official action during ex parte prosecution.

Analysis and Findings

On balance, it does not appear that the petition explains the "sufficient cause" for an extension of time. The present request fails to include (a) a statement of what action the Paten Owner has taken thus far as a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period, and (b) why, in spite of the action taken thus far, the additional time is needed. In the view of the requirement of 35 USC 305 that the proceedings be conducted with special dispatch, no extension of time is deemed necessary. The response to the Office action dated September 21, 2007 is due on November 21, 2007.

Conclusion

1. The Patent Owner's petition for extension of time of one month in which to file a response to the Office action dated September 21, 2007 is **dismissed**.

2. The Patent Owner's response is due November 21, 2007.

3. Response may be submitted as follows:

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

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

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

4. Telephone inquiries with regard to this decision should be directed to Deborah Jones, Supervisory Patent Examiner in the Central Reexamination Unit, Art Unit 3991, at (571) 272-1535.

for Lissi M. Marquis,
Director,
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,724	07/24/2003	6402013	2022005-7031160001	4464

EXAMINER

ART UNIT	PAPER NUMBER

23639 7590 02/20/2008
BINGHAM MCCUTCHEN LLP
Three Embarcadero Center
San Francisco, CA 94111-4067

DATE MAILED: 02/20/2008

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THREE EMBARCADERO CENTER
SAN FRANCISCO CA 94111-4067

(For Patent Owner)

MAILED

FEB 20 2008

CENTRAL REEXAMINATION UNIT

In re Reexamination Proceeding	:
H. Abe et al.	:
Control No. 90/006,724	: DECISION GRANTING PETITION
Filed: July 24, 2003	:
U.S. Patent No. 6,402,013	:
Attorney Docket No. 2022005-7031160001	:

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on January 31, 2008, 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, in part:

> "*Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by: (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in § 1.17(m); (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional ...."

The present petition under 37 CFR 1.137(b) includes, inter alia, an authorization to charge counsel's deposit account for the $1,540.00 petition fee under 37 CFR 1.17(m) (item 2), the requisite statement (item 3) and a Certificate of Service on the Third Party Requester. Petitioners state that the requisite response (Amendment after Non-Final Rejection) was previously filed on December 20, 2007.

The petition for entry of the late papers is granted.

$1,540.00 has been charged to counsel's deposit account no. 50-4047 in accordance with the present petition.

Jurisdiction over the reexamination proceeding is being returned to Central Reexamination Unit (CRU) Art Unit 3991 for further examination and consideration of the Amendment after Non-Final Rejection filed December 20, 2007, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Alan Diamond, in CRU Art Unit 3991, who can be reached at 571-272-1338.

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,724	07/24/2003	6402013	2022005-7031160001	4464

23639 7590 03/26/2009
BINGHAM MCCUTCHEN LLP
Three Embarcadero Center
San Francisco, CA 94111-4067

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/26/2009

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MAR 26 2009

CENTRAL REEXAMINATION UNIT

Matthew L. Fedowitz
Bingham McCutchen LLP
2020 K Street, N.W.
Washington, D.C. 20006-1801

For Patent Owner

Ex Parte Reexamination Proceeding
Control No. 90/006,724
Filed: July 24, 2003
For: US Patent No. 6,402,013

: DECISION ON PETITION
: UNDER 37 CFR 1.181

The Petition filed March 16, 2009 by Matthew L. Fedowitz of Bingham McCutchen LLP in Washington, DC, entitled "Petition for Withdrawal of Dismissal of Reexamination Proceeding Based on Failure to File a Corrected Brief," is considered as a Petition under 37 CFR 1.181 and 1.8(b) to reconsider the decision of March 6, 2009 pertaining to the petition dated March 2, 2009, and to accept the Declaration of Yuji Kawamata and attached exhibits A-E filed in the paper dated March 2, 2009 as a true and complete copy of the Kawamata Declaration and attached exhibits, which was originally filed on December 20, 2007. This Petition is before the Director of the Central Reexamination Unit.

The Petition is GRANTED to the extent that the Kawamata Declaration and attached exhibits filed on March 2, 2009 are being treated as a true and complete copy of the Kawamata Declaration and attached exhibits, which was originally filed on December 20, 2007.

Therefore, the appeal brief filed on March 2, 2009 is deemed to be compliant with 37 CFR 41.37. Accordingly, the "Ex Parte Reexamination Notification Re: Appeal" dated March 6, 2009, which dismissed the appeal because the brief was not compliant with 37 CFR 41.37, and the "Notice of Intent to Issue Ex Parte Reexamination Certificate" dated March 13, 2009 are hereby vacated.

Review of Facts

On December 20, 2007, Patent Owner filed a Declaration under 37 CFR 1.132 from Yuji Kawamata with Exhibits A-E with a response to a non-final Office action. The Image File Wrapper record reflects that Exhibit A has 7 pages, Exhibit B has 1 page, Exhibit C contained no pages, Exhibit D has 2 pages, and Exhibit E has 2 pages (not reflecting the coversheet for each exhibit). Since this response was not timely filed, the Office issued a Notice of Intent to Issue a Reexamination Certificate on January 22, 2008.

On January 31, 2008, Patent Owner submitted a petition for entry of late papers based on unintentional delay which was granted on February 20, 2008.

On April 3, 2008, a Notice of Defective Paper in Ex Parte Reexamination was mailed. A corrected and enterable response was received on April 24, 2008.

On May 15, 2008, the Office issued a Final Office action. The Office action indicated the Declaration of Yuji Kawamata referred to pages that were not in the Appendix. In particular, paragraph 13 of the Declaration referred to page 2 of Exhibit B but Exhibit B contained only one page. Likewise, the Office action indicated paragraph 14 of the Declaration referred to Appendix C; however, Appendix C contained no data at all.

On July 15, 2008, Patent Owner submitted a response and amendment but did attempt to file the above-noted missing pages and did not even comment on the missing pages of the Declaration.

On July 17, 2008, an Advisory Action issued denying entry of the amendment dated July 15, 2008.

A Notice of Appeal was filed on September 15, 2008.

An Appeal Brief was filed on November 17, 2008. The Evidence Appendix included the Kawamata Declaration with attached Exhibits A-D including the pages that were indicated as missing.

On December 4, 2008, a Notice of Non-Compliant Appeal Brief was mailed giving patent owner one month or thirty days from the filing date of the Notice to file an amended or corrected brief. The notice clearly indicated the appeal will be dismissed if the amended/corrected brief was not received within the period for response (MPEP 1205.03).

A Supplemental Appeal Brief was filed on December 23, 2008.

On January 29, 2009, a Notice of Non-Compliant Appeal Brief was mailed indicating the Kawamata Declaration in the brief did not match that which was filed on December 20, 2007.

On March 2, 2009, Patent Owner filed a paper entitled Responsive Appeal Brief in Accordance with 37 CFR 41.37 confirming that the Kawamata Declaration filed with the

Appeal Brief is identical to that filed on December 20, 2007 and includes the pages indicated as missing. Patent Owner also filed a paper entitled "Submission under 37 CFR § 1.251" to show that the copy of the Kawamata Declaration and attached exhibits, which was originally filed on December 20, 2007, was not complete in the Image File Wrapper record of the proceedings. Attachment 4 to the March 2, 2009 petition reflects that Exhibit A has 7 pages, Exhibit B has 2 pages, Exhibit C has 2 pages, Exhibit D has 3 pages, and Exhibit E has 3 pages (not reflecting the coversheet for each exhibit).

On March 6, 2009, an Ex parte Reexamination Notification Re: Appeal was mailed dismissing the appeal for failure to file a corrected Brief in accordance with the Notice of Non-Compliant Appeal Brief mailed January 29, 2009. Also, a decision returning the "Submission under 37 CFR § 1.251" as an improper paper was mailed.

On March 13, the Office issued a Notice of Intent to Issue an Ex Parte Reexamination Certificate.

On March 16, 2009, Patent Owner submitted this Petition.

Decision

In the Petition dated March 16, 2009, the Petitioner argues that the appeal was improperly dismissed because the Appeal Brief filed on March 2, 2009 was responsive to the Notice of Non-compliant Brief dated January 29, 2009 and complies with the requirements of 37 CFR 41.37. Specifically, Petitioner states that Kawamata declaration and attached exhibits were complete when filed on December 20, 2007, but that the Office's Image File Wrapper record does not reflect a complete copy of the attached exhibits to the Kawamata declaration. As a showing thereof, petitioner submitted evidence, on March 2, 2009, including a copy of his postcard receipt which acknowledges receipt of the Kawamata declaration with exhibits A-E (in attachment 3 of the March 2, 2009 petition), a complete and true copy of the Kawamata declaration with exhibits A-E submitted on December 20, 2007, (in attachment 4 of the March 2, 2009 petition) and a statement by the patent owner's representatives attesting that the copy in attachment 4 is a complete and accurate copy of the Kawamata declaration with exhibits A-E submitted on December 20, 2007 (see page 2 of March 2, 2009 petition).

It is noted that the postcard receipt does not reflect the number of pages for the Kawamata Declaration and attached exhibits A-E. Therefore, this receipt fails to provide evidence that there were missing pages, but only provides evidence that the patent owner did file the Kawamata Declaration and attached exhibits A-E on December 20, 2007. Therefore, the sole evidence of the missing pages is the copy submitted on March 2, 2009, which is attested to be a true and accurate copy of the Kawamata Declaration and attached exhibits A-E filed on December 20, 2007. It is further noted that the attested statement by the patent owner's representative constitutes a certification under 37 CFR 10.18(b), and that any violation of 37 CFR 10.18(b) may result in the imposition of sanctions under 37 CFR 10.18(c) and disciplinary action. See 37 CFR 1.4(d)(4), 10.18(d) and 10.23(c)(15) and MPEP 501.

Upon review of the record, the evidence is convincing that Kawamata declaration with exhibits A-E submitted on December 20, 2007 deposited on December 20, 2007, included 7 pages for exhibit A, 2 pages for exhibit B, 2 pages for exhibit C, 3 pages for exhibit D, and 3 pages for exhibit E, which was subsequently scanned into the Office's Image File Wrapper system with missing pages (e.g., the second page of exhibit B, both pages of exhibit C, the first page of exhibit D, and the first page of exhibit E, as reflected in the copy filed on March 2, 2009). Therefore, the Appeal Brief, dated March 2, 2009, reflects the complete Kawamata declaration with exhibits A-E submitted on December 20, 2007 as evidenced by the papers filed March 2, 2009.

In view of the above, the petition is granted to the extent that the Kawamata Declaration and attached exhibits filed on March 2, 2009 are being treated as a true and complete copy of the Kawamata Declaration and attached exhibits, which were originally filed on December 20, 2007. Therefore, the appeal brief filed on March 2, 2009 is deemed to be compliant with 37 CFR 41.37. Accordingly, the "Ex Parte Reexamination Notification Re: Appeal" dated March 6, 2009, which dismissed the appeal because the brief was not compliant with 37 CFR 41.37, and the "Notice of Intent to Issue Ex Parte Reexamination Certificate" dated March 13, 2009 are hereby vacated.

CONCLUSION

1. Given the facts involved in this proceeding, the appeal brief filed on March 2, 2009 is deemed to be compliant with 37 CFR 41.37.

2. Accordingly, the PETITION is GRANTED.

3. The "Ex Parte Reexamination Notification Re: Appeal" dated March 6, 2009, which dismissed the appeal because the brief was not compliant with 37 CFR 41.37, is hereby vacated.

4. The "Notice of Intent to Issue Ex Parte Reexamination Certificate" dated March 13, 2009 is hereby vacated.

5. The appeal is reinstated and the examiner will act on the proceeding in due course.

6. 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) 272-3838.

for Deborah Jones

Gregory A. Morse, Director
Central Reexamination Unit

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JUL 0 7 2005

TECHNOLOGY CENTER 3600

Peter J. Phillips
Cooper & Dunham LLP
1185 Avenue of the Americas
New York NY 10036

Reexamination Control No. 90/006,725
Filed: July 24, 2003
For: Patent No. 5,970,744

DECISION ON PETITION
FOR THE ACCEPTANCE
OF LATE PAPERS

This is in reply to petitioner's communication filed July 7, 2005 which will be treated as a Petition To Accept Late Filed Papers. There is no fee required for this petition.

The petition is **GRANTED**.

A review of the above reexamination file indicates that an Office action was mailed on March 18, 2005 wherein a two-month shortened statutory period for response was set. Petitioner alleges that a response was timely filed on May 18, 2005. Petitioner has submitted a copy of the response bearing a Certificate of Mailing dated May 18, 2005 and a statement under 37 CFR 1.8(b)(3) reaffirming that the response was timely filed on May 18, 2005. This is acceptable evidence of timely filing of the response.

Telephone inquiries relative to this decision should be directed to Special Programs Examiner Kenneth J. Dorner at (571) 272-6587.

The reexamination file is being forwarded to the Supervisory Legal Instruments Examiner to enter the response.

Kenneth J. Dorner, Special Programs Examiner
Patent Technology Center 3600
(571) 272-6587

kjd: 7/7/05

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DEC 0 1 2008

CENTRAL REEXAMINATION UNIT

Peter J. Phillips
Cooper & Dunham
1185 Avenue of the Americas
New York, NY 10036

(For Patent Owner)

In re Greeff :
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/006,725 : **GRANTING**
Filed: July 24, 2003 : **PETITION**
For: U.S. Patent No. 5,970,744 :

This is a decision on the September 2, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding ("the September 2, 2008 patent owner petition to revive").

The September 2, 2008 patent owner petition to revive, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

The petition fee of $1540 set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b) has been received.

SUMMARY

The September 2, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 47(a)(7) provides, in pertinent part:

> REVIVAL FEES. — On filing each petition . . . for an unintentionally delayed response by the patent owner in any reexamination proceeding . . .

35 U.S.C. 133 provides:

> Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

12/01/2008 JREDDICK 00000002 033125 90006725
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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.

37 CFR 1.137 provides, in pertinent part:

(b) *Unintentional.* If the delay in reply by . . . patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive . . . a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) . . . 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 . . .

*

*

(d) *Terminal Disclaimer.*

*

*

(3) The provisions of paragraph (d)(1) of this section do not apply to . . . reexamination proceedings.

37 CFR 1.550 provides, in pertinent part:

(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.

(e) If a response by the patent owner is not timely filed in the Office,

*

*

(2) The response may nevertheless be accepted if the delay was unintentional; a petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b).

37 CFR 41.37 provides, in pertinent part:

(a)

(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

(2) The brief must be accompanied by the fee set forth in § 41.20(b)(2).

(b) On failure to file the brief, accompanied by the requisite fee, within the period specified in paragraph (a) of this section, the appeal will stand dismissed.

MPEP 711.03(c) II A 2 (c) provides, in pertinent part:

Abandonment for Failure To File an Appeal Brief

In those situations where abandonment occurred because of the failure to file an appeal brief, the reply required pursuant to 37 CFR 1.137(a)(1) or 1.137(b)(1) must be . . . an appeal brief in compliance with 37 CFR 41.37(c) and appeal brief fee . . .

MPEP 2268 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into, and are applicable to, all *ex parte* reexamination proceedings by section 4605 of the American Inventors Protection Act of 1999. The unintentional delay provisions of 35 U.S.C. 41(a)(7) became effective in reexamination proceedings on November 29, 2000. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed subsequent to the order for reexamination. Any such petition must provide a verified statement that the delay was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee set forth in 37 CFR 1.17(m).

*

*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

See also MPEP § 711.03(c), subsection II, for a detailed discussion of the requirements of petitions filed under 37 CFR 1.137(a) and (b).

DECISION

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) a response to the outstanding Office action, (2) the petition fee set forth in 37 CFR 1.17(m), and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required response from the due date of the response to the filing of a grantable petition was unintentional. A petition fee as set forth in 37 CFR 1.17(m) has been submitted, which satisfies item (2). The statement appearing on page 2 of the September 2, 2008 patent owner petition under 37 CFR 1.137(b) to revive, i.e., "Applicant states that the entire delay was unintentional, i.e., that the applicant did not intend to abandon the subject application at any time," is construed as a statement under 37 CFR 1.137(b) that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional, and satisfies item (3). If the above-identified statement, appearing on page 2 of the September 2, 2008 patent owner petition under 37 CFR 1.137(b) to revive, is not intended to be construed in this manner, the patent owner is required to so inform the Office.

Regarding item (1), the required response must be an appeal brief in compliance with 37 CFR 41.37(c) and (b) an appeal brief fee.[1] An appeal brief fee of $510 pursuant to 37 CFR 41.20(b)(2), which was in effect at the time of filing the present petition, has been charged to deposit account no. 03-3125 as authorized on page 3 of the present petition.[2] To fulfill the requirement of a submission of an appeal brief in compliance with 37 CFR 41.37(c), the patent owner points to the appeal brief received on January 3, 2007 "as supplemented by the [a]mended [a]ppeal [b]rief" received on May 14, 2007. The January 3, 2007 appeal brief, however, fails to comply with 37 CFR 41.37(c) as indicated in the April 11, 2007 notification of non-compliant

[1] See MPEP 2268 IV and MPEP 711.03(c) II A 2 (c).

[2] The appeal brief fee of $500, received on January 3, 2007, has been credited to deposit account no. 03-3125.

appeal brief.[3] The May 14, 2007 amended appeal brief, however, is a complete (rather than merely a supplemental) appeal brief.[4] Furthermore, the examiner determined that the May 14, 2007 amended appeal brief complies with the requirements of 37 CFR 41.37(c), as indicated by the September 17, 2007 mailing of an examiner's answer "in response to the appeal brief filed 14 May 2007."[5] For the reasons given above, the payment of $510 for the appeal brief fee under 37 CFR 41.20(b)(2) which was in effect at the time of filing the present petition, and the May 14, 2007 amended appeal brief, **together** satisfy item (1).

Accordingly, the September 2, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding[6] is **granted**.

CONCLUSION

- The September 2, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.
- Jurisdiction over this reexamination proceeding is being returned to Art Unit 3677 for processing of the May 14, 2007 appeal brief.
- Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Ruth Rodriguez, of Art Unit 3677, at (571) 272-7070.
- Any inquiry concerning this decision should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.

Kenneth M. Schor

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

---

[3] Because this reexamination proceeding was legally terminated as of December 5, 2006 due to the failure of the patent owner to timely file an appeal brief, **the April 11, 2007 notification of non-compliant appeal brief, and the September 17, 2007 examiner's answer, were vacated by the Office communication of August 5, 2008.**

[4] It is noted that the related proceedings appendix was timely filed with the amended appeal brief on May 14, 2007. The related proceedings appendix appears in the Office's Image File Wrapper database (IFW) immediately after the signature page of the May 14, 2007 brief, contains an Office date stamp of May 14, 2007, and was not missing from the amended appeal brief (received on May 14, 2007) as stated in patent owner's June 12, 2007 faxed transmission.

[5] See the sentence appearing on the first page of the September 17, 2007 examiner's answer. The September 17, 2007 examiner's answer was vacated by the Office communication of August 5, 2008 (see footnote 2).

[6] Although a Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" within the meaning of 37 CFR 1.550(d) for failure of the patent owner to timely file an appeal brief pursuant to 37 CFR 41.37(a).

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,726	07/24/2003	4859016	67793.0001	9027

90/007,147

20995 7590 02/22/2005

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/22/2005

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Paper No. 21405

KNOBBE MARTENS OLSON & BEAR LLP 2040 Main Street Fourteenth Floor Irvine, CA 92614	:	(for patent owner)
Mr. Kevin McMahon WEIL, GOTSHAL & MANGES LLP 767 Fifth Avenue New York, NY 10153	:	(for requestor)
In re SHAW *et al.* Reexamination Proceeding Control No. 90/006,726 Filed: July 24, 2003 Title: **FIBER OPTIC AMPLIFIER**	:	DECISION MERGING REEXAMINATION PROCEEDINGS
In re SHAW *et al.* Reexamination Proceeding Control No. 90/007,147 Filed: July 30, 2004 Title: **FIBER OPTIC AMPLIFIER**	:	

The above-identified reexamination files are before the Director of Examining Group 2880, Technology Center 2800, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 4,859,016 issued on August 22, 1989.

2. A first request for reexamination, Reexamination Control No. 90/006,726, was filed by the third party requester on July 24, 2003.

3. Reexamination was ordered in the '726 reexamination proceeding on October 16, 2003.

4. The Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed on November 17, 2004.

5. A second request for reexamination, Reexamination Control No. 90/007,147, was filed by the same third party requestor on July 30, 2004.

6. Reexamination was ordered in the '147 reexamination proceeding on November 02, 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 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. Vacating NIRC Mailed on November 17, 2004

Because the '726 proceeding was still pending at the time of the reexamination of the '147 proceeding was ordered, the NIRC mailed November 17, 2004, must be vacated in order merge the '726 and '147 reexamination proceedings pursuant to rule § 1.565(c). The NIRC mailed November 17, 2004, for the '726 proceeding is hereby vacated.

II. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '726 and '147 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

III. Regarding Amendments in All Proceedings.

The term for Patent No. 4,859,016, issued on August 22, 1989, has expired. Accordingly, no amendments to the claims are permitted. The patent claims will be reexamined based solely on prior art.

IV. Conduct of Merged Proceeding.

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

CONCLUSION

Reexamination Control Nos. 90/006,726 and 90/007,147 are merged. The reexamination files are being forwarded to the examiner for issuing a first Office action.

Inquiries regarding this decision should be directed to Clayton E. LaBalle at (571) 272-1594.

Janice A. Falcone

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

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WEIL GOTSHAL & MANGES, LLP
767 FIFTH AVE.
NEW YORK, ny 10153

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/006,726*. a 90/007,147

PATENT NO. *4859016*.

ART UNIT *2883*.

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.
90/006,727	07/28/2003	6040626	IR 2.079 (2-3584)	9029

7590 03/23/2005

Samuel H. Weiner
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1180 Avenue of the Americas
New York, NY 10036-8403

EXAMINER

ART UNIT	PAPER NUMBER
	#7

DATE MAILED: 03/23/2005

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,727	07/28/2003	6040626	IR 2.079 (2-3584)	9029

7590 03/23/2005

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Brian Ogonowsky
PATENT LAW GROUP LLP
2635 North First Street, Suite 223
San Jose, CA 95134

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/006,727, 90/007,073*.

PATENT NO. *6,040,626*.

ART UNIT *2815*.

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. 030805

Samuel H. Weiner Ostrolenk Faber Gerb & Soffen LLP 1180 Avenue of the Americas New York, NY 10036	:	(for patent owner)
Brian Ogonowsky PATENT LAW GROUP LLP 2635 North First Street, Suite 223 San Jose, CA 95134	:	(for requestor)
In re CHEAH *et al.* Reexamination Proceeding Control No. 90/006,727 Filed: July 28, 2003 Title: **SEMICONDUCTOR PACKAGE**	:	DECISION MERGING REEXAMINATION PROCEEDINGS
In re CHEAH *et al.* Reexamination Proceeding Control No. 90/007,073 Filed: June 9, 2004 Title: **SEMICONDUCTOR PACKAGE**	:	

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. Patent No. 6,040,626 issued on March 21, 2000.

2. A first request for reexamination, Reexamination Control No. 90/006,727, was filed by the patent owner on July 28, 2003.

3. Reexamination was ordered in the '727 reexamination proceeding on October 16, 2003.

4. An amendment was filed on December 16, 2003, adding new claims 29 - 35.

5. A second request for reexamination, Reexamination Control No. 90/007,073, was filed by a third party requestor on June 9, 2004.

6. Reexamination was ordered in the '073 reexamination proceeding on July 15, 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 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 '727 and '073 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 '727 reexamination proceeding. Patent owner is required to maintain the same claims 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. '727 and '073 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.

Inquiries regarding this decision should be directed to Clayton E. LaBalle, Special Programs Examiner, at (571) 272-1594.

James L. Dwyer, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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Kourosh Salehi
Ostrolenk, Faber, Gerb & Soffen LLP
1180 Avenue of the Americas
New York, NY 10036-8403

(For Patent Owner)

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MAY 15 2007

CENTRAL REEXAMINATION UNIT

Brian D. Ogonowsky
Patent Law Group LLP
2635 North First Street, Suite 223
San Jose, CA 95134

(For Third Party Requester)

In re Cheah et al.
Reexamination Proceeding
Control No.: 90/006,727
Filed: July 28, 2003
For: U.S. Patent No.: 6,040,626

In re Cheah et al.
Reexamination Proceeding
Control No.: 90/007,0373
Filed: June 9, 2004
For: U.S. Patent No.: 6,040,626

DECISION ON PETITIONS

This is a decision on (1) the May 1, 2007 patent owner petition entitled REQUEST FOR EXTENSION OF TIME TO SUBMIT APPEAL BRIEF UNDER 37 C.F.R. § 1.550(c), (2) the May 9, 2007 patent owner petition entitled SUBMISSION OF AFFIDAVITS AND PETITION UNDER 37 C.F.R. § 1.47, and (3) the May 14, 2007 patent owner petition entitled REQUEST FOR EXTENSION OF TIME TO SUBMIT AN AFFIDAVIT UNDER RULE 131 AND TO SUBMITT AN APPEAL BRIEF UNDER 37 C.F.R. § 1.550(c).

The three petitions are before the Office of Patent Legal Administration of the United States Patent and Trademark Office.

SUMMARY

The petition for extension of time filed May 14, 2007, is granted for the reasons set forth below.

The petition for extension of time filed May 1, 2007, is dismissed as moot for the reasons set forth below.

The petition for submission of affidavits under 37 CFR 1.47 is dismissed as moot for the reasons set forth below.

BACKGROUND

1. On December 15, 2006, a final Office action was mailed closing prosecution in present merged *ex parte* reexamination proceeding (merged proceeding), which includes the 90/006,727 and 90/007073 proceedings.

2. On February 15, 2007, patent owner filed a responsive paper in the merged proceeding.

3. On February 23, 2007, an advisory action issued, stating a time period of response of three months, running from the date of the final Office action, with a notice of appeal being due no later than March 15, 2007.

4. On March 14, 2007, patent owner filed a further responsive paper in the form of an 37 CFR 1.131 affidavit, not signed by one of the inventors, in conjunction with several non-patent literature references.

5. On March 15, 2007, patent owner filed a notice of appeal.

6. On March 30, 2007, an advisory action issued stating a time period of two months from the date of the notice of appeal for submission of an appeal brief, May 15, 2007.

7. On May 1, 2007, patent owner filed a petition for extension of time.

8. On May 9, 2007, patent owner filed a petition under 37 CFR 1.47, for acceptance of the 37 CFR 1.131 affidavit not signed by one of the inventors.

9. On May 14, 2007, patent owner filed a second petition for extension of time.

DECISION

37 CFR 1.550(c) States (in part):

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).

MPEP 2265 states (in part):

Accordingly, a request for an extension ***(A) must be filed on or before the day on which action by the patent owner is due and (B) must set forth sufficient reason for the extension, and (C) must be accompanied by the petition fee set forth in 37 CFR 1.17(g)***. . . .

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. **The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed.** The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.

I. The May 14, 2007 petition for extension of time:

The petition for extension of time filed May 14, 2007 is **granted**. The petition was filed on or before the day on which action by patent owner was due, the petition sets for the reason for the extension, and the petition authorizes payment of the appropriate fee under 37 CFR 1.17(g). Petitioner has evidenced diligent behavior on the record by providing the two signed inventor affidavits and stated on the record that patent owner's representatives are in communication with a third inventor who cannot sign at this time because he is out of the country. Therefore, the petition provides a sufficient factual showing of diligence and an explanation as to why the extension is needed in spite of the action taken.

The grant of the May 14, 2007 petition for an extension of time does not decide whether an affidavit under 37 CFR 1.131 entered into the record has an entry right. See MPEP 2265, Part II. The examiner of record will decide whether or not the submitted affidavit is made of record. (See 37 CFR 1.116(e) and 41.33(d)(1)).

II. The May 1, 2007 petition for extension of time:

The petition for extension of time filed May 1, 2007 is **dismissed as moot** in light of the granting of the extension of time petition submitted on May 14, 2007. Furthermore, it is noted that review of a recent Supreme Court decision does not meet the guidance of MPEP 2265 in term of fully stating the facts of diligent behavior, and how in spite of such diligence additional time is needed. Therefore, the showing of the May 1, 2007 petition is not a sufficient cause to grant an extension of time.

III. The May 9, 2007 petition under 37 CFR 1.47, to accept the 37 CFR 1.131 affidavit:

The petition for submission of the 37 CFR 1.131 affidavit, not signed by one of the inventors is **dismissed as moot** in light of the granting of the extension of time requested in the petition submitted on May 14, 2007. The petition states the non-signing inventor will not be available to sign the affidavit until May 16, 2007. The granted one month extension results in an appeal brief due date well in excess of this date, during which time the patent owner can obtain the signature of the non-signing inventor. Accordingly, the petition under 37 CFR 1.47 is dismissed as moot.

It is further to be noted that petitioner failed to submit the appropriate petition under 37 CFR 1.183 and the requisite $400 fee. Under the facts stated, petitioner is requesting a suspension of the requirements under 37 CFR 1.131. Such is not a request for relief where an inventor refuse to execute an application for patent, or cannot be found or reached after diligent effort, which is the circumstance where a petition under 37 CFR 1.47 would be applicable. Rather, petitioner is actually requesting a suspension of 37 CFR 1.131, which must be requested via a petition under

37 CFR 1.183, which requires a $400 petition fee. Any future petition to submit an affidavit under like circumstances would be made under 37 CFR 1.183, and not under 37 CFR 1.47.

CONCLUSION

1. The patent owner petition for extension of time filed May 14, 2007 is **granted**.

2. The patent owner petition for extension of time filed May 1, 2007 is **dismissed as moot**.

3. The patent owner petition for submission of an affidavit under 37 CFR 1.47 is **dismissed as moot**.

4. Petitioner has **ONE (1) MONTH** from the mail date of this decision to submit an Appeal Brief, to keep the proceeding pending.

5. Petitioner may use this 1-month period to submit a 37 CFR 1.131 affidavit executed by all the inventors.

6. Telephone inquiries related to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759.

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

May 15, 2007
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Paper No. 7

CANTOR COLBURN, LLP
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(Patent Owner)

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City Place II, 18th Floor
Hartford CT 06103

(Requester)

MAILED

APR 1 8 2005

REEXAM UNIT

In re Arthur et al	:
Reexamination Proceeding	: DECISION
Control No. 90/006,734	: DISMISSING
Filed: August 4, 2003	: PETITION
For: U.S. Patent No. 5,384,181	:
	:

This is a decision on the November 15, 2004, patent owner petition entitled PETITION UNDER 37 C.F.R. 1.59(b) TO EXPUNGE ACCOMPANYING INFORMATION SUBMITTED UNDER M.P.E.P. § 724.02. The petition requests consideration of a reference, submitted after the Notice of Intent to Issue a Reexamination Certificate (NIRC), and prior to issuance of the reexamination certificate.

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

The petition is dismissed for the reasons set forth below.

REVIEW OF FACTS

1) U.S. Patent number 5,384,181 issued January 24, 1995 with 41 claims.
2) A request for reexamination, assigned control No. 90/005,294, was filed on March 16, 1999.
3) A reexamination certificate, confirmation number 4421, was issued on June 13, 2000.
4) A second request for reexamination, assigned control No. 90/006,734, was filed on August 4, 2003, by a third party requester. This is the proceeding in which the instant petition is filed.
5) Reexamination was ordered for the '6734 reexamination proceeding on October 16, 2003.
6) A Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed on October 22, 2004.
7) A set of documents was submitted in the '6734 reexamination proceeding on November 15, 2004, with a transmittal letter identifying the documents as "Transmittal of Proprietary Material Not Open to the Public, to be Opened by Examiner or Other Authorized PTO Employee (M.P.E.P. § 724.02)"
8) A "Petition Under 37 CFR 1.59(b) to Expunge Accompanying Information Submitted Under M.P.E.P. § 724.02" was also submitted on November 15, 2004 .
9) A reexamination certificate, confirmation number 1591, was issued on March 15, 2005.

DECISION DISMISSING THE PETITION TO STAY THE REEXAMINATION PROCEEDINGS

A review of the record shows that the examiner terminated prosecution on the merits and issued an NIRC on October 22, 2004. The file was forwarded to the Office of Publications on December 20, 2004, for issuance of the reexamination certificate. The certificate issued on March 15, 2005.

Although the petition was filed on November 15, 2004, (three weeks after the NIRC), the petition was not matched with the file wrapper until February 8, 2005. Accordingly the petition is dismissed as moot.

It is noted for the record, however, that had the petition been matched and considered prior to the printing of the certificate, it would have been dismissed in view of the following:

The petition was filed very late in the examination of the reexamination, and failed to provide (a) a sufficient explanation of why the art submitted could not have been submitted earlier, and (b)a statement as to why the art submitted makes at least one claim unpatentable. To the contrary, the patent owner states that the reference is considered to be proprietary and requests that it would be appropriate to expunge the reference, thus implying the reference is not considered by patent owner to be prior art that is "important to a reasonable examiner in deciding whether or not a claim is patentable." See MPEP 724.04(c) parts (B) – (D). Thus, even had the petition been matched with the file in time to do so, it would not have been appropriate to withdraw the reexamination from the printing cycle for consideration of information that may not be prior art.

It is to be noted that in a reexamination proceeding, there is a statutory mandate special dispatch, and the need for certainty and finality, especially where there is a third party involved (either as a requester of the reexamination, as is the case here, or as an interested third party such as a potential licensee. If, however, the patent owner in fact believes the reference to raise a substantial question of patentability as to at least one claim of the patent, the patent owner can always file a new request for reexamination for consideration of the reference.

CLOSING IFW ENTRY FOR PAPERS FILED NOVEMBER 15, 2004

Pursuant to MPEP 724.02:

> "Information which is considered by the party submitting the same to be either trade secret material or proprietary material, and any material subject to a protective order, must be clearly labeled as such and be filed in a sealed, clearly labeled, envelope or container. Each document or item must be clearly labeled as a "Trade Secret" document or item, a "Proprietary" document or item, or as an item or document "Subject To Protective Order." It is essential that the terms "Confidential," "Secret," and "Restricted" or "Restricted Data" not be used when marking these documents or items in order to avoid confusion with national security information documents which are marked with these terms (note also MPEP § 121). If the item or document is "Subject to Protective Order" the proceeding, including the tribunal, must be set forth on each document or item. Of course, the envelope or container, as well as each of the documents or items, must be labeled with complete identifying information for the file to which it is directed, including the Office or area to which the envelope or container is directed."

The record does not indicate that the above was done for the papers filed November 15, 2004. Accordingly, the entirety of the November 15, 2004 papers were scanned into the Image File Wrapper (IFW) file history for the instant proceeding. Given the stated proprietary nature of the papers filed November 15, 2004, the file history entry for the papers filed November 15, 2004, in IFW for the present proceeding will be closed.

It is to be noted that the information filed November 15, 2004, has already been made available to the public and subject to copying (of the file by the public) because a reexamination file is open to the public under 37 CFR 1.11(d). Accordingly, the Office cannot guarantee that the information being closed as a result of this decision were not previously accessed by the public.

CONCLUSION

1. The patent owner petition to expunge the information submitted in the '6734 reexamination proceedings on November 15, 2004 with a transmittal letter identifying the documents as "Transmittal of Proprietary Material Not Open to the Public, to be Opened by Examiner or Other Authorized PTO Employee (M.P.E.P. § 724.02)" is DISMISSED.

2. The file history entry for the papers filed November 15, 2004, will be immediately CLOSED by the Central Reexamination Unit.

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

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

April 13, 2005
6734Post NIRCDecisionDismissingExpungePetition.doc

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Paper No. 8

Brian M. Berliner
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FOR OWNER

MAIL

JUL 2 2 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

Benjamin E. Urcia
BACON & THOMAS, PLLC
625 Slaters Lane, 4th Floor
Alexandria, Virginia 22314

FOR THIRD PARTY REQUESTER

In re Reexamination of:
U.S. Patent No. 6,389,458
Reexamination Control No. 90/006,736
Filed: August 8, 2003
For: METHOD, APPARATUS AND SYSTEM FOR DIRECTING ACCESS TO CONTENT ON A COMPUTER NETWORK

DECISION ON PETITION UNDER 37 C.F.R. 1.181 TO WITHDRAW HOLDING OF ABANDONMENT

This is a decision in response to the petition under 37 CFR 1.181 requesting the withdrawal of the holding of abandonment filed July 15, 2004.

The petition is **GRANTED**.

This application was held abandoned for failure to file a timely response to the Office action dated March 26, 2004. A Notice of Abandonment is not yet mailed.

In support of the petition, Applicant asserts that the Office action dated March 26, 2004 was not received, and that no record of the Office action was found in the Attorney's file for this reexamination proceeding. Petitioner supplies a copy of the case history report for the instant reexamination proceeding and states that this is where the record would have been entered in the firm's docket calendar record. The firm's docket calendar record shows no entry indicating receipt of the Office action dated March 26, 2004.

The relevant portion of MPEP 711.03(c) states:

> The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received.

> A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received, 1156 O.G. 53 (November 16, 1993)".

Petitioner has met the criteria of set out in MPEP 711.03(c) for establishing failure to receive an Office action.

For the above, the petition is **GRANTED**. The abandonment is **WITHDRAWN**.

The reexamination proceeding file is being forwarded to the Technology Center support staff. The Office action of March 26, 2004 will be remailed to the addresses noted above with the two month Shortened Statutory Period restarted to run from the date of the re-mailing. **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(C).**

Vincent N. Trans
Special Program Examiner
Technology Center 2100
Computer Security, Architecture and
Information Security
703-305-9750

#10

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Foley Hoag, LLP
Patent Group, World Trade Center West
155 Seaport Blvd
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(For Patent Owner)

APR - 8 2004

Michael P. Kenney, Esq.
Amster Rothstein & Ebenstein
90 Park Avenue
New York, NY 10016

(For Requester)

Reexam Control No.: 90/006,737 Filed: August 8, 2003 For: U.S. Patent No. 6,001,079	:	DECISION MERGING REEXAMINATION PROCEEDINGS
Reexam Control No.: 90/006,798 Filed: October 3, 2003 For: U.S. Patent No. 6,001,079	:	

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

Reexamination in application Control No. 90/006,737 was ordered in a decision mailed October 3, 2003.

Reexamination in application Control No. 90/006,798 was ordered in a decision mailed November 3, 2003.

Merger is proper if a reexamination is ordered while a prior reexamination proceeding is pending. In view of the above, merger is appropriate and is hereby ordered.

Requirement for Same Claims in Both Proceedings

The Patent Owner is required to maintain identical specifications, abstract, claims and claim numbering in both files. In view of the fact that both reexamination applications contain identical specifications, drawings, and claims, no amendment is required.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. All papers mailed by the Office will take the form of a single action, which applies to both proceedings. All papers issued by the Office or as filed by the Patent Owner will contain the identifying data for both files and will be

physically entered in each reexamination file. All papers filed by the Patent Owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by Patent Owner must be served on Requester and Requester will be sent copies of all papers mailed by the Office. See 37 CFR 1.565 (d).

Conclusion

Reexamination Control Nos. 90/006,737 and 90/006,798 are hereby merged. At this time there is no further action required by Patent Owner. These proceedings will be forwarded to the Examiner for an action on the merits.

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

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155 Seaport Boulevard
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(For Patent Owner)

Michael P. Kenney, Esq.
Amster Rothstein & Ebenstein
90 Park Avenue
New York, NY 10016

(For Requester)

In re: Thierry POURCHEZ
Reexamination Proceeding
Control No.: 90/006,737
Filed: August 8, 2003
For: U.S. Patent No. 6,001,079

DECISION DISMISSING PETITION

MAILED

OCT 06 2006

CENTRAL REEXAMINATION UNIT

In re: Thierry POURCHEZ
Reexamination Proceeding
Control No.: 90/006,798
Filed: October 3, 2003
For: U.S. Patent No. 6,001,079

This is a decision on the October 26, 2005, patent owner petition entitled PETITION UNDER 37 CFR 1.182 FOR CONSIDERATION OF INFORMATION DISCLOSURE STATEMENT FILED AFTER NOTICE OF INTENT TO ISSUE EX PARTE REEXAMINATION CERTIFICATE.

The petition is before the Office of Patent Legal Administration.

The petition is **dismissed** for the reasons set forth below.

REVIEW OF SALIENT FACTS

1. U.S. Patent number 6,001,079 (the '079 patent) issued December 14, 1999.

2. A request for reexamination, assigned control No. 90/006,737, was filed on August 8, 2003, by a third party requestor.

3. A second request for reexamination, assigned control No. 90/006,798, was filed on October 3, 2003, by the same third party requestor.

4. The two reexamination proceedings were merged on April 8, 2004.

5. Patent owner filed an Information Disclosure Statement (IDS) on July 8, 2005.

6. The patent owner conducted a telephonic interview with the examiner on August 5, 2005. During this interview, patent owner apparently alerted the examiner to the fact that a German patent corresponding to the '079 patent had been nullified by a German court during a nullity proceeding.[1]

7. On August 19, 2005, the Office mailed, for the merged reexamination proceeding, a Notice of Intent to Issue a Reexamination Certificate (NIRC), accompanied by a copy of the PTO 1449 for the IDS of July 8, 2005, which identified the references considered by the examiner.

8. On October 26, 2005, the patent owner filed an IDS citing information stated to be related to the nullity proceeding for the German patent corresponding to the '079 patent. The instant petition accompanied the IDS.

DECISION

A review of the record shows that the examiner terminated prosecution of the proceeding by issuing the NIRC on August 19, 2005.

A) Consideration of Previously Submitted Documents

On July 8, 2005, before the issuance of the NIRC, patent owner filed a Supplemental Information Disclosure Statement (IDS) requesting consideration of the documents identified therein. On August 19, 2005, the Office mailed to the patent owner a copy of the IDS with the examiner's initials next to all but three citations, which had been crossed out by the examiner as not having been considered. The examiner did not consider documents "D-11," "D-12," and "D-13." In the present petition, patent owner requests that the examiner consider the three crossed out documents and make his consideration of each document of record. [2] An itemized postcard stamped with an Office date-stamp of July 8, 2005, has been provided by patent owner as evidence that the three non-considered documents in question were provided to the Office with the IDS.

From a review of the transcript of the deposition of John Zawaki, the Office has determined that the three documents that were identified as D-11, D-12, and D-13 are all United States patents. [3] Patent owner, however, listed these patents as "non-patent literature" on the IDS of July 8, 2005. Yet, 37 CFR 1.98(a)(1) requires that all "U.S. patents and U.S. patent application publications must be listed in a section separately from citations of other documents." Additionally, § 1.98(b)(1) requires that "each U.S. patent listed in an information disclosure statement must be identified by inventor, patent number, and issue date." The patent owner failed to comply with these requirements of § 1.98; as a consequence, in accordance with 37 CFR 1.97(i), the examiner did not consider these patents at the time he considered the other documents cited in the IDS of July 8, 2005. [4, 5]

---

[1] The record of this reexamination proceeding does not include an interview summary prepared by the examiner for the interview of August 5, 2005, which is referenced in patent owner's INTERVIEW SUMMARY received August 12, 2005.

[2] These documents were resubmitted with the IDS of October 26, 2005, and listed as documents "AK" – "AM."

[3] D-11 has been determined to be US Patent No. 4,134,402 to Mahurkar; D-12 has been determined to be US Patent No. 5,704,915 to Melsky et al., and D-13 has been determined to be US Patent No. 6,001,079 to Pourchez.

[4] "If an information disclosure statement does not comply with either this section or § 1.98, it will be placed in the file but will not be considered by the Office." 37 CFR 1.97(i) (2005).

B) **Consideration of Newly Submitted Documents**

37 CFR 1.510(a) states, in part:

> Any person may, at any time during the period of enforceability of a patent, file a request for an *ex parte* reexamination by the Office of any claim of the patent on the basis of **prior art** patents or printed publications cited under § 1.501 (emphasis added).

37 CFR 1.555(a) states, in pertinent part:

> Any information disclosure statement must be filed with the items listed in § 1.98(a) as applied to individuals associated with the patent owner in a reexamination proceeding, and should be filed within two months of the date of the order for reexamination, **or as soon thereafter as possible**. (emphasis added).

37 CFR 1.555(b)(1) states:

> Under this section, information is material to patentability in a reexamination proceeding when it is not cumulative to information of record or being made of record in the reexamination proceeding, and
>
> (1) It is a patent or printed publication that establishes, by itself or in combination with other patents or printed publications, a *prima facie* case of unpatentability of a claim.

1) Foreign Patent Documents

Patent owner identified two foreign patent documents, "AA" and "AB," in the IDS of October 26, 2005, for consideration by the examiner. [6] Both of these documents appear to be foreign counterpart applications of the '079 patent. If these documents are foreign counterpart applications, petitioner has not explained how these documents are material to the examination of the '079 patent and why they should be considered by the examiner at this point in the reexamination proceeding.[7] Moreover, even if these documents were explained as to their materiality to the examination of the '079 patent, as defined in § 1.555(b)(1), petitioner has failed to provide a statement explaining why these counterpart applications were not previously cited to the Office during this reexamination proceeding in accordance with § 1.555(a) prior to the termination of the prosecution.

---

[5] The examiner has already considered US Patent No. 4,134,402 to Mahurkar. Patent owner's attention is directed to the initialed IDS signed October 4, 2004. Similarly, the examiner indicated his prior consideration of US Patent No. 5,704,915 to Melsky et al. in the IDS signed May 17, 2004.

[6] The foreign patent documents identified for consideration are EP 0848626 and DE 69616355. Both of these documents were identified by petitioner as being foreign counterparts of the patent subject to the current, merged reexamination proceeding.

[7] On their face, documents "AA" and "AB" would not appear to qualify as prior art with respect to the '079 patent, and patent owner has not explained why they were cited.

2) <u>German Nullity Action Documents</u>

37 CFR 1.552(a) states:

> Claims in an *ex parte* reexamination proceeding will be examined on the basis of patents or printed publications and, with respect to subject matter added or deleted in the reexamination proceeding, on the basis of the requirements of 35 U.S.C. 112.

Petitioner requests consideration of the documents listed as "AC" – "AJ" in the information disclosure statement of October 26, 2005. [8] These documents were apparently generated for, and first brought to the patent owner's attention during, the German nullity proceeding.

While the present petition sets forth a timeline of events to show the timely filing of these documents with the Office, the petition does not explain how these documents, each produced at least four years after the '079 patent issued, qualify as "prior art patents or printed publications" to the '079 patent pursuant to 35 USC § 302 and 37 CFR 1.510. [9] Similarly, the petitioner does not indicate how these documents can be properly considered by an examiner when examining the claims of the '079 patent in accordance with § 1.552(a).

To the extent that petitioner is seeking consideration of the patents or patent publications discussed within documents "AC" – "AJ" of the IDS filed October 26, 2005, the patent owner has "already submitted all references cited during the nullity proceeding." [10] Therefore, based on the patent owner's statement, the documents cited in the German nullity proceeding are duplicative, or at least cumulative, of those previously considered by the examiner, and have not been shown to raise an issue regarding the patentability of the claims of the '079 patent.

For the above-discussed reasons, the petition is dismissed. The reexamination proceeding will proceed to the publication of an *ex parte* reexamination certificate.

Additional discussion:

The present merged 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 to show relevance, it is proper that the reexamination proceeding should not be reopened

---

[8] The petitioner does not indicate that these documents raise a patentability question with respect to the claims of the '079 patent.

[9] The petition states, "Patent Owner's German counsel received a copy of the German Federal Patent Court's opinion in the nullity action and promptly obtained an English translation of it. Patent Owner's undersigned counsel received the English translation on October 25, 2005." The petition and information disclosure statement were filed with the USPTO on October 26, 2005.

[10] See Page 2 of the Interview Summary, filed by patent owner on August 12, 2005.

at this late date to consider the proffered IDS papers. See also MPEP 2656 (Rev. 5, Aug. 2006).[11] 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,** 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 that is different than raised in this merged proceeding, then the patent owner can always file a new request for reexamination for consideration of the references.

CONCLUSION

1. The patent owner petition to have the information disclosure statement filed October 26, 2005, considered is dismissed.

2. The IDS papers filed October 26, 2005, will be entered into the file, but will not be considered by the examiner.

3. The present proceeding will continue in the publication process, toward issuance of a reexamination certificate.

4. Telephone inquiries related to this decision should be directed to Brian E. Hanlon, Legal Advisor, at (571) 272-5047, or in his absence, the undersigned at (571) 272-7710.

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

9-29-06
c:\Kiva\kenids\decisions\6737 IDS after NIRC published.doc

[11] "…..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."

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Larry Coates (For Patent Owner)
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Richard R. Johnson (For Requester)
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JUN 0 2 2005

OFFICE OF PETITIONS

In re Delsalle et al.
Reexamination Proceeding
Control No. 90/006,739
Filed: August 11, 2003
For: U.S. Patent No. 5,840,195

DECISION GRANTING PETITION

This is a decision on the March 29, 2005, patent owner PETITION UNDER 37 CFR 1.137(b) TO REVIVE UNINTENTIONALLY TERMINATED REEXAMINATION PROCEEDING, requesting revival of the present proceeding under the unintentional standard.

The petition 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. 18-1167, in accordance with petitioner's authorization in the third from the last paragraph of the instant petition.

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

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

DECISION

The instant petition under 37 CFR 1.137(b) is accompanied by the appropriate statement pursuant to § 1.137(b)(3). In addition, as required by § 1.137(b)(1), a proposed response to the non-final Office action in *Ex Parte Reexamination* mailed September 28, 2004, was previously filed on December 30, 2004 (certificate of mailing dated December 28, 2004). (This response was untimely as the required petition for a one-month extension of time was not presented prior to the expiration of the original response period). Finally, the petition includes the petition fee required pursuant to § 1.137(b)(2).

On March 28, 2005, petitioner submitted a copy of the instant petition and of the papers filed December 30, 2004, with a Certificate showing proof of service on the third party requester in accordance with 37 CFR 1.550(f).

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

CONCLUSION

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

II. The application file is being forwarded to Technology Center AU 1724 for consideration of the response filed December 30, 2004.

III. Any further communications as to the merits of the reexamination proceeding should be directed to the examiner, Chester Barry, in Technology Center 1724, at (571) 272-1152.

IV. Telephone inquiries related to this decision should be directed to Senior Petitions Attorney Nancy Johnson at (571) 272-3219.

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

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United States Patent and Trademark Office
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Stephen B. Goldman
LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD NJ 07090

(For Patent Owner)

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APR 0 4 2005

OFFICE OF PETITIONS

In re Odd N. Oddsen
Reexamination Proceeding
Control No. 90/006,740
Filed: August 11, 2003
For: U.S. Patent No. 6,782,274

DECISION GRANTING PETITION

This is a decision on the March 17, 2005 patent owner PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNAVOIDABLY UNDER 37 CFR 1.137(a), requesting revival of the present proceeding under the "unavoidable" standard. Given petitioner's assertions on petition, the petition is being taken as a petition under 37 CFR 1.181 requesting withdrawal of the termination of the reexamination proceeding.

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

The petition under 37 CFR 1.181 is granted.

Consideration of the petition under 37 CFR 1.137(a) is unnecessary. Accordingly, the petition fee of $250 set forth in 37 CFR 1.17(l) for the present petition under 37 CFR 1.137(a) is being refunded to petitioner's Deposit Account No. 12-1095.

DECISION ON PETITION UNDER 37 CFR 1.181

The reexamination proceeding was terminated under 37 CFR 1.550(d) for failure to timely respond to the Notice of Defective Paper in *Ex Parte* Reexamination mailed January 20, 2005. On instant petition, petitioner asserts that no such Notice was received in the Office of the attorneys of record. The petition includes a

statement from the practitioner attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. In addition, the petition includes a copy of the docket record where the non-received Office communication would have been entered had it been received and docketed. Petitioner has thus overcome the presumption of proper mailing of the Office action to the correspondence address of record.

In view thereof, the petition is **GRANTED**, and the holding of terminated reexamination proceedings is hereby **WITHDRAWN**.

It is noted that a response (reply) to the January 20, 2005 Notice of Defective Paper in *Ex Parte* Reexamination accompanied the filing of the instant petition. Petitioner has a copy of the Notice, and there is, thus, no need to re-mail the Notice to patent owner.

CONCLUSION

1. The petition under 37 CFR 1.181 is **granted**.

2. The reexamination file is being returned to Technology Center 3632 to address the response to the January 20, 2005 Notice of Defective Paper in *Ex Parte* Reexamination which accompanied the filing of the instant petition.

3. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Korie Chan, in Technology Center 3632, who can be reached at (571) 272-6816.

4. Telephone inquiries related to this decision should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

Nancy Johnson for

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

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3-31-05

UNITED STATES PATENT AND TRADEMARK OFFICE

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Mailed: March 1, 2005

Hoffmann & Baron LLP
6900 Jericho Turnpike
Suite 200
Syosset NY 11791

In re Golub et al.
Reexamination Proceeding
Control No.: 90/006,752
Filed: August 18, 2003
For: U.S.Patent No. 4,666,897

: DECISION ON
: REQUEST FOR
: EXTENSION OF TIME

This is a decision on Patent Owner's Request for a one-month Extension of Time filed on February 15, 2005. Patent Owner states that there is sufficient cause to justify the extension of time based on a discussion with the examiner that she would not be able to begin preparing an Advisory Action until the week of February 21, 2005 which would not give patent Owner sufficient time to prepare an Appeal Brief which may have to address any replies or new issues raised in the Advisory Action.

The Request is **GRANTED** for one month.

The filing of Patent Owner's Appeal Brief is extended by one-month from February 27, 2005 to March 27, 2005.

Marianne C. Seidel for

Bruce Kisliuk
Director, Technology Center 1600

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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.
90/006,755	08/20/2003	5376159	020354 056P4	7493

7590 10/14/2005

Robert A. Miller
Patent & Licensing Department
Nalco Chemical Company
One Nalco Center
Naperville, IL 60563-1198

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/14/2005

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

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10/14/05

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Bruce E. Peacock, Esq.

WEGMAN HESSLER & VANDERBURG

6055 Rockside Road, Suite 200

Cleveland, OH 44131

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/006755

PATENT NO. 5,376,159

ART UNI 3900

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a 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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Cleveland, OH 44131

MAILED
OCT 14 2005
REEXAM UNIT

Cunningham et al	:	
Reexamination Proceeding	:	**DECISION**
Control No. 90/006,755	:	**GRANTING**
Filed: August 20, 2003	:	**PETITION**
For: U.S. Patent No. 5,376,159	:	

This is a decision on the August 17, 2005, patent owner PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY 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 fee of $1,500.00 set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b) has been charged to petitioner's Deposit Account No. 14-0105, in accordance with petitioner's authorization on the cover page of the petition sent via facsimile on August 17, 2005.

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

DECISION ON PETITION UNDER 37 CFR 1.137(b)

The instant petition under 37 CFR 1.137(b) is accompanied by the appropriate statement pursuant to 37 CFR 1.137(b)(3). In addition, a substitute Response to Office Action was filed on

October 13, 2005,[1] to accompany patent owner's August 17, 2005 petition, thereby providing the response "required to the outstanding Office action or notice" pursuant to 37 CFR 1.137(b)(1). Further, the required petition fee is being charged to petitioner's deposit account as authorized on the cover page of the 37 CFR 1.137(b) petition, thereby providing the "petition fee as set forth in 37 CFR 1.17(m)" pursuant to 37 CFR 1.137(b)(2). Accordingly, the petition under 37 CFR 1.137(b) is granted.

CONCLUSION

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

2. Jurisdiction over the reexamination proceeding is being returned to Technology Center 1700 for consideration, in due course, of the substitute Response to Office Action filed October 13, 2005, to accompany the petition.

3. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Stuart Hendrickson, in Art Unit 1754, who can be reached at (571) 272-6828.

4. Telephone inquiries related to this decision should be directed to Samuel Broda at (571)272-7711.

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

[1]In response to a request for same, in a telephone call made by Samuel Broda to Michael Martin on October 11, 2005.

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Fish & Richardson, P.C.
P. O. Box 1022
Minneapolis, MN 55440-1022

(For Patent Owner)

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JUN 22 2006

CENTRAL REEXAMINATION UNIT

In re Reexamination Proceeding :
Bradford Keene :
Control No. 90/006,757 : DECISION GRANTING PETITION
Filed: September 24, 2003 :
U.S. Patent No. 6,502,936 :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on March 30, 2006, by facsimile transmission, for entry of late papers based upon unintentional delay.

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

37 CFR 1.137(b) states:

> "*Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by: (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in § 1.17(m); (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section."

Petitioner, patent owner, argues that a petition, a $750.00 check for the petition fee; and copies of an amendment, a transmittal letter, a petition and fee for an extension of time were filed on September 1, 2005. As evidence thereof, petitioner submitted a copy of the papers which included a certificate of mailing by First Class Mail on September 1, 2005 and a copy of a postcard receipt which acknowledges receipt of the petition, petition fee; and copies of an amendment, a transmittal letter, a petition and fee for an extension of time were filed on September 6, 2005. Copies of the petition, petition fee; and copies of an amendment, a transmittal letter, a petition and a check for the petition fee for an extension of time were filed were also submitted.

Upon review of the record, neither the petition, the $750.00 check for the petition fee nor copies of the amendment, the transmittal letter and a check for the petition and fee for an extension of time filed on September 1, 2005, have been located among the application papers in the Image

File Wrapper (IFW). However, the evidence is convincing that a petition, petition fee; and copies of an amendment, a transmittal letter, a petition and fee for an extension of time were filed September 1, 2005, which were subsequently misplaced in the PTO.

A review of the petition reveals that it includes an authorization to charge counsel's deposit account.

The present petition under 37 CFR 1.137(b) includes the requisite response (item 1), a $750.00 petition fee under 37 CFR 1.17(m) in the authorization to charge counsel's deposit account (item 2) and the requisite statement (item 3).

The petition for entry of the late papers is granted.

A review of the record reveals that on March 24, 2005, a declaration was filed containing a Power of Attorney and a Change of Correspondence Address. The Power of Attorney and Change of Correspondence Address have been entered.

$750.00 has been charged to counsel's deposit account no. 06-1050 in accordance with the present petition.

Jurisdiction over the reexamination proceeding is being returned to Technology Center Art Unit 2873 for further examination and consideration of the amendment filed February 2, 2005 and March 2, 2005 (received March 7, 2005), in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Hung Dang, in Technology Center Art Unit 2873, who can be reached at 571-272-2326.

Telephone inquiries related to this decision should be directed to Fred A. Silverberg at 571-272-7719.

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

Kenneth M. Schor
Conferee: Kenneth M. Schor

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(For Patent Owner)

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(For Third Party Requester)

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AUG 1 6 2005

REEXAM UNIT

Norman Cameron
Suite 1401
1166 Alberni Street
Vancouver, BC V6E 3Z3
Canada

(Courtesy Copy)

In re
Reexamination Proceeding
Control No.: 90/006,764
Filed: August 29, 2003
For: U.S. Patent No.: 4,848,289

: **DECISION**
: **DISMISSING**
: **PETITION**

This is a decision on the July 18, 2005, third party requester petition entitled PETITION TO THE DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE TO REOPEN REEXAMINATION NUMBER 90/006,764 AND ACCOMAPNYING MEMORANDUM .

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

The petition is dismissed for the reasons set forth below.

REVIEW OF FACTS

1. Patent number 4,848,289 issued on July 18, 1989.

2. A request for reexamination, assigned control No. 90/006,764, was filed on August 29, 2003 by third party requester (hereinafter "petitioner").

3. On October 23, 2003, Joseph W. Berenato, III, a practitioner of record in the file of U.S. Patent No. 4,848,289 filed a change or correspondence address for the patent owner in this proceeding.

4. An Order granting reexamination was mailed November 12, 2003.

5. No patent owner statement pursuant to 37 CFR 1.530 was filed.

6. A first, non-final Office action was mailed on December 21, 2004.

7. A petition for an extension of the time set for filing a response to the non-final Office action was filed on January 24, 2005.

8. A decision granting the petition for extension of time was mailed on February 23, 2005, and the period for filing a response to the non-final Office action was extended to run through May 2, 2005.

9. The examiner conducted a personal interview with counsel for patent owner on April 19, 2005.

10. A response to the non-final Office action was filed on April 28, 2005.

11. A Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed on May 31, 2005.

12. The reexamination proceeding was forwarded to the Office of Patent Publication on June 2, 2005.

13. The instant petition was filed on July 18, 2005.

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

The record shows that the examiner terminated prosecution on the merits in this reexamination proceeding by issuing a NIRC on May 31, 2005. The file was thereafter forwarded to the Office of Publications for issuance of the reexamination certificate. The file is presently being prepared for printing the reexamination certificate.

Petitioner has indicated that the instant petition is filed pursuant to Sections 1.181(a)(1), 1.181(a)(3), 1.182 and 1.313(a)-(b) of Title 37 of the code of Federal Regulations. Petitioner has tendered a $130.00 petition fee, presumably for the petition filed pursuant to 37 CFR 1.182. [1,2] However, as petitioner has requested relief pursuant to 37 CFR 1.181(a)(1) and 37 CFR 1.181(a)(3) which relate to the general supervisory authority of the Director, and inasmuch as the relief requested invokes the general supervisory authority of the Director to review alleged "mistakes" made by the examiner during the reexamination proceeding, [3] it appears that a petition under 37 CFR 1.182 is not required. [4] Since a petition pursuant to 37 CFR 1.181 does not require any fee, the $130.00 petition fee tendered with the petition will be refunded by crediting Deposit Account No. 03-2469 in the amount of $130.00.

With regard to the merits of the relief requested by petitioner, 32 U.S.C. § 304 provides:

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[1] Effective November 22, 2004, 37 CFR 1.182 requires that a petition fee pursuant to 37 CFR 1.17(f) be tendered with the petition. Effective November 22, 2004, 37 CFR 1.17(f) requires a fee of $400.00, with no small entity deduction.

[2] By its terms, 37 CFR 1.313 applies to "applications", not to reexamination proceedings. Therefore, 37 CFR 1.313 is inapplicable and any fee required thereby is irrelevant with respect to the instant petition.

[3] Petition, page 2.

[4] By its terms, 37 CFR 1.182 applies to "all situations not specifically provided for ...," and here, 37 CFR 1.181 has been advanced by petitioner.

"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 1.535 provides in pertinent part:

"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. ... **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 supplied.)

37 CFR 1.550(g) and (h) provide:

"(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.

(h) Submissions by third parties, filed after the date of the order for *ex parte* reexamination pursuant to § 1.525, must meet the requirements of and will be treated in accordance with § 1.501(a)." (Emphasis supplied.)

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 petition does not qualify as a prior art statement pursuant to 37 CFR 1.501 and was not filed prior to the date of the order for *ex parte* reexamination. Therefore, neither the reexamination statute nor the regulations promulgated pursuant thereto provide authority for the filing by a third parte requester of a paper directed to the issues of an *ex parte* reexamination proceeding filed pursuant to 35 U.S.C. § 302. The reexamination statute and its intent are clear that examination conducted by the examiner during a reexamination proceeding requested under 35 U.S.C. § 302 must be *ex parte*. [5] All of the assertions set forth by petitioner are directed to the merits of the reexamination proceeding, and addressing them would be contrary to the intent of the reexamination statute. Comments at this stage of the proceeding [6] are precluded, since the examination conducted by the examiner in an *ex parte* reexamination proceeding requested under 35 U.S.C. § 302 is an *ex*

---

[5] *In re Amp*, 212 USPQ 826 (Comr. Pats. 1981)

[6] As noted, *supra*, prosecution has been terminated; a NIRC has issued.

parte proceeding following the expiration of the statement/reply period under 37 CFR 1.530 and 1.535, as clearly set forth in these regulations and in 37 CFR 1.550(g).

Accordingly the third party requester petition of July 18, 2005 is an improper submission under 37 CFR 1.550(g) and it is being "returned" to the third party requester. Because the reexamination proceeding is contained in an image file wrapper (IFW), the petition cannot be physically removed from the file and sent back to the third party requester. However, the petition will be marked "not public" and "closed" in the IFW. A copy of this decision will be made part of the publicly available IFW.

CORRESPONENCE ADDRESS

A review of the record shows that as noted, *supra*, a change of correspondence address for the patent owner was filed in favor of Joseph W. Berenato, III, a practitioner of record in the file of U.S. Patent No. 4,848,289. The patent owner address of record is accordingly:

Joseph W. Berenato, III
Liniak, Berenato & White, LLC
6550 Rock Spring Drive
Bethesda, MD 20817

Notwithstanding the change of address, correspondence for patent owner has subsequently been routinely mailed to Norman Cameron, a registered practitioner who is also of record in the file of U.S. Patent No. 4,848,289. All future correspondence for patent owner will be mailed to the Bethesda, MD address. However, as a courtesy, a copy of this decision is being mailed to Mr. Cameron at the Vancouver, BC address.

CONCLUSION

1. The third party requester petition under 37 CFR 1.181 to reopen reexamination proceeding 90/006,764 after conducting the petitioner's requested review of the examination process and a review of the decisions made by the examiner, is **dismissed** .

2. The petition is being **"returned"** to the third party requester in the manner discussed, *supra*. The "return" will take the form of closing the petition document in the IFW file of the 90/006,764 reexamination proceeding and marking the document "not public."

3. A copy of this decision is being made of record in the IFW of reexamination proceeding 90/006,764.

4. The process of issuing and publishing the reexamination certificate resulting from reexamination proceeding 90/006,764 will continue.

5. At the same time, the Central Reexamination Unit will (a) make the necessary IFW and PALM changes such that future correspondence for patent owner will be mailed to the Bethesda, MD address, and (b) refund the $130.00 petition fee tendered with the petition by crediting Deposit Account No. 03-2469 in the amount of $130.00.

6. 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
August 12, 2005

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August 27, 2004

Paper No. 10

Daniel Bliss
Bliss McGlynn PC
2075 West Big Beaver Road
Troy, MI 48084

(For Patent Owner)

James M. McPherson
Dobrusin & Thennisch PC
401 S. Old Woodward Ave. Ste. 311
Birmingham, MI 48009

(For Third Party Requester)

Enclosure: Petition filed July 9, 2004.

In re Cross et al.	:	
Ex parte Reexamination Proceeding	:	DECISION DISMISSING
Control No. 90/006,767	:	PETITION AND RETURNING
Filed: August 29, 2003	:	IMPROPER PAPER
For: U.S. Patent No. 5,184,833	:	

This is a decision on the July 9, 2004, third party reexamination requester petition requesting that the provisions of 37 CFR 1.550(g) 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:
>
> (1) in accordance with § 1.510 or § 1.535; or
>
> (2) entered in the patent file prior to the date of the order for *ex parte* reexamination pursuant to § 1.525.

The present petition is not a request for reexamination in compliance with the requirements of 37 CFR 1.510, and it is not a reply pursuant to 37 CFR 1.535. Nor does the petition qualify as a prior art statement under 37 CFR 1.501. Neither the rules nor any provision of the statute provide authority for a third party requester of 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 the sufficiency of the examiner's reasoning in the Office action of May 13, 2004. This request by petitioner is clearly directed to the merits of the reexamination proceeding, and addressing the 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). 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).

Petitioner provides no showing of extraordinary circumstances which would warrant waiver of the rules under 37 CFR 1.183 and compel entry and consideration of the petition. With respect to petitoner's argument regarding the examiner's failure to provide "detailed reasoning" in his determination regarding "motivation," the record clearly shows in paragraphs 11 and 12 of the Office action of May 13, 2004, that the examiner considered the teaching of the prior art and the arguments of requester in his determination. Accordingly, 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.

For the reasons set forth above, the third party requester petition of July 9, 2004, is <u>dismissed</u> and is being returned with this decision. This decision returning the improper paper will be made of record in the reexamination file.

CONCLUSION

1. The third party requester petition filed July 9, 2004, is **dismissed** and is being returned with this decision.

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

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C:\zJerry\90_6767 3PR request for to examiner to elaborate reasoning in Office action.wpd

mas

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Paper No. 7

Ralph C. Francis
Francis Law Group
1808 Santa Clara Ave.
Alameda, CA 94501

(For Patent Owner)

James A. Deland
Deland Law Office
P.O. Box 69
Klamath River, CA 96050

(For Requester)

MAILED
JAN 20 2004
REEXAM UNIT

Sam H. Patterson	:	
Ex Parte Reexamination Proceeding	:	**DECISION DISMISSING**
Control No. 90/006,774	:	**PETITION**
Filed: September 11, 2003	:	
For: U.S. Patent No. 4,900,291	:	

This is a decision on the September 11, 2003, 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 participate in the *ex parte* reexamination. Requester requests "the privilege to comment on any inaccuracies or omissions made by the patent owner, or any perceived misunderstandings or omission related to the prior art on behalf of the examiner." 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 comment on any 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).

Petitioner's arguments that Congress did not intend the current 1999 *ex parte* reexamination statute to prohibit active participation by the third party requester is not persuasive. 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*.

With regard to petitioner's contention (page 8 of the petition) that the Director has the discretion to waive 37 CFR 1.913 and grant petitioner the "privilege" to file an *inter partes* reexamination request, it is noted that the '291 patent issued in 1990. Congress, however, drafted the 1999 statute to specifically exclude from *inter partes* reexamination any patent which issued from an application filed prior to November 29, 1999. The rule (§ 1.913) merely implements this statutory exclusion. The Director does not have the authority nor discretion to waive the statute.

For the reasons set forth above, the third party requester petition of September 11, 2003, is dismissed.

CONCLUSION

1. The third party requester petition filed September 11, 2003, 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_6774petition by 3PR to participate in ex parte reexam.wpd

#8/Petition for Time

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Request for Reexamination of:
Patent No. 4,900,291
Issued: February 13, 1990
Inventor: Sam H. Patterson
For: REEXAM CONTROL NO. 90/006,774 Art Unit 3682
Filed: September 11, 2003
Examiner: Marcus Charles
Box REEXAM

OK to Enter SM

January 26, 2004

LETTER TO THE UNITED STATES PATENT AND TRADEMARK OFFICE

TO THE COMMISSIONER OF PATENTS AND TRADEMARKS,
Alexandria, VA 22313

SIR:

In response to the Order Granting Ex Parte Reexamination (Order) mailed December 8, 2003, and pursuant to 37 CFR § 1.550(c) and MPEP § 2265, SRAM Corporation, the patent owner, requests a one-month extension of time to file its Patent Owner's Statement pursuant to 37 C.F.R. § 1.530(b) in response to the Order and Shimano's Request for Ex Parte Reexamination (Request), which was filed September 11, 2003.

SRAM needs this extension to provide a response to the Order and Shimano's Request. Shimano's Request is lengthy, involves numerous claims and raises multiple issues. Similarly, the Order involves numerous claims and raises several issues regarding the patentability of the claims of U.S. Patent Reexamination Certificate B1 4,900,291. SRAM has been diligent regarding this matter, but its in-house patent attorney whose assistance is required in responding to this action has been under severe time constraints for the following reasons:

1. It was necessary for SRAM's in-house patent counsel to assist in arguing against Requester Shimano's motions for preliminary injunction in two pending litigation matters concerning trigger shifters in France and Germany.

Additionally, SRAM is now preparing for the trial on the merits in both matters and in-house patent counsel is involved in the trial preparation.

2. SRAM's in-house counsel was involved recently with the filing of an invalidation proceeding with the Intellectual Property Office in Taiwan against a Shimano patent concerning trigger shifter technology. That matter was filed December 11, 2003.

3. SRAM's in-house counsel is currently working on an appellate brief with regard to litigation with the Requester, Shimano, in Germany, concerning cassette technology. SRAM's brief is due January 24, 2004, and that matter is scheduled for First Oral Hearing in the appeals court on February 12, 2004.

4. SRAM's in-house counsel has been involved in settlement negotiations with regard to recently concluded litigation in the United States District Court for the Northern District of Illinois in a matter entitled, Answer Products, Inc. v. SRAM Corp., Case No. 03 C 3165 CRN (IHL).

5. SRAM's in-house patent counsel is also involved in coordinating with outside counsel the production of documents from pending litigation involving the Reexamined '291 patent: SRAM Corporation v. AD-II Engineering, Inc., Case Nos. 00-C-6675, 01-C-0062 (N.D. Ill.) and SunRace Roots Enterprise Co., Ltd. v. SRAM Corp., No. C-00-3217VRW (N.D. Cal.).

The above activities demanded and continue to demand a substantial time commitment by SRAM and its in-house patent attorney, as a result of which SRAM has had insufficient time to prepare a suitable response to the Order and Shimano's Request. Both the Request and the Order involve numerous claims, and raise multiple issues.

PAGE 3/6 * RCVD AT 1/28/2004 4:43:56 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-2/4 * DNIS:7468000 * CSID:3142314342 * DURATION (mm-ss):01-28

SRAM respectfully submits that these circumstances demonstrate sufficient cause for a one-month time extension, up to and including March 8, 2004, which is believed to be a reasonable amount of additional time for a response to the Order and Request. The patent owner recognizes that reexamination proceedings are to be conducted with special dispatch. However, the patent owner requests favorable consideration so that it has a fair opportunity to present well-reasoned and considered arguments in defense of its patent.

Respectfully submitted,

Michael E. Godar

Michael E. Godar, Reg. No. 28,416
SENNIGER, POWERS, LEAVITT & ROEDEL
One Metropolitan Square, 16th Floor
St. Louis, MO 63102
(314) 231-5400

PAGE 4/6 * RCVD AT 1/28/2004 4:43:56 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-2/4 * DNIS:7468000 * CSID:3142314342 * DURATION (mm-ss):01-28

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Law Offices of

SENNIGER, POWERS, LEAVITT AND ROEDEL

One Metropolitan Square, 16th Floor
St. Louis, Missouri 63102

Telephone (314) 231-5400
Facsimile (314) 231-4342

FACSIMILE TRANSMITTAL COVER SHEET

DATE: January 28, 2004 **ATTORNEY DOCKET NUMBER:** SRAM 1599
PTO FACSIMILE NUMBER: (703) 305-3597

PLEASE DELIVER THIS FACSIMILE TO: Examiner Marcus Charles
THIS FACSIMILE IS BEING SENT BY: Michael E. Godar
NUMBER OF PAGES: 6 **INCLUDING COVER SHEET**

TIME SENT: 3:50 pm **OPERATOR'S NAME** Mindy L. Ward

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

Mindy L. Ward
Typed or printed name of person signing certification

Mindy L Ward
Signature

January 28, 2004
Date

Type of paper transmitted: Letter to the United States Patent and Trademark Office and Power of Attorney and Revocation of Prior Powers

Applicant's Name: SRAM Corporation

Serial No. (Control No.): 90/006,774 **Examiner:** Marcus Charles

Filing Date: September 11, 2003 **Art Unit:** 3682

Application Title: BICYCLE GEAR SHIFTING METHOD AND APPARATUS

IF YOU DO NOT RECEIVE ALL PAGES CLEARLY, CALL BACK AS SOON AS POSSIBLE. CONFIRMING NUMBER IS (314) 231-5400.

90006774.012804

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JUL - 5 2005

Commissioner for Patents
United States Patent and Trademark Office
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For the Patent Owner:

Michael E. Godar
Senniger, Powers, Leavitt & Roedel
One Metropolitan Square, 16th Floor
St. Louis, MO 63102

For the Requester:

Deland Law Office
P.O. Box 69
Klamath River, CA 96050

DECISION ON PETITION
FOR EXTENSION OF TIME

In re Reexamination proceeding 90/006,774
Filed: September 11, 2003
For: BICYCLE GEAR SHIFTING METHOD AND APPARATUS

This is a decision on the request for extension of time filed by the Patent Owner under 37 CFR 1.550(c) on June 16, 2005.

The petition is **GRANTED**.

A non-final Office action was mailed on April 25, 2005 wherein a shortened statutory period for response of two months was set. Patent Owner requests an extension of time of one month to submit a response to the non-final rejection. The reason for the request is that during an interview held with the examiner on June 14, 2005, the examiner indicated that in order to be persuasive, the alleged differences between the prior art and the claimed invention would need a demonstration by the Patent Owner using a replica of the prior art. The Patent Owner requests the one month extension of time to be able to comply with the examiner's request.

An extension of time for the Patent Owner to submit a response to the non-final Office action of April 25, 2005 is granted for a period of one month. The period for response will expire on July 25, 2005.

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

Robert Oberleitner, Director
Patent Technology Center 3600
(571) 272-5350

SM/SM: 6/29/05
SM

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.
90/006,775	09/12/2003	6428526	P & G-001	4595

7590 05/22/2008

Kimberly Clark Worldwide, Inc.
Legal Dept.
401 N. Lake Street
Neenah, WI 54956

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/22/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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MAY 22 2008

CENTRAL REEXAMINATION UNIT

KIMBERLY CLARK WORLDWIDE, INC. (For Patent Owner)
LEGAL DEPT.
401 N. LAKE STREET
NEENAH WI 54956

PETER G. PAPPUS, ESQ. (For Third Party Requester)
SUTHERLAND, ASBILL & BRENNAN LLP.
999 PEACHTREE STREET, NE
ATLANTA, GA 30309-3996

In re Reexamination Proceeding :
T. Heindel et al. :
Control No. 90/006,775 : DECISION GRANTING PETITION
Filed: September 12, 2003 :
U.S. Patent No. 6,428,526 :
Attorney Docket No. P & G-001 :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on April 28, 2008, 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, 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, the requisite response (Amendment - item 1), an authorization to charge counsel's deposit account for the $1,540.00 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.

$1,540.00 has been charged to counsel's deposit account no. 11-0875 in accordance with the present petition.

Jurisdiction over the reexamination proceeding is being returned to Technology Center Art Unit 3761 for further examination and consideration of the Amendment filed April 28, 2008, in due course. See 37 CFR 41.50(b)(1).

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Karin Reichle, in Technology Center Art Unit 3761, who can be reached at 571-272-4936.

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

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CENTRAL REEXAMINATION UNIT

Kimberly-Clark Worldwide, Inc. (For Patent Owner)
Legal Department
401 North Lake Street
Neenah, Wisconsin 54956

Peter G. Pappas, Esq. (For Third Party Requester)
Sutherland, Asbill & Brennan LLP.
999 Peachtree Street, NE
Atlanta, GA 30309-3996

In re *Heindel et al.*	:	
Ex Parte Reexamination Proceeding	:	**DECISION**
Control No.: 90/006,775	:	**DENYING**
Filed: September 12, 2003	:	**PETITION**
For: U.S. Patent No. 6,428,526	:	

This is a decision addressing the October 2, 2008 patent owner petition styled as "Petition Pursuant to 37 CFR § 1.182" ("the petition").

The petition, and *ex parte* reexamination control number 90/006,775, are before the Office of Patent Legal Administration for decision.

Summary: The petition has been carefully considered. However, the relief requested in the petition is denied.

This decision is designated as a final agency action pursuant to 5 U.S.C. § 704.

FEES

Patent owner has authorized a charge against a deposit account of $130.00 for the petition fee, as well as authorization to charge any additionally required fees. The fee for a petition under 37 CFR 1.182 is the fee set by 37 CFR 1.17(f). That fee is currently $400.00. Accordingly the $130.00 fee will be credited back to Deposit Account No. 11-0875 and the proper petition fee of $400.00 will be charged to Deposit Account No. 11-0875.

11/06/2008 JHCDOUGA 00000001 110875 90006775
01 FC:1462 400.00 DA

REVIEW OF FACTS

1. U.S. Patent No. 6,428,526 (the '526 patent) issued on August 6, 2002.

2. The present request for reexamination was filed by patent owner on September 12, 2003, was assigned control No. 90/006,775, and is hereinafter referred to as the '775 reexamination proceeding.

3. Reexamination was ordered in the '775 reexamination proceeding on November 7, 2003.

4. Prosecution progressed to the point at which a final rejection was mailed in the '775 reexamination proceeding on September 2, 2004, and the final rejection was appealed.

5. After the mailing of an examiner's answer on August 29, 2006, and the receipt of a reply brief on October 23, 2006, the Board of Appeals and Interferences (BPAI) issued a decision on June 20, 2007 in which the rejection of claims 1-11 was reversed, the rejection of claims 12-22 was affirmed, and a new ground of rejection was entered by the BPAI for claims 1-11.

6. On August 20, 2007, amendment papers were filed by the patent owner in response to the BPAI decision mailed June 20, 2007.

7. The August 20, 2007 amendment papers included a Request for Continued Reexamination (RCE) Transmittal form, a submission in the form of an amendment responsive to the BPAI decision, and a deposit account payment in the amount of $790.00 for the RCE fee under 37 CFR 1.17(e).

8. In a Decision dated October 24, 2007, the August 20, 2007 (RCE) paper was returned to patent owner as an improper paper and the RCE fee was not charged. However, the amendment was forwarded to the examiner for consideration.

9. On November 28, 2007, the Office mailed a Notice of Defective paper in which the examiner held the August 20, 2007 amendment to be informal, and set a period in which patent owner could correct the informality.

10. On December 19, 2007, patent owner submitted "revised" RCE papers, which included, *inter alia*, a revised amendment that patent owner stated would "correct failings" in the August 7, 2007 amendment.

11. On January 28, 2008, the Office mailed Decision that returned the December 19, 2007 "revised" RCE papers to patent owner, without charging patent owner the RCE fee under 37 CFR 1.17(e).

12. On March 31, 2008, the Office mailed a paper advising patent owner that the amendment that had accompanied the December 19, 2007 "revised" RCE papers was not in proper amendment format pursuant to 37 CFR 1.530, and there was a failure to comply with 37 CFR 41.50(b)(1).

13. On April 28, 2008, patent owner filed a petition to accept late papers in the '775 reexamination proceeding, together with and amendment that was alleged to comply with the entry requirements of the rules.

14. On May 22, 2008, the Office granted the petition to accept late papers, and the '775 reexamination proceeding was returned to Technology Center Art Unit 3761 for further examination based on the April 28, 2008 amendment papers.

15. On July 2, 2008, the examiner mailed a final rejection for claims 1-3 and 7-11, the only pending claims subject to examination. [1]

16. On August 28, 2008, patent owner filed a paper to address the July 2, 2008 final rejection, in which certain claim amendments were proposed.

17. On September 19, 2008, the examiner issued an advisory action in which entry of the August 28, 2008 claim amendments was refused. [2]

18. On October 2, 2008, patent owner filed a Notice of Appeal.

19. On October 2, 2008, patent owner also filed the present petition, apparently seeking relief stated to be directed to a "Request for Continued Reexamination" (RCR).

RELEVANT AUTHORITY

35 U.S.C. § 132(b) provides:

> 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:

> 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.

37 CFR 1.114 provides:

> (a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of:
> (1) Payment of the issue fee, unless a petition under § 1.313 is granted;
> (2) Abandonment of the application; or
> (3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.
> (b) Prosecution in an application is closed as used in this section means that the application is under appeal, or that the last Office action is a final action (§ 1.113), a notice of allowance (§ 1.311), or an action that otherwise closes prosecution in the application.
> (c) A submission as used in this section includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. If reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of § 1.111.
> (d) If an applicant timely files a submission and fee set forth in § 1.17(e), the Office will withdraw the finality of any Office action and the submission will be entered and considered. If an applicant

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[1] Claims 12-22 remained in the record of the '775 reexamination proceeding pending treatment of claims 1-11. Pursuant to 37 CFR 41.50(b)(1), the BPAI decision affirming the rejection of claims 1-11 was not final for purposes of further appeal, because the filing of the "RCE" papers was deemed to be a request to reopen prosecution of the claims subject to the new ground of rejection in the BPAI decision.

[2] Entry was refused both on formal grounds (claims not in proper amended format) and substantive grounds (proposed claims raised new issues requiring further consideration/search; proposed amendments did not materially reduce or simplify the issues for appeal).

files a request for continued examination under this section after appeal, but prior to a decision on the appeal, it will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner. An appeal brief (§ 41.37 of this title) or a reply brief (§ 41.41 of this title), or related papers, will not be considered a submission under this section.
(e) The provisions of this section do not apply to:
(1) A provisional application;
(2) An application for a utility or plant patent filed under 35 U.S.C. 111(a) before June 8, 1995;
(3) An international application filed under 35 U.S.C. 363 before June 8, 1995;
(4) An application for a design patent; or
(5) A patent under reexamination.

37 CFR 1.116(b) provides:

After a final rejection or other final action (§ 1.113) in an application or in an *ex parte* reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an *inter partes* reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):
(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;
(2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or
(3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

37 CFR 1.550(a) provides:

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.

37 CFR 1.181 provides:

(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.
...
(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.
...
(g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

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).

United States Patent and Trademark Office *Official Gazette*, March 1, 2005 (1292 *OG* 20) provides, in pertinent part:

> D. Transition Procedure: It is noted that, as a consequence of the changes made to MPEP 2240, a patent owner will now be prevented from obtaining entry of an amendment and/or evidence not entered after final rejection in an *ex parte* reexamination proceeding by filing another request for reexamination based on the same substantial question of patentability raised/existing in the pending reexamination proceeding. In order to provide relief to the patent owner, the Office plans to propose a revision to the patent rules to provide for the filing of a request for continued reexamination (RCR) which would be similar to the request for continued examination (RCE) practice for applications. If the RCR practice is implemented, the patent owner, by filing an RCR, could obtain continued prosecution on the merits in the reexamination proceeding, including entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding or after an action closing prosecution in an *inter partes* reexamination proceeding. Until these new rules become effective, however, patent owners are advised to use either: (1) the petition procedure under 37 CFR 1.181 to seek review of a denial of entry of an amendment submitted after final rejection in an *ex parte* reexamination proceeding or after an action closing prosecution in an *inter partes* reexamination proceeding; or (2) the petition procedure under 37 CFR 1.182 to seek relief that is not currently provided by an existing rule, but that would be provided when a new request for continued reexamination (RCR) practice is in effect.

DECISION

The record in the present '775 reexamination proceeding reveals that a request for *ex parte* reexamination of the '526 patent was filed on September 12, 2003. Reexamination was ordered for patent claims 1-11 (i.e., all of the patent claims), on November 7, 2003. The '775 reexamination proceeding has once been appealed to the Board of Patent Appeals and Interference (BPAI), where a decision was rendered on June 20, 2007. In that decision the BPAI affirmed a rejection of proposed new claims 12-22, reversed the rejection of patent claims 1-11, and entered a new ground of rejection of patent claims 1-11 pursuant to 37 CFR 41.50(b). Patent owner attempted to re-open prosecution after the BPAI decision, but submitted amendments that failed to comply with the regulations for properly formatting amended claims, and/or the regulations governing the re-opening of prosecution after entry of a new ground of rejection made in a BPAI decision. The prosecution of the '775 proceeding became technically terminated, and patent owner filed a petition to revive the terminated proceeding. On May 22, 2008, that petition was granted. Thereafter, prosecution resumed, resulting in a final rejection on July 2, 2008.

Patent owner filed a proposed claim amendment on August 28, 2008, to address the July 2, 2008 final rejection, but the examiner refused to enter the amendment for a number of reasons. Patent owner was found to have failed to comply with the requirements for entry of an amendment after final action established by 37 CFR 1.116(b), the procedure which, in accordance with 37 CFR 1.550(a), governs the requirements for entry of an amendment

submitted after final rejection in an *ex parte* reexamination proceeding. The August 28, 2008 amendment was refused entry pursuant to 37 CFR 1.116(b), and an advisory action so informing patent owner was mailed on September 18, 2008. On October 2, 2008, patent owner timely filed a Notice of Appeal from the final rejection. Patent owner did not file a petition under 37 CFR 1.181 seeking supervisory review of the examiner's decision not to enter the August 28, 2008 amendment. Instead, also on October 2, 2008, patent owner filed the present petition under 37 CFR 1.182, in which patent owner requests relief not provided for by the rules, in the form of what petitioner refers to as a Request for Continued Reexamination (RCR). If this relief were granted, it would mandate entry of the August 28, 2008 amendment as a matter of right, by re-designating the July 2, 2008 rejection as a non-final rejection.

The filing of a petition for relief in the form of an RCR is addressed in a Notice published at 1292 OG 20 (March 1, 2005). That Notice advised patent owners that, in appropriate circumstances, a patent owner in an *ex parte* reexamination in which an amendment after final rejection was refused entry, could file a petition under 37 CFR 1.181 seeking supervisory review of an examiner's refusal to enter the amendment after final rejection. The Notice also advised patent owner's that it could, instead, file a petition under 37 CFR 1.182 in an *ex parte* reexamination proceeding to obtain relief analogous to the relief that an applicant in certain nonprovisional patent applications might obtain by filing a Request for Continued Examination (RCE) under 35 U.S.C. § 132(b) and 37 CFR 1.114. It should be noted that an RCE is simply a request that an amendment after the close of prosecution (as, for example, an amendment after final rejection), be entered by removing the closure of prosecution, thus mandating entry of the amendment as a matter of right (because prosecution would no longer be closed). It should further be noted that 35 U.S.C. § 132(b) expressly limits RCE practice to nonprovisional applications, and accordingly, 37 CFR 1.114 expressly states the RCE practice is not permitted in reexamination proceedings.

A review of the present 37 CFR 1.182 petition shows that although patent owner requests relief in the form of an RCR, the petition is totally devoid of any rationale that would explain why petitioner patent owner is entitled to such relief. Instead, entry of the August 28, 2008 amendment is justified only by patent owner's statements that entry of that amendment will "put the present reexamination application in better condition for appeal," and that "[A]pplicants have made the amendments in order to advance prosecution to a conclusion." There is no explanation of <u>how</u> and <u>why</u> entry of the proposed amendment filed on August 28, 2008 would in any way place the '775 reexamination proceeding in better form for appeal or advance the '775 reexamination proceeding to a final disposition. Thus, the petition cannot be granted.

In addition, even a cursory review of the August 28, 2008 amendment and the examiner's September 18, 2008 advisory action explaining why the examiner refused to enter that amendment shows that the amendment would impede, rather than advance, final disposition of the '775 reexamination proceeding. The examiner has determined that the amendment is not enterable for failure to comply with the required amendment format in an *ex parte* reexamination proceeding. [3] Thus, entry of the August 28, 2008 amendment would delay the '775 reexamination proceeding by requiring that the Office mail yet another *Notice of Defective*

[3] It should be noted that on October 24, 2007, November 28, 2007 and March 31, 2008, patent owner was given notice by the mailing of papers entitled *Notice of Defective Paper in Ex Parte Reexamination* that an amendment filed by patent owner failed to comply with the formatting requirements in an *ex parte* reexamination proceeding.

Paper in Ex Parte Reexamination and again to await patent owner's response to that Notice. [4] Further, the examiner's September 18, 2008 advisory action also informed patent owner that the August 28, 2008 amendment would raise additional issues on appeal, and would not reduce or simplify the issues on appeal. If patent owner believed that the examiner had erred in these conclusions, patent owner could have filed a petition seeking supervisory review of the examiner's position, as permitted by 37 CFR 1.181. However, patent owner apparently has elected not to do so. Instead patent owner has filed the present 37 CFR 1.182 petition to request that it be permitted to obtain an RCR, thereby obtaining entry into the record of the August 28, 2008 amendment. Thus, the record remains such that the August 28, 2008 amendment does not provide a *bona fide* effort to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate, and is accordingly not consistent with the requirement of 35 U.S.C. § 305 to conduct reexamination proceedings "with special dispatch within the Office."

It is impossible to see how grant of an RCR based on amendment that has been refused entry as raising additional issues and being in an improper format will advance the '775 proceeding to a final conclusion, or place the '775 proceeding in better condition for appeal. Moreover, the cursory review of the August 28, 2008 amendment also shows that, in addition to the issues raised by the examiner in the September 18, 2008 advisory action, patent owner's amendment, if entered, proposes to amend claim 1 to "remove the adjective 'hook-and-loop type' from the claim in order to allegedly remedy the 'indefiniteness around the nature of the elastic material with which the stemlike projections are releasably engaged'" noted by the examiner in the July 2, 2008 final rejection. However, it is noted that the "hook-and-loop type" language appears as a positive limitation in independent claim 1 of the '526 patent, and therefore also is a positive limitation in each of dependent patent claims 2-11. Thus, petitioner patent owner's proposed amendment would, if entered, impermissibly broaden each of the pending amended versions of the original patent claims, in direct contravention to 35 U.S.C. § 305, which provides, *inter alia*, that "[N]o proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter."

For the foregoing reasons, it is clear that petitioner patent owner has failed to establish any basis for the grant of the relief requested in the present, because the record clearly shows that entry of the August 28, 2008 amendment into the record of the '775 proceeding will not materially advance the '775 proceeding to a conclusion, and will, instead, raise additional issues in the '775 proceeding that do not currently exist in that proceeding. Accordingly, there is no basis for delaying the '775 proceeding (contrary to the reexamination requirement of 35 U.S.C. § 305 for special dispatch) by admitting the August 28, 2008 into the record, and thereby necessitating yet another rejection prior to the appeal going forward.

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[4] It should also be noted that although patent owner was advised by the examiner on September 18, 2008 that the amendment filed on August 28, 2008 was non-compliant with those formatting requirements, patent owner has not taken steps to correct that deficiency.

CONCLUSION

1. The petition pursuant to 37 CFR § 1.182 is denied.

2. Jurisdiction of the '775 reexamination proceeding is being returned to the Central Reexamination Unit to await action by patent owner.

3. This decision is designated as a final agency action under 5 U.S.C. § 704.

4. Telephone inquiries related to this decision should be directed to Senior Legal Advisor Stephen Marcus 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

July 21, 2008
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REEXAM UNIT

In re Reissue Application of SCA Hygiene Products AB Application No.: 10/875,090 Filed: June 24, 2004 For: U.S. Patent No. 5,855,574	DECISION, *SUA SPONTE*, TO MERGE REISSUE AND REEXAMINATION PROCEEDINGS
In re SCA Hygiene Products AB Reexamination Proceeding Control No.: 90/006,782 Filed: September 24, 2003 For: U.S. Patent No.: 5,855,574	

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. 5,855,574 (the '574 patent) issued on January 5, 1999.
2. A request for reexamination, assigned control No. 90/006,782 (the '782 reexamination proceeding), was filed by patent owner on September 24, 2003.
3. Reexamination was ordered for the '782 reexamination proceeding on November 13, 2003.
4. A non-final Office action was mailed in the '782 reexamination proceeding on April 8, 2004.
5. An application for reissue, assigned application No. 10/626,486 (the '090 application), was filed by the patent owner on June 24, 2004.
6. A response to the non-final Office action in the '782 reexamination proceeding was received from the patent owner on July 6, 2004.
7. Notice of the filing of the reissue application was published in the *Official Gazette* on August 8, 2004.
8. A second non-final Office action was mailed in the '782 reexamination proceeding on October 10, 2004.
9. A response to the second non-final Office action in the '782 reexamination proceeding was received from the patent owner on December 8, 2004.

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. 10/875,090 and reexamination control No. 90/006,782 are currently pending. Since the order to reexamine has been mailed in the reexamination proceeding, a decision under 37 CFR 1.565(d) is timely.

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

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

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

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

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

II. The Same Claims Must Be Maintained in Both Proceedings

1. A review of the reexamination file and the reissue application shows that both contain original patent claims 1-4 and 6-17; patent claim 5 as amended, and new claim 18 added by amendment. The claims are identical in both number and text in both proceedings.

2. The patent owner is required to maintain the claims in the reexamination proceeding and reissue application as identical in both number and text while the two remain merged. See 37 CFR 1.565(d). Accordingly, any amendments filed while the proceedings remain merged must be identical.

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

1. Upon receipt of the merged proceeding, the examiner should promptly prepare an Office action.

2. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 USC § 305 relating to the conduct of reexamination

proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue-application examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. However, periods of response should be set at TWO (2) months to comply with the statutory requirement for special dispatch in *ex parte* reexamination (35 USC § 305).

3. Each Office action issued by the examiner will take the form of a single action which jointly applies to both the reissue application and the reexamination proceeding. Each action will contain identifying data for both of the cases, i.e, the reissue application and the reexamination proceeding, and each action will be physically entered into both files (which will be maintained as separate files).

4. 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.

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

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

6. 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.

7. 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.

8. 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.

9. 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).

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

CONCLUSION

1. Reissue application No. 10/875,090 and reexamination control No. 90/006,782 **ARE MERGED** into a single consolidated proceeding. A copy of this merger decision will be made of record in both of the files.

2. The reissue and reexamination files for the merged proceeding are being forwarded to the examiner via the Director of Technology Center 3700 for the preparation of an Office action, to be issued in due course.

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

4. 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

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July 20, 2005

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(For Patent Owner)

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REEXAM UNIT

In re D'Andrea et al. Reexamination Proceeding Control No. 90/006,783 Filed: September 25, 2003 For: U.S. Patent No. 5,395,366	: : : : : : :	**DECISION GRANTING PETITION**

This is a decision on the September 29, 2004, patent owner petition for entry of belated papers filed under 37 C.F.R. § 1.137(b), based upon unintentional delay. The petition is before the Office of Patent Legal Administration for decision.

The petition fee of $665.00 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 4 of the instant petition.

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

DECISION

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

(1) the required reply, unless previously filed;

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

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

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

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

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

The petition fee was paid, and was accompanied by 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 3700 for the examiner's immediate consideration of the response to the nonfinal Office action of July 7, 2004.

3. Any inquiries with regard to the merits of this proceeding should be directed to Examiner Jennifer Maynard, of Group Art Unit 3763.

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

January 4, 2005

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,784	09/24/2003	6199925	20045-68	8226

7590 01/13/2006

Bruce A. Jagger
Brunton & Jagger
P. O. Box 29000
Glendale, CA 91209

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/13/2006

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1/13/06

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

CLIFFORD A. POFF

9800B MCKNIGHT ROAD

SUITE 115

PITTSBURGH, PA 15237

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/006784

PATENT NO. 6,199,925

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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Bruce A. Jagger
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6100 Center Drive, Suite 630
Los Angeles, CA 90045

(For Patent Owner)

MAILED
JAN 13 2006
REEXAM UNIT

Clifford A. Poff
9800B McKnight Road
Suite 115
Pittsburgh, PA 15237

(For Requester)

In re Tony Alba
Reexamination Proceeding
Control No.: 90/006,784
Filed: September 24, 2003
For: U.S. Patent No.: 6,199,925

: DECISION ON PETITION
: TO CONTINUE
: *EX PARTE*
: REEXAMINATION
: PROCEEDINGS

This is a decision on the December 1, 2005 patent owner petition titled PETITION TO THE DIRECTOR FOR QUESTIONS NOT SPECIFICALLY PROVIDED FOR, UNDER 37 C.F.R. § 1.182.

The petition is before the Office of Patent Legal Administration.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182 has been charged to petitioner's Deposit Account No. 18-2011, in accordance with petitioner's authorization on page 1 of the instant petition.

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

REVIEW OF FACTS

1) U.S. Patent No. 6,199,925 (the '925 patent) issued on March 13, 2001.

2) The present request for reexamination, assigned control No. 90/006,784, was filed by a third party requester on September 24, 2003.

3) Reexamination was ordered for the '6784 reexamination proceeding on December 12, 2003.

4) A patent owner's statement under 37 CFR 1.530 was not received in the '6784 reexamination proceeding.

5) A non-final Office action was mailed in the '6784 reexamination proceeding on April 29, 2005.

6) A response from the patent owner to the non-final Office action was received in the Office on June 29, 2005.

7) A final Office action was mailed on July 25, 2005.

8) A first response (Amendment After Final Action) from the patent owner to the final Office action was received in the Office on September 26, 2005.

9) An interview between the patent owner and the examiner was held on October 12, 2005.

10) A second response (Supplemental Response) from the patent owner to the final Office action was received in the Office on October 24, 2005.

11) An advisory Office action, in which the examiner extended the period for response to the final Office action to January 25, 2006, the full six months permitted by law, was mailed on November 1, 2005.

12) The present petition under 37 C.F.R. 1.182 for continued reexamination was received in the Office on December 1, 2005.

DECISION

In the present petition, it is requested that the Office continue the prosecution of the instant reexamination proceeding to provide consideration of the Amendment After Final Action received in the Office on September 26, 2005, and the Supplemental Response received in the Office on October 24, 2005.

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending"[1]. Notice was provided therein that a second (or subsequent) reexamination will no longer be ordered on the basis of a "substantial new question of patentability" (SNQ) that is the same as a SNQ raised in an earlier pending reexamination. The Notice stated that:

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

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

parte reexamination proceeding or after an action closing prosecution in an inter partes reexamination proceeding.

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

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

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

The patent owner's petition notes that an after-final amendment that furthers the prosecution of the reexamination proceeding rather than delaying it has been submitted in the instant proceeding. The petitioner states, "the Examiner issued an Advisory Action indicating that the Amendment after Final would not be entered for raising new issues." The Examiner's decision was based on a conclusion that new issues requiring further consideration and/or search were raised by the proposed changes to claims and the newly presented declarations. In particular, the Examiner stated, "the patent owner proposes to add new structural limitations in claims 1, 8, and 11 (in combination with other structural limitations) that would require further search and reconsideration of the prior art of record." Advisory Action at p. 3. This action by the examiner is taken as evidence of a *bona fide* effort by the patent owner to advance the prosecution.

In view of the above and the fact situation presented by the record, the petition is granted, and the prosecution in the above-noted reexamination proceeding is hereby continued. The finality of the July 25, 2005, Office action is withdrawn, and the prosecution is reopened for consideration of the Amendment After Final Action received September 26, 2005, and the Supplemental Response received October 24, 2005. These responses to the final Office action will be entered in the reexamination proceeding, and the proceeding will be forwarded to the examiner for action consistent with this Decision. The examiner will consider the Amendment After Final Action and

the Supplemental Response, and then issue an Office action treating these papers as a response and a supplemental response, respectively, received after a first Office action.

CONCLUSION

1) The petition under 37 CFR 1.182 is granted.

2) The prosecution of the present '6784 reexamination proceeding is continued. No further continuation of the present reexamination proceeding will be granted under 37 CFR 1.182.

3) The finality of the July 25, 2005, Office action is withdrawn, and prosecution of the proceeding is reopened.

4) The Amendment After Final Action received September 26, 2005, and the Supplemental Response received October 24, 2005, will be entered by the Technology Center, and then considered by the examiner. These papers will be addressed and treated as a response and a supplemental response, respectively, received after a first Office action

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

6) Telephone inquiries related to this decision should be directed to Brian E. Hanlon, Legal Advisor, at (571) 272-5047, or in his absence, the undersigned at (571) 272-7710.

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

January 11, 2006

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Serial Number	Filing Date	First Named Applicant
10/918,833	08/12/04	Dalen M. Abraham
Attorney Docket Number	Patent Number	Date of This Notice
	5,983,270	04/18/05

NOTICE OF MERGED REEXAM - REISSUE PROCEEDING

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

Control No. __90/006,787_____ Filing Date: ___10/14/03_____

Requester: ____Russell M. Jeide_____

____KNOBE MARTENS OLSON & BEAR LLP_____

____2040 Main Street_____

____Fourteenth Floor_____

____Irvine, CA 92614_____

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

REEXAMINATION RESULTS

The questions raised in reexamination request no. _90/006,787, filed 10/14/03, 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), for *ex parte* reexaminations, or the reexamination certificate required by 35 U. S. C. 316 as provided in 37 CFR 1.997(e) for *inter partes* reexaminations.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,787	10/14/2003	5983270	WEBSEN.033FRX	6735

20995 7590 04/18/2005

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EXAMINER

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Paper No.__

Russell M. Jeide
Knobbe Martens Olson & Bear LLP
2040 Main Street
Fourteenth Floor
Irvine, CA 92614

(For Patent Owner)

In re Reissue Application of Dalen M. Abraham, et al. Application No. 10/918,833 Filed: August 12, 2004 For: U.S. Patent No. 5,983,270	DECISION, *SUA SPONTE*, TO MERGE REISSUE AND REEXAMINATION PROCEEDINGS
In re Dalen M. Abraham, et al. Reexamination Proceeding Control No. 90/006,787 Filed: October 14, 2003 For: U.S. Patent No. 5,983,270	

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

REVIEW OF FACTS

1. U.S. Patent No. 5,983,270 issued on November 9, 1999, with 72 claims.

2. A request for reexamination was filed by the patent owner on October 14, 2003, and was assigned control No. 90/006,787 (hereinafter, the '6787 proceeding).

3. Reexamination was ordered for the '6787 reexamination proceeding on December 16, 2003.

4. An application for reissue, assigned application No. 10/918,833, was filed by the patent owner on August 12, 2004.

5. A patent owner's statement under 37 CFR 1.530 was received on February 17, 2004, in the '6787 proceeding.

6. On April 15, 2004, a non-final Office action was mailed in the '6787 proceeding.

7. After obtaining an extension of time, the patent owner responded to the non-final Office action by filing an amendment on August 16, 2004.

8. Notice of the filing of the reissue application was published in the *Official Gazette* on October 5, 2004.

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. 10/918,833 and reexamination control No. 90/006,787 are currently pending. Since the order to reexamine has been mailed in the reexamination proceeding, a decision under 37 CFR 1.565(d) is timely.

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

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

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

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

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

II. Requirement for Same Amendments in Both Proceedings

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

2. A review of the file for reexamination control No. 90/006,787 shows the presence of the following live claims: Original patent claims 1-72, new claims 73 and 80-87 which were added in the patent owner's statement of February 17, 2004, and new claims 88-98, which were added in the patent owner's amendment of August 16, 2004. [1] A review of reissue application No. 10/918,833 shows that original patent claims 1-72 are present. [2] **Accordingly, the claims are not identical in both proceedings.**

---

[1] Claims 75-79, which had been added in the patent owner's statement of February 17, 2004 have been cancelled in patent owner's amendment of August 16, 2004.

[2] It is noted that in the 10/918,833 reissue application declaration filed by the assignee on August 12, 2004, reference is made to new claims 73-97 which "have been added in the reissue application." However, no evidence of the presence of these claims is found in the 10/918,833 file, and in fact, applicant's reissue transmittal letter, filed August 12, 2004, indicates that the number of claims filed and paid for in the reissue application is the same as that in the patent, 72 claims.

An appropriate housekeeping amendment is required within <u>ONE (1) MONTH</u> of this decision placing the same amendments in both cases, specifically, Application No. 10/918,833 and Control Number 90/006,787. The response to this requirement must be limited to formally placing the same amendments in all cases, and patent owner must **not** address any issue of patentability in the housekeeping amendment. It is to be noted that, pursuant to MPEP 2285, amendments in a merged proceeding are submitted under 37 CFR 1.173, in accordance with reissue practice.

III. <u>Conduct of the Merged Reissue Application Examination and Reexamination Proceedings</u>

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

2. In the event that a housekeeping amendment is not timely submitted, any claim which does not contain identical text in both proceedings should be rejected under 35 U.S.C. 112, paragraph 2, as being indefinite as to the content of the claims, and thus failing to particularly point out the invention.

3. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. 305 relating to the conduct of *ex parte* reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue-application examination. The examiner will apply the <u>reissue</u> statute, rules, and case law to the merged proceeding. **However, periods for response should be set at TWO (2) months in order to comply with the statutory requirement for special dispatch in an *ex parte* reexamination proceeding (35 U.S.C. 305).**

4. Each Office action issued by the examiner will take the form of a *single action* which jointly applies to the reissue application and the reexamination proceeding. Each action will contain identifying data *for both of the cases*, i.e, the reissue application and the reexamination proceeding, and each action will be entered into both files (which will be maintained as separate files).

5. Any response by the applicant/patent owner must consist of a single response, with two copies being filed for entry in the two files, with each of the two bearing a signature.

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 a reissue application. Accordingly, clean copies of the amended claims, and presentation of all the claims in an amendment (e.g., original unamended claims), are not required, ***and are not to be submitted.*** Instead, pursuant to 37 CFR 1.173(b)(2), amendments are to be presented via markings pursuant to 37 CFR 1.173(d), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.173(g), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the reissue application. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets. It is noted that the amendments in the reexamination proceeding that were presented in the patent owner's amendment of August 16, 2004, to claims 73, 80, 81, and 87 have not been entered, as they were not made relative to the patent claims which were in effect as of the date of filing the request for reexamination. 37 CFR 1.530(i).

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

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

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

10. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be dissolved. The reissue application will be held abandoned. The reexamination prosecution will be terminated and a reexamination certificate under 37 CFR 1.570 will be issued in accordance with the last action of the Office, unless further action in the reexamination proceeding is needed as a result of the difference in the rules relating to reexamination and reissue proceedings. If further action in the reexamination proceeding is needed, any grounds of rejection which are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner, upon dissolution of the merged proceeding. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 CFR 1.552(c).

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

CONCLUSION

1. Reissue application No. 10/918,833 and reexamination control No. 90/006,787 **are merged** into a single proceeding.

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

3. The reissue and reexamination proceedings are being forwarded to the examiner via the Director of Technology Center 2100. Upon receipt of same, the examiner **should not issue an Office action for the present merged proceeding of the reissue and reexamination proceedings until after the earlier of** (a) the submission of the housekeeping amendment to place the same amendments in both cases or (b) the expiration of the ONE MONTH period from the mailing of this decision for filing the amendment.

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 Elizabeth L. Dougherty, Senior Legal Advisor, at (571) 272-7733.

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

April 18, 2005
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,787	10/14/2003	5983270	WEBSEN.033FRX	6735

20995 7590 04/18/2005

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Paper No.__

Russell M. Jeide
Knobbe Martens Olson & Bear LLP
2040 Main Street
Fourteenth Floor
Irvine, CA 92614

(For Patent Owner)

In re Reissue Application of Dalen M. Abraham, et al. Application No. 10/918,833 Filed: August 12, 2004 For: U.S. Patent No. 5,983,270 In re Dalen M. Abraham, et al. Reexamination Proceeding Control No. 90/006,787 Filed: October 14, 2003 For: U.S. Patent No. 5,983,270	DECISION, *SUA SPONTE*, TO MERGE REISSUE AND REEXAMINATION PROCEEDINGS

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

REVIEW OF FACTS

1. U.S. Patent No. 5,983,270 issued on November 9, 1999, with 72 claims.

2. A request for reexamination was filed by the patent owner on October 14, 2003, and was assigned control No. 90/006,787 (hereinafter, the '6787 proceeding).

3. Reexamination was ordered for the '6787 reexamination proceeding on December 16, 2003.

4. An application for reissue, assigned application No. 10/918,833, was filed by the patent owner on August 12, 2004.

5. A patent owner's statement under 37 CFR 1.530 was received on February 17, 2004, in the '6787 proceeding.

6. On April 15, 2004, a non-final Office action was mailed in the '6787 proceeding.

7. After obtaining an extension of time, the patent owner responded to the non-final Office action by filing an amendment on August 16, 2004.

8. Notice of the filing of the reissue application was published in the *Official Gazette* on October 5, 2004.

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. 10/918,833 and reexamination control No. 90/006,787 are currently pending. Since the order to reexamine has been mailed in the reexamination proceeding, a decision under 37 CFR 1.565(d) is timely.

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

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

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

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

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

II. Requirement for Same Amendments in Both Proceedings

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

2. A review of the file for reexamination control No. 90/006,787 shows the presence of the following live claims: Original patent claims 1-72, new claims 73 and 80-87 which were added in the patent owner's statement of February 17, 2004, and new claims 88-98, which were added in the patent owner's amendment of August 16, 2004. [1] A review of reissue application No. 10/918,833 shows that original patent claims 1-72 are present. [2] **Accordingly, the claims are not identical in both proceedings.**

---

[1] Claims 75-79, which had been added in the patent owner's statement of February 17, 2004 have been cancelled in patent owner's amendment of August 16, 2004.

[2] It is noted that in the 10/918,833 reissue application declaration filed by the assignee on August 12, 2004, reference is made to new claims 73-97 which "have been added in the reissue application." However, no evidence of the presence of these claims is found in the 10/918,833 file, and in fact, applicant's reissue transmittal letter, filed August 12, 2004, indicates that the number of claims filed and paid for in the reissue application is the same as that in the patent, 72 claims.

An appropriate housekeeping amendment is required within <u>ONE (1) MONTH</u> of this decision placing the same amendments in both cases, specifically, Application No. 10/918,833 and Control Number 90/006,787. The response to this requirement must be limited to formally placing the same amendments in all cases, and patent owner must **not** address any issue of patentability in the housekeeping amendment. It is to be noted that, pursuant to MPEP 2285, amendments in a merged proceeding are submitted under 37 CFR 1.173, in accordance with reissue practice.

III. <u>Conduct of the Merged Reissue Application Examination and Reexamination Proceedings</u>

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

2. In the event that a housekeeping amendment is not timely submitted, any claim which does not contain identical text in both proceedings should be rejected under 35 U.S.C. 112, paragraph 2, as being indefinite as to the content of the claims, and thus failing to particularly point out the invention.

3. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. 305 relating to the conduct of *ex parte* reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue-application examination. The examiner will apply the <u>reissue</u> statute, rules, and case law to the merged proceeding. **However, periods for response should be set at TWO (2) months in order to comply with the statutory requirement for special dispatch in an *ex parte* reexamination proceeding (35 U.S.C. 305).**

4. Each Office action issued by the examiner will take the form of a *single action* which jointly applies to the reissue application and the reexamination proceeding. Each action will contain identifying data *for both of the cases*, i.e, the reissue application and the reexamination proceeding, and each action will be entered into both files (which will be maintained as separate files).

5. Any response by the applicant/patent owner must consist of a single response, with two copies being filed for entry in the two files, with each of the two bearing a signature.

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 a reissue application. Accordingly, clean copies of the amended claims, and presentation of all the claims in an amendment (e.g., original unamended claims), are not required, ***and are not to be submitted.*** Instead, pursuant to 37 CFR 1.173(b)(2), amendments are to be presented via markings pursuant to 37 CFR 1.173(d), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.173(g), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the reissue application. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets. It is noted that the amendments in the reexamination proceeding that were presented in the patent owner's amendment of August 16, 2004, to claims 73, 80, 81, and 87 have not been entered, as they were not made relative to the patent claims which were in effect as of the date of filing the request for reexamination. 37 CFR 1.530(i).

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

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

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

10. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be dissolved. The reissue application will be held abandoned. The reexamination prosecution will be terminated and a reexamination certificate under 37 CFR 1.570 will be issued in accordance with the last action of the Office, unless further action in the reexamination proceeding is needed as a result of the difference in the rules relating to reexamination and reissue proceedings. If further action in the reexamination proceeding is needed, any grounds of rejection which are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner, upon dissolution of the merged proceeding. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 CFR 1.552(c).

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

CONCLUSION

1. Reissue application No. 10/918,833 and reexamination control No. 90/006,787 **are merged** into a single proceeding.

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

3. The reissue and reexamination proceedings are being forwarded to the examiner via the Director of Technology Center 2100. Upon receipt of same, the examiner **should not issue an Office action for the present merged proceeding of the reissue and reexamination proceedings until after the earlier of** (a) the submission of the housekeeping amendment to place the same amendments in both cases or (b) the expiration of the ONE MONTH period from the mailing of this decision for filing the amendment.

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 Elizabeth L. Dougherty, Senior Legal Advisor, at (571) 272-7733.

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

April 18, 2005
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UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,789	10/14/2003	4918645	QNTA.001XX0	8644

33694 7590 04/05/2005

SIDLEY AUSTIN BROWN & WOOD LLP
1501 K STREET, N.W.
WASHINGTON, DC 20005

EXAMINER
Bragdon, Reginald

ART UNIT	PAPER NUMBER
2188	

DATE MAILED: 04/05/2005

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.
90/006,789 90/007,420	10/14/2003	4918645	QNTA.001XX0

EXAMINER
Bragdon, Reginald

ART UNIT	PAPER
2188	

DATE MAILED: 04/05/2005

James H. Hsue
PARSONS HSUE & DERUNTZ, LLP
655 Montgomery Street, Suite 1800
San Francisco, California 94111

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

Commissioner of Patents and Trademarks

CC: SIDLEY AUSTIN BROWN & WOOD LLP
1501 K. Street, N.W.
Washington, DC 20005

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

Richard Wilder Sidley Austin Brown & Wood, LLP 1501 K Street, NW Washington, DC 20005	))))	**FOR PATENT OWNER**
James H. Hsue Parsons Hsue & DeRuntz, LLP 655 Montgomery Street, Suite 1800 San Francisco, California 94111	))))	**FOR THIRD PARTY REQUESTER**
In re Brian E. J. Lagoy Reexamination Proceeding Control No. 90/006,789 Filed: October 14, 2003 For: U.S. Patent No. 4,918,645	)))))	**DECISION *SUA SPONTE*, MERGING REEXAMINATION PROCEEDINGS**
In re Brian E. J. Lagoy Reexamination Proceeding Control No. 90/007,420 Filed: February 14, 2005 For: U.S. Patent No. 4,918,645	)))))	

The above noted reexamination proceedings are before the Director of Technology Center 2100 for consideration of merger of the proceedings under 37 CFR § 1.565(c).

BACKGROUND

1. Patent No. 4,918,645 issued on April 17, 1990.

'6789 Proceeding

2. A first request for reexamination, Control No. 90/006,789 ('6,789 was filed by the Third Party Requester on October 14, 2003.

3. Reexamination was ordered in the '6789 reexamination proceeding on December 8, 2003.

4. A Notification of concurrent proceedings under 37 CFR §1.565 was filed by Requestor on February 27, 2004.

5. A revocation and appointment of attorneys was filed on February 27, 2004.

6. A first Office action was mailed on May 5, 2004.

7. An Interview was held on June 16, 2004 and an Interview Summary was mailed on that date recording the substance of that interview.

8. A change of Address for third party requestor was filed on June 21, 2004.

9. Applicant filed a Response to the Office action on June 30, 2004. The response includes Remarks, Patent Owner's Statement of substance of the Interview (of June 16), an Information Disclosure Statement, and a notification of concurrent proceedings under 37 CFR §1.565.

10. A Notification of concurrent proceedings under 37 CFR §1.565 was filed by Requestor on August 2, 2004.

11. A Final Office action was mailed on September 22, 2004.

12. An Interview was held on October 12, 2004 and an Interview Summary was mailed on October 30 recording the substance of that interview.

13. Applicant filed a Response to the Office action on November 5, 2004. The response includes Remarks, Patent Owner's Statement of substance of the Interview (of October 12), and a notification of concurrent proceedings under 37 CFR §1.565.

14. An advisory action was mailed November 30, 2004.

15. A Letter returning non-compliant papers (submitted December 8, 2004) was mailed on December 20, 2004.

16. A Notice of Appeal was filed on December 20, 2004.

17. An Information Disclosure Statement was filed December 30, 2004.

18. A Revocation and appointment of attorneys was filed on January 25, 2005.

19. A Petition under 37 §CFR 1.550(c) for an Extension of Time to file the Appeal Brief was filed February 16, 2005.

20. A Decision granting Patent Owner until March 22, 2005 to file an Appeal Brief was mailed February 18, 2005.

21. A Second Petition under 37 §CFR 1.550(c) for an Extension of Time to file the Appeal Brief was filed March 15, 2005.

22. A Decision granting Patent Owner until May 2, 2005 to file an Appeal Brief was mailed March 17, 2005.

23. A Revocation and appointment of attorneys was filed on March 25, 2005.

'7420 Proceeding

24. A second request for reexamination, Control No. 90/007,420 ('7420) was filed by Third Party Requester on February 14, 2005.

25. Reexamination was ordered in the '7420 reexamination proceeding on March 21, 2005.

26. A Letter informing the Office that Patent Owner will not be filing a Statement under 37 CFR 1.530 was filed on March 25, 2005.

27. A Revocation and appointment of attorneys was filed on March 25, 2005.

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 '7007 and '7371 reexamination proceedings are merged.

The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in all Proceedings

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

III. Conduct of Merged Proceeding

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

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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO..	CONFIRMATION NO.
90/006,789	10/14/2003	4918645	QNTA.001XX0	8644

33694 7590 02/12/2008

SIDLEY AUSTIN LLP
ATTN: DC PATENT DOCKETING
1501 K STREET, N.W.
WASHINGTON, DC 20005

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/12/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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SIDLEY AUSTIN LLP
ATTN: DC PATENT DOCKETING
1501 K STREET, N.W.
WASHINGTON DC 20005

(For Patent Owner)

MAILED

FEB 12 2008

CENTRAL REEXAMINATION UNIT

HSUE, JAMES
Davis Wright Tremaine, LLP
505 Montgomery Street
Suite 800
San Francisco, CA 94111

(For Third Party Requestor)

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

In re: Lagoy, Jr.
Reexamination Proceeding
Control No. 90/006,789
Deposited: 14 October 2003
For U.S. Patent No. 4,918,645

In re: Lagoy, Jr.
Reexamination Proceeding
Control No. 90/007,420
Deposited: 14 February 2005
For U.S. Patent No. 4,918,645

In re: Lagoy, Jr.
Reexamination Proceeding
Control No. 90/008,391
Deposited: 26 February 2007
For U.S. Patent No. 4,918,645

The above-identified reexamination files are before the Director of the Central Reexam Unit, for consideration of merger of reexamination control number 90/008,391 and the reexamination control number 90/007,420 previously merged with 90/006,789 pursuant to 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 4,918,645 issued on 17 April 1990.

2. The 90/006,789 reexamination proceeding was deposited on 14 October 2003 by a third party requester.

3. The 90/007,420 proceeding Order was deposited on 14 February 2005 by a third party requester.

4. The 90/006,678 and the 90/007,420 proceedings were merged on 5 April 2005.

5. Claim 2, 6, 13 and 17 were amended on 27 May 2005 in the merged proceedings, control number 90/006,789 and 90/007,420.

6. On 28 September 2006 the Board of Appeals and Interferences rendered a decision on the claims. Claims 1, 6, 12, and 17 were revered under the examiner's rejection and new grounds for rejection provided by the Board. The Merged proceedings were remanded to the examiner for further action on the new grounds for rejection.

7. The 90/008,391 reexamination proceeding was deposited on 26 February 2007 by a third party requester.

8. The 90/008,391 proceeding Order granting reexamination was mailed on 27 April 2007.

9. There are no amendments to the 90/008,319 proceeding at this time.

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 90/006,789; 90/007,420 and 90/008,391 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the 90/006,789; 90/007,420 and 90/008,391 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 90/006,789 and 90/007,420 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.

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. 90/006,789; 90/007,420 and 90/008,391 are **merged**.

2. Patent owner has **one-month** from the date of this decision to submit an appropriate "housekeeping" amendment.

3. Upon receipt of the "housekeeping" amendment, an Office action will be issued in due course.

4. 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
SPE ~~SPRE~~ AU 3992
CENTRAL REEXAMINATION UNIT

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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,789	10/14/2003	4918645	24286-40160	8644

33694 7590 02/13/2009

SIDLEY AUSTIN LLP
ATTN: DC PATENT DOCKETING
1501 K STREET, N.W.
WASHINGTON, DC 20005

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/13/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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.
90/007,420	02/14/2005	4918645	24286-40161	2031

33694 7590 02/13/2009

SIDLEY AUSTIN LLP
ATTN: DC PATENT DOCKETING
1501 K STREET, N.W.
WASHINGTON, DC 20005

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/13/2009

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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,391	02/26/2007	4918645	24286-40162	6097

33694 7590 02/13/2009

SIDLEY AUSTIN LLP
ATTN: DC PATENT DOCKETING
1501 K STREET, N.W.
WASHINGTON, DC 20005

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/13/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

SIDLEY AUSTIN LLP
ATTN: DC PATENT DOCKETING
1501 K STREET, N.W.
WASHINGTON DC 20005

(Patent Owner)

JAMES S. HSUE
PARSONS HSUE & DE RUNTZ LLP
595 MARKET STREET
SUITE 1900
SAN FRANCISCO, CA 94105

(Third Party Requester)

MAILED

FEB 13 2009

CENTRAL REEXAMINATION UNIT

In re Lagoy, Jr. et al.
Reexamination Proceeding
Control No.: 90/006,789
Filed: October 14, 2003
For: U.S. Patent No.: 4,918,645

In re Lagoy, Jr. et al.
Reexamination Proceeding
Control No.: 90/007,420
Filed: February 14, 2005
For: U.S. Patent No.: 4,918,645

In re Lagoy, Jr. et al.
Reexamination Proceeding
Control No.: 90/008,391
Filed: December 26, 2006
For: U.S. Patent No.: 4,918,645

DECISION ON PETITION UNDER 37 CFR 1.182

This is a decision on the December 12, 2008 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.

The patent owner IDS submission filed on December 12, 2008 is improper and is being EXPUNGED from the record.

BACKGROUND

1. Patent number 4,918,645 (the '645 patent) issued on April 17, 1990.
2. Reexamination Control Numbers 90/006,789, 90/007,420, and 90/008,391, addressed to the '645 patent, were merged on February 12, 2008.
3. A Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the merged '6789/'7420/'8931 proceeding on May 27, 2008.
4. On June 6, 2008, the '6789/'7420/8931 proceeding was forwarded to the Office of Publications.
5. The instant petition was filed on December 12, 2008, accompanied by an IDS that the patent owner requests the Office to consider.
6. 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.)

37 CFR 1.4(c) states:

Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

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.

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.

37 CFR l.565(a) provides:

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 2254 provides, (in part):

Once *ex parte* reexamination is ordered pursuant to 35 U.S.C. 304 and the times for submitting any responses to the order have expired, no further active participation by a third party reexamination requester is allowed, and no third party submissions will be acknowledged or considered unless they are in accordance with 37 CFR 1.510. The reexamination proceedings will be ex parte, even if ordered based on a request filed by a third party, because this was the intention of the legislation. *Ex parte* proceedings preclude the introduction of arguments and issues by the third party requester which are not within the intent of 35 U.S.C. 305 ("reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title").

The patent owner may not file papers on behalf of the requester and thereby circumvent the intent of the ex parte reexamination legislation and the rules. The Court of Appeals for the Federal Circuit held in *Emerson Elec. Co. v. Davoil*, Inc., 88 F.3d 1051, 39 USPQ2d 1474 (Fed. Cir. 1996) that a federal district court does not have the authority to order a patent owner to file papers prepared by a third party in addition to the patent owner's own submission in a patent reexamination proceeding. Such papers prepared by the third party and filed by the patent owner will not be entered, and the entire submission will be returned to the patent owner as an inappropriate response. See MPEP §§ 2266 and 2267. (Emphasis added)

MPEP 2256 provides, (in part):

. . . 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)

MPEP § 2282 provides:

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 entered into 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 entry into 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. Such decisions include final court decisions (even if the decision is still appealable), decisions to vacate, decisions to remand, and decisions as to the merits of the patent claims. Non-merit decisions on motions such as for a new venue, a new trial/discovery date, or sanctions will not be entered into the patent file, and will be expunged from the patent file by closing the appropriate paper if they were entered before discovery of their nature. **Further, papers filed in the court from litigations or other proceedings involving the patent will not be entered into the record (and will be expunged if already entered) if they provide a party's arguments**, such as a memorandum in support of summary judgment. If the argument has an entry right in the reexamination proceeding, it must be submitted via the vehicle (provision(s) of the rules) that provides for that entry right. It is not required nor is it permitted that parties submit copies of copending reexamination proceedings and applications (which copies can be mistaken for a new request/filing); rather, submitters may provide a notice identifying the application/proceeding number and its status. **Any submission that is not permitted entry will be returned, expunged, or discarded, at the sole discretion of the Office.** It is to he noted that if the Office, in its sole discretion, deems the volume of the papers filed from litigations or other proceedings to be too extensive/lengthy, the Office may return all or part of the submission. In such an instance, a party may limit the submission in accordance with what is deemed relevant, and resubmit the papers. **Persons making such submissions must limit the submissions to the notification, and must not include further arguments or information. Where a submission is not limited to bare notice of the prior or concurrent proceedings (in which a patent undergoing reexamination is or was involved), the submission will be returned by the Office.** It is to be understood that highlighting of certain text by underlining, fluorescent marker, etc., goes beyond bare notice of the prior or concurrent proceedings. (Emphasis added.)

DECISION

I. MPEP 2254 & 2282 SUBMISSION OF THIRD PARTY ARGUMENTS

The December 12, 2008 submission styled as an IDS submission is improper, because a review of the submissions reveals that the patent owner is submitting court documents, containing third party arguments, with patent owner commentary on the documents, which constitutes impermissible "notification" of concurrent proceedings. The submissions are improper under 37 CFR 1.565(a) and MPEP 2282 because (1) the patent owner has gone beyond the bare notice requirement for notification of concurrent proceedings in accordance with MPEP 2282 and (2) the third party documents contain impermissible third party arguments in support of the third party's legal defense to patent owner's legal claim they infringed the patent. Therefore, the submission is an improper submission of notification of concurrent proceedings and its inclusion on the record would violate the statutory preclusion of third party participation in an *ex parte*

reexamination proceeding. A submission can only be permitted on the record if there is a vehicle by which the documents have a right of entry.

To safeguard the statutory preclusion of third party participation in accordance with 35 U.S.C. 305, MPEP 2254 provides materials that are prepared by a third party cannot obtain entry by way of the patent owner submitting them. Accordingly, the December 12, 2008 IDS submission lacks an entry right in the present reexamination proceeding, because patent owner is submitting arguments made by a third party that do not have any right of entry. While the December 12, 2008 IDS submission was filed by the patent owner, patent owner's petitions merely points to the fact that the papers were from third party in related proceedings regarding the relevancy of the materials/documents, which do not have an entry right as an IDS submission, nor as a notification of concurrent proceedings as outlined above.[1] These materials contain third party arguments that go to the merits of the proceeding and provide unauthorized third party participation in the proceeding. See patent owner's petitions under 37 CFR 1.182 requesting entry of IDS after NIRC, documents cited in the December 12, 2008 submission in Attachments A, B, and C. The assertions made in these cited papers are, as noted above, not prior art patents or printed publications, they are directed to the merits of the reexamination proceeding, as they are commenting on the patentability of claims subject to the instant reexamination in light of prior art patents and printed publications. The assertions are clearly sourced from a third party or parties who do not have a right to comment on the merits in the present *ex parte* proceeding; having their opinions, arguments and assertions considered on the record by the examiner would be contrary the reexamination rules and the statute.

Even if patent owner's submissions are treated as a petition to waive 37 CFR 1.565(a), the provisions of this rule cannot be waived, because there is no authority in the statute providing for submission of a third party paper directed to the issues of the reexamination proceeding during the examination-prosecution stage of an *ex parte* reexamination proceeding. *In re Amp*, 212 USPQ 826 (Comr. Pats. 1981). To the contrary, the *ex parte* reexamination legislation made the examination-prosecution stage of a reexamination proceeding under 35 U.S.C. 302 - 307 an *ex parte* proceeding. 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. . . . (Emphasis added.)

The examination under the provisions of 35 U.S.C. 132 and 133 is ex parte examination. 35 U.S.C. 305 unequivocally requires such *ex parte* examination, and third party input (by a requester **or any other party**) is thus prohibited after the times for filing the statement and reply provided for by section 304. See also *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):

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[1] Furthermore, the December 12, 2008, submission, containing third party authored/prepared materials, is not a patent owner's statement pursuant to 37 CFR 1.530, nor a reply pursuant to 37 CFR 1.535 in accordance with 35 U.S.C. 305. The December 12, 2008, submission is not a request for reexamination in compliance with the requirements of 37 CFR 1.510 (it not in the proper format for a request for reexamination, and the reexamination filing fee has not been paid). Nor do the third party prepared court papers in the December 12, 2008, submission qualify as a prior art citation under 37 CFR 1.501. Therefore, based on 37 CFR 1.550(e), the December 12, 2008, submission does not have an entry right.

> "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)

Accordingly, materials authored/prepared by a third party are precluded during the examination/prosecution stage of a reexamination proceeding, because 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 53 1.530 and 1.535. Furthermore, patent owner's petition and IDS cover letters go beyond the bare notice requirement of MPEP 2282, for notification and submission of papers in related proceedings.

In view of the above, the December 12, 2008 submission has been reviewed only to the extent needed to find that they contain impermissible third party materials, and discussions of same, which touch upon the merits of the merged proceeding. Because the December 12, 2008 submission contains improper papers, the IDS submissions are not being made a part of the record of the present proceeding. The copy of the December 12, 2008 submission papers filed for the merged reexamination proceeding is being expunged from the electronic Image File Wrapper (IFW) record of the proceedings. The expungment is effected by closing the submission documents in the IFW file of the merged proceeding and marking the documents "not public." They will not constitute part of the record of the present reexamination proceeding. In accordance with MPEP 2266, all papers in the IDS submissions will be expunged, as the Office will not determine which portion of the submission is the third party paper. A copy of this decision will be made of record in the merged proceeding.

As the IDS submission is expunged, because the information submitted therein lacks a right of entry, the petition requesting entry of an IDS after NIRC is dismissed.

II. ADDITIONAL DICUSSION REGARDING THE POST NIRC IDS PETITION

The following discussion is provided as general guidance for submissions after NIRC.

There is no issue fee in reexamination, and, in this instance, the 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 CFR 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 has provided 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 the above-quoted criteria. 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 provides contentions from a third party, along with references and a rejection of claims from a "counterpart" Japanese patent application. These are not statements by the patent owner that unequivocally state why the art submitted makes at least one claim unpatentable.

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." Since it has been 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, such criteria must certainly be complied with for a reexamination proceeding *where there is a statutory mandate for special dispatch.* This is the point of MPEP 2656, quoted from above.

A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on May 27, 2008, 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 and the failure to identify a question of patentability of the claims, the present merged reexamination proceeding would <u>not</u> be reopened at this late date to consider the proffered IDS papers. Accordingly, even if the IDS submission was a proper reexamination paper, the proceeding would not be withdrawn from the publication process.

<u>If, however</u>, the patent owner in fact believes that one or more references submitted raises a substantial question of patentability as to at least one claim of the patent *different* than raised in this proceeding, the patent owner can always file a new request for reexamination for consideration of such reference(s), presenting the patent owner's position.

III. DIFFERENT MATTERS SUBMITTED IN A SINGLE PAPER

The December 12, 2008 submission styled as an IDS submission is improper, because while it contains prior art patents and printed publications, it also contains court documents from a related legal proceeding that are not prior art patents and printed publications. IDS submissions of patents and printed publication are governed by 37 CFR 1.97-98 and MPEP § 609; the submission of a notice of prior or concurrent proceedings and providing papers from such proceedings is governed by 37 CFR 1.565 and MPEP 2282. By melding the two separate and distinct sets of information into a single paper that purports to be an IDS, the submission runs contrary to the strictures of 37 CFR 1.4(c), which requires separate submissions for each separately distinct and different matter, in this instance prior art submissions versus related proceeding notification. Therefore, the filing of IDS submissions to serve as both prior art submissions and to serve as concurrent proceeding notifications is improper.

CONCLUSION

1. The petition is dismissed as to the request for consideration of the IDS filed on December 12, 2008.

2. The December 12, 2008 IDS submission is an improper paper, and therefore it will NOT be made a part of the record of the merged proceeding.

3. The December 12, 2008 IDS submission, which was scanned into the electronic Image File Wrapper (IFW) of the merged proceeding, is being expunged by closing the documents in the IFW file of the present proceeding and marked them as "not public." They will not constitute part of the record of the present reexamination proceeding.

4. The present proceeding will continue in the publication process, toward issuance of a reexamination certificate.

5. Telephone inquiries related to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.

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

2-12-09

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Paper No. 31

Neil S. Cohen Advanced Card Technologies, Inc. 75 Montebello Road Suffern, NY 10901	For Patent Owner
John J. Gresens Merchant & Gould P.C. P.O. Box 2903 Minneapolis, MN 55402-0902	For Requester
In re Reexamination Control No. 90/006,441 Request Filed: November 5, 2002 U.S. Patent No. 5,720,158 Issued: February 24, 1998 Patent Owner: Advanced Card Technologies	DECISION, *SUA SPONTE*, MERGING REEXAMINATION PROCEEDINGS
In re Reexamination Control No. 90/006,795 Request Filed: October 15, 2003 For: U.S. Patent No. 5,720,158 Issued: February 24, 1998 Patent Owner: Advanced Card Technologies	

The above noted reexamination files are before the Director of Patent Examining Group 3700 for consideration of merger of the proceedings under 37 CFR 1.565(c), in accordance with the practice set forth at MPEP § 2283.

Preliminary Matters

On January 13, 2004, in the '441 proceeding, Owner filed an amendment responsive to the Office action dated April 21, 2003. This paper has been entered. There has been no *ex parte* action in the '795 proceeding.

Merger of Copending Reexamination Proceedings

I. Merger of Proceedings

As required by the practice pursuant to MPEP § 2283, and under the authority of 37 CFR 1.565(c), the reexamination proceeding 90/006,441 and reexamination proceeding 90/006,795 are hereby MERGED. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in Both Proceedings

Patent Owner is required to maintain the same claims, drawings and specification in both files. The contents of each file will be hereafter be maintained identically, and all actions promulgated and papers filed subsequent to this Decision will bear the same paper number. This Decision is paper No. 31 in both files. There will be no paper Nos. 9-30 in Control No. 90/006,795.

III. Housekeeping Amendment

As discussed above, Owner filed an amendment in control No. 90/006,441 and that paper has been entered in that proceeding. Therefore, Owner is **required** to file a housekeeping amendment in control No. 90/006,795 entering the identical claims therein, as well as making the specification and drawings in the '795 proceeding identical to the specification and drawings in the '441 proceeding if amendments to these items have also been made during the prosecution to date. That paper will be paper No. 32 in control No. 90/006,795. There will then be no paper No. 32 in 90/006,441, unless Owner elects to file additional claims by way of a supplemental amendment in the '441 proceeding. If that is the case, such additional claims **must** also be added to the housekeeping amendment filed in control No. 90/006,795. The next action by the Primary Examiner will then be paper No. 33 in both files. **Owner is required to file the housekeeping amendment not later than ONE MONTH from the date of this decision.** Attention is invited to MPEP § 2282, subsection entitled "Merger of Reexaminations", last paragraph.

IV. Conduct of Merged Proceeding

All mailed by the Office will take the form of a single combined action which applies to both proceedings, and which will cross-reference the two proceedings. A separate action cover form for each proceeding will be printed by the PALM printer for each of the two reexamination control numbers. Requester and Owner will each receive one copy of the body of the action, and a copy of the cover sheet (*e.g.* Form PTO-466). All papers filed by Owner following filed subsequent to the items in Section III above will contain the identifying data for **both** files and will be physically entered in each reexamination file. All papers filed by Owner **must** consist of a single response, **filed in duplicate**, each bearing an original signature, for entry in each file. Owner and Requester are reminded that **every** paper filed in the merged proceeding subsequent to this Decision must be served on the other party, including papers filed *via* facsimile transmission. Owner is asked to review 37 CFR 1.530 and MPEP § 2250 prior to filing any amendments to the drawings, specification or claims in order to make sure that the amendments are in proper format. **Clean copies of the amended claims are not required; only so called "marked-up" claims and paragraphs in which specification amendments are requested must be filed together with material satisfying the requirements of 37 CFR 1.530(e).** All words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets. New drawing figures must be labeled "New", while amended drawing figures must be labeled "Amended".

V. Citation of Patents and Printed Publications

Following the filing of the housekeeping amendment, the examiner will promulgate an action on the merits of the claims. That action will be paper No. 37. The examiner will review the files to insure that each file contains identical citations of prior patents and printed publications, and will make cite such documents as are necessary as part of the next action in order to place the files in that condition.

The reexamination proceeding files are being returned to storage in the Technology Center 3700 Central Files awaiting the filing of the above described housekeeping amendment. The amendment **must** be filed by Owner **not later than one month from the date of this decision.**

E. Rollins-Cross, Director
Technology Center 3700

REEXAMINATION

66548 U.S. PTO
90006795
10/15/03

PATENT APPLICATION

90006795

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APR 29 2004

Paper No. 35

Neil S. Cohen Advanced Card Technologies, Inc. 75 Montebello Road Suffern, NY 10901	For Patent Owner
John J. Gresens Merchant & Gould P.C. P.O. Box 2903 Minneapolis, MN 55402-0902	For Requester
In re Reexamination Control No. 90/006,442 Request Filed: November 5, 2002 U.S. Patent No. 5,921,584 Issued: July 13, 1999 Patent Owner: Advanced Card Technologies	DECISION, *SUA SPONTE*, MERGING REEXAMINATION PROCEEDINGS
In re Reexamination Control No. 90/006,796 Request Filed: October 15, 2003 For: U.S. Patent No. 5,921,584 Issued: July 13, 1999 Patent Owner: Advanced Card Technologies	

The above noted reexamination files are before the Director of Patent Examining Group 3700 for consideration of merger of the proceedings under 37 CFR 1.565(c), in accordance with the practice set forth at MPEP § 2283.

Preliminary Matters

On April 14, 2004, in the '442 proceeding, Owner filed an amendment responsive to the Office action dated October 15, 2003, an Information Disclosure Statement, and a declaration pursuant to 37 CFR 1.131. These papers have been entered. There has been no *ex parte* action in the '796 proceeding.

Merger of Copending Reexamination Proceedings

I. Merger of Proceedings

As required by the practice pursuant to MPEP § 2283, and under the authority of 37 CFR 1.565(c), the reexamination proceeding 90/006,442 and reexamination proceeding 90/006,796 are hereby MERGED. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in Both Proceedings

Patent Owner is required to maintain the same claims, drawings and specification in both files. The contents of each file will be hereafter be maintained identically, and all actions promulgated and papers filed subsequent to this Decision will bear the same paper number. This Decision is paper No. 35 in both files. There will be no paper Nos. 9-34 in Control No. 90/006,796.

III. Housekeeping Amendment

As discussed above, Owner filed an amendment and other papers in control No. 90/006,442 and those papers have been entered in that proceeding. Therefore, Owner is **required** to file a housekeeping amendment in control No. 90/006,796 entering the identical claims therein, as well as making the specification and drawings in the '796 proceeding identical to the specification and drawings in the '442 proceeding. That paper will be paper No. 36 in control No. 90/006,796. There will then be no paper No. 36 in 90/006,442, unless Owner elects to file additional claims by way of a supplemental amendment in the '442 proceeding. If that is the case, such additional claims **must** also be added to the housekeeping amendment filed in control No. 90/006,796. The next action by the Primary Examiner will then be paper No. 37 in both files. **Owner is required to file the housekeeping amendment not later than ONE MONTH from the date of this decision.** Attention is invited to MPEP § 2282, subsection entitled "Merger of Reexaminations", last paragraph.

IV. Conduct of Merged Proceeding

All mailed by the Office will take the form of a single combined action which applies to both proceedings, and which will cross-reference the two proceedings. A separate action cover form for each proceeding will be printed by the PALM printer for each of the two reexamination control numbers. Requester and Owner will each receive one copy of the body of the action, and a copy of the cover sheet (*e.g.* Form PTO-466). All papers filed by Owner following filed subsequent to the items in Section III above will contain the identifying data for **both** files and will be physically entered in each reexamination file. All papers filed by Owner **must** consist of a single response, **filed in duplicate**, each bearing an original signature, for entry in each file. Owner and Requester are reminded that **every** paper filed in the merged proceeding subsequent to this Decision must be served on the other party, including papers filed *via* facsimile transmission. Owner is asked to review 37 CFR 1.530 and MPEP § 2250 prior to filing any amendments to the drawings, specification or claims in order to make sure that the amendments are in proper format. **Clean copies of the amended claims are not required; only so called "marked-up" claims and paragraphs in which specification amendments are requested must be filed together with material satisfying the requirements of 37 CFR 1.530(e).** All words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets. New drawing figures must be labeled "New", while amended drawing figures must be labeled "Amended".

V. Citation of Patents and Printed Publications

Following the filing of the housekeeping amendment, the examiner will promulgate an action on the merits of the claims. That action will be paper No. 37. The examiner will review the files to insure that each file contains identical citations of prior patents and printed publications, and will make cite such documents as are necessary as part of the next action in order to place the files in that condition.

The reexamination proceeding files are being returned to storage in the Technology Center 3700 Central Files awaiting the filing of the above described housekeeping amendment. The amendment **must** be filed by Owner **not later than one month from the date of this decision.**

E. Rollins-Cross, Director
Technology Center 3700

#10

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(For Patent Owner)

APR - 8 2004

Michael P. Kenney, Esq.
Amster Rothstein & Ebenstein
90 Park Avenue
New York, NY 10016

(For Requester)

Reexam Control No.: 90/006,737 Filed: August 8, 2003 For: U.S. Patent No. 6,001,079	:	DECISION MERGING REEXAMINATION PROCEEDINGS
Reexam Control No.: 90/006,798 Filed: October 3, 2003 For: U.S. Patent No. 6,001,079	:	

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

Reexamination in application Control No. 90/006,737 was ordered in a decision mailed October 3, 2003.

Reexamination in application Control No. 90/006,798 was ordered in a decision mailed November 3, 2003.

Merger is proper if a reexamination is ordered while a prior reexamination proceeding is pending. In view of the above, merger is appropriate and is hereby ordered.

Requirement for Same Claims in Both Proceedings

The Patent Owner is required to maintain identical specifications, abstract, claims and claim numbering in both files. In view of the fact that both reexamination applications contain identical specifications, drawings, and claims, no amendment is required.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. All papers mailed by the Office will take the form of a single action, which applies to both proceedings. All papers issued by the Office or as filed by the Patent Owner will contain the identifying data for both files and will be

physically entered in each reexamination file. All papers filed by the Patent Owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by Patent Owner must be served on Requester and Requester will be sent copies of all papers mailed by the Office. See 37 CFR 1.565 (d).

Conclusion

Reexamination Control Nos. 90/006,737 and 90/006,798 are hereby merged. At this time there is no further action required by Patent Owner. These proceedings will be forwarded to the Examiner for an action on the merits.

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

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(For Requester)

In re: Thierry POURCHEZ
Reexamination Proceeding
Control No.: 90/006,737
Filed: August 8, 2003
For: U.S. Patent No. 6,001,079

DECISION DISMISSING PETITION

MAILED

OCT 06 2006

CENTRAL REEXAMINATION UNIT

In re: Thierry POURCHEZ
Reexamination Proceeding
Control No.: 90/006,798
Filed: October 3, 2003
For: U.S. Patent No. 6,001,079

This is a decision on the October 26, 2005, patent owner petition entitled PETITION UNDER 37 CFR 1.182 FOR CONSIDERATION OF INFORMATION DISCLOSURE STATEMENT FILED AFTER NOTICE OF INTENT TO ISSUE EX PARTE REEXAMINATION CERTIFICATE.

The petition is before the Office of Patent Legal Administration.

The petition is **dismissed** for the reasons set forth below.

REVIEW OF SALIENT FACTS

1. U.S. Patent number 6,001,079 (the '079 patent) issued December 14, 1999.

2. A request for reexamination, assigned control No. 90/006,737, was filed on August 8, 2003, by a third party requestor.

3. A second request for reexamination, assigned control No. 90/006,798, was filed on October 3, 2003, by the same third party requestor.

4. The two reexamination proceedings were merged on April 8, 2004.

5. Patent owner filed an Information Disclosure Statement (IDS) on July 8, 2005.

6. The patent owner conducted a telephonic interview with the examiner on August 5, 2005. During this interview, patent owner apparently alerted the examiner to the fact that a German patent corresponding to the '079 patent had been nullified by a German court during a nullity proceeding.[1]

7. On August 19, 2005, the Office mailed, for the merged reexamination proceeding, a Notice of Intent to Issue a Reexamination Certificate (NIRC), accompanied by a copy of the PTO 1449 for the IDS of July 8, 2005, which identified the references considered by the examiner.

8. On October 26, 2005, the patent owner filed an IDS citing information stated to be related to the nullity proceeding for the German patent corresponding to the '079 patent. The instant petition accompanied the IDS.

DECISION

A review of the record shows that the examiner terminated prosecution of the proceeding by issuing the NIRC on August 19, 2005.

A) Consideration of Previously Submitted Documents

On July 8, 2005, before the issuance of the NIRC, patent owner filed a Supplemental Information Disclosure Statement (IDS) requesting consideration of the documents identified therein. On August 19, 2005, the Office mailed to the patent owner a copy of the IDS with the examiner's initials next to all but three citations, which had been crossed out by the examiner as not having been considered. The examiner did not consider documents "D-11," "D-12," and "D-13." In the present petition, patent owner requests that the examiner consider the three crossed out documents and make his consideration of each document of record. [2] An itemized postcard stamped with an Office date-stamp of July 8, 2005, has been provided by patent owner as evidence that the three non-considered documents in question were provided to the Office with the IDS.

From a review of the transcript of the deposition of John Zawaki, the Office has determined that the three documents that were identified as D-11, D-12, and D-13 are all United States patents. [3] Patent owner, however, listed these patents as "non-patent literature" on the IDS of July 8, 2005. Yet, 37 CFR 1.98(a)(1) requires that all "U.S. patents and U.S. patent application publications must be listed in a section separately from citations of other documents." Additionally, § 1.98(b)(1) requires that "each U.S. patent listed in an information disclosure statement must be identified by inventor, patent number, and issue date." The patent owner failed to comply with these requirements of § 1.98; as a consequence, in accordance with 37 CFR 1.97(i), the examiner did not consider these patents at the time he considered the other documents cited in the IDS of July 8, 2005. [4, 5]

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[1] The record of this reexamination proceeding does not include an interview summary prepared by the examiner for the interview of August 5, 2005, which is referenced in patent owner's INTERVIEW SUMMARY received August 12, 2005.

[2] These documents were resubmitted with the IDS of October 26, 2005, and listed as documents "AK" – "AM."

[3] D-11 has been determined to be US Patent No. 4,134,402 to Mahurkar; D-12 has been determined to be US Patent No. 5,704,915 to Melsky et.al., and D-13 has been determined to be US Patent No. 6,001,079 to Pourchez.

[4] "If an information disclosure statement does not comply with either this section or § 1.98, it will be placed in the file but will not be considered by the Office." 37 CFR 1.97(i) (2005).

B) Consideration of Newly Submitted Documents

37 CFR 1.510(a) states, in part:

> Any person may, at any time during the period of enforceability of a patent, file a request for an *ex parte* reexamination by the Office of any claim of the patent on the basis of **prior art** patents or printed publications cited under § 1.501 (emphasis added).

37 CFR 1.555(a) states, in pertinent part:

> Any information disclosure statement must be filed with the items listed in § 1.98(a) as applied to individuals associated with the patent owner in a reexamination proceeding, and should be filed within two months of the date of the order for reexamination, **or as soon thereafter as possible**. (emphasis added).

37 CFR 1.555(b)(1) states:

> Under this section, information is material to patentability in a reexamination proceeding when it is not cumulative to information of record or being made of record in the reexamination proceeding, and
>
> (1) It is a patent or printed publication that establishes, by itself or in combination with other patents or printed publications, a *prima facie* case of unpatentability of a claim.

1) Foreign Patent Documents

Patent owner identified two foreign patent documents, "AA" and "AB," in the IDS of October 26, 2005, for consideration by the examiner. [6] Both of these documents appear to be foreign counterpart applications of the '079 patent. If these documents are foreign counterpart applications, petitioner has not explained how these documents are material to the examination of the '079 patent and why they should be considered by the examiner at this point in the reexamination proceeding.[7] Moreover, even if these documents were explained as to their materiality to the examination of the '079 patent, as defined in § 1.555(b)(1), petitioner has failed to provide a statement explaining why these counterpart applications were not previously cited to the Office during this reexamination proceeding in accordance with § 1.555(a) prior to the termination of the prosecution.

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[5] The examiner has already considered US Patent No. 4,134,402 to Mahurkar. Patent owner's attention is directed to the initialed IDS signed October 4, 2004. Similarly, the examiner indicated his prior consideration of US Patent No. 5,704,915 to Melsky et al. in the IDS signed May 17, 2004.

[6] The foreign patent documents identified for consideration are EP 0848626 and DE 69616355. Both of these documents were identified by petitioner as being foreign counterparts of the patent subject to the current, merged reexamination proceeding.

[7] On their face, documents "AA" and "AB" would not appear to qualify as prior art with respect to the '079 patent, and patent owner has not explained why they were cited.

2) <u>German Nullity Action Documents</u>

37 CFR 1.552(a) states:

> Claims in an *ex parte* reexamination proceeding will be examined on the basis of patents or printed publications and, with respect to subject matter added or deleted in the reexamination proceeding, on the basis of the requirements of 35 U.S.C. 112.

Petitioner requests consideration of the documents listed as "AC" – "AJ" in the information disclosure statement of October 26, 2005. [8] These documents were apparently generated for, and first brought to the patent owner's attention during, the German nullity proceeding.

While the present petition sets forth a timeline of events to show the timely filing of these documents with the Office, the petition does not explain how these documents, each produced at least four years after the '079 patent issued, qualify as "prior art patents or printed publications" to the '079 patent pursuant to 35 USC § 302 and 37 CFR 1.510. [9] Similarly, the petitioner does not indicate how these documents can be properly considered by an examiner when examining the claims of the '079 patent in accordance with § 1.552(a).

To the extent that petitioner is seeking consideration of the patents or patent publications discussed within documents "AC" – "AJ" of the IDS filed October 26, 2005, the patent owner has "already submitted all references cited during the nullity proceeding." [10] Therefore, based on the patent owner's statement, the documents cited in the German nullity proceeding are duplicative, or at least cumulative, of those previously considered by the examiner, and have not been shown to raise an issue regarding the patentability of the claims of the '079 patent.

For the above-discussed reasons, the petition is dismissed. The reexamination proceeding will proceed to the publication of an *ex parte* reexamination certificate.

Additional discussion:

The present merged 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 to show relevance, it is proper that the reexamination proceeding should not be reopened

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[8] The petitioner does not indicate that these documents raise a patentability question with respect to the claims of the '079 patent.

[9] The petition states, "Patent Owner's German counsel received a copy of the German Federal Patent Court's opinion in the nullity action and promptly obtained an English translation of it. Patent Owner's undersigned counsel received the English translation on October 25, 2005." The petition and information disclosure statement were filed with the USPTO on October 26, 2005.

[10] See Page 2 of the Interview Summary, filed by patent owner on August 12, 2005.

at this late date to consider the proffered IDS papers. See also MPEP 2656 (Rev. 5, Aug. 2006).[11] 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,** 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 that is different than raised in this merged proceeding, then the patent owner can always file a new request for reexamination for consideration of the references.

CONCLUSION

1. The patent owner petition to have the information disclosure statement filed October 26, 2005, considered is dismissed.

2. The IDS papers filed October 26, 2005, will be entered into the file, but will not be considered by the examiner.

3. The present proceeding will continue in the publication process, toward issuance of a reexamination certificate.

4. Telephone inquiries related to this decision should be directed to Brian E. Hanlon, Legal Advisor, at (571) 272-5047, or in his absence, the undersigned at (571) 272-7710.

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

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[11] "....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."

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
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Paper No. 6

HUNTON & WILLIAMS
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON, DC 20006-1109

(For Patent Owner)

MAILED

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REEXAM UNIT

Arthur J. Usher, Esquire
WOODARD, EMHARDT, NAUGHTON,
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(For Third Party Requester)

Harvey et al	:
Reexamination Proceeding	: DECISION
Control No. 90/006,800	: GRANTING-IN-PART
Filed: October 3, 2003	: PETITION
For: U.S. Patent No. 4,694,490	:

This is a decision on the October 20, 2003, patent owner petition titled PATENT OWNER'S PETITION TO DENY THE REQUEST FOR REEXAMINATION, EXPUNGE AND SEAL PAPERS FROM THE REQUEST FOR REEXAMINATION, AND REFUSE TO CONSIDER FUTURE PAPERS INCLUDING CONFIDENTIAL MATERIAL.

The petition is addressed in five 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 materials of the request for reexamination, and

(3) Under 37 CFR 1.182 as a request that papers from the request for reexamination be sealed.

(4) Under 37 CFR 1.182 as a request that the Office deny the request for reexamination, as a harassment of the patent owner.

(5) Under 37 CFR 1.182 as a request that the Office put the requester on notice that "the Office will return without consideration any correspondence that publicly includes the confidential notice." [1]

[1] Petition at page 2.

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 dismissed as to the request that materials be expunged from the Reexamination Processing System (REPS) Scanning Data Base of the Central Reexamination Unit (CRU), since this is a request for relief from an action not taken by the Office. The petition under 37 CFR 1.59(b) 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 that the Office deny the request for reexamination, as a harassment of the patent owner, is dismissed, for the reasons set forth below.

The petition under 37 CFR 1.182, as it relates to the request that the Office put the requester on notice that "the Office will return without consideration any correspondence that publicly includes the confidential notice," is dismissed, for the reasons set forth below.

REVIEW OF FACTS

1. U.S. patent No. 4,694,490 was issued on September 15, 1987.

2. A request for reexamination of the '4490 patent was filed by a third party requester on October 3, 2003, and it was assigned reexamination control No. 90/006,800.

3. On October 20, 2003, patent owner filed the present petition to expunge and seal papers from the request for reexamination, and to deny the request for reexamination as a harassment of the patent owner. A redacted copy of the request for reexamination and a redacted copy of Exhibit A1 were submitted with the petition.

4. A decision on the '6,800 request for reexamination has not yet been rendered.

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.[2]

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."

Thus, the present petition paper does not have an entry right under the reexamination rules.

A right of entry for the petition papers would require a waiver of the above-cited provision of 37 CFR 1.530(a) pursuant to 37 CFR 1.183.[3] The present petition requests, under 37 CFR 1.183, such a waiver of the rules.

At pages 5-6, and elsewhere in the petition, grounds for waiver are presented, and found to be persuasive. 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, where 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 <u>granted</u>.

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[2] Three aspects of 37 CFR 1.182 relief will be addressed separately.

[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)."

[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).

II. PETITION UNDER 37 CFR 1.59(b)

In the second page of the petition, as well as pages 9-10 thereof, it is requested that the Commissioner 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. Subsequently in the petition, the request for reexamination and Exhibit A1 are identified as the papers containing such quotations and descriptions.

(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 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 <u>premature</u>.

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 proceeding 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 made 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 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 will be sealed by direction of the present decision; see Section III below.

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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.

(2) To the extent that the petition is taken as a petition for expungement, from the CRU REPS Scanning Data Base, of the request for reexamination papers containing the confidential material, the petition is dismissed. The reexamination papers have not been scanned into the REPS Scanning Data Base, and as such, the petition is premature as to this issue. In addition, the materials to which petitioner's request is directed are being sealed without such scanning, and as such, the petition is moot as to the issue.

III. DECISION ON PETITION UNDER 37 CFR 1.182 REQUESTING SEALING

At page 2 of the petition, and on page 10 thereof, 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. 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. This relief is directed to protecting patent owner's interest in confidentiality, and the present petition is granted to this extent.

It is to be noted, however, 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 requester's filing of prior related reexamination requests, 37 CFR 1.11(d). [7] Accordingly, the Office cannot guarantee that the materials being sealed as a result of this decision were not previously accessed by the public.

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[7] For example, requests for reexamination in Control Numbers 90/006,563 and 90/006,536 were filed by the requester on March 14, 2003, and February 4, 2003, respectively. 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 owner did not file the initial petition addressing the materials stated to be protected until May 30, 2003, in the '6536 proceeding, and June 10, 2003, in the '6563 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.

IV. DECISION ON PETITION UNDER 37 CFR 1.182 REQUESTING THAT THE REQUEST FOR REEXAMINATION BE DENIED

In the second page of the petition, as well as pages 6-9 thereof, it is requested that the Office deny the request for reexamination, as a harassment of the patent owner and an inappropriate submission of confidential materials. This request will <u>not</u> be granted.

As to the harassment issue, such is addressed in the Manual of Patent Examining Procedure at § 2240, where it is stated:

> "If a second or subsequent request for reexamination is filed ... in aggravated situations, upon petition by the patent owner under 37 CFR 1.182, where it appears clear that the second or subsequent request was filed for purposes of harassment of the patent owner, the request should be denied. The grant of such a request would unduly prolong the conclusion of the pending reexamination and be inconsistent with the requirement that reexamination proceeding be conducted with special dispatch."

In the present instance, this is the first reexamination request filed for the patent by requester (or otherwise). There is no pending reexamination whose conclusion would be delayed.

As to the question of creating delay in the instant reexamination, the request for reexamination will be acted upon within three months of the request filing date, and no other delay has been shown by petitioner for the maintaining of some of the submitted papers as confidential. On the other hand, the papers will be sealed and available for consideration and applying same to the claims, if deemed sufficiently relevant. If the sealed papers, or any of the other papers submitted, provide a substantial new question of patentability as to any claim of the patent, there is no reason why reexamination should not be ordered. The present request for reexamination complies with the statute and the rules, and to deny the request for reexamination before its contents are evaluated (as is requested in the petition) would be contrary to the public interest in maintaining valid patents, and contrary to the reexamination statute. The materials are appropriately before the examiner, and should they not be found relevant to the extent discussed above, they will not be unsealed and may be expunged upon a proper timely petition requesting the expungement of the materials.

It is additionally noted that the issue raised in the petition is not ripe for decision. Petitioner requests denial of the request for reexamination on the grounds of harassment by the third party requester. In the present proceeding, the examiner has not yet issued a decision on the request for reexamination finding a substantial new question of patentability to exist. The examiner's decision might find that a substantial new question of patentability has not been raised and deny reexamination. If so, the issue raised in the present petition would be moot.

V. DECISION ON PETITION UNDER 37 CFR 1.182 REQUESTING THAT THE REQUESTER BE PUT ON NOTICE

In the second page of the petition, as well as pages 10-12 thereof, it is requested that the Office return, without consideration, any correspondence that publicly includes the confidential notice.

It is initially noted that this request is not directed to relief to be provided for the instant reexamination proceeding, and as such, is inappropriate. In addition, it is fitting for the Office to consider such "correspondence," to determine whether it raises a substantial new question of patentability as to any claim of the patent. By retaining the "correspondence" and sealing the "confidential" materials in containers, the public interest of evaluating the patent while having the benefit of the materials is served, and patent owner's interest in the confidentiality of the materials is also served. If, subsequently, the materials are found to contribute to a finding of a substantial new question of patentability as to a patent claim, then the public interest in maintaining the validity of its patents dictates that such papers be considered and applied.

It is requested beginning at page 12 of the petition that:

> "Should the Office dismiss PMC's request to return without consideration any public filing of the confidential notice, PMC requests that the Office provide PMC the opportunity to review and request proper sealing or redaction of every paper filed by Thomson prior to any such paper being made accessible to the public."

It is initially noted that this request also is not directed to relief to be provided for the instant reexamination proceeding, and as such, is inappropriate. In addition, it is noted that the patent owner has been served with a copy of the papers for each request that was filed thus far by the third party requester. The patent owner should have ample time to file a petition to request

sealing of materials prior to CRU scanning of any future-filed request papers. If any such a petition is filed, the patent owner is strongly advised that the Office of Patent Legal Administration be alerted orally [8] to ensure that such petition is matched with the appropriate request papers as soon as possible. As pointed out above in a footnote, the materials stated to be protected were already made available to the public when the owner did not file the initial petition addressing such materials until May 30, 2003, in the '6536 proceeding, and June 10, 2003, in the '6563 proceeding, *and thus*, the Office did not have notice that protected materials might be present in the proceedings until about three months after each request for reexamination was filed.

VI. ACTION TO BE TAKEN BY THE CENTRAL REEXAMINATION UNIT

The appropriate Central Reexamination Unit (CRU) personnel will immediately:

1. Scan into the CRU REPS Scanning Data Base the redacted copy of the request for reexamination and the redacted copy of Exhibit A1 submitted with the petition, together with the originally submitted attachments other than Exhibit E and the original of Exhibit A1. (The present petition will also be scanned.)

2. Enter into the paper file 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; the originally submitted attachments other than Exhibit E and the original of Exhibit A1 are to be retained in the paper file as is.

3. Then forward the file to the Technology Center for sealing of documents.

VII. ACTION TO BE TAKEN BY THE TECHNOLOGY CENTER TO SEAL MATERIALS

Upon receipt of the present file in the Technology Center, the appropriate personnel thereof will immediately:

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[8] Marsha Twitty of the CRU may be contacted for this purpose at 703-308-9692. In her absence, Lynn Kryza may be reached at 703-308-0255.

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).

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 dismissed 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 under 37 CFR 1.182, as it relates to the request that the Office deny the request for reexamination is dismissed.

5. The petition under 37 CFR 1.182, as it relates to the request that the Office put the requester on notice that "the Office will return without consideration any correspondence that publicly includes the confidential notice" is dismissed.

6. The reexamination file is being forwarded to the CRU to

   (A) 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.

   (B) Scan into the REPS Data Base - the petition filed October 20, 2003, the redacted copy of the request for reexamination and the redacted copy of Exhibit A1 submitted with the petition, together with the attachments as originally filed other than Exhibit E and the original of Exhibit A1.

7. The reexamination file will then be forwarded by the CRU to Technology Center 2600. The Technology Center will seal materials as directed by part V of this decision.

8. The reexamination file will then be forwarded to the examiner who will promptly prepare a decision on the request for reexamination.

9. Any questions regarding this decision should be directed to the undersigned at (703) 308-6710.

10. 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

November 6, 2003
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Paper No. __

HUNTON & WILLIAMS
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
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(For Patent Owner)

Arthur J. Usher, Esquire
WOODARD, EMHARDT, NAUGHTON,
MORIARTY & MC NETT
BANK ONE CENTER/TOWER
111 MONUMENT CIRCLE, SUITE 3700
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(For Third Party Requester)

MAILED

DEC 1 6 2004

REEXAM UNIT

Harvey et al	:
Reexamination Proceeding	: DECISION
Control No. 90/006,800	: GRANTING-IN-PART
Filed: October 3, 2003	: PETITION
For: U.S. Patent No. 4,694,490	:

This is a decision on (A) the November 3, 2003, third party requester petition titled REQUESTER THOMSON INC.'S PETITION IN OPPOSITION TO "PATENT OWNER'S PETITION TO DENY THE REQUEST FOR REEXAMINATION, EXPUNGE AND SEAL PAPERS FROM THE REQUEST FOR REEXAMINATION, AND REFUSE TO CONSIDER FUTURE PAPERS INCLUDING CONFIDENTIAL MATERIAL" and (B) the patent owner's November 13, 2003, petition titled PATENT OWNER'S PETITION TO SEAL PAPERS FROM REEXAMINATION PROCEEDING.

The requester petition is addressed in six respects, as set out in p. 17 of requestor's petition:

(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 that the Office continue the request for reexamination, and reject the patent owner's request for a denial of the request for reexamination.

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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.

(3) Under 37 CFR 1.182 as a request to maintain any papers from the request for reexamination in their form as filed, and a request to unseal the paper documents sealed in the present reexamination proceeding.

(4) Under 37 CFR 1.182 as a request that all the request materials, originally and presently submitted by requester, be publicly available in accord with 37 CFR 1.11.

(5) Under 37 CFR 1.182 as a request that requester not be precluded from publicly filing papers that include the Notice of Abandonment discussed below.

(6) Under 37 CFR 1.182 as a request that no papers that have been, or will be, sealed will be expunged absent a ruling from the Delaware Court.

The patent owner petition is addressed in two 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 sealed, and that a redacted copy of requester's petition, supplied by the patent owner, be substituted for requester's petition in the file.

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 the requester and the patent owner in the form of a check or authorization for payment from a deposit account.

The petitions are before the Office of the Patent Legal Administration of the United States Patent and Trademark Office for decision.

SUMMARY OF ACTION TAKEN

The requester and patent owner petitions under 37 CFR 1.183 are granted, to the extent 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 granted to the extent that the requester petition is being sealed and the redacted copy is being placed in the file, and dismissed as to the request that

requester's petition be denied consideration.

REVIEW OF FACTS

1. U.S. patent No. 4,694,490 was issued on September 15, 1987.

2. A request for reexamination of the '4490 patent was filed by a third party requester on October 3, 2003, and it was assigned reexamination control No. 90/006,800.

3. On October 20, 2003, patent owner filed a petition to expunge and seal papers from the request for reexamination, and to deny the request for reexamination as a harassment of the patent owner. A redacted copy of the request for reexamination and a redacted copy of Exhibit A1 were submitted with the petition.

4. A decision on patent owner's original petition was mailed November 6, 2003, in which:

   A. The petition under 37 CFR 1.183 was granted, such that the petition paper was entered and addressed.

   B. The petition under 37 CR 1.59(b) was dismissed as to the request for expungement of the materials of the reexamination from the REPS Scanning Data Base. It was otherwise is held in abeyance, pending renewal of same by patent owner at an appropriate time. The patent owner was 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.

   C. The petition to seal materials under 37 CR 1.182 was granted to seal the originally filed request for reexamination, the originally filed Exhibit A1, and Exhibit E.

   D. The petition under 37 CFR 1.182, as it relates to the request that the Office deny the request for reexamination was dismissed.

   E. The petition under 37 CFR 1.182, as it relates to the request that the Office put the requester on notice that "the Office will return without consideration any correspondence that publicly includes the confidential notice" was dismissed.

5. On November 7, 2003, the requester filed the instant petition requesting waiver of the rules to provide an entry right for the petition paper, and specifically requesting that the paper documents sealed in the present reexamination proceeding be unsealed, and that all the request materials originally submitted by the requester be publicly available in accord with 37 CFR 1.11. The instant requester petition addresses the October 20, 2003, patent owner petition.

7. On November 13, 2003, the patent owner filed a petition in opposition to requester's November 7, 2003, petition, including a request for substitution of a redacted version of requester's petition, on the grounds that the requester's petition contained information that would afford public access, via an unindexed website, to copies of the papers that had been sealed from public view by the Office. [2]

4. A decision on the '6,800 request for reexamination resulted in an order for reexamination on December 12, 2003.

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."

---

[2] This patent owner paper will also require a waiver of the rules to provide it with an entry right, as will be discussed below.

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 requests relief under 37 CFR 1.183 by 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 November 6, 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 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 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

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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)."

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 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 prior 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

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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.

> "PMC wrote Thomson that PMC would allow Thomson to treat the document as public." [Requester Petition at p.6]

Requester bolsters this point (agreement to treat the Notice as public) by reference to an e-mail dated December 20, 2003 (attached as Exhibit C), from the patent owner's counsel to the 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 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, the patent owner, on pages 9 and 10 of the patent owner's petition dated October 20, 2003, disputes this. The 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.

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[6] Exhibit D of the requester petition.

[7] *See* Exhibit D, second paragraph.

[8] *See* Exhibit E of the requester petition.

On May 2, 2003, an Order of the Atlanta District Court [9] granted patent owner's motion for a protective order to protect the Notice. The requester is not a party to that action, and there is no indication that the requester made any attempt to intervene in that action.

It is initially noted that the Order of the Atlanta District Court granting the 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 requester 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 the requester's submissions will be made, and there is no reason to grant this request of the third party requester which (a) is not provided for in the rules, and (b) 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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[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).

[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

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. 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.

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

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of the proceeding will not be impeded by the Notice not being available to the public via the reexamination.

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 the request for same is accordingly dismissed. 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.

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 materials 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; [12] 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.

III. **The Requester Petition Under 37 CFR 1.182, as It Relates to Requesting That the Request for Reexamination Be Continued.**

On pages 13-14 and page 17 of the requester's petition, it is requested that the Office continue the request for reexamination. This request is nothing more than that the existing process continue, which will be implicitly occur in the ordinary course of business. Thus, this request is moot.

IV. **The Requester Petition, as It Relates to Requesting that the Requester Not Be Precluded from Publicly Filing Papers that Contain the Notice of Abandonment Decision on Petition, under 37 CFR 1.182.**

On page 17 of the requester's petition, it is urged that the Office defer to the Delaware Court's authority, and reject PMS's request that Thomson be put on notice or otherwise precluded from publicly filing papers that include the Notice of Abandonment. 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 sections 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 sections.

If this is a request that Thomson not be put on notice or otherwise precluded from publicly filing papers that include the Notice of Abandonment in other proceedings, such a matter would relate to activity outside the present proceeding, and would not be the subject of providing relief in the present proceeding. Also, as to any future filing of papers in the present proceeding, the admissibility of such papers is decided on a case-by-case basis based on the content of such papers, and a blanket statement cannot be made. Rather, the patent owner is free to object to the admissibility of future papers as they may be filed. Accordingly, such relief requested by the patent owner would not be appropriate in this proceeding.

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[12] And a certificate of service of the petitions (that accompanied the filing of the petitions) *prima facie* establishes that requester was served.

V. The Requester Petition, as It Relates to Requesting that the Office avoid permanently expunging the Notice of Abandonment and any references thereto.

At page 17 of the requester's petition, it is requested that the Office not permanently expunge the Notice of Abandonment. This request is premature, as the prosecution has not advanced to the point where it would be ripe for the patent owner to file a petition to expunge the Notice. It has been pointed out that the papers placed under seal will not be destroyed or returned until after the examiner has made a determination as to their necessity. It should, however, be noted that the requester cannot challenge an examiner's finding that the Notice would not be "important to a reasonable examiner in deciding whether or not a claim is patentable," since that would amount to an impermissible participation in the examination stage of the reexamination proceeding.

VI. The Patent Owner Petition, as It Relates to Substitution of the Redacted Requester Petition for the Original Requester Petition Under 37 CFR 1.182.

A. Discussion:

At pages 2-3 of the patent owner petition, it is argued that requester's petition should be replaced by the redacted version supplied by the patent owner with its petition.

The patent owner points out that the requester has included a web address in its petition, whereby the confidential material may be found. The patent owner contends this web address cannot be found from indexes available on the web, but can only be found from the address given in the requester's petition. Therefore, the patent owner requests that its submitted version of the requester's petition, which has all references to the web address redacted to avoid disclosing the location of the confidential information, be substituted for the original requester's petition.

Because this request is consistent with the aforementioned analysis, the request is granted to the extent that patent owner is requesting the substitution of the redacted requester petition for the original requester petition. The original requester petition will be sealed and maintained along with the remaining sealed materials for review and disposition by the examiner, according to the criteria set forth above.

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 CFR 1.182 is dismissed, and the materials previously expunged and sealed will not be restored and unsealed (respectively).

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 original requester petition is being sealed and the redacted version of the requester petition is being substituted therefor in the public record of the proceeding.

4. Given that the original requester petition papers are being sealed, if the examiner subsequently determines there is no need for the original un-redacted version, the original version will be returned to the requester.

5. The reexamination file is being returned to Technology Center 2600 for forwarding to the examiner who will prepare an appropriate Office action not inconsistent with this decision.

6. Any questions regarding this decision should be directed to Anton Fetting at (571) 272-7717.

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) 305-4365 or (703) 305-3900.

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

December 14, 2004
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UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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OCT 21 2005

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(For Petitioner)

In re John C. Harvey et al.	:	DECISION DISMISSING
Reexamination Proceeding	:	PETITION AND SEALING
Control No.: 90/006,800	:	PAPERS, AND
Filed: October 3, 2003	:	ORDER *RE* SHOWING
For: U.S. Patent No. 4,964,490	:	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 19, 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 19, 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. 4,964,490 (hereinafter, the '490 patent) issued on September 15, 1987.

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 October 3, 2003 Thomson, Inc. filed a request for reexamination of the '490 patent. The request for reexamination was assigned control number 90/006,800, and it was granted.

5. On August 19, 2005, PMC filed an IDS in reexamination control number 90/006,800.

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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).

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.[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

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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).

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 19, 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 19, 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

mav

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner Personalized Media Communications, LLC)

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.)

MAILED
MAR 30 2006
REEXAM UNIT

Nina L. Medlock
BANNER & WITCOFF, LTD
1001 G Street NW
Washington, DC 20001

(For Non-Party Scientific-Atlanta, Inc.)

In re John C. Harvey et al.	:	
Reexamination Proceeding	:	DECISION DISMISSING
Control No.: 90/006,800	:	PETITION AND UNSEALING
Filed: October 3, 2003	:	PAPERS
For: U.S. Patent No. 4,964,490	:	

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

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[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. 4,964,490 (hereinafter, the '490 patent) issued on September 15, 1987.

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 October 3, 2003 Thomson, Inc. filed a request for reexamination of the '490 patent. Reexamination control number 90/006,800 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 90/006,800.

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 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

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March 29, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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HUNTLON & WILLIAMS LLP
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Washington, DC 20006-1109

(For Patent Owner)

MAILED
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. 90/006,800
Filed: October 3, 2003
For: US Patent No. 4,694,490

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. 4,694,490 issued on September 15, 1987.

2. A request was filed by a third party requester for reexamination of US Patent No. 4,694,490 on October 3, 2003.

3. The Order granting reexamination is dated December 10, 2003.

4. The Office mailed an *ex parte* Advisory Action before the patent owner filing of an Appeal Brief, mailed December 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. 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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(For Patent Owner Personalized Media)

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OFFICE OF PETITIONS

Krieg DeVault LLP
One Indiana Square
Suite 2800
Indianapolis Indiana 46204-2079

(For Requestor)

In re John C. Harvey :
Ex Parte Reexamination Proceeding :
Control No. 90/006,800 : ON PETITION
Filed: October 3, 2003 :
For: U.S. Patent No. 4,694,490 :

This is a decision on the petition filed September 20, 2006, under 37 CFR 1.183 by patent owner to waive the applicable rules and permit the submission of new evidence with the reply brief.

The petition is granted.

Petitioner, in essence, complains that in each communication from the first Office action to the Advisory Action, the examiner has continued to expand the evidence relied upon to support the rejection. Petitioner further complains that while the examiner has not specifically identified that he has made a new ground of rejection, which would permit patent owner to submit new evidence, the examiner has taken a new position in his Examiner's Answer that the CBS petition includes Appendix B in a "single complete publication." Petitioner asserts that as the accompanying declaration of Kimberly Kellmel ("Kellmel") bears directly on this newly created issue, justice dictates waiver of the rules.

As noted in MPEP 1208.01, "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." While it is not asserted by petitioner nor is it apparent from the record that the statutory ground for the rejection has changed, the record does suggest that the totality of the evidence surrounding the CPS petition to support the rejection has not remained unchanged; rather is has grown substantially with each Office communication.

That is, the CBS petition relied upon by the examiner has grown from an exhibit of 4 pages in the first Office action (see Appendix III of the Office action of) to an exhibit now subtending some 148 pages in the Answer. It thus seems, without deciding the issue, that the quantum of

evidence relied upon in support of the rejection has increased. As noted in In re Hilmer, 53 CCPA 1288, 1313, 359 F.2d 859, 879, 149 USPQ 480, 496 (CCPA 1966):

> Much confused thinking could be avoided by realizing that rejections are based on statutory provisions, not on references, and that the references merely supply the evidence of lack of novelty, obviousness, loss of right or whatever may be the ground of rejection.

As of the first Office action, the evidence provided by and from the CBS petition reference was but 5 pages; now it is 150 pages. On the other hand, the mere citation of new information after appeal has been taken does not *ipso facto* constitute a change in the evidence relied upon, such that a new grounds of rejection has been made. See In re Kronig, 539 F.2d 1300, 190 USPQ 425 (CCPA 1976); In re Ahlert, 424 F.2d 1088, 165 USPQ 418 (CCPA 1970); MPEP 1208.01. The issue is whether applicant has had a fair opportunity to react to the thrust of the rejection. Kronig, supra. Since the challenge raised by petitioner to the citation of the CBS Petition has remained substantially unchanged over time, it appears that petitioner has had that fair opportunity.

However, as the CBS petition now totals some 150 pages of citation, and in light of the examiner's first-time assertion in the Answer that such constitutes "a single complete publication", it is agreed that justice would be served by waiving the rules that would prohibit entry of the Kellmel declaration.

Petitioner should note, for future reference, that if he should feel that he has been subjected to a new ground of rejection, which has not been appropriately so designated, his remedy is a timely petition requesting supervisory review under 37 CFR 1.181, and not a belated petition under CFR 1.183 seeking to level the playing field. 37 CFR 1.183 is not a mechanism for avoiding the diligence requirement of 37 CFR 1.181(f).

This reexamination proceeding is being referred to the Technology Center for further action consistent with this decision.

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3217.

Brian Hearn

Brian Hearn
Petitions Examiner
Office of Petitions

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(For Patent Owner)

JAN 25 2005

Howard Grossman
Kenyon & Kenyon
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Kevin McMahon
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(For Requester)

Reexam Control No.: 90/006,801
Filed: October 6, 2003
For: U.S. Patent No. 6,216,030

Reexam Control No.: 90/007,168
Filed: August 10, 2004
For: U.S. Patent No. 6,216,030

DECISION MERGING REEXAMINATION PROCEEDINGS

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

Reexamination in application Control No. 90/006,801 was ordered in a decision mailed December 12, 2003. Prosecution progressed through to the filing of an amendment to the claims on June 28, 2004, which amendment was responsive to a non-final Office action mailed April 27, 2004.

Reexamination in application Control No. 90/007,168 was ordered in a decision mailed September 28, 2004. The Office has received no Patent Owner statement responsive to the order mailed September 28, 2004.

Merger is proper if a reexamination is ordered while a prior reexamination proceeding is pending (37 CFR 1.565(c)). In view of the above, merger is appropriate and is hereby ordered and will be conducted in accordance with the following guidelines and requirements.

Requirement for Same Claims in Both Proceedings

As noted above the claims have been amended in the '801 reexamination proceedings. The Patent Owner is required to maintain identical specifications, abstract, drawings, claims and claim numbering in both files. **Accordingly, Patent Owner is required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in both files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. All papers mailed by the Office will take the form of a single action, which applies to both proceedings. All papers issued by the Office or as filed by the Patent Owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the Patent Owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by Patent Owner must be served on Requester and Requester will be sent copies of all papers mailed by the Office. See 37 CFR 1.565 (d).

Dual Correspondence

Currently, Patent Owner appears to be represented by two different representatives. Under 37 CFR 1.33(a), the Office will not engage in double correspondence with more than one registered attorney or agent except as deemed necessary by the Commissioner. Accordingly, Patent Owner is hereby required to notify the Office who his single representative will be by filing the necessary papers in the appropriate files. The notification must be submitted within one month of the mailing date of this decision.

Conclusion

Reexamination Control Nos. 90/006,801 and 90/007,168 are hereby merged. **As stated above, Patent Owner has one month from the mailing date of this decision within which to submit a "housekeeping" amendment placing the same claims in both files and to name but a single representative.** Upon receipt of the response, an Office action will issue in due course.

Richard A. Bertsch

Richard A. Bertsch, Director
Technology Center 3700
Phone: (571) 272-3750

ak/01/20/05

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Paper No. IFW

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(Patent Owner)

Joel D. Myers, Intellectual Prop. Law
MYERS & KAPLAN
1827 Powers Ferry Road, Building 3, Suite 200
Atlanta, GA 30339

(Requester)

MAILED
APR 0 6 2006
REEXAM UNIT

In re Reeder et al.
Reexamination Proceeding
Control No. 90/006,802
Filed: October 8, 2003
For: U.S. Patent No. 5,980,667

: DECISION
: DISMISSING
: PETITION

The above-captioned reexamination proceeding is before the Office of Patent Legal Administration for decision on the patent owner's March 8, 2005 petition to continue the pending reexamination or initiate a second reexamination of U.S. Patent No. 5,980,667.

The petition is dismissed as moot, because it is not ripe for action.

REVIEW OF FACTS

1. U.S. Patent No. 5,980,667 issued on November 9, 1999.

2. A request for reexamination, assigned control No. 90/006,802, was filed by a third party requester on October 8, 2003.

3. Reexamination was ordered for the '6802 reexamination proceedings on December 18, 2003.

4. A non-final Office action was mailed on November 22, 2004.

5. A response from the patent owner to the non-final Office action was received on June 17, 2004.

6. A final Office action was mailed on September 27, 2005.

7. A response from the patent owner to the final Office action was received on December 1, 2005.

8. An advisory Office action was mailed on December 13, 2005.

9. The present petition was filed by the patent owner on March 8, 2005.

DECISION ON PETITION

The petition requests that the present reexamination continue or that an additional reexamination proceeding be initiated. The petition is not, however, ripe for a decision on the arguments raised in the petition, because the prosecution of the present reexamination proceeding has terminated.

Assuming that a one month extension of time was granted based on the December 1, 2005 response after final Office action, a response to the final Office action mailed September 27, 2005 was due by December 27, 2005. Neither a response, nor a request for extension of time, was received by that date. It is to be noted that, pursuant to 37 CFR 1.550(c), "[a]ny request for such extension must be filed on or before the day on which action by the patent owner is due." Accordingly, the reexamination prosecution is terminated for lack of an appropriate response within the requisite time period following the final Office action. 37 CFR 1.550(d).

Relief with respect to the prosecution of a proceeding cannot be granted in a terminated reexamination. Thus, the present petition is not ripe for a decision, and the third party requester request for continuation of the current reexamination is dismissed.

VENUE TO RESTORE PROCEEDING TO PENDING STATUS

Petitioner's attention is drawn to MPEP 2268 and 37 C.F.R. 1.137 for information on restoring a terminated reexamination prosecution to a pending status. Petitioner has the option to seek revival of the reexamination prosecution, pursuant to under 37 CFR 1.137, based on either unintentional or unavoidable delay.

A grantable petition for entry of belated papers under 37 CFR 1.137(b) must be accompanied by (1) the response required to the outstanding Office action or notice, unless previously filed; (2) the petition fee (set forth in 37 CFR 1.17(m)) required by law; and (3) a proper statement that the entire delay in filing the required response from the due date for the response until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

A grantable petition for entry of belated papers under 37 CFR 1.137(a) must be accompanied by (1) the response required to the outstanding Office action or notice, unless previously filed; (2) the petition fee (set forth in 37 CFR 1.17(l)) required by law; and (3) a showing to the satisfaction of the Director that the entire delay in filing the required response from the due date for the response until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable.

A proposed response to the final Office action mailed September 27, 2005 would be a Notice of Appeal. If the terminated reexamination prosecution is restored to a pending status, the patent owner may renew the petition to continue the pending reexamination at that point.

CONCLUSION

1. The request for continuing the '6802 reexamination, filed March 8, 2005, is dismissed.

2. Jurisdiction over the proceeding is being retained by the Office of Patent Legal Administration for ONE MONTH to await the submission of a petition to restore the terminated reexamination prosecution to a pending status. If no such petition is received within the month, jurisdiction will be forwarded to the examiner for conclusion of the proceeding.

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

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

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March 20, 2006

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(For Patent Owner)

MAILED

JUL 18 2006

CENTRAL REEXAMINATION UNIT

Joel D. Myers, Intellectual Prop. Law
MYERS & KAPLAN
1827 Powers Ferry Road, Building 3, Suite 200
Atlanta, GA 30339

(For Third Party Requester)

In re Reeder et al.	:	DECISION GRANTING
Reexamination Proceeding	:	PETITION FOR
Control No.: 90/006,802	:	CONTINUED
Filed: October 8, 2003	:	REEXAMINATION
For: U.S. Patent No. 5,980,667	:	(37 CFR 1.182)

This is a decision on patent owner's "Petition Under 37 CFR 1.182 For Relief Not Currently Provided, Requesting Continued Reexamination (RCR)" filed on April 19, 2006. [1] The petition is before the Office of Patent Legal Administration for decision.

FEES

The $400.00 petition fee under 37 CFR 1.17(f) for filing the present 37 CFR 1.182 petition was paid by check on March 8, 2006.

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 5,980,667 (the '667 patent) issued on November 9, 1999.

2. The present request for reexamination was filed by patent owner on October 8, 2003, was assigned control No. 90/006,802, and is hereinafter referred to as the '802 reexamination proceeding.

3. Reexamination was ordered in the '802 reexamination proceeding on December 18, 2003.

4. A patent owner's statement under 37 CFR 1.530 was not received in the '802 reexamination proceeding.

[1] This paper was not immediately associated with the Image File Wrapper (IFW), and patent owner submitted a copy of the paper on May 25, 2006.

5. A non-final Office action was mailed in the '802 reexamination proceeding on November 22, 2004.

6. A timely response by the patent owner to the non-final Office action was received in the Office on June 17, 2005, and was entered into the record. [2]

7. A final rejection was mailed in the '802 reexamination proceeding on September 27, 2005.

8. A timely proposed response by the patent owner to the final rejection was received in the Office on December 1. 2005.

9. An advisory action was mailed on December 13, 2005 refusing entry into the record of the December 1, 2005 proposed response after final rejection.

10. On March 8, 2006, a request for extension of time and a paper styled "Petition Under 37 CFR 1.182 For Relief Not Currently Provided, Requesting Continued Reexamination (RCR)" were filed by the patent owner.

11. On April 6, 2006, the March 8, 2006 petitions were dismissed on the grounds that the petition for extension of time was not timely filed, and the 37 CFR 1.182 petition was moot because the reexamination prosecution had been terminated for failure to file a proper response to the final rejection.

12. On April 19, 2006, patent owner filed the present 37 CFR 1.182 petition to continue the '802 reexamination prosecution notwithstanding that a final rejection has been promulgated and the '802 reexamination prosecution had been terminated by patent owner's failure to file a proper response to the final rejection. The present petition was accompanied by a notice of appeal under 37 CFR 41.31(b) and the appeal fee under 37 CFR 41.20(b)(1).

13. On April 19, 2006, patent owner also filed a petition under 37 CFR 1.137(b) to revive the terminated '802 reexamination prosecution, together with a copy of a previously filed petition for extension of time. The 37 CFR 1.137(b) petition and petition for extension of time are also pending before the Office of Patent Legal Administration. [3]

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[2] This response perfected a previously filed response to the non-final Office action that had been held to be informal.

[3] A decision on both the 37 CFR 1.137(b) petition to revive and the petition for extension of time is being mailed concurrently with the decision on the present 37 CFR 1.182 petition.

DECISION

The present petition under 37 CFR 1.182 requests relief in the form of continued examination in the '802 reexamination proceeding to the extent provided by, and in accordance with the terms of the "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While Earlier Filed Reexamination is Pending," published in the March 1, 2005 *Official Gazette* (hereinafter "the Notice").

The Notice announced a change in reexamination practice, whereby a party requesting reexamination of a patent could no longer obtain reexamination of a patent for which a pending reexamination had previously been ordered by requesting the second reexamination proceeding based upon the *same* substantial new question of patentability (SNQ) that had been raised in the pending reexamination proceeding. Rather, the second request for reexamination would have to demonstrate a different SNQ than had been demonstrated in the pending reexamination proceeding. Prior to the practice change announced in the Notice, if a patent owner filed an amendment and/or evidence after final rejection in a reexamination proceeding patent owner and entry of the material was refused, a patent owner could elect to file a second request for *ex parte* reexamination of a given patent in order to obtain entry of the amendment and/or evidence and base the second request for reexamination on the same SNQ that was relied upon in the pending first *ex parte* reexamination proceeding. Pursuant to the practice change set forth in the Notice, a patent owner could no longer rely upon the same SNQ to request a second reexamination proceeding. In order to provide relief for a patent owner to request entry of a amendment and/or evidence filed after final rejection, the Office made reference to a possible proposal for revision to the rules to provide for the filing of a request for continued reexamination (RCR). The contemplated RCR practice would, if implemented, enable a patent owner to, in appropriate circumstances, obtain a continuation of prosecution on the merits in an existing reexamination proceeding, to permit entry of an amendment and/or evidence that had been denied entry after a final rejection in the *ex parte* reexamination proceeding (or after an action closing prosecution in an *inter partes* reexamination proceeding). The Notice provided that until such time as rules provide for the filing of a RCR were put into place, a patent owner could file a petition under 37 CFR 1.182 to seek relief that is not currently provided by an existing rule, but that would be analogous to the contemplated continued reexamination (RCR) practice . Currently, the rules do not provide for a RCR practice.

The present patent owner 37 CFR 1.182 petition requests relief in the form of entry of an amendment attached to the petition, and also entry of a 37 CFR 1.132 declaration of Steven L. Reeder in support of patentability by reason of the commercial success of the claimed subject matter. In the present 37 CFR 1.182 petition, patent owner points out that the process of gathering the financial and sales data set forth in support of the showing in the Reeder declaration "has been non-trivial and extensive, thereby resulting (*sic*, impeding?) Applicant's ability to submit" the verified showing at an earlier date. [4] Patent owner further states the belief that the submission of the Reeder declaration "will advance the prosecution of the requested Continued Reexamination." [5]

Patent owner's petition is persuasive, and the requested relief will be granted to the extent set forth as follows:

1. The prosecution on the merits is hereby reopened in the '802 reexamination proceeding for the purpose of entering:

---

[4] "Petition Under 37 CFR 1.182 ...", page 2.
[5] *Id.*

a. The amendment filed on April 19, 2006, as attached to the present petition; and

b. The declaration of Steven L. Reeder, executed on February 24, 2006, as attached to the present petition.

2. The examiner will reconsider patentability of the claims, as amended, in light of the Reeder declaration, and will promulgate an Office action reflecting that consideration.

3. The examiner's reconsideration will be conducted with special dispatch in accordance with 35 U.S.C. § 305.

4. If the next Office action does not result in confirmation/allowance of all of the pending claims, but instead includes a rejection of one or more of the pending claims, the Office action will be made final, unless:

   a. The Office action relies upon one or more newly applied prior patents or printed publications, and such reliance was not necessitated by the amendment and/or the Reeder declaration; or

   b. The Office action relies upon one or more newly applied prior patents or printed publications submitted by patent owner, for which the patent owner has demonstrated that such documents were not available to patent owner such that they could have been earlier submitted.

CONCLUSION

1. The petition under 37 CFR 1.182 is granted.

2. The prosecution of the present '802 reexamination proceeding is continued.

3. The finality of the September 27, 2005 Office action is withdrawn, and prosecution of the proceeding is reopened to the extent that the response submitted with the petition under 37 CFR 1.182 will be addressed and treated as a response received after a first, non-final Office action.

4. The amendment filed with the present petition, and the Reeder 37 CFR 1.132 declaration, will be entered by the Central Reexamination Unit, and then considered by the examiner.

5. Any further relief via a Request for Continued Reexamination is barred, absent a showing of an extraordinary situation where justice requires further such relief.

6. A decision granting the April 19, 2006 petition to accept the delayed filing of the appeal brief is being mailed concurrently with the present decision.

7. Jurisdiction over the present '802 reexamination proceeding is being forwarded to the Central Reexamination Unit for further handling and examination not inconsistent with this decision.

8. Any further communications as to the merits of the reexamination proceeding should be directed to Central Reexamination Special Program Examiner Deborah Jones at (571) 272-1535.

9. Telephone inquiries related to this 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

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July 11, 2006

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July 14, 2006

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(For Patent Owner)

MAILED

JUL 18 2006

CENTRAL REEXAMINATION UNIT

Joel D. Myers, Intellectual Prop. Law
MYERS & KAPLAN
1827 Powers Ferry Road, Building 3, Suite 200
Atlanta, GA 30339

(For Third Party Requester)

In re Reeder et al.	:	DECISION
Reexamination Proceeding	:	GRANTING
Control No.: 90/006,802	:	PETITION
Filed: October 8, 2003	:	TO REVIVE
For: U.S. Patent No. 5,980,667	:	(37 CFR 1.137(b))

This is a decision on patent owner's "Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b)" filed on April 19, 2006. [1] This is also a decision on the concurrently filed patent owner Petition under 37 CFR 1.550(c) and 35 U.S.C. § 41(a)(7) Requesting Extension of Time." [2] The petitions are before the Office of Patent Legal Administration for decision.

FEES

The $750.00 small entity fee for the present petition to revive has been charged to the patent owner's Deposit Account No. 23-1951 as requested by patent owner. The $250.00 small entity fee for filing the Notice of Appeal that accompanied the present petition to revive has also previously been charged to patent owner's Deposit Account. The fee for the petition for extension of time was paid on February 27, 2006.

[1] This paper was not immediately associated with the Image File Wrapper (IFW), and patent owner submitted a copy of the paper on May 25, 2006.

[2] The petition for extension of time is a copy of a petition for extension of time previously filed on March 8, 2006 that was addressed as part of the "Decision Dismissing Petition" dated April 6, 2006.

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 5,980,667 (the '667 patent) issued on November 9, 1999.

2. The present request for reexamination was filed by patent owner on October 8, 2003, was assigned control No. 90/006,802, and is hereinafter referred to as the '802 reexamination proceeding.

3. Reexamination was ordered in the '802 reexamination proceeding on December 18, 2003.

4. A patent owner's statement under 37 CFR 1.530 was not received in the '802 reexamination proceeding.

5. A non-final Office action was mailed in the '802 reexamination proceeding on November 22, 2004.

6. A timely response by the patent owner to the non-final Office action was received in the Office on June 17, 2005, and was entered into the record.[3]

7. A final rejection was mailed in the '802 reexamination proceeding on September 27, 2005.

8. A timely proposed response by the patent owner to the final rejection was received in the Office on December 1. 2005.

9. An advisory action was mailed on December 13, 2005 refusing entry into the record of the December 1, 2005 proposed response after final rejection.

10. On March 8, 2006, a request for extension of time and a paper styled "Petition Under 37 CFR 1.182 For Relief Not Currently Provided, Requesting Continued Reexamination (RCR)" were filed by the patent owner.

11. On April 6, 2006, the March 8, 2006 petitions were dismissed on the grounds that the petition for extension of time was not timely filed, and the 37 CFR 1.182 petition was moot because the reexamination prosecution had been terminated for failure to file a proper response to the final rejection.

12. On April 19, 2006, patent owner filed the present petition to revive the '802 reexamination proceeding under 37 CFR 1.137(b) together with a copy of a previously filed petition for extension of time.

13. On April 19, 2006, patent owner also filed petition under 37 CFR 1.182 requesting continued reexamination pursuant to the "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While Earlier Filed Reexamination is Pending," published in the March 1, 2005 *Official Gazette*. The 37 CFR 1.182 petition is also pending before the Office of Patent Legal Administration. [4]

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[3] This response perfected a previously filed response to the non-final Office action that had been held to be informal.
[4] A decision on the 37 CFR 1.182 petition is being mailed concurrently with the decision on the present 37 CFR 1.137 petition to revive.

DECISION

I. Petition To Revive

A grantable petition under 37 CFR 1.137(b) must be accompanied by:

(1) The reply [5] required to the outstanding Office action or notice, unless previously filed;

(2) The petition fee as set forth in 37 CFR 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 satisfied items (1)-(3).

Specifically, the filing of a notice of appeal constitutes a proper response ("reply") to the outstanding final rejection. See 37 CFR 1.113, which is applicable to reexamination proceedings in accordance with 37 CFR 1.550(a). Therefore item (1) is satisfied.

The petition fee and the appeal fee have previously been charged to petitioner patent owner's Deposit Account on April 19, 2006. Therefore, item (2) is satisfied.

With respect to item (3), the statement on page 2 of the present petition to revive satisfies the regulation.

II. Petition For Extension Of Time

The petition for extension of time is considered to be moot. The petition was previously considered and dismissed as being moot in the "Decision Dismissing Petition" dated April 6, 2006 on the grounds that it is not possible to secure an extension of time in a proceeding that is terminated. Patent owner should note that where a proceeding is revived under 37 CFR 1.137 pursuant to the grant of a petition to revive, there is no necessity that an extension of time for filing a response be filed or granted. A petition to revive requires that the response to the previous Office action be filed as part of the showing required by the petition to revive. See 37 CFR 1.137(b) and Section II, *infra*. Therefore, patent owner should, in the future, avoid submission of a petition for extension of time if the filing a petition to revive should become necessary.

[5] For reexamination proceedings, the word "reply" is to be replaced by "response." See 37 CFR 1.550(d) and (e)(2)

CONCLUSION

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

2. The petition for extension of time is dismissed as being moot.

3. Jurisdiction over the present reexamination proceeding is being returned to the examiner.

4. Any further communications as to the merits of the reexamination proceeding should be directed to Central Reexamination Special Program Examiner Deborah Jones at (571) 272-1535.

5. Telephone inquiries related to this 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.

6. The concurrently filed 37 CFR 1.182 petition for continued reexamination in the '802 reexamination proceeding is being addressed in a separate decision mailed on even date with this decision.

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

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July 12 2006

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CENTRAL REEXAMINATION UNIT

JOEL D. MYERS, ESQ.
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SUITE 1400
ATLANTA, GA 30339

In re Application of	:	
REEDER et al.	:	
Control No. 90/006,802 (U.S. Patent 5,980,667)	:	DECISION ON PETITION
Filed: October 08, 2003	:	TO WITHDRAW
Attorney Docket No. 22480-M1	:	FROM RECORD
	:	

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed October 10, 2008.

The request is **APPROVED**.

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

The request was signed by Joel D. Myers on behalf of all attorneys of record who are associated with Customer No. 30184. All attorneys/agents associated with Customer No. 30184 have been withdrawn.

All future communications from the Office will be directed to the *Ex Parte* Requester at the first copied address below until otherwise properly notified.

Telephone inquiries concerning this decision should be directed to Patricia Volpe at 571-272-6825.

Patricia Volpe for

Deborah Jones
Supervisory Patent Examiner
CRU 3991

cc: **THOMAS L. COLLINS**
COLLINS CUSTOM MILLWORK
1 JOHNSON STREET, SUITE 106
CARTERSVILLE, GA 30120

cc: **DUANE MORRIS LLP – Atlanta** (Patent Owner)
IP DEPARTMENT
ATLANTIC CENTER PLAZA
1180 WEST PEACHTREE STREET, NW SUITE 700
ATLANTA GA 30309-3348

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on October 10, 2008. There is no indication it was served on the Patent Owner.

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Mirut Dalal
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500 West Madison-Suite 3400
Chicago, IL 60661

(For Patent Owner)

MAILED
FEB 02 2006
REEXAM UNIT

In re Mark Slamowitz et al.
Reexamination Proceeding
Control No.: 90/006,803
Filed: October 8, 2003
For: U.S. Patent No.: 6,519,204

: **DECISION**
: **DISMISSING**
: **PETITION**

This is a decision on the November 9, 2005, patent owner petition entitled PETITION TO REVIVE REEXAMINATION PROCEEDING UNDER 37 CFR §§ 1.137(b), 1.958(b)

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

The petition is dismissed for the reasons set forth below.

Any request for reconsideration of this decision must be submitted within ONE (1) MONTH from the mail date of this decision. An extension of time may be requested only under 37 CFR 1.550(c); extensions of time under 37 CFR 1.136 are not available in reexamination proceedings. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)."

DECISION

A grantable petition for entry of belated papers under 37 CFR 1.137(b) must be accompanied by (1) the response required to the outstanding Office action or notice, unless previously filed; (2) the petition fee as set forth in 1.17(m); and (3) a proper statement that the entire delay in filing the required response, from the due date for the response until filing of a grantable petition pursuant to 37 CFR 1.137(b), was unintentional.

Items (2) and (3) of 37 CFR 1.137(b) have been satisfied, as the appropriate petition fee and the requisite statement of delay have been provided.

Item (1) of 37 CFR 1.137(b) has not been complied with, because the Appeal Brief accompanying the present petition is defective. The following defects in the Appeal Brief are pointed out:

1) On page 3, under the heading "Status of the Amendments," appellant patent owner states that there are no amendments pending in the present application. The record

shows an after-final amendment, filed 2/7/05, which was denied entry. See Advisory, mailed 4/1/05. According to MPEP page 1200-14, column 1, item (iv), this section includes the status of <u>any</u> amendment filed subsequent to final rejection.

2) On page 3, the heading "Summary of the Invention" should be --Summary of Claimed Subject Matter--. See MPEP page 1200-14, column 1, item (v). See also 37 CFR 41.37(c)(1).

3) On pages 5-18, the claimed subject matter does not refer to the drawing by reference characters, if any. For example, on page 6, with reference to claim 8, the "two NFet transistors" are not referenced with reference characters in Figs. 8-9. See MPEP page 1200-14, column 1, item (v).

4) On page 8, the heading "Issues for Review" should be --Grounds of Rejection to be Reviewed on Appeal--. See MPEP page 1200-14, column 2, item (vi). See also 37 CFR 41.37(c)(1).

5) On page 8, under the heading "Grouping of Claims," appellant did not state that all the claims stand or fall together. See MPEP page 1200-15, column 1.

6) On page 13, the heading "Appendix" should be --Claims Appendix--. See MPEP page 1200-15, column 1, item (viii). See also 37 CFR 41.37(c)(1).

7) On page 13, claim 1 which is presented is that of the "after-final" amendment, which was denied entry, and, therefore, is not the latest entered or admitted version of the amendment. According to MPEP page 1200-15, column 2, the rule prohibits the inclusion in a brief of any new or non-admitted amendment, affidavit or other evidence.

8) A heading "Evidence Appendix" with the indication "none" on a new page is missing. See MPEP page 1200-15, column 2, item (ix). See also 37 CFR 41.37(c)(1).

9) A heading "Related Proceedings Appendix" with the indication "none" on a new page is missing. See MPEP page 1200-15, column 2, item (x). See also 37 CFR 41.37(c)(1).

In order for the petition to be grantable, the proper response must be submitted with a renewed petition. In the present case, an Appeal Brief complying with 37 CFR 41.37 must be submitted.

CONCLUSION

1. The petition under 37 CFR 1.137(b) is **<u>dismissed</u>**.

2. For granting of the present petition, it is required that patent owner file a submission that provides the proper response to the final rejection dated December 6, 2004.

3. If petitioner desires to make the required submission in order that the present petition be granted, the submission should be included in a cover letter entitled **"Renewed Petition under 37 CFR 1.137(b)."**

4. Any renewed petition must be filed within **ONE (1) MONTH** of the mail date of this decision. An extension of time **to file a renewed petition** may be requested only under 37 CFR 1.1550(c); extensions of time under 37 CFR 1.136 are **not** available in reexamination proceedings.

5. All correspondence relating to the petition in this *ex parte* reexamination proceeding should be directed to:

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
Attention: Central Reexamination Unit
Randolph Building
401 Dulany St.
Alexandria, VA 22314

6. Telephone inquiries related to this decision should be directed to Mary C. Till, Legal Advisor, at (571) 272-7755.

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

S://OPLA/General Duties/Reexamination/Decisions/6803_dism_unint-2-2-06

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MAR 21 2006

REEXAM UNIT

Mirut Dahl (For Patent Owner)
McAndrews, Held & Malloy, Ltd.
500 West Madison-Suite 3400
Chicago, IL 60661

In re Reexamination Proceeding	:
Mark Slamowitz et al.	:
Control No. 90/006,803	: DECISION GRANTING
Filed: October 8, 2003	: REQUEST FOR RECONSIDERATION
U.S. Patent No. 6,519,204	:
Attorney Docket No. 13151US02	:

This is a decision on the renewed petition under 37 CFR 1.137(b) filed by the patent owner on March 2, 2006, for entry of late papers based upon unintentional delay, in response to the Decision mailed February 2, 2006, in the above-identified application.

The renewed 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 renewed petition under 37 CFR 1.137(b) includes the requisite response (Appeal Brief) (item 1). The petition fee (item 2) and the requisite statement (item 3) were previously supplied with the November 9, 2005 petition.

The renewed petition for entry of the late papers is granted.

Jurisdiction over the reexamination proceeding is being returned to Technology Center Art Unit 2824 for further examination and consideration of the Appeal Brief filed March 2, 2006, along with the renewed present petition, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Jung (John) Hur, in Technology Center Art Unit 2824, who can be reached at 571-272-1870.

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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Paper No. 25
Mailed: February 11, 2004

JONES DAY
222 EAST 41ST STREET
NEW YORK NY 10017

In re Gelfand et al Reexamination Proceeding Control No.: 90/006,184 Filed: January 10, 2002 For: U.S.Patent No. 4,889,818	DECISION MERGING REEXAMINATION PROCEEDINGS
In re Gelfand et al Reexamination Proceeding Control No.: 90/006,805 Filed: October 9, 2003 For: U.S.Patent No. 4,889,818	

The above noted reexamination files are before the director of Technology Center 1600 for consideration of merger of the proceedings under 37 CFR 1.656(c).

BACKGROUND

1. Patent No. 4,889,818 issued December 26, 1989.

2. A first request for reexamination, Control No. 90/006,184, was filed by patent owner on January 10, 2002.

3. Reexamination was ordered in the '184 reexamination proceeding on April 4, 2002.

4. A second request for reexamination, Control No. 90/006,805, was filed by patent owner on October 9, 2003.

5. Reexamination was ordered in the '805 reexamination proceeding on December 22, 2003.

DISCUSSION

Under 37 CFR 1.565(c):

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

As noted in the above review of facts, reexamination has been ordered in both of the above noted reexamination proceedings. Accordingly, merger of the proceedings under 37 CFR 1.565(c) is appropriate.

DECISION

Merger of Proceedings.

In accordance with 37 CFR 1.565(c), the '184 and '805 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

Requirement for Same Amendments in Both Proceedings.

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

Conduct of Merged Proceeding.

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

CONCLUSION

Reexamination Control Nos. 90/006,184 and 90/006,805 are merged.

Bruce M. Kisliuk
Director, Technology Center 1600

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Stetina Brunda Garred & Brucker
75 Enterprise, Suite 250
Aliso Viejo, CA 92656

(For Patent Owner)

APR 19 2004

William P. Christie
Christie, Parker & Hale, LLP
P.O. Box 7068
Pasadena, CA 91109-7068

(For Requester)

Reexam Control No.: 90/006,809 Filed: October 14, 2003 For: U.S. Patent No. 6,443,929	:	DECISION MERGING REEXAMINATION PROCEEDINGS
Reexam Control No.: 90/006,842 Filed: November 4, 2003 For: U.S. Patent No. 6,443,929	:	

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

Reexamination in application Control No. 90/006,809 was ordered in a decision mailed December 12, 2003. On February 11, 2004, Patent Owner filed a statement under 37 CFR 1.530. The statement included an amendment to the claims.

Reexamination in application Control No. 90/006,842 was ordered in a decision mailed December 12, 2003. On February 11, 2004, Patent Owner filed a statement under 37 CFR 1.530. the Statement included an amendment to the claims. On April 12, 2004, third party Requester filed a reply under 37 CFR 1.535.

Merger is proper if a reexamination is ordered while a prior reexamination proceeding is pending. In view of the above, merger is appropriate and is hereby ordered.

Requirement for Same Claims in Both Proceedings

The Patent Owner is required to maintain identical specifications, abstract, claims and claim numbering in both files. In view of the fact that both reexamination applications contain identical specifications, drawings, and claims, no amendment is required.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. All papers mailed by the Office will take the form of a single action, which applies to both proceedings. All papers issued by the Office or as filed by the Patent Owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the Patent Owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by Patent Owner must be served on Requester and Requester will be sent copies of all papers mailed by the Office. See 37 CFR 1.565 (d).

Conclusion

Reexamination Control Nos. 90/006,809 and 90/006,842 are hereby merged. At this time there is no further action required by Patent Owner. These proceedings will be forwarded to the Examiner for an action on the merits.

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

ak/4/16/04

mas

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Raiford A. Blackstone, Jr. (For Patent Owner)
Trexler, Bushnell, Giangiorgi, Blackstone & Marr, Ltd.
105 West Adams Street, Suite 3600
Chicago IL 60603

MAILED

OCT 19 2006

CENTRAL REEXAMINATION UNIT

In re Reexamination Proceeding	:
Smith et al	:
Control No. 90/006,810	: DECISION GRANTING PETITION
Filed: October 16, 2003	:
U.S. Patent No. 5,266,855	:
Attorney Docket No. 1170/40483/RAB	:

This is a decision on the petition under 37 CFR 1.10(e) filed October 4, 2006, requesting that a Petition To The Director be accorded a filing date of April 21, 2006, the date it was deposited in Express Mail service.

On October 4, 2006, the present petition, including an authorization to charge counsel's deposit account for any needed petition fee, was filed. Petitioner argues that a Petition To The Director was deposited in Express Mail service on April 21, 2006. As evidence thereof, the following documents were filed along with the present petition: a copy of the Petition To The Director including an Express Mail label number thereon (Exhibit A); a copy of a postcard receipt acknowledging receipt on April 21, 2006 of, *inter alia*, a Petition To The Director and a $400.00 check for the petition fee (Exhibit B); an Express Mail label showing a "Date-In" of April 21, 2006, wherein the Express Mail label number matches the Express Mail number on Exhibit A (Exhibit C); a copy of both sides of a check for $400.00 for the Petition To The Director's petition fee (Exhibit D); and Declarations of Amy Lazzari and Yvonne Sullivan (Exhibits E and F).

Upon review of the record, no Petition To The Director deposited in Express Mail service on April 21, 2006, has been located among the papers in the Image File Wrapper for the present proceeding. A review of the Office finance records for the present proceeding reveals that the $400.00 petition fee for the Petition To The Director was paid on April 24, 2006.

In view of the above, the evidence is convincing that a communication filed on April 21, 2006, included a Petition To The Director, which was subsequently misplaced in the Office.

In view of the above, the petition is **GRANTED**. The copy of the Petition To The Director (Exhibit A) submitted with the present petition will be scanned into the Image File Wrapper. No petition fee is required for the present petition and none has been charged to counsel's deposit account.

Jurisdiction over the reexamination proceeding is being returned to Technology Center 2800 for consideration of Petition To The Director filed April 21, 2006 (wherein the $400.00 petition fee was paid on April 24, 2006), in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Karl Tamai, in Technology Center Art Unit 2834, who can be reached at 571-272-2036.

Telephone inquiries related to this decision should be directed to Fred A. Silverberg at 571-272-7719.

Fred A. Silverberg

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

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FEB 29 2008

In re Application of 5266855	:	
Appl. No.: 90/006,810	:	**PETITION TO CONSIDER**
Filed: October 16, 2003	:	**AMENDMENTS AFTER**
For: ELECTRIC MOTOR FOR CLOTHES WASHING	:	**FINAL**
MACHINE DRIVE	:	*37 CFR 1.181*
	:	
	:	
	:	

This decision is in response to appellants' petition filed 6/18/07 to reverse the holding of the examiner of record with respect to the refusal to enter amendments and consider evidence filed after a final rejection on 1/23/06.

Appellants' petition is DENIED.

In the aforementioned petition, appellants raise three issues: First, was the examiner's treatment of the amendment filed 1/23/06 as being filed after appeal proper? Second, was the examiner's refusal to consider evidence submitted 1/23/06 improper? Third, was the examiner's refusal to consider and enter amendments filed 1/23/06 proper?

A review of the record indicates, with respect to appellants' first point that the examiner's response mailed 5/22/07 indicated that it was after an appeal brief was filed, that appellants are correct. Inasmuch as the advisory was directed to appellants' filings prior to their appeal brief filing of 4/21/06, the response should have been treated as an amendment before appeal. Nevertheless, the examiner's 5/22/07 consideration of the amendment was consistent with after final practice before filing an appeal. Therefore, appellants' argument with respect to the first point is unpersuasive.

In terms of appellants' second point, that the examiner should have responded to the evidence presented on 1/23/06 in the form of two affidavits under 37 CFR 1.132, the appellants are correct. The examiner's initial advisory action, mailed 2/23/06, should have included a response to the merits of the affidavits, as they were, in fact, timely, being filed as a first response to a new grounds of rejection in a final office action. A review of the record indicates that the examiner subsequently addressed the merits of the affidavits in the examiner's answer mailed 9/15/06, as noted in the advisory action of 5/22/07. Therefore, since appellants' 37 CFR 1.132 evidence was eventually considered, the argument is considered moot.

Finally, with respect to the examiner's refusal to consider appellants' amendments filed 1/23/06 after final rejection, a review of the record indicates that the changes to the claims were

substantial enough to warrant further consideration and/or search, thus providing ample basis for non-entry. For example, comparing appellants' claim 1 as filed 4/18/05, and acted on in the final rejection of 12/23/05, to claim 1 as filed in the after final response of 1/23/06, it is clear that significant changes have been made. Additionally, new claims 98-101 in the amendment after final of 1/23/06 recite previously unclaimed subject matter. Therefore, the examiner's decisions, to deny entry of the amendments filed 1/23/06, in the advisory actions of 2/23/06 and 5/22/07, was proper.

Inquiries concerning this decision should be directed to Supervisory Patent Examiner Darren Schuberg at (571) 272-2044.

This application is being returned to the BPAI for their consideration of the pending appeal.

Sharon Gibson
Director
Technology Center 2800

KNOBBE MARTENS OLSON & BEAR LLP
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IRVINE, CA 92614

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MAR 17 2008

CENTRAL REEXAMINATION UNIT

KNOBBE MARTENS OLSON & BEAR LLP (For Patent Owner)
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE CA 92614

In re Reexamination Proceeding	:
D. Smith et al.	:
Control No. 90/006,810	: DECISION GRANTING PETITION
Filed: October 16, 2004	:
U.S. Patent No. 5,266,855	:
Attorney Docket No. FSHPY.20DDCCRX	:

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on March 4, 2008, 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, in part:

> "*Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by: (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in § 1.17(m); (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional ...."

The present petition under 37 CFR 1.137(b) includes, inter alia, an authorization to charge counsel's deposit account for the $1,540.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3). The requisite response (applicant's summary of interview - item 1) was previously filed on March 3, 2008.

The petition for entry of the late papers is granted.

$1,540.00 has been charged to counsel's deposit account no. 11-1410 in accordance with the present petition.

Jurisdiction over the reexamination proceeding is being returned to Technology Center Art Unit 2834 for further examination and consideration of the applicant's summary of interview filed March 3, 2008, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, K. Tamai, in CRU Art Unit 2834, who can be reached at 571-272-2036.

Telephone inquiries related to this decision should be directed to Fred A. Silverberg at 571-272-7719.

Fred A. Silverberg

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,810	10/16/2003	5266855	FSHPY.20DDCCRX	9421

20995 7590 07/22/2008

KNOBBE MARTENS OLSON & BEAR LLP
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IRVINE, CA 92614

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/22/2008

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

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CENTRAL REEXAMINATION UNIT

Knobbe, Martens, Olson & Gear LLP
2040 Main Street, 14th Flr
Irvine, CA 92614

(For Patent Owner)

In re Reexamination Proceeding
D. Smith et al.
Control No.: 90/006,810
Filed: October 16, 2004
For: U.S. Patent No.: 5,266,855

: DECISION ON PETITION
: TO CONTINUE
: *EX PARTE*
: REEXAMINATION
: PROCEEDINGS

This is a decision on the May 5, 2008 patent owner petition under 37 CFR 1.182 or 1.183 requesting continued reexamination in the present proceeding.

The petition is before the Office of Patent Legal Administration.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182 has been charged to Deposit account No. 11-1410.

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

REVIEW OF THE FACTS

1. On November 30, 1993, U.S. Patent 5,266,855 (the '855 patent) issued to Smith et al.

2. On October 16, 2003, a request for *ex parte* reexamination of the '855 patent was filed by patent owner. The resulting reexamination proceeding was assigned control number 90/006,810 (the '6810 proceeding).

3. On January 7, 2004, an order granting the'6810 *ex parte* reexamination request was mailed.

4. On March 17, 2005, the Office issued a first Office action on the merits rejecting claims as unpatentable over (1) Forbes in view of Grebe; (2) Forbes in view of Grebe and Taguchi; and (3) Forbes in view of Grebe and Lieata.

5. On April 18, 2005 patent owner filed a response amending all the claims, adding new claims and providing evidence and remarks alleging patentability over the art of record.

6. On December 23, 2005, a final Office action was issued in the '6810 proceeding, which included for the first time the van der Heide reference in all the rejections record.

7. On January 23, 2006, patent owner filed an after-final amendment and affidavit evidence in the '6810 proceeding.

8. On February 21, 2006, patent owner filed a notice of appeal in the '6810 proceeding.

9. On February 23, 2006, an advisory action issued in the '6810 proceeding denying entry of the January 23, 2006 after-final amendment.

10. On April 21, 2006, patent owner filed an appeal brief in the '6810 proceeding.

11. On September 15, 2006, an examiner's answer was issued in the '6810 proceeding.

12. On October 4, 2006, patent owner filed a petition under 37 CFR 1.10(e) alleging that a petition was filed on April 21, 2006 requesting review of the February 23, 2006 decision to deny entry of the January 23, 2006 after-final amendment in the '6810 proceeding.

13. On October 19, 2006, the Office issued a decision granting the October 4, 2006 petition under 37 CFR 1.10(e) and returned jurisdiction to the Technology Center to decide the April 21, 2006 petition in the '6810 proceeding.

14. On November 15, 2006, patent owner filed a reply brief in response to the September 15, 2006 examiner's answer in the '6810 proceeding.

15. On May 22, 2007, a second advisory action was issued denying entry of the January 23, 2006 after-final amendment.

16. On June 18, 2007, patent owner filed a petition requesting review of the May 22, 2007 decision to deny entry of the January 23, 2006 after-final amendment in the '6810 proceeding.

17. On November 2, 2007, jurisdiction over the proceeding was transferred to the Board of Patent Appeals and Interferences (BPAI).

18. On November 7, 2007, the BPAI returned jurisdiction over the '6810 proceeding to the examiner for consideration of the outstanding June 18, 2007 petition filed by the patent owner.

19. On January 30, 2008, the Office issued an interview summary reflecting that patent owner's counsel conducted an *ex parte* reexamination interview on January 29, 2008.

20. On February 29, 2008, the Technology Center Director issued a decision denying patent owner's June 18, 2007 petition, determining that the examiner's February 23, 2006 and May 22, 2007 denials of entry of the January 26, 2006 amendment where both proper and returned jurisdiction of the '6810 proceeding to the BPAI.

21. On March 3, 2008, patent owner filed a summary of the January 29, 2008 interview conducted in the '6810 proceeding.

22. On March 4, 2008, patent owner filed a petition to revive the '6810 proceeding due to a failure to timely file an interview summary in the '6810 reexamination proceeding.

23. On March 17, 2008, the Office issued a decision granting patent owner's March 4, 2008 petition to revive.

24. On March 20, 2008, patent owner filed a reissue application for the '855 patent, which was assigned application number 12/052,582 (the '582 reissue application). Concurrently, patent owner filed a request for merger of the reissue application with the '6810 reexamination proceeding.

25. On April 22, 2008, a notice of the filing of a reissue application was published in the *Official Gazette* for the present reissue application.

26. On May 5, 2008, patent owner filed a petition under 37 CFR 1.182 or 1.183 requesting continued reexamination in the '6810 proceeding, which petition is the subject of this decision. Concurrently, patent owner filed a paper styled as a response to the December 23, 2005 Final Office Action issued by the Office in '6810 reexamination proceeding.

27. On May 15, 2008, the Office issued a decision declining to merge the '582 reissue application with the '6810 reexamination proceeding and suspending the '582 reissue application until the '6810 reexamination proceeding is concluded.

DECISION ON PETITION UNDER 37 CFR 1.182

In the present petition, it is requested that the Office continue the prosecution of the '6810 reexamination proceeding to provide consideration of the paper styled as a response to the December 23, 2005 Final Office Action which accompanied the instant petition.

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending." [1] Notice was provided therein that a second (or subsequent) reexamination would no longer be ordered on the basis of a "substantial new question of patentability" (SNQ) that is the same as a SNQ raised in an earlier pending reexamination. Notice was also provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding. By filing such a petition, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the

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

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

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

Based on the facts and circumstances of the present case, Petitioner patent owner's response in the form of an amendment and remarks/arguments is not found to be a *bona fide* effort to advance prosecution and as such, the granting of the present petition is inconsistent with the requirement of 35 USC 305 to conduct *ex parte* reexamination proceedings "with special dispatch within the Office."

Petitioner presents three arguments to justify the granting of the extraordinary relief of request for continued reexamination: (1) An alleged substantial change in the case law regarding obviousness rejections under 35 U.S.C. 103;[2] (2) The examiner's use of the Van der Heide reference in all the rejections of the claims; and (3) The existence of a request for merger in a newly filed application for the reissue of the '855 patent currently under reexamination in the present '6810 proceeding.

Petitioner's first argument, that a continuation of the reexamination prosecution should be granted due to clarification of the legal standard for unpatentability based on 35 U.S.C. 103 because the '6810 proceeding was briefed, is not persuasive. The instant proposed response adds new claims 98 – 101, and it has not been shown that all of these claims are directed to the clarification of the legal standard for unpatentability based on 35 U.S.C. 103, and how they are so directed. Also, the argument is not relevant to the issue of granting continued reexamination, which is a form of equitable relief, and which is not for the purpose of re-briefing a reexamination proceeding before the BPAI takes up a case for decision. While the rules do not provide for a party to request a supplemental brief due to a change in the law, an alternative exists – that of filing a petition to request the relief of supplemental briefing due to a clarification in the law. Additionally, petitioner has the ability to address any changes in the law either at oral

[2] Presumably petitioner is referring to *KSR International Co. v. Teleflex Inc.*, 550 U.S. , 82 USPQ2d 1385 (2007), however as no case is cited it is uncertain as to what case(s) petitioner is referring to when the assert the existence of substantial changes in the case law.

hearing[3] or in a request for rehearing.[4] The present extensive amendment is not called for in this instance, and is not directed to providing a *bona fide* effort to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate.

Petitioner's second argument, that continued reexamination should be granted to address the new substantial question of patentability based on the examiner's use of the Van der Heide, is not persuasive. The examiner's use of an additional reference that was not previously made of record may constitute merit to the grant of a continued reexamination. However, any response by petitioner accompanying a request for continued reexamination must ONLY address the newly presented and unforeseeable use of the new reference. As pointed out above, the instant proposed response adds new claims 98 – 101. This presentation of new claims which require new examination for patentability matters in the accompanying response is inappropriate, as examination of the new claims would complicate and delay reexamination with respect to the inclusion of new claims that are unrelated to the unforeseeable use of a new reference in the final Office action. Thus the proposed response runs contrary to the statutory mandate of "special dispatch." Moreover, in this instance, petitioner was free to petition the propriety of the final rejection, based on the newly added reference. Likewise, petitioner was free to seasonably follow up on its June 18, 2007 petition requesting review of the May 22, 2007 decision to deny entry of the January 23, 2006 after-final amendment, to further petition the Technology Center Director's decision to the next level in the Office, and ultimately to the court. Petitioner was also free to request that the Technology Center Director retain jurisdiction over the proceeding pending decision of its petition, prior to issue of any decision on applicant's brief. Petitioner chose not to avail itself of these options, but instead waited until the examiner's answer was written and forwarded to the BPAI to file the present request for continued reexamination. This action runs counter to the statutory mandate for special dispatch, and does not represent a *bona fide* effort to advance prosecution.

Petitioner's third argument, that for the sake of efficiency continued reexamination should be granted in light of the existence of a reissue application, with merger of the reissue application with the '6810 proceeding, is not persuasive. The record of the '582 reissue application reflects that a determination was made denying the request for merger and staying the '582 reissue application, thus rendering petitioner's argument moot. Additionally the substance of the decision denying merger and staying the '582 reissue application reflects that the mandate of special dispatch is best served by moving forward with the '6810 reexamination proceeding's appeal and not merging the two proceedings to address the same issues anew in a merged proceeding. Therefore, the argument is not persuasive.

In view of the above and the fact situation presented by the record, the petition is <u>dismissed</u>, and jurisdiction of the proceeding is returned to the BPAI to address the appeal.

---

[3] See 37 CFR 41.47(e) (2) Upon a showing of good cause, appellant and/or the primary examiner may rely on a new argument based upon a recent relevant decision of either the Board or a Federal Court.

[4] See 37 CFR 41.52(a) (2) Upon a showing of good cause, appellant may present a new argument based upon a recent relevant decision of either the Board or a Federal Court.

CONCLUSION

1. The petition under 37 CFR 1.182 is dismissed.

2. The '6810 *ex-parte* reexamination proceeding will continued in the appeal process.

3. Jurisdiction for the '6810 reexamination proceeding is returned to the Board of Patent Appeals and Interferences (BPAI).

4. Telephone inquiries related to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759, or in his absence, the undersigned at (571) 272-7710.

Kenneth Schor,
Senior Legal Advisor
Office of Patent Legal Administration

July 21, 2008
C:\Kiva\Kenpet7\RCR\ 6810_RCR dismiss-after-exr-ans+amdt-entry-petition-was denied.doc

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,810	10/16/2003	5266855	FSHPY.20DDCCRX	9421

20995 7590 09/04/2008

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/04/2008

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CENTRAL REEXAMINATION UNIT

Knobbe, Martens, Olson & Gear LLP
2040 Main Street, 14th Flr
Irvine, CA 92614

(For Patent Owner)

In re Reexamination Proceeding
D. Smith et al.
Control No.: 90/006,810
Filed: October 16, 2004
For: U.S. Patent No.: 5,266,855

: DECISION ON PETITION
: TO CONTINUE
: *EX PARTE*
: REEXAMINATION
: PROCEEDING

This is a decision on the August 12, 2008 patent owner petition entitled "RENEWED PETITION UNDER 37 CFR 1.182 OR 1.183 TO REQUEST CONTINUED REEXAMINATION OR IN THE ALTERNATIVE, TO REQUEST RECONSIDERATION."

The petition is before the Office of Patent Legal Administration.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182 was charged to petitioner's credit card on August 12, 2008.

The petition is granted.

REVIEW OF THE FACTS

1. On November 30, 1993, U.S. Patent 5,266,855 (the '855 patent) issued to Smith et al.

2. On October 16, 2003, a request for *ex parte* reexamination of the '855 patent was filed by patent owner. The resulting reexamination proceeding was assigned control number 90/006,810 (the '6810 proceeding).

3. On January 7, 2004, an order granting the'6810 *ex parte* reexamination request was mailed.

4. On March 17, 2005, the Office issued a first Office action on the merits rejecting claims as unpatentable over (1) Forbes in view of Grebe; (2) Forbes in view of Grebe and Taguchi; and (3) Forbes in view of Grebe and Lieata.

5. On April 18, 2005, patent owner filed a response amending all the claims, adding new claims and providing evidence and remarks alleging patentability over the art of record.

6. On December 23, 2005, a final Office action was issued in the '6810 proceeding, which included for the first time the van der Heide reference in all the rejections record.

7. On January 23, 2006, patent owner filed an after-final amendment and affidavit evidence in the '6810 proceeding.

8. On February 21, 2006, patent owner filed a notice of appeal in the '6810 proceeding.

9. On February 23, 2006, an advisory action issued in the '6810 proceeding denying entry of the January 23, 2006 after-final amendment.

10. On April 21, 2006, patent owner filed an appeal brief in the '6810 proceeding.

11. On September 15, 2006, an examiner's answer was issued in the '6810 proceeding.

12. On October 4, 2006, patent owner filed a petition under 37 CFR 1.10(e) alleging that a petition was filed on April 21, 2006, requesting review of the February 23, 2006 decision to deny entry of the January 23, 2006 after-final amendment in the '6810 proceeding.

13. On October 19, 2006, the Office issued a decision granting the October 4, 2006 petition under 37 CFR 1.10(e) and returned jurisdiction to the Technology Center to decide the April 21, 2006 petition in the '6810 proceeding.

14. On November 15, 2006, patent owner filed a reply brief in response to the September 15, 2006 examiner's answer in the '6810 proceeding.

15. On May 22, 2007, a second advisory action was issued denying entry of the January 23, 2006 after-final amendment.

16. On June 18, 2007, patent owner filed a petition requesting review of the May 22, 2007 decision to deny entry of the January 23, 2006 after-final amendment in the '6810 proceeding.

17. On November 2, 2007, jurisdiction over the proceeding was transferred to the Board of Patent Appeals and Interferences (BPAI).

18. On November 7, 2007, the BPAI returned jurisdiction over the '6810 proceeding to the examiner for consideration of the June 18, 2007 petition filed by the patent owner.

19. On January 30, 2008, the Office issued an interview summary reflecting that patent owner's counsel participated in an *ex parte* reexamination interview on January 29, 2008.

20. On February 29, 2008, the Technology Center Director issued a decision denying patent owner's June 18, 2007 petition, determining that the examiner's February 23, 2006 and May 22, 2007 denials of entry of the January 26, 2006 amendment where both proper. The decision returned jurisdiction of the '6810 proceeding to the BPAI.

21. On March 3, 2008, patent owner filed a written statement pursuant to 37 CFR 1.560(b) directed to the January 29, 2008 interview conducted in the '6810 proceeding.

22. On March 4, 2008, patent owner filed a petition to revive the '6810 proceeding due to a failure to timely file a written statement pursuant to 37 CFR 1.560(b) in the '6810 reexamination proceeding.

23. On March 17, 2008, the Office issued a decision granting patent owner's March 4, 2008 petition to revive.

24. On March 20, 2008, patent owner filed a reissue application for the '855 patent, which was assigned application number 12/052,582 (the '582 reissue application). Concurrently, patent owner filed a request for merger of the reissue application with the '6810 reexamination proceeding.

25. On April 22, 2008, a notice of the filing of a reissue application was published in the *Official Gazette* for the present reissue application.

26. On May 5, 2008, patent owner filed a petition under 37 CFR 1.182 or 1.183 requesting continued reexamination in the '6810 proceeding. Concurrently, patent owner filed a paper styled as a response to the December 23, 2005 final Office action issued by the Office in '6810 reexamination proceeding.

27. On May 15, 2008, the Office issued a decision declining to merge the '582 reissue application with the '6810 reexamination proceeding and suspending the '582 reissue application until the '6810 reexamination proceeding is concluded.

28. On July 22, 2008 the Office issued a decision dismissing patent owner's petition requesting continued reexamination of the '6810 proceeding under 37 CFR 1.182.

29. On August 12, 2008, patent owner filed the present petition under 37 CFR 1.182 or 1.183 requesting reconsideration of the July 22, 2008 dismissal of the request for continued reexamination. Concurrently, patent owner filed a paper styled as a response to the December 23, 2005 final Office action issued by the Office in '6810 reexamination proceeding.

DECISION ON PETITION UNDER 37 CFR 1.182

In the present petition, patent owner has renewed its request that the Office continue the prosecution of the '6810 reexamination proceeding to provide consideration of the paper styled as a response to the December 23, 2005 final Office action which accompanied the instant petition.

As pointed out in the July 22, 2008 decision, the Office issued a Notice in March of 2005,[1] providing that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding. This petition will be referred to herein as "the § 1.182 petition."

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

Based on the facts and circumstances of the present case, it is found that Petitioner patent owner's presentation of an amendment and argument directed to the determination of patentability are deemed a *bona fide* effort to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate; and as such, the granting of the present petition is consistent with the requirement of 35 USC 305 to conduct reexamination proceedings "with special dispatch within the Office."

Patent owner's has an equitable position in regards to the instant request for relief, in light of the timely filing of a response to the December 23, 2005 final Office action prior to the filing of a Notice of Appeal, in conjunction with a timely petition for review of the response's denial of entry, because had the petition been decided in a timely manner, patent owner could have timely filed the instant petition under 37 CFR 1.182 requesting a continuation of reexamination. Patent owner has both clarified and focused the concurrently filed response to solely address the newly raised issues in the December 23, 2005 final Office action and additionally substantially advance prosecution by cancelling seventy-seven (77) claims.

In light of patent owner's limiting of the issues and advancement of prosecution, as well as the individual facts and circumstances of this case, the petition requesting continued reexamination is granted, and the prosecution in the above-noted reexamination proceeding is hereby continued. Prosecution is reopened for consideration of the response to the December 23, 2005 final Office action filed concurrently with the August 12, 2008 request for continued reexamination. These papers will be entered in the reexamination proceeding, and the proceeding will be forwarded to the examiner for action consistent with this decision. The examiner will consider the Amendment After Final, and all papers submitted as part of the appeal process. The Examiner will then issue an Office action treating these papers as responses of patent owner received **after** a first Office action.

---

[1] "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending." 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

CONCLUSION

1. The petition under 37 CFR 1.182 is granted.

2. The prosecution of the present '6810 *ex-parte* reexamination proceeding is continued. **No further continuation** of the present reexamination proceeding **will be granted absent** a showing of ***extraordinary*** circumstances.

3. The closing of prosecution rendered via the December 23, 2005 Office action is withdrawn, and prosecution of the proceeding is reopened.

4. The response to the December 23, 2005 final Office action concurrently filed with the August 12, 2008 request for continued reexamination will be entered [2] by Technology Center 2800, and will then be considered by the examiner. These papers (and all papers submitted relating to the appeal [3] process) will be treated as a response by patent owner received **after** a first Office action.

5. Jurisdiction for the '6810 reexamination proceeding is being transferred to Technology Center 2800 for further handling and examination consistent with this decision.

6. Telephone inquiries related to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759, or in his absence, the undersigned at (571) 272-7710.

Kenneth Schor,
Senior Legal Advisor
Office of Patent Legal Administration

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9-3-08

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

[3] Insofar as the proceeding is no longer in appeal status, any arguments and evidence submitted with the brief are entered in the record and are properly ripe for consideration by the examiner.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,811	10/17/2003	5270108	1938-1	9422

7590 12/06/2005

EXAMINER

Wm. Bruce Day
Day Law Firm, P.C.
4330 Belleview, Suite 300
Kansas, MI 64111-3579

ART UNIT	PAPER NUMBER

DATE MAILED: 12/06/2005

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12/6/05

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

JOHN S. EGBERT

HARRISON & EGBERT

412 MAIN ST., 7TH FLOOR

HOUSTON, TX 77002

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/006811

PATENT NO. 5,270,108

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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4330 Belleview, Suite 300
Kansas MI 64111-3579

(For Patent Owner)

MAILED
DEC 0 6 2005
REEXAM UNIT

John S. Egbert
Harrison & Egbert
412 Main Street 7th Floor
Houston, TX 77002

(For Third Party Requester)

In re AFM Corporation	:
Reexamination Proceeding	: **DECISION**
Control No.: 90/006,811	: **DISMISSING**
Filed: October 17, 2003	: **PETITION**
For: U.S. Patent No.: 5,270,108	:

This is a decision on the October 17, 2005 patent owner petition entitled "PETITION TO ENTRY OF LATE PAPERS BASED ON UNAVOIDABLE DELAY. "

Patent owner seeks entry of the belated papers based upon the provisions of 37 CFR 1.137(a). The petition is before the Office of Patent Legal Administration for consideration of the above petition. The petition fee of $500.00 has been submitted.

The petition is dismissed for the reasons set forth below.

Any request for reconsideration of this decision must be submitted within ONE (1) MONTH from the mail date of this decision. An extension of time may be requested only under 37 CFR 1.550(c); extensions of time under 37 CFR 1.136 are **not** available in reexamination proceedings. Any reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)" or "Renewed Petition under 37 CFR 1.137(b)," as will be discussed below.

BACKGROUND

1. This reexamination proceeding was filed on October 17, 2003 and assigned control number 90/006,811.

2. Reexamination was ordered on December 16, 2003.

3. A patent owner's statement pursuant to 37 CFR 1.530 was timely filed on February 20, 2004.

4. A non-final Office action was mailed on April 26, 2005 setting a two month shortened statutory period in which to file a reply.

5. A reply to the outstanding Office action was not timely filed. Although a Notice of Intent to Issue Reexamination Certificate (NIRC) has not been mailed, this proceeding is not pending because its prosecution has been "terminated" within the meaning of 37 CFR 1.550(d) for failure of petitioner to timely file a response to the outstanding Office action.

DECISION

I. APPLICABLE STATUTORY AND REGULATORY PROVISIONS

35 U.S.C. § 305 states, 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.

35 U.S.C. § 133 provides:

> Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

37 CFR 1.137(a) provides:

> Unavoidable. If the delay in reply by applicant or patent owner was unavoidable, 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(l);
>
> (3) A showing to the satisfaction of the Director 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 unavoidable; and
>
> (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

37 CFR 1.530(b) provides:

> 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 1.530(d)(2) provides:

> Claims. An amendment paper must include the entire text of each patent claim which is being proposed to be changed by such amendment paper and of each new claim being proposed to be added by such amendment paper. For any claim changed by the amendment paper, a parenthetical expression "amended," "twice amended," etc., should follow the claim number. Each patent claim proposed to be changed and each proposed added claim must include markings pursuant to paragraph (f) of this section, except that a patent claim or proposed added claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

37 CFR 1.550(b) provides:

> 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.

37 CFR 1.550(c) provides:

> 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.

37 CFR 1.550(d) provides:

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

II. ANALYSIS AND FINDINGS

A timely response to the outstanding Office action dated April 26, 2005 was not filed. Therefore, in accordance with 37 CFR 1.550(d), the prosecution of this reexamination proceeding is terminated. Absent the filing of a grantable petition to revive this reexamination proceeding, a certificate in accordance with 37 CFR 1.570 will issue. A grantable petition to revive based upon unavoidable delay under 37 CFR 1.137(a) must be accompanied by the items enumerated in the regulation as reproduced, *supra*. Patent owner's petition satisfies item (2) of 37 CFR 1.137(a), *supra*, since the petition fee has been paid. Further, the item (4) terminal disclaimer of 37 CFR 1.137(a) is not required in reexamination proceedings. [1] The present petition, however, lacks items (1) and (3) as required by the regulation.

As to item (1), a response to the outstanding Office action or notice must be provided. In this instance, the patent owner has attached to the instant petition a paper styled "PATENT OWNER'S STATEMENT UNDER 37 CFR 1.530." The record shows, however, that patent owner actually timely filed a patent owner statement pursuant to 37 CFR 1.530(b) on February 20, 2004. The above mentioned paper attached to the petition appears to be a proposed response under 37 CFR 1.550(b),) directed to the non-final Office action of April 26, 2005. However, the proposed response is not a proper response to the Office action of April 26, 2005, because it does not comply with the provisions 37 CFR 1.550(d)(2). Newly added claims 10-18 are not underlined as required by the regulation. It is also noted that the proposed response is accompanied by two 37 CFR 1.132 declarations, one of which is not executed by the declarant.

With respect to item (3), the petition must include a satisfactory showing that the entire delay in filing the required response [2] to the Office action from the due date for the response until the filing of a grantable petition was unavoidable. Patent owner asserts that: (1) patent owner's representative and patent owner's counsel were delayed in meeting with the examiner during the initial two month period set by the April 26, 2005 Office action for filing a response thereto; (2) the availability of owner's representative was limited due to business out of the country with licenses; and (3) during this time counsel took Boy Scouts to a ranch for a two week trek. For the reasons that follow, these facts are not sufficient to establish that that the entire delay (in filing the required response from the due date for the response until the filing of a grantable petition) was unavoidable.

---

[1] See 37 CFR 1.137(d) and MPEP §711.03(c)

[2] In reexamination proceedings, the term" reply" is replaced by term "response."

The term "unavoidable delay" as utilized in 35 U.S.C. § 133 and 37 CFR 1.137(a) has been interpreted in the decisional law. The decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

> "The word unavoidable ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfections of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present." [4]

A review of the instant petition shows that patent owner does not rely upon the failure of ordinary and trustworthy agencies, employees or other instrumentalities employed by patent owner as having caused the delay in filing the response to the outstanding Office action. Instead, patent owner asserts that the delay in filing the response to the April 26, 2005 Office action resulted in part from unspecified circumstances which delayed meeting with the examiner. Patent owner further asserts that delay also resulted from owner's representative conducting other business and from the unavailability of counsel due to a personal choice. However, a patent owner's preoccupation with other matters does not relieve petitioner from the obligation to exercise diligence in the instant proceeding. [5] It is to be noted that counsel could have retained alternate counsel to address the Office action while counsel was away. Even further, the petition fails to show why a meeting with the owner's president could not have been affected by telecommunication, to carry out the "important business" of preparing the required response to the Office action. Also, the petition does not show the efforts made to meet with the examiner prior to the expiration of the two month period for response and why those efforts were not successful. It is also to be noted that the patent owner might have requested a sufficient extension of time in which to file a response to the April 16, 2005 Office action based on the need to meet with the examiner and the unavailability of the owner's president for meeting with counsel, if it could have been shown that the response could not be provided within the time set in the Office action despite the exercise of "diligence than is generally used and observed by prudent and careful men in relation to their most important business."

Patent owner has not established that the delay in filing a response to the outstanding Office action dated April 26, 2005 was unavoidable in accordance with 35 U.S.C. § 133 and 37 CFR 1.137(a). Patent owner has also failed to supply a proper response to the outstanding Office action. Accordingly, the present petition under 1.137(a) is dismissed.

ALTERNATIVE OPTION

As an **alternative** to filing a renewed petition under 37 CFR 1.137(a), the patent owner may wish to consider the filing of a petition under 37 CFR 1.137(b) if the delay in filing the proposed response to the April 26, 2005 Office action was unintentional. The "unintentional delay" fee provisions of 35 U.S.C. § 41(a)(7) have been imported into, and are applicable to, all *ex parte*

---

[4] *Ex parte Pratt*, 1887 Dec. Comm'r Pat. 31, 322-33 (Comm'r Pat. 1887)

[5] See *Smith v. Diamond*, 209 USPQ 1091 (D.D.C. 1981)

reexamination proceedings by Section 4605 of the American Inventors Protection Act of 1999. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed in response to an Office action subsequent to the order for reexamination. Any such petition must provide (1) a statement [6] that the entire delay in filing the required response from the due date for the response to the filing of a grantable petition was unintentional, (2) a proposed response to continue prosecution in compliance with the formatting requirements 37 CFR 1.530(d)(1)-(4) (unless such response has been previously filed), and (3) the petition fee required by 37 CFR 1.17(m).

CONCLUSION

1. The petition under 37 CFR 1.137(a) for entry of late papers based on unavoidable delay is dismissed.

2. **Any** renewed petition must be filed within ONE (1) MONTH of the mailing date of this decision. Any such petition should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)" or "Renewed Petition under 37 CFR 1.137(b)," depending on which is filed.

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

By U.S. Postal Service Mail:	Mail Stop "*Ex Parte* Reexam" 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 Attn: Central Reexamination Unit Randolph Building 401 Delany St. Alexandria, VA 22314

[6] This statement *per se* is sufficient without any showing, unless the Office finds a need to require additional information where there is a question whether the delay was unintentional.

4. 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
December 6, 2005

C:\Kiva\kpet-abe\ 6811 Unavoidable-dismissed.doc

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,811	10/17/2003	5270108	1938-1	9422

7590 02/16/2006

EXAMINER

Wm. Bruce Day
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4330 Belleview, Suite 300
Kansas, MI 64111-3579

ART UNIT	PAPER NUMBER

DATE MAILED: 02/16/2006

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

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Wm. Bruce Day
Day Law Firm, P.C.
4330 Belleview, Suite 300
Kansas MI 64111-3579

(For Patent Owner)

MAILED

FEB 1 6 2006

REEXAM UNIT

John S. Egbert, Esq.
Harrison & Egbert
412 Main Street, 7th Floor
Houston, TX 77002

(For Third Party Requester)

In re Reexamination Proceeding	:
Thomas Savoy	:
Control No. 90/006,811	: DECISION GRANTING PETITION
Filed: October 17, 2003	:
U.S. Patent No. 5,270,108	:
Attorney Docket No. 1938-1	:

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on January 10, 2006, for entry of late papers based upon unintentional delay.

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

On January 20, 2006, in a telephone communication between counsel Wm. Bruce Day and Senior Legal Advisor Fred Silverberg, counsel was informed that a response in compliance with the formatting requirements of 37 CFR 1.530 had not been filed. Counsel stated that he would file such a response along with any required fees.

In response, on January 24, 2006, a response was filed including, a amendment and a check for $172.00.

On February 9, 2006, in a telephone communication between counsel Wm. Bruce Day and Senior Legal Advisor Fred Silverberg, counsel was informed that since the amendment filed included 2 additional claims, the other than a small entity fee for the 2 additional claims is $400.00. Since a January 24, 2006, response included a check for $172.00, a balance of $228.00 is due.

In response, on February 13, 2006, the $228.00 balance was submitted.

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 $1500.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3).

With respect to satisfying item (1), the amendment practice set forth in 37 CFR 1.121 does not apply to reexamination proceedings rather, it is 37 CFR 1.530 which applies. See 37 CFR 1.121(j). The response filed January 24, 2006, does not comply with 37 CFR 1.530(d)(2) because its amendment is not limited to directing that proposed specified amendments be made, that is, the amendment presents all of the claims, notwithstanding that only claims 10-18 are being added. A review of the response reveals that it can be readily determined what the record claims are following entry of the amendment. Accordingly, the response filed January 24, 2006, will be accepted as being proper to satisfy the item (1) requiremnt. No assurance can be given 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.

The petition for entry of the late papers is granted.

Jurisdiction over the reexamination proceeding is being returned to Technology Center Art Unit 1771 for further examination and consideration of the communication filed January 24, 2006, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Vo Hai, in Technology Center Art Unit 1771, who can be reached at 571-272-1485.

Telephone inquiries related to this decision should be directed to Fred A. Silverberg at 571-272-7719.

Fred A. Silverberg

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

Kenneth M. Schor

Conferee: Kenneth M. Schor

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Wm. Bruce Day
Day Law Firm, P.C.
4330 Bellvue, Suite 300
Kansas City, Missouri 64111

For Patent Owner

MAILED

SEP 15 2006

CENTRAL REEXAMINATION UNIT

John S. Egbert, Esq.
Harrison & Egbert
412 Main Street, 7th floor
Houston, Texas 77002

For Requester

Ex Parte Reexamination Proceeding
Control No. 90/006,811
Filed: October 17, 2003
For: US Patent No. 5,270,108

DECISION GRANTING
PETITION FOR
EXTENSION OF TIME
[37 CFR 1.550(c)]

This is a decision on the petition filed August 18, 2006 to request a one-month extension of time pursuant to 37 CFR 1.550 for responding to the Final Office action dated June 19, 2006.

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

The petition is denied for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file a response to the Final Office action dated June 19, 2006, which set a two-month date for filing a response thereto. The request is timely filed and includes authorization to debit deposit account for the $200.00 petition fee as required by 37 CFR 1.515(c).

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. ...

Patent Owner's Showing of Sufficient Cause to Grant an Extension of Time

The petition for extension of time states that the examiner's action was unexpected in view of the interview that was held on July 14, 2005. The Office action is complex and will require significant consideration. Patent Owner believed significant progress toward allowance had been made at the earlier interview and had redrafted claims and provided arguments appropriate to the discussions held at that time. An extension of time for one (1) month is requested to prepare, coordinate and circulate a complete final response.

Analysis and Findings

On balance, it is considered that the petition does not explain the "sufficient cause" for an extension of time. The Office action is not unexpected in view of the Interview of July 14, 2005 where counsel agreed the concentration of the borate in the range of from 1 to 2% by weight should be included in the claims. No such amendment was made and the added claims include a range of 0.01 to 1.99% by weight, support for which is found nowhere in the original specification. Further, no claims have been redrafted and no arguments have been presented to refute the rejections based on CA 1,005,02 or those based on US 4,564,554 to Mikushi. The response to arguments in the Final Office action of June 19, 2006 is clear and adequate time for response has been allotted. Summer schedules and significant out of office travels are not seen to provide sufficient cause for an extension of time.

Conclusion

1. The patent owner's petition for extension of time of one month in which to file a response to the Office action dated June 19, 2006 is **denied**.

2. The Patent Owner's response is due August 19, 2006.

3. Response may be submitted as follows:

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

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

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

4. Telephone inquiries with regard to this decision should be directed to Deborah Jones, Special Program Examiner in the Central Reexamination Unit, Art Unit 3992, at (571) 272-1535.

Deborah Jones

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
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.
90/006,813	10/20/2003	6023154	IR 2.078 (2-3359)	3943

7590 09/19/2007

Samuel H. Weiner
Ostrolenk Faber Gerb & Soffen LLP
1180 Avenue of the Americas
New York, NY 10036-8403

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/19/2007

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
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Samuel H. Weiner
Ostrolenk, Faber, Gerb & Soffen, LLP
1180 Avenue of the Americas
New York, NY 10036-8403

(Patent Owner)

MAILED

SEP 19 2007

CENTRAL REEXAMINATION UNIT

In re Martinez
Reexamination Proceeding
Control No.: 90/006,813
Filed: October 20, 2003
For: U.S. Patent No.: 6,094,219

DECISION ON PETITIONS UNDER 37 CFR 1.182, 1.181

This is a decision on the June 16, 2006 patent owner combined petitions under 37 CFR 1.182 and 1.181 (a) to withdraw the notice of intent to issue the reexamination certificate, and (b) 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 combined petitions were recently forwarded to the Office of Patent Legal Administration (OPLA) for decision.

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

Thus, the IDS and the amendment filed June 16, 2007, have not been entered for consideration by the examiner.

BACKGROUND

1. Patent number 6,023,154 issued on February 8, 2000 with 11 claims.
2. A request for reexamination, assigned control No. 90/006,813 (the '813 proceeding), was filed on October 20, 2003, by the patent owner.
3. An order granting the reexamination request was mailed January 14, 2004.
4. The proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the '813 proceeding on June 1, 2005.
5. Two Information Disclosure Statements (IDSs) were filed by the patent owner on January 23, 2006 and February 16, 2006, respectively.

6. The Office mailed a communication for the '813 proceeding on May 16, 2006, stating that the IDSs filed on January 23, 2006, and February 16, 2006, were not considered because they lacked an entry right.
7. The instant petition was filed on June 16, 2006, accompanied by a new IDS and an amendment, in which the patent owner requests the Office withdraw the NIRC to consider both the IDS and the amendment.
8. The Reexamination Certificate issued and published on April 17, 2007, thus, the '813 reexamination proceeding has been concluded.

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

The present combined petitions are dismissed as moot, since the reexamination certificate has issued and published. The Office was unable to earlier consider the combined petitions filed June 16, 2006, because the papers were not matched up the file and forwarded to OPLA until recently. Accordingly, the Office no longer has jurisdiction to consider entry of the IDS submissions.

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 may always file a new request for reexamination for consideration of such references.

The IDS submitted by patent owner will be placed in the electronic image file wrapper (IFW) for the proceeding. However, since prosecution has been terminated for this reexamination proceeding and a certificate has been issued, the IDS cannot be considered by the examiner.

ADDITIONAL DISCUSSION

However, even if the petition papers had been matched with the file in time to address them before a reexamination certificate would issue, consideration of the submissions would not have been granted.

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 there is a statutory requirement for special dispatch. The combined petitions filed on July 16, 2006 did not so comply. Patent owner has provided a proposed amendment to the claims, and argued why the proposed claims are patentable over some of the art submitted. However, as to the existing claims of record, the patent owner did not provide "an unequivocal statement as to why the art submitted makes at least one claim unpatentable,...and an explanation as to how the amendment causes such claim or claims to be patentable." Thus, the patent owner did not provide an explanation as to why the proceeding should be pulled from the publication process. In fact, the petition states [1] –, "It is believed that at least the subject matter of Kates is of such relevance that the reexamination certificate should not issue without close consideration of the same." (underline omitted) – but does not even make an "unequivocal statement" that the art submitted makes any claim unpatentable (with identification of the claim). In addition, the petition states [2] – "Before the actual issuance of the Reexamination Certificate the patentee became aware of highly relevant art."--, but does not set forth "a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier" than the issuance of NIRC. Thus, even if the petition papers had been matched with the file in time to address them before a

[1] Petition at page 2, penultimate paragraph.
[2] Petition at page 1, 4th paragraph.

reexamination certificate would issue, consideration of the IDS information, and the amendment, would not have been granted. [3]

CONCLUSION

1. The combined petitions are dismissed as to the request for consideration of the IDS and the entry of the amendment filed on June 16, 2006.

2. The June 16, 2006 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. The amendment filed on June 16, 2006 will also be permitted to remain in the electronic file.

3. 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

kmh
9/14/07

9-14-07
c:\Kiva\kenids\decisions\6813 IDS + amdt after Rex Cert issued.doc

[3] As to the form of the amendment, the filing of any amendments to the drawings, specification or claims must comply with the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2250. 37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim. Further, pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. Amendments are not to be made relative to previous amendments. Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets. Note that at least claim 1 of the amendment filed June 16, 2007 was not marked up properly relative to the language of claim 1 in the patent.

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Alexandria, VA 22313-1450
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Mailed: September 21, 2005

FINNEGAN HENDERSON FARABOW
GARRETT & DUNNER LLP
1300 I STREET, NW
WASHINGTON DC 20005

In re Reexamination Proceeding	:
Freudenberg	:
Serial No.: 90/006,823	: PETITION DECISION
Filed: October 21, 2003	:
Attorney Docket No.: 06478.0999-21000	:

This is a response to the petition under 37 CFR 1.59(b), filed May 25, 2005, to expunge information from the above identified reexamination proceeding.

Petitioner requests that documents submitted on May 25, 2005 which are under court seal be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(h) has been paid.

The examiner has reviewed the documents and found them not to adversely impact the determination of patentability of claims under reexamination. The proceeding will be terminated by issuance of an NIRC in due course. The information has not been returned with his decision due to the large volume submitted, but, since applicant's attorneys are local to the USPTO, may be retrieved by contacting the examiner who has retained the information and will return it personally at a prearranged time.

The petition to is **GRANTED.**

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,619; 90/006,824	07/07/2005	6359022	OXID/0002/HMP/12123.0024	7605

20306 7590 02/24/2006

MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP
300 S. WACKER DRIVE
32ND FLOOR
CHICAGO, IL 60606

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/24/2006

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

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CST

Steven J. Sarussi McDonnell Boehnen Hulbert & Berghoff LLP 300 South Wacker Drive Chicago, Illinois 60606	:	(for Patent Owner)
Henry M. Pogorzelski Patterson & Sheridan LLP 3040 Post Oak Blvd. Suite 1500 Houston, TX 77056	:	(for Third Party)
In re Hickey et al Reexamination Proceeding Control No. 90/006,824 Filed: October 20, 2003 For: U.S. Patent 6,359,022	:	**DECISION MERGING REEXAMINATION PROCEEDINGS**
In re Hickey et al Reexamination Proceeding Control No. 90/007,619 Filed: July 7, 2005 For: U.S. Patent 6,359,022	:	

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 6,359,022, issued March 19, 2002, is the subject of Reexamination Control Nos. 90/006,824 and 90/007,619.

2. A first request for reexamination, assigned Reexamination Control No. 90/006,824 ('6824), was filed October 20, 2003 by Steven Sarussi of McDonnell Boehnen Hulbert & Berghoff LLP. The request urged that a substantial new question of patentability was raised by the teachings of (a) "Improved Hydrocarbon Blown Foams for North America", Polyurethane, 1995 (Nicola), (b) "Hydrocarbon Blown

Foams for U.S. Construction Applications", 35th Annual Polyurethane Technical/Marketing Conference, October 9-12 (Nicola 1994) and (c) U.S. patent 5,916,480 to Rotermund et al.

3. Reexamination was ordered for '6824 on January 15, 2004.

4. A first Office action for '6824 was mailed on January 18, 2005 and contained the rejection of (a) claims 1-26 under 35 USC 102(b) as being anticipated by WO 96/25,443, (b) claims 1-26 under 35 USC 103 as being unpatentable over Nicola et al 1994, and (c) claims 1-26 as being unpatentable over Nicola et al 1995 alone, or in view of Nicola et al 1994.

5. Patent owner responded to the first Office action on April 21, 2005 with an amendment to the claims.

6. A second request for reexamination, assigned Reexamination Control No. 90/007,619 ('7619), was filed July 7, 2005 by Henry Pogorzelski of Patterson & Sheridan LLP. The request urged that a substantial new question of patentability was raised by the teachings of WO 96/25,433 to Blanpied, U.S. patent 5,859,078 to Chittolini and WO 97/21,764 to Singh.

7. Reexamination was ordered for '7619 on September 26, 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 90/006,824 and 90/007,619 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. 90/006,824 on April 21, 2005. 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. 90/006,824 and 90/007,619.

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 electronically 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. 90/006,824 and 90/007,619 as:

Steven Sarussi
McDonnell Boehnen Hulbert & Berghoff LLP
300 South Wacker Drive
Chicago, Illinois 60606

CONCLUSION

Reexamination Control Nos. 90/006,824 and 90/007,619 are merged. The Patent Owner is given one (1) month from the date of this decision to provide a "housekeeping amendment" to make the claims the same in each file.

JMStone

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,824	10/20/2003	6359022	97-845-C	7651

23446 7590 03/31/2008

MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO, IL 60661

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/31/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Henry M. Pogorzelski
MOSER PATTERSON & SHERIDAN LLP
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/006824 → 90/007619
PATENT NO. 6,359,022
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 reply has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
Alexandria, VA 22313-1450
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George Wheeler
McAndrews, Held & Malloy
500 West Madison Street, Suite 3400
Chicago, IL 60661

For Patent Owner
(First request)

Henry M. Pogorzelski
Patterson & Sheridan LLP
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056

For Requester

In re: Hickey et al
Ex Parte Reexamination Proceedings
Control No. 90/006,824
Filed: October 20, 2003
Merged with:
Control No. 90/007,619
Filed: July 7, 2005

For: US Patent No. 6,359,022

DECISION ON PETITION
FOR ENTRY OF
AMENDMENT

This is a decision on the Petition under 37 CFR 41.33 and 1.181, filed May 15, 2007, to request entry of amendment before filing appeal brief in an *ex parte* reexamination.

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

The petition is dismissed for the reasons set forth below.

Decision

The Patent Owner requests entry of the **Amendment Before Filing Appeal Brief**, filed May 15, 2007, such amendment filed concurrently with this petition under the provisions of 37 CFR 41.33 and 1.181. The basis for requesting relief is that the requirements of 37 CFR 1.116 and 37 CFR 41.33 for entering an amendment, when requested after filing a Notice of Appeal and before an appeal brief, have been met.

37 CFR 41.33 states in pertinent part:

(a) Amendments filed after the date of filing an appeal pursuant to 41.31(a)(1) through (a)(3) and prior to the date a brief is filed pursuant to 41.37 may be admitted as provided in 1.116 of this title.

37 CFR 1.116 states in relevant part:

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

(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;
(2) An amendment presenting rejected claims in better form for consideration on appeal may be entered; or
(3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

Analysis and Findings

In the Advisory action mailed June 14, 2007, the amendment submitted by Patent Owner May 15, 2007 was indicated as "entered". As this amendment is entered and is part of the record under consideration in this proceeding, this petition is dismissed as moot.

Conclusion

The patent owner's petition for entry of the amendment submitted May 15, 2007 is **dismissed**.

Telephone inquiries with regard to this decision should be directed to Deborah Jones, Supervisory Patent Examiner in the Central Reexamination Unit, Art Unit 3991, at (571) 272-1535.

Deborah Jones

Lissi M. Marquis,
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,824	10/20/2003	6359022	97-845-C	7651

23446 7590 03/31/2008

MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO, IL 60661

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/31/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,619	07/07/2005	6359022	OXID/0002/HMP/12123.0024	7605

23446 7590 03/31/2008

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EXAMINER

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MAR 31 2008

CENTRAL REEXAMINATION UNIT

George Wheeler
McAndrews, Held & Malloy
500 West Madison Street, Suite 3400
Chicago, IL 60661

For Patent Owner
(First request)

Henry M. Pogorzelski
Patterson & Sheridan LLP
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056

For Requester

In re: Hickey et al
Ex Parte Reexamination Proceedings
Control No. 90/006,824
Filed: October 20, 2003
Merged with:
Control No. 90/007,619
Filed: July 7, 2005

For: US Patent No. 6,359,022

DECISION ON PETITION
TO DESIGNATE NEW
GROUNDS OF REJECTION
(37 CFR 1.181(a))

This is a decision on the Petition under 37 CFR 1.181(a), filed September 13, 2007, to designate new grounds of rejection.

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

The petition is dismissed for the reasons set forth below.

Decision

The Patent Owner requests the Office, under 37 CFR 1.181(a), to re-designate the rejections of claims 33-51 and 53-54 under 35 USC 103(a) in the Examiner's Answer dated July 13, 2007, in this proceeding as new grounds of rejection.

MPEP 1207.03 III states in relevant part:

> There is no new ground of rejection when the basis 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.

Summary of Relevant Facts

On March 16, 2007 Patent Owner filed a response to the Final rejection which included an amendment to the claims. A Notice of Appeal was filed concurrently with this response.

On April 5, 2007 an Advisory Action was mailed indicating the amendment would not be entered because it raised new issues and did not place the claims in better condition for appeal. Suggestions were made by the examiner regarding the amendments and synopsis of how the claims would be rejected was provided.

On May 15, 2007 Patent Owner submitted a petition for Entry of the Amendment before Filing Appeal Brief in an *Ex Parte* Reexamination accompanied by an amendment to the claims.

On May 18, 2007, Patent Owner filed an appeal brief.

On June 14, 2007, an Advisory Action was mailed indicating the amendment was entered and providing a synopsis of the remaining rejections.

On July 13, 2007, an Examiner's Answer was mailed responding to the claims as amended on May 15, 2007.

On September 13, 2007, Patent Owner submitted a Reply Brief that reflected the corrected summary of claimed subject matter and addressed the arguments raised pursuant thereto.

On September 13, 2007, Patent Owner submitted this petition to Designate New Grounds of Rejection.

Analysis and Findings

The Advisory Action of June 14, 2007 indicated that the amendment to the claims filed May 15, 2007 would be entered and included a discussion of all remaining rejections. The Examiner's Answer dated July 13, 2007 did not present any new references or view those of record in any new light. Since the statutory basis and supporting evidence has not changed and the discussion of the rejections remains essentially the same, no new grounds of rejection are noted.

Conclusion

The patent owner's petition designate new grounds of rejection, filed September 13, 2007 is **dismissed**.

Telephone inquiries with regard to this decision should be directed to Deborah Jones, Supervisory Patent Examiner in the Central Reexamination Unit, Art Unit 3991, at (571) 272-1535.

for Deborah Jones

Lissi M. Marquis,
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,824	10/20/2003	6359022	97-845-C	7651

23446 7590 12/05/2008

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/05/2008

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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Date:
MAILED
DEC 05 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90006824
PATENT NO. : 6359022
ART UNIT : 3900

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

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DEC 05 2008

CENTRAL REEXAMINATION UNIT

George Wheeler
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(For Patent Owner)

Henry M. Pogorzelski
Moser, Patterson, & Sheridan, LLP
3040 Post Oak Boulevard, Suite 1500
Houston, TX 77056-6582

(For Third Party Requester)

In re F. Leo Hickey et al.
Reexamination Proceeding
Control Nos.: 90/006,824
Filed: October 20, 2003
For: U.S. Patent No.: 6,359,022

In re F. Leo Hickey et al.
Reexamination Proceeding
Control No.: 90/007,619
Filed: July 7, 2005
For: U.S. Patent No.: 6,359,022

DECISION TO DISMISS PETITION TO SUSPEND 37 CFR 1.114(e)(5) AND TO EXPUNGE PAPERS REQUESTING CONTINUED EXAMINATION

This is a decision on the November 6, 2008 patent owner petition entitled "PETITION UNDER 37 CFR 1.183 TO SUSPEND 37 CFR 1.114(e)(5)."

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

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.183 was charged to petitioner's account on November 7, 2008.

The petition is dismissed and the accompanying papers of the request for continued examination under 37 CFR 1.114 are being expunged as improper papers for the reasons pointed out below.

REVIEW OF FACTS

1. U.S. Patent No. 6,359,022 to Hickey *et al.* (the '022 patent) was issued on March 19, 2002.

2. On October 20, 2003, patent owner filed a request for *ex parte* reexamination, which was assigned reexamination control number 90/006,824 (the '6824 proceeding).

3. On September 13, 2004, patent owner filed an amendment pursuant to 37 C.F.R. § 1.530(b) in the '6824 proceeding.

4. On January 15, 2004, the Office granted the '6824 reexamination request and ordered reexamination.

5. The'6824 reexamination proceeding progressed to the point where, on April 21, 2005, patent owner filed a response to an Office action mailed January 18, 2005.

6. On July 7, 2005, a second request for reexamination was filed by a third party requester, which was assigned reexamination control number 90/007,619.

7. On August 26, 2005, the Office granted the '7619 reexamination request and ordered reexamination.

8. On February 24, 2006, the Office issued a decision merging the '6824 patent owner reexamination proceeding with the '7619 third party requester reexamination proceeding (the merged reexamination proceeding).

9. The merged proceeding progressed to the point where the Office's rejection of the claims was appealed, and, on September 24, 2008, the Board issued an order returning the application to the Central Reexamination Unit (CRU) to issue a response to a petition under 37 C.F.R. § 1.181 to reconsider a petition to designate new grounds of rejection in the examiner's answer in the merged reexamination proceeding.

10. On November 6, 2008, patent owner filed the present petition under 37 CFR 1.183 to suspend 37 CFR 1.114(e)(5), concurrently with a request for continued examination under 37 CFR1.114, including an amendment to the claims, in the merged reexamination proceeding.

DECISION DISMISSING PETITION AND EXPUNGING PAPERS

The present November 6, 2008 petition under 37 CFR 1.183 to suspend 37 CFR 1.114(e)(5) and accept the accompanying Request for Continued Examination (RCE) is dismissed:

37 CFR 1.183 states, in pertinent part:

> In an extraordinary situation, when justice requires, any requirement of the regulations in this part which **is not a requirement of the statutes** may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. [Emphasis added]

35 U.S.C. § 132(b) states:

> 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. [Emphasis added]

37 CFR 1.114 states, in pertinent part:

> (a) If prosecution **in an application** is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth under § 1.17(e) prior to the earliest of:
>
> (1) Payment of the issue fee, unless a petition under § 1.313 is granted;
> (2) Abandonment of the application; or
> (3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141 or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.
>
> ...
>
> **(e) The provisions of this section do not apply to:**
>
> ...
>
> **(5) A patent under reexamination.**
>
> [Emphasis added]

35 U.S.C. § 132(b) expressly limits the authority to create regulations providing for continued examination to "the continued examination of applications for patent." To implement this statutory limitation, 37 CFR 1.114(e)(5), specifically excludes reexamination proceedings from RCE practice, because reexamination of a patent is not the examination of an "application for patent." There is, accordingly, no authority for the filing, in a reexamination proceeding, of a RCE in an effort to continue prosecution of the reexamination proceeding, regardless of whether prosecution was closed, or otherwise.

Accordingly, the RCE filed on November 6, 2008 is not a paper that is enterable in the merged '6824 and '7619 reexamination proceeding.

37 CFR 1.183 empowers the Office to waive any requirement of the regulations "which is not a requirement of the statutes." However, since a reexamination of a patent is not the examination of an "application for patent," there exists no statutory authority to grant a continued examination of a reexamination of a patent. Therefore, 37 CFR 1.183 is inapplicable.

Furthermore, 37 CFR 1.183 is to be used only in an "extraordinary situation," and such has not been established in this instance. Petitioner's argument alleging inadequate opportunity to prosecute the currently amended claims such that justice requires reopening of prosecution is not persuasive. The record shows that petitioner has had a full and fair opportunity to prosecute the merged reexamination, including four interviews, consideration of claim amendments and affidavits, and entry of claim amendments filed three days prior to filing of an appeal brief. Petitioner's allegations of new grounds of rejections in the examiner's answer are properly addressable by way of 37 CFR 1.181, not via 37 CFR 1.183. Therefore, the record does not exhibit an "extraordinary situation" as required under 37 CFR 1.183, even were 37 CFR 1.183 applicable.

In view of the above and the fact situation presented by the record, the petition is dismissed. Further, the papers of the request for continued examination under 37 CFR 1.114 that accompanied the petition are being expunged as improper papers, not authorized by statute.

CONCLUSION

1. The petition is dismissed.

2. The accompanying papers of the request for continued examination under 37 CFR 1.114 are being expunged as improper papers. The papers are being expunged by closing them in the IFW file of the present reexamination proceeding, and marking the papers "closed" and "non-public" in the IFW.

2. The present decision is being made of part of the official record (the IFW) for the present proceeding.

3. Jurisdiction over the present *ex parte* reexamination proceeding is being returned to the Central Reexamination Unit (CRU), for appropriate action in due course, including consideration of a petition under 37 CFR 1.181, filed on May 29, 2008, requesting reconsideration of a petition to designate new grounds of rejection..

4. Telephone inquiries related to the present decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700, or in his absence, the undersigned at 571-272-7710.

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

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12-3-08

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,824	10/20/2003	6359022	97-845-C	7651

23446 7590 03/12/2009

MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO, IL 60661

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/12/2009

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Henry M. Pogorzelski
MOSER PATTERSON & SHERIDAN LLP
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056

Date: MAILED
MAR 12 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90006824
PATENT NO. : 6359022
ART UNIT : 3900

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

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George Wheeler
McAndrews, Held & Malloy
500 West Madison Street, Suite 3400
Chicago, IL 60661

For Patent Owner

MAILED

MAR 12 2009

CENTRAL REEXAMINATION UNIT

Henry M. Pogorzelski
Patterson & Sheridan LLP
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056

For Requester

In re: Hickey et al
Ex Parte Reexamination Proceedings
Control No. 90/006,824
Filed: October 20, 2003
Merged with:
Control No. 90/007,619
Filed: July 7, 2005

For: US Patent No. 6,359,022

DECISION ON PETITION
TO DESIGNATE NEW
GROUNDS OF REJECTION
(37 CFR 1.181(a))

This is a decision on the May 29, 2008 patent owner petition under 37 1.181(a) requesting reconsideration of the March 31, 2008 decision by the Director of the Central Reexamination Unit which was issued on patent owner's petition under 37 CFR 1.181(a) to designate new grounds of rejection.

The petition is before Irem Yucel, Director, Technology Center 1600 for reconsideration of the March 31, 2008 decision.

The petition is granted to the extent that the March 31, 2008 decision has been reconsidered, but is denied as to the underlying relief requested, for the reasons set forth below.

Background

On January 16, 2007, Patent Owner filed an Amendment after Final that included extensive amendments to the claims.

On February 2, 2007, an Advisory Action was mailed indicating that the January 16, 2007 response would not be entered because it raised new issues and did not place the proceeding in better form for appeal. The examiner offered several suggestions on how to amend the claims to over come some of these issues and at least place the proceeding in better form for appeal. The examiner explicitly indicated that, should a subsequent amendment be filed according to the suggestions, the 35 U.S.C. 102(b) rejection over Singh will become a 35 U.S.C. 103(a) rejection and the finality will be maintained. See the paragraph bridging pages 8-9 of this Advisory Action.

On March 16, 2007, Patent Owner filed a response to the Final rejection which included an amendment to the claims. A Notice of Appeal was filed concurrently with this response.

On April 5, 2007, an Advisory Action was mailed indicating the amendment would not be entered because it raised new issues and did not place the claims in better condition for appeal. Suggestions were again made by the examiner regarding the amendments, and a synopsis of how the claims would be rejected was provided.

On May 15, 2007, Patent Owner submitted a petition for Entry of the Amendment before Filing Appeal Brief in an *Ex Parte* Reexamination accompanied by an amendment to the claims.

On May 18, 2007, Patent Owner filed an appeal brief.

On June 14, 2007, an Advisory Action was mailed stating that the amendment was entered and providing a synopsis of the remaining rejections. As was stated in the Advisory Action of February 2, 2007, the 35 U.S.C. 102(b) rejection of claims 1-10, 13-16. 20, 24, 27-47, 49-51, 53-55, 57-59, 61-66, and 68 were now rejected under 35 U.S.C.103(a) over Singh.

On July 13, 2007, an Examiner's Answer was mailed responding to the claims as amended on May 15, 2007.

On September 13, 2007, Patent Owner submitted a Reply Brief that reflected the corrected summary of claimed subject matter and addressed the arguments raised pursuant thereto.

On September 13, 2007, Patent Owner submitted a petition to Designate New Grounds of Rejection, which was dismissed on March 31, 2008.

On May 29, 2008, Patent Owner filed the present Petition requesting reconsideration of the Decision of March 31, 2008.

Relevant Procedure

MPEP 1207.03 III states in relevant part:

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).

In addition, former 37 CFR 1.193(a)(2) also provided that if:

(A) an amendment under 37 CFR 1.116 [or 41.33] proposes to add or amend one or more claims;

(B) appellant was advised (through an advisory action) that the amendment would be entered for purposes of appeal; and

(C) the advisory action indicates which individual rejection(s) set forth in the action from which appeal has been taken would be used to reject the added or amended claims, then

(1) the appeal brief must address the rejection(s) of the added or amended claim(s) and

(2) the examiner's answer may include the rejection(s) of the added or amended claims. Such rejection(s) made in the examiner's answer would not be considered as a new ground of rejection.

The filing of such an amendment represents appellant's consent to proceed with the appeal process. For example, when an amendment under 37 CFR 1.116 or 41.33 cancels a claim (the "canceled claim") and incorporates its limitations into the claim upon which it depends or rewrites the claim as a new independent claim (the "appealed claim"), the appealed claim contains the limitations of the canceled claim (i.e., the only difference between the appealed claim and the canceled claim is the claim number). In such situations, the appellant has been given a fair opportunity to react to the ground of rejection (albeit to a claim having a different claim number). Thus, such a rejection does not constitute a "new ground of rejection" within the meaning of 37 CFR 41.39.

The phrase "individual rejections" addresses situations such as the following: the action contains a rejection of claim 1 under 35 U.S.C. 102 on the basis of Reference A, a rejection of claim 2 (which depends upon claim 1) under 35 U.S.C. 103 on the basis of Reference A in view of Reference B and a rejection of claim 3 (which depends upon claim1) under 35 U.S.C. 103 on the basis of Reference A in view of Reference C. In this situation, the action contains the following "individual rejections": (1) 35 U.S.C. 102 on the basis of Reference A; (2) 35 U.S.C. 103 on the basis of Reference A in view of Reference B; and (3) 35 U.S.C. 103 on the basis of Reference A in view of Reference C. The action, however, does not contain any rejection on the basis of A in view of B and C. If an amendment under 37 CFR 1.116 or 41.33 proposes to combine the limitations of claims 1 and 2 together into amended claim 1 and cancels claim 2, a rejection of amended claim 1 under 35 U.S.C. 103 on the basis of Reference A in view of Reference B would be appropriate and would not be considered a new ground of rejection within the meaning of 37 CFR 41.39, provided the applicant was advised that this rejection would be applied to amended claim 1 in an advisory action. Furthermore, since claim 3 (which depends upon claim 1) would include the limitations of the original claims 1, 2, and 3, a rejection of amended claim 3 (amended by the amendment to original claim 1) under 35 U.S.C. 103 on the basis of Reference A in view of Reference B and Reference C may be appropriate and would not be considered a new ground of rejection within the meaning of 37 CFR 41.39, provided applicant was advised that this rejection would be applied to amended claim 3 in the advisory action. Of course, as amended claim 3 includes the limitations of the original claims 1, 2, and 3, amended claim 3 is a newly proposed claim in the application raising a new issue (i.e., a new ground of rejection), and such an amendment under 37 CFR 1.116 or 41.33 may properly be refused entry as raising a new issue.

Decision

The Patent Owner requests the Office, under 37 CFR 1.181(a), to re-designate the rejections of claims 33-51 and 53-54 under 35 USC 103(a) in the July 13, 2007 Examiner's Answer as new grounds of rejection.

The Advisory Action of June 14, 2007 stated that the amendment to the claims filed May 15, 2007 would be entered, and it included a discussion of all remaining rejections including the change with regards to the rejection over Singh. The July 13, 2007 Examiner's Answer reflected this discussion and did not present any new references or view those of record in any new light. This is consistent with MPEP 1207.03. Claim 52 was originally rejected over Singh alone under § 103(a) with respect to the water content. This issue was clearly developed in the Final rejection (see pages 22-24). The amendment of May 15, 2007 was denied entry because is raised other substantial issues and did not put the proceeding in better form for appeal. However, Patent Owner was notified at that time that, if a subsequent after-final amendment was filed ameliorating the other issues and containing the amendment with respect to water content, the § 102(b) rejection

would be converted to a §103(a) rejection over Singh and the finality maintained because this issue had been discussed. In the amendment filed May 15, 2007, Patent Owner filed an amendment incorporating claim 52 into claim 1 as suggested by the Examiner. The Examiner then issued a subsequent Advisory action stating that the claims were rejected under §103(a) and maintaining the finality of the rejection as had been discussed. Upon entry of the May 15, 2007, the patent owner could have filed a replacement brief, addressing the Examiner's statement in the Advisory action that the claims were, at that point, rejected under §103(a). Patent Owner amended the claims under the advisement of the Examiner, was aware of the consequences and had ample time to respond and did not do so until the filing of the reply brief; accordingly the request for reconsideration to designate new grounds of rejection is denied.

Conclusion

The Patent Owner's petition for reconsideration to designate new grounds of rejection is granted to the extent that the March 31, 2008 decision has been reconsidered, but is denied as to the underlying relief requested.

Telephone inquiries with regard to this decision should be directed to Deborah Jones, Supervisory Patent Examiner in the Central Reexamination Unit, Art Unit 3991, at (571) 272-1535.

Irem Yucel
Director, Technology Center 1600

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OCT 21 2005

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(For Petitioner)

In re John C. Harvey et al.	:	DECISION DISMISSING
Reexamination Proceeding	:	PETITION AND SEALING
Control No.: 90/006,838	:	PAPERS, AND
Filed: October 31, 2003	:	ORDER *RE* SHOWING
For: U.S. Patent No. 5,109,414	:	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 19, 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 19, 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. 5,109,414 (hereinafter, the '414 patent) issued on April 28, 1992.

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. The petitioner S-A filed a request for reexamination of the '414 patent, on October 31, 2003. Reexamination control number 90/006,838 was assigned to the proceeding. The request for reexamination was granted.

5. On August 19, 2005, PMC filed an IDS in reexamination control number 90/006,838.

6. S-A filed the instant petition on September 6, 2005, alleging that PMC's IDS improperly included certain documents subject to the court's protective Order.

---

[1] *Personalized Media Communications,LLC v. Scientific-Atlanta, Inc.*, No.1:02-CV -824 (N.D. Ga. filed Mar. 28, 2002).

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 a third party requester 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 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

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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).

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 19, 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 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 19, 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

C:\kiva\kenpet6\6838_Expunge-PO-submission_by-3PR.wpd
October 18, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Thomas Scott
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1751 Pinnacle Drive
Suite 1700, Tysons Corner
McLean, VA 22102

(For Patent Owner Personalized Media Communications, LLC)

MAILED
MAR 3 1 2006
REEXAM UNIT

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	:	DECISION DISMISSING
Control No.: 90/006,838	:	PETITION AND UNSEALING
Filed: October 31, 2003	:	PAPERS
For: U.S. Patent No. 5,109,414	:	

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 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

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[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).

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. 5,109,414 (hereinafter, the '414 patent) issued on April 28, 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 October 31, 2003 S-A filed a request for reexamination of the '414 patent. Reexamination control number 90/006,838 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 90/006,838.

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

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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).

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).

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\6838 Resp by Owner Re Unseal_grant.wpd
March 29, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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MAY 1 8 2006
REEXAM UNIT

HUNTLON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K Street N.W.
Suite 1200
Washington, DC 20006-1109

(For Patent Owner)

Nina L. Medlock
BANNER & WITCOFF, LTD
1001 G Street NW
Washington, DC 20001

(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. 90/006,838
Filed: October 31, 2003
For: US Patent No. 5,109,414

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. 5,109,414 issued on April 28, 1992.

2. A request was filed by a third party requester for reexamination of US Patent No. 5,109,414 on October 31, 2003.

3. The Order granting reexamination is dated January 9, 2004.

4. A non-final Office action was mailed on December 23, 2005.

5. The patent owner response was received on February 23, 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 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
SP.RE 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
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,606 +90/006,703 +90/006,889	04/18/2003	5233654	6011-226	9269

21967 7590 12/03/2004

HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON, DC 20006-1109

EXAMINER

ART UNIT	PAPER NUMBER

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

PTO-90C (Rev. 10/03)

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DO NOT USE IN PALM PRINTER

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Arthur J. Usher IV, Esquire
Woodard, Emhardt, Naughton, Moriarty & McNett LLP
Bank One Center/Tower
111 Monumental Circle, Suite 3700
Indianapolis, Indiana 46204-5137

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/006,606* + 90/006,703 + 90/006,835

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)

Thomas L. Peterson, Esq.
Banner & Witcoff, Ltd.
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)).

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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ALEXANDRIA, VA 22313-1450
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Paper No. 16

Thomas Scott HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON DC 20006-1109	)	FOR OWNER
Arthur J. Usher IV, Esquire Woodard, Emhardt, Naughton, Moriarty & McNett LLP Bank One Center/Tower 111 Monumental Circle, Suite 3700 Indianapolis, Indiana 46204-5137	)	FOR FIRST THIRD PARTY REQUESTOR
Thomas L. Peterson, Esq. Banner & Witcoff, Ltd. 1001 G Street NW 11th Floor Washington DC 20001-4597	)	FOR SECOND THIRD PARTY REQUESTOR
In Re Harvey, et al. Reexamination Proceeding Control No. 90/006,606 Filed 4-18-03 For U.S. Patent No. 5,233,654	)	DECISION SUA SPONTE MERGING REEXAMINATION PROCEEDINGS
In Re Harvey, et al. Reexamination Proceeding Control No. 90/006,703 Filed 7-7-03 For U.S. Patent No. 5,233,654	)	
In Re Harvey, et al. Reexamination Proceeding Control No. 90/006,839 Filed 10-31-03 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

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

OCT 21 2005

REEXAM UNIT

Thomas Scott
HUNTON & WILLIAMS
1751 Pinnacle Drive
Suite 1700, Tysons Corner
McLean, VA 22102

(For Patent Owner)

Nina L. Medlock
BANNER & WITCOFF, LTD
1001 G Street NW
Washington, DC 20001

(For Requester Scientific-Atlanta, Inc.)

Arthur J. Usher, IV
WOODARD EMHARDT NAUGHTON
MORIARTY & MCNETT LLP
Bank One Center/Tower
111 Monument Circle, Suite 3700
Indianapolis, IN 46204-5137

(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	DECISION DISMISSING PETITION AND SEALING PAPERS, AND ORDER *RE* SHOWING CAUSE TO UNSEAL
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	

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

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Thomas Scott
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1751 Pinnacle Drive
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(For Patent Owner Personalized Media Communications, LLC)

MAILED
MAR 31 2006
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(For Requester Thomson, Inc.)

Nina L. Medlock
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1001 G Street NW
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(For Requester Scientific-Atlanta, Inc.)

In re John C. Harvey et al.	:	
Reexamination Proceeding	:	DECISION DISMISSING
Control Nos.: 90/006,606 filed April 18, 2003	:	PETITION AND
90/006,703 filed July 7, 2003	:	UNSEALING PAPERS
90/006,839 filed October 31, 2003	:	
For: U.S. Patent No. 5,233,654	:	

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

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[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

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March 29, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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MAY 18 2006
REEXAM UNIT

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Arthur J. Usher, IV
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(For First Third Party Requester)

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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. 90/006,606
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
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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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,703	07/07/2003	5233654	001263.00015	9271

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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

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901 NEW YORK AVENUE, N.W.
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EXAMINER

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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	:	DECISION GRANTING PETITION
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	:	

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."

[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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,841	10/31/2003	4704725	001263.00021	6928

+ 90/006697

21967 7590 12/03/2004

HUNTON & WILLIAMS LLP
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1900 K STREET, N.W.
SUITE 1200
WASHINGTON, DC 20006-1109

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/03/2004

#8

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

cc'd: Third Party Requester, as attached

PTO-90C (Rev. 10/03)

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/006,697*.

PATENT NO. *4704725*.

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. 8

Thomas Scott HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON DC 20006-1109	))))))	FOR OWNER
Thomas L. Peterson, Esq. Banner & Witcoff, Ltd. 1001 G Street NW 11th Floor Washington DC 20001-4597	))))	FOR THIRD PARTY REQUESTOR
In Re Harvey, et al. Reexamination Proceeding Control No. 90/006,697 Filed 7-7-03 For U.S. Patent No. 4,704,725	)))))	DECISION SUA SPONTE MERGING REEXAMINATION PROCEEDINGS
In Re Harvey, et al. Reexamination Proceeding Control No. 90/006,841 Filed 10-31-03 For: U.S. Patent No. 4,704,725	)))))	

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. 4,704,725 issued on November 3, 1987.

2. A first request for reexamination, Control No. 90/006,697 ('697) was filed by the Third Party Requestor on July 7, 2003.

3. Reexamination was ordered on the '697 reexamination proceedings on September 9, 2003.

4. A statement of non-submission of Patent Owner's statement was filed on November 5, 2003.

5. A second request for reexamination, Control No. 90/006,841 ('841) was filed by the Third Party Requestor on October 31, 2003.

6. Reexamination was ordered on the '841 reexamination proceedings on January 6, 2004.

7. 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 '697 and '841 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

Reinhard Eisenzopf, Acting Director
Technology Center 2600
Communications & Information Processing

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OCT 21 2005

REEXAM UNIT

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(For Patent Owner)

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(For Petitioner)

In re John C. Harvey et al.
Reexamination Proceeding
Control No.: 90/006,697
Filed: July 7, 2003
For: U.S. Patent No. 4,704,725

In re John C. Harvey et al.
Reexamination Proceeding
Control No.: 90/006,841
Filed: October 31, 2003
For: U.S. Patent No. 4,704,725

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 19, 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 19, 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 for expungement of 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. 4,704,725 (hereinafter, the '725 patent) issued on November 3, 1987.

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. The petitioner S-A filed two requests for reexamination of the '725 patent, on July 7, 2003 and October 31, 2003. Reexamination control numbers 90/006,697 and 90/006,841, respectively, were assigned to the proceedings. The requests for reexamination were granted, and the two proceedings have been merged under 37 CFR 1.565(c).

5. On August 19, 2005, PMC filed an IDS in reexamination control numbers 90/006,697 and 90/006,841.

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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).

6. S-A filed the instant petition on September 6, 2005, 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 a third party requester 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 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

---

[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).

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 19, 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 19, 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

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(For Patent Owner Personalized Media Communications, LLC)

Nina L. Medlock
BANNER & WITCOFF, LTD
1001 G Street NW
Washington, DC 20001

(For Requester Scientific-Atlanta, Inc.)

MAILED

MAR 30 2006

REEXAM UNIT

In re John C. Harvey et al.	:	
Reexamination Proceeding	:	DECISION DISMISSING
Control Nos.: 90/006,697 filed July 7, 2003	:	PETITION AND
90/006,841 filed October 31, 2003	:	UNSEALING PAPERS
For: U.S. Patent No. 4,704,725	:	

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 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

---

[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).

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. 4,704,725 (hereinafter, the '725 patent) issued on November 3, 1987.

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. S-A filed requests for reexamination of the '725 patent on July 7, 2003 and October 31, 2003, and reexamination control numbers 90/006,697 and 90/006,841, respectively, were assigned to the proceedings. The request for reexamination was granted, and the two proceedings have been merged under 37 CFR 1.565(c).

5. On August 19, 2005, PMC filed an IDS in reexamination control numbers 90/006,697 and 90/006,841.

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 PMC filed the instant petition to return materials submitted by S-A, 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.

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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).

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).

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

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March 29, 2006

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1001 G Street NW
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(For Requester Scientific-Atlanta, Inc.)

MAILED

MAR 30 2006

REEXAM UNIT

In re John C. Harvey et al.	:	
Reexamination Proceeding	:	DECISION DISMISSING
Control Nos.: 90/006,697 filed July 7, 2003	:	PETITION AND
90/006,841 filed October 31, 2003	:	UNSEALING PAPERS
For: U.S. Patent No. 4,704,725	:	

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 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.

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[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).

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. 4,704,725 (hereinafter, the '725 patent) issued on November 3, 1987.

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. S-A filed requests for reexamination of the '725 patent on July 7, 2003 and October 31, 2003, and reexamination control numbers 90/006,697 and 90/006,841, respectively, were assigned to the proceedings. The request for reexamination was granted, and the two proceedings have been merged under 37 CFR 1.565(c).

5. On August 19, 2005, PMC filed an IDS in reexamination control numbers 90/006,697 and 90/006,841.

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 PMC filed the instant petition to return materials submitted by S-A, 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.

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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).

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.

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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).

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

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March 29, 2006

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(For Patent Owner)

MAILED
MAY 1 6 2006
REEXAM UNIT

Nina L. Medlock
BANNER & WITCOFF, LTD
1001 G Street NW
Washington, DC 20001

(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. 90/006,697
Filed: July 7, 2003
For: US Patent No. 4,704,725

In re John C. Harvey
Ex Parte Reexamination Proceeding
Control No. 90/006,841
Filed: October 31, 2003
For: US Patent No. 4,704,725

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. 4,704,725 issued on November 3, 1987.

2. A request was filed by a third party requester for reexamination of US Patent No. 4,704,725 on July 7, 2003 and October 31, 2003.

3. The Order granting reexamination is dated September 9, 2004.

4. A decision merging the proceedings was mailed December 3, 2004.

5. A non-final Office action was mailed on April 20, 2005.

6. The patent owner response was received on June 20, 2005.

7. A final Office action was mailed July 22, 2005.

8. The patent owner's appeal brief was received December 27, 2005.

9. The examiner's answer was mailed April 21, 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 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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(For Patent Owner Personalized Media)

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SEP 19 2006

OFFICE OF PETITIONS

Nina L. Medlock
Banner & Witcoff
10012 G Street NW
Washington DC 20001

(For Requestor)

In re John C. Harvey :
Ex Parte Reexamination Proceeding :
Control No. 90/006,697 :
Filed: July 7, 2003 :
For: U.S. Patent No. 4,704,725 :

ON PETITION

In re John C. Harvey :
Ex Parte Reexamination Proceeding :
Control No. 90/0068417 :
Filed: October 31, 2003 :
For: U.S. Patent No. 4,704,725 :

This is a decision on the petition filed June 21, 2006, under 37 CFR 1.183 by patent owner to waive the applicable rules and permit the submission of new evidence with the reply brief.

The petition is granted.

Petitioner, in essence, complains that in each communication from the first Office action to the Advisory Action, the examiner has continued to expand the evidence relied upon to support the rejection. Petitioner further complains that while the examiner has not specifically identified that he has made a new ground of rejection, which would permit patent owner to submit new evidence, the examiner has taken a new position in his Examiner's Answer that the CBS petition includes Appendix B in a "single complete publication." Petitioner asserts that as the accompanying declaration of Kimberly Kellmel ("Kellmel") bears directly on this newly created issue, justice dictates waiver of the rules.

As noted in MPEP 1208.01, "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." While it is not asserted by petitioner nor is it apparent from the record that

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the statutory ground for the rejection has changed, the record does suggest that the totality of the evidence surrounding the CPS petition to support the rejection has not remained unchanged; rather is has grown substantially with each Office communication.

That is, the CBS petition relied upon by the examiner has grown from an exhibit of 5 pages in the first Office action to an exhibit now subtending some 150 pages in the Answer. It thus seems, without deciding the issue, that the quantum of evidence relied upon in support of the rejection has increased. As noted in In re Hilmer, 53 CCPA 1288, 1313, 359 F.2d 859, 879, 149 USPQ 480, 496 (CCPA 1966):

> Much confused thinking could be avoided by realizing that rejections are based on statutory provisions, not on references, and that the references merely supply the evidence of lack of novelty, obviousness, loss of right or whatever may be the ground of rejection.

As of the first Office action, the evidence provided by and from the CBS petition reference was but 5 pages; now it is 150 pages. On the other hand, the mere citation of new information after appeal has been taken does not *ipso facto* constitute a change in the evidence relied upon, such that a new grounds of rejection has been made. See In re Kronig, 539 F.2d 1300, 190 USPQ 425 (CCPA 1976); In re Ahlert, 424 F.2d 1088, 165 USPQ 418 (CCPA 1970); MPEP 1208.01. The issue is whether applicant has had a fair opportunity to react to the thrust of the rejection. Kronig, supra. Since the challenge raised by petitioner to the citation of the CBS Petition has remained substantially unchanged over time, it appears that petitioner has had that fair opportunity.

However, as the CBS petition now totals some 150 pages of citation, and in light of the examiner's first-time assertion in the Answer that such constitutes "a single complete publication", it is agreed that justice would be served by waiving the rules that would prohibit entry of the Kellmel declaration.

Petitioner should note, for future reference, that if he should feel that he has been subjected to a new ground of rejection, which has not been appropriately so designated, his remedy is a timely petition requesting supervisory review under 37 CFR 1.181, and not a belated petition under CFR 1.183 seeking to level the playing field. 37 CFR 1.183 is not a mechanism for avoiding the diligence requirement of 37 CFR 1.181(f).

This reexamination proceeding is being referred to the Technology Center for further action consistent with this decision.

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3217.

Brian Hearn
Petitions Examiner
Office of Petitions

Copied from 90006697 on 01/19/2007

#8

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Stetina Brunda Garred & Brucker
75 Enterprise, Suite 250
Aliso Viejo, CA 92656

(For Patent Owner)

APR 19 2004

William P. Christie
Christie, Parker & Hale, LLP
P.O. Box 7068
Pasadena, CA 91109-7068

(For Requester)

Reexam Control No.: 90/006,809
Filed: October 14, 2003
For: U.S. Patent No. 6,443,929

Reexam Control No.: 90/006,842
Filed: November 4, 2003
For: U.S. Patent No. 6,443,929

DECISION MERGING REEXAMINATION PROCEEDINGS

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

Reexamination in application Control No. 90/006,809 was ordered in a decision mailed December 12, 2003. On February 11, 2004, Patent Owner filed a statement under 37 CFR 1.530. The statement included an amendment to the claims.

Reexamination in application Control No. 90/006,842 was ordered in a decision mailed December 12, 2003. On February 11, 2004, Patent Owner filed a statement under 37 CFR 1.530. the Statement included an amendment to the claims. On April 12, 2004, third party Requester filed a reply under 37 CFR 1.535.

Merger is proper if a reexamination is ordered while a prior reexamination proceeding is pending. In view of the above, merger is appropriate and is hereby ordered.

Requirement for Same Claims in Both Proceedings

The Patent Owner is required to maintain identical specifications, abstract, claims and claim numbering in both files. In view of the fact that both reexamination applications contain identical specifications, drawings, and claims, no amendment is required.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. All papers mailed by the Office will take the form of a single action, which applies to both proceedings. All papers issued by the Office or as filed by the Patent Owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the Patent Owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by Patent Owner must be served on Requester and Requester will be sent copies of all papers mailed by the Office. See 37 CFR 1.565 (d).

Conclusion

Reexamination Control Nos. 90/006,809 and 90/006,842 are hereby merged. At this time there is no further action required by Patent Owner. These proceedings will be forwarded to the Examiner for an action on the merits.

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

ak/4/16/04

UNITED STATES PATENT AND TRADEMARK OFFICE

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46th Floor
1650 Market Street
Philadelphia, PA 19103

(For Patent Owner)

MAILED
JUL 25 2005
REEXAM UNIT

In re INPRO LICENSING SARL
Reexamination Proceeding
Control No.: 90/006,848
Filed: November 7, 2003
For: U.S. Patent No.: 6,535,922 C1

: DECISION
: DISMISSING
: PETITION

This is a decision on the June 20, 2005 patent owner petition entitled PETITION UNDER 37 CFR 1.182 TO HAVE CONSIDERED AN INFORMATION DISCLOSURE STATEMENT FILED AFTER THE TERMINATION OF THE PROSECUTION IN A REEXAMINATION PROCEEDING.

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

The petition is dismissed for the reasons set forth below.

REVIEW OF FACTS

1. Patent number 6,535,922 issued March 18, 2003 with 15 claims.
2. A request for reexamination, assigned control No. 90/006,848, was filed on November 7, 2003.
3. A Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the '849 proceeding on January 24, 2005.
4. The instant petition was filed on June 20, 2005.
5. A reexamination certificate, confirmation number 5129 was issued on June 28, 2005.

DECISION DISMISSING THE PETITION TO CONSIDER THE INFORMATION DISCLOUSRE STATEMENT IN THE ABOVE CAPTIONED REEXAMINATION PROCEEDING

A review of the record shows that the examiner terminated prosecution on the merits and issued an NIRC on January 24, 2005. The file was forwarded to the Office of Publications for issuance of the reexamination certificate. The certificate issued on June 28, 2005.

Accordingly the petition is dismissed as moot.

It is noted for the record, however, that had the instant petition been matched and considered prior to the printing of the certificate, it would have been dismissed in view of the following:

The petition was filed very late in the examination of the reexamination, and fails to provide a statement as to why the art submitted makes at least one claim unpatentable. To the contrary, patent owner merely states that the references were "recently" brought to patent owner's attention in "an English litigation" that involves a European patent. Patent owner does not state the relationship of the European patent to the patent for which reexamination was conducted, and does not describe the relationship, if any, of the claims in the European patent to the claims that were reexamined. Patent owner states that certain of the reference are "undated," but are alleged to have a date in the "amended complaint" filed in the litigation. One of the references is described as an undated video, and it not clear whether that reference would qualify as a "patent or printed publication" pursuant to 35 U.S.C. § 302 and 37 CFR 1.510. Further, patent owner has submitted six items for consideration, and has provided a discussion of three of those items as set forth above, and no discussion of the other three items. There is no discussion as to the substance of any of the documents or their relevance to the reexamination proceeding.

It is to be noted that in a reexamination proceeding, there is a statutory mandate special dispatch, and the need for certainty and finality. In view of the fact that the information submitted was submitted after termination of the prosecution in this reexamination proceeding and is not asserted as raising a question of patentability of the claims, and it is not in any way discussed in detail, it is to be observed that the reexamination proceeding would not have been reopened even if the petition had been filed prior to publication of the reexamination certificate. If 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, the patent owner can always file a new request for reexamination for consideration of the references.

CONCLUSION

1. The patent owner petition to have the information disclosure statement filed on June 20, 2005 is DISMISSED.

2. 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 25, 2005

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Woodcock Washburn LLP
One Liberty Place
46th Floor
1650 Market Street
Philadelphia, PA 19103

(For Patent Owner)

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REEXAM UNIT

In re INPRO LICENSING SARL
Reexamination Proceeding
Control No.: 90/006,849
Filed: November 7, 2003
For: U.S. Patent No.: 6,553,410 B1

: **DECISION**
: **DISMISSING**
: **PETITION**

This is a decision on the June 20, 2005, patent owner petition entitled PETITION UNDER 37 CFR 1.182 TO HAVE CONSIDERED AN INFORMATION DISCLOSURE STATEMENT FILED AFTER THE TERMINATION OF THE PROSECUTION IN A REEXAMINATION PROCEEDING.

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

The petition is dismissed for the reasons set forth below.

REVIEW OF FACTS

1. Patent number 6,553,410 issued April 22, 2003 with 16 claims.

2. A request for reexamination, assigned control No. 90/006,849, was filed on November 7, 2003.

3. A Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed on January 24, 2005.

4. The instant petition was filed on June 20, 2005.

5. The reexamination proceeding is in the final phase of being prepared for printing of the examination certificate.

DECISION DISMISSING THE PETITION TO CONSIDER THE INFORMATION DISCLOUSRE STATEMENT IN THE ABOVE CAPTIONED REEXAMINATION PROCEEDING

A review of the record shows that the examiner terminated prosecution on the merits and issued an NIRC on January 24, 2005. The file was forwarded to the Office of Publications for

issuance of the reexamination certificate. The file is in the final phase of preparation for printing the reexamination certificate.

The instant petition was filed very late in the examination of the reexamination, and fails to provide a statement as to why the art submitted makes at least one claim unpatentable. To the contrary, patent owner merely states that the references were "recently" brought to patent owner's attention in "an English litigation" that involves a European patent. Patent owner does not state the relationship of the European patent to the patent for which reexamination was conducted, and does not describe the relationship, if any, of the claims in the European patent to the claims that were reexamined. Patent owner states that certain of the references are "undated," but are alleged to have a date in the amended complaint filed in the litigation. One of the references is described as an undated video, and it is not clear whether that reference would qualify as a "patent or printed publication" pursuant to 35 U.S.C. § 302 and 37 CFR 1.510. Further, patent owner has submitted six items for consideration, has provided a discussion of three of those items only to the extent set forth above, and has provided no discussion of the other three items. There is no discussion as to the substance of any of the documents.

It is to be noted that, in a reexamination proceeding, there is a statutory mandate special dispatch, and the need for certainty and finality. In view of the fact that the information submitted was submitted after termination of the prosecution in this reexamination proceeding and is not asserted as raising a question of patentability of the claims, and it is not in any way discussed in detail, it is deemed that the reexamination proceeding should not be reopened at this late date. If 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, the patent owner can always file a new request for reexamination for consideration of the references.

Accordingly the petition is dismissed.

CONCLUSION

1. The patent owner petition to have the information disclosure statement filed on June 20, 2005 is DISMISSED.

2. 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 25, 2005

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Paper No. 11
Mailed: July 19, 2004

DANN, DORFMAN, HERRELL & SKILLMAN 1601 MARKET STREET SUITE 2400 PHILADELPHIA PA 19103-2307	FOR PATENT OWNER
PHILIP L. McGARRIGLE LEGAL DEPARTMENT AFFYMATRIX, INC. 3380 CENTRAL EXPRESSWAY SANTA CLARA, CA 95051	FOR THRID PARTY REQUESTER
In re Ekins Reexamination Proceeding Control No.: 90/006,852 Filed: November 10, 2003 For: U.S.Patent No. 5,432,099 In re Ekins Reexamination Proceeding Control No.: 90/006,972 Filed: March 22, 2004 For: U.S.Patent No. 5,432,099	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. 5,432,099 issued July 11, 1995.

2. A first request for reexamination, Control No. 90/006,852, was filed by patent owner on November 10, 2003.

3. Reexamination was ordered in the '852 reexamination proceeding on February 6, 2004.

4. A second request for reexamination, Control No. 90/006,972, was filed by third party Requester on March 22, 2004.

5. Reexamination was ordered in the '972 reexamination proceeding on June 1, 2004.

6. Patent Owner filed a waiver of Patent Owner statement on April 5, 2004, in the '852 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 § 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 '852 and '972 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

Requirement for Same Amendments in Both Proceedings.

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

Conduct of Merged Proceeding.

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

CONCLUSION

Reexamination Control Nos. 90/006,852 and 90/006,972 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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Commissioner for Patents
United States Patent and Trademark Office
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Mailed: April 25, 2005

DANN, DORFMAN, HERRELL & SKILLMAN 1601 MARKET STREET SUITE 2400 PHILADELPHIA PA 19103-2307	FOR PATENT OWNER
PHILIP L. McGARRIGLE LEGAL DEPARTMENT AFFYMATRIX, INC. 3380 CENTRAL EXPRESSWAY SANTA CLARA, CA 95051	FOR THIRD PARTY REQUESTER
In re Ekins Reexamination Proceeding Control No.: 90/006,852 Filed: November 10, 2003 For: U.S.Patent No. 5,432,099 In re Ekins Reexamination Proceeding Control No.: 90/006,972 Filed: March 22, 2004 For: U.S.Patent No. 5,432,099 In re Ekins Reexamination Proceeding Control No.: 90/007,266 Filed: November 25,2004 For: U.S.Patent No. 5,432,099	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. 5,432,099 issued July 11, 1995.

2. A first request for reexamination, Control No. 90/006,852, was filed by patent owner on November 10, 2003.

3. Reexamination was ordered in the '852 reexamination proceeding on February 6, 2004.

4. A second request for reexamination, Control No. 90/006,972, was filed by third party Requester on March 22, 2004.

5. Reexamination was ordered in the '972 reexamination proceeding on June 1, 2004.

6. Patent Owner filed a waiver of Patent Owner statement on April 5, 2004, in the '852 proceeding.

7. The '852 and '972 proceedings were merged on July 19, 2004.

8. A third request for reexamination, Control No. 90/007,266, was filed by third party Requester on November 25, 2004.

9. Reexamination was ordered in the '266 proceeding on November 29, 2004.

10. Patent Owner filed a notice of waiver of patent owner's statement on December 2, 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 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 '852, '972 and '266 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.

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.

CONCLUSION

Reexamination Control Nos. 90/006,852, 90/006,972 and 90/007,266 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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CENTRAL REEXAMINATION UNIT

Dann, Dorfman, Herrell & Skillman
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(For Patent Owner)

In re Roger P. Ekins et al.	:	
Ex Parte Reexamination Proceeding	:	DECISION ON PETITION
Control No. 90/006,853	:	
Filed: November 10, 2003	:	
For: U.S. Patent No. 5, 516,635	:	

This is a decision on the October 10, 2006 patent owner petition, entitled "Petition to Dismiss Reexamination (37 CFR 1.181(a)(3)," seeking to invoke the statutory authority of the Director to terminate the present proceeding, as an *ultra vires* action.

Reexamination proceeding 90/006,853 (the '853 proceeding) and the October 10, 2006 patent owner petition are before the Office of Legal Administration.

SUMMARY

The petition is dismissed as to all relief requested, for the reasons set forth below.

REVIEW OF FACTS

- On May 14, 1996, U.S. Patent 5,516,635 (the '635 patent) issued.
- On October 10, 2003, a request for reexamination of the '635 patent was filed, and it was assigned reexamination control no. 90/006,853 (the '853 proceeding).
- On February 6, 2004, reexamination was ordered for the '853 proceeding.
- On August 29, 2005, a first Office action rejecting claims 1-16, i.e., all of the '635 patent claims, was mailed.
- On November 11, 2005, a request for reconsideration was filed by the patent owner.
- On January 17, 2006, an interview summary by the examiner was made of record.

- On February 28, 2006, a second nonfinal Office action rejecting patent claims 1-16 was mailed.
- On April 28, 2006, a request for reconsideration was filed by the patent owner.
- On May 19, 2006, a supplemental response to the Office action mailed February 28, 2006, was filed by the patent owner.
- On August 9, 2006, a third nonfinal Office action rejecting patent claims 1-16 was mailed.
- On October 10, 2006, a request for reconsideration was filed by the patent owner.
- Also on October 10, 2006, the patent owner filed the instant petition.
- On December 4, 2006, an interview summary by the examiner was made of record.
- On December 5, 2006, a supplemental amendment, and an applicant summary of the December 4, 2006 interview with the examiner, was filed by the patent owner. The December 5, 2006 amendment has not yet been reviewed for propriety and entry.

STATUTES, RULES, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 134(b) states, in part:

> "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."

35 U.S.C. 303 states, in part:

> "(a) 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....The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office."

35 U.S.C. 305 states, 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."

35 U.S.C. 306 states, in part:

> "The patent owner involved in a reexamination proceeding under this chapter may appeal under the provisions of section 134 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 41.31(a)(3) states:

> "Every owner of a patent under ex parte reexamination filed under § 1.510 of this title on or after November 29, 1999, any of whose claims has been finally (§ 1.113 of this title) rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § 41.20(b)(1) within the time period provided under § 1.134 of this title for reply."

37 CFR 1.181 states, in part:

> (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;
>
> * * *
>
> "(f) Any petition . . . 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."

MPEP § 2246 states, in part:

> "In the examiner's decision, [[1]] the examiner must identify at least one substantial new question of patentability and explain how the prior art patents and/or printed publications raise such a question."

MPEP § 2246(II), states, in part:

> "[n]either the patent owner nor the requester has a right to petition, or request reconsideration of, a finding that prior art patents or printed publications raise a substantial new question after a request for reexamination is granted. There is no right to petition such a finding after a request for reexamination is granted even if the finding of a substantial new question is based on reasons other than those urged by the requester (or based on less than all the grounds urged by the requester). "
>
> "A petition under 37 CFR 1.181 may... be filed to vacate an *ultra vires* reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where <u>no discretion</u> to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained. "Appropriate circumstances" under 37 CFR 1.181(a)(3) exist to vacate the order granting reexamination where, for example:
>
> * * *
>
> "(E) the reexamination order is based wholly on the same question of patentability raised by the prior art previously considered in an earlier concluded examination of the patent by the Office (e.g., the application which matured into the patent, a prior reexamination, an interference proceeding)."

---

[1] The context here is a decision on whether reexamination should, or should not, be ordered.

MPEP § 2258.01 A states, in part (emphasis in original):

> "For a reexamination that was ordered **on or after November 2, 2002** (the date of enactment of Public Law 107-273; see Section 13105, of the Patent and Trademark Office Authorization Act of 2002), reliance solely on old art (as the basis for a rejection) does not necessarily preclude the existence of a substantial new question of patentability (SNQ) that is based exclusively on that old art. Determinations on whether a SNQ exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis. For example, a SNQ may be based solely on old art where the old art is being presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request."

MPEP § 2258.01 (B) (3) states, in part:

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

DECISION

I. The Issue Raised

Petitioner argues that the only remaining rejection applied by the examiner in this reexamination proceeding fails to raise a substantial new question of patentability, and as such, reexamination should be dismissed. This argument is not found to be persuasive, as will now be discussed.

In the order granting reexamination mailed February 6, 2004, the examiner determined that substantial new questions of patentability were raised by two of the references presented by the patent owner in the request for reexamination.[2] The first Office action mailed on August 29, 2005, applied two grounds of rejection, each based in part on references raised by the patent owner in the request for reexamination.[3] In the second nonfinal Office action, all previously applied grounds of rejection were subsequently withdrawn, and the examiner newly applied Ekins, U.S. 5,432,099 (Ekins '099) in view of Cheung et al U.S. 5,132,242 (Cheung '242) as the

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[2] Ekins, Chapter 13, Concurrent Concepts and Future Developments, in "Alternative Immunoassays" (1985) (the Ekins article) and Chang et al, WO 84/03151 (Chang '151).

[3] The examiner rejected patent claims 1-4, 6-16 over Gordon et al, GB 2099578 (Gordon) in view of Cheung '242 and the Ekins article (while the statement of the rejection indicated that Chen et al, 4,385,126, rather than Cheung '242, was cited as a secondary reference, the body of the rejection discussed the Cheung '242 reference.) Patent claim 5 was rejected over Gordon in view of the Ekins article, Cheung '242, and Chang et al, U.S. 4,591,570 (Chang '570).

sole ground of rejection. The third Office action mailed August 9, 2006, again contained only one rejection of the patent claims, i.e., the same rejection over Ekins '099 in view of Cheung.

In this instance, petitioner is not requesting that the instant reexamination proceeding be vacated based upon the absence of a substantial new question of patentability at the point where reexamination was ordered. Rather, petitioner is requesting that the proceeding be "dismissed" or "terminated" based upon the contention that all of the originally raised substantial new questions of patentability have been resolved, and the allegation that the newly applied art (Ekins '099 and Cheung '242) fails to raise substantial new question of patentability, to provide jurisdiction to continue. Stated another way, the ground of rejection newly raised in the second nonfinal Office action and presently maintained in the third nonfinal Office action differs from the prior art providing the grounds on which the order granting reexamination was based. The issue petitioner raises is, rather, whether the sole remaining ground of rejection, newly raised after the order granting reexamination, raises a substantial new question of patentability.

II. The Present Petition is Untimely Filed

Petitioner urges that the sole rejection of the patent claims, newly applied by the examiner in the second nonfinal Office action mailed February 28, 2006 and maintained in the third nonfinal Office action mailed August 9, 2006, is cumulative to a rejection applied by the examiner in the earlier concluded prosecution of the patent under reexamination, the '635 patent.

37 CFR 1.181(f), however, provides for the dismissal, as untimely, of any petition not filed within two months of the mailing date of the Office action or notice from which relief is requested. In the present case, the only remaining rejection, applied by the examiner in the August 9, 2006 third nonfinal Office action is based on the <u>same ground</u> as the sole rejection applied by the examiner in the February 28, 2006 second nonfinal Office action. [4] Petitioner thus received notice of this rejection on February 28, 2006; yet petitioner failed to file the present petition until October 10, 2006, which is far more than two months from the mail date of the second nonfinal Office action. The present petition, therefore, is not considered to be timely filed.

It is to be noted that, in litigation, where a time period for filing a pleading 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 present *ex parte* reexamination must be conducted with special dispatch within the Office. Accordingly, 37 CFR 1.181(f) is especially important in the reexamination context. Petitioner's delay of approximately 7.5 months in filing the present petition clearly runs counter to the mandate of the statute that reexamination proceedings are to be dealt with using special dispatch to provide a resolution of the proceeding. This delay by petitioner independently provides grounds for dismissal of

[4] On page 3 of the third nonfinal Office action mailed August 9, 2006, the examiner states that "this rejection is substantially [the] same as the rejection set forth in the previous office action mailed on 2/28/06." This has been found to be the case. To the extent there may be a difference, Ekins '099 and Cheung '242 were the only two references applied in both instances. If Ekins '099 and Cheung '242 were believed to fail to raise a substantial new question, petitioner was on notice that these were the only references being applied on February 28, 2006.

the present petition under 37 CFR 1.181as untimely.

It is further to be noted that, in this instance, the patent owner elected to respond to the rejection based on Ekins '099 and Cheung '242, to await the Office's response to patent owner's response, and only then to file the present petition. Such is clearly precluded by 37 CFR 1.181(f) and runs counter to the Congressional call for "special dispatch."

III. The Remaining Rejection Raises a Substantial New Question of Patentability

The following is provided for completeness; however, the petition is not timely filed as discussed immediately above.

MPEP § 2242 provides a statement of the requirements for the presence of a statutory "substantial new question of patentability," based upon which reexamination may be ordered. Section 2242 states as follows:

> "For "a substantial new question of patentability" to be present, it is only necessary that: (A) the prior art patents and/or printed publications raise a substantial question of patentability regarding at least one claim, i.e., the teaching of the (prior art) patents and printed publications is such that a reasonable examiner would consider **the teaching to be important in deciding whether or not the claim is patentable;** and (B) **the same question** of patentability as to the claim **has not been decided** by the Office in a previous examination or pending reexamination of the patent or in a final holding of invalidity by the Federal Courts in a decision on the merits involving the claim. It is not necessary that a "prima facie" case of unpatentability exist as to the claim in order for "a substantial new question of patentability" to be present as to the claim. **Thus, "a substantial new question of patentability" as to a patent claim could be present even if the examiner would not necessarily reject the claim as either fully anticipated by, or obvious in view of, the prior art patents or printed publications.**" [Emphasis added.]

The present discussion is not directed to the merits of the applied rejection; that is a matter to be addressed on appeal. The discussion is solely addressed to whether there is at least one "new" teaching provided by Ekins '099 and Cheung '242 **that would be important in deciding whether or not the claim is patentable.**

During the prosecution of the '635 patent, the claims were rejected over Ekins, U.S. Patent 5,171,695 (Ekins '642) in view of Cheung et al, U.S. 5,132,242 (Cheung '242).

In the '853 reexamination proceeding, the second and third nonfinal Office actions each contain only one rejection, which rejects all of the patent claims over Ekins '099 in view of Cheung '242.

Petitioner urges that the disclosure of Ekins '099, applied in the second and third nonfinal Office actions of this proceeding, is cumulative, i.e., repetitive, to the disclosure of Ekins '695, as applied in the earlier concluded examination of the '635 patent.

As stated in MPEP 2258.01 A (quoted above), however, for a reexamination that was ordered on or after November 2, 2002, as is the case here, reliance solely on "old art" as the

basis for a rejection does not necessarily preclude the existence of a substantial new question of patentability (SNQ) that is based exclusively on that old art. An SNQ may be based solely on "old art" where the "old art" is being presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request. Such is the case in this instance.

For example, during the prosecution of the '635 patent, the examiner relied upon line 36 of column 9 of Ekins '695 in an effort to provide a teaching of the limitation "one or more microspots, each microspot having an area less than 1 mm^2", which is recited in claim 1 of the '635 patent (see line 7 of page 11 of the June 20, 1995 Office action for application no. 08/211,800, which resulted in the issuance of the '635 patent.) Lines 34-36 of column 9 of Ekins '695 teaches "a microbead . . .having a diameter of about 1 mm or less."

In the third nonfinal Office action of the '853 reexamination proceeding, however, the examiner relied on claims 1-17 of Ekins '099 (see line 5 of page 4) for a teaching of the same claim limitation recited in the patent under reexamination (the '635 patent.) Claims 2 and 13 of Ekins '099 separately recite "each of said spots has a size of less than 1 mm^2."

A teaching of a *microbead* having a diameter of *about 1 mm or less* differs from a teaching of a *spot* having a size of *less than one square millimeter*. Furthermore, the teaching in Ekins '099 of a spot having a size of less than one square millimeter more closely meets the limitation of claim 1 of the patent under reexamination (the '635 patent), which recites "one or more microspots , each microspot having an area less than 1 mm^2." Ekins '099, therefore presents this subject matter recited in claim 1 of the patent under reexamination, in a new light, or in a different way, as compared with the use of the same subject matter as taught by Ekins '695, in the earlier concluded examination of the '635 patent.

Even for reexaminations ordered prior to November 2, 2002, under the *Portola* guidelines, a different reference that presented information in a different way than another reference was not necessarily precluded from application by the examiner in reexamination, even though the reference might have addressed the same general subject matter. Again see MPEP 2258.01 B (3) which states ". . . it is expected that a repetitive reference which cannot be considered by the Office during reexamination will be a rare occurrence since most references teach additional information or present information in a different way than other references, even though the references might address the same general subject matter."

Petitioner is referred to *Heinl v Godici*, (E.D.Va. 2001), 143 F. Supp. 2d 593. In *Heinl*, 143 F.Supp.2d at 601, the court stated:

> "Under the well established *ultra vires* doctrine, the exhaustion and final agency requirements are excused 'only if plaintiff is able to show that the PTO clearly exceeded its statutory authority'", quoting from *Philip Morris, Inc. v. Block*, 755 F.2d 368, 370 (4th Cir. 1985) (quoting *Mayor and City Council of Baltimore v. Mathews*, 562 F.2d 914, 920 (4th Cir. 1977), vacated on other grounds, 571 F.2d 1273 (4th Cir. 1978).

The court went on to state:

> "Put differently, when an agency acts in 'brazen defiance' of its statutory authorization, courts need not await the conclusions of the underlying proceedings."

After a review of the record, and based upon the above discussion, it is found that petitioner has not shown the Office to have "clearly exceeded its statutory authority" nor acted "in brazen defiance of its statutory authorization" in the Office's determination to continue reexamination. Thus, even aside from the timeliness issue pointed out above, the present petition under 37 CFR 1.181 is appropriately dismissed.

CONCLUSION

1. The petition under 37 CFR 1.181 to terminate reexamination proceeding control no. 90/006,853 as being an *ultra vires* action on the part of the Office is **dismissed**.

2. Jurisdiction over the reexamination proceeding is returned to the Central Reexamination Unit.

3. Telephone inquiries relating to this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, at (571) 272-7724, or 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

02/21/07
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UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 9
Mailed: June 15, 2004

DANN, DORFMAN, HERRELL & SKILLMAN 1601 MARKET STREET SUITE 2400 PHILADELPHIA PA 19103-2307	FOR PATENT OWNER
PHILIP L. McGARRIGLE LEGAL DEPARTMENT AFFYMATRIX, INC. 3380 CENTRAL EXPRESSWAY SANTA CLARA, CA 95051	FOR THRID PARTY REQUESTER
In re Ekins Reexamination Proceeding Control No.: 90/006,854 Filed: November 10, 2003 For: U.S.Patent No. 5,599,720 In re Ekins Reexamination Proceeding Control No.: 90/006,961 Filed: March 11, 2004 For: U.S.Patent No. 5,599,720	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. 5,599,720 issued February 4, 1997.

2. A first request for reexamination, Control No. 90/006,854, was filed by patent owner on November 10, 2003.

3. Reexamination was ordered in the '854 reexamination proceeding on February 6, 2004.

4. A second request for reexamination, Control No. 90/006,961, was filed by third party Requester on March 11, 2004.

5. Reexamination was ordered in the '961 reexamination proceeding on May 17, 2004.

6. Patent Owner filed a waiver of Patent Owner statement on May 20, 2004, in the '961 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 § 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 '854 and '961 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

Requirement for Same Amendments in Both Proceedings.

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

Conduct of Merged Proceeding.

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

CONCLUSION

Reexamination Control Nos. 90/006,854 and 90/006,961 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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Paper No. 9
Mailed: June 15, 2004

DANN, DORFMAN, HERRELL & SKILLMAN 1601 MARKET STREET SUITE 2400 PHILADELPHIA PA 19103-2307	FOR PATENT OWNER
PHILIP L. McGARRIGLE LEGAL DEPARTMENT AFFYMATRIX, INC. 3380 CENTRAL EXPRESSWAY SANTA CLARA, CA 95051	FOR THRID PARTY REQUESTER
In re Ekins Reexamination Proceeding Control No.: 90/006,854 Filed: November 10, 2003 For: U.S.Patent No. 5,599,720 In re Ekins Reexamination Proceeding Control No.: 90/006,961 Filed: March 11, 2004 For: U.S.Patent No. 5,599,720	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. 5,599,720 issued February 4, 1997.

2. A first request for reexamination, Control No. 90/006,854, was filed by patent owner on November 10, 2003.

3. Reexamination was ordered in the '854 reexamination proceeding on February 6, 2004.

4. A second request for reexamination, Control No. 90/006,961, was filed by third party Requester on March 11, 2004.

5. Reexamination was ordered in the '961 reexamination proceeding on May 17, 2004.

6. Patent Owner filed a waiver of Patent Owner statement on May 20, 2004, in the '961 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 § 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 '854 and '961 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

Requirement for Same Amendments in Both Proceedings.

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

Conduct of Merged Proceeding.

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

CONCLUSION

Reexamination Control Nos. 90/006,854 and 90/006,961 are merged.

The files will be forwarded to the examiner for further action thereon.

Jasemine C. Chambers
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

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Mailed: April 25, 2005

DANN, DORFMAN, HERRELL & SKILLMAN 1601 MARKET STREET SUITE 2400 PHILADELPHIA PA 19103-2307	FOR PATENT OWNER
PHILIP L. McGARRIGLE LEGAL DEPARTMENT AFFYMATRIX, INC. 3380 CENTRAL EXPRESSWAY SANTA CLARA, CA 95051	FOR THIRD PARTY REQUESTER
In re Ekins Reexamination Proceeding Control No.: 90/006,854 Filed: November 10, 2003 For: U.S.Patent No. 5,599,720 In re Ekins Reexamination Proceeding Control No.: 90/006,961 Filed: March 11, 2004 For: U.S.Patent No. 5,599,720 In re Ekins Reexamination Proceeding Control No.: 90/007,321 Filed: November 23, 2004 For: U.S.Patent No. 5,599,720	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. 5,599,720 issued February 4, 1997.

2. A first request for reexamination, Control No. 90/006,854, was filed by patent owner on November 10, 2003.

3. Reexamination was ordered in the '854 reexamination proceeding on February 6, 2004.

4. A second request for reexamination, Control No. 90/006,961, was filed by third party Requester on March 11, 2004.

5. Reexamination was ordered in the '961 reexamination proceeding on May 17, 2004.

6. Patent Owner filed a waiver of Patent Owner statement on May 20, 2004, in the '961 proceeding.

7. The '854 and '961 proceedings were merged on June 15, 2004.

8. A third request for reexamination, Control No. 90/007,321, was filed by third party Requester on November 23, 2004.

9. Reexamination was ordered in the '321 reexamination proceeding on February 3, 2005.

10. No Patent Owner statement has been filed and the time for doing so has expired.

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 '854, '961 and '321 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.

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.

CONCLUSION

Reexamination Control Nos. 90/006,854, 90/006,961 and 90/007,321 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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,855	11/12/2003	6290265	04TRU96648	3647

34456 7590 09/08/2005

TOLER & LARSON & ABEL L.L.P.
5000 PLAZA ON THE LAKE STE 265
AUSTIN, TX 78746

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/08/2005

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

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Jeffrey S. Abel, Esq. (For Patent Owner)
TOLER, LARSON & ABEL, LLP
5000 Plaza On The Lake, Suite 265
Austin, TX 78746

MAILED
SEP 0 8 2005
REEXAM UNIT

David L. Davis, Esq. (For Third Party Requestor)
90 Washington Valley Road
Bedminster, NJ 07921

Stephen R. Warburton-Pitt et al	:	
Reexamination Proceeding	:	**DECISION**
Control No. 90/006,855	:	**GRANTING**
Filed: November 12, 2003	:	**PETITION**
For: U.S. Patent No. 6,290,265	:	

This is a decision on the July 19, 2005, patent owner PETITION UNDER RULES 1.137(b) and 1.550(2), 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 $1500.00 set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b) has been charged to petitioner's Deposit Account No. 50-2469, in accordance with petitioner's authorization in the Fee Transmittal Form PTO/SB/17 (appearing on page 7 of the facsimile transmission received on July 19, 2005).

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

DECISION ON PETITION UNDER 37 CFR 1.137(b)

The instant petition under 37 CFR 1.137(b) is accompanied by the appropriate statement pursuant to 37 CFR 1.137(b)(3). In addition, a Response was filed with patent owner's July 19, 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 3600 for consideration, in due course, of the response filed July 19, 2005, with the petition.

3. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, David Bochna, in Art Unit 3679, who can be reached at (571) 272-7078.

4. Telephone inquiries related to this decision should be directed to Samuel Broda at (571)272-7711.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Mailed: April 25, 2005

DANN, DORFMAN, HERRELL & SKILLMAN 1601 MARKET STREET SUITE 2400 PHILADELPHIA PA 19103-2307	FOR PATENT OWNER
PHILIP L. McGARRIGLE LEGAL DEPARTMENT AFFYMATRIX, INC. 3380 CENTRAL EXPRESSWAY SANTA CLARA, CA 95051	FOR THIRD PARTY REQUESTER
In re Ekins Reexamination Proceeding Control No.: 90/006,856 Filed: November 10, 2003 For: U.S.Patent No. 5,807,755 In re Ekins Reexamination Proceeding Control No.: 90/007,267 Filed: November 25, 2004 For: U.S.Patent No. 5,807,755	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. 5,807,755 issued September 15, 1998.

2. A first request for reexamination, Control No. 90/006,856, was filed by patent owner on November 10, 2003.

3. Reexamination was ordered in the '856 reexamination proceeding on February 6, 2004.

4. A second request for reexamination, Control No. 90/007,267, was filed by third party Requester on November 25, 2004.

5. Reexamination was ordered in the '267 reexamination proceeding on January 7, 2005.

6. Patent Owner filed a waiver of Patent Owner statement on January 21, 2005, in the '267 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 '856 and '267 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

Requirement for Same Amendments in Both Proceedings.

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

Conduct of Merged Proceeding.

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

CONCLUSION

Reexamination Control Nos. 90/006,856 and 90/007,267 are merged.

The files will be forwarded to the examiner for further action thereon.

for Jasemine C. Chambers
Director, Technology Center 1600

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Paper No. 9

James A. Thomas
GLAST, PHILLIPS & MURRAY
13355 Noel Road L.B. 48
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(For Third Party Requester)

Robert F. Frijouf
FRIJOUF, RUST & PYLE PA
201 East Davis Blvd.
Tampa, FL 33606

(For Patent Owner)

MAILED
APR 06 2006
REEXAM UNIT

In re Reissue Application of
Larry G. Junker
Application No.: 29/217,870
Filed: July 21, 2003
For: U.S. Patent No. D450,839

In re Larry G. Junker
Reexamination Proceeding
Control No.: 90/006,867
Filed: November 17, 2003
For: U.S. Patent No.: D450,839

: 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. D450,839 issued on November 20, 2001.

2. The patent owner filed an application for reissue, assigned application No. 29/217,870, on July 21, 2003.

3. A third party protest was filed in the '7870 reissue proceeding on November 4, 2003.

4. A third party requester filed a request for reexamination, assigned control No. 90/006867, on November 17, 2003.

5. Notice of the reexamination request was posted in the *Official Gazette* on

January 6, 2004.

6. Reexamination was ordered for the '6867 reexamination proceeding on February 9, 2004.

7. A patent owner's statement under 37 CFR 1.530 was not received in the '6867 reexamination proceeding.

8. An *Official Gazette* notice related to the '7870 reissue proceeding has not yet been published.

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. 29/217870 and reexamination control No. 90006867 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 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 <u>not</u> an assurance that, in a future similar situation, merger would be ordered.*

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

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

II. Requirement for Same Amendments in Both Proceedings

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

2. A review of the reexamination file for the proceeding of reexamination control No. 90006867 shows that the original patent claim remains. A review of reissue application No. 29/217870 shows that the original patent claim remains. Accordingly, the claims are identical in both proceedings.

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

1. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue-application examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. *However, periods of response should be set at TWO (2) months to comply with the statutory requirement for special dispatch in reexamination (35 U.S.C. 305).*

2. Each Office action issued by the examiner will take the form of a single action which jointly applies to the reissue application and the reexamination proceedings. Each action will contain identifying data for both of the cases, i.e, the reissue application and the reexamination proceeding, and each action will be physically entered into both files (which will be maintained as separate files).

3. Any response by the applicant/patent owner must consist of a single response, with two copies being filed for entry in the two files, with each of the two bearing a signature. Any such responses must be served on the requester, who will also be sent copies of Office actions.

4. Pursuant to MPEP 2285:

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

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

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

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

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

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

8. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the reissue application will be held abandoned, and the merger will be dissolved. With respect to the reexamination proceeding, the USPTO Director will proceed to issue a reexamination certificate under 37 CFR 1.570 in accordance with the last action of the Office, unless further action is clearly

needed as a result of the difference in rules relating to reexamination and reissue proceedings. For any further action in the reexamination proceeding, any grounds of rejection that are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner upon dissolution of the merged proceeding. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 CFR 1.552(c).

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

IV. Waiver of the Two Month Delay Period for the Reissue Application

MPEP 1441 ("Two-Month Delay Period") provides as follows:

> "Generally, a reissue application will not be acted on sooner than 2 months after announcement of the filing of the reissue has appeared in the *Official Gazette*. The 2-month delay is provided in order that members of the public may have time to review the reissue application and submit pertinent information to the Office before the examiner's action. The pertinent information is submitted in the form of a protest under 37 CFR 1.291(a)."

In the present instance, the filing of the reissue application has not yet been announced in the *Official Gazette*. Once the reissue application is announced in the *Official Gazette*, action would not be taken by the Office for the reissue application until two months from the announcement date, and action in the copending reexamination proceeding would be delayed accordingly. Waiver of the 2-month delay provision of MPEP 1441 is appropriate in view of the facts and circumstances in the present instance, including the extended pendency for both of the proceedings, taken with the statutory requirement that the '6997 reexamination proceeding be conducted with special dispatch within the Office, pursuant to 35 U.S.C. 305. The two-month delay period is therefore waived under 37 CR 1.182, and the present merger decision is being issued at this time.

The present action taken by the Office does not close or remove the public's opportunity to protest the reissue application. Should a protest be filed in this application within two months from the date of the *Official Gazette* announcement, the examiner is instructed to proceed according to the provisions of 37 CFR 1.291, as well as MPEP §§ 1901.04 and 1901.06.

In the event that an early determination of allowable/patentable subject matter is made by the examiner and made known to the patent owner/applicant, the merged proceeding would be retained in the Technology Center pending expiration of the MPEP 1441 two-month delay period, prior to the mailing of a formal Notice of Allowance.

CONCLUSION

1. Reissue application No. 29/217870 and reexamination control No. 90/006,867 are hereby **merged** into a single proceeding.

2. The merged reissue and reexaminations proceeding and its files are being forwarded to the Office of the Special Program Examiner, Technology Center 2900, **for processing to obtain announcement (publication) of the filing of the reissue application in the *Official Gazette*.** The proceeding and its files will then be forwarded to the examiner for prompt action on the merged proceeding.

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

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

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

April 3, 2006
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OFFICE OF PETITIONS

ROBERT F. FRIJOUF
FRIJOUF, RUST & PYLE, P.A.
201 EAST DAVIS BOULEVARD
TAMPA, FL 33606

In re Application of :

Larry G. Junker :
Application No. 29/217,870 :
Filed: July 21, 2003 :
Attorney Docket No. 2003-0073 :

DECISION ON PETITION
TO WITHDRAW
FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b) filed April 19, 2007.

The request is **APPROVED**.

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

The request was signed by Robert F. Frijouf on behalf of himself.

Robert F. Frijouf has been withdrawn as attorney or agents of record; all other attorneys remain of record.

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

The correspondence address of record remains unchanged.

There is an outstanding Office action mailed April 2, 2007 that requires a reply from the applicant.

Telephone inquiries concerning this decision should be directed to undersigned at 571-272-1642.

April M. Wise
Petitions Examiner
Office of Petitions

cc: LARRY G. JUNKER
8930 ROAN LANE EAST
INVERNESS, FL 34450

Copied from 29217870 on 03/19/2008

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John S. Mortimer (For Third Party Requester)
Wood, Phillips, Katz, Clark & Mortimer
500 West Madison Street
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Chicago, IL 60661-2511

MAILED

JUN 20 2005

REEXAM UNIT

In re Reissue Application of
Schjerven, Sr. et al.
Application No. 10/991,326
Filed: November 17, 2004
For: U.S. Patent No. 6,481,433

In re Schjerven, Sr. et al.
Reexamination Proceeding
Control No. 90/006,868
Filed: November 17, 2003
For: U.S. Patent No. 6,481,433

DECISION, *SUA SPONTE*, TO MERGE REISSUE AND REEXAMINATION PROCEEDINGS

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

REVIEW OF FACTS

1. U.S. patent No. 6,481,433 issued on November 19, 2002, with 11 claims.

2. A request for reexamination was filed by a third party requester on November 17, 2003, and was assigned control No. 90/006,868 (hereinafter, the '6868 proceeding).

3. Reexamination was ordered for the '6868 reexamination proceeding on January 26, 2004.

4. An application for reissue, assigned application No. 10/991,326 was filed by the patent owner on November 17, 2004.

5. A patent owner's statement under 37 CFR 1.530 was not received in the '6868 proceeding.

6. Notification of the filing of the reissue application was published in the *Official Gazette* on January 25, 2005.

7. A Notice of Concurrent Proceedings under 37 CFR 1.565(a) was filed by the patent owner in the '6868 proceeding on January 10, 2005.

DISCUSSION REGARDING MERGER

Under 37 CFR 1.565(d):

> "If a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings."

As evidenced by the above review of facts, reissue application No. 10/991,326 and reexamination control No. 90/006,868 are currently pending. Since the order to reexamine has been mailed in the reexamination proceeding, a decision under 37 CFR 1.565(d) is timely.

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

In order to provide efficient and prompt handling of the reissue

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

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

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

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

II. Requirement for Same Amendments in Both Proceedings

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

2. A review of the reexamination file for reexamination control No. 90/006,868 shows that original patent claims 1-11 are present. A review of reissue application No. 10/991,326 shows that original patent claims 1-11 are present and new claims 12-49 have been added by a preliminary amendment, filed on November 17, 2004, the date the reissue application was filed. **Accordingly, the claims are not identical in both proceedings.**

   An appropriate housekeeping amendment is required

within ONE (1) MONTH of this decision placing the same amendments in both cases, specifically, Application No. 10/991,326 and Control Number 90/006,868. The response to the requirement must be limited to placing the same amendments in all cases, and patent owner must **not** address any issue of patentability in the housekeeping amendment. It is to be noted that, pursuant to MPEP 2285, amendments in a merged proceeding for a reissue and reexamination are submitted in accordance with the reissue practice under 37 CFR 1.173.

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

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

2. In the event that a housekeeping amendment is not timely submitted, any claim which does not contain identical text in both proceedings should be rejected under 35 U.S.C. 112, paragraph 2, as being indefinite as to the content of the claims, and thus failing to particularly point out the invention.

3. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. 305 relating to the conduct of *ex parte* reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue-application examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. **However, periods of response should be set at TWO (2) months to comply with the statutory requirement for special dispatch in reexamination (35 U.S.C. 305).**

4. Each Office action issued by the examiner will take the form of a *single action* which jointly applies to the reissue application and the reexamination proceeding. Each action will contain identifying data *for both of the cases*, i.e, the reissue application and the reexamination proceeding, and each action will be entered into both files (which will be maintained as

separate files).

5. Any response by the applicant/patent owner must consist of a single response, with two copies being filed for entry in the two files, with each of the two bearing a signature. *Any such 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 a reissue application. Accordingly, clean copies of the amended claims are not required, *and such clean copies are not to be submitted*. Instead, pursuant to 37 CFR 1.173(b)(2), amendments are to be presented via markings pursuant to 37 CFR 1.173(d), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

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

8. Upon return of the present merged proceeding to the

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

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

10. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be dissolved. The reissue application will be held abandoned. The reexamination prosecution will be terminated and a reexamination certificate under 37 CFR 1.570 will be issued in accordance with the last action of the Office, unless further action in the reexamination proceeding is needed as a result of the difference in the rules relating to reexamination and reissue proceedings. If further action in the reexamination proceeding is needed, any grounds of rejection which are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner, upon dissolution of the merged proceeding. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 CFR 1.552(c).

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

CONCLUSION

1. Reissue application No. 10/991,326 and reexamination control No. 90/006,868 **are merged** into a single proceeding.

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

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

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 Elizabeth L. Dougherty, Senior Legal Advisor, at (571) 272-7733.

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

June 17, 2005
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(For Patent Owner)

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(For Requester)

JOHN S. MORTIMER
WOOD, PHILLIPS, KATZ, CLARK & MORTIMER
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CHICAGO IL 60661-2511

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APR 14 2009

OFFICE OF PETITIONS

In re Schjerven et al.
Reexamination Proceeding
Control No. 90/006,868
Request Deposited: November 17, 2003
For: U.S. Patent No. 6,481,433
Attorney Docket No. 202170-0481

In re Schjerven et al.
Application No. 10/991,326
Filed: November 17, 2004
Reissue of U.S. Patent No. 6,481,433
Issued: November 19, 2002
Application No: 09/883,786
Filed: June 18, 2001
Attorney Docket No. 202170-0481-02

DECISION ON PETITION

This is a decision on the petition, styled under 37 CFR 1.47(a) and filed on February 26, 2009, which is being treated as a petition under 37 CFR 1.183 seeking waiver of 37 CFR §§ 1.67 and 1.175 where they require that a supplemental declaration be executed by the legal representative of a deceased named inventor.[1]

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

[1] Once an application has received a fully executed oath or declaration and been placed on the files for examination, the provisions of 37 CFR 1.47 no longer apply. Rather, the remedy for treating an inventor's refusal to also sign a supplemental oath or declaration is waiver of 37 CFR 1.67. See MPEP 603. Since this is a reissue application, 37 CFR §§ 1.172 and 1.175 must also be waived.

The petition is **DISMISSED.**

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. **FAILURE TO TIMELY RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.183."

BACKGROUND

1. On November 17, 2003, a request for *Ex Parte* reexamination of U.S. Patent No. 6,481,433 was deposited. The reexamination proceeding was assigned Control No. 90/006,868,

2. On November 17, 2004, an application was filed for reissue of U.S. Patent No. 6,481,433. The reissue application papers were assigned Application No. 10/991,326.

3. On March 7, 2005, a reissue declaration in compliance with 37 CFR 1.63 and 1.175 was filed, in Application No. 10/991,326 naming William S. Schjerven, Sr., Mark A. Sieron, Bruce Grau, Adrian A. Bruno, Gerald J. Schneeweiss, and Frank Carbonara as joint inventors.

4. On June 20, 2005, a decision merging the above-captioned reissue and reexamination proceedings was mailed.

5. On September 29, 2006, a non-final Office action was mailed for the merged proceedings, requiring a new reissue oath or declaration because the declaration filed with the application fails to identify at least one error, which is relied upon to support the reissue application.

6. On April 2, 2007 (certificate of mailing date March 28, 2007), a three (3) month extension of time was filed, along with an amendment. A supplemental reissue oath or declaration was also filed, signed by all joint inventors except Schneeweiss.[1]

7. On October 1, 2008, a non-final Office action was mailed for the merged proceedings, requiring, *inter alia*, a new reissue oath or declaration signed by all of the inventors or their representatives. A three (3)-month shortened statutory time period for reply was set.

8. On February 26, 2009, the subject petition was filed, along with the petition fee and the fee for a petition for a two (2) month extension of time.

9. Petitioners assert that joint inventor Schneeweiss is deceased and that his widow, Mrs. Sylvia Schneeweiss, is his legal representative. Petitioners state that a copy of the declaration, and a

[1] The declaration was annotated to indicate that Schneeweiss was "DECEASED 8/23/06".

request that the declaration be signed on behalf of the deceased inventor, was sent to the legal representative on two occasions, but that the letters were returned as undeliverable.

DECISION ON PETITION UNDER 37 CFR 1.183
TO WAIVE §§ 1.67 AND 1.175

At the outset, this application bears an original reissue Declaration executed by joint inventors Schjerven, Sieron, Grau, Bruno, Schneeweiss, and Carbonara (*i.e.*, all of the inventors). Thus, the provisions of 37 CFR 1.47 do not apply in this instance. Rather, suspension of the rules under 37 CFR 1.183 may be granted in an "extraordinary situation, when justice requires."

37 CFR 1.42 states that in case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent. Where the inventor dies during the time intervening between the filing of the application and the granting of a patent thereon, the letters patent may be issued to the legal representative upon proper intervention.

In addressing a showing under 37 CFR 1.183, it is appropriate to apply the principles for a showing under 37 CFR 1.47 to the situation at hand. Since now-deceased joint inventor Schneeweiss signed the original declaration, petitioners must show that efforts were made to obtain the signature of his legal representative on the supplemental declaration, and that the legal representative either refused to sign the supplemental reissue declaration, or despite diligent efforts, could not be reached to sign the supplemental reissue declaration.

The facts presented on the record do not adequately establish an extraordinary situation. Petitioner has not sufficiently established any special circumstances of equities that would require suspension of the rules in the interests of justice. In particular, petitioners' showing is deficient in that the requisite proof of diligent efforts to locate the non-signing inventors has not been made.[2]

Petitioners state, via the declaration of assignee's employee, Terry Solar, that a copy of the declaration was sent to the legal representative of the deceased inventor at the address on file at his previous employer on two occasions, but that the mailings were returned as unclaimed and undeliverable, respectively. Petitioners further state that attempts were mailed to contact the legal representative by phone and through a telephone directory search, but were unsuccessful.

A brief Internet search, however, indicates that the legal representative, Mrs. Schneeweiss, may now be living at a different address in Romeoville, IL. Accordingly, petitioners should verify the correct last known address for the legal representative of the deceased inventor, and send a copy of the specification and supplemental reissue declaration, with a request that the legal

[2] MPEP 409.03(d).

representative sign and return it, to the last known address for the legal representative resulting from the search. If no more recent address is discovered, a copy of the search should be attached to any renewed petition.

Petitioners may provide proof that the inventors have refused to sign the supplemental reissue declaration by supplying a copy of the cover letter transmitting the supplemental reissue declaration to the non-signing inventors or in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

If there is a written refusal, petitioners should supply a copy of that written refusal. If a refusal to sign is made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

On the other hand, if the envelope containing the reissue declaration is returned as undeliverable, a copy of the envelope showing that the letter sent to the last known address of the non-signing inventor was return as undeliverable by the post office should be submitted with any renewed petition. Petitioners should provide details of the efforts made to locate the non-signing inventors by telephone or internet directories, and the results of such efforts. If repeated attempts to locate the non-signing inventors are unsuccessful, petitioners will have shown that despite diligent efforts, the inventors could not be located.

Additionally, if a new last known address is discovered for the legal representative of the deceased inventor, that address should be provided with any renewed petition.

CONCLUSION

1. The petition is dismissed. As a petition under 37 CFR 1.183 to waive 1.67, 1.172, and 1.175 is required rather than a petition under 37 CFR 1.47, the petition fee due is $400.00. The balance due of $200.00 will be charged to counsel's deposit account.

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

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

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

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

3. Telephone inquiries related to this decision only should be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.

4. Inquiries regarding petition status or general petition information are handled by the Office of Petitions staff at (571) 272-9282.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

MICHAEL BEST & FRIEDRICH
TWO PRUDENTIAL PLAZA
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CHICAGO IL 60601

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JUL 21 2009

OFFICE OF PETITIONS

(For Requester)

JOHN S. MORTIMER
WOOD, PHILLIPS, KATZ, CLARK & MORTIMER
500 WEST ST., SUITE 3800
CHICAGO IL 60661-2511

In re Schjerven et al. Reexamination Proceeding Control No. 90/006,868 Request Deposited: November 17, 2003 For: U.S. Patent No. 6,481,433 Attorney Docket No. 202170-0481	:	
In re Schjerven et al. Application No. 10/991,326 Filed: November 17, 2004 Reissue of U.S. Patent No. 6,481,433 Issued: November 19, 2002 Application No: 09/883,786 Filed: June 18, 2001 Attorney Docket No. 202170-0481-02	:	DECISION ON PETITION

This is a decision on the renewed petition filed on June 12, 2009 under 37 CFR 1.183 seeking waiver of 37 CFR §§ 1.67 and 1.175 where they require that a supplemental declaration be executed by the legal representative of a deceased named inventor.[1]

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

The petition is again **DISMISSED.**

[1] Once an application has received a fully executed oath or declaration and been placed on the files for examination, the provisions of 37 CFR 1.47 no longer apply. Rather, the remedy for treating an inventor's refusal to also sign a supplemental oath or declaration is waiver of 37 CFR 1.67. See MPEP 603. Since this is a reissue application, 37 CFR §§ 1.172 and 1.175 must also be waived.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. **FAILURE TO TIMELY RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION**. The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.183."

BACKGROUND

1. On November 17, 2003, a request for *Ex Parte* reexamination of U.S. Patent No. 6,481,433 was deposited. The reexamination proceeding was assigned Control No. 90/006,868,

2. On November 17, 2004, an application was filed for reissue of U.S. Patent No. 6,481,433. The reissue application papers were assigned Application No. 10/991,326.

3. On March 7, 2005, a reissue declaration in compliance with 37 CFR 1.63 and 1.175 was filed, in Application No. 10/991,326 naming William S. Schjerven, Sr., Mark A. Sieron, Bruce Grau, Adrian A. Bruno, Gerald J. Schneeweiss, and Frank Carbonara as joint inventors.

4. On June 20, 2005, a decision merging the above-captioned reissue and reexamination proceedings was mailed.

5. On September 29, 2006, a non-final Office action was mailed for the merged proceedings, requiring a new reissue oath or declaration because the declaration filed with the application fails to identify at least one error, which is relied upon to support the reissue application.

6. On April 2, 2007 (certificate of mailing date March 28, 2007), a three (3) month extension of time was filed, along with an amendment. A supplemental reissue oath or declaration was also filed, signed by all joint inventors except Schneeweiss.[1]

7. On October 1, 2008, a non-final Office action was mailed for the merged proceedings, requiring, *inter alia*, a new reissue oath or declaration signed by all of the inventors or their representatives. A three (3)-month shortened statutory time period for reply was set.

8. On February 26, 2009, the original petition was filed along with the petition fee and the fee for a petition for a two (2) month extension of time. Petitioners asserted, in the original petition, that joint inventor Schneeweiss is deceased and that his widow, Mrs. Sylvia Schneeweiss, is his legal representative. Petitioners stated that a copy of the declaration, and a request that the declaration be signed on behalf of the deceased inventor, was sent to the legal representative on two occasions, but that the letters were returned as undeliverable.

[1] The declaration was annotated to indicate that Schneeweiss was "DECEASED 8/23/06".

9. On April 14, 2009, the petition was dismissed because petitioners did not provide sufficient proof that the legal representative of the deceased inventor had refused to sign or could not be reached to sign the declaration.

10. On June 12, 2009, the subject renewed petition was filed, accompanied by a copy of a "DECLARATION Supplemental Sheet For Legal Representatives (35 U.S.C. 117) On Behalf of A Deceased or Incapacitated Inventor" PTO/SB/02LR form executed on behalf of deceased inventor Schneeweiss by his widow and legal representative, Mrs. Sylvia Schneeweiss.

DECISION ON PETITION UNDER 37 CFR 1.183
TO WAIVE §§ 1.67 AND 1.175

The petition is again dismissed because an oath or declaration in compliance with 37 CFR 1.42, 1.67 and 1.175 has not been presented. Specifically, the PTO/SB/02LR declaration form signed by the legal representative contains a non-initialed and non-dated interlineation. The typewritten citizenship of "USA" has been lined out and replaced with "British UK." The alteration, however, has not been initialed and dated.

37 CFR 1.52(c)(1) states that any interlineation, erasure, cancellation or other alteration of the application papers filed must be made before the signing of any accompanying oath or declaration pursuant to § 1.63 referring to those application papers and should be dated and initialed or signed by the applicant on the same sheet of paper.

A new oath or declaration signed on behalf of the legal representative of the deceased inventor should be filed with a renewed petition.

CONCLUSION

1. The petition is dismissed. No further petition fee is due.

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

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

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

By hand: Customer Service Window
Mail Stop Petition

Randolph Building
401 Dulany Street
Alexandria, VA 22314

3. Telephone inquiries related to this decision only should be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.

4. Inquiries regarding petition status or general petition information are handled by the Office of Petitions staff at (571) 272-9282.

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

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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(For Requester)

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In re Schjerven et al.
Reexamination Proceeding
Control No. 90/006,868
Request Deposited: November 17, 2003
For: U.S. Patent No. 6,481,433
Attorney Docket No. 202170-0481

In re Schjerven et al.
Application No. 10/991,326
Filed: November 17, 2004
Reissue of U.S. Patent No. 6,481,433
Issued: November 19, 2002
Application No: 09/883,786
Filed: June 18, 2001
Attorney Docket No. 202170-0481-02

DECISION ON PETITION

This is a decision on the renewed petition filed on August 27, 2009 under 37 CFR 1.183 seeking waiver of 37 CFR §§ 1.67 and 1.175 where they require that a supplemental declaration be executed by the legal representative of a deceased named inventor.

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

The petition is **DISMISSED AS MOOT.**

BACKGROUND

1. On November 17, 2003, a request for *Ex Parte* reexamination of U.S. Patent No. 6,481,433 was deposited. The reexamination proceeding was assigned Control No. 90/006,868,

2. On November 17, 2004, an application was filed for reissue of U.S. Patent No. 6,481,433. The reissue application papers were assigned Application No. 10/991,326.

3. On March 7, 2005, a reissue declaration in compliance with 37 CFR 1.63 and 1.175 was filed, in Application No. 10/991,326 naming William S. Schjerven, Sr., Mark A. Sieron, Bruce Grau, Adrian A. Bruno, Gerald J. Schneeweiss, and Frank Carbonara as joint inventors.

4. On June 20, 2005, a decision merging the above-captioned reissue and reexamination proceedings was mailed.

5. On September 29, 2006, a non-final Office action was mailed for the merged proceedings, requiring a new reissue oath or declaration because the declaration filed with the application fails to identify at least one error, which is relied upon to support the reissue application.

6. On April 2, 2007 (certificate of mailing date March 28, 2007), a three (3) month extension of time was filed, along with an amendment. A supplemental reissue declaration was also filed, signed by all joint inventors except Schneeweiss.[1]

7. On October 1, 2008, a non-final Office action was mailed for the merged proceedings, requiring, *inter alia*, a new reissue oath or declaration signed by all of the inventors or their representatives. A three (3)-month shortened statutory time period for reply was set.

8. On February 26, 2009, the original petition was filed along with the petition fee and the fee for a petition for a two (2) month extension of time. Petitioners asserted, in the original petition, that joint inventor Schneeweiss is deceased and that his widow, Mrs. Sylvia Schneeweiss, is his legal representative. Petitioners stated that a copy of the declaration, and a request that the declaration be signed on behalf of the deceased inventor, was sent to the legal representative on two occasions, but that the letters were returned as undeliverable.

9. On April 14, 2009, the petition was dismissed because petitioners did not provide sufficient proof that the legal representative of the deceased inventor had refused to sign or could not be reached to sign the declaration.

10. On June 12, 2009, a renewed petition was filed, accompanied by a copy of a "DECLARATION Supplemental Sheet For Legal Representatives (35 U.S.C. 117) On Behalf of

[1] The declaration was annotated to indicate that Schneeweiss was "DECEASED 8/23/06".

A Deceased or Incapacitated Inventor" PTO/SB/02LR form executed on behalf of deceased inventor Schneeweiss by his widow and legal representative, Mrs. Sylvia Schneeweiss.

11. On July 21, 2009, the renewed petition was dismissed because an oath or declaration in compliance with 37 CFR 1.42, 1.67 and 1.175 had not been presented. Specifically, the declaration form signed by the legal representative contained a non-initialed and non-dated interlineation.

12. On August 27, 2009, the subject renewed petition was filed. The petition is accompanied by a new PTO/SB/02LR form executed on behalf of deceased inventor Schneeweiss by his widow and legal representative, Mrs. Sylvia Schneeweiss.

DECISION ON PETITION UNDER 37 CFR 1.183
TO WAIVE §§ 1.67 AND 1.175

As a fully executed declaration in compliance with 37 CFR 1.42, 1.67, and 1.175, signed by all of the inventors, or, in the case of the deceased inventor, his legal representative, has been supplied, the requirements of 37 CFR 1.67 and 1.175 have been satisfied. Accordingly, it is unnecessary to waive 37 CFR 1.67 and 1.175. The petition under 37 CFR 1.183 is therefore dismissed as moot.

CONCLUSION

1. The petition is **dismissed as moot**.

2. The merged application and reexamination proceeding is referred to Technology Center 3749 for further processing.

3. Telephone inquiries related to this decision only should be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.

4. Inquiries regarding petition status or general petition information are handled by the Office of Petitions staff at (571) 272-9282.

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

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.
90/006,876 90/007,166	11/25/2003	4797599	15343US01	2296

7590 04/15/2005

Max Moskowitz
Ostrolenk, Faber, Gerb & Soffen
1180 Avenue of the Americas
New York, NY 10036-8403

EXAMINER
W. Lee

ART UNIT	PAPER NUMBER
2821	

DATE MAILED: 04/15/2005

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

James P. Murphy
McAndrews, Held & Malloy, Ltd.
500 West Madison Street, 34th Floor
Chicago, IL 60661

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/007,166, 90/006,876

PATENT NO. 4797599.

ART UNIT 2800.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Paper No. 10

Max Moskowitz (for Patent Owner)
Ostrolenk, Faber, Gerb & Soffen
1180 Avenue of the Americas
New York, NY 10036-8403

James P. Murphy (for Third Party Requester)
McAndrews, Held & Malloy, Ltd.
500 West Madison Street, 34th Floor
Chicago, IL 60661

In re Jonathan H. Ference *et al.* Reexamination Proceeding Control No. 90/006,876 Filed: November 25, 2003 For: U.S. Patent No. 4,797,599	:	DECISION MERGING REEXAMINATION PROCEEDINGS
In re Jonathan H. Ference *et al.* Reexamination Proceeding Control No. 90/007,166 Filed: August 10, 2004 For: U.S. Patent No. 4,797,599	:	

The above-identified reexamination files are before the Director of Examining Group 2820, Technology Center 2800, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 4,797,599 issued on January 10, 1989.

2. Reexamination Control No. 90/6,876 was filed by the third party requester on November 25, 2003.

3. Reexamination was ordered in the '6876 reexamination proceeding on February 12, 2004.

4. Reexamination Control No. 90/007,166 was filed by the same third party requester on August 10, 2004.

8. Reexamination was ordered in the '7166 reexamination proceeding on November 9, 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 § 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 '6876 and '7166 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. '6876 and '7166 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.

James Dwyer, 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.
90/006,881	12/05/2003	6412628	47636.20.0	2416

7590 05/05/2004

Cohen & Grigsby P, C.
11 Stanwix Street 15th Floor
Pittsburgh, PA 15222

EXAMINER
LUONG

ART UNIT	PAPER NUMBER
3728	18

DATE MAILED: 05/05/2004

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

PTO-90C (Rev. 10/03)

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Paper No. 18

Cohen & Grigsby, P.C. 11 Stanwix Street, 15th Floor Pittsburgh, PA 15222	For Patent Owner
Kate DeVries Smith Merchant & Gould, P.C. P.O. Box 2903 Minneapolis, MN 55402-0902	For Requester
Natalie D. Kadievitch Fredrikson & Byron, P.A. 4000 Pillsbury Ctr. 200 S. 6th Street Minneapolis, MN 55402-1425	
In re Reexamination Control No. 90/006,411 Request Filed: October 11, 2002 U.S. Patent No. 6,412,628 Issued: July 2, 2002 Patentee: Tramposch	DECISION, *SUA SPONTE*, MERGING REEXAMINATION PROCEEDINGS
In re Reexamination Control No. 90/006,881 Request Filed: December 5, 2003 For: U.S. Patent No. 6,412,628 Issued: July 2, 2002 Patentee: Tramposch	

The above noted reexamination files are before the Director of Patent Examining Group 3700 for consideration of merger of the proceedings under 37 CFR 1.565(c), in accordance with the practice set forth at MPEP § 2283.

Preliminary Matters

On January 13, 2004, in the '411 proceeding, the examiner promulgated a non-final Office action in which a two month shortened statutory period for filing a reply was set and continues to run.. Extensions of time to that action can only be obtained pursuant to 37 CFR 1.550(c). On January 22, 2004, the examiner issued an Order granting the request for reexamination in the '881 proceeding. The time for filing a patent owner's statement in the '881 proceeding was set at two months pursuant to 37 CFR 1.535, and the time for filing the owner's statement has expired.

Merger of Copending Reexamination Proceedings

I. Merger of Proceedings

As required by the practice pursuant to MPEP § 2283, and under the authority of 37 CFR 1.565(c), the 90/006,411 reexamination proceeding and the 90/006,881 reexamination proceeding are hereby MERGED. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in Both Proceedings

Patent owner is required to maintain identical claims, drawings and specifications in both files. The contents of each file will hereafter be maintained identically, and all actions promulgated and papers filed subsequent to this Decision will bear the same paper number. This Decision is paper No. 18 in both files. There will be no paper Nos. 9-17 in Control No. 90/006,881.

III. Housekeeping Amendment

As discussed above, owner is required to file a reply to the outstanding Office action in the '411 proceeding. The period for filing that reply remains as set therein, and may only be extended pursuant to 37 CFR 1.550(c). Owner is **required** to file a housekeeping amendment in control No. 90/006,881 making the claims therein identical to the claims in the '881 proceeding, as well as making the specification and drawings in the '881 proceeding identical to the specification and drawings in the '411 proceeding if amendments to these items have also been made during the prosecution to date.

If patent owner files the reply in the '411 proceeding without requesting an extension of time, that paper will be paper No. 19 in the '411 proceeding. In the '881 proceeding, Owner should then file a housekeeping amendment as discussed in the immediately proceeding paragraph, which incorporates the changes (if any) made in the reply filed in the '411 proceeding together with any other changes necessary to make the specification, claims and drawings identical in both proceedings. The housekeeping amendment will then be paper No. 19 in the '881 proceeding.

If patent owner requests an extension of time in the '411 proceeding, then a duplicate copy of the request must be filed in the '881 proceeding. The request for extension of time will be entered as paper No. 19 in each proceeding, and if granted, the Decision granting the request will set a period of time in which the reply in the '411 proceeding and the housekeeping amendment in the '881 proceeding must both be filed. **In the absence of a granted request for extension of time in the '411 proceeding, owner is required to file the housekeeping amendment not later than ONE MONTH from the date of this decision.** Attention is invited to MPEP § 2282, subsection entitled "Merger of Reexaminations", last paragraph.

IV. Conduct of Merged Proceeding

All letters mailed by the Office will take the form of a single combined action which applies to both proceedings, and which will cross-reference the two proceedings. A separate action cover form for each proceeding will be printed by the PALM printer for each of the two reexamination control numbers. Owner will receive one copy of the body of the action, and a copy of the cover sheet (*e.g.* Form PTO-466) for the action from both proceedings. Each requester will receive a copy of the body of the action and a copy of the cover sheet for the proceeding filed by that requester. All papers filed by owner **subsequent to** the items in Section III above will contain the identifying data for **both** files and will be physically entered in each reexamination file. All such papers **must** consist of a single response, **filed in duplicate**, each bearing an original signature, for entry in each file. Owner and requester are reminded that **every** paper filed in the merged proceeding subsequent to this Decision must be served on the other party, including papers filed *via* facsimile transmission. Owner is asked to review 37 CFR 1.530 and MPEP § 2250 prior to filing any amendments to the drawings, specification or claims in order to make sure that the amendments are in proper format. **Clean copies of the amended claims are not required; only so called "marked-up" claims and paragraphs in which specification amendments are requested are to be filed, together with material satisfying the requirements of 37 CFR 1.530(e).** All words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets. New drawing figures must be labeled "New", while amended drawing figures must be labeled "Amended".

V. Citation of Patents and Printed Publications

Following the filing of the housekeeping amendment, the examiner will promulgate an action on the merits of the claims. The examiner will review the files to insure that each file contains identical citations of prior patents and printed publications, and will make cite such documents as are necessary as part of the next action in order to place the files in that condition.

The reexamination proceeding files are being returned to storage in the Technology Center 3700 Central Files awaiting the filing of the above described papers. Unless an extension of time is requested and granted in both proceedings, the reply in the '411 proceeding must be filed not later than March 18, 2004, and the housekeeping amendment **must** be filed **not later than one month from the date of this decision.**

E. Rollins-Cross, Director
Technology Center 3700

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,881	12/05/2003	6412628	47636.20.0	2416

7590 05/11/2004

Cohen & Grigsby P, C.
11 Stanwix Street 15th Floor
Pittsburgh, PA 15222

EXAMINER
LUONG

ART UNIT	PAPER NUMBER
3728	19

DATE MAILED: 05/11/2004

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

PTO-90C (Rev. 10/03)

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COMMISSIONER FOR PATENTS
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Paper No. 19

Cohen & Grigsby, P.C. 11 Stanwix Street, 15th Floor Pittsburgh, PA 15222	: For Patent Owner
Kate DeVries Smith Merchant & Gould, P.C. P.O. Box 2903 Minneapolis, MN 55402-0902	: For Requester
Natalie D. Kadievitch Fredrikson & Byron, P.A. 4000 Pillsbury Ctr. 200 S. 6th Street Minneapolis, MN 55402-1425	
In re Reexamination Control No. 90/006,411 Request Filed: October 11, 2002 U.S. Patent No. 6,412,628 Issued: July 2, 2002 Patentee: Tramposch	: CORRECTED : DECISION, *SUA SPONTE*, : MERGING REEXAMINATION : PROCEEDINGS
In re Reexamination Control No. 90/006,881 Request Filed: December 5, 2003 For: U.S. Patent No. 6,412,628 Issued: July 2, 2002 Patentee: Tramposch	

The above noted reexamination files are before the Director of Patent Examining Group 3700 for consideration of merger of the proceedings under 37 CFR 1.565(c), in accordance with the practice set forth at MPEP § 2283.

Preliminary Matters

On March 18, 2004, in the '411 proceeding, the examiner promulgated a non-final Office action in which a two month shortened statutory period for filing a reply was set and continues to run. Extensions of time to that action can only be obtained pursuant to 37 CFR 1.550(c). On January 22, 2004, the examiner issued an Order granting the request for reexamination in the '881 proceeding. The time for filing a patent owner's statement in the '881 proceeding was set at two months pursuant to 37 CFR 1.535, and the time for filing the owner's statement has expired.

Merger of Copending Reexamination Proceedings

I. Merger of Proceedings

As required by the practice pursuant to MPEP § 2283, and under the authority of 37 CFR 1.565(c), the 90/006,411 reexamination proceeding and the 90/006,881 reexamination proceeding are hereby MERGED. The merged proceeding will be conducted in accordance with the following guidelines and requirements. This Corrected Decision replaces paper No. 18, the Decision mailed on May 5, 2004.

II. Requirement for Same Amendments in Both Proceedings

Patent owner is required to maintain identical claims, drawings and specifications in both files. The contents of each file will hereafter be maintained identically, and all actions promulgated and papers filed subsequent to this Corrected Decision will bear the same paper number. This Corrected Decision is paper No. 19 in both files. There will be no paper Nos. 9-17 in Control No. 90/006,881.

III. Housekeeping Amendment

As discussed above, owner is required to file a reply to the outstanding Office action in the '411 proceeding. The period for filing that reply remains as set therein, and may only be extended pursuant to 37 CFR 1.550(c). Owner is **required** to file a housekeeping amendment in control No. 90/006,881 making the claims therein identical to the claims in the '881 proceeding, as well as making the specification and drawings in the '881 proceeding identical to the specification and drawings in the '411 proceeding if amendments to these items have also been made during the prosecution to date.

If patent owner files the reply in the '411 proceeding without requesting an extension of time, that paper will be paper No. 20 in the '411 proceeding. In the '881 proceeding, Owner should then file a housekeeping amendment as discussed in the immediately proceeding paragraph, which incorporates the changes (if any) made in the reply filed in the '411 proceeding together with any other changes necessary to make the specification, claims and drawings identical in both proceedings. The housekeeping amendment will then be paper No. 20 in the '881 proceeding.

If patent owner requests an extension of time in the '411 proceeding, then a duplicate copy of the request must be filed in the '881 proceeding. The request for extension of time will be entered as paper No. 20 in each proceeding, and if granted, the Decision granting the request will set a period of time in which the reply in the '411 proceeding and the housekeeping amendment in the '881 proceeding must both be filed. **In the absence of a granted request for extension of time in the '411 proceeding, owner is required to file the housekeeping amendment not later than ONE MONTH from the date of this decision.** Attention is invited to MPEP § 2282, subsection entitled "Merger of Reexaminations", last paragraph.

IV. Conduct of Merged Proceeding

All letters mailed by the Office will take the form of a single combined action which applies to both proceedings, and which will cross-reference the two proceedings. A separate action cover form for each proceeding will be printed by the PALM printer for each of the two reexamination control numbers. Owner will receive one copy of the body of the action, and a copy of the cover sheet (*e.g.* Form PTO-466) for the action from both proceedings. Each requester will receive a copy of the body of the action and a copy of the cover sheet for the proceeding filed by that requester. All papers filed by owner **subsequent to** the items in Section III above will contain the identifying data for **both** files and will be physically entered in each reexamination file. All such papers **must** consist of a single response, **filed in duplicate**, each bearing an original signature, for entry in each file. Owner and requester are reminded that **every** paper filed in the merged proceeding subsequent to this Decision must be served on the other party, including papers filed *via* facsimile transmission. Owner is asked to review 37 CFR 1.530 and MPEP § 2250 prior to filing any amendments to the drawings, specification or claims in order to make sure that the amendments are in proper format. **Clean copies of the amended claims are not required; only so called "marked-up" claims and paragraphs in which specification amendments are requested are to be filed, together with material satisfying the requirements of 37 CFR 1.530(e).** All words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets. New drawing figures must be labeled "New", while amended drawing figures must be labeled "Amended".

V. Citation of Patents and Printed Publications

Following the filing of the housekeeping amendment, the examiner will promulgate an action on the merits of the claims. The examiner will review the files to insure that each file contains identical citations of prior patents and printed publications, and will make cite such documents as are necessary as part of the next action in order to place the files in that condition.

The reexamination proceeding files are being returned to storage in the Technology Center 3700 Central Files awaiting the filing of the above described papers. Unless an extension of time is requested and granted in both proceedings, the reply in the '411 proceeding must be filed not later than May 18, 2004, and the housekeeping amendment **must** be filed **not later than one month from the date of this Corrected Decision.**

E. Rollins-Cross, Director
Technology Center 3700

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Ben J. Yorks, Esq. (For Patent Owner)
Irell & Manella LLP
840 Newport Center Drive, Suite 400
Newport Beach, CA 92660

MAR 0 6 2006

Schretmueller et al	:	
Reexamination Proceeding	:	**DECISION**
Control No. 90/006,883	:	**GRANTING**
Filed: December 9, 2003	:	**PETITION**
For: U.S. Patent No. 6,185,540	:	

This is a decision on the May 9, 2005, patent owner PETITION FOR REVIVAL OF TERMINATED REEXAMINATION PROCEEDING UNDER 37 C.F.R. § 1.550(e)(2), 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 $1,500.00 set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b) has been charged to petitioner's Deposit Account No. 90-0946, in accordance with petitioner's authorization on the cover sheet of the petition.

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

DECISION ON PETITION UNDER 37 CFR 1.137(b)

The original copy of the instant petition dated May 9, 2005, was not placed in the paper file for this reexamination proceeding. Subsequently, on November 30, 2005, petitioner sent via facsimile a copy of the materials first mailed on May 6, 2005. Included with the materials was a photocopy of the mailing receipt postcard stamped by the Office of Initial Patent Examination on May 9, 2005.

The facsimile copy of the instant petition has been entered in the file as Paper No. 9, and the facsimile copy of the Supplemental Preliminary Amendment accompanying the petition has been entered in the file as Paper No. 10.

It is noted that while the mailing receipt bears the correct control number of **90/006,883**, the transmittal form, fee

transmittal, supplemental preliminary amendment, and petition all incorrectly list the control number as **90/006,882**. A subsequent review of file 90/006,882 did not locate the missing petition and materials first mailed on May 6, 2005. Petitioner is advised to review all further correspondence in this proceeding prior to mailing to ensure that the correct control number is used.

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 petition contains a Supplemental Preliminary Amendment, thereby providing the response "required to the outstanding Office action or notice" pursuant to 37 CFR 1.137(b)(1). Further, the required petition fee is being charged to petitioner's deposit account as authorized on the cover page of the 37 CFR 1.137(b) petition, thereby providing the "petition fee as set forth in 37 CFR 1.17(m)" pursuant to 37 CFR 1.137(b)(2). Accordingly, the petition under 37 CFR 1.137(b) is granted.

CONCLUSION

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

2. Jurisdiction over the reexamination proceeding is being returned to the Central Reexamination Unit for consideration, in due course, of the Supplemental Preliminary Amendment dated May 6, 2005, to accompany the petition.

3. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Mike O'Neill, in Art Unit 3993, who can be reached at (571) 272-4442.

4. Telephone inquiries related to this decision should be directed to Samuel Broda at (571)272-7711.

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

SSB
3/3/2006

mw

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JAMES T. JONES (For Patent Owner)
PFIZER INC.
PATENT DEPRTMENT, MS 8260-1611
EASTERN POINT ROAD
GROTON, CT 06340

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP (For Requester Lilly Corporation)
1300 I Street, N.W.
Suite 700
Washington DC 20005-3315

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 08 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
C:\Kiva\Kenpet6\ 7614reassign_4th_3PR_req_disniss.doc

UNITED STATES PATENT AND TRADEMARK OFFICE

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Mailed: December 6, 2004

GREGG C. BENSON PFIZER, INC. PATENT DEPARTMENT MS 4159 EASTERN POINT ROAD GROTON CT 06340	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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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,886	12/15/2003	6469012	02021.8075-00000	8015

7590 08/19/2005

EXAMINER

Gregg C. Benson
Pfizer, Inc.
Patent Department MS 4159
Eastern Point Road
Groton, CT 06340

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. PATENT DEPARTMENT MS 4159 EASTERN POINT ROAD GROTON CT 06340	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
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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

FINNEGAN, HENDERSON, FARABOW
GARRETT & DUNNER, LLP
1300 I STREET, NW, SUITE 700
WASHINGTON, DC 20005

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.
90/006,894	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
	16

DATE MAILED: 05/14/2004

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CST

Paul M. Richter, Jr. Kenyon & Kenyon One Broadway New York, NY 10004	(for Patent Owner)
Oblon, Spivak, McClelland, Maier & Neustadt, PC 1940 Duke Street Alexandria, VA 22314	(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.

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.
90/006,894	12/23/2003	5578684	253808	3206

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

Paul M. Richter, Jr. Kenyon & Kenyon One Broadway New York, NY 10004	:	(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	:	**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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,896	12/24/2003	5656996	114944-00401	3208

27557 7590 06/27/2005

BLANK ROME LLP
600 NEW HAMPSHIRE AVENUE, N.W.
WASHINGTON, DC 20037

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/27/2005

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

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BLANK ROME LLP
600 NEW HAMPSHIRE AVENUE, N.W.
WASHINGTON DC 20037

(For Patent Owner)

MAILED
JUN 2 7 2005
REEXAM UNIT

In re Reexamination Proceeding
Peter Houser
Control No. 90/006,896
Filed: December 24, 2003
U.S. Patent No. 5,656,996
Attorney Docket No. 114944-00449

: DECISION GRANTING PETITION

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on June 3, 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 - Response), a $1500.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3).

The petition is granted.

A review of the record reveals that while the present petition authorizes the charging of counsel's deposit account for a petition fee under 37 CFR 1.17(f), (g) or (h), the petition fee for the present petition is set forth in 37 CFR 1.17(m). The present petition does include a catch-all provision "The Commissioner is hereby authorized to charge ... any deficiency of fees..."

The $1,500.00 petition fee will be charged to counsel's deposit account No. 23-2185 in accordance with catch-all provision set forth above.

Thereafter, the reexamination file will be returned to Technology Center Art Unit 2632 for further examination and consideration of the response filed June 3, 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, Toan N. Pham, in Technology Center Art Unit 2632, who can be reached at 571-272-2967.

Telephone inquiries related to this decision should be directed to Fred A. Silverberg at 571-272-7719.

Kenneth M. Schor

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

Fred A. Silverberg

Conferee: Fred A. Silverberg

mas

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BLANK ROME LLP
600 New Hampshire Avenue, N.W.
Washington, DC 20037
New York, NY 10023

For Patent Owner

DECISION DISMISSING
AS MOOT
ONE MONTH
PETITIONS FOR EXTENSION
OF TIME
[37 CFR 1.550(c)]

In re: Houser
Ex Parte Reexamination Proceeding
Control No. 90/006,896
Filed: December 24, 2003
For: US Patent No 5,656,996

MAILED
MAY 16 2006
REEXAM UNIT

This is a decision on the March 17, 2006 and April 17, 2006 petitions by the patent owner "Petition for Extension of Time to Respond to Office Action Pursuant to 37 CFR 1.550 (c)," requesting that the time for responding to the Final Office action dated January 17, 2006, be extended by one month.

The petitions are before the Director of the Central Reexamination Unit for consideration.

The petitions are dismissed as moot for the reasons set forth below.

STATEMENT OF FACTS

1. US Patent No. 5,656,996 was granted on August 12, 1997 to Houser.

2. A request for reexamination was filed on December 24, 2003 by the patent owner

3. The Order for Reexamination was granted on August 5, 2005.

4. A Final Office action was mailed on January 17, 2006.

5. The Patent Owner timely filed a requests for a one month extension of time under 37 CFR 1.550 (c) on March 16, 2006 and April 17, 2006 respectively.

6. The Patent Owner submitted a timely filed After Final response April 17, 2006.

DECISION

The Patent Owner requests a extensions of time in which to file a response to the Office action dated January 17, 2006, which set a two month date for filing a response thereto. The Office action is a Final Office action. The petition for extension of time was timely filed on March 17, 2006 and April 17, 2006, together with petition fee required by 37 CFR 1.515(c). The patent owner followed with an After Final dated April 17, 2006 amendment as a timely response to the Final Action which renders moot the extension of time.

LEGAL BASIS FOR DECISION

MPEP 2272

I. FINAL REJECTION — TIME FOR RESPONSE
The statutory period for response to a final rejection in a reexamination proceeding will normally be two (2) months. If a response to the final rejection is filed, the time period set in the final rejection continues to run. The time period is automatically extended by 1 month (in accordance with the guidelines set forth in MPEP § 2265) if the response is the first response after the final rejection and a notice of appeal has not yet been filed.

ANAYLSIS AND FINDINGS

On balance, it is considered that the petitions are now moot in view of the After Final response by the timely filed patent owner response

CONCLUSION

1. The patent owner's petitions for ONE-MONTH extension of time in which to file a response to the Office action dated March 17, 2006 and April 17, 2206 are **dismissed** as moot in view of the timely responsé.

2. Response may be submitted as follows:

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

By Fax to: (571) 273-9900

Central Reexamination Unit

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

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

MReinhart SPRE CRU 3992
Lissi M. 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

MAILED

JUL 21 2006

CENTRAL REEXAMINATION UNIT

BLANK ROME LLP
600 New Hampshire Avenue, N. W.
Washington, DC 20037

For Patent Owner

DECISION ON PETITION
FOR VACATING FINALITY
OF OFFICE ACTION

In re: Houser
Ex Parte Reexamination Proceeding
Control No. 90/006,896
Filed: December 24, 2003
For: US Patent No. 5,656,996

This is a decision on the July 6, 2006, patent owner "Petition To Withdraw Finality Or Alternatively To Consider The Amendment After Final."

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

The petition is granted in part to withdraw the finality of the outstanding Office action and dismissed as moot in part to consider the amendment after final for the reasons set forth below.

DISCUSSION REGARDING VACATING THE FINAL ACTION

MPEP 2271 is directed to final Office actions in *ex parte* reexamination proceedings and states as follows:

> Before a final action is in order, a clear issue should be developed between the examiner and the patent owner. To bring the prosecution to a speedy conclusion and at the same time deal justly with the patent owner and the public, the examiner will twice provide the patent owner with such information and references as may be useful in defining the position of the Office as to unpatentability before the action is made final. Initially, the decision ordering reexamination of the patent will contain an identification of the new questions of

patentability that the examiner considers to be raised by the prior art considered. In addition, the first Office action will reflect the consideration of any arguments and/or amendments contained in the request, the owner's statement filed pursuant to 37 CFR 1.530, and any reply thereto by the requester, and should fully apply all relevant grounds of rejection to the claims.

...

In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed and any grounds or rejection relied on should be reiterated. The grounds of rejection must (in the final rejection) be clearly developed to such an extent that the patent owner may readily judge the advisability of an appeal. However, where a single previous Office action contains a complete statement of a ground of rejection, the final rejection may refer to such a statement and also should include a rebuttal of any arguments raised in the patent owner's response.

DECISION TO VACATE THE FINAL OFFICE ACTION

On balance, the arguments presented by the Patent Owner are sufficiently persuasive to support the petition for granting vacating the finality of the Office action mailed January 17, 2006. Further, in light of vacating the finality of the Office action mailed January 17, 2006, the request to consider the amendment after final is a moot request and hereby dismissed.

Conclusion

1. The patent owner's petition for withdrawl of the finality of the Office action is granted and the request to consider the amendment after final dismissed as moot for the reasons set forth above.

2. Correspondence by the patent owner 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

3. 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

for

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

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
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,898	12/30/2003	5604531	970966-24-10	5425

49443 7590 07/10/2009

Pearl Cohen Zedek Latzer, LLP
1500 Broadway
12th Floor
New York, NY 10036

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/10/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

RICHARD M. ROSATI
KENYON & KENYON
ONE BROADWAY
NEW YORK, NY 10004

MAILED

JUL 10 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/006898

PATENT NO. 5,604,531

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

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

Pearl Cohen Zedek Latzer, LLP
1500 Broadway
12th Floor
New York NY 10036

(For Patent Owner)

MAILED

JUL 10 2009

CENTRAL REEXAMINATION UNIT

Richard M. Rosati
Kenyon & Kenyon
One Broadway
New York NY 10004

(For Requester)

In re Iddan et al.
Ex Parte Reexamination Proceeding
Control No. 90/006,898
Filed: December 30, 2003
For: U.S. Patent No. 5,604,531

DECISION
DISMISSING PETITION
UNDER 1.182

This is a decision on the June 23, 2009 patent owner petition entitled "PETITION UNDER 37 CFR 1.182 AND REQUEST FOR CONTINUING REEXAMINATION (RCR)."

The patent owner petition is before the Office of Patent Legal Administration.

The petition is **dismissed**.

RELEVANT BACKGROUND

- On February 18, 1997, U.S. Patent No. 5,604,531 was issued to Iddan et al., having claims 1-17 therein.

- On December 30, 2003, a request for *ex parte* reexamination of claims 1-5 and 10-13 of U.S. Patent No. 5,604,531 was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/006,898 ("the '898 proceeding").

- Prosecution progressed until, on April 3, 2006, an Office action was issued, finally rejecting claims 1-3 and 11, and confirming the patentability of claims 4-10 and 12-17.

- On June 27, 2006, the examiner held an interview with patent owner's representative to discuss a proposed amendment submitted by patent owner on June 5, 2006. An interview summary form mailed on that date set forth the examiner's reasons why the proposed amendments would not overcome the prior art of record, would not simplify the issues for appeal, and/or would raise new issues that would require further consideration.

- On July 3, 2006, the Office issued an advisory action stating that the amendment filed June 5, 2006 would not be entered, for the reasons set forth in the interview summary of June 27, 2006.

- The '898 proceeding subsequently entered the appeal process, and, on November 8, 2007, the Office issued an examiner's answer in response to a supplemental appeal brief received on August 23, 2007.

- On May 5, 2009, the Board of Patent Appeals and Interferences issued a decision affirming the rejection of claims 1-3 and 11.

- On June 18, 2009, patent owner submitted a request under 37 CFR 304(a) for extension of the time to seek judicial review.

- On June 23, 2009, patent owner submitted the instant "PETITION UNDER 37 CFR 1.182 AND REQUEST FOR CONTINUING REEXAMINATION (RCR)." The submission further included remarks and an amendment, which amended claims 1, 6, 11, and 14, and added new claims 18-31.

- On June 25, patent owner's request under 37 CFR 304(a) for extension of the time to seek judicial review was granted, extending the time period until September 7, 2009.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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). (emphasis added)

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

37 CFR 1.525(a) provides, in pertinent part:

If a substantial new question of patentability is found pursuant to § 1.515 or § 1.520, the determination will include an order for ex parte reexamination of the patent for **resolution of the question**. (emphasis added)

DECISION

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."[1] Notice was provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding.

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

The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. This is critical in the reexamination setting, where 35 U.S.C. 305 (for *ex parte* reexamination) and 35 U.S.C. 314 (for *inter partes* reexamination) mandate that reexamination proceedings must be conducted "with special dispatch within the Office." Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, as well as an effort to seasonably submit such a petition (rather than waiting to see what happens to the case without the amendment or evidence), since these are key factors in reducing pendency of a reexamination proceeding. Following the same rationale, the requirement of special dispatch permits continued prosecution only where the need for the patent owner's proposed response could not have been anticipated earlier, and only became apparent as a result of a newly made statement in the action closing prosecution. Thus, a petition for continuation of the reexamination prosecution is to explain why the patent owner did not become

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

aware of (did not anticipate) the need for the new amendment or evidence earlier in the prosecution.

The first issue, then, is whether applicant's submission, if entered, would advance the issues towards resolution of the questions of patentability at issue in the proceeding. The questions of patentability at issue in the proceeding are whether the Saito and Yamazaki references anticipate or, in view of other prior art, make obvious the invention set forth in claims 1-3 and 11. These questions have been answered in the affirmative by the Board. See the Board Decision of May 5, 2009, at 28. As these claims have been found unpatentable, the questions of patentability of theses claims are considered to be resolved in the reexamination proceeding. Patent owner may request rehearing of the decision pursuant to 37 CFR 41.52, or appeal to the Court of Appeals for the Federal Circuit pursuant to 35 U.S.C. 141. Absent a timely request for rehearing or appeal, the proceeding can be most rapidly brought to resolution through issuance of an *ex parte* reexamination certificate through the procedure set forth at MPEP sections 2278 and 1214.06(II).

Patent owner proposes to advance the issues through amendment of the claims and addition of new claim*s*. Such an amendment is permitted by 35 U.S.C. 305 to the extent that entry of the amendment would be consistent with the other provisions of the relevant statutes and regulations; in particular, the requirement in 35 U.S.C. 305 that the proceedings be conducted with special dispatch. At this stage in the proceedings, a submission raising new issues that would require significant consideration would be expected to unduly delay the proceeding. Where the proceeding is not clearly advanced through the entry of the submission, such entry would clearly run counter to the mandate of conducting the reexamination proceeding to the resolution of the question of patentability with special dispatch.

In this instance, patent owner's response includes a submission directed towards the entry of claim amendments and accompanying remarks, as described in patent owner's instant petition. These amendments were in some ways similar, but not identical, to proposed amendments refused entry by the examiner in the advisory action of July 3, 2006. These amendments are alleged to address the rejections of claims 1-3 and 11, upheld by the Board, by narrowing claims 1 and 11 to avoid applied prior art (see, e.g., pages 10-13 of the instant petition), and further the prosecution of the '6898 proceeding. Additionally, new claims 19-31 have been proposed to be added.

To the extent that the amendments are similar to those presented in the June 5, 2006 amendment after final rejection, the examiner stated that entry of such amendments would not overcome the prior art of record, would not simplify the issues for appeal, and/or would raise new issues that would require further consideration. See the examiner's interview summary of June 27, 2006, page 2. To the extent that the amended and new claims are different from those presented earlier, entry of these claims would increase rather than decrease the amount of issues in the present proceeding. While the proposed new claims 21, 22, and 26-31 merely place previously confirmed claims in a rewritten form, proposed new claims 18-20 and 23-25, as well as proposed amended claims 1 and 11 *contain previously unconsidered claim limitations*.

In view of the nature of the proposed amendments and the stage of the reexamination proceeding, continuation of the proceeding through entry of the proposed amendments would

unduly introduce a multitude of new issues at a point where the original issues have been completely resolved, and would therefore not be conducive to conducting the reexamination proceeding with special dispatch.

The second issue is whether the submission comports with the requirement of special dispatch, in that the response could not have been presented earlier. Patent owner's response is not persuasive as to the reasons why such amendments could not have been presented earlier. Patent owner argues that no claim amendments were earlier thought desirable because the patent owner was of the opinion that the rejections could be overcome by arguments against the legal interpretation of enablement issues in the references applied as the bases for the rejections. However, the anticipation rejections affirmed by the Board were first made in the non-final Office action issued on June 17, 2005. Although patent owner chose only to argue against the legal sufficiency of the rejections, patent owner could have *also* presented new claims having the scope of the presently proposed amendments, in addition to the arguments against the rejected claims. Patent owner could have presented these claim amendments, or new claims having the scope of these amendments, in patent owner's response to the non-final Office action, and all issues could have been resolved together. Entry of the instant amendment, which could have been presented earlier, would run counter to the requirement of special dispatch.

Based on the facts and circumstances of the present situation, it is found that petitioner patent owner's response is not deemed to provide the requisite *bona fide* effort in a manner consistent with the requirement of 35 U.S.C. 305 to conduct reexamination proceedings "with special dispatch within the Office."

In view of the above and the facts and circumstances presented by the present record, the petition is dismissed.

PATENT OWNER'S ADDRESS

The patent owner is called upon to coordinate the proper correspondence addresses in the patent and the reexamination proceedings. Different patent owner addresses are of record for the two reexamination proceedings. *The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings* pursuant to 37 CFR 1.33(c), and it is that of Eitan, Pearl, Latzer, & Cohen Zedek LLP, 10 Rockefeller Plaza, Suite 1001, New York, NY 10020. Accordingly, all future correspondence will be directed to Eitan, Pearl, Latzer, & Cohen Zedek LLP, 10 Rockefeller Plaza, Suite 1001, New York, NY 10020, unless, within ONE (1) MONTH of this decision, patent owner changes the correspondence address of record in the patent, using form PTO/SB/123.

CONCLUSION

- The petition is **dismissed**.

- Patent owner is provided with ONE (1) MONTH from the mailing of this decision to file papers to address the correspondence address and attorney of record considerations in both proceedings, as set forth in the last section of this decision.

- **All** correspondence relating to this *ex parte* reexamination proceeding should be directed:

By EFS: Registered users may submit the response via the electronic filing system EFS-Web, at: https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html.

By Mail to: Mail Stop *Ex Parte* Reexam
Attn: 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.

- Any inquiry concerning this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.

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

July 7, 2009
C:\Kiva\Kenpet7\

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 F. Lawrence, Esq.
FROMMER LAWRENCE & HAUG LLP
745 Fifth Avenue
New York NY 10151

(For Patent Owner)

MAILED
MAR 0 8 2006
REEXAM UNIT

In re Reexamination Proceeding :
Hoffmann et al. :
Control No. 90/006,899 : DECISION GRANTING PETITION
Filed: December 31, 2003 :
U.S. Patent No. 5,393,529 :
Attorney Docket No. 512100-1005 :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on January 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 (item 1)(Appeal Brief and a $500.00 fee for filing an Appeal Brief), a $1500.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3).

The petition for entry of the late papers is granted.

Jurisdiction over the reexamination proceeding is being returned to Technology Center Art Unit 1615 for further examination and consideration of the Appeal Brief and the Amendment under 37 CFR 1.550(b) filed January 30, 2006, along with the present petition, and the amendment filed September 8, 2005 by facsimile transmission, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Isis Ghali, in Technology Center Art Unit 1615, who can be reached at 571-272-0595.

Telephone inquiries related to this decision should be directed to Fred A. Silverberg at 571-272-7719.

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

Conferee: Kenneth M. Schor

UNITED STATES PATENT 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.
90/006,905	01/14/2004	5167047	T3488-908224	9765

7590 02/22/2005

EXAMINER

Marc Karish
Sheldon & Mak
225 South Lake Avenue Suite 900
Pasadena, CA 91101

ART UNIT	PAPER NUMBER

DATE MAILED: 02/22/2005

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

Marc Karish (For Patent Owner)
Sheldon & MA
225 South Lake Avenue Suite 900
Pasadena, CA 91 101

James T. Carmichael (For Third Party Requester)
Miles & Stockbridge P.C.
1751 Pinnacle Drive, Suite 500
McLean, VA 22102-3833

Enclosure: Patent owner petition filed February 10, 2005

In re Plumley	
Reexamination Proceeding	DECISION
Control No. 90/006,905	RETURNING
Filed: January 14, 2004	PETITION
For: U.S. Patent No. 5,167,047	

This is a decision on the February 10, 2005 patent owner petition under 37 CFR 1.182, titled "PETITION UNDER 37 CFR 1.182 FOR DENIAL OR RETURN OF IMPROPERLY SUBMITTED REEXAMINATION REQUEST."

Pursuant to 37 CFR 1.17(h), the petition fee for a 37 CFR 1.182 petition is $130.00. This fee has been charged to petitioner's deposit account no. 19-2090, as per the petitioner's instructions on page 4 of the instant petition.

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

The petition is an <u>improper paper</u>, and will not be considered for the reasons set forth below. Rather than returning the petition to the patent owner, it is being forwarded to the third party requester, since there is no indication that a copy was served on the requester.

REVIEW OF FACTS

1. U.S. Patent No. 5,167,047 (the '047 patent), issued to Plumley, on December 1, 1992.

2. A first request for reexamination of the '047 patent (assigned control No. 90/006,520) was filed by a third party requester, James T. Carmichael, on January 21, 2003.

3. A second request for reexamination of the '047 patent (the instant reexamination, assigned control No. 90/006,6905) was filed by third party requester Carmichael on January 14, 2004. The petition to be considered in this decision was filed in the '6905 proceeding.

4. On March 16, 2004, a reexamination certificate was issued for the '6520 reexamination proceeding.

5. Reexamination was ordered March 22, 2004, for the '6905 reexamination proceeding, and the proceeding is presently undergoing the examination stage.

6. A third request for reexamination of the '047 patent (assigned control No. 90/007,378) was filed by third party requester Carmichael on January 21, 2005.

7. A decision on the request has not yet been issued for the '7378 reexamination proceeding.

8. On February 10, 2005, the patent owner filed the present petition under 37 CFR 1.182 in the '6905 proceeding. The petition seeks denial or return of the reexamination request filed January 21, 2005, by Carmichael. Although the control number of the January 21, 2005 request is not identified in the petition, the petition is presumably directed to the '7378 reexamination proceeding.

DECISION "RETURNING PAPER"

1. The present petition seeks relief in the '7378 proceeding; yet, it was filed in the present '6905 proceeding. Relief cannot be granted in the '6905 proceeding for a matter directed to the '7378 proceeding. Pursuant to 37 CFR 1.4(b), a filing of the petition in the '7378 proceeding would be required, before the petition could be considered as to whether it has an entry right in the '7378 proceeding. See, however, the advisory discussion below as to consideration by the patent owner of the potential filing of the petition in the '7378 proceeding.

2. 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 third party requester was not included with the instant petition papers. Any future communications filed by patent owner in this proceeding must include proof of service on the third party requester in accordance with 37 CFR 1.550(f).

3. In view of the above, the petition is an improper submission, and it will not be made of record in the reexamination file. While ordinarily the petition would be returned to the patent owner, in this instance it is being forwarded to the third party requester, since there is no indication that the third party requester was provided with a copy of the papers, as discussed above. The present decision will be made of record in the reexamination file.

ADVISORY DISCUSSION

1. If the present petition had been filed in the '7378 reexamination proceeding, it would not have been timely, i.e., it would not have had an entry right. 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 examination stage of the '7378 reexamination proceeding has not yet commenced, and the present petition is neither a statement pursuant to 37 CFR 1.530, nor a reply by the requester pursuant to 37 CFR 1.535.

2. It is observed that the patent owner objects to the use of the second reexamination (the '7378 reexamination) to address the amendment in the first reexamination. In effect, the patent owner objects to the requester's response or rebuttal to the Amendment and Response to Office Action of December 22, 2005, filed by the patent owner in the '6905 reexamination proceeding. This objection would not be persuasive, even if it were timely made in the '7378 reexamination proceeding.

Initially, it is to be noted that the decision has not yet been made as to whether or not to order reexamination in the '7378 reexamination proceeding. If reexamination should be ordered in the '7378 proceeding, then 37 CFR 1.565(c) would apply. 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. [Emphasis added]

Accordingly, if reexamination is granted for the '7378 reexamination proceeding, then the present proceeding would be merged with the '7378 proceeding, and a housekeeping amendment to make the claims the same in each file would be required. [1] As a result, the claims for the '7378 proceeding would include those added and those amended via the first reexamination (the present '6905 proceeding). It would be a waste of time and resources to require that requester refrain from commenting on those claims until after a reexamination certificate is issued for the '6905 proceeding, and then provide the comments via a subsequent reexamination request. This runs contrary to the requirement for "special dispatch" in the reexamination statute. [2]

Further, the argument in the second request for reexamination as to any amended and new claims does not violate the reexamination rules as to the content of the second request. The reexamination statute expressly provides that "any person at any time may file a request for reexamination" and states that "the request must set forth the pertinency and manner of applying the prior art to every claim for which reexamination is requested." 35 USC § 302. A complete analysis of the prior art may include a discussion of any pertinent portion of the file history of the patent for which reexamination is requested, *including any pending reexamination proceeding*.

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[1] See MPEP 2283.

[2] See 35 U.S.C. 305.

Even further, it is to be recognized/appreciated that the *ex parte* reexamination requester only has one chance to address the issues as to the patent, - the filing of the request for reexamination. Accordingly, the rules do not preclude the requester from addressing how the prior art applies to the full scope of the patent disclosure. The requester may discuss how the prior art is relevant to limitations of the patent disclosure that requester believes might be added to the existing patent claims during reexamination, or as to limitations that might be read into the existing patent claims (by the examiner during reexamination) via claim interpretation. In the present instance, the fact that the requester knows what limitations have been "proposed" for addition to the existing patent claims, because of the first reexamination, does not change the point that the patent owner may address such limitations in the request.

As a final point, it is conceded that the amendments proposed in the first reexamination proceeding will not be effective until the reexamination certificate is issued.[3] While that fact is significant to prevent patent owner from enforcing the "proposed" new and amended claims until the reexamination certificate issues, the content of the "proposed" new and amended claims does, however, exist, such that it may be addressed in a subsequent reexamination request. Note that pursuant to 35 U.S.C. 304:

> "The patent owner will be given a reasonable period... 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. ...**that person may file and have considered in the reexamination a reply to any statement filed by the patent owner.**" [Emphasis added]

Thus, although the "proposed" new and amended claims do not become effective until after the reexamination certificate issues for purposes of enforcement, they do exist in fact, and are available for a third party requester to comment on, whether by a reply to an owner's statement, or via a statutorily permitted subsequent request for reexamination of the patent.

It is true that, pursuant to 37 CFR 1.515, the issue of whether the reexamination is to be granted is decided *by the Office* based on the existing patent claims; however, that does not place a limit on the comments that the *requester* may include in the request. Additional comments as to limitations the requester

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[3] See 37 CFR 1.530(k).

believes might be added to the existing patent claims via reexamination, or that might be read into the existing patent claims, can be provided by the requester in the request, and are available for consideration by the examiner in the prosecution/examination stage of the proceeding (after the reexamination request has been granted).

CONCLUSION

1. The patent owner petition filed February 10, 2005, is an improper paper, and will not be considered

2. The petition papers are being forwarded, with the instant decision, to the third party requester, since there is no indication that a copy was served on the requester.

3. The reexamination proceeding is returned to Technology Center 2800.

4. Telephone inquiries related to the present decision should be directed to the undersigned, at 571-272-7710.

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

February 22, 2005
C:\kiva\kimpropa\6905_for_7378.wpd

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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.
90/006,905	01/14/2004	5167047	T3488-908224	9765

7590 02/23/2006

EXAMINER

Marc Karish
Sheldon & Mak
225 South Lake Avenue Suite 900
Pasadena, CA 91101

ART UNIT	PAPER NUMBER

DATE MAILED: 02/23/2006

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

DOUGLAS A.J. MOCKETT
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1751 PINNACLE DRIVE, SUITE 500
MCLEAN, VIRGINIA 22102-3833

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/006,905*.

PATENT NO. *5,167,047*.

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(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.
90/007,378	01/21/2005	5167047	T3488-908224	3827

7590 02/23/2006

EXAMINER

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Pasadena, CA 91101

ART UNIT	PAPER NUMBER

DATE MAILED: 02/23/2006

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/007,378*.

PATENT NO. *5,167,047*.

ART UNIT *2831*.

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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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02032005

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(For Patent Owner)

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1751 Pinnacle Drive, Suite 500
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(For Third Party Requester)

In re Plumley
Reexamination Proceeding
Control No. 90/006,905
Filed: January 20, 2004
For U.S. Patent No. 5,167,047

In re Plumley
Reexamination Proceeding
Control No. 90/007,378
Filed: January 21, 2005
For U.S. Patent No. 5,167,047

DECISION MERGING REEXAMINATION PROCEEDINGS

The above-identified reexamination files are before the Group 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. 5,167,047 issued on December 1, 1992.

2. A first request for reexamination, Control No. 90/006,520, was filed by the third party requester on January 21, 2003.

3. Reexamination was ordered for the '6520 reexamination proceeding on April 14, 2003.

4. A first Reexamination Certificate 5,167,047 C1 was issued March 16, 2004, with the patentability of claims 1 through 27 being confirmed.

5. A second request for reexamination, Control No. 90/006,905, was filed by the third party requester on January 14, 2004.

6. Reexamination was ordered for the '6905 reexamination proceeding on March 22, 2004.

7. A first Office action was issued on November 22, 2004 in the '6905 reexamination proceeding, wherein the patentability of claims 8-17 was confirmed, claims 2-5, 7, 20 and 27 were objected to and claims 1, 6, 18, 19, and 21-26 were rejected as being unpatentable.

8. An amendment was filed on December 22, 2004 in the '6905 reexamination proceeding, however, it was held to be informal/nonresponsive. The new claims added did not comply with 37 C.F.R. § 1.530 (d)-(j).

9. A Notice of Defective Paper was mailed February 15, 2005 in the '6905 reexamination proceeding setting a one-month period for reply.

10. A supplemental amendment was filed February 22, 2005 in the '6905 reexamination proceeding, wherein new claims 28 through 31 were added.

11. A third request for reexamination, Control No. 90/007,378, was filed by the third party on January 21, 2005.

12. Reexamination was ordered for the '7378 reexamination proceeding on April 11, 2005.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

> (c) If ex parte reexamination is ordered while a prior ex parte reexamination proceeding is pending and prosecution in the prior ex parte reexamination

> proceeding has not been terminated, the ex parte reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570.

As noted in the above noted facts, reexamination has been ordered in both of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is appropriate.

DECISION

I. Merger proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '6905 and '7378 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Two Proceedings.

As noted above, the claims have been amended in the '6905 reexamination proceedings. The claims in the '6905 reexamination proceeding are not the same as the claims in the '7378 reexamination proceeding. The patent owner is required to maintain the same claims and specification in both files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in both files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

III. Conduct of Merged Proceeding.

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

CONCLUSION

Reexamination Control Nos.'6905 and '7378 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, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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Marc Karish
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225 South Lake Avenue Suite 900
Pasadena, CA 91101

(For Patent Owner)

MAILED

AUG 15 2007

CENTRAL REEXAMINATION UNIT

James T. Carmichael
Miles & Stockbridge P.C.
1751 Pinnacle Drive, Suite 500
McLean, VA 22102-3833

(For 3rd Party Requester)

In re	: Roger K. Plumley
Reexamination Proceeding	:
Control No.	: 90/006,905
Filed	: January 14,2004
For U.S. Patent No.	: 5167047
	:
In re	: Roger K. Plumley
Reexamination Proceeding	:
Control No.	: 90/007,378
Filed	: January 21,2005
For U.S. Patent No	: 5167047

DECISION ON REQUEST FOR EXTENSION OF TIME

The above noted merged reexamination proceedings are before the Director of the Central Reexamination Unit for consideration of Patent Owner's petition for an extension of time under 37 CFR 1.550(c) filed February 27, 2007. This request is for an extension of time of one (1) month, through March 27, 2007 to file an amendment in compliance with 37 CFR 1.530. The petition fee of $200 required by 37 CFR 1.550(c) has been charged to Deposit Account No. 192090 as authorized in the request.

Pursuant to 37 CFR 1.550(c):

> (c) The time for taking any action by a patent owner in an ex parte reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such 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.

The request indicates that a Notice of Appeal was timely filed on December 27, 2006. An after-final amendment was timely filed on February 12, 2007. However, as noted in the Advisory Action mailed February 23, 2007, the after-final amendment of February 12, 2007 was not entered because the proposed amendment failed to comply with 37 CFR 1.530. Another after-final amendment was timely filed on February 22, 2007. The amendment of February 22, 2007 is in compliance with 37 CFR 1.530, has been entered and a Notice of Intent to Issue Ex Parte Reexamination Certificate has been prepared by the Examiner. The present petition requesting an extension of time "was to allow the Examiner to further consider the Amendment and Response to Final Office Action filed on February 22, 2007." Since the amendment was timely filed, any extension of time beyond February 27, 2007 is unnecessary.

In view of the circumstances outlined above, the request is DISMISSED as moot.

The period for filing a response ends on February 27, 2007. It is noted that an amendment was timely filed on February 22, 2007.

Any inquiry concerning this decision should be directed to Eric Keasel, Supervisory Patent Examiner, at telephone No. (571) 272-4929.

Eric Keasel For

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,907	01/14/2004	5497306		9761

7590 04/25/2007

EXAMINER

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ART UNIT	PAPER NUMBER

DATE MAILED: 04/25/2007

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4/26/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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VALLEY FORGE, PA 19482-0980

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/006907

PATENT NO. 5,497,306

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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APR 25 2007

CENTRAL REEXAMINATION UNIT

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Grand Rapids, MI 49501

(For Patent Owner)

Jacques L. Etkowicz
P.O. Box 908
Valley Forge, PA 19482-0908

(For Third Party Requester)

In re Donnelly Corporation	:	DECISION GRANTING
Ex Parte Reexamination Proceeding	:	PETITION
Control No.: 90/006,907	:	(37 CFR 1.182)
Filed: January 14, 2004	:	
For: U.S. Patent No. 5,497,306	:	

This is a decision on patent owner's "Petition Under 37 CFR 1.182" filed by facsimile transmission on April 2, 2007. The petition, and the above-captioned reexamination proceeding, are before the Office of Patent Legal Administration for decision on the petition.

FEES

Petitioner patent owner has authorized a charge against Deposit Account No. 22-0190 for the $400.00 petition fee under 37 CFR 1.17(f) for filing the present 37 CFR 1.182 petition.

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 5,497,306 (the '306 patent) issued on March 5, 1996.

2. The present request for reexamination was filed by a third party requester on January 14, 2004, was assigned control No. 90/006,907, and is hereinafter referred to as the '907 reexamination proceeding.

3. Reexamination was ordered in the '907 reexamination proceeding on April 9, 2004.

4. Prosecution and examination progressed to the point where a final rejection was mailed on September 19, 2006.

5. A response to the final rejection, in the form of an amendment, was filed on November 20, 2006.

6. The amendment after final rejection was entered, and prosecution was closed by the mailing of a Notice of Intent to Issue Reexamination Certificate (NIRC) on December 28, 2006.

7. On February 9, 2007, patent owner filed a paper entitled "Supplemental Amendment After Final Action (37 CFR 1.116).

8. Patent owner filed the present petition on April 2, 2007 requesting entry of the February 9, 2007 supplemental amendment.

DECISION

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)."

The *ex parte* reexamination rules do not provide for consideration or entry of an amendment in an *ex parte* reexamination proceeding after prosecution of the *ex parte* reexamination proceeding has been terminated by the mailing of an NIRC. Accordingly, consideration (and entry) of an amendment filed after the mailing of an NIRC present a situation not specifically provided for in the regulations of Part 1 of Title 37 of the Code of Federal Regulations. Therefore, relief could only be available by way of a grantable petition under 37 CFR 1.182 requesting consideration and entry of such amendment.

Consideration and entry of an amendment filed after the mailing of an NIRC in *ex parte* reexamination proceeding is somewhat analogous to consideration and entry of an amendment after allowance that is filed under 37 CFR 1.312 in a nonprovisional patent application. Therefore, it is expected that a 37 CFR 1.182 petition requesting consideration and entry of an amendment filed after the mailing of an NIRC would include:

(1) A discussion of why entry of such an amendment is needed for proper disclosure or protection of the invention;
(2) A discussion of why a substantial amount of additional work on the part of the Office would not be required for consideration of the amendment;
(3) A discussion of patentability with respect to the amended or added claims; and
(4) A statement explaining why the amended or added claims were not earlier presented. *

A review of the present 37 CFR 1.182 petition shows that it contains no discussion of why the proposed amendment filed on February 9, 2007 is necessary. There is also no discussion of why no substantial amount of work is required for consideration of the amendment, and why the amendment was not earlier presented. However, inspection of the amendment , and of the record of the '907 *ex parte* reexamination proceeding, reveals that the amendment was filed to simply change the dependency of three of the claims of record. A cursory inspection of the record shows that the amendment would appear to be necessary. The requested amendment is such that consideration of the amendment and entry of the amendment into the record would require no substantial amount of time or work. At present, the '907 *ex parte* reexamination

* cf. MPEP § 714.16

proceeding has not been forwarded to the Office of Patent Publication. Entry of the amendment at this time will not unduly interfere with or delay the process of publication of the Reexamination Certificate, while providing a clear benefit to the proceeding.

Therefore, the present proceeding is being forwarded to the Primary Examiner to consider the February 9, 2007 supplemental amendment and, if appropriate, *to recommend entry of the amendment. Accordingly, jurisdiction of the '907 *ex parte* reexamination proceeding will be returned to the Central Reexamination Unit. The Primary Examiner will issue an appropriate action, which may (if justified) be a supplemental Notice of Intent to Issue Reexamination Certificate indicating consideration of the February 9, 2007 supplemental amendment and the results thereof. If the Primary Examiner enters the amendment, the Primary Examiner should update the associated paperwork, for example, any changes to the reexamination checklists necessitated by the entry of the amendment. Thereafter, the examiner should notify the Office of Patent Legal Administration, that the '907 *ex parte* reexamination proceeding is being returned to that Office for screening pursuant to MPEP 2289.

CONCLUSION

1. The petition under 37 CFR 1.182 is granted.

2. Jurisdiction of the '907 *ex parte* reexamination proceeding is being returned to the Central Reexamination Unit for consideration, and entry if appropriate, of the supplemental amendment filed on February 9, 2007 by the Primary Examiner.

3. Prosecution is not being reopened in the '907 *ex parte* reexamination proceeding by this decision.

4. Following appropriate action by the Primary Examiner, the '907 *ex parte* reexamination proceeding will be returned to the jurisdiction of the Office of Patent Legal Administration.

5. Any further communications as to the merits of the reexamination proceeding should be directed to Central Reexamination Unit Supervisory Patent Examiner Mark Reinhart at (571) 272-1611.

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

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

sm
April 23, 2007

April 24, 2007
C:\Kiva\Kenpet6\ 6907_1.182 Amdt after NIRC (clear from amdt-little work) grant.doc

* Absent any overriding issue that would be raised by entry of the amendment.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,911	01/15/2004	5958106	ITP-1BA-REEXAM	4781

7590 11/22/2005

Harry M. Levy, Esq.
Emrich & Dithmar LLC
125 South Wacker Drive, Suite 2080
Chicago, IL 60606

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/22/2005

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
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Harry M. Levy (For Patent Owner)
Emrich & Dithmar, LLC.
125 South Wacker Drive
Suite 2080
Chicago, Illinois 60606

MAILED
NOV 22 2005
REEXAM UNIT

In re Armstrong, et al.	:	
Reexamination Proceeding	:	**DECISION**
Control No. 90/006,911	:	**DISMISSING**
Filed: July 15, 2004	:	**PETITION**
For: U.S. Patent No. 5,958,106	:	

This is a decision on the October 13, 2005 patent owner PETITION TO REVIVE UNINTENTIONAL ABANDONMENT OF APPLICATION UNDER § 1.137(b), requesting revival of the present reexamination proceeding under the "unintentional" standard, pursuant to 37 CFR 1.137(b). The petition is before the Office of Patent Legal Administration for decision.

The petition fee of $750 set forth in 37 CFR 1.17(m) for the present petition has been paid by check.

The petition is **dismissed** for the reasons set forth below.

Any request for reconsideration of this decision must be submitted within ONE (1) MONTH from the mail date of this decision. An extension of time may be requested only under 37 CFR 1.550(c); extensions of time under 37 CFR 1.136 are **not** available in reexamination proceedings. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)."

DECISION

Petitioner is advised that a grantable petition under 37 CFR 1.137(b) must be accompanied by (1) a proper statement that the entire delay from the due date for the response to the filing of a grantable petition was unintentional, (2) by the proposed response to the outstanding Office action, and (3) by the petition fee (set forth in 37 CFR 1.17(m)) required by law. Petitioner has supplied item (2) and item (3). However, petitioner has **not** satisfied item (1).

37 CFR 1.137(b)(3) requires the submission of a statement that "the **entire delay** in filing the required reply **from the due date for the reply until the filing of a grantable petition** pursuant to 37 CFR 1.137(b) was **unintentional"** (emphasis added).[1] The present petition is incomplete as to item (1) because the patent owner has not made the required statement. The present petition does not state that the delay in filing the amendment, as well as the delay in filing the present petition, was unintentional. Instead, the present petition merely states that "the abandonment was unintentional as evidenced by the response [of April 8, 2005] and late fee." [2]

PETITION FOR EXTENSION OF TIME

The non-final Office action of February 7, 2005, set a 2-month shortened statutory period for filing a response.

> (1) A response to that Office action was filed on April 8, 2005, together with <u>a petition for extension of time</u> under 37 CFR 1.136(a).

As to the petition for extension of time under 37 CFR 1.136 filed on April 8, 2005, with the response:

Extensions of time under 37 CFR 1.136 do not apply in reexamination proceedings; but rather, extensions of time in reexamination proceedings are provided for in 37 CFR 1.550(c). Pursuant to 37 CFR 1.550(c), **any request for extension of time must be filed** "on or before the day on which action by the patent owner is due," **and will be granted only** upon a presentation of "sufficient cause" for the extension and "for a reasonable time specified." In the present instance, the period for response to the Office action of February 7, 2005, expired after April 7, 2005, thus, the April 8, 2005 request (petition) for extension of time was not timely filed. Further, there was no showing of "sufficient cause" for the extension. Accordingly, the April 8, 2005, petition for extension of time could not be granted.

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[1] For reexamination proceedings, the word "reply" is to be replaced by "response."

[2] Page 1 of the present petition.

CONCLUSION

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

2. **For the granting of the present petition, it is required that patent owner provide:**

   (A) A statement that: The entire delay in filing the required response from the due date for the response until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

If petitioner desires to make the required submissions in order that the present petition be granted, the submission should be included in a cover letter entitled "**Renewed Petition under 37 CFR 1.137(b).**"

3. Any renewed petition must be filed within **ONE (1) MONTH** of the mailing date of this decision. An extension of time to file a renewed petition may be requested **only** under 37 CFR 1.550(c); extensions of time under 37 CFR 1.136 are **not** available in reexamination proceedings.

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

   By mail:

   Attn: Mail Stop "Ex Parte Reexam"
   Central Reexamination Unit
   Commissioner for Patents
   P. O. Box 1450
   Alexandria VA 22313-1450

   By FAX to:

   (571) 273-9900
   Central Reexamination Unit

   By hand:

   Customer Service Window
   Attn: Central Reexamination Unit
   Randolph Building, Lobby Level
   401 Dulany Street
   Alexandria, VA 22314

5. Telephone inquiries with regard to this decision should be directed to Brian E. Hanlon, Legal Advisor, at (571) 272-5047.

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

November 21, 2005
C:\Kiva\kpet-abe\6911_dismiss-unint-lang.wpd

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.
90/006,911	01/15/2004	5958106	ITP-1BA-REEXAM	4781

7590 01/13/2006

Harry M. Levy, Esq.
Emrich & Dithmar LLC
125 South Wacker Drive, Suite 2080
Chicago, IL 60606

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/13/2006

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

Harry M. Levy (For Patent Owner)
Emrich & Dithmar, LLC.
125 South Wacker Drive
Suite 2080
Chicago, Illinois 60606

MAILED
JAN 13 2006
REEXAM UNIT

In re Armstrong, et al.	:	
Reexamination Proceeding	:	**DECISION**
Control No. 90/006,911	:	**GRANTING**
Filed: January 15, 2004	:	**PETITION**
For: U.S. Patent No. 5,958,106	:	
	:	

This is a decision on the patent owner's December 21, 2005, RENEWED PETITION UNDER §1.137 requesting revival of the present reexamination proceeding under the "unintentional" standard, pursuant to 37 CFR 1.137(b). The petition is before the Office of Patent Legal Administration for decision.

The petition is **granted**.

DECISION

In the November 22, 2005, decision dismissing patent owner's PETITION TO REVIVE UNINTENTIONAL ABANDONMENT OF APPLICATION UNDER § 1.137(b), it was stated:

> **"For the granting of the present petition, it is required that patent owner provide:**
>
> (A) A statement that: The entire delay in filing the required response from the due date for the response until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional."

By way of the renewed petition under 37 CFR 1.137(b), patent owner has now satisfied this requirement. Accordingly, the petition under 37 CFR 1.137(b) is granted.

CONCLUSION

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

2. The reexamination proceeding is being returned to Technology Center 1700 for issuance of an Office action in due course.

3. Any further communications as to the merits of the reexamination proceeding should be directed to the examiner, George Wyszomierski, in Technology Center 1742, at (571)272-1252.

4. Telephone inquiries with regard to this decision should be directed to Brian E. Hanlon, Legal Advisor, at (571) 272-5047.

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

January 11, 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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,911	01/15/2004	5958106	ITP-1BA-REEXAM	4781

7590 04/20/2007

Harry M. Levy, Esq.
Emrich & Dithmar LLC
125 South Wacker Drive, Suite 2080
Chicago, IL 60606

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/20/2007

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

Harry M. Levy, Esq.
Emrich & Dithmar LLC
125 South Wacker Drive, Suite 2080
Chicago IL 60606

(For Patent Owner)

MAILED

APR 20 2007

CENTRAL REEXAMINATION UNIT

In re Reexamination Proceeding :
Armstrong et al. :
Control No. 90/006,911 : DECISION GRANTING PETITION
Filed: July 15, 2004 :
U.S. Patent No. 5,958,106 :
Attorney Docket No. ITP 1B-A REEXAM :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on March 26, 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, a $750.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3).

In a telephone communication of April 16, 2007, counsel's office was informed that the present petition lacked the requisite response, which in this instance is a Notice of Appeal along with the requisite fee, for compliance with the item 1 requirement of 37 CFR 1.137(b).

In response, on April 16, 2007, a communication, including a Notice of Appeal and an authorization to counsel's deposit account for the $250.00 fee, was filed by facsimile transmission.

In view of the above, the petition for entry of the late papers is granted.

$250.00 has been charged to counsel's deposit account no. 15-0508 in accordance with the communication filed April 16, 2007.

The time period for filing an appeal brief and appeal brief fee in response to the Notice of Appeal filed as a response required to the outstanding Office action is two months from the date of this decision, MPEP 711.03(c).

Jurisdiction over the reexamination proceeding is being returned to CRU Art Unit 3993 for further examination and consideration of the reexamination proceeding in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Jerry Johnson, in CRU Art Unit 3991, who can be reached at 571-272-1448.

Telephone inquiries related to this decision should be directed to Fred A. Silverberg at 571-272-7719.

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

Conferee: Kenneth M. Schor, Senior Legal Advisor

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,911	01/15/2004	5958106	ITP-1BA-REEXAM	4781

7590 01/28/2008

Harry M. Levy, Esq.
Emrich & Dithmar LLC
125 South Wacker Drive, Suite 2080
Chicago, IL 60606

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/28/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

HARRY M. LEVY, ESQ.
OLSON & CEPURITIS, LTD.
36TH FLOOR
20 NORTH WACKER DRIVE
CHICAGO, IL 60606

(For Patent Owner)

MAILED

JAN 28 2008

CENTRAL REEXAMINATION UNIT

In re Reexamination Proceeding	:
D. Armstrong et al.	:
Control No. 90/006,911	: DECISION GRANTING PETITION
Filed: January 15, 2004	:
U.S. Patent No. 5,958,106	:
Attorney Docket No. ITP 1B-A-REEXAM	:

This is a decision on the petition under 37 CFR 1.181(c) or in the alternative under 37 CFR 1.137(b) filed by the patent owner on November 16, 2007, for entry of late papers based upon unintentional delay.

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

On November 16, 2007, the present petition was filed, including an authorization to charge, inter alia, additional fees to counsel's deposit account and a revised brief on appeal. Petitioners argue that the revised brief included with the present petition was late due to the Office Action being mailed to an incorrect address. Petitioners noted that the law firm of the attorney of record disbanded between December 31, 2006 and January 12, 2007, with an order filed with the United States Postal Service to forward all mail addressed to the law firm. Petitioners further stated that the address was corrected electronically. Petitioners request that the Office accept the revised brief as being timely. In the alternative, petitioners argue that the delay in filing the revised brief was unintentional.

A review of the record reveals that no formal request to change the correspondence address of record has been submitted from on or about December 31, 2006 and January 12, 2007, to the date of filing the present petition. Placing an order with the United States Postal Service to forward all mail addressed to the law firm is not a proper change of correspondence address with the Office. Absent a proper change of address, correspondence is mailed to the address of record. See 37 CFR 1.33 and MPEP 403.

As the correspondence from the Office was sent to the address of record, the revised brief cannot be accepted as timely.

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 ...."

On January 25, 2008, in a telephone communication between Counsel, Harry Levy and Senior Legal Advisor, Fred Silverberg, counsel was informed that a review of the record revealed that no formal change of correspondence address had been submitted in this reexamination proceeding to change the address of record to the address denoted in the petition. Counsel was also informed that if he desired to properly change the correspondence address he should file one in conformance with 37 CFR 1.33. Counsel stated that if a petition fee was needed for the petition under 37 CFR 1.37(b) the Office was authorized to charge his deposit account.

In response, on January 25, 2008, a change of correspondence address was submitted by facsimile transmission.

A review of the record reveals that the present petition under 37 CFR 1.137(b) includes, inter alia, the requisite response (revised brief - item 1), an authorization to charge counsel's deposit account for the petition fee under 37 CFR 1.17(m)($1,540.00) (item 2) and the requisite statement (item 3).

The petition for entry of the late papers is granted.

$1,540.00 has been charged to counsel's deposit account no. 15-0580 in accordance with the present petition.

Jurisdiction over the reexamination proceeding is being returned to Central Reexamination Unit (CRU) Art Unit 3991 for further examination and consideration of the revised brief filed November 16, 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, Jerry D. Johnson, in CRU Art Unit 3991, who can be reached at 571-272-1448.

Telephone inquiries related to this decision should be directed to Fred A. Silverberg at 571-272-7719.

Fred A. Silverberg

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

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.
90/006,911	01/15/2004	5958106	ITP-1BA-REEXAM	4781

7590 04/25/2008

OLSON & CEPURITIS, LTD.
36TH FLOOR
20 NORTH WACKER DRIVE
CHICAGO, IL 60606

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/25/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

HARRY M. LEVY, ESQ. (For Patent Owner)
OLSON & CEPURITIS, LTD.
36TH FLOOR
20 NORTH WACKER DRIVE
CHICAGO, IL 60606

In re Reexamination Proceeding	:
D. Armstrong et al.	:
Control No. 90/006,911	: DECISION DISMISSING PETITION
Filed: January 15, 2004	:
U.S. Patent No. 5,958,106	:
Attorney Docket No. ITP 1B-A-REEXAM	:

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on April 4, 2008, for entry of late papers based upon unintentional delay.

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

Patent owner's correspondence address for all communications in an *ex parte* reexamination proceeding is designated as the correspondence address of the patent. While applicant has submitted a change of address in this reexamination proceeding, no change of correspondence address has been submitted in the patent. Absent a proper change of address in the patent, in the future correspondence in this reexamination proceeding will be mailed to the address of record in accordance with 37 CFR 1.33 and MPEP 403.

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, a response (Applicant's Revised Brief On Appeal - item 1), an authorization to charge counsel's deposit account for the $750.00 petition fee under 37 CFR 1.17(m) and an authorization to charge any additional fees to counsel's deposit account (item 2) and the requisite statement (item 3).

A review of Applicant's Revised Brief On Appeal (item 1) reveals the following:

1. Page 11 includes arguments directed to a reference which is not of record ("Introduction to Fluid Mechanics", pages 34-37);
2. Pages 13-15 include thermodynamic calculations from a Declaration which was not entered; and
3. The evidence Appendix does not identify (1) all of the included exhibits or (2) where they were entered into the record.

Accordingly, no proper reply as required for a grantable petition under 37 CFR 1.137(b) to the outstanding Office action has been filed.

CONCLUSION

1. In view of the above, the present petition under 37 CFR 1.137(b) is **dismissed**.

2. $770.00 has been charged to counsel's deposit account no.15-0580 in accordance with the present petition (the small entity petition fee is $770.00).

3. For the granting of the present petition, it is required that patent owner provide **a proper reply to the Outstanding Office action**.

4. The submissions should be included in a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)."

5. Absent a proper change of address in the patent, in the future correspondence in this reexamination proceeding will be mailed to the address of record in accordance with 37 CFR 1.33 and MPEP 403.

5. Any request for reconsideration of this decision must be submitted within **ONE (1) MONTH** from the mail date of this decision. An extension of time to file a request for reconsideration may be requested **only** under 37 CFR 1.550(c), extensions of time under 37 CFR 1.136 are **not** available in reexamination proceedings. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)."

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

By mail: Attn: Mail Stop "Ex Parte Reexam"
Central Reexamination Unit
Commissioner for Patents
United States Patent and Trademark Office
P. O. Box 1450
Alexandria VA 22313-1450

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

By hand: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

7. Telephone inquiries related to this decision should be directed to Fred A. Silverberg at 571-272-7719

Fred A. Silverberg

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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MAILED

JUN 18 2008

CENTRAL REEXAMINATION UNIT

OLSON & CEPURITIS, LTD.
36TH FLOOR
20 NORTH WACKER DRIVE
CHICAGO, IL 60606

(For Patent Owner)

In re Reexamination Proceeding	:	
D. Armstrong et al.	:	
Control No. 90/006,911	:	DECISION GRANTING RENEWED PETITION
Filed: January 15, 2004	:	
U.S. Patent No. 5,958,106	:	
Attorney Docket No. ITP 1B-A-REEXAM	:	

This is a decision on Applicant's Revised Brief On Appeal, which is being treated as a Renewed Petition under 37 CFR 1.137(b) for entry of late papers based upon unintentional delay filed by the patent owner on May 23, 2008, in response to a Decision mailed April 25, 2008, in the present reexamination proceeding.

The Renewed Petition is before the Office of Patent Legal Administration (OPLA) for decision.

37 CFR 1.137(b) states, in part:

> "*Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination 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."

The present renewed petition includes the omitted proper response (Applicant's Revised Brief On Appeal - item 1). The petition filed April 4, 2008, included the petition fee (item 2) and the requisite statement (item 3).

The petition for entry of the late papers is granted.

Jurisdiction over the reexamination proceeding is being returned to Central Reexamination Unit (CRU) Art Unit 3991 for further examination and consideration of the Applicant's Revised Brief On Appeal filed May 23, 2008, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Jerry Johnson, in CRU Art Unit 3991, who can be reached at 571-272-1448.

Telephone inquiries related to this decision should be directed to Fred A. Silverberg at 571-272-7719.

Fred A. Silverberg

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissi ner for Patents
United States Pat nt and Trademark Offic
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Alexandria, VA 22313-1450
www.uspto.gov

Peter P. Tong (Patent Owner)
1807 Limetree Lane
Mountain View CA 94040

MAILED
APR 1 1 2006
REEXAM UNIT

Stephen C. Durant (Third Party Requester)
Morrison & Foerster LLP
425 Market Street
San Francisco, CA 94105

In re Ho et al :
Reexamination Proceeding : DECISION
Control No. 90/006,915 : DISMISSING
Submitted: August 25, 2003 : PETITION
For: U.S. Patent No. 6,398,556 :

This is a decision on the petition filed by Peter P. Tong, on behalf of the patent owner on January 29, 2006, entitled PETITION TO WITHDRAW FROM ISSUANCE UNDER 37 C.F.R. 1.313(a) and INFORMATION DISCLOSURE STATEMENT PURSUANT TO 37 C.F.R. 1.56.

The petition is before the Office of Patent Legal Administration in the United States Patent and Trademark Office (the "Office") for a decision on the petition.

The petition is **dismissed** for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No.6,398,556, entitled, "Inexpensive computer-aided learning methods and apparatus for learners," issued on June 4, 2002, with 86 claims.

2. A Request for Reexamination, assigned control no. 90/006,915, was filed on August 25, 2003.

3. The proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed on January 6, 2006.

4. Patent Owner filed the present Petition to Withdraw from Issuance under 37 CFR 1.313(a) and an accompanying Information Disclosure Statement under 37 CFR 1.56 on January 29, 2006.

DECISION DISMISSING THE PETITION TO WITHDRAW FROM ISSUE FOR CONSIDERATION OF INFORMATION DISCLOSURE STATEMENT

1. The present petition is a petition to withdraw from issuance under 37 CFR 1.313(a). This is not a proper petition for withdrawal from issuance of a Reexamination Certificate.

37 CFR 1.313 states (empasis 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.

There is no withdrawal of a reexamination proceeding from issue available under 37 CFR 1.313, because 37 CFR 1.313(a) applies to applications and not to reexamination proceedings. Even if a petition had been filed under 37 C.F.R. 1.182, there would be no grounds for relief. There is no issue fee in reexamination, and the present proceeding has entered the publication process. The present fact situation fails to satisfy any grounds that would be analogous to 37 CFR 1.313(b) or (c). In addition, the statutory requirement of 35 U.S.C. 305 that all *ex parte* reexamination proceedings "will be conducted with special dispatch within the Office" dictates that the present proceeding not be withdrawn from the publication process. 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, the petition to withdraw from issue must be dismissed.

2. Patent owner's basis for withdrawing the reexamination from the publication process is for consideration of an Information Disclosure Statement (IDS). The IDS was concurrently filed (with the petition) under 37 CFR 1.56. The filing of an IDS in a reexamination proceeding by the patent owner is governed by 37 CFR 1.555. 37 CFR 1.555 states the timing requirements for filing an IDS in a reexamination proceeding. Specifically, it is stated:

> "Any information disclosure statement must be filed with the items listed in 1.98(a) as applied to individuals associated with the patent owner in a reexamination proceeding and should be filed within two months of the date of the order for reexamination, or **as soon thereafter as possible**." (Emphasis added)

In the present instance, even if the proceeding was not is the publication process, the patent owner has not provided (a) a sufficient explanation of why the art submitted could not have been submitted earlier,[1] and (b) a statement as to why the art submitted makes at least one claim unpatentable.

Specifically, patent owner has not made a sufficient statement that the art submitted herein could not have been submitted earlier. Although patent owner does state that the documents cited were mailed to Patentees with an Office action from another patent application which identified a number of patent references, it is not stated that the references cited on the IDS filed January 29, 2006, were not in patent owner's (and counsel's) possession earlier than the mailing of the Office action in "another patent application." Additionally, patent owner does not state the relationship, if any, of the claims in the "another patent application" to the claims under reexamination. Furthermore, the relevance of the cited documents with respect to the claimed invention in the reexamination proceeding has not been articulated in the IDS filing.

It is to be noted that, if patent owner, in fact, believes that one or more references submitted raise a substantial question of patentability as to at least one claim of the patent, the patent owner can always file a new request for reexamination for consideration of the references.

Accordingly, the petition is dismissed.

---

[1] This is especially important in view of the statutory mandate for special dispatch in reexamination proceedings discussed above.

CONCLUSION

1. The patent owner petition to withdraw the application from issuance under 37 CFR 1.313(a) filed on January 29, 2006 is dismissed.

2. Telephone inquiries related to this decision should be directed to Mary C. Till, Legal Advisor, at 571-272-7755.

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

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C:\Kiva\kenids\decisions\6915_dismiss_late IDS_reex-in-publ.wpd
April 10, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Mailed May 25, 2005

IRA J. SCHAEFER
HOGAN & HARTSON, L.L.P.
875 THIRD AVENUE
NEW YORK NY 10022

In re Reexamination Proceeding	:
Control No.: 90/006,921	:
Filed: January 26, 2004	: PETITION DECISION
For Patent No.: 6,391,920	:
Attorney Docket No.: Fisch 201	:

This is in response to the petition under 37 CFR 1.181, filed April 25, 2005, requesting withdrawal of the Finality of the last Office action.

BACKGROUND

A review of the file history shows that following the Order granting reexamination and both Patent Owner's and Requester's replies thereto, the examiner mailed a non-Final Office action to Patent Owner on September 9, 2004, setting a two month shortened statutory period for reply, which set forth three grounds of rejection: claims 1-3 under 35 U.S.C. 102(b) as anticipated by Guay et al; claims 1-3 and 11-14 under 35 U.S.C. 103(a) as unpatentable over Guay et al in view of Jarow; and claims 1-10 under 35 U.S.C. 103(a) as unpatentable over Guay et al in view of Sternbach and Suzuki et al.

Patent Owner replied on October 29, 2004, amending claims 1 and 4 by adding the phrases "disorders related to" and "to men in need of such treatment" (Claim 4 only). Claims 15-22 were also added. Each of the rejections was properly addressed.

The examiner mailed a Final Office action to Patent Owner on February 23, 2005, in which all of the previous rejections were specifically withdrawn in view of Patent Owner's arguments. The examiner set forth a new rejection under 35 U.S.C. 103(a) of claims 1-22 as unpatentable over Guay et al in view of Sternbach and Jarow. The examiner made the Office action Final asserting that Patent Owner's amendments necessitated the new ground of rejection.

Patent Owner filed this petition accompanied by a reply to the Office action on April 25, 2005.

DISCUSSION

Patent Owner argues that the amendment to claim 4 was non-substantive in that it merely explicitly recited an implicit limitation and thus did not change the scope of the claim. Thus the making of a new ground of rejection of claim 4 Final was improper. It is noted that all of the

prior art applied against claim 4 was applied in previous rejections, but not in the same manner or combination as now applied. Thus the rejection is a new rejection and was not necessitated by Patent Owner's amendment of claim 4. (It is noted that the amendment to claim 1 or the addition of claims 15-22 are not argued as being non-substantive and the examiner's attention may have been focused thereon as a substantive change which permitted the making a new ground of rejection Final.)

The petition is **GRANTED.**

The Office action mailed February 23, 2005, is hereby redesignated a non-Final Office action. Patent Owner's reply filed April 25, 2005, is considered timely and will be fully considered 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,922	01/27/2004	6305410	20051.000200	5760

7590 04/20/2006

Thomas R. Fitzgerald, Esq.
16 E. Main Street Suite 210
Rochester, NY 14614-1803

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/20/2006

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Thomas R. FitzGerald
16 East Main Street, Suite 210
Rochester, New York 14614-1803

For Patent Owner

APR 2 0 2006
REEXAM UNIT

Ex Parte Reexamination Proceeding
Control No. 90/006,922
Filed: January 27, 2004
For: US Patent No. 6,305,410

DECISION GRANTING
PETITION FOR
EXTENSION OF TIME
[37 CFR 1.550(c)]

This is a decision on the petition filed March 2, 2006 to request a one-month extension of time pursuant to 37 CFR 1.550 for responding to the Office action dated February 2, 2006.

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

The petition is granted for one month for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action dated February 2, 2006, which set a one month date for filing a response thereto. The Office action is a non-final Office action. The request is timely filed and includes authorization to debit a deposit account for the $200.00 petition fee as required by 37 CFR 1.515(c).

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. ...

Patent Owner's Showing of Sufficient Cause to Grant an Extension of Time

The petition for extension of time states that, due to a docketing error, the action was mistakenly docketed for three months. A copy of the pertinent pages of the attorney's docketing calendar is included with the petition.

Analysis and Findings

On balance, it is considered that the petition explains the "sufficient cause" for an extension of time. Patent Owner has provided the appropriate documentation to support the assertion of a docketing error. Docketing errors are not ordinarily considered sufficient cause to grant an extension of time; however, in the interest of providing the patent owner with a fair opportunity to present an argument and in view of the conscientious manner in which counsel attempted to correct this error, an extension of time of one month is granted. Patent Owner should note that this will not be seen to provide a compelling reason establishing an extraordinary situation in support of the grant of any subsequent extension of time.

Conclusion

1. The patent owner's petition for extension of time of one month in which to file a response to the Office action dated February 2, 2006 is **granted**.

2. The Patent Owner's response is due April 2, 2006.

3. Response may be submitted as follows:

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

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

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

4. Telephone inquiries with regard to this decision should be directed to Deborah Jones, Special Program Examiner in the Central Reexamination Unit, Art Unit 3991, at (571) 272-1535.

for Lissi M. Marquis,
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,926	01/28/2004	5683548	SC02896A R01	7475

23125 7590 07/03/2006

FREESCALE SEMICONDUCTOR, INC.
LAW DEPARTMENT
7700 WEST PARMER LANE MD:TX32/PL02
AUSTIN, TX 78729

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/03/2006

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UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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David G. Dolezal	:	
Freescale Semiconductor, Inc	:	
7700 W. Parmer Lane	:	(Patent Owner)
MD: TX 32/PL02	:	
Austin, TX 78729	:	

MAILED

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CENTRAL REEXAMINATION UNIT

In re Hartig et al	:	
Reexamination Proceeding	:	DECISION
Control No. 90/006,926	:	DISMISSING
Submitted: January 28, 2004	:	PETITION
For: U.S. Patent No. 5,683,548	:	

This is a decision on the March 31, 2006 patent owner petition, titled PETITION UNDER 37 C.F.R. 1.182 TO ALLOW INFORMATION DISCLOSURE STATEMENTS.

The petition is before the Office of Patent Legal Administration in the United States Patent and Trademark Office (the "Office") for decision.

The petition is **dismissed** for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 5,683,548, entitled, "Inductively Coupled Plasma Reactor and Process," issued on November 4, 1997, with 28 claims.

2. A request for reexamination, assigned Control No. 90/006,926, was filed on January 28, 2004.

3. The proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed on August 9, 2005.

4. Patent Owner filed the present petition under 37 CFR 1.182 to permit for consideration of an Information Disclosure Statement (IDS) on March 31, 2006.

DECISION DISMISSING THE PETITION TO CONSIDER INFORMATION DISCLOSURE STATEMENTS

Patent owner has filed the present petition under 37 C.F.R. 1.182 for consideration of an Information Disclosure Statement stated to be based on references uncovered during prosecution of a Japanese application related to U.S. Patent No. 5,683,548. The present proceeding has entered the publication process. The filing of an IDS in a reexamination proceeding by the patent owner is governed by 37 CFR 1.555. 37 CFR 1.555 states the timing requirements for filing an IDS in a reexamination proceeding. Specifically, it is stated:

> "Any information disclosure statement must be filed with the items listed in 1.98(a) as applied to individuals associated with the patent owner in a reexamination proceeding and should be filed within two months of the date of the order for reexamination, or **as soon thereafter as possible**." (Emphasis added)

In the present instance, even if the proceeding was not is the publication process, the patent owner has not provided (a) a sufficient explanation of why the art submitted could not have been submitted earlier,[1] and (b) a statement as to why the art submitted makes at least one claim unpatentable.

Specifically, patent owner has not made a sufficient statement that the art submitted herein could not have been submitted earlier. Although patent owner does state that the documents referred to on the PTO-1449 were cited in a related Japanese Application that is still pending, there is no express statement that the documents were not in the patent owner's or patent owner's representative's possession earlier. It is not stated that the references cited on the IDS filed March 31, 2006, were not in patent owner's (and counsel's) possession earlier than the citation of the references in a related Japanese application that is still pending. Additionally, patent owner does not state the relationship, if any, of the claims in the "related Japanese Application" to the claims under reexamination. Furthermore, the relevance of the cited documents with respect to the claimed invention in the reexamination proceeding has not been articulated in the IDS filing.

It is to be noted that, if patent owner, in fact, believes that one or more references submitted raise a substantial new question of patentability as to at least one claim of the patent that is different than the substantial new questions raised in the present proceeding, the patent owner can always file a new request for reexamination for consideration of the references.

Accordingly, the petition is dismissed.

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[1] This is especially important in view of the statutory mandate for special dispatch in reexamination proceedings discussed above.

CONCLUSION

1. The patent owner petition to consider the Information Disclosure Statement filed on March 31, 2006 is dismissed.

2. The Information Disclosure Statement filed on March 31, 2006 is however entered into the file.

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 Mary C. Till, Legal Advisor, at 571-272-7755.

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

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July 2, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,927	01/30/2004	6586065	0425-1110P	1851

2292 7590 05/02/2006

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/02/2006

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CST

Birch, Stewart, Kolasch & Birch, LLP PO Box 747 Falls Church, Virginia 22040	:	(for Patent Owner)
In re Katayama et al Reexamination Proceeding Control No. 90/006,927 Filed: January 30, 2004 For: U.S. Patent 6,586,065	:	**DECISION ON PETITION TO WITHDRAW THE PREMATURE INDICATION OF FINALITY**

This is a decision on the PETITION UNDER 37 CFR § 1.181 FOR WITHDRAWAL OF PREMATURE INDICATION OF FINALITY, filed March 24, 2006. Petitioner states that the finality of the Office action mailed December 27, 2005 is premature. In particular, petitioner notes that while claims 7 and 11 were indicated as rejected on the coversheet of the final office action (form PTOL-466), claims 7 and 11 were not mentioned in the body of the office action.

A review of the file history of Reexamination Control No. 90/006,927 ('6927) shows that while claims 7 and 11 were indicated as being rejected on the coversheet of the final office action, none of the prior art rejections specifically discussed claims 7 and 11. As patent owner was unable to determine whether or not claims 7 and 11 were rejected, and if rejected, the identity of the prior art forming the basis of the rejection, the finality of the office action mailed December 27, 2005 is withdrawn.

The petition is **GRANTED**.

This reexam is being forwarded to the examiner for preparation of an office action addressing claims 7 and 11, and consideration of the amendment submitted on February 27, 2006.

JMStone

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

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Paper No. 10

MAILED
SEP 10 2004
REEXAM UNIT

Hark Chan
861 Brent Drive
Cupertino, CA 95014

(For Patent Owner)

Carol G. Stovsky
Standley Law Group LLP
495 Metro Place South; Suite 210
Dublin, OH 43017-5319

(For Third Party Requester)

In re Chan	:	
Ex parte Reexamination Proceeding	:	DECISION GRANTING
Control No. 90/006,933	:	PETITION
Filed: February 11, 2004	:	
For: U.S. Patent No. 6,314,574	:	

This is a decision on the July 29, 2004, patent owner petition requesting that the provisions of 37 CFR 1.550(f) (service of copy on requester) be waived, and that patent owner be permitted to submit confidential information (sealed under the guidelines of MPEP 724 et seq.) which has not been served on the third party requester. The petition is before the Office of Patent Legal Administration.

The petition is granted for the reasons set forth below.

DISCUSSION

37 CFR 1.550(f) provides (in part):

> (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 reexamination proceeding in the manner provided by § 1.248.

On April 29, 2004, petitioner submitted an information disclosure statement (three large boxes) which comprises non-confidential prior art and confidential litigation material. The non-confidential information is submitted in paper copy format for entry into the reexamination file (and available to the public) at this time. Petitioner avers that the non-confidential prior art has been served on the reexamination requester. The confidential litigation material has been submitted in sealed envelopes under the guidelines of MPEP 724 et seq. This material has not been served on the reexamination requester. Petitioner requests that the service of copy requirement of § 1.550(f) be waived for the sealed confidential information material.

Petitioner also requests the Director for a waiver, to the extent it is needed, of the filing prohibition of 37 CFR 1.540 which prohibits the filing of any submission by any party except for the statement and reply before the first Office action. It is noted that a waiver of § 1.540 is not needed for the filing of an information disclosure statement (IDS) by the patent owner in a reexamination proceeding prior to the first Office action. 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. Accordingly, the request for a waiver of § 1.540 is dismissed as moot.

DECISION

Under the guidelines of MPEP 724 et seq. confidential information may be submitted in sealed envelopes for consideration by the examiner during the examination on the merits, and timely release to the public of any of the information found to be important to a reasonable examiner in deciding whether or not a claim is patentable. It goes without saying, that requiring service of copy of confidential information submitted under seal would defeat the intent and goal of submitting confidential information under seal. Accordingly, an extraordinary situation is present where justice requires that the provisions of 37 CFR 1.550(f) be waived to the extent that the materials listed as "confidential" do not have to be served on the third party requester. It is noted that any of the "confidential" materials found to be important to a reasonable examiner in deciding whether or not a claim is patentable and therefore made of record in the proceeding would become available to the public (and to the requester) under the guidelines of MPEP 724.04(c). Accordingly, the petition is granted.

CONCLUSION

1. The patent owner petition filed July 29, 2004, is **granted**.

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

Gerald A. Dost

Gerald A. Dost
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner for Patent Examination Policy

UNITED STATES
PATENT AND
TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR
INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
PO BOX 1450, ALEXANDRIA, VA 22313-1450
WWW.USPTO.GOV

Mailed: December 27, 2004

ADAM COCHRAN
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PASADENA CA 91125

FOR PATENT OWNER

EDWARD S. IRONS
3945 52ND STREET, NW
WASHINGTON, DC 20016

FOR REQUESTER

In re Grubbs et al
Reexamination Proceeding
Control No.: 90/006,939
Filed: February 13, 2004
For: U.S.Patent No. 5,831,108

: DECISION RETURNING
: IMPROPER PAPER

The paper filed on September 22, 2004, by the third party Irons as a petition for issuance of a Certificate (NIRC) is an improper paper under 37 CFR 1.550(e)..

Following order of reexamination a third party requester has no standing to file any papers in a reexamination proceeding except to reply to a Patent Owner's Statement. No such statement has been filed in this proceeding. The proceeding is presently before the examiner for further consideration. Third party requester's filing of papers such as this only delays that consideration. Accordingly, the paper has not been considered and is being returned herewith. MPEP 2267. This decision will be made of record in the reexamination file.

Bruce M. Kisliuk
Director, Technology Center 1600