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McDermott Will & Emery LLP
600 13TH Street, N.W.
Washington, DC 20005-3096

(For Patent Owner)

MAY 8 2006

David L. Fehrman
Morrison & Foerster, LLP
555 West Fifth Street
Los Angeles, CA 90013

(For 3rd Party Requester)

Reexam Control No.: 90/007,222
Filed : September 24, 2004
For U.S. Patent No. : 4,808,155

DECISION MERGING REEXAMINATION PROCEEDINGS

Reexam Control No.: 90/007,784
Filed : October, 27, 2005
For U.S. Patent No. : 4,808,155

The above noted reexamination proceedings are before the Director of the Central Reexamination Unit for consideration of merger as provided for in 37 CFR § 1.565(c).

Reexamination in application control No. 90/007,222 was ordered in a decision mailed November 19, 2004. Prosecution has proceeded to the filing of a Patent Owner's response to an Office action on September 22, 2005.

Reexamination in application control No. 90/007,784 was ordered in a decision mailed January 20, 2006. On February 16, 2006 Patent Owner filed a letter waiving the rights to file a Patent Owner's statement under the provisions of 37 CFR § 1.530 (c) and (d). No Office action has been issued.

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.

Requirement for Same Claims, Drawings, and Specification in Both Proceedings

The Patent Owner is required to maintain identical claims, specifications, and drawings in both files. In view of the fact that both proceedings are identical, no amendment is necessary at this time.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. All papers mailed by the Office will take the form of a single action, which applies to both proceedings. All papers issued by the Office or as filed by the Patent Owner will contain the

identifying data for both files and will be physically entered in each reexamination file. All papers filed by the Patent Owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by Patent Owner must be served on the Third Party Requester and requester will be sent copies of all papers mailed by the Office.

Conclusion

Reexamination Control Nos. 90/007,222 and 90/007,784 are hereby merged. Upon mailing of this decision, both files will be forwarded to the examiner for issuance of an Office action on the merits.

Any inquiry concerning this decision should be directed to Andres Kashnikow, Special Programs Examiner, at telephone No. (571) 272-4361.

Lissi Mojica Marquis, Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,222 E 90/007,784	09/24/2004	4808155	480060000001	1451

20277 7590 08/03/2006

MCDERMOTT WILL & EMERY LLP
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

EXAMINER
REIP, D

ART UNIT	PAPER NUMBER
3993	

DATE MAILED: 08/03/2006

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

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8/3/2006

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

David L. Fehman

Morrison & Foerster, LLP

555 West Fifth Street

Los Angeles, CA 90013

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007222 & 90/007,784

PATENT NO. 4,808,155

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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AUG 3 2006

In re Application of 4808155
Appl. No.: 90/007,222 & 90/007,7784
Filed: September 24, 2004 & October 27, 2005(resp.)
For: Simple Double Lumen Catheter

DECISION ON PETITION UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b), filed March 4, 2005 in reexam Control No. 90/007,222, to expunge information from the above identified application.

The petition is granted.

Petitioner requests that the documents entitled: (1) Consent Judgment Order, In the Matter of Mahurkar Double Lumen Hemodialysis Patent Litigation, U.S. District Court for The Northern District of Illinois, Eastern Division, No. MDL 853 90-CV-05909, April 30, 1992; (2) Examination Before Trial Of USCI, Inc. In The Matter Of Mahurkar Double Lumen Hemodialysis Catheter Patent Litigation, U.S. District Court for The Northern District of Illinois, Eastern Division, No. MDL 853, June 29, 1992, at 19-20; (3) Chronological Index of Mahurkar Documents and attachments, relating to the conception and reduction to practice of the invention of U.S. Patent No. 4,808,155; and (4) Dr. Mahurkar Supplemental Exhibits 1-22, relating to the conception and reduction to practice of the invention of U.S. Patent 4,808,155, filed March 4, 2005, be expunged from the record. Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(h) has been paid.

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

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

The expunged material has been removed from the official file.

Andres Kashnikow,
Special Program Examiner,
Central Reexamination Unit 3993
(571) 272-4361

Enclosures:

(1) Consent Judgment Order, In the Matter of Mahurkar Double Lumen Hemodialysis Patent Litigation, U.S. District Court for The Northern District of Illinois, Eastern Division, No. MDL 853 90-CV-05909, April 30, 1992;
(2) Examination Before Trial Of USCI, Inc. In The Matter Of Mahurkar Double Lumen Hemodialysis Catheter Patent Litigation, U.S. District Court for The Northern District of Illinois, Eastern Division, No. MDL 853, June 29, 1992, at 19-20;
(3) Chronological Index of Mahurkar Documents and attachments, relating to the conception and reduction to practice of the invention of U.S. Patent No. 4,808,155; and
(4) Dr. Mahurkar Supplemental Exhibits 1-22, relating to the conception and reduction to practice of the invention of U.S. Patent 4,808,155.

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MAILED
JAN 04 2006
REEXAM UNIT

In re Thomas et al :
Reexamination Proceeding : **DECISION**
Control No.: 90/007,223 : **GRANTING**
Filed: September 28, 2004 : **PETITION**
For: U.S. Patent No.: 6,618,998 :

This is a decision on the October 18, 2005 patent owner petition entitled PETITION TO ACCEPT AN UNINTENTIONALLY DELAYED RESPONSE UNDER 37 C.F.R. § 1.550(e)(2), as supplemented by a December 28, 2005 renewed petition containing a Corrected Amendment .

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

The petition fee of $1,500.00 set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b) has been charged to petitioner's Deposit Account No. 16-0631, in accordance with petitioner's authorization on page 65 of the petition materials sent via facsimile on October 18, 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 renewed petition containing a Corrected Amendment was filed on December 28, 2005,[1] to accompany patent owner's October 18, 2005 petition. The Corrected Amendment presents the claims in proper marked-up form and incorporates by reference the Remarks and submissions in the Amendment

[1] In response to a request for same, in a telephone call made by Samuel Broda to the office of James H. Patterson on December 27, 2005.

originally submitted with the October 18, 2005 petition. The combination of the submissions, the Remarks, and the Corrected Amendment thereby provides the response "required to the outstanding Office action or notice" pursuant to 37 CFR 1.137(b)(1). Further, the required petition fee is being charged to petitioner's deposit account as authorized on page 65 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 3900 for consideration, in due course, of the Corrected Amendment filed December 28, 2005, and the corresponding Remarks and submissions filed October 18, 2005.

3. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Jimmy Foster, in Art Unit 3993, who can be reached at (571) 272-4554.

4. Telephone inquiries related to this decision should be directed to Samuel Broda at (571) 272-7711.

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

SSB
12/28/05

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1/4/06

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,228	10/01/2004	5736164	36585.2	5921

7590 01/18/2006

EXAMINER

William Rudy, Esq.
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ART UNIT	PAPER NUMBER

DATE MAILED: 01/18/2006

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

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Orlando, FL 32802

MAILED
JAN 18 2006
REEXAM UNIT

In re Reexamination Proceeding :
John B. Taylor :
Control No. 90/007,228 : DECISION GRANTING PETITION
Filed: October 1, 2004 :
U.S. Patent No. 5,736,164 :
Attorney Docket No. 431492 :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on December 20, 2005, by facsimile transmission, for entry of late papers based upon unintentional delay.

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

37 CFR 1.137(b) states:

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

A review of the response filed December 20, 2005, reveals that it includes a request for reconsideration including, *inter alia*, amendments to the specification and claims, a Rule 132 Declaration of Monty Ferrell, a Notice of Appeal including an authorization to charge counsel's deposit account, and a Certificate of Service, wherein the Notice of Appeal is considered the

requisite item 1.

The present petition under 37 CFR 1.137(b) includes a response (item 1), a $750.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3).

The petition for entry of the late papers is granted.

37 CFR 1.121(j) states:

> *"Amendments in reexamination proceedings.*
> Any proposed amendment to the description and claims in patents involved in reexamination proceedings must be made in accordance with § 1.530."

Petitioner should review the amendments submitted along with the present petition on December 20, 2005, by facsimile transmission, for compliance with 37 CFR 1.530, as 37 CFR 1.121(c) does not apply in reexamination proceedings.

$1,000 ($750.00 for the present petition fee and $250.00 for the Notice of Appeal fee) has been charged to counsel's deposit account 12-0600 in accordance with the authorization contained in the present petition.

The reexamination proceeding is being returned to Technology Center Art Unit 1616 for further examination and consideration of the response filed December 20, 2005, along with the present petition, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Frank Choi, in Technology Center Art Unit 1616, who can be reached at 571-272-0610.

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

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

Kenneth M. Schor
Conferee: Kenneth M. Schor

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,229	10/01/2004	5800837	36585.2	5922

7590 01/18/2006

EXAMINER

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ART UNIT	PAPER NUMBER

DATE MAILED: 01/18/2006

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

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Orlando, FL 32802

MAILED
JAN 18 2006
REEXAM UNIT

In re Reexamination Proceeding :
John B. Taylor :
Control No. 90/007,229 : DECISION GRANTING PETITION
Filed: October 1, 2004 :
U.S. Patent No. 5,800,837 :
Attorney Docket No. 431448 :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on December 20, 2005, by facsimile transmission, for entry of late papers based upon unintentional delay.

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

37 CFR 1.137(b) states:

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

A review of the response filed December 20, 2005, reveals that it includes a request for reconsideration including, *inter alia*, amendments to the specification and claims, a Rule 132 Declaration of Monty Ferrell, a Notice of Appeal including an authorization to charge counsel's deposit account, and a Certificate of Service, wherein the Notice of Appeal is considered the

requisite item 1.

The present petition under 37 CFR 1.137(b) includes a response (item 1), a $750.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3).

The petition for entry of the late papers is granted.

37 CFR 1.121(j) states:

> *"Amendments in reexamination proceedings.*
> Any proposed amendment to the description and claims in patents involved in reexamination proceedings must be made in accordance with § 1.530."

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$1,000 ($750.00 for the present petition fee and $250.00 for the Notice of Appeal fee) has been charged to counsel's deposit account 12-0600 in accordance with the authorization contained in the present petition.

The reexamination proceeding is being returned to Technology Center Art Unit 1616 for further examination and consideration of the response filed December 20, 2005, along with the present petition, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Frank Choi, in Technology Center Art Unit 1616, who can be reached at 571-272-0610.

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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MAILED

JAN 0 9 2006

REEXAM UNIT

In re Application of 5122136
Appl. No.: 90/007,230
Filed: October 04, 2004
For: Endovascular Electrolytically Detachable Guidewire Tip for the Electroformation of Thrombus in Arteries, Veins, Aneurysms, Vascular Malformations and Arteriovenous et al

DECISION ON PETITION UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b), filed May 13, 2005, to expunge information from the above identified application.

The petition is granted.

Petitioner requests that documents associated with the proceedings of The Regents of the University of California v. Micro Therapeutics, Inc. et al. (case No. C 03 05669 (JW)) and Boston Scientific Corp. v. Cordis Neurovascular (case No. C 02-1474 JW), listed hereinbelow and filed May 13, 2005, be expunged from the record. Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(h) has been paid.

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

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

The expunged material has been removed from the official file.

Lissi Mojica Marquis, Director
Central Reexamination Unit

Listing of Returned Documents

(A) The Regents of the University of California v. Micro Therapeutics, Inc. et al documents:

(1) MTI's Memorandum of Points and Authorities in Opposition to the Boston Scientific and Target's Motion for Summary Judgement;
(2) MTI's Memorandum of Points and Authorities in Opposition to the Regents' Motion for Summary Judgement;
(3) MTI's Notice of Motion, Motion and Memorandum in Support of Motion for Summary Judgement of Unforceability of the Patents in Suit Due to Inequitable Conduct;
(4) Exhibits 59-71 to the Declaration of Michelle M. Umberger in Support of Summary Judgement of Unforceability of the Patents in Suit Due to Inequitable Conduct;
(5) The Regents' Notice of Motion, Motion, and Memorandum of Points and Authorities in Support of Motion for Summary Judgement of No Inequitable Conduct; and Opposition to Defendants' Motion for Summary Judgement;
(6) Exhibits 9 and 10 to Declaration of Alice Chen in Support of The Regents' Motion for Summary Judgement of No Inequitable Conduct; and Opposition to Defendants' Motion for Summary Judgement;
(7) MTI's Opposition To Plaintiff's Motion for Summary Judgement of No Inequitable Conduct; and
(8) MTI's Reply in Support of Motion for Summary Judgement of Unenforceability of the Patents in Suit Due to Inequitable Conduct.

(B) Boston Scientific Corp. v. Cordis Neurovascular documents:

(1) Exhibit 1 to the Declaration of Lisa A. Schneider in Support of Defendant Cordis' Claim Construction Brief;
(2) Exhibit 4 to the Declaration of Stephanie P. Koh in Support of Cordis' Motion for Leave to Amend Final Invalidity Contentions;
(3) Defendant Cordis' Opposition to Plaintiffs' Motion for Summary Judgement of No inequitable Conduct;

(4) Defendant Cordis' Reply to Plaintiffs' Opposition to Motion for Summary Judgement of Invalidity of Radiopaque Marker Claims of U.S. Patent Numbers 5,895,385 and 5,010,498 and Opposition to Cross-Motion for Validity of the Radiopaque Marker Claims;
(5) Motion for Summary Judgement of Invalidity of Radiopaque Marker Claims of U.S. Patent Numbers 5,895,385 and 6,010,498;
(6) Exhibits A and B to the Supplemental Declaration of Amanda M. Kessel in Support of Plaintiffs' Opposition to Cordis' Motion for Summary Judgement of Invalidity of Radiopaque Marker Claims;
(7) Exhibits B and C to the Declaration of Dr. Charles Strothers in Support of Plaintiffs' Opposition to Cordis' Motion for Summary Judgement of Invalidity;
(8) Plaintiffs' Opposition to Cordis' Motion for Summary Judgement of Invalidity of Radiopaque Marker Claims of U.S. Patent Numbers 5,895,385 and 6,010,498 and Memorandum in Support of Cross-Motion for Validity of the Radiopaque Marker Claims;
(9) Errata and Corrected Defendant Cordis' Opposition to Plaintiffs' Motion for Summary Judgement of No Inequitable Conduct;
(10) Defendant Cordis' Reply to Plaintiffs' Opposition to Motion for Summary Judgement of Invalidity of Radiopaque Marker Claims of U.S. Patent Numbers 5,895,385 and 6,010,498 and Opposition to Cross-Motion for Validity of the Radiopaque Marker Claims;
(11) Revised First Amended Answer and Counterclaims;
(12) Reply in Further Support of Plaintiffs' Cross-Motion for Validity of the Radiopaque Marker Claims;
(13) Exhibit A to the Declaration of Dwight Green in Support of Plaintiff Boston Scientific's Reply in Further Support of its Cross-Motion for Validity of the Radiopaque Marker Claims of U.S. Patent Numbers 5,895,385 and 6,010,498;
(14) Exhibit 1 to Declaration of Stephanie P. Koh in Support of Defendant Cordis' Motion for Leave to Amend Final Invalidity Contentions;
(15) Exhibits B, G, and I to Second Supplemental Declaration of Amanda M. Kessel in Support of Plaintiffs' Summary Judgement Motions;
(16) Various Pages of Deposition Testimony;
(17) Exhibits D, K, L, R, S, T, U, and W to the Declaration of Amanda Kessel in Support of Plaintiffs' Summary Judgement Motions;
(18) Exhibits 4, 6, 8-12, 30, and 39-46 to Declaration of Stephanie P. Koh in Support of Motion for Summary Judgement;
(19) Exhibits 53, 56, 61-82, and 87-89 to Supplemental Declaration of Stephanie P. Koh in Support of Plaintiffs' Motions for Summary Judgement Regarding Validity and Inequitable Conduct;
(20) Notice of Motion and Motion for Summary Judgement of Invalidity of Radiopaque Marker Claims of U.S. Patent Numbers 5,895,385 and 6,010,498;
(21) Declaration of Dr. Randall T. Higashida in Support of Notice of Motion and Claims for Summary Judgement of Invalidity of Radiopaque Marker Claims of U.S. Patent Numbers 5,895,385 and 6,010,498; Declaration of John M. Collins; and Declaration of Stephanie P. Koh;
(22) Exhibits 3-7 and 9-16 to the Declaration of Stephanie P. Koh in Support of Notice of Motion and Motion for Summary Judgement of Invalidity of Radiopaque Marker Claims of U.S. Patent Numbers 5,895,385 and 6,010,498;

(23) Exhibits 17-23 to Declaration of Stephanie P. Koh in Support of Notice of Motion and Motion for Summary Judgement of Invalidity of Radiopaque Marker Claims of U.S. Patent Numbers 5,895,385 and 6,010,498; and
(24) Exhibits 24-33 to Declaration of Stephanie P. Koh in Support of Notice of Motion and Motion for Summary Judgement of Invalidity of Radiopaque Marker Claims of U.S. Patent Numbers 5,895,385 and 6,010,498.

mcl

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Joel E. Siegel (For Requester)
Wood Phillips, Katz, Clark & Mortimer
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Chicago, Illinois 60661-2562

MAILED
JUN 07 2006
REEXAM UNIT

In re Reissue Application of Guido Guglielmi et al. Application No. 11/377,895 Filed: March 15, 2006 For: U.S. Patent No. 5,895,385	:	DECISION GRANTING PETITION TO MERGE REISSUE AND REEXAMINATION PROCEEDINGS
In re Guido Guglielmi et al. Reexamination Proceeding Control No. 90/007,231 Filed: October 4, 2004 For: U.S. Patent No. 5,895,385	:	

This is a decision on the March 15, 2006 patent owner petition under 37 CFR 1.182,[1] requesting that the above captioned reissue and reexamination proceeding be merged.

The petition and the above-captioned 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.

The petition is **GRANTED**.

REVIEW OF FACTS

1. U.S. patent No. 5,895,385 (the '385 patent) issued on April 20, 1999, with 47 claims.

[1] The petition for merger was filed in the reissue application on March 15, 2006, and a separate copy was filed in the reexamination proceeding on April 11, 2006.

2. A request for reexamination was filed by a third party requester on October 4, 2004, and was assigned control No. 90/007,231 (the '231 proceeding).

3. Reexamination was ordered for the '231 proceeding on November 19, 2004.

4. An Office action setting a two-month period for response was mailed on February 9, 2006.

5. On February 10, 2006 an Examiner's Interview summary record (memorializing an interview with patent owner's representative on February 1, 2006) was mailed.

6. A statement of the substance of the interview held February 1 2006, was filed by patent owner's representative on February 28, 2006.

7. An application for reissue, assigned application No. 11/377,895 (the '895 application), was filed by the patent owner on March 15, 2006.

8. A response to the Office action of February 9, 2006 was received in the Office on April 11, 2006, with a certificate of mailing executed on April 7, 2006.

9. A petition requesting merger of the '895 reissue application and the '231 reexamination proceeding was filed in the reissue application on March 15, 2006 and a copy of the petition was filed in the reexamination proceeding on April 11, 2006.

10. The filing of the '895 reissue application was announced in the *Official Gazette* on May 9, 2006.

DISCUSSION REGARDING MERGER

Under 37 CFR 1.565(d):

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

As evidenced by the above review of facts, reissue application No. 11/377,895 and reexamination control No. 90/007,231 are currently

pending. The order to reexamine has been mailed in the reexamination proceeding, and notice of the reissue application has been published in the *Official Gazette*. Accordingly, a decision under 37 CFR 1.565(d) is timely.

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

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

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

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

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

II. Requirement for Same Amendments in Both Proceedings

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

2. A review of the file for reexamination control No. 90/007,231 shows the presence of the following live claims: original patent claims 1-47.

A review of reissue application No. 11/377,895 shows:

(a) original patent claims 1-47 are present;

(b) no new claims have been added;

(c) an amendment to the specification, affecting the priority, has been added.

Accordingly, although the claims are identical in both proceedings, the specifications are not identical.

An appropriate housekeeping amendment is required within <u>ONE (1) MONTH</u> of this decision placing the same amendments in both proceedings, specifically, Application No. 11/377,895 and Control Number 90/007,231. 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 reissue/reexamination proceeding are submitted <u>under 37 CFR 1.173</u>, 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 (or would be construed differently based on a difference in the specifications in the reexamination and reissue proceedings) should be rejected under 35 U.S.C. 112, paragraph 2, as being indefinite as to the content of the claim, and thus failing to particularly point out the invention.

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

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

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

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

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

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

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

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

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

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

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

10. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be dissolved. The reissue application will be held abandoned. The reexamination prosecution will be terminated, and a reexamination certificate under 37 CFR 1.570 will be issued in accordance with the last action of the Office, unless further action in the reexamination proceeding is needed as a result of the difference in the rules relating to reexamination and reissue proceedings. If further action in the reexamination proceeding is needed, any grounds of rejection 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 for consideration in reexamination pursuant to 37 CFR 1.552(c).

10. If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 CFR 1.138, then 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. The petition for merger is **granted**.

2. Reissue application No. 11/377,895 and reexamination control No. 90/007,231 **are merged** into a single proceeding.

3. 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.

4. Jurisdiction over the merged reissue and reexamination proceeding is being transferred to Technology Center 3700 in which the reissue proceeding is assigned. The examiner assigned the merged proceeding is not to be one who was involved in any part of the examination of the '385 patent (e.g., by preparing/signing an action), or was so involved in the examination of any parent of the '385 patent. See MPEP 2236.

5. The examiner should not issue an Office action for the present merged proceeding until after the earlier of: (a) the submission of the housekeeping amendment to place the same amendments in both cases, or (b) the expiration of the ONE MONTH period from the mailing of this decision for filing the amendment.

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

7. Telephone inquiries related to this decision should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726.

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

6-6-06
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(For Patent Owner)

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(For Requester)

In re Reissue Application of
GUGLIELMI ET AL.
Appl. No.: 11/377,895
Filed: March 15, 2006
For: U.S. Patent 5,895,385

In re GUGLIELMI ET AL.
Reexamination Proceeding
Control No. 90/007,231
Filed October 4, 2004
For: U.S. Patent 5,895,385

DECISION ON PETITION UNDER 37 CFR 1.59

This is a decision on the petitions under 37 CFR 1.59(b), filed May 13, 2005 and March 9, 2007, to expunge information from the above identified application.

The petition is granted.

Petitioner requests that documents as listed in the attachment to this decision, filed on May 13, 2005 (resubmitted on September 8, 2008), December 20, 2005, and February 13, 2006, be expunged from the record. Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the

information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

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

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

The expunged material has been removed from the official file.

Linda Sholl

Linda Sholl
Special Program Examiner
TC3700

Attachment: Listing of documents to be expunged

ATTACHMENT:
LISTING OF CONFIDENTIAL MATERIAL
FILED ON MAY 13, 2005 (RESUBMITTED ON SEPTEMBER 8, 2008)

The Regents of the University of California v. Micro Therapeutics, Inc., et al.
Case No. C 03 05669 (JW)

INDEX TO CONFIDENTIAL UNDER SEAL DOCUMENTS SUBMITTED

TAB	DATE	DOCUMENT
1	3/11/04	MTI's Memorandum of Points and Authorities in Opposition to the Boston Scientific and Target's Motion for Summary Judgment
2	3/11/04	MTI's Memorandum of Points and Authorities in Opposition to the Regents' Motion for Summary Judgment
3	12/20/04	MTI's Notice of Motion, Motion and Memorandum in Support of Motion for Summary Judgment of Unenforceability of the Patents in Suit Due to Inequitable Conduct
4	12/20/04	Exhibits 59- 71 to the Declaration of Michelle M. Umberger in Support of Summary Judgment of Unenforceability of the Patents in Suit Due to Inequitable Conduct
5	1/24/05	The Regents' Notice of Motion, Motion, and Memorandum of Points and Authorities in Support of Motion for Summary Judgment of No Inequitable Conduct; and Opposition to Defendants' Motion for Summary Judgment
6	1/24/05	Exhibits 9 and 10 to Declaration of Alice Chen in Support of The Regents' Motion for Summary Judgment of No Inequitable Conduct; and Opposition to Defendants' Motion for Summary Judgment
7	2/7/05	MTI's Opposition To Plaintiff's Motion for Summary Judgment of No Inequitable Conduct
8	2/15/05	MTI's Reply in Support of Motion for Summary Judgment of Unenforceability of the Patents in Suit Due to Inequitable Conduct

May 13, 2005

Boston Scientific Corp. v. Cordis Neurovascular
Case No. C 02-1474 JW

INDEX OF CONFIDENTIAL UNDER SEAL DOCUMENTS SUBMITTED

TAB	DATE	DOCUMENT
1.	04/24/03	Exhibit 1 to the Declaration of Lisa A. Schneider in Support of Defendant Cordis' Claim Construction Brief
2.	08/20/03	Exhibit 4 to the Declaration of Stephanie P. Koh in Support of Cordis' Motion for leave to Amend Final Invalidity Contentions
3.	12/20/04	Defendant Cordis' Opposition to Plaintiffs' Motion for Summary Judgment of No Inequitable Conduct
4.	12/21/04	Defendant Cordis' Reply to Plaintiffs' Opposition to Motion for Summary Judgment of Invalidity of Radiopaque Marker Claims of U.S. Patent Numbers 5,895,385 and 5,010,498 and Opposition to Cross-Motion for Validity of the Radiopaque Marker Claims.
5.	12/21/04	Motion for Summary Judgment of Invalidity of Radiopaque Marker Claims of U.S. Patent Numbers 5,895,385 and 6,010,498
6.	11/22/04	Exhibits A and B to the Supplemental Declaration of Amanda M. Kessel In Support of Plaintiffs' Opposition to Cordis' Motion for Summary Judgment of Invalidity of Radiopaque Marker Claims
7.	11/22/04	Exhibits B and C to the Declaration of Dr. Charles Strothers in Support of Plaintiffs' Opposition to Cordis' Motion for Summary Judgment of Invalidity
8.	11/24/04	Plaintiffs' Opposition to Cordis' Motion for Summary Judgment of Invalidity of Radiopaque Marker Claims of U.S. Patent Numbers 5,895,385 and 6,010,498 and Memorandum in Support of Cross-Motion for Validity of the Radiopaque Marker Claims
9.	01/07/05	Errata and Corrected Defendant Cordis' Opposition to Plaintiffs' Motion for Summary Judgment of No Inequitable Conduct
10.	12/20/04	Defendant Cordis' Reply to Plaintiffs' Opposition to Motion for Summary Judgment of Invalidity of Radiopaque Marker Claims of U.S. Patent Numbers 5,895,385 and 6,010,498 and Opposition to Cross-Motion for Validity of the Radiopaque Marker Claims
11.	04/02/04	Revised First Amended Answer and Counterclaims
12.	01/27/05	Reply in Further Support of Plaintiffs' Cross-Motion for Validity of the Radiopaque Marker Claims

May 13, 2005

TAB	DATE	DOCUMENT
13.	01/27/05	Exhibit A to the Declaration of Dwight Green in Support of Plaintiff Boston Scientific's Reply in Further Support of its Cross-Motion for Validity of the Radiopaque Marker Claims of U.S. Patent Numbers 5,895,385 and 6,010,498
14.	07/09/04	Exhibit 1 to Declaration of Stephanie P. Koh in Support of Defendant Cordis' Motion for Leave to Amend Final Invalidity Contentions
15.	01/26/05	Exhibits B, G, and I to Second Supplemental Declaration of Amanda M. Kessel in Support of Plaintiffs' Summary Judgment Motions
16.		Various Pages of Deposition Testimony
17.	11/12/04	Exhibits D, K, L, R, S, T, U, and W to the Declaration of Amanda Kessel In Support of Plaintiffs' Summary Judgment Motions
18.	12/21/04	Exhibits 4, 6, 8-12, 30 and 39-46 to Declaration of Stephanie P. Koh in Support of Motion for Summary Judgment
19.	12/21/04	Exhibits 53, 56, 61-82 and 87-89 to Supplemental Declaration of Stephanie P. Koh in Support of Plaintiffs' Motions for Summary Judgment Regarding Validity and Inequitable Conduct
20.	08/20/03	Purposely not submitted
21.	08/20/03	Purposely not submitted
22.	08/20/03	Purposely not submitted
23.	08/20/03	Purposely not submitted
24.	05/24/04	Purposely not submitted
25.	11/02/04	Notice of Motion and Motion for Summary Judgment of Invalidity of Radiopaque Marker Claims of U.S. Patent Numbers 5,895,385 and 6,010,498
26.	11/02/04	Declaration of Dr. Randall T. Higashida in Support of Notice of Motion and Motion for Summary Judgment of Invalidity of Radiopaque Marker Claims of US Patent Numbers 5,895,385 and 6,010,498; Declaration of John M. Collins; and Declaration of Stephanie P. Koh
27.	11/02/04	Exhibits 3-7 and 9-16 to the Declaration of Stephanie P. Koh in Support of Notice of Motion and Motion for Summary Judgment of Invalidity of Radiopaque Marker Claims of U.S. Patent Numbers 5,895,385 and 6,010,498

May 13, 2005

TAB	DATE	DOCUMENT
28.	11/02/04	Exhibits 17-23 to Declaration of Stephanie P. Koh in Support of Notice of Motion and Motion for Summary Judgment of Invalidity of Radiopaque Marker Claims of U.S. Patent Numbers 5,895,385 and 6,010,498
29.	11/02/04	Exhibits 24-33 to Declaration of Stephanie P. Koh in Support of Notice of Motion and Motion for Summary Judgment of Invalidity of Radiopaque Marker Claims of U.S. Patent Numbers 5,895,385 and 6,010,498
30.	11/02/04	Exhibits 24-33 to Declaration of Stephanie P. Koh in Support of Notice of Motion and Motion for Summary Judgment of Invalidity of Radiopaque Marker Claims of U.S. Patent Numbers 5,895,385 and 6,010,498

ATTACHMENT: LISTING OF CONFIDENTIAL MATERIAL FILED ON DECEMBER 20, 2005

Boston Scientific Corp. and Target Therapeutics v. Cordis Corporation
Case No. C 02-1474 JW

INDEX OF CONFIDENTIAL UNDER SEAL DOCUMENTS SUBMITTED

TAB	DATE	DOCUMENT
1.		Second Amended Disclosure of Expert Testimony of John M. Collins Under Fed. R. Civ. P.26(a)(2)
2.	02/11/03	Exhibit 4 To The Declaration Of Susan E. Bower In Support Of Defendant Cordis' Claim Construction Brief
3.	06/10/04	Deposition of Robert Lulo, p. 1, pp. 44-45, pp. 48-49
4.	06/10/04	Deposition of Robert Lulo, 69 pages
5.	06/16/04	Deposition of Grant Hieshima, M.D., p. 110
6.	06/16/04	Deposition of Grant Hieshima, M.D., 76 pages

ATTACHMENT: LISTING OF CONFIDENTIAL MATERIAL FILED ON FEB 13, 2006

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INDEX OF CONFIDENTIAL UNDER SEAL DOCUMENTS SUBMITTED

1. The Regents of the University of California v. Micro Therapeutics, Inc. and Dendron GmbH v. Boston Scientific Corporation and Target Therapeutics, Inc. – (Northern District Of California – Case No. C 03-05669 JW)

TAB NO.	DATE	DESCRIPTION
1.	12/20/04	Exhibit 59 to the Declaration of Michelle M. Umberger in Support of Summary Judgment of Unenforceability of the Patents in Suit Due to Inequitable Conduct
2.	12/20/04	Exhibit 60 to the Declaration of Michelle M. Umberger in Support of Summary Judgment of Unenforceability of the Patents in Suit Due to Inequitable Conduct
3.	12/20/04	Exhibit 61 to the Declaration of Michelle M. Umberger in Support of Summary Judgment of Unenforceability of the Patents in Suit Due to Inequitable Conduct
4.	12/20/04	Exhibit 62 to the Declaration of Michelle M. Umberger in Support of Summary Judgment of Unenforceability of the Patents in Suit Due to Inequitable Conduct
5.	12/20/04	Exhibit 63 to the Declaration of Michelle M. Umberger in Support of Summary Judgment of Unenforceability of the Patents in Suit Due to Inequitable Conduct
6.	12/20/04	Exhibit 64 to the Declaration of Michelle M. Umberger in Support of Summary Judgment of Unenforceability of the Patents in Suit Due to Inequitable Conduct
7.	12/20/04	Exhibit 65 to the Declaration of Michelle M. Umberger in Support of Summary Judgment of Unenforceability of the Patents in Suit Due to Inequitable Conduct
8.	12/20/04	Exhibit 66 to the Declaration of Michelle M. Umberger in Support of Summary Judgment of Unenforceability of the Patents in Suit Due to Inequitable Conduct
9.	12/20/04	Exhibit 67 to the Declaration of Michelle M. Umberger in Support of Summary Judgment of Unenforceability of the Patents in Suit Due to Inequitable Conduct
10.	12/20/04	Exhibit 68 to the Declaration of Michelle M. Umberger in Support of Summary Judgment of Unenforceability of the Patents in Suit Due to Inequitable Conduct
11.	12/20/04	Exhibit 69 to the Declaration of Michelle M. Umberger in Support of Summary Judgment of Unenforceability of the Patents in Suit Due to Inequitable Conduct

Feb 13, 2006

12.	12/20/04	Exhibit 70 to the Declaration of Michelle M. Umberger in Support of Summary Judgment of Unenforceability of the Patents in Suit Due to Inequitable Conduct
13.	12/20/04	Exhibit 71 to the Declaration of Michelle M. Umberger in Support of Summary Judgment of Unenforceability of the Patents in Suit Due to Inequitable Conduct
14.	02/28/05	MTI's Notice of Motion, Motion and Memorandum in Support of Motion for Summary Judgment of Unenforceability of the Patents in Suit Due to Inequitable Conduct
15.	02/28/05	The Regents of the University of California's Notice of Motion, Motion, and Memorandum in Support of Motion for Summary Judgment of No Inequitable Conduct; and Opposition to Defendants' Motion for Summary Judgment
16.	02/28/05	MTI's Opposition to Plaintiff's Motion for Summary Judgment of No Inequitable Conduct
17.	10/17/05	Exhibit 7 to the Supplemental Declaration of Michelle M. Umberger in Support of Summary Judgment of Unenforceability of the Patents-In-Suit Due to Inequitable Conduct
18.	10/17/05	Exhibit 9 to the Supplemental Declaration of Michelle M. Umberger in Support of Summary Judgment of Unenforceability of the Patents-In-Suit Due to Inequitable Conduct
19.	11/03/05	Exhibit 15 of the Declaration of Wendy Bjerknes in Support of Supplemental Brief in Support of Plaintiff's Motion for Summary Judgment of No Inequitable Conduct and in Opposition to Defendants' Motion for Summary Judgment; and in Support of Motion to Strike Inadmissable Evidence

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(For 3rd Party Requester)

MAILED

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REEXAM UNIT

In re Application of 6,010,498
Appl. No.: 90/007,232
Filed: October 04, 2004
For: Endovascular Electrolytically Detachable Guidewire Tip for the Electroformation of Thrombus in Arteries, Veins, Aneurysms, Vascular Malformations and Arteriovenous et al

DECISION ON PETITION UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b), filed May 13, 2005, to expunge information from the above identified application.

The petition is granted.

Petitioner requests that documents associated with the proceedings of The Regents of the University of California v. Micro Therapeutics, Inc. et al. (case No. C 03 05669 (JW)) and Boston Scientific Corp. v. Cordis Neurovascular (case No. C 02-1474 JW), listed hereinbelow and filed May 13, 2005, be expunged from the record. Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(h) has been paid.

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

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

The expunged material has been removed from the official file.

Lissi Mojica Marquis, Director
Central Reexamination Unit

Listing of Returned Documents

(A) The Regents of the University of California v. Micro Therapeutics, Inc. et al documents:

(1) MTI's Memorandum of Points and Authorities in Opposition to the Boston Scientific and Target's Motion for Summary Judgement;
(2) MTI's Memorandum of Points and Authorities in Opposition to the Regents' Motion for Summary Judgement;
(3) MTI's Notice of Motion, Motion and Memorandum in Support of Motion for Summary Judgement of Unforceability of the Patents in Suit Due to Inequitable Conduct;
(4) Exhibits 59-71 to the Declaration of Michelle M. Umberger in Support of Summary Judgement of Unforceability of the Patents in Suit Due to Inequitable Conduct;
(5) The Regents' Notice of Motion, Motion, and Memorandum of Points and Authorities in Support of Motion for Summary Judgement of No Inequitable Conduct; and Opposition to Defendants' Motion for Summary Judgement;
(6) Exhibits 9 and 10 to Declaration of Alice Chen in Support of The Regents' Motion for Summary Judgement of No Inequitable Conduct; and Opposition to Defendants' Motion for Summary Judgement;
(7) MTI's Opposition To Plaintiff's Motion for Summary Judgement of No Inequitable Conduct; and
(8) MTI's Reply in Support of Motion for Summary Judgement of Unenforceability of the Patents in Suit Due to Inequitable Conduct.

(B) Boston Scientific Corp. v. Cordis Neurovascular documents:

(1) Exhibit 1 to the Declaration of Lisa A. Schneider in Support of Defendant Cordis' Claim Construction Brief;
(2) Exhibit 4 to the Declaration of Stephanie P. Koh in Support of Cordis' Motion for Leave to Amend Final Invalidity Contentions;
(3) Defendant Cordis' Opposition to Plaintiffs' Motion for Summary Judgement of No inequitable Conduct;

(4) Defendant Cordis' Reply to Plaintiffs' Opposition to Motion for Summary Judgement of Invalidity of Radiopaque Marker Claims of U.S. Patent Numbers 5,895,385 and 5,010,498 and Opposition to Cross-Motion for Validity of the Radiopaque Marker Claims;
(5) Motion for Summary Judgement of Invalidity of Radiopaque Marker Claims of U.S. Patent Numbers 5,895,385 and 6,010,498;
(6) Exhibits A and B to the Supplemental Declaration of Amanda M. Kessel in Support of Plaintiffs' Opposition to Cordis' Motion for Summary Judgement of Invalidity of Radiopaque Marker Claims;
(7) Exhibits B and C to the Declaration of Dr. Charles Strothers in Support of Plaintiffs' Opposition to Cordis' Motion for Summary Judgement of Invalidity;
(8) Plaintiffs' Opposition to Cordis' Motion for Summary Judgement of Invalidity of Radiopaque Marker Claims of U.S. Patent Numbers 5,895,385 and 6,010,498 and Memorandum in Support of Cross-Motion for Validity of the Radiopaque Marker Claims;
(9) Errata and Corrected Defendant Cordis' Opposition to Plaintiffs' Motion for Summary Judgement of No Inequitable Conduct;
(10) Defendant Cordis' Reply to Plaintiffs' Opposition to Motion for Summary Judgement of Invalidity of Radiopaque Marker Claims of U.S. Patent Numbers 5,895,385 and 6,010,498 and Opposition to Cross-Motion for Validity of the Radiopaque Marker Claims;
(11) Revised First Amended Answer and Counterclaims;
(12) Reply in Further Support of Plaintiffs' Cross-Motion for Validity of the Radiopaque Marker Claims;
(13) Exhibit A to the Declaration of Dwight Green in Support of Plaintiff Boston Scientific's Reply in Further Support of its Cross-Motion for Validity of the Radiopaque Marker Claims of U.S. Patent Numbers 5,895,385 and 6,010,498;
(14) Exhibit 1 to Declaration of Stephanie P. Koh in Support of Defendant Cordis' Motion for Leave to Amend Final Invalidity Contentions;
(15) Exhibits B, G, and I to Second Supplemental Declaration of Amanda M. Kessel in Support of Plaintiffs' Summary Judgement Motions;
(16) Various Pages of Deposition Testimony;
(17) Exhibits D, K, L, R, S, T, U, and W to the Declaration of Amanda Kessel in Support of Plaintiffs' Summary Judgement Motions;
(18) Exhibits 4, 6, 8-12, 30, and 39-46 to Declaration of Stephanie P. Koh in Support of Motion for Summary Judgement;
(19) Exhibits 53, 56, 61-82, and 87-89 to Supplemental Declaration of Stephanie P. Koh in Support of Plaintiffs' Motions for Summary Judgement Regarding Validity and Inequitable Conduct;
(20) Notice of Motion and Motion for Summary Judgement of Invalidity of Radiopaque Marker Claims of U.S. Patent Numbers 5,895,385 and 6,010,498;
(21) Declaration of Dr. Randall T. Higashida in Support of Notice of Motion and Claims for Summary Judgement of Invalidity of Radiopaque Marker Claims of U.S. Patent Numbers 5,895,385 and 6,010,498; Declaration of John M. Collins; and Declaration of Stephanie P. Koh;
(22) Exhibits 3-7 and 9-16 to the Declaration of Stephanie P. Koh in Support of Notice of Motion and Motion for Summary Judgement of Invalidity of Radiopaque Marker Claims of U.S. Patent Numbers 5,895,385 and 6,010,498;

(23) Exhibits 17-23 to Declaration of Stephanie P. Koh in Support of Notice of Motion and Motion for Summary Judgement of Invalidity of Radiopaque Marker Claims of U.S. Patent Numbers 5,895,385 and 6,010,498; and
(24) Exhibits 24-33 to Declaration of Stephanie P. Koh in Support of Notice of Motion and Motion for Summary Judgement of Invalidity of Radiopaque Marker Claims of U.S. Patent Numbers 5,895,385 and 6,010,498.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

OCT 02 2008

CENTRAL REEXAMINATION UNIT

PAUL ADAMS
901 RIO GRANDE BLVD. NW
SUITE H262
ALBUQUERQUE, NM 87104

In re Application of	:	
William A. Hall	:	
Control No. 90/007,233 (U.S. Patent 6,422,413)	:	DECISION ON PETITION
Filed: November 20, 1994	:	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 September 19, 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 Paul Adams on behalf of all attorneys of record. All attorneys/agents have been withdrawn.

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

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

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

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

Denise L. Boyd for

Andres Kashnikow
Supervisory Patent Examiner
CRU 3993

cc: **William A. Hall**
2174 Lake Ysabel Road
Templeton, CA 93465

cc: **HOLLAND & KNIGHT, LLP** (Third Party Requester)
One East Broward Blvd.
Suite 1300
FT. Lauderdale, FL 33301

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on September 19, 2008. There is no indication it was served on 3rd Party Requester.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAR 19 2009

CENTRAL REEXAMINATION UNIT

William A. Hall
2174 Lake Ysabel Road
Templeton, CA 93465

In re Application of	:	
HALL, et al.	:	
Control No. 90/007,233 (US PAT 6,422,413)	:	DECISION ON REQUEST FOR
Filed: October 4, 2004	:	REVOCATION OF POWER
Attorney Docket No. 95255.2	:	OF ATTORNEY
	:	

This is a decision on the Request to Revoke the attorney or agent of record under 37 C.F.R. § 1.36(a), filed November 03, 2008 ("Appointment of Attorney").

The request is **NOT APPROVED**.

A power of attorney, pursuant to § 1.32(b), may be revoked at any stage in the proceeding of a case by an applicant for patent (§ 1.41(b)) or an assignee of the entire interest of the applicant under § 3.71(b). Fewer than all of the applicants (or by fewer than the assignee of the entire interest of the applicant) may only revoke the power of attorney upon a showing of sufficient cause, and payment of the petition fee set forth § 1.17(h). For the assignee to take action a proper statement under § 3.73(b) is required.

The request cannot be approved because no statement under 3.73(b) was filed.

All future communications from the Office will continue to be directed to the above-listed address until otherwise notified by applicant.

Telephone inquiries concerning this decision should be directed to Patricia Volpe at 571-272-6825.

Patricia Volpe for

Andres Kashnikow
Supervisory Patent Examiner
CRU 3993

cc: **William W. Haefliger**
201 S. Lake Avenue
Suite 512
Pasadena, CA 91108

cc: **Thomas L. Kautz** (for third party requester)
Holland & knight, LLP
One East Broward Blvd.
Suite 1300
St Lauderdale, FL 33301

Enclosure:

Copy of Appointment of Attorney filed on November 3, 2008. There is no indication it was served on the Third Party Requester.

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PATENT & TRADEMARK OFFICE

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Art Unit 3993	Examiner: Matthew c. Graham
Applicants:	William A. Hall et al
Serial No:	08/348,744
now U.S. Patent No:	6,422,413
Filed:	Nov. 30, 1994
now Issued:	July 23, 2002
For:	TANK VAULT

Pasadena, California

APPOINTMENT OF ATTORNEY

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

Sir:

The Hall Patent Group, LLC, assignee of the above patent, hereby appoints William W. Haefliger, Registration No.17,120, their attorney to prosecute all matters, including re-examination and appeal, concerning the above patent and to transact all business in the Patent and Trademark Office connected therewith. All previous powers are hereby revoked.

Dated 9/24/08

William A. Hall

Copied from 08348744 on 11/25/2008

OIPE
NOV. 0 3 2008
PATENT & TRADEMARK OFFICE

LAW OFFICES
WILLIAM W. HAEFLIGER
PATENT LAWYER

201 SOUTH LAKE AVENUE
SUITE 512
PASADENA, CALIFORNIA 91101

TELEPHONE
(323) 684-2707
(626) 449-0467
FAX (626) 449-0520
E-MAIL: whaefllg@pacbell.net

November 3, 2008

CERTIFICATE OF EXPRESS MAILING

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

Sir:

I, WILLIAM W. HAEFLIGER, hereby certify that the attached Appointment of Attorney, Reply Brief for Appellant & Certificate of Service and a self-addressed stamped postal acknowledgement card were deposited with the U.S. Patent and Trademark Office "Express Mail - Post Office to Addressee", mailing label number ED 983433182US in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on November 3, 2008.

Dated: November 3, 2008

By
William W. Haefliger
Attorney for Applicant
Registration No.17,120
Area Code 323 684-2707

Dkt.13,124

Copied from 08848744 on 11/25/2008

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.
90/007,236	10/06/2004	5640859	MAT 3K8R1	4305

7590 01/27/2005

Mathews Collins Shepherd & McKay PA
100 Thanet Circle Suite 306
Princeton, NJ 08540

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/27/2005

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

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P.O. Box 1450
Alexandria, VA 22313-1450
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CST

Hunton & Williams LLP 1900 K Street, NW, Suite 1200 Washington, DC 20006-1109	(for Patent Owner)
Mathews Collins Shepherd & McKay PA 100 Thanet Circle, Suite 306 Princeton, NJ 08540	(for Patent Owner)
Charles H. DeVoe, Esq. Kolisch Hartwell, PC 520 S.W. Yamhill Street, Suite 200 Portland, OR 97204	(for Third Party)
In re Fromm Reexamination Proceeding Control No. 90/006,546 Filed: February 12, 2003 For: U.S. Patent 5,640,859 In re Fromm Reexamination Proceeding Control No. 90/007,236 Filed: October 6, 2004 For: U.S. Patent 5,640,859	**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 5,640,859, issued June 24, 1997, is the subject of Reexamination Control Nos. 90/006,546 and 90/007,236. Reexamination Certificate 5,640,859 C1 issued on November 27, 2001.

2. A first request for reexamination, assigned Reexamination Control No. 90/006,546 ('6546), was filed February 12, 2003 by Charles H. DeVoe of Kolisch Hartwell, PC. The request urged that a substantial new question of patentability was raised by the teachings of (a) 1994 Mattel catalog showing "Tie & Dye™ Barbie® Fashions"; (b) 1993 Mattel packaging accompanying "Barbie® Tie & Dye™ Fashions"; (c) 1984 Surface Design for Fabric; (d) 1973 Contemporary Batik and Tie-Dye; (e) 1977 Arts and Crafts for the classroom; (f) The Gazette (Montreal); and (g) U.S. Patent 4,981,516 to Kluger.

3. Reexamination was ordered for '6546 on April 1, 2003.

4. A first Office action for '6546 was mailed on September 29, 2003.

5. Patent owner responded to the first Office action on December 1, 2003.

6. A final Office action for '6546 was mailed on May 26, 2004.

7. Patent owner responded to the final Office action on July 26, 2004.

8. An advisory action for '6546 was mailed on August 30, 2004.

9. Patent owner responded to the advisory action on October 26, 2004.

10. A Notice of Appeal for '6546 was filed on November 24, 2004.

11. An advisory action for '6546 was mailed on November 26, 2004.

12. A second request for reexamination, assigned Reexamination Control No. 90/007,236 ('7236), was filed October 6, 2004 by Charles H. DeVoe of Kolisch Hartwell, PC. The request urged that a substantial new question of patentability was raised by the teachings of (a) TYCO Dolls Color Me Kente Kenya, from a TYCO Toys catalog and price list (copyright 1994); (b) U.S. Trademark Registration No. 1922987 for the mark COLOR ME KENTE KENYA; (c) TYCO Activity Toys Fashion Pace from a TYCO Toys catalog (copyright 1990); (d) TYCO Tie Dye Deluxe Bear and TYCO Doodle Bear Feature, documents form 1994 and (e) other prior art previously cited by or to the Office.

13. Reexamination was ordered for '7236 on December 6, 2004.

14. Patent owner indicated that no patent owner statement was being submitted on December 22, 2004.

DISCUSSION

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

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

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

> After the patent owner and second requester have been given an opportunity to file a statement and reply, respectively, the second reexamination proceeding will be merged with the first reexamination proceeding, and prosecution will then continue at the most advanced point possible for the first proceeding. It should be noted that if a final rejection has been issued in the first proceeding, prosecution will be ordinarily be reopened where any of the new patents or printed publications presented in the second request are applied to the merged proceeding in a new ground of rejection.

DECISION

I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. 1.565(c), the 90/006,546 and 90/007,236 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

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

III. CONDUCT OF MERGED PROCEEDING

An Office action will be issued in due course which applies to Reexamination Nos. 90/006,546 and 90/007,236. All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for <u>all</u> files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, **filed in duplicate**, each bearing a

signature and identifying data for all files, for entry into each file. All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control Nos. 90/006,546 as:

Brian Buroker
Hunton & Williams LLP
1900 K Street, NW
Suite 1200
Washington, DC 20006-1109

Note also that all correspondence from the USPTO will be addressed to the patent owner's representative listed in Reexamination Control No. 90/007,236 as:

Mathews Collins Shepherd & McKay PA
100 Thanet Circle, Suite 306
Princeton, NJ 08540

*A new power of attorney and revocation of power of attorney has been submitted in Reexamination Control No. 90/006,546, but no such paper has been submitted in Reexamination Control No. 90/007,236.

CONCLUSION

Reexamination Control Nos. 90/006,546 and 90/007,236 are merged. The merged reexamination files are being forwarded to the examiner for preparation of an Office action, to be issued in due course.

JMStone

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,241	10/07/2004	5938309	P0302482	7701

21919 7590 05/11/2006
MEREK, BLACKMON & VOORHEES, LLC
673 S. WASHINGTON ST.
ALEXANDRIA, VA 22314

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/11/2006

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

cc'd: 3rd 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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In re Application of 5938309	:	
Appl. No.: 90/007,241	:	**DECISION ON PETITION**
Filed: October 07, 2004	:	**UNDER 37 CFR 1.59**
For: BIT-RATE TRANSPARENT WDM OPTICAL COMMUNICATION SYSTEM WITH REMODULATORS	:	

This is a decision on the petition under 37 CFR 1.59(b), filed December 23, 2005, to expunge information from the above identified application.

The petition is granted.

Petitioner requests that the Protective Order materials submitted in the Supplemental Information Disclosure Statement, filed December 23, 2005, be expunged from the record. Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(h) has been paid.

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

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

The expunged material has been removed from the official file.

Krista Zele
Technology Center 2600
Communications

Enclosure: Protective Order Materials listed on the Form PTO-1449 filed December 23, 2005

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)

Venable LLP
P.O. Box 34385
Washington, DC 20043-9998

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/007,241*.

PATENT NO. *5938309*.

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

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,244	10/04/2004	5803501	04592/8200767-000	8852

34313 7590 07/06/2005

ORRICK, HERRINGTON & SUTCLIFFE, LLP
IP PROSECUTION DEPARTMENT
4 PARK PLAZA
SUITE 1600
IRVINE, CA 92614-2558

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/06/2005

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
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Paper No. __

Orrick, Herrington & Sutcliffe, LLP (Patent Owner)
4 Park Plaza
Suite 1600
Irvine CA 92614-2558

MAILED
JUL 0 6 2005
REEXAM UNIT

Darby & Darby P.C. (Requester)
Michael J. Sweedler
P.O. Box 5257
New York NY 10150-5257

In re Adrian Gluck	:
Reexamination Proceeding	: DECISION
Control No. 90/007,244	: DISMISSING
Filed: October 4, 2004	: PETITION
For: U.S. Patent No. 5,803,501	:
	:

This is a decision on a February 14, 2005, as corrected on February 22, 2005, patent owner petition entitled "PETITION UNDER 37 C.F.R. 1.181" to vacate an order for reexamination dated December 13, 2004. The third party requestor filed a reply in opposition to the 37 CFR 1.181 petition on April 4, 2005.

The petition and opposition are before the Office of Patent Legal Administration for consideration.

The petition is dismissed for the reasons set forth below.

REVIEW OF FACTS

1) U.S. Patent number 5,803,501 (the '501 patent) issued September 8, 1998 with 7 claims. The claims are directed towards a memorabilia (trading) card that contains an image of a famous figure and a three dimensional piece of memorabilia adhered to the card, which memorabilia relates to the famous figure.

2) A request for reexamination, assigned control No. 90/007,244, was filed on October 4, 2004.

3) An order for reexamination was issued on December 13, 2004. A substantial new question of patentability was found for claims 1, 6, and 7 of the patent based on the prior art supplied in the reexamination request.[1]

4) The instant petition under 37 CFR 1.181, and a corrected petition, were filed on February 14, and February 22, 2005, respectively. All further references to the "petition" will refer to the corrected § 1.181 petition of February 22, 2005. The § 1.181 petition requests that the Office vacate the order for reexamination, arguing that the Office lacked jurisdiction to issue the order. Petitioner contends that the Office improperly relied upon prior art that were not printed publications, upon which the order for reexamination was based. Accordingly, petitioner argues that there was no substantial new question of patentability upon which to base the order for reexamination.

5) The third party requestor has supplied a Reply to the § 1.181 petition on April 4, 2005. The Reply opposes the owner's request to vacate the order for reexamination and argues that the prior art relied upon are in fact printed publications.

[1] While a substantial new question of patentability was not identified for patent claims 2-5, such claims will obviously be considered when the examiner determines whether to issue a rejection of any claims based on the prior art identified in the request for reexamination.

Discussion

Claim 1 in the '501 patent is illustrative:

1. A memorabilia card comprising a substrate in the form of a card and having an image surface,

the image surface including a background image and a foreground image, and wherein the foregoing image is of a famous figure,

a piece of a memorabilia item being adhered to the card adjacent to where an image of the actual item normally would appear, and

the card including a certificate attesting to the authenticity of the item.

In other words, a type of trading card is claimed that contains a picture of a famous person, and attached to the card, is an authentic (three dimensional) piece of an item that relates to or reminds one of the famous person. [2]

The order granting reexamination relied upon the following items of memorabilia cards as raising a substantial new question of patentability:

1. Marilyn Monroe Diamond Memorabilia Card,
2. Whittier Hotel Beatles Memorabilia Card,
3. James Dean Memorabilia Card,
4. Father Eckert Memorabilia Card, and
5 Space Memorabilia Cards.

Items 1. and 2. were stated to each "teach a card having an image of a famous person and a piece of memorabilia being adhered thereto ... along with a certification attesting to the authenticity of the item" and raise a substantial new question of patentability for claims 1, 6 and 7. Items 3.-5. as used in combination with items 1. and 2. were also deemed, in the order, to raise a substantial new question of patentability in regard to claims 1, 6, and 7.

An examination based on the prior art stated to raise a substantial new question of patentability has not yet taken place.

The § 1.181 petition notes that pursuant to 35 U.S.C. 301 and 302, reexamination may be based only on prior art consisting of patents or printed publications. Under the circumstances of the instant order for reexamination, the issue revolves around whether

[2] Claim 1, unlike claims 6 and 7, does not actually require that the piece of memorabilia be authentic, only that a statement to that effect appear on the card.

the applied prior art can be considered a printed publication. Petitioner alleges that none of the cards used as the basis for ordering reexamination can be considered a printed publication.

Petitioner supplies a definition of the statutory phrase "printed publication" as meaning "dissemination" and "public accessibility," based on three decisions by the CCPA and the Federal Circuit, including *In re Wyer*, 655 F.2d 221, 210 USPQ 790 (CCPA 1981). As to dissemination, petitioner looks to the 35 USC 301 and 302 recitations of "printed publication" to determine that "dissemination" cannot occur when there is only a single/unique copy. Sufficient copies must be made to ensure dissemination to the public. [3]

Petitioner, in explaining the requirement of "public accessibility," again refers to the statutory section 301 and 302. Petitioner starts the interpretation by referring to a first requirement that the prior art must be in "writing." A second requirement refers to the explicit language in the statutory sections that the prior art must be a printed publication. Reference is also made to MPEP 2216.

The cards with the memorabilia attached are characterized by petitioner as physical objects and not written prior art.

> The fact that these physical objects may have writing on them does not transform them from physical objects into a written prior art. 35 U.S.C. § 301. If the only requirement for such written prior art was that the physical objects had words on it, any machine, device or apparatus could be considered a 'printed publication' if it has words on it. [4]

Patent and printed publications are urged to contain similar qualities that enable them to be suitable for reexamination purposes, unlike the cards relied upon to order reexamination, namely that: (1) they have publication dates that are easily determined without significant evidentiary issues, and (2) both teach and describe the art.

The third party Reply opposing the § 1.181 petition looks to MPEP 2246, section I, which recites:

> [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.

The MPEP section continues on in regard to this matter:

> Where the examiner determines that a reference is a printed publication (i.e., that the criteria for publication has been satisfied), that determination is also not

[3] Petition at page 2.
[4] Petition at page 3.

> petitionable. These matters cannot be questioned with respect to vacating the order granting reexamination until a final agency decision on the reexamination proceeding has issued. Rather, these matters can by argued by the patent owner and appealed during the examination phase of the reexamination proceeding.

The third party does, however, recognize that MPEP 2246, section I also provides an *ultra vires* exception:

> A petition under 37 CFR 1.181 may, however, be filed to vacate an *ultra vires* reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant ... will be entertained. (emphasis in original).

The Reply by the third party goes on to argue that the prior art relied on in the order granting reexamination are in fact printed publications. The "key inquiry is whether or not a reference has been made 'publicly accessible," [5] for which *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004) is cited. Examples are provided of different types of items that can constitute a printed publication, such as photographs, [6] a drawing, [7] or a publicly displayed poster board. [8]

The Reply would change the focus of the "dissemination" requirement, which is treated by the petition as requiring distribution of copies to making widespread or to foster the general knowledge of as clarified by *Klopfenstein*. The public poster boards in Klopfenstein were only single unique copies typically owned by an individual, yet the Federal Circuit held they were printed publications.

DECISION DISMISSING THE § 1.181 PETITION TO VACATE THE REEXAMINATION PROCEEDING

The burden is on petitioner to establish an *ultra vires* act. Nothing in this Decision is intended to reach the ultimate conclusion as to whether the prior art relied upon to order reexamination are in fact printed publications. The gravamen of the instant petition is not whether it can be definitively established that the prior art relied on are printed publications, but only whether there is a colorable argument that the relied upon prior art are printed publications so that the ordered reexamination can move forward. Only where there is no basis to believe that the relied upon prior art are printed publications and therefore the cards would provide no basis for reexamination pursuant to the

[5] Reply to petition at page 4.
[6] Footnote 5 of the Reply.
[7] Footnote 6 of the Reply.
[8] Footnote 7 of the Reply, which is the Klopfenstein case,

statute, 35 U.S.C. 301 and 302,[9] could the § 1.181 petition be granted in view of an *ultra vires* act in ordering reexamination. Should the examiner continue to believe that the prior art cards are printed publications, and that such prior art was applicable to the patent claims, the patent owner would then be able to appeal the rejection of the patent claims on the basis that the applied prior art are not printed publications.[10]

Preliminarily, the order granting reexamination does not explicitly address the issue as to whether the cards relied upon to establish a substantial new question of patentability meet the definition of printed publications. The absence of explicitly raising such issue does not imply that the examiner did not address whether the prior art cards are printed publications, but may simply mean that the examiner deemed the requirement for a printed publication to be clearly met by the prior art cards, particularly in view of the attention paid to such issue in the request for reexamination. [11]

MPEP 2128 is drawn towards a discussion of printed publications as prior art. It states that:

> A reference is proven to be a 'printed publication' 'upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it.

MPEP section 2128 refers to *In re Wyer*, 655 F.2d 221;210 USPQ 790 (CCPA), which it quotes as follows:

> We agree that 'printed publication' should be approached as a unitary concept. The traditional dichotomy between 'printed' and 'publication' should be approached as a unitary concept. The traditional dichotomy between 'printed' and 'publication' is no longer valid. Given the state of technology in document duplication, data storage, and data retrieval systems, the 'probability of dissemination' of an item very often has little to do with whether or not it is 'printed' in the sense of that word when it was introduced into the patent statutes

[9] The relied upon prior art cards are not patents and therefore must be printed publications for reexamination to be ordered.

[10] While petitioner has not explicitly invoked the *ultra vires* petition exception to the normal appeal route for the application of prior art in a reexamination, it would appear that would be the only basis upon which petitioner could rely in seeking termination of the reexamination based on petitioner's theory that the prior art relied upon to order reexamination were not printed publications. See *Heinl v. Godici*, 143 F.Supp.2d 593, 601 (E.D. VA. 2001)(In a decision seeking termination of reexamination based on the absence of a new question of patentability 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."

[11] Petitioner attempts to insert a statutory requirement into 35 U.S.C. 301 and 302 that the printed publication must be "written." There is no such standard in the statutory provisions. 35 U.S.C. 302 does, however, provide that requests for reexamination be in writing.

in 1836. In any event, interpretation of the words 'printed' and 'publication' to mean 'probability of dissemination' and 'public accessibility' respectively, now seems to render their use in the phrase 'printed publication' somewhat redundant.

For the purposes of deciding whether there is some basis to believe that the prior art cards relied upon to order reexamination were either: disseminated, or made available and accessible, the request for reexamination has been reviewed to determine the history of these cards, which in some cases dates back many years. It is noted that:

- the Whittier Hotel Beatles Memorabilia Card has been listed in a 1988 price guide called the Beatles Memorabilia Price Guide [12], and
- the Marilyn Monroe Diamond Memorabilia Card has been listed in October 1993 magazine called "The Magazine For the Discriminating Collector of Non-Sport Cards."[13]

The dates of both the price guide and the magazine are prior to the December 15, 1994 filing date of the application leading to the patent under reexamination.

As to the James Dean Memorabilia Card, the request for reexamination refers to a declaration of Daniel S. Berlin that the Card was "exhibited and offered for sale at numerous card and industry trade shows...." [14]

The request for reexamination also presents affidavits as to how the Father Eckert Memorabilia Card [15] and the Space memorabilia Cards [16] were distributed. For example, it is stated that the Apollo XIV Safety-Line card was "originally given to hundreds, if not thousands of persons involved in the Apollo mission."

Petitioner addresses the support supplied in the request for examination for the publication of the cards by attacking an alleged failure to distinguish between the price guide, "which may be a printed publication," and the cards.

At a minimum, the price guide and magazine referring to the Whittier Hotel Beatles Memorabilia Card, and to the Marilyn Monroe Diamond Memorabilia Card, provide some evidence that the cards were available to the public and were accessible (albeit for a price). Similarly, some evidence has been presented that the other cards were disseminated to the public.

[12] Request for reexamination at page 4.
[13] Request for reexamination at page 7.
[14] Request for reexamination at page 11.
[15] Id at page 12.
[16] Id. at page 13.

Petitioner has not provided any reason to believe why the exhibits relating to establishing publication of each of the cards does not meet the minimum requirement to avoid a charge of an *ultra vires* act on behalf of the Office in ordering reexamination based on the cards as printed publications.

CONCLUSION

1. Petitioner has failed in its burden to establish that there is not a colorable argument (or scintilla of evidence) that the cards are printed publications and that therefore the Office has acted in brazen disregard of the statutory mandate to only order reexaminations based on (patents or) printed publications.

Accordingly, the § 1.181 petition is dismissed.

2. The instant reexamination proceeding, and jurisdiction thereover, is being transmitted to Technology Center 3700 to proceed with examination of the present reexamination proceeding.

3. Telephone inquiries related to this decision should be directed to Hiram H. Bernstein, Senior Legal Advisor, at (571) 272-7707, or, in his absence, to the undersigned at (571) 272-7710.

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

C:\kiva\kenpet5\7244_printed_pub_snq2.doc
July 6, 2005

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MAR - 6 2007

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Reexam Control No.: 90/007,244
Filed : October 4, 2004
For U.S. Patent No. : 5,803,501

Reexam Control No.: 90/008,074
Filed : July 28, 2006
For U.S. Patent No. : 5,803,501

DECISION MERGING REEXAMINATION PROCEEDINGS

The above noted reexamination proceedings are before the Director of the Central Reexamination Unit for consideration of merger as provided for in 37 CFR § 1.565(c).

Reexamination in application control No. 90/007,244 was ordered in a decision mailed December 13, 2004. Prosecution has proceeded to the filing of a Patent Owner's response to an Office action on March 30, 2006. There have been no amendments to the claims, specification, and drawings in this reexamination proceeding.

Reexamination in application control No. 90/008,074 was ordered in a decision mailed September 20, 2006. Patent Owner did not file a Patent Owner's statement under the provisions of 37 CFR § 1.530 (c) and (d). No Office action has been issued. There have been no amendments to the claims, specification and drawings in this reexamination proceeding.

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.

Requirement for Same Claims, Drawings, and Specification in Both Proceedings

The Patent Owner is required to maintain identical claims, specifications, and drawings in both files. In view of the fact that both proceedings are identical, no amendment is necessary at this time.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. All papers mailed by the Office will take the form of a single action, which applies to both proceedings. All papers issued by the Office or as filed by the Patent Owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the Patent Owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by Patent Owner must be served on each Third Party Requester and each requester will be sent copies of all papers mailed by the Office. Where a paper is filed which requires a fee (e.g., petition fee, excess claims fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid.

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 Office action in order to place the files in that condition.

Conclusion

Reexamination Control Nos. 90/007,244 and 90/008,074 are hereby merged. Upon mailing of this decision, both files will be forwarded to the examiner for issuance of an Office action on the merits.

Any inquiry concerning this decision should be directed to Andres Kashnikow, Special Programs Examiner, at telephone No. (571) 272-4361.

Andres Kashnikow

for Lissi Mojica Marquis, Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,245	10/04/2004	6142532	04592/8200767-000	9721

34313 7590 07/06/2005

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/06/2005

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

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Paper No. __

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REEXAM UNIT

Darby & Darby P.C.
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(Requester)

In re Adrian Gluck	:
Reexamination Proceeding	: DECISION
Control No. 90/007,245	: DISMISSING
Filed: October 4, 2004	: PETITION
For: U.S. Patent No. 6,142,532	:
	:

This is a decision on a February 18, 2005, as corrected on February 22, 2005, patent owner petition entitled "PETITION UNDER 37 C.F.R. 1.181" to vacate an order for reexamination dated December 13, 2004. The third party requestor filed a reply in opposition to the 37 CFR 1.181 petition on April 5, 2005.

The petition and opposition are before the Office of Patent Legal Administration for consideration.

The petition is dismissed for the reasons set forth below.

REVIEW OF FACTS

1) U.S. Patent number 6,142,532 (the '532 patent) issued November 7, 2000 with 15 claims. The claims are directed towards a portion of authentic memorabilia used by a sport or entertainment personality or during a memorable event with the portion attached to a member, e.g., a piece of a hockey puck attached to a sports trading card.
2) A request for reexamination, assigned control No. 90/007,245, was filed on October 4, 2004.[1]
3) An order for reexamination was issued on December 15, 2004. A substantial new question of patentability was found for claims 1-15 of the patent based on the prior art supplied in the reexamination request.
4) The instant petition under 37 CFR 1.181 was filed on February 18. The § 1.181 petition requests that the Office vacate the order for reexamination, arguing that the Office lacked jurisdiction to issue the order. Petitioner contends that the Office improperly relied upon prior art that were not printed publications, upon which the order for reexamination was based. Accordingly, petitioner argues that there was no substantial new question of patentability upon which to base the order for reexamination.
5) The third party requestor has supplied a Reply to the § 1.181 petition on April 5, 2005. The Reply opposes the owner's request to vacate the order for reexamination and argues that the prior art relied upon are in fact printed publications.

Discussion

Claim 1 in the '532 patent is illustrative:

> 1. An article of memorabilia comprising,
>
> a first member, and
>
> a portion, but not the entirety, of an authentic memorabilia item used by a popular sport or entertainment personality or during a memorable event, said portion attached to said first member.

In other words, a trading card is created with an attached three dimension portion of some article used by a sports or entertainment figure, or used in a memorable event.

---

[1] The transmittal form of the reexamination request, item 9 and page 1 of the following discussion recite that reexamination is requested for claims 1-15, however, page three of the discussion in addressing the existence of a substantial new question identifies only claims 1-4 and claims 6-15. Claim 5 of the instant patent is addressed at page 46.

The order granting reexamination relied upon the following items of memorabilia cards either alone, or taken together, as raising a substantial new question of patentability:

1. Marilyn Monroe Diamond Memorabilia Card,
2. Whittier Hotel and Riviera Hotel Beatles Memorabilia Cards,
3. James Dean Memorabilia Card,
4. Father Eckert Memorabilia Card, and
5 Space Memorabilia Cards.

The Marilyn Monroe Diamond Memorabilia Card, and the Whittier Hotel Memorabilia Card were stated in the order to each "teach a card having an image of a famous person and a piece of memorabilia item being adhered thereto ...."

An examination based on the prior art stated to raise a substantial new question of patentability has not yet taken place.

The § 1.181 petition notes that pursuant to 35 U.S.C. 301 and 302, reexamination may be based only on prior art consisting of patents or printed publications. Under the circumstances of the instant order for reexamination, the issue revolves around whether the applied prior art can be considered a printed publication. Petitioner alleges that none of the cards used as the basis for ordering reexamination can be considered a printed publication.

Petitioner supplies a definition of the statutory phrase "printed publication" as meaning "dissemination" and "public accessibility," based on three decisions by the CCPA and the Federal Circuit, including *In re Wyer*, 655 F.2d 221, 210 USPQ 790 (CCPA 1981). As to dissemination, petitioner looks to the 35 USC 301 and 302 recitations of "printed publication" to determine that "dissemination" cannot occur when there is only a single/unique copy. Sufficient copies must be made to ensure dissemination to the public.[2]

Petitioner in explaining the requirement of "public accessibility" again refers to the statutory section 301 and 302. Petitioner starts the interpretation by referring to a first requirement that the prior art must be in "writing." A second requirement refers to the explicit language in the statutory sections that the prior art must be a printed publication. Reference is also made to MPEP 2216.

The cards with the memorabilia attached are characterized by petitioner as physical objects and not written prior art.

> The fact that these physical objects may have writing on them does not transform them from physical objects into one of the two requisite written prior art categories. 35 U.S.C. § 301. If the only requirement for written prior art, such as a printed publication[s], was that the physical objects had words on them, then

[2] Petition at page 2.

> any machine, device, or apparatus could be considered written prior art - such as a printed publication - if it has words on it.[3]

Patent and printed publications are urged to contain similar qualities that enable them to be suitable for reexamination purposes, unlike the cards relied upon to order reexamination, namely that: (1) they have publication dates that are easily determined without significant evidentiary issues, and (2) both teach and describe the art.[4]

The third party Reply opposing the § 1.181 petition looks to MPEP 2246, section I,[5] which recites:

> [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.

The MPEP section continues on in regard to this matter:

> Where the examiner determines that a reference is a printed publication (i.e., that the criteria for publication has been satisfied), that determination is also not petitionable. These matters cannot be questioned with respect to vacating the order granting reexamination until a final agency decision on the reexamination proceeding has issued. Rather, these matters can by argued by the patent owner and appealed during the examination phase of the reexamination proceeding.

The third party does, however, recognize that MPEP 2246, section I also provides an *ultra vires* exception:[6]

> A petition under 37 CFR 1.181 may, however, be filed to vacate an *ultra vires* reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where <u>no discretion</u> to grant a request for reexamination exists, a petition to vacate the decision to grant ... will be entertained. (emphasis in original).

The Reply by the third party goes on to argue that the prior art relied on in the order granting reexamination are in fact printed publications. The "key inquiry is whether or not a reference has been made 'publicly accessible,"[7] for which *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004) is cited. Examples are provided of different types of items that can constitute a printed publication, such as photographs,[8] a drawing,[9] or a publicly displayed poster board.[10]

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[3] Petition at page 3.
[4] Petition at page 4.
[5] Reply to petition at page 3.
[6] Id.
[7] Reply to petition at page 4.
[8] Footnote 5 of the Reply.

The Reply would change the focus of the "dissemination" requirement, which is treated by the petition as requiring distribution of copies to making widespread or to foster the general knowledge of as clarified by *Klopfenstein*. The public poster boards in Klopfenstein were only single unique copies typically owned by an individual yet the Federal Circuit held they were printed publications.

DECISION DISMISSING THE § 1.181 PETITION TO VACATE THE REEXAMINATION PROCEEDING

The burden is on petitioner to establish an *ultra vires* act. Nothing in this Decision is intended to reach the ultimate conclusion as to whether the prior art relied upon to order reexamination are in fact printed publications. The gravamen of the instant petition is not whether it can be definitively established that the prior art relied on are printed publications, but only whether there is a colorable argument that the relied upon prior art are printed publications so that the ordered reexamination can move forward. Only where there is no basis to believe that the relied upon prior art are printed publications and therefore the cards would provide no basis for reexamination pursuant to the statute, 35 U.S.C. 301 and 302,[11] could the § 1.181 petition be granted in view of an *ultra vires* act in ordering reexamination. Should the examiner continue to believe that the prior art cards are printed publications, and that such prior art was applicable to the patent claims, the patent owner would then be able to appeal the rejection of the patent claims on the basis that the applied prior art are not printed publications.[12]

Preliminarily, the order granting reexamination does not explicitly address the issue as to whether the cards relied upon to establish a substantial new question of patentability meet the definition of printed publications. The absence of explicitly raising such issue does not imply that the examiner did not address whether the prior art cards are printed publications, but may simply mean that the examiner deemed the requirement for a

[9] Footnote 6 of the Reply.
[10] Footnote 7 of the Reply, which is the Klopfenstein case,
[11] The relied upon prior art cards are not patents and therefore must be printed publications for reexamination to be ordered.
[12] While petitioner has not explicitly invoked the *ultra vires* petition exception to the normal appeal route for the application of prior art in a reexamination, it would appear that would be the only basis upon which petitioner could rely in seeking termination of the reexamination based on petitioner's theory that the prior art relied upon to order reexamination were not printed publications. See *Heinl v. Godici*, 143 F.Supp.2d 593, 601 (E.D. VA. 2001)(In a decision seeking termination of reexamination based on the absence of a new question of patentability 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."

printed publication to be clearly met by the prior art cards, particularly in view of the attention paid to such issue in the request for reexamination.[13]

MPEP 2128 is drawn towards a discussion of printed publications as prior art. It states that:

> A reference is proven to be a 'printed publication' 'upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it.

MPEP section 2128 refers to *In re Wyer*, 655 F.2d 221,210 USPQ 790 (CCPA), which it quotes as follows:

> We agree that 'printed publication' should be approached as a unitary concept. The traditional dichotomy between 'printed' and 'publication' should be approached as a unitary concept. The traditional dichotomy between 'printed' and 'publication' is no longer valid. Given the state of technology in document duplication, data storage, and data retrieval systems, the 'probability of dissemination' of an item very often has little to do with whether or not it is 'printed' in the sense of that word when it was introduced into the patent statutes in 1836. In any event, interpretation of the words 'printed' and 'publication' to mean 'probability of dissemination' and 'public accessibility' respectively, now seems to render their use in the phrase 'printed publication' somewhat redundant.

For the purposes of deciding whether there is some basis to believe that the prior art cards relied upon to order reexamination were either: disseminated, or made available and accessible, the request for reexamination has been reviewed to determine the history of these cards, which in some cases dates back many years. It is noted that:

- the Whittier Hotel Beatles Memorabilia Cards have been listed in a 1988 price guide called the Beatles Memorabilia Price Guide[14], and
- the Marilyn Monroe Diamond Memorabilia Card has been listed in October 1993 magazine called "The Magazine For the Discriminating Collector of Non-Sport Cards."[15]

The dates of both the price guide and the magazine are prior to the September 8, 1998 filing date of the application leading to the patent under reexamination.

---

[13] Petitioner attempts to insert a statutory requirement into 35 U.S.C. 301 and 302 that the printed publication must be "written." There is no such standard in the statutory provisions. 35 U.S.C. 302 does, however, provide that requests for reexamination be in writing.
[14] Request for reexamination at page 4.
[15] Request for reexamination at page 7.

As to the James Dean Memorabilia Card, the request for reexamination refers to a declaration of Daniel S. Berlin that the Card was "exhibited and offered for sale at numerous card and industry trade shows..."[16] prior to the filing date of the application leading to the patent under examination

The request for reexamination also presents affidavits as to how the Father Eckert Memorabilia Card [17] and the Space memorabilia Cards[18] were distributed. For example, it is stated that the Apollo XIV Safety-Line card was "originally given to hundreds, if not thousands of persons involved in the Apollo mission."

Petitioner addresses the support supplied in the request for examination for the publication of the cards by attacking an alleged failure to distinguish between the price guide, "which may be a printed publication," and the cards.

At a minimum, the price guide and magazine referring to the Whittier Hotel Beatles Memorabilia Card, and to the Marilyn Monroe Diamond Memorabilia Card, provide some evidence that the cards were available to the public and were accessible (albeit for a price). Similarly, some evidence has been presented that the other cards were disseminated to the public.

Petitioner has not provided any reason to believe why the exhibits relating to establishing publication of each of the cards does not meet the minimum requirement to avoid a charge of an *ultra vires* act on behalf of the Office in ordering reexamination based on the cards as printed publications.

CONCLUSION

1. Petitioner has failed in its burden to establish that there is not a colorable argument (or scintilla of evidence) that the cards are printed publications and that therefore the Office has acted in brazen disregard of the statutory mandate to only order reexaminations based on (patents or) printed publications.

Accordingly, the § 1.181 petition is dismissed.

2. The instant reexamination proceeding, and jurisdiction thereover, is being transmitted to Technology Center 3700 to proceed with examination of the present reexamination proceeding.

[16] Request for reexamination at page 11.
[17] Id at page 12.
[18] Id. at page 13.

3. Telephone inquiries related to this decision should be directed to Hiram H. Bernstein, Senior Legal Advisor, at (571) 272-7707, or, in his absence, to the undersigned at (571) 272-7710.

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

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July 6, 2005

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Reexam Control No.: 90/007,245
Filed : October 4, 2004
For U.S. Patent No. : 6,142,532

Reexam Control No.: 90/008,075
Filed : June 29, 2006
For U.S. Patent No. : 6,142,532

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination proceedings are before the Director of the Central Reexamination Unit for consideration of merger as provided for in 37 CFR § 1.565(c).

Reexamination in application control No. 90/007,245 was ordered in a decision mailed December 15, 2004. Prosecution has proceeded to the filing of a Patent Owner's response to an Office action on March 30, 2006. There have been no amendments to the claims, specification, and drawings in this reexamination proceeding.

Reexamination in application control No. 90/008,075 was ordered in a decision mailed August 9, 2006. Patent Owner did not file a Patent Owner's statement under the provisions of 37 CFR §

1.530 (c) and (d). No Office action has been issued. There have been no amendments to the claims, specification and drawings in this reexamination proceeding.

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.

Requirement for Same Claims, Drawings, and Specification in Both Proceedings

The Patent Owner is required to maintain identical claims, specifications, and drawings in both files. In view of the fact that both proceedings are identical, no amendment is necessary at this time.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. All papers mailed by the Office will take the form of a single action, which applies to both proceedings. All papers issued by the Office or as filed by the Patent Owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the Patent Owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by Patent Owner must be served on each Third Party Requester and each requester will be sent copies of all papers mailed by the Office. Where a paper is filed which requires a fee (e.g., petition fee, excess claims fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid.

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 Office action in order to place the files in that condition.

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 Director. Accordingly, the Patent Owner is hereby required to notify the Office who his single representative will be by filing the necessary papers in the appropriate file(s). The notification must be submitted within one month of the mailing date of this decision.

Conclusion

Reexamination Control Nos. 90/007,245 and 90/008,075 are hereby merged. **As stated above, Patent Owner has one month from the mailing date of this decision within which to name but a single representative**. Upon receipt of the response, an Office action will issue in due course.

Any inquiry concerning this decision should be directed to Andres Kashnikow, Special Programs Examiner, at telephone No. (571) 272-4361.

for Andres Kashnikow

Lissi Mojica Marquis, Director
Central Reexamination Unit

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REEXAM UNIT

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(For Requester)

In re Michel W. Graham et al.
Reexamination Proceeding : DECISION ON PETITON
Control No. 90/007,247 : FOR EXTENSION OF TIME
Filed: October 11, 2005 : (37 CFR 1.550.(c))
For: U.S. Patent No. 6,573,099 :

The above noted *ex parte* reexamination proceeding is before the Director of Central Reexam Unit for consideration of Patent Owner's petition for an extension of time in which to file a reply to the Office Action dated August 31, 2005. The petition was timely filed on October 11, 2005, which was a Tuesday. The $200.00 petition fee under 37 CFR 1.17(g) was charged to owner's deposit account. See 37 CFR 1.1.550(c), effective November 22, 2004.

The petition is granted.

Owner requests an extension of time of one month. Owner sets forth a factual accounting that is deemed to establish reasonably diligent behavior by all those responsible for preparing a response within the statutory period. When balanced against the requirement of 35 U.S.C. § 305 that this proceeding be handled with special dispatch, owner's showing is adequate to justify the grant of a one month extension of time in which to file a response to the outstanding Office action.

Accordingly, the period of time for filing a reply to the Office action dated August 31, 2005 is extended to run three months from the date of the Office action, that is, through November 30, 2005. With respect to future extensions of time to reply to the outstanding Office action, Owner should expect that such requests would not be granted absent strong and compelling reasons that establish the existence of an extraordinary situation necessitating the additional extension of time.

PETITION GRANTED.

Jean F Vollano for
James Dwyer, Director
Central Reexam Unit

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875 15th Street, NW, Suite 800
Washington, DC 20005-2221

(For Requestor)

MAILED

OCT 26 2006

CENTRAL REEXAMINATION UNIT

In re Graham
Reexamination Proceeding
Control No.: 90/007,247
Filed: October 4, 2004
For: U.S. Patent 6,573,099

In re Graham
Reexamination Proceeding
Control No.: 90/008,096
Filed: May 18, 2006
For: U.S. Patent 6,573,099

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination files are before the Director of the Central Reexamination Unit for consideration of the proceedings under 37 C.F.R. 1.565(c).

BACKGROUND

1. United States Patent 6,573,099, issued June 3, 2003, is the subject of Reexamination Control Nos. 90/007,247 and 90/008,096.

2. A first request for reexamination, assigned Reexamination Control No. 90/007,247, was filed October 4, 2004 by Erich Veitenheimer for Nucleonics, Inc.. The request urged that a substantial new question of patentability was raised by the teachings of USPN 5,272,065 to Inouye et al, USPN 4,768,072 to Jendrisak, and the Cohli et al article.

3. Reexamination was ordered for 90/007,247 on December 7, 2004.

4. A first Office action for 90/007,247 was mailed August 3, 2005.

5. A second non-final Office action was mailed on April 13, 2006

6. A second request for re-examination, assigned Reexamination Control No. 90/008,096, was filed May 18, 2006 by Erich Veitenheimer for Nucleonics, Inc. The request urged that a substantial new question of patentability was

raised by the teachings of at least USPN 5,578,716 to Szyf et al, USPN 5,631,148 to Urdea and WO 97/11170 to Zamecnik.

7. Reexamination was ordered for 90/008,096 on July 20, 2006.

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 para 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. 1.5659 (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 question raised.

DECISION

I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. 1.565(c), the 90/007,247 and 90/008,096 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. **Accordingly, patent owner is hereby 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. See MPEP 2283, "Merger of Reexaminations."

III. CONDUCT OF MERGED 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 of filed by the patent owner will contain the identifying data for <u>all</u> files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, **filed in duplicate**, each bearing a signature and identifying data for **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. 90/007,247 and 90/0078,096 as:

Scott Chambers
Patton Boggs LLP
8484 westpark Drive, 9th Floor
McLen, VA 22102

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control Nos. 90/007,247 and 90/0078,096 as:

Erich E. Veitenheimer
Cooley Godward LLP
The Bowen Building
875 15th Street, NW, Suite 800
Washington, DC 20005-2221

CONCLUSION

Reexamination Control Nos. 90/007,247 and 90/008,096 are merged. **As stated above, patent owner has one month from the mailing date of this decision within which to submit a "housekeeping" amendment placing the same claims in both files.** Upon receipt of the response, as Office action will be issued in due course.

Any inquiry concerning this decision should be directed to Deborah Jones, Special Programs Examiner, at telephone No. (571) 272-1535.

for Lissi M. Marquis, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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.
90/007,247	10/04/2004	6573099	023004.0103X1US	6310

32042 7590 10/21/2008

PATTON BOGGS LLP
8484 WESTPARK DRIVE
SUITE 900
MCLEAN, VA 22102

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/21/2008

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Erich E. Veitenheimer
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777 6th STREET, NW, Suite 1100
WASHINGTON, D.C. 20001

MAILED

OCT 21 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/007,247. (merged 901008, 096)

PATENT NO. 6573099.

ART UNIT 3991.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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ALEXANDRIA, VA 22313-1450
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(For Patent Owner)

MAILED

OCT 21 2008

CENTRAL REEXAMINATION UNIT

Erich E. Veitenheimer
COOLEY GODWARD KRONISH LLP
777 6TH Street, NW, Suite 1100
Washington, DC 20001

(For *Ex Parte* Requester)

In re Graham et al.	:	
Merged *Ex Parte* Reexamination Proceedings	:	**DECISION**
Control Nos. 90/007,247 & 90/008,096	:	**GRANTING**
Filed: Oct. 4, 2004 & May 18, 2006	:	**PETITION**
For: U.S. Patent No. 6,573,099	:	

This is a decision on the August 14, 2008 patent owner Petition Under 37 C.F.R. § 1.182 To Withdraw Terminal Disclaimers Submitted in Reexamination.

The petition fee of $400.00 pursuant to 37 C.F.R. § 1.17(f) for the patent owner's petition under 37 C.F.R. § 1.182 was charged to patent owner's credit card, as authorized by the patent owner on page 3 of the patent owner's petition.

The merged proceeding and the patent owner petition are before the Office of Patent Legal Administration.

The petition is granted.

REVIEW OF FACTS

1. U.S. Patent 6,573,099 (the'099 patent) issued June 3, 2003, from application 09/100,812 (the '812 application) listing Michael Wayne Graham as the inventor. After issuance, the inventorship was corrected to add Robert Norman Rice.

2. The chain of title for the '099 patent is as follows, based on the assignment records of the U.S. Patent & Trademark Office. It appears that the '099 patent is presently jointly owned by **Benitec Limited and CSIRO**, as evident from the following chain.

a. Inventor Graham assigned the ownership rights of the '812 application and any ensuing patents to AG-Gene Australia Ltd (AG-Gene) and State of Queensland through its Department of Primary Industries (Primary) on 7/17/1998;
b. AG-Gene changed its name to Benitec Australia Ltd. (Benitec Au) on 5/2/2000;
c. Inventor Graham and inventor Rice assigned the ownership rights of the '099 patent to Benitec Au and Primary on 6/30/2003 and 6/17/2003, respectively;
d. Primary assigned its ownership rights to Commonwealth Scientific and Industrial Research Organization (CSIRO) on 12/8/2003; and,
e. Benitec Au changed its name to Benitec Limited on 6/22/2006 (the recorded document appears to be a press release and pages excerpted from a financial statement, rather than a change of name document).

3. On Oct. 4, 2004, an *ex parte* request for reexamination was filed by a third party requester, Nucleonics, Inc., and was assigned control no. 90/007,247 (the '7247 proceeding).

4. The request for reexamination in the '7247 proceeding was granted on Dec. 7, 2004.

5. During the course of the '7247 proceeding in a non-final Office action mailed Aug. 31, 2005, nonstatutory double patenting rejections were made against various claims in the '099 patent based on various claims of continuing application nos.: 10/346,853; 10/646,070; 10/759,841; 10/821,726; and, 11/180,928 (the reference applications).

6. The chain of title for the reference applications, as recorded in the U.S. Patent & Trademark Office records to date, is as follows:[1]

   a. 10/346,853:
      i. Inventors Graham and Rice assigned their ownership rights to Benitec Au and Primary on 4/29/2003;
      ii. Primary assigned its ownership rights to CSIRO on 12/18/2003; and,
      iii. Benitec Au assigned its ownership rights to CSIRO on 8/21/2006.

   b. 10/646,070:
      i. No assignment from the inventors has been recorded.
      ii. Primary assigned ownership rights to Benitec Au on 12/8/2003; and,
      iii. Benitec Au assigned ownership rights to CSIRO on 8/21/2006.

[1] It is noted that the original assignment recorded in the '812 application for the '099 patent indicated that the ownership of any continuations ensuing from the parent '812 application was also transferred from the inventors to the assignees and their assigns. However, the assignments recorded in the continuing reference applications in some instances are not consistent with the parent and conflict with the original assignment.

c. 10/759,841:
   i. No assignment from the inventors has been recorded.
   ii. Primary assigned ownership rights to CSIRO on 12/8/2003; and,
   iii. Benitec Au assigned ownership rights to CSIRO on 8/21/2006.

d. 10/821,726:
   i. Inventors Graham and Rice assigned their ownership rights to Benitec Au and Primary on 6/30/2007 and 6/17/2003, respectively;
   ii. Primary assigned its ownership rights to CSIRO on 12/8/2003;
   iii. Benitec Au assigned its ownership rights to CSIRO on 8/21/2006; and,
   iv. Peter Michael Waterhouse and Ming-Bo Wang assigned ownership rights in this application to CSIRO on 9/14/2007.

e. 11/180,928:
   i. No assignment from the inventors has been recorded.
   ii. Benitec Au assigned ownership rights to CSIRO on 8/21/2006; and,
   iii. Peter Michael Waterhouse and Ming-Bo Wang assigned ownership rights in this application to CSIRO on 9/14/2007.

7. Nonstatutory double patenting rejections have been entered in the reference applications, but to date no terminal disclaimers have been filed in the applications. Instead, applicant requested that the rejections be held in abeyance until allowable subject matter is indicated.[2]

8. Two terminal disclaimers were filed Nov. 28, 2005 in the '7247 proceeding on behalf of CSIRO and Benitec Au to overcome the double patenting rejections based on the five reference applications noted in item 5 above.

9. In an Office action mailed on April 13, 2006, in the '7247 proceeding, <u>the nonstatutory double patenting rejections were withdrawn in response to the filing of the terminal disclaimers</u>.

10. On May 18, 2006, another *ex parte* request for reexamination of the '099 patent was filed by Nucleonics and was assigned control no. 90/008,096 (the '8096 proceeding).

11. The request for reexamination in the '8096 proceeding was granted on July 20, 2006.

12. The '7247 and the '8096 proceedings were merged by the Office on Oct. 26, 2006, to result in the present merged proceeding.

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[2] It is noted that it is improper to request that any rejection be held in abeyance. The only proper response to a nonstatutory double patenting rejection is to rebut the rejection by showing that the rejected claims are patentably distinct from the reference claims or to file a terminal disclaimer.

13. The subject petition filed August 14, 2008, requests that the terminal disclaimers filed in the merged '7247 and '8096 proceeding be withdrawn.

DECISION

I. RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURES

37 C.F.R. § 1.321(a)-(c) read as follows:

§ 1.321 Statutory disclaimers, including terminal disclaimers.

(a) A patentee owning the whole or any sectional interest in a patent may disclaim any complete claim or claims in a patent. In like manner any patentee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted. Such disclaimer is binding upon the grantee and its successors or assigns. A notice of the disclaimer is published in the *Official Gazette* and attached to the printed copies of the specification. The disclaimer, to be recorded in the Patent and Trademark Office, must:

(1) Be signed by the patentee, or an attorney or agent of record;

(2) Identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term will be refused recordation;

(3) State the present extent of patentee's ownership interest in the patent; and

(4) Be accompanied by the fee set forth in § 1.20(d).

(b) An applicant or assignee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of a patent to be granted. Such terminal disclaimer is binding upon the grantee and its successors or assigns. The terminal disclaimer, to be recorded in the Patent and Trademark Office, must:

(1) Be signed:

(i) By the applicant, or

(ii) If there is an assignee of record of an undivided part interest, by the applicant and such assignee, or

(iii) If there is an assignee of record of the entire interest, by such assignee, or

(iv) By an attorney or agent of record;

(2) Specify the portion of the term of the patent being disclaimed;

(3) State the present extent of applicant's or assignee's ownership interest in the patent to be granted; and

(4) Be accompanied by the fee set forth in § 1.20(d).

(c) A terminal disclaimer, when filed to obviate judicially created double patenting in a patent application or in a reexamination proceeding except as provided for in paragraph (d) of this section, must:

(1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;

(2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding; and

(3) Include a provision that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the judicially created double patenting.

The Manual of Patent Examining Procedure section 301, subsection V. states:

An assignment can be made of record in the United States Patent and Trademark Office (Office) in two different ways, for two different purposes. The differences are important to note:

(A) An assignment can be made of record in the assignment records of the Office. Recordation of the assignment provides legal notice to the public of the assignment. It should be noted that recording of the assignment is merely a ministerial act; it is not an Office determination of the validity of the assignment document nor the effect of the assignment document on the ownership of the patent property. See **37 CFR 3.54** and MPEP § **317.03**; and

(B) An assignment can be made of record in the file of a patent application, patent, or other patent proceeding (e.g., reexamination proceeding). This step is necessary to permit the assignee to "take action" in the application, patent, or other patent proceeding under the conditions set forth in **37 CFR 3.73** and MPEP § **324**. Recordation of an assignment in the assignment records of the Office does **not**, by itself, permit the assignee to take action in the application, patent, or other patent proceeding. For a patent to issue to an assignee, the assignment must have been recorded or filed for recordation in accordance with **37 CFR 3.11**. See **37 CFR 3.81(a)**.

The Manual of Patent Examining Procedure section 306 states:

In the case of a division or continuation application, a prior assignment recorded against the original application is applied (effective) to the division or continuation application because the assignment recorded against the original application gives the assignee rights to the subject matter common to both applications. Although the assignment recorded against an original application is applied to the division or continuation application, the Office's assignment records will only reflect an assignment of a division or continuation application (or any other application) if a request for recordation in compliance with 37 CFR **3.28**, accompanied by the required fee (37 CFR **3.41**), is filed.

In the case of a substitute or continuation-in-part application, a prior assignment of the original application is not applied (effective) to the substitute or continuation-in-part application because the assignment recorded against the original application gives the assignee rights to only the subject matter common to both applications. Substitute or continuation-in-part applications require the recordation of a new assignment if they are to be issued to an assignee. See 37 CFR **3.81**.

The Manual of Patent Examining Procedure section 2258, section I., subsection D.2. states:

Double patenting may exist where the patent being reexamined and a patent or application contain conflicting claims and:

(A) are filed by the same inventive entity;

(B) are filed by different inventive entities having a common inventor; and/or

(C) are filed by a common assignee (common ownership); and/or

(D) result from activities undertaken within the scope of a joint research agreement as defined in 35 U.S.C. **103**(c)(3).

> A double patenting rejection based on common ownership may be applied if the earlier invention would qualify as prior art for purposes of obviousness under 35 U.S.C. **103**(a) only under 35 U.S.C. **102**(g), or under 35 U.S.C. **102**(e) in a reexamination proceeding in which the patent under reexamination was granted on or after December 10, 2004; or in a reexamination proceeding in which the application which issued as a patent undergoing reexamination was filed on or after November 29, 1999.
>
> As is the case for an application, a judicially created double patenting rejection (made in a reexamination) can be overcome by the filing of a terminal disclaimer in accordance with **37 CFR 1.321(c)**. Where a terminal disclaimer is submitted in a reexamination proceeding, form paragraph **14.23.01** should be used if the terminal disclaimer is proper. If the terminal disclaimer is not proper, form paragraph **14.25** should be used, and one or more of the appropriate form paragraphs **14.26** to **14.32** must follow form paragraph **14.25** to indicate why the terminal disclaimer is not accepted. See also **MPEP § 1490**.

II. DISCUSSION

Patent owner states in the petition that an inadvertent error was committed by the filing of the Nov. 28, 2005 terminal disclaimer (note the statement of facts, item 8 above) on behalf of CSIRO. The reasons provided for showing the error are that (1) an incorrect form that is intended for applications rather than patents was used, and (2) one of the copending reference applications, application no. 10/646,070, was not commonly owned at the time of filing the terminal disclaimer.

As detailed in the above statement of facts, items 2 and 6, the chain of ownership and the present ownership of the reference applications is unclear. At the time of filing the terminal disclaimers, the ownership of not simply one application, but at least three reference application nos. 10/646,070, 10/759,841 and 11/180,928, appears to be inadequately established in the Office assignment records as being the same as the '099 patent. No other evidence of ownership has been proffered, thus the Office is relying on the recordation of the assignment documents. See MPEP §§ 301(V) and 306. The terminal disclaimers of record include a provision that any patent granted on '099 patent shall be enforceable only for and during such period that said patent is commonly owned with the reference applications. Based on the conflicting assignment records, and apparent lack of common ownership, retention of the terminal disclaimers would result in the '099 patent being rendered unenforceable. <u>In addition</u>, given that the present proceeding is still pending, the public has not yet been placed in a position of entitlement to rely upon the public record, including the reexamination prosecution history, of the '099 patent in determining the scope of the patent's claims. Accordingly, the petition is being granted, and the terminal disclaimers filed Nov. 28, 2005 in the '7247 proceeding, are hereby withdrawn. Upon return of jurisdiction over the present proceeding to the Central Reexamination Unit (CRU), the CRU will take the appropriate action to cancel the terminal disclaimers. The examiner in charge of the merged '7247 and '8096 proceeding will review the proceeding, taking into account the withdrawal of the terminal disclaimers, with respect to any rejection that might be appropriate in view of the withdrawal of the terminal disclaimers.

Additional discussion:

It is noted that TWO years passed from the point where the ownership of the reference applications changed after the filing of the terminal disclaimers to point of the present request of patent owner for withdrawal of the terminal disclaimers. In these two years, the reexamination proceeding and the reference applications were actively prosecuted without the examiners being made aware of the ownership change. There is no explanation of record as to why the Office was not notified immediately upon the change in ownership. Withdrawal of the terminal disclaimers would have materially changed the status of the nonstatutory double patenting rejections that were withdrawn based solely on the filing of the terminal disclaimers. If the reexamination proceedings had concluded or any of the applications had issued as patents during this time, any confirmed claims and issued patents would have been rendered unenforceable, because the agreement of common ownership was violated by the patent owners.

Patent owner is called upon to clarify the ownership of the '099 patent and each of the reference applications. Clarification would include documentary evidence and appropriate requests for recordation of any missing assignment documents.

As pointed out above, the reexamination examiner will evaluate and reinstitute all applicable nonstatutory double patenting rejections in the reexamination proceeding. The reinstatement of any nonstatutory double patenting rejections based on this information will not prevent the next Office action from being made final, if otherwise appropriate, as patent owner's actions precipitated such rejections.

CONCLUSION

1. The patent owner Petition under 37 C.F.R. § 1.182 is granted.

2. The terminal disclaimers filed Nov. 28, 2005 in the '7247 proceeding, are hereby withdrawn.

3. Jurisdiction over this proceeding is returned to the Central Reexamination Unit. The CRU will take the appropriate action to cancel the terminal disclaimer. The examiner in charge of the proceeding will review the proceeding taking into account the withdrawal of the terminal disclaimer, with respect to any rejection that might be appropriate in view of the withdrawal of the terminal disclaimer.

4. The patent owner is respectfully reminded of its continuing duty to keep the Office apprised as to the status of any concurrent proceedings pursuant to 37 C.F.R. § 1.985.

5. Any future correspondence with respect to this *ex parte* reexamination proceeding should be directed:

   By EFS: Registered users may submit via the electronic filing system

By Mail to: Attn: Mail Stop "*Inter Partes* 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 to: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

6. Any questions concerning this decision should be directed to Caroline D. Dennison, Legal Advisor, at 571-272-7729.

Kenneth M. Schor

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

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October 20, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

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APR 25 2009

CENTRAL REEXAMINATION UNIT

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For Patent Owner

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For Requester

Ex Parte Reexamination Proceeding
Control No. 90/008,096
Filed: May 18, 2006
Merged with:
Control No. 90/007,247
Filed: October 4, 2004
For: US Patent No. 6,573,099

DECISION ON
PETITION UNDER
37 CFR 1.181

This is a decision on the petition filed April 7, 2009 to request entry of Patent Owner's February 26, 2009 amendment and accompanying Declaration of Dr. Riggs.

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

The petition is **granted** for the reasons set forth below.

Analysis and Findings

37 CFR 1.116 states in pertinent 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 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.

(c) The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or reexamination proceeding from its condition as subject to appeal or to save the application from abandonment under § 1.135, or the reexamination prosecution from termination under § 1.550(d) or § 1.957(b)or limitation of further prosecution under § 1.957(c).

(e) An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913 but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

MPEP 2272 (II)
It should be kept in mind that a patent owner cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection, or reinstate previously canceled claims. For an amendment filed after final rejection and prior to the appeal brief, a showing under 37 CFR 1.116(b) is required and will be evaluated by the examiner for all proposed amendments after final rejection except where an amendment merely cancels claims, adopts examiner's suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner. An amendment filed at any time after final rejection but before an appeal brief is filed, may be entered upon or after

filing of an appeal provided:

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

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

The first proposed amendment after final action in a reexamination proceeding will be given sufficient consideration to determine whether it places all the claims in condition where they are patentable and/or whether the issues on appeal are reduced or simplified. Unless the proposed amendment is entered in its entirety, the examiner will briefly explain the reasons for not entering a proposed amendment. For example, if the claims as amended present a new issue requiring further consideration or search, the new issue should be identified and a brief explanation provided as to why a new search or consideration is necessary. The patent owner should be notified if certain portions of the amendment would be entered if a separate paper was filed containing only such amendment.

Any second or subsequent amendment after final will be considered only to the extent that it removes issues for appeal or puts a claim in obvious patentable condition.

Since patents undergoing reexamination cannot become abandoned and cannot be refiled, and since the holding of claims unpatentable and canceled in a certificate is absolutely final, it is appropriate that the examiner consider the feasibility of entering amendments touching the merits after final rejection or after appeal has been taken, where there is a showing why the amendments are necessary and a suitable reason is given why they were not earlier presented.

The petition submits that the Final Office Action of November 26, 2008 presented new assertions regarding claim interpretation and construction. Particularly, the Examiner took issue with the meaning of "copy" and the limitation of "double-stranded genetic construct". Patent Owner contends the amendment filed February 26, 2009 was necessary to address these new issues and to prepare a proper record for any necessary appeal. Patent Owner requests entry of the February 26, 2009 amendment and Declaration.

Conclusion

Patent Owner has set forth a factual accounting that is deemed to establish good and sufficient reasons why the amendment is necessary and was not earlier presented. In the interest of providing the Patent Owner with a fair opportunity to present an argument against the rejections of record and the requirement of 35 USC 305 that the proceedings be conducted with special dispatch, the amendment

of February 26, 2009 is entered in its entirety with the Declaration. The proceeding is returned to the Examiner for consideration of the amendment and Declaration and for appropriate action.

Conclusion

1. The Patent Owner's petition for entry of the February 26, 2009 amendment and Declaration is **granted**.

2. Any future response may be submitted as follows:

By EFS: Registered users may submit via the electronic filing system, EFS-Web at https://sportal.uspto.gov/authenticate/authenticatuserlocale:html

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

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

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

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.

Gregory ~~Morris~~ Morse
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.
90/008,096	05/18/2006	6573099	023004.0103X2US	4110

23432 7590 06/25/2009

COOPER & DUNHAM, LLP
30 Rockefeller Plaza
20th Floor
NEW YORK, NY 10112

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/25/2009

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

Copied from 90008096 on 07/27/2009

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.
90/008,096	05/18/2006	6573099	023004.0103X2US	4110

23432 7590 06/25/2009

EXAMINER

Erich E. Veitenheimer
Cooley Godward KronishLLP
777 6th Street, NW Suite 1100
Washington, DC 20001

ART UNIT	PAPER NUMBER

DATE MAILED: 06/25/2009

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

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Cooper & Dunham, LLP
30 Rockefeller Plaza
2oth Floor
New York, NY 10112

(For Patent Owner)

Erich E. Veitenheimer
Cooley Godward Kronish LLP
777 6th Street, NW Suite 1100
Washington, DC 20001

(For Third Party Requester)

MAILED

JUN 2 5 2009

CENTRAL REEXAMINATION UNIT

In re Graham *et al.*
Merged *Ex Parte* Reexamination Proceedings
Control Nos.: 90/007,247 & 90/008,096
Filed: Oct. 4, 2004 & May 18, 2006
For: U.S. Patent No.: 6,573,099

: DECISION
: ON
: PETITIONS

This is a decision on the April 7, 2009 patent owner petition under 37 CFR 1.182 requesting continued reexamination and the May 7, 2009 patent owner petition under 37 CFR 1.182 requesting withdrawal of the April 7, 2009 petition.

The above noted petitions are before the Office of Patent Legal Administration.

For the reasons set forth below, the April 7, 2009 petition is dismissed as withdrawn and has not been considered on its merits. The May 7, 2009 petition is granted.

FEES

The petition fee of $400 set forth in 37 CFR 1.17(f) for the April 7, 2009 petition under 37 CFR 1.182 has been charged to Deposit account No. 03-3125 in accordance with petitioner's authorization on page 6 of the April 7, 2009 petition.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the May 7, 2009 petition under 37 CFR 1.182 is waived, as the petition is a request to withdraw the previous petition.[1]

REVIEW OF THE FACTS

1. On June 3, 2003, the Office issued U.S. Patent 6,573,099 (the '099 patent) to Michael Wayne Graham. After issuance, the inventorship was corrected to add Robert Norman Rice.

2. On October 4, 2004, a first request for *ex parte* reexamination of the '099 patent was filed by a third party requester, Nucleonics, Inc. The resulting reexamination proceeding was assigned control number 90/007,247 (the '7247 proceeding).

[1] As such, the petition for withdrawal of the prior petition is treated as a supplemental petition, as far as the fee is concerned.

Copied from 90008096 on 07/27/2009

3. On December 7, 2004, the Office issued an order in the '7247 proceeding granting the first request for reexamination of the '099 patent.

4. On May 18, 2006, another request for *ex parte* reexamination of the '099 patent was filed by a third party requester, Nucleonics, Inc. The resulting reexamination proceeding was assigned control number 90/008,096 (the '8096 proceeding).

5. On July 20, 2006, the Office issued an order in the '8096 proceeding granting the second request for reexamination of the '099 patent.

6. On October 26, 2006, the Office merged the '7247 and the '8096 proceedings into the present merged *ex parte* reexamination proceeding (the merged proceeding).

7. Prosecution in the merged proceeding advanced to the point that a final Office action issued on November 26, 2008.

8. On February 26, 2009, patent owner submitted an amendment after final with an evidentiary declaration by Dr. Riggs.

9. On March 25, 2009, the Office issued an advisory action informing patent owner the February 26, 209 amendment did not place the proceeding in condition for confirmation or allowance and did not reduce issues for appeal and therefore would not be entered.

10. On April 7, 2009, patent owner submitted a petition requesting entry of the February 26, 2009 after final amendment.

11. Concurrently on April 7, 2009, patent owner submitted a petition requesting continued reexamination of the merged proceeding.

12. On April 22, 2009, patent owner submitted a petition requesting an extension of time.

13. On April 24, 2009, the Office issued a supplemental advisory action informing patent owner that the February 26, 209 amendment, while not placing the proceeding in condition for confirmation or allowance, reduced issues for appeal, and, therefore, it would be entered. The supplemental advisory action also extended patent owner's time to respond to the November 26, 2009 final Office action for six months until May 26, 2009.

14. On April 25, 2009, the Office issued a decision granting patent owner's April 7, 2009 petition requesting entry of the February 26, 2009 amendment after final.

15. On April 27, 2009, the Office issued a decision dismissing patent owner's April 22, 2009 petition for an extension of time in light of the extension of time granted by the April 24, 2009 supplemental advisory action.

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16. On May 7, 2009, patent owner filed a petition requesting withdrawal of the April 7, 2009 petition requesting continued reexamination of the merged proceeding, in light of the Office's entry of the February 26, 2009 after final amendment.

17. On May 27, 2007, patent owner submitted a notice of appeal with a certificate of express mailing dated May 22, 2009.

DECISION ON PETITION UNDER 37 CFR 1.182

In the April 7, 2009 petition, patent owner requested that the Office continue the prosecution of the merged reexamination proceeding to provide consideration of the Riggs declaration and the February 26, 2009 after-final amendment in response to the November 26, 2008 final Office action.

In the May 7, 2009 petition, patent owner requested that the Office withdraw from consideration the April 7, 2009 request for continued prosecution of the merged reexamination proceeding in light of the fact that the Riggs declaration and the February 26, 2009 after-final amendment were entered onto the record by the Office on April 25, 2009.

In light of the patent owner request that the Office withdraw from consideration the April 7, 2009 request for continued prosecution of the merged reexamination proceeding, the April 7, 2009 petition is hereby dismissed as withdrawn and has not been considered on its merits. The May 7, 2009 petition is granted.

CONCLUSION

1. The April 7, 2009 petition under 37 CFR 1.182 is dismissed as withdrawn.

2. The May 7, 2009 petition under 37 CFR 1.182 is granted.

3. Jurisdiction for the merged reexamination proceeding is returned to the Central Reexamination Unit (CRU).

4. Telephone inquiries related to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759.

Kenneth Schor,
Senior Legal Advisor
Office of Patent Legal Administration

6-24-09
Kendpet7/RCR

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SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON DC 20037

(For Patent Owner)

MAILED
APR 06 2006
REEXAM UNIT

John W. Chestnut
Greer Burns & Crain Ltd
300 South Wacker Drive
Suite 2500
Chicago, IL 60606

(For Third Party Requester)

In re Reexamination Proceeding :
Stufflebeam et al. :
Control No. 90/007,253 : DECISION GRANTING PETITION
Filed: October 12, 2004 :
U.S. Patent No. 5,842,428 :
Attorney Docket No. 11563 :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on March 22, 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 - Amendment Under 37 CFR § 1.530 (item 1), a $1500.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3).

The petition for entry of the late papers is granted.

$1,500.00 has been charged to counsel's deposit account no. 19-4880 in accordance with the present petition.

A review of the present petition reveals that the requisite proof of service on the third party requester has not been included with the present petition papers or with its attachments.

Since there is no indication that the third party requester was provided with a copy of these papers, any response by patent owner to this decision **must** include a Certificate that the present petition papers (including, *inter alia*, the required response submitted hereto - Amendment Under 37 CFR § 1.530) have been served on the third party requester in the manner provided by § 1.248.

In addition, any future communications filed by patent owner in this proceeding (including any response to this decision) **must** include proof of service on the third party requester in accordance with 37 CFR 1.550(f).

Jurisdiction over the reexamination proceeding is being returned to Technology Center Art Unit 3993 for further examination and consideration of the Amendment Under 37 CFR § 1.530 filed March 22, 2006, along with the present petition, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Matthew Graham, in Technology Center Art Unit 3993, who can be reached at 571-272-7116.

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

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SUGHRUE MION, PLLC
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SUITE 800
WASHINGTON DC 20037

(For Patent Owner)

John W. Chestnut
Greer Burns & Crain Ltd
300 South Wacker Drive
Suite 2500
Chicago, IL 60606

(For Third Party Requester)

MAILED

AUG 24 2006

CENTRAL REEXAMINATION UNIT

In re Reexamination Proceeding :
Stufflebeam et al. :
Control No. 90/007,253 : DECISION GRANTING PETITION
Filed: October 12, 2004 :
U.S. Patent No. 5,842,428 :
Attorney Docket No. 11563 :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on July 24, 2006, by facsimile transmission, for entry of late papers based upon unintentional delay.

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

37 CFR 1.137(b) states:

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

On April 6, 2006, in a decision granting a petition,the following was stated:

> Since there is no indication that the third party requester was provided with a copy of these papers, any response by patent owner to this decision **must** include a Certificate that the present petition papers (including, *inter alia*, the required response submitted hereto - Amendment Under 37 CFR § 1.530) have been served on the third party requester in the manner provided by § 1.248.
>
> In addition, any future communications filed by patent owner in this proceeding (including any response to

this decision) **must** include proof of service on the third party requester in accordance with 37 CFR 1.550(f).

On April 11, 2006, the requisite certificate of service was filed.

On June 1, 2006, an interview on the substance of the reexamination proceeding was held in the Office with a copy of an interview summary record being given to the patent owner. The mandatory statement of the substance of the interview, however, was not filed by the patent owner within the one month period set forth in the interview summary record.

On July 24, 2006, the present petition, petition fee, a certificate of service and the mandatory statement of the substance of the interview were filed by facsimile transmission.

The present petition under 37 CFR 1.137(b) includes the requisite response (a statement of substance of interview - item 1), a $1500.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3).

The petition for entry of the late papers is granted.

$1,500.00 has been charged to counsel's deposit account no. 19-4880 in accordance with the present petition.

Jurisdiction over the reexamination proceeding is being returned to Central Reexamination Unit (CRU), Art Unit 3993 for further examination, and consideration of a statement of substance of interview filed July 24, 2006, along with the present petition and consideration of a supplemental amendment filed July 11, 2006, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Matthew Graham, in Technology Center Art Unit 3993, who can be reached at 571-272-7116.

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

Fred A. Silverberg

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

Kenneth M. Schor

Conferee: Kenneth M. Schor

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,256	10/13/2004	5292097	048782/276678	2673

826 7590 08/21/2007

ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/21/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE NC 28280-4000

(For Patent Owner)

MAILED

AUG 2 1 2007

CENTRAL REEXAMINATION UNIT

In re Reexamination Proceeding :
E. Russell :
Control No. 90/007,256 : DECISION GRANTING PETITION
Filed: October 13, 2004 :
U.S. Patent No. 5,292,097 :
Attorney Docket No. 048782/276678 :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on July 25, 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, 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 (Notice of Appeal and an authorization to charge counsel's deposit account for the appeal fee - item 1), an authorization to charge counsel's deposit account for the $750.00 petition fee under 37 CFR 1.17(m)) (item 2) and the requisite statement (item 3).

The petition for entry of the late papers is granted.

$1,000.00 ($750.00 for the petition fee and $250.00 Notice of Appeal fee) has been charged to counsel's deposit account no. 16-0605 in accordance with the present petition.

Jurisdiction over the reexamination proceeding is being returned to Central Reexamination Unit (CRU) Art Unit 3993 for further examination and consideration of the Notice of Appeal filed July 25, 2007, and the amendments previously filed after the final Office action, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Jimmy G. Foster, in CRU Art Unit 3993, who can be reached at 571-272-4554.

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

Attorney's Docket No. 048782/276678

PETITION FOR ENTRY OF LATE PAPERS FOR REVIVAL OF A REEXAMINATION PROCEEDINGS UNDER 37 CFR 1.137(B)

In re:	Russell	Confirmation No.:	2673
Appl. No.:	90/007,256	Group Art Unit:	3993
Filed:	10/13/2004	Examiner:	Jimmy G. Foster
For:	Reexamination of Work Surface Support		

Attention: Office of Petitions
Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the Office notice or action plus any extensions of time actually obtained.

Applicant hereby petitions for entry of late papers for revival of this Reexamination proceeding.

1. ☒ Petition fee under 37 CFR 1.17(m) ($1500 or $750 for small entity)
   ☒ Applicant claims Small entity status (37 CFR 1.27)

2. Reply and/or fee

   A. The reply and/or fee to the above noted Office action in the form of a related, continuation application claiming priority to this application:
   ☒ has been filed previously on February 2, 2007.
   ☒ plus the enclosed Notice of Appeal.

   B. The issue fee of $
   ☐ has been paid previously on
   ☐ is enclosed herewith.

3. Terminal disclaimer with disclaimer fee

   ☐ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.

   ☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of $55 for a small entity or $110 for other than a small entity) is enclosed herewith.

4. STATEMENT: 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 CFR 1.137(b) was unintentional.

5. It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

/Walter Scott/
Registration No. 30,588

CUSTOMER NO. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
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ELECTRONICALLY FILED USING THE EFS-WEB ELECTRONIC FILING SYSTEM OF THE UNITED STATES PATENT & TRADEMARK OFFICE ON July 25, 2007.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Kurt L. Grossman
Wood Herron & Evans LLP
2700 Carew Tower
Cincinnati, OH 45202

(For Patent Owner)

MAY 21 2007

Hoffman Wasson & Gitler, P.C.
Crystal Center 2
2461 South Clark Street, Suite 522
Arlington, VA 22202-2768

(For Requester)

In re: Patrick D. McCarthy	:
Reexamination Proceeding	: DECISION ON PETITION
Control No.: 90/007,258	: FOR WITHDRAWAL OF
Filed : October 20, 2004	: FINALITY OF OFFICE
For : U.S. Patent No. Re 36,116	: ACTION

This is a decision on the petition filed January 24, 2006 requesting the withdrawal of the finality of the Office action dated January 11, 2006. The petition is before the Director of the Central Reexamination Unit for consideration. Since the filing of the request for the withdrawal of the finality of the Office action mailed January 11, 2006, an amendment was filed March 13, 2006 and a Notice of Appeal on April 11, 2006 and an Appeal Brief on June 12, 2006.

The petition is **dismissed** for the reasons set forth below.

The petition states that the examiner's Final rejection of January 11, 2006 identifies an additional reference, US Patent No. 3,938,090 to Borison et al, not previously cited by the examiner. The disclosure of this reference is relied upon as "extrinsic evidence to the statement of inherency" with respect to the assertion that the UPI article inherently discloses a magnetic card reader terminal. The request asserts that the examiner's use of Borison et al is clearly a new citation of art for a ground of rejection to which patentee is entitled to respond prior to issuance of a Final action.

Upon review of the Office action, it is clear that US Patent No. 3,938,090 to Borison et al was cited merely to substantiate the examiner's position with respect to the UPI article inherently disclosing a magnetic card reader terminal and to refute patent owner's arguments filed October 25, 2005 in which patent owner challenged the statement of inherency within the rejections presented in the Office action of August 25, 2005. The basis for the rejections remaining as presented in the Office action of August 25, 2005.

Since the additional reference cited in the Office action of January 24, 2006 was evidentiary in nature and not seen to be the basis for the Final rejection and since the rejection reiterated the position taken in the Office action of August 25, 2005, the finality is deemed proper.

The petition is, accordingly, DISMISSED.

Upon the mailing of this decision, the application will be returned to then examiner in charge of this proceeding for appropriate action on the amendment filed March 13, 2006 and the Appeal Brief filed June 12, 2006.Telephone inquiries related to this decision should be directed to Andres Kashnikow, Special Program Examiner, at (571) 272-4361.

Lissi Mojica Marquis, Director
Central Reexamination Unit

ak 5/21/07

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Thomas W. Humphrey
WOOD, HERRON & EVANS, LLP
441 Vine Street
Cincinnati, OH 45202-2917

For Patent Owner

MAILED
MAR 6 2006
REEXAM UNIT

Randy Lacasse
1725 Duke Street
Suite 650
Alexandria, VA 22314

For Requester

Ex Parte Reexamination Proceeding
Control No. 90/007,259
Filed: October 20, 2004
For: US Patent No. 5,202,826

DECISION ON
PETITION FOR
WITHDRAWAL OF
FINALITY OF OFFICE
ACTION

This is a decision on the petition filed January 24, 2006 to request withdrawal of the finality of the Office action dated December 6, 2005.

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

The petition is **DISMISSED** for the reasons set forth below.

Decision

Patent Owner's Statement

The petition states the Examiner's Final rejection identifies an additional reference, US Patent 3,939,090 to Borison et al, not previously cited by the Examiner. The disclosure of this reference is relied upon as "extrinsic evidence to the statement of inherency" with respect to the assertion the UPI article inherently discloses a magnetic card reader terminal. The request asserts that the Examiner's use of Borison is clearly a new citation of art for a ground of rejection to which Patentee is entitled to respond prior to the issuance of a Final rejection.

Analysis and Findings

Upon review of the Office action, it is clear that US Patent 3,938,090 to Borison et al has been cited merely to substantiate the Examiners position with respect to the UPI article inherently disclosing a magnetic card reader terminal and to refute Patent Owner's arguments filed 10/26/2005 in which Patent Owner challenged the statement of inherency within the rejections presented in the previous Office action. The basis for the rejections remains as presented in the initial Office action.

Conclusion

Since the additional reference cited in the Office action of December 6, 2005 is evidentiary in nature and not seen to be the basis for the final rejection and since the rejection reiterates the position taken in the initial office action, the finality is deemed proper.

The petition is **DISMISSED**.

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 Andres Kashnikow, Special Program Examiner in the Central Reexamination Unit, Art Unit 3993, at (571) 272-4361.

for 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
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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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Alexandria, VA 22313-1450
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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.

Jasemine C. Chambers
Director, Technology Center 1600

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MAR 12 2008

CENTRAL REEXAMINATION UNIT

Hickman, Palermo, Trong & Becker, LLP (For Patent Owner)
2055 Gateway Place
Suite 550
San Jose, CA 95110

Ropes & Gray LLP (For Third Party Requester)
Attn: J. Steven Baughman
One International Place
Boston, MA 02110-2624

In re John Phillips Pettitt	:
Ex Parte Reexamination Proceeding	: **DECISION**
Control No. 90/007,268	: **DISSMISSING**
Filed: October 26, 2004	: **PETITION**
For: U.S. Patent No. 6,029,154	: **UNDER 37 CFR 1.182**

This is a decision on the patent owner paper, denominated "Patent Owner's Request Under 37 C.F.R. 1.550(g) to Strike Third Party Requestor's Petition to the Director" submitted July 25, 2007, which will be treated under 37 CFR 1.182, as the rules do not provide for such a paper.

The patent owner petition is before the Office of Patent Legal Administration.

The petition is dismissed as moot.

FEES

In regards to petitions under 37 CFR 1.182, a petition fee of $400.00 under 37 CFR 1.17(f) is being charged to petitioner's Deposit Account No. 50-1302 as authorized in the July 25, 2007 petition.

BACKGROUND

1. U.S. patent No. 6,029,154 ("the '154 patent") issued to John Phillips Pettitt on February 22, 2000.

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2. On October 26, 2004, third party requester submitted a request for *ex parte* reexamination of the '154 patent assigned reexamination proceeding Control Number 90/007,268 (the '7268 proceeding).

3. On December 30, 2004, the Office issued an order granting *ex parte* reexamination of the '154 patent.

4. On May 3, 2007, the Office issued a Notice of Intent to Issue a Reexamination Certificate (NIRC) in the '7268 proceeding.

5. On July 2, 2007, the third party submitted a paper entitled "Petition to the Director of the United States Patent and Trademark Office Under 37 CFR 1.183(a) (3)."

6. On July 25, 2007, the patent owner submitted a paper entitled "Patent Owner's Request Under 37 C.F.R. 1.550(g) to Strike Third Party Requestor's Petition to the Director."

7. On February 26, 2008, the Office issued a decision returning the third party's July 2, 2007 paper as improper.

DECISION

The paper filed by patent owner which is the subject of this decision requests that the paper filed by third party requester on July 2, 2007, not be entered into the record because it goes beyond the scope of what is permissible under the governing regulation - 37 CFR 1.550(g).

On February 26, 2008, the Office issued a letter stating that the third party requester's submission of July 2, 2007, entitled "Petition to the Director of the United States Patent and Trademark Office Under 37 CFR 1.183(a)(3)," had not been entered and was being returned because it was not a proper paper under the rules governing reexamination. Accordingly, there is no action to be taken, for which patent owner need be granted relief, and, therefore, patent owner's petition is dismissed as moot.

CONCLUSION

1. The July 25, 2007 patent owner paper is dismissed as moot.

2. Telephone inquiries with regard to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759, or to the undersigned at (571) 272-7710.

Kenneth Schor
Senior Legal Advisor
Office of Patent Legal Administration

3-7-08
C:\Kiva\Kenpet6\7268_dismiss_petition_to_strike_as_moot

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.
90/007,271	10/27/2004	6502233	MSFT-4566/74128.01	8481

41505 7590 02/02/2006

WOODCOCK WASHBURN LLP (MICROSOFT CORPORATION)
ONE LIBERTY PLACE - 46TH FLOOR
PHILADELPHIA, PA 19103

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/02/2006

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

WOODCOCK, WASHBURN LLP (For Patent Owner)
(MICROSOFT CORPORATION)
ONE LIBERTY PLACE - 46th FLOOR
PHILADELPHIA, PA 19103

In re Vaidyanathan et al.	:	
Reexamination Proceeding	:	**DECISION**
Control No. 90/007,271	:	**DISMISSING**
Filed: October 27, 2004	:	**PETITION**
For: U.S. Patent No. 6,502,233	:	

This is a decision on the January 25, 2006 patent owner PETITION TO REINSTATE PATENT EXPIRED FOR FAILURE TO RESPOND TO NOTICE OF DEFECTIVE PAPER IN EX PARTE REEXAMINATION AS THERE IS NO EXPIRATION OF PATENT IN FACT, which is properly taken as a petition under 37 CFR 1.181 requesting withdrawal of the termination of the reexamination proceeding.

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

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

Any request for reconsideration of this decision must be submitted within **ONE (1) MONTH** from the mail date of this decision. An extension of time may be requested only under 37 CFR 1.550(c); extensions of time under 37 CFR 1.136 are not available in reexamination proceedings. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181."

DECISION ON PETITION UNDER 37 CFR 1.181

The reexamination proceeding was terminated under 37 CFR 1.550(d) for failure to timely respond to the Notice of Defective Paper in *Ex Parte* Reexamination mailed November 8, 2005. On instant petition, petitioner asserts that the Notice was never received by Patent Owner.

A review of the application file reveals no irregularities in the mailing of the Notice of Defective Paper in *Ex Parte* Reexamination as mailed on November 8, 2005. A review of the record confirms that the Notice was properly mailed to the correspondence address of record. Thus, there is a strong presumption that the correspondence was properly mailed to and received by Patent Owner at the correspondence address of record. In the absence of demonstrated irregularities in mailing of this Notice, petitioner must submit evidence to overcome this presumption.

Section 711.03(c), part II, of the Manual of Patent Examining Procedure sets forth that a grantable petition establishing non-receipt of an Office communication requires two items:

(1) A statement from the practitioner averring that the Office communication was not received and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received; and

(2) A copy of the docket record(s) where the non-received Office communication would have been entered, had it been received and docketed.

The petition includes a statement from the Patent Owner's representative attesting to the fact that the Notice, although addressed to the Patent Owner (and not to the Patent Owner's representative), was not received by the Patent Owner. The petition includes the Declaration of Sindie Olinares, attesting to having firsthand knowledge of the Notice not being received by the Patent Owner. Ms. Olinares states that a search of the Patent Owner's docketing database indicates that the Office communication was not received. In addition, petitioner included a copy of the docket record where the non-received Office communication would have been entered had it been received and docketed.

However, the present petition does not contain any statement (from the <u>practitioner</u>) to the effect that a search of the file jacket <u>and</u> docket records was made, and that such a search indicated that the November 8, 2005 Notice was not received. The petition does not address what is shown by the contents of the file jacket.

In view thereof, the petition is **<u>DISMISSED</u>**. This decision is made without prejudice to reconsideration upon timely submission of the items required to establish non-receipt.

ALTERNATE VENUE

Alternatively, petitioner is not precluded from seeking revival 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 § 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.

A copy of the November 8, 2005 Notice of Defective Paper in *Ex Parte* Reexamination is enclosed.

CONCLUSION

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

2. For the granting of the present petition, it is required that patent owner provide:

   (1) A statement from the practitioner averring that the Office communication was not received and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received.

   If petitioner desires to make the required submissions in order that the present petition be granted, the submissions should be included in a cover letter entitled "Renewed Petition under 37 CFR 1.181."

3. Any renewed petition must be filed within **ONE (1) MONTH** of the mailing date of this decision. An extension of time to file a renewed petition may be requested only under 37 CFR 1.550(c); extensions of time under 37 CFR 1.136 are not available in reexamination proceedings.

4. For the granting of a petition to revive under either 37 CFR 1.137(a) or (b), that patent owner meet the requirements of those provisions as set forth in the regulations (and repeated in the body of this decision).

   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)."

5. 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

6. Telephone inquiries related to this decision should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

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

Enclosure: Copy of Notice mailed November 8, 2005 (3 pages)

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February 2, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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

WOODCOCK, WASHBURN LLP (For Patent Owner)
(MICROSOFT CORPORATION)
ONE LIBERTY PLACE - 46th FLOOR
PHILADELPHIA, PA 19103

MAILED
MAR 16 2006
REEXAM UNIT

In re Vaidyanathan et al.	:	
Reexamination Proceeding	:	**DECISION**
Control No. 90/007,271	:	**GRANTING**
Filed: October 27, 2004	:	**PETITION**
For: U.S. Patent No. 6,502,233	:	

This is a decision on the February 24, 2006 patent owner RENEWED PETITION TO REINSTATE PATENT EXPIRED FOR FAILURE TO RESPOND TO NOTICE OF DEFECTIVE PAPER IN EX PARTE REEXAMINATION AS THERE IS NO EXPIRATION OF PATENT IN FACT (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.

By decision mailed February 2, 2006, the initial petition under 37 CFR 1.181 was **dismissed**. Petitioner failed to establish non-receipt of the Office communication as alleged.

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 November 8, 2005. On instant petition, petitioner asserts that the Notice was never received by Patent Owner.

The initial petition included a statement from the practitioner attesting to the fact that the Notice, although addressed to the

Patent Owner (and not to the Patent Owner's representative), was not received by the Patent Owner. The petition included the Declaration of Sindie Olinares, attesting to having firsthand knowledge of the Notice not being received by the Patent Owner. Ms. Olinares stated that a search of their docketing database indicates that the Office communication was not received. In addition, petitioner included a copy of the docket record where the non-received Office communication would have been entered had it been received and docketed.

However, the initial petition was dismissed because it did not contain any statement (from the practitioner) to the effect that a search of the file jacket and docket records was made, and that such a search indicated that the November 8, 2005 Notice was not received. The petition did not address what is shown by the contents of the file jacket.

On instant renewed petition, petitioner submitted the Declarations of patent attorneys Michael J. Swope and Kevin Sullivan. It is noted that patent attorney Michael J. Swope attested to having searched the file jacket maintained in his Office at the law firm of Woodcock Washburn and that the Notice was not among the items present in the file. However, this Declaration is of little persuasive value as the Notice was mailed to the Patent Owner and not to its representative.

Nonetheless, patent attorney Kevin Sullivan attested to having made a thorough search of the Patent Owner's docketing database and determining that no entry was made reflecting receipt of the Notice. Attorney Sullivan further clarified that only an electronic file is maintained.

In view thereof, the petition is **GRANTED**, and the holding of terminated reexamination proceedings is hereby **WITHDRAWN**.

CONCLUSION

1. The petition under 37 CFR 1.181 is granted.

2. The reexamination file is being returned to Technology Center 2193 for re-mailing and re-starting of the period for reply to the November 8, 2005 Notice of Defective Paper in Ex Parte Reexamination.

3. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Todd Ingberg, in Technology Center 2193, who can be reached at (571) 272-3723.

4. Telephone inquiries related to this decision should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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ALEXANDRIA, VA 22313-1450
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Gregory F. Wirzbicki (For Patent Owner)
Union Oil of California
Patent Department
P.O. Box 7600
Brea, CA 92822

Michael S. Marcus (For Third Party Requester)
Morgan & Finnegan, L.L.P.
1775 Eye Street, N.W., Suite 400
Washington, D.C. 20006

In re Application of In re Peter J. Jessup, et al Reexamination Proceedings Control No. 90/007,273 Filed: October 29, 2004 For: U.S. Patent No. 5,837,126 Application Filing Date: November 17, 1998 Issued: November 17, 1998	DECISION ON PETITION UNDER 37 CFR 1.182

MAILED
MAY 10 2005
REEXAM UNIT

This is a decision on the patent owner PETITION UNDER 37 CFR §1.182 filed January 25, 2005. In response to the patent owner petition, the third party requester filed, on February 16, 2005, an opposition entitled REPLY TO PETITION UNDER 37 CFR §1.182 FILED AS PATENT OWNER'S STATEMENT.

The petition and opposition are before the Office of Patent Legal Administration.

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

REVIEW OF FACTS

1. U. S. patent No. 5,837,126 (the '126 patent) issued November 17, 1998. The patent lists 66 claims. Counting multiple dependencies, the actual claim number has been stated to be 279.[1] The references cited on the printed patent cover 16 columns.

2. A first request for reexamination was filed on February 6, 2001, by third party requester Price. The first request resulted in a reexamination proceeding that was assigned Control No. 90/005,924 (the '5924 proceeding), and reexamination was ordered for the '5924 proceeding on January 24, 2002.

3. On July 25, 2002, an Office action rejected all claims in the '924 proceeding.

[1] Second request for reexamination, page 1, first paragraph.

4. On September 25, 2002, the patent owner filed a response to the rejection, a supplemental response, and an affidavit under 37 CFR 1.132.

5. On January 17, 2003, a second request for reexamination was filed by third party requester Marcus. The second request was assigned Control No. 90/006,518 (the '6518 proceeding). The second request was drawn towards all 279 claims of the patent and was based on the following questions of patentability set forth by the requester as prior art rejections:

   a. All 148 composition of matter claims (claims 1-40 and those dependent thereon) are unpatentable under 35 U.S.C. 103 based on a January 17, 1972 Oil and Gas Journal publication (GM-1), either alone or in view of an August 1987 Notice of Proposed Rule Making published by the EPA (EPA RVP).

   b. All 148 composition claims (claims 1-40 and those dependent thereon) are unpatentable under 35 U.S.C. 103 based on an October 2, 1972 Oil and Gas Journal publication (GM-2), either alone or in view of a May 1973 Adams API publication (Adams).

   c. All 131 method claims (claims 41-66 and those dependent thereon) are unpatentable under 35 U.S.C. 103 based on GM-1 either alone or in view of EPA RVP together with a Kirk-Othmer publication (Kirk-Othmer).

   d. All 131 method claims (claims 41-66 and those dependent thereon) are unpatentable under 35 U.S.C. 103 based on GM-2, either alone or in view of Adams and/or EPA RVP together with Kirk-Othmer.

6. On March 18, 2003, reexamination was ordered for the '6518 proceeding based on findings of substantial new questions of patentability for claims 1-66 [2] grounded on the cited prior art identified in the second request for reexamination.

7. The '5924 and '6518 proceedings were merged into a single reexamination proceeding, by the merger decision mailed July 21, 2003.

8. On March 22, 2004, the Office issued a non-final Office action for the merged reexamination proceeding, rejecting all of the patent claims on prior art, including art identified in the first and second requests for reexaminations.

9. On May 12, 2004 a response to the March 22, 2004 Office action was filed. The response included an affidavit under 37 CFR 1.132 and an Appendix containing comparisons based on a "Predictive Model" set forth in the '126 patent.

10. On October 29, 2004, a third request for reexamination was filed by third party requester Marcus (the same requester who filed the second request). The third request was assigned Control No.90/007,273 (the '7273 proceeding), and the '7273 proceeding is the proceeding which is the subject of this decision. The third request:

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[2] March 18, 2003 Order Granting Reexamination, page 2, paragraph 1.

a. was drawn towards 145 claims, including multiple dependent claims,

b. was based on the following prior art: CRC Report No. 464 and CRC Report No. 493 either alone or in view of Kirk-Othmer previously relied upon in the second request for reexamination.

c. included pages 21-79 directed towards supporting the rejections made based on the prior art supplied in the first two requests for reexamination and to address the patent owner's response to the last Office action in the merged proceeding. A lengthy Cunningham declaration is also submitted for that purpose.

11. On January 10, 2005, reexamination was ordered for the '7273 proceeding based on findings of substantial new questions of patentability set forth in an a ten page decision ordering reexamination and detailing the substantial new questions.

12. The instant patent owner petition under 37 CFR 1.182 was filed on January 25, 2005. Petitioner patent owner, relying upon MPEP 2240, requests termination of the third reexamination based on the clear intent to harass the owner by the filing of the third request for reexamination by:

a. the piecemeal filing of the two requests for reexamination (the second and third requests) by the same requester rather than presenting all the grounds for reexamination at once, and

b. utilization of the third request for reexamination to "effectively gain advantages of *inter partes* argumentation in an *ex parte* proceeding," by supporting the rejections based on the previous requests for reexamination and addressing the patent owner's reply to the Office rejection based on the previous requests for reexamination.

13. On February 16, 2005, the third party requester submitted a reply in opposition to the § 1.182 petition by the patent owner.

14. The '7273 proceeding has not been merged with the ongoing merged reexamination proceeding for the '5924 and '6518 reexaminations.

THE PETITION AND THE OPPOSITION

Patent owner's petition under 37 CFR 1.182: [3] The § 1.182 petition seeks termination of the third reexamination, i.e., the present '7273 proceeding. It is urged that termination is appropriate even where reexamination has been ordered, if the purpose of a second or subsequent reexamination request is to harass the patent owner. The petition presents the following arguments: [4]

1. As reexaminations are to be conducted with special dispatch under 35 U.S.C. 305, a third request for reexamination "can do nothing other than unduly prolong the conclusion" of the reexamination proceedings. [5] Moreover, there is a pressing need for conclusion of reexamination in regard to the instant patent in view of the suspension of litigation regarding the '126 patent. [6]

---

[3] The petition has been timely filed pursuant to 35 U.S.C. 304 as the patent owner's statement within the two months permitted by the decision ordering reexamination.

[4] Petitioner also objects to the manner in which a harassment petition is provided via MPEP 2240 in that characterizing the harassment petition as a patent owner's statement or as part of the statement "moots any question of abuse being addressed until the issue of [a] substantial new question of patentability is decided..." See footnote 1 of the petition. It is to be noted, however, that if no legitimate substantial new question as to the patent claims is presented, the reexamination request will be denied, and there is no need for the lengthy process of deciding a "harassment" petition. On the other hand, if a legitimate substantial new question as to the patent claims is presented, this cannot be characterized as harassment, other than in the highly unusual instance where it can be shown that the requester willfully delayed in presenting the substantial new question for purposes of delaying the ongoing reexamination prosecution. In balance, it is not appropriate to permit the patent owner to file a petition in the proceeding at a point where requester has no reply right, in order to address that unusual case; rather, if the patent owner can make that unusual showing, the reexamination proceeding can be suspended after the requester has had a chance to try to rebut patent owner's case once reexamination has been ordered. Also, even in that unusual situation, it would not be appropriate to terminate the proceeding, since the public has a right of resolution of any legitimate substantial new question as to the patent claims that is raised. Thus, suspension would be in order to address the harassment delay of the ongoing reexamination proceeding, but permit addressing the legitimate question at a later time. See also the discussion below in this decision.

[5] Reference is also made to: (1) *In re Recreative Technologies*, 38 USPQ2d 1776, 1778 (Fed. Cir. 1996) ("Congress recognized that [the] ... broad purpose of [reexamination] must be balanced against the potential for abuse, whereby unwarranted reexaminations can harass the patentee and waste the patent life. The legislative record and the record of the interested public reflect a serious concern that reexaminations not create new opportunities for abusive tactics and burdensome procedures."), and (2) *Patlex Corp. v Mossinghoff*, 226 USPQ 985, 987 (Fed. Cir. 1985) ("As described by the then PTO Commissioner Diamond: [The statute] carefully protects patent owners from reexamination proceedings brought for harassment or spite. The possibility of harassing patent holders is a classic criticism of some foreign reexamination systems and we made sure it would not happen here.").

[6] Bridge of pages 13 and 14 of the petition.

2. *Ex parte* reexamination provides for only limited participation by the requester, which limited participation is explained in an Office comment in the rule making for § 1.535 relating to replies by a third party requester: "The reasons for the limited participation are that it is all that is required under the law, it prevents to a great degree, harassment of a patent owner, it results in a less expensive proceeding for all parties, and it results in an earlier conclusion of the proceedings." [7] The piecemeal presentation of requester Marcus's two reexamination requests is such to "effectively gain the advantages of *inter parties* argumentation in an *ex parte* proceeding." [8] Both requests should have been presented as one, particularly as they rely mostly on prior art identified on the face of the patent of which the instant requester was long aware of. All of pages 21 to the conclusion on page 79 of the third request for reexamination are identified as "devoted to arguments seeking to refute ... [the patent owner's] arguments previously filed in response to the PTO Office action." [9]

3. Actions, including litigation and reexamination requests, involving patent No. 5,288,393, sharing a common specification with the instant '126 patent being reexamined and in the benefit chain, should be taken into account as establishing a pattern of harassment and showing a deliberate long delay in presenting prior art known the requester to the attention of the Office. [10]

4. With "literally hundreds of references ... to select from ... the potential for further abuse in selecting from among a plethora of references ... [that the requesters] have know for years for future harassing requests becomes self-evident." [11]

Requester's opposition to 37 CFR 1.182 petition: [12] The requester's reply to the § 1.182 patent owner petition opposes termination of the present third reexamination, as harassment has not been established. The requester responds to the relevant patent owner's allegations as follows: [13]

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[7] Petition at p. 7, quoting from 46 Fed. Reg. 29176 at pages 29, 179-180 (1981).

[8] Petition at p. 2.

[9] Petition at p. 13.

[10] Petition at pp. 5+.

[11] Petition at p. 15.

[12] The reply to the petition/owner's statement has been timely filed pursuant to 35 U.S.C. 304 within the two months permitted by the statute and the decision ordering reexamination.

[13] The requester responds to issues raised by the patent owner regarding the length of knowledge of several references by pointing out the legislative overturning of *In re Portola Packaging*, 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997), which barred submission of prior art during reexamination that

1. The suspended litigation involving the patent being reexamined is irrelevant as the requester is not a party to the litigation; [14] and

2. "Nowhere in the statutes or regulation is there a prohibition against addressing in subsequent proper *ex parte* reexamination requests patentability arguments previously made by the patent owner." [15]

3. The information being supplied, such as the Cunningham declaration, is information "not readily available to the Office, which will enable the Office to discharge its responsibility for issuing sound and reliable patents." [16]

DECISION

As to *ex parte* reexamination, MPEP 2240, II. Second or Subsequent Request Filed During Reexamination, states in-part:

> "If the requester includes in the second or subsequent request prior art which raised a substantial new question in the pending reexamination, reexamination should be ordered only if the prior art cited raises a substantial new question of patentability which is different than that raised in the pending reexamination proceeding. If the prior art cited raises the same substantial new question of patentability as that raised in the pending reexamination proceedings, the second or subsequent request should be denied. However, in aggravated situations, after a grant of a second or subsequent request for *ex parte* reexamination, where (A) the patent owner files a petition under 37 CFR 1.182 as part of the statement or as the statement, and (B) it **appears clear** that the second or subsequent request was filed **for purposes of harassment** of the patent owner. If the petition is granted, prosecution on the second or subsequent reexamination **would be suspended**." [Emphasis Added]

As to *inter partes* reexamination, MPEP 2640, II. Second or Subsequent Request Filed During Reexamination, also speaks to the issue of harassment as follows:

> "In an aggravated situation, where reexamination is granted on a second or subsequent request, but the patent owner **can clearly show** that the second or subsequent request was filed **for purposes of harassment**, the patent owner can petition under 37 CFR 1.182 that the second or subsequent request should be suspended. If such a petition is granted, prosecution on the second or subsequent reexamination would be **suspended** until termination of proceedings in the first reexamination."[Emphasis Added]

Patent owner's § 1.182 petition seeks <u>termination</u> of the present (third) reexamination proceeding, while MPEP 2240 and 2640 both speak to <u>suspension</u> of the reexamination proceeding in an instance where harassment is established. As pointed out above, a decision granting the present reexamination was issued on January 10, 2005. The examiner issued a ten page order for reexamination detailing the substantial new questions presented by the request in the present reexamination proceeding. It would not be in the interest of the public to terminate the reexamination proceeding prior to the resolution of the substantial new questions of patentability that are raised. Thus, the petition must be <u>dismissed</u>.

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was considered during prosecution of the patent. Reliance upon proceedings in related patents is not material, and the arguments and defenses will not be addressed in any detail.

[14] Opposition at p. 7.

[15] Opposition at p. 3.

[16] Opposition at p. 5.

Additional discussion:

1. In *Heinl v. Godici*, 143 F.Supp.2d 593 (E.D.Va. 2001), the issue of harassment was addressed. In *Heinl*, the requester, Medicon, filed a second request for reexamination while its first requested reexamination was pending. In Medicon's first requested reexamination proceeding, the examiner had withdrawn the rejection of the patent claims based on a finding that the record was inadequate to reach a conclusion on whether the four reference catalogs relied upon constituted prior art as to the patent being reexamined. Medicon's second request provided a substantial new question of patentability with evidence of the availability of the catalog references. The patent owner then filed a petition seeking the denial or termination of the second reexamination request. The decision of the Director of the USPTO dismissed patent owner's petition to deny or terminate the second reexamination. The decision, noted that the second reexamination "was not filed for purposes of harassment, but rather to address a substantial new question of patentability, which had not been considered in the [first]... Reexamination," [17] and "that plaintiff has provided no evidence establishing that the purpose of the [second] Reexamination was to harass the patent owner."[18] This dismissal was upheld by the Court. The Court stated that "no [final] decision in the [first] Reexamination was made regarding whether the four catalogs qualify as prior art. Thus, in allowing the [second] Reexamination to proceed, the PTO is neither invoking burdensome procedures to harass a patent holder, nor violating 35 U.S.C. § 303(a)." [19]

In this instance, the present '7273 request is the second request by the same third party requester, as was the case in *Heinl*. The examiner issued a ten page order for reexamination detailing the substantial new questions presented by the request. Further, as pointed out above, the request included a lengthy Cunningham declaration directed towards supporting the rejections made based on the prior art supplied in the first two requests for reexamination and addressing the patent owner's position; thus, the present request provided evidence of the applicability of the references employed by the examiner. Therefore, the presentation in the instant request clearly cannot be viewed as frivolous and for the purpose of harassment, but rather, as raising legitimate concerns as to the patent. While the petition does discuss the lengthy prior activity in the reexamination of the patent, etc., the petition has provided no evidence to make it "clear that the second or subsequent request was filed for purposes of harassment of the patent owner." [20] There is no evidence provided to make it clear that the requester purposefully delayed presentation of materials/arguments, rather than presenting same as requester deemed same to be appropriate and needed for presentation (e.g., to address a matter/issue raised in the prosecution). Accordingly, as was the case in *Heinl*, there is no basis for making a finding of harassment in this instance.

Petitioner argues that actions, including litigation and reexamination requests, involving patent No. 5,288,393, sharing a common specification with the instant '126 patent, should be taken into account as establishing a pattern of harassment and showing a deliberate long delay in presenting prior art known to the requester to the attention of the Office. However, as pointed out above, the examiner issued a ten page order for reexamination detailing the substantial new questions presented by the request in this reexamination proceeding, and it is in the public interest to resolve those questions, regardless of whatever activity may, or may not, have taken place in the companion patent.

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[17] *Heinl v. Godici*, 143 F.Supp.2d at 595.

[18] *Heinl v. Godici*, 143 F.Supp.2d at 603

[19] *Heinl v. Godici*, 143 F.Supp.2d at 603

[20] Quotation from MPEP 2240, *supra*.

2. While suspension of the '7273 proceeding is not requested in patent owner's petition, the issue will be briefly addressed. As pointed out in MPEP 2283 II, When Proceeding Is Suspended:

> "A suspension will only be granted in extraordinary instances, because of the statutory requirements that examination proceed with 'special dispatch.'"

As to a suspension based on harassment in this instance, MPEP 2240 requires that it must appear "clear" that the second or subsequent request was filed "for purposes of" harassment of the patent owner. Such has not been shown to be the case in the instant situation, as discussed above.

It is further to be observed that even if the present '7273 proceeding were suspended, it is a public record. It would be the responsibility of the Office to address, in the first and second reexamination proceedings (which have been merged), any issue bearing on the patentability of the patent that is raised in the present reexamination proceeding. The Office could not ignore any such issues, given the public interest in resolving any issues of patentability of patent claims. Further, it would be a waste of resources to prevent addressing legitimate issues raised in this reexamination proceeding, and requiring parties to wait until a reexamination certificate issues for the pending merged reexamination proceeding of the '5924 and '6518 reexaminations, and only then to address the issues raised in the present reexamination request.

3. As noted above, petitioner points out that with "literally hundreds of references ... to select from," the "potential for further abuse in selecting from among a plethora of references ... [that the requesters] have know for years for future harassing requests becomes self-evident." Addressing this point, parties may take note of the Office's *Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending*; Notice, 1292 *Off. Gaz. Pat. Office 20* (March 1, 2005). As to the filing of any future requests for reexamination of the '126 patent while the already-filed three reexaminations are pending, such future requests must clearly point out how any "substantial new question of patentability" presented is different than that raised in the three pending reexamination proceedings. If only prior art used in the three pending reexaminations is used in a future request, it must be clearly explained how that prior art is being presented/viewed in a new light, or in a different way, as compared with its use in the earlier examination(s), in view of a material new argument or interpretation presented in the request. Such presentation/viewing of prior art in a new light, or in a different way, is discussed in *Ex parte Chicago Rawhide*, 223 USPQ 351 (Bd. Pat. App. & Inter. 1984).

4. Petitioner urges that there is a pressing need for conclusion of reexamination in regard to the instant '126 patent in view of the suspension of litigation regarding the patent. Accordingly, the reexamination proceeding is being forwarded to the Technology Center with direction to immediately issue a decision merging the '7273 proceeding with the ongoing merged reexamination proceeding for the '5924 and '6518 reexaminations. The immediate merger of the proceedings is to be carried out in order to provide *de minimus* delay after the issuance of this decision.

Pursuant to 37 CFR 1.550(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."

Accordingly, the instant ordered reexamination proceeding is ready to be merged with two earlier reexaminations (90/005,924 and 90/006,518) which have already been merged. In order to address patent owner's concern for delay raised in the petition, as well as the statutory dictate (37 U.S.C. 305) for "special dispatch within the Office," the merger decision is to be issued by the Technology Center immediately after receipt of the reexamination proceeding from the Office of Patent Legal Administration.

CONCLUSION

1. For the reasons given above, the patent owner petition filed January 25, 2005, is dismissed.

2. The instant reexamination proceeding, and jurisdiction thereover, is being transmitted to Technology Center 1700 for prompt merger of the instant '7273 reexamination proceeding with the already merged proceeding of the 90/005,924 and 90/006,518 reexaminations.

3. Telephone inquiries related to this decision should be directed to Hiram Bernstein at 571-272-7707, or to the undersigned at 571-272-7710.

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

5-10-05
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/005,924; 90/006,518; 90/007,273	02/06/2001	5837126	39591-039	2910

7590 05/10/2005

Gregory F. Wirzbicki
Patent Department
Union Oil Company of California
1150 CONNECTICUT AVENUE, NW SUITE 1025
WASHINGTON, DC 20036

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/10/2005

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

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CST

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Robert L. Price McDermott, Will & Emery 600 13th Street, NW Washington, DC 20005-3096	(for Third Party)
Michael S. Marcus Morgan & Finnegan, L.L.P. 1775 Eye Street, N.W., Suite 400 Washington, DC 20006	(for Third Party)
In re Jessup et al Reexamination Proceeding Control No. 90/005,924 Filed: February 6, 2001 For: U.S. Patent 5,837,126 In re Jessup et al Reexamination Proceeding Control No. 90/006,518 Filed: January 17, 2003 For: U.S. Patent 5,837,126 In re Jessup et al Reexamination Proceeding Control No. 90/007,273 Filed: October 29, 2004 For: U.S. Patent 5,837,126	**DECISION MERGING REEXAMINATION PROCEEDINGS**

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

BACKGROUND

1. United States Patent 5,837,126, issued November 17, 1998, is the subject of Reexamination Control Nos. 90/005,924; 90/006,518 and 90/007,273.

2. A first request for reexamination, assigned Reexamination Control No. 90/005,924 ('5924), was filed February 6, 2001 by Robert L. Price of McDermott, Will and Emery. The request urged that a substantial new question of patentability was raised by the teachings of (a) SAE Paper No. 730474, "An Evaluation of the Performance and Emissions of a CRF Engine Equipped with a Prechamber"; (b) "Carburetor Evaporation Losses", SAE Paper No. 12B; (c) CRC Report No. 510, "1978 Fuel Rating Program: Road Octane Performance in 1978 Model Cars"; (d) CRC Report No. 477, "1973 CRC Fuel Rating Program Part I: Road Octane Performance in 1973 Model Cars"; (e) CRC Report No. 494, "1975 CRC Fuel Rating Program: Road Octane Performance in 1975 Model Cars"; (f) File History of U.S. Patent 4,812,146 to P.J. Jessup; (g) SAE Paper No. 730616, "Gasolines for Low-Emission Vehicles"; (h) API Publication 4310; (i) California Air Resources Board Publication #SS-86-01, "California Perspective on Controlling Gasoline Evaporative Emissions"; (j) Kirk-Othmer Encyclopedia of Chemical Technology, Third Edition; (k) "A New Approach to Blending Octanes", Healy et al; (l) "The Interaction Approach to Gasoline Blending", William E. Morris; (m) SAE Publication 841206, Schmidt et al; (n) SAE Publication 841210, Dorn et al; and (o) GAO Report to Chairman, Subcommittee on Oversight and Investigations, Committee on Energy and Commerce, House of Representatives.

3. Patent owner filed a petition under 37 CFR 1.182 and 1.183 on March 28, 2001 requesting that the Commissioner waive the provisions of 37 CFR 1.530 and permit entry and consideration of this petition prior to the initial determination of the request for reexamination.

4. The petition filed on March 28, 2001 was dismissed on April 30, 2001.

5. The request for reexamination for '5924 was denied on May 2, 2001.

6. Robert L. Price of McDermott, Will and Emery petitioned for reversal of the examiner's decision denying the request for reexamination on June 1, 2001.

7. The petition for reversal of the examiner's decision denying the request for reexamination was granted on January 24, 2002. The request for reexamination for '5924 was thus granted.

8. A first Office action for '5924 was mailed on June 26, 2002. A supplemental Office action was subsequently mailed on July 25, 2002.

9. Patent owner timely responded to the first Office action on September 30, 2002 (certificate of mailing September 25, 2002).

10. A second request for reexamination, assigned Reexamination Control No. 90/006,518 ('6518), was filed January 17, 2003 by Michael S. Marcus of Morgan & Finnegan, LLP. The request urged that a substantial new question of patentability was raised by the teachings of (a) the January 17, 1972 Oil and Gas Journal publication ("GM-1"), either alone or in view of an August 1987 Notice of Proposed Rule Making published by the EPA ("the EPA RVP limits"); (b) the October 2, 1972 Oil and Gas Journal publication ("GM-2"), either alone or in view of the May 1973 Adams API publication ("Adams") and/or the EPA RVP limits; (c) GM-1, either alone or in view of the EPA RVP limits, together with the Kirk-Othmer publication describing gasoline blending and (d) GM-2, either alone or in view of Adams and/or the EPA RVP limits, together with Kirk-Othmer.

11. Reexamination was ordered for '6518 on March 18, 2003.

12. A Decision Merging Reexamination Control Nos. 90/005,924 and 90/006,518 was mailed on July 21, 2003.

13. A non-final Office action for the merged proceeding was mailed on March 22, 2004.

14. Patent owner responded to the non-final action on May 12, 2004.

15. A third request for reexamination, assigned Reexamination Control No. 90/007,273 ('7273), was filed October 29, 2004 by Michael S. Marcus of Morgan & Finnegan, LLP. The request urged that a substantial new question of patentability was raised by the teachings of (a) CRC Report No. 464 describing the Fuel 253 Specifications, either alone or in view of the Kirk-Othmer publication describing gasoline blending and (b) CRC Report No. 493 describing the Fuel 287 Specifications, either alone or in view of the Kirk-Othmer publication describing gasoline blending.

16. Reexamination was ordered for '7273 on January 10, 2005.

DISCUSSION

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

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

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

> After the patent owner and second requester have been given an opportunity to file a statement and reply, respectively, the second reexamination proceeding will be merged with the first reexamination proceeding, and prosecution will then continue at the most advanced point possible for the first proceeding. It should be noted that if a final rejection has been issued in the first proceeding, prosecution will be ordinarily be reopened where any of the new patents or printed publications presented in the second request are applied to the merged proceeding in a new ground of rejection.

DECISION

I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. 1.565(c), the 90/005,924; 90/006,518 and 90/007,273 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

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

III. CONDUCT OF MERGED PROCEEDING

The reexamination files shall be forwarded to the examiner for consideration of the Request for Reexamination in the '7273 reexamination proceeding, as well as consideration of the response, submitted May 12, 2004, in the merged reexamination proceeding including '5924 and '6518.

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for <u>all</u> files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, **filed in triplicate**, each bearing a signature and identifying data for <u>all</u> files, for entry into each file. All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control Nos. 90/005,924; 90/006,518 and 90/007,273 as:

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

Also, until further notice, courtesy copies of all correspondence will be mailed to the California Attorney General's Office.

CONCLUSION

Reexamination Control Nos. 90/005,924; 90/006,518 and 90/007,273 are merged. The merged reexamination files are being forwarded to the examiner for preparation of an Office action, to be issued in due course.

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,277	11/01/2004	6665048	C5250379	4376

1333 7590 02/23/2007

PATENT LEGAL STAFF
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ROCHESTER, NY 14650-2201

EXAMINER

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(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

In re Reexamination Proceedings
Daniel Gelbart
Control No. 90/007277
Filed: November 1, 2004
Attorney Docket No. C5250379

DECISION GRANTING PETITION

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on January 16, 2007, for entry of late papers based upon unintentional delay.

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

The petition is **granted.**

DECISION

The requisite fee for a petition under 37 CFR 1.137(b), for other than a small entity is $1500 as set forth in 37 CFR 1.17(m). The petition fee of $1320.00, which accompanied the present petition under 37 CFR 1.137(b) was thus deficient $180.00. The $180.00 fee deficiency was charged to petitioner's Deposit Account No. 05-0225, in accordance with petitioner's authorization on page 2, fee section of the January 16, 2007 petition to pay for any additional necessary fees.

37 CFR 1.137(b) states:

> "(b) *Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.55(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by: (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in § 1.17(m); (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and (4) Any terminal disclaimer (and fee as set forth in § 1.20(d) required pursuant to paragraph (d) of this section."

A review of the present petition reveals that it includes correspondence denoted as "Statement of the Substance of the Interview" and "Amendment" mailed January 16, 2007. As such, petitioner has provided the response required by 37 CFR 1.137(b) (item 1). The requisite unintentional delay fee for other than a small entity (item 2) has been satisfied; see above. The petition contains the proper statement for unintentional delay in filing the required response (item 3).

Accordingly, the petition is complete, and complies with the provisions of 37 CFR 1.137(b).

CONCLUSION

1. The petition to accept unintentionally delayed late papers is **granted.**

2. Jurisdiction over the reexamination proceedings is being returned to the Central Reexamination Unit (CRU) for further examination and consideration, in due course, of the response filed in conjunction with the petition to revive.

3. Any further communication as to the merits of the reexamination proceeding should be directed to examiner David E. Harvey in the CRU, who can be reached at (571) 272-7345

4. Telephone inquiries with regard to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759.

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

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MAILED

AUG 1 8 2005

REEXAM UNIT

Daniel J. Polglaze
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(For Requester)

In re Michael E. Woolford et al. Reexamination Proceeding Control No.: 90/007,278 Filed: November 2, 2004 For: U.S. Patent No.: 6,312,197	DECISION TO *SUA SPONTE* MERGE *EX PARTE* REEXAMINATION PROCEEDINGS AND DISMISS PETITION TO VACATE REEXAMINATION ORDER AND TERMINATE REEXAMINATION
In re Michael E. Woolford et al. Reexamination Proceeding Control No.: 90/007,386 Filed: January 21, 2005 For: U.S. Patent No.: 6,312,197	

This is a decision on the March 16, 2005 and May 17, 2005 patent owner petitions under 37 CFR 1.181(a)(3), to vacate the orders granting the two above-captioned reexamination proceedings. Requester oppositions to the two patent owner petitions were received March 24, 2005 and June 3, 2005, respectively.

This is also a decision to *sua sponte* merge the two above-captioned *ex parte* reexamination proceedings into a single proceeding.

The two proceedings, the two petitions, and the two oppositions are before the Office of Patent Legal Administration.

SUMMARY

For the reasons set forth below, the two petitions under 37 CFR 1.181(a)(3) are dismissed. The January 31, 2005 order granting reexamination in the 90/007,278 proceeding and the April 4, 2005 order granting reexamination in the 90/007,386 proceeding remain intact.

Pursuant to 37 CFR 1.565(c), reexamination Control Nos. 90/007,278 and 90/007,386 are *sua sponte* merged into a single proceeding.

A single decision is being issued to address the above matters.

REVIEW OF FACTS

1. U.S. Patent No. 6,312,197 (the '197 patent) issued on February 6, 2001.
2. A first request for reexamination of the '197 patent was filed by a third party requester on November 2, 2004. The first request was assigned control No. 90/007,278 (the '7278 proceeding).
3. A second request for reexamination of the '197 patent was filed by a third party requester on January 21, 2005. The second request was assigned control No. 90/007,386 (the '7386 proceeding).
4. Reexamination was ordered for the '7278 proceeding on January 31, 2005.
5. A petition under 37 CFR 1.181(a)(3) to vacate the '7278 reexamination order was received from the patent owner on March 16, 2005.
6. An opposition to the March 16, 2005 patent owner petition to vacate was received from the '7278 requester on March 24, 2005.
7. Reexamination was ordered for the '7386 proceeding on April 4, 2005.
8. A petition under 37 CFR 1.181(a)(3) to vacate the '7386 reexamination order was received from the patent owner on May 17, 2005.
9. An opposition to the May 17, 2005 patent owner petition to vacate was received from the '7386 requester on June 3, 2005.
10. A patent owner's statement under 37 CFR 1.530 has not been received in the '7278 and '7386 reexamination proceedings.

DECISION ON PETITIONS

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."

MPEP 2246, Part I, states, in part:

"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 no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained. "Appropriate circumstances" under 37 CFR 1.181(a)(3) exist to vacate the order granting reexamination where, for example:

...

"(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).

"As to (E) above, the decision of *In re Recreative Technologies Corp.*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996) is to be noted."

MPEP 2242, Part II.A., states, in part:

"A "substantial new question of patentability" is not raised by prior art presented in a reexamination request if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

"In deciding whether to grant a request for reexamination of a patent, the examiner should check the patent's file history to ascertain whether any of the prior art now advanced by requester was previously cited/considered in an earlier concluded Office examination of the patent (e.g., in the examination of the application for the patent)."

In this instance, the patent owner petitioner urges that the Office has previously considered (in an earlier concluded examination of the patent) the questions of patentability of the '197 patent claims on which the two orders for reexamination were based, and that the previous consideration was favorable to the patent owner. Accordingly, the patent owner petitions that the '7278 and '7386 orders for reexamination of the '197 patent be vacated as *ultra vires* actions taken by the Office.

Review of the requests for reexamination

The '7278 Request for Reexamination, filed November 3, 2004, urges that Keystone Retaining Walls (Beautiful Do-It Yourself Retaining Walls! (1989)) raises a substantial new question of patentability (SNQ) with respect to claims 1-8 of the '197 patent. Specifically, the Request urges that the Keystone reference anticipates the claims and has a publication date earlier than the '197 filing date.

The '7386 Request for Reexamination, filed January 21, 2005, urges that Keystone Retaining Walls (Beautiful Do-It Yourself Retaining Walls! (1989)), Keystone Retaining Walls (Introducing the Keystone Retaining Wall System (1989)) and Johnson Block (Johnson Block Retaining Wall Systems (1989)) raise substantial new questions of patentability with respect to claims 1-8 of the '197 patent. Specifically, the Request urges that the two Keystone references each individually anticipates the claims, or renders the claims obvious in view of Johnson Block, and have publication dates earlier than the '197 filing date.

Both requests allege that the dates of the Keystone references are no later than March 1989 for one, and May 1989 for the other, the dates being established by trademark registration documents and by affidavits of Keystone sales representatives.

Review of the Patent Owner's Argument for Vacatur

Both petitions admit that the Keystone references would anticipate the indicated claims if the references were prior art. The petitions argue that the references are undated and have never had a date of publication established. The petitioner alleges that the source of the references pays substantial royalties to license the patented subject matter (of the '197 patent), and this is submitted to be evidence that the source of the references does not believe it could antedate the patent.

Further, both petitions state that "both documents are of record *and were considered* during the prosecution of Serial No. 09/497,250 ('the '250 application'), which subsequently issued as the '197 patent." The evidence proffered for this assertion is the paper entitled "Comments On Statement Of Reasons For Allowance" entered in the '250 application on March 20, 2000.

The petitions also argue, as to the impropriety of other references in the request, on the grounds that those references were listed on information disclosure statements initialed by the examiner, and that all those references are secondary references for obviousness patentability issues.

Review of the orders for reexamination

In the orders granting the reexamination request, the examiner stated that each of the Keystone references were cited but never applied in the '197 prosecution. This appears to be correct from a review of the '197 file.

Evaluation as to any prior consideration of the references:

A review of the record reveals that all of the references which the orders for reexamination cite as raising substantial new questions of patentability were cited in the '197 prosecution; however, none of them were applied, nor were they commented upon by the examiner. The petition urges that the fact that the examiner initialed the citations in the '197 prosecution evidences the examiner's consideration such that those references cannot be the basis for a new question of patentability. This is an incorrect reading of the law. 35 U.S.C. 303(a) states, in part, "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."

The petition further urges that the precise question, raised and addressed in the orders, of whether the references were prior art was considered by the examiner. Petitioner cites as evidence of this - the paper titled "Comments On Statement Of Reasons For Allowance" filed on March 20, 2000, in the 09/160,916 file, in which the applicant stated "[t]he Keystone brochure referred to in the 'Reasons for Allowance' is not the brochure which bears the copyright office date stamp of 'June 27, 1988', which is referred to in the earlier Office Action, but is the undated brochure which was attached to the 'Statutory Declaration of All Pfannestein dated August 28, 1998' filed with the Australian litigation between Keystone and Anchor Wall Systems" and "[t]he issue of the undated brochure and various related allegations of its purported author (Keystone) have previously been discussed with the Examiner in the prosecution of the parent case."

Although the Comments On Statement of Reasons For Allowance further states that '[t]hese remarks are being submitted with the consent of and at the request of Examiner Taylor," the record provides no corroborating evidence that the examiner reviewed the comments or agreed with them, much less requested them. These applicant comments are deemed to be self serving, and they were delayed until after the close of prosecution, with no further comment by the examiner. Accordingly, the comments are not deemed to be persuasive that the precise question of whether the issue of the date of the references purportedly presenting a substantial new question of patentability was ever evaluated in view of the documents suggesting a date of March 1989.

As to the issue of any oral statement the examiner might have made, and any weight to be accorded same, oral statements are open to misinterpretation. Accordingly, 37 CFR 1.2 clearly states:

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

As to the examiner's not having commented on applicant's March 20, 2000 "Comments On Statement Of Reasons For Allowance," 37 C.F.R. 104(e) states that:

> "Failure by the examiner to respond to any statement commenting on reasons for allowance does not give rise to any implication."

As to whether the issue of the date of publication may present a substantial new question of patentability, this is readily answered by the opinion in *Heinl v Godici*, (E.D.Va. 2001), 143 F. Supp. 2d 593, which found that art cited in the original patent proceedings, but for which no findings as to their status as prior art were made in the original proceedings, could raise a substantial new question of patentability in light of evidence as to their status as prior art.

It is further to be noted that the *Heinl* opinion further states that "Courts are uniform in recognizing that the decision to grant reexaminations of a patent is preliminary, not final agency action." *Heinl*, 143 F. Supp. 2d at 597. Both the fact that the issue as to the status of the cited references as prior art has never been determined in the prior proceedings, and the fact that an order granting reexamination is not a final agency action, weigh in favor of allowing the reexamination proceedings to continue.

Finding:

In *Heinl*, 143 F.Supp.2d at 601, the Court stated, in a decision seeking termination of reexamination based on the absence of a new question of patentability:

> "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 determination that the questions of patentability raised in the January 21, 2005 and April 4, 2005 requests were not previously considered in an earlier concluded examination of the patent. The petition is thus dismissed, and the two reexamination proceedings will continue.

DISCUSSION REGARDING MERGER

Under 37 CFR 1.565(c):

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

As evidenced by the above review of facts, reexamination control No. 90/007,278 and reexamination control No. 90/007,386 are currently pending. Since the order to reexamine has been mailed in both reexamination proceedings, a decision under 37 CFR 1.565(c) is timely.

DECISION MERGING REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-captioned 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

The patent owner is required to maintain identical amendments in the two 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(c).

A review of the reexamination file for the proceedings of reexamination control No. 90/007,278 and 90/007,386 shows that, in both proceedings, original patent claims 1-8 are present and no claims are added or altered by amendment. Accordingly, the claims are identical in number and are identical as to content in both proceedings.

III. Conduct of the Merged Proceeding

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

2. Any response by the 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 two requesters, who will also be sent copies of Office actions.

3. Where a paper is filed which requires payment of a fee (e.g., petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appellant brief, 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.

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

CONCLUSION

1. The petitions under 37 CFR 1.181 are dismissed.

2. The '7278 and '7386 reexamination proceedings are merged into a single proceeding.

3. The reexamination file is being forwarded to the Technology Center for the issuance of a first Office action (for the merged proceeding) in due course.

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

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

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AUG 1 8 2005

REEXAM UNIT

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(For Requester)

In re Michael E. Woolford et al. Reexamination Proceeding Control No.: 90/007,280 Filed: November 2, 2004 For: U.S. Patent No.: 6,183,168 In re Michael E. Woolford et al. Reexamination Proceeding Control No.: 90/007,387 Filed: January 21, 2005 For: U.S. Patent No.: 6,183,168	DECISION TO *SUA SPONTE* MERGE *EX PARTE* REEXAMINATION PROCEEDINGS AND DISMISS PETITION TO VACATE REEXAMINATION ORDER AND TERMINATE REEXAMINATION

This is a decision on the March 16, 2005 and May 17, 2005 patent owner petitions under 37 CFR 1.181(a)(3), to vacate the orders granting the two above-captioned reexamination proceedings. Requester oppositions to the two patent owner petitions were received March 24, 2005 and June 3, 2005, respectively.

This is also a decision to *sua sponte* merge the two above-captioned *ex parte* reexamination proceedings into a single proceeding.

The two reexamination proceedings, the two petitions, and the two oppositions are before the Office of Patent Legal Administration.

SUMMARY

For the reasons set forth below, the two petitions under 37 CFR 1.181(a)(3) are dismissed. The January 31, 2005 order granting reexamination in the 90/007,280 proceeding and the April 4, 2005 order granting reexamination in the 90/007,387 proceeding remain intact.

Pursuant to 37 CFR 1.565(c), reexamination Control Nos. 90/007,280 and 90/007,387 are *sua sponte* merged into a single proceeding.

A single decision is being issued to address the above matters.

REVIEW OF FACTS

1. U.S. Patent No. 6,183,168 (the '168 patent) issued on February 6, 2001.
2. A first request for reexamination of the '168 patent was filed by a third party requester on November 2, 2004. The first request was assigned control No. 90/007,280 (the '7280 proceeding).
3. A second request for reexamination of the '168 patent was filed by a third party requester on January 21, 2005. The second request was assigned control No. 90/007,387 (the '7387 proceeding).
4. Reexamination was ordered for the '7280 proceeding on January 31, 2005.
5. A petition under 37 CFR 1.181(a)(3) to vacate the '7280 reexamination order was received from the patent owner on March 16, 2005.
6. An opposition to the March 16, 2005 patent owner petition to vacate was received from the '7280 requester on March 24, 2005.
7. Reexamination was ordered for the '7387 proceeding on April 4, 2005.
8. A petition under 37 CFR 1.181(a)(3) to vacate the '7387 reexamination order was received from the patent owner on May 17, 2005.
9. An opposition to the May 17, 2005 patent owner petition to vacate was received from the '7387 requester on June 3, 2005.
10. A patent owner's statement under 37 CFR 1.530 has not been received in the '7280 and '7387 reexamination proceedings.

DECISION ON PETITIONS

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."

MPEP 2246, Part I, states, in part:

> "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 no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained. "Appropriate circumstances" under 37 CFR 1.181(a)(3) exist to vacate the order granting reexamination where, for example:
>
> ...
>
> "(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).
>
> "As to (E) above, the decision of *In re Recreative Technologies Corp.*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996) is to be noted."

MPEP 2242, Part II.A., states, in part:

> "A "substantial new question of patentability" is not raised by prior art presented in a reexamination request if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).
>
> "In deciding whether to grant a request for reexamination of a patent, the examiner should check the patent's file history to ascertain whether any of the prior art now advanced by requester was previously cited/considered in an earlier concluded Office examination of the patent (e.g., in the examination of the application for the patent)."

In this instance, the patent owner petitioner urges that the Office has previously considered (in an earlier concluded examination of the patent) the questions of patentability of the '168 patent claims on which the two orders for reexamination were based, and that the previous consideration was favorable to the patent owner. Accordingly, the patent owner petitions that the '7280 and '7387 orders for reexamination of the '168 patent be vacated as *ultra vires* actions taken by the Office.

Review of the requests for reexamination

The '7280 Request for Reexamination, filed November 3, 2004, urges that Keystone Retaining Walls (Beautiful Do-It Yourself Retaining Walls! (1989)) raises a substantial new question of patentability (SNQ) with respect to claims 1-14 of the '168 patent. Specifically, the Request urges that the Keystone reference anticipates the claims and has a publication date earlier than the '168 filing date.

The '7387 Request for Reexamination, filed January 21, 2005, urges that Keystone Retaining Walls (Beautiful Do-It Yourself Retaining Walls! (1989)), Keystone Retaining Walls (Introducing the Keystone Retaining Wall System (1989)) and Johnson Block (Johnson Block Retaining Wall Systems (1989)) raise substantial new questions of patentability with respect to claims 1-14 of the '168 patent. Specifically, the Request urges that the two Keystone references each individually anticipates the claims, or renders the claims obvious in view of Johnson Block, and have publication dates earlier than the '168 filing date.

Both requests allege that the dates of the Keystone references are no later than March 1989 for one, and May 1989 for the other, the dates being established by trademark registration documents and by affidavits of Keystone sales representatives.

Review of the Patent Owner's Argument for Vacatur

Both petitions admit that the Keystone references would anticipate the indicated claims if the references were prior art. The petitions argue that the references are undated and have never had a date of publication established. The petitioner alleges that the source of the references pays substantial royalties to license the patented subject matter (of the '168 patent), and this is submitted to be evidence that the source of the references does not believe it could antedate the patent.

Further, both petitions state that "both documents are of record *and were considered* during the prosecution of Serial No. 09/497,250 ('the '250 application'), which subsequently issued as the '168 patent." The evidence proffered for this assertion is the paper entitled "Comments On Statement Of Reasons For Allowance" entered in the '250 application on March 20, 2000.

The petitions also argue, as to the impropriety of other references in the request, on the grounds that those references were listed on information disclosure statements initialed by the examiner, and that all those references are secondary references for obviousness patentability issues.

Review of the orders for reexamination

In the orders granting the reexamination request, the examiner stated that each of the Keystone references were cited but never applied in the '168 prosecution. This appears to be correct from a review of the '168 file.

Evaluation as to any prior consideration of the references:

A review of the record reveals that all of the references which the orders for reexamination cite as raising substantial new questions of patentability were cited in the '168 prosecution; however, none of them were applied, nor were they commented upon by the examiner. The petition urges that the fact that the examiner initialed the citations in the '168 prosecution evidences the examiner's consideration such that those references cannot be the basis for a new question of patentability. This is an incorrect reading of the law. 35 U.S.C. 303(a) states, in part, "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."

The petition further urges that the precise question, raised and addressed in the orders, of whether the references were prior art was considered by the examiner. Petitioner cites as evidence of this - the paper titled "Comments On Statement Of Reasons For Allowance" filed on March 20, 2000, in the 09/160,916 file, in which the applicant stated "[t]he Keystone brochure referred to in the 'Reasons for Allowance' is not the brochure which bears the copyright office date stamp of 'June 27, 1988', which is referred to in the earlier Office Action, but is the undated brochure which was attached to the 'Statutory Declaration of All Pfannestein dated August 28, 1998' filed with the Australian litigation between Keystone and Anchor Wall Systems" and "[t]he issue of the undated brochure and various related allegations of its purported author (Keystone) have previously been discussed with the Examiner in the prosecution of the parent case."

Although the Comments On Statement of Reasons For Allowance further states that '[t]hese remarks are being submitted with the consent of and at the request of Examiner Taylor," the record provides no corroborating evidence that the examiner reviewed the comments or agreed with them, much less requested them. These applicant comments are deemed to be self serving, and they were delayed until after the close of prosecution, with no further comment by the examiner. Accordingly, the comments are not deemed to be persuasive that the precise question of whether the issue of the date of the references purportedly presenting a substantial new question of patentability was ever evaluated in view of the documents suggesting a date of March 1989.

As to the issue of any oral statement the examiner might have made, and any weight to be accorded same, oral statements are open to misinterpretation. Accordingly, 37 CFR 1.2 clearly states:

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

As to the examiner's not having commented on applicant's March 20, 2000 "Comments On Statement Of Reasons For Allowance," 37 C.F.R. 104(e) states that:

> "Failure by the examiner to respond to any statement commenting on reasons for allowance does not give rise to any implication."

As to whether the issue of the date of publication may present a substantial new question of patentability, this is readily answered by the opinion in *Heinl v Godici*, (E.D.Va. 2001), 143 F. Supp. 2d 593, which found that art cited in the original patent proceedings, but for which no findings as to their status as prior art were made in the original proceedings, could raise a substantial new question of patentability in light of evidence as to their status as prior art.

It is further to be noted that the *Heinl* opinion further states that "Courts are uniform in recognizing that the decision to grant reexaminations of a patent is preliminary, not final agency action." *Heinl*, 143 F. Supp. 2d at 597. Both the fact that the issue as to the status of the cited references as prior art has never been determined in the prior proceedings, and the fact that an order granting reexamination is not a final agency action, weigh in favor of allowing the reexamination proceedings to continue.

Finding:

In *Heinl*, 143 F.Supp.2d at 601, the Court stated, in a decision seeking termination of reexamination based on the absence of a new question of patentability:

> "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 determination that the questions of patentability raised in the January 21, 2005 and April 4, 2005 requests were not previously considered in an earlier concluded examination of the patent. The petition is thus dismissed, and the two reexamination proceedings will continue.

DISCUSSION REGARDING MERGER

Under 37 CFR 1.565(c):

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

As evidenced by the above review of facts, reexamination control No. 90/007,280 and reexamination control No. 90/007,387 are currently pending. Since the order to reexamine has been mailed in both reexamination proceedings, a decision under 37 CFR 1.565(c) is timely.

DECISION MERGING REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-captioned 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

The patent owner is required to maintain identical amendments in the two 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(c).

A review of the reexamination file for the proceedings of reexamination control No. 90/007,280 and 90/007,387 shows that, in both proceedings, original patent claims 1-14 are present and no claims are added or altered by amendment. Accordingly, the claims are identical in number and are identical as to content in both proceedings.

III. Conduct of the Merged Proceeding

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

2. Any response by the 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 two requesters, who will also be sent copies of Office actions.

3. Where a paper is filed which requires payment of a fee (e.g., petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appellant brief, 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.

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

CONCLUSION

1. The petitions under 37 CFR 1.181 are dismissed.

2. The '7280 and '7387 reexamination proceedings are merged into a single proceeding.

3. The reexamination file is being forwarded to the Technology Center for the issuance of a first Office action (for the merged proceeding) in due course.

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

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

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JAN 18 2006

REEXAM UNIT

In re Michael E. Woolford et al.
Reexamination Proceeding
Control No.: 90/007,280
Filed: November 2, 2004
For: U.S. Patent No.: 6,183,168

In re Michael E. Woolford et al.
Reexamination Proceeding
Control No.: 90/007,387
Filed: January 21, 2005
For: U.S. Patent No.: 6,183,168

: DECISION DENYING
: PETITION TO VACATE
: REEXAMINATION ORDERS
: AND TERMINATE
: REEXAMINATIONS

This is a decision on the October 18, 2005 patent owner petition under 37 CFR 1.181(a)(3), seeking supervisory review and final agency decision on the August 18, 2005 decision dismissing the petition to vacate the orders granting the two above-captioned reexamination proceedings. A requester opposition to the patent owner petition was received November 1, 2005.

The merged proceeding of reexamination Control Numbers 90/007,280 and 90/007,387, the present petition, and the present opposition are before the Office of Patent Legal Administration.

For the reasons set forth below, the petition under 37 CFR 1.181(a)(3) is denied as to the request to vacate the orders for the 90/007,278 and 90/007,387 proceedings. In addition, the petition is granted to the extent that (a) the prior decision has been fully reconsidered and (b) the instant decision is designated as a final agency decision.

The January 31, 2005 order granting reexamination in the 90/007,280 proceeding and the April 4, 2005 order granting reexamination in the 90/007,387 proceeding remain intact. Given the August 18, 2005 merger of the two proceedings, a single decision is being issued for the two proceedings.

REVIEW OF FACTS

1. U.S. Patent No. 6,183,168 (the '168 patent) issued on February 6, 2001.
2. A first request for reexamination of the '168 patent was filed by a third party requester on November 2, 2004. The first request was assigned control No. 90/007,280 (the '7280 proceeding).
3. A second request for reexamination of the '168 patent was filed by a third party requester on January 21, 2005. The second request was assigned control No. 90/007,387 (the '7387 proceeding).
4. Reexamination was ordered for the '7280 proceeding on January 31, 2005.
5. A petition under 37 CFR 1.181 to vacate the '7280 reexamination order was received from the patent owner on March 16, 2005.
6. An opposition to the March 16, 2005 patent owner petition to vacate was received from the '7280 requester on March 24, 2005.
7. Reexamination was ordered for the '7387 proceeding on April 4, 2005.
8. A petition under 37 CFR 1.181 to vacate the '7387 reexamination order was received from the patent owner on May 17, 2005.
9. An opposition to the May 17, 2005 patent owner petition to vacate was received from the '7387 requester on June 3, 2005.
10. On August 18, 2005, the Office mailed a decision (a) dismissing the two petitions to vacate the orders, and (b) merging the two reexamination proceedings.
11. The present petition under 37 CFR 1.181(a)(3) seeking supervisory review and a final agency decision concerning the petition by patent owner to vacate the order granting reexamination was received in the present merged proceeding on October 18, 2005.
12. An opposition to the October 18, 2005 petition was received from the '7280 third party requester on November 1, 2005.
13. A patent owner's statement under 37 CFR 1.530 has <u>not</u> been received in either of the '7280 and '7387 reexamination proceedings.

DECISION ON PETITION

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."

MPEP 2246, Part I, states, in part:

> "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 no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained. "Appropriate circumstances" under 37 CFR 1.181(a)(3) exist to vacate the order granting reexamination where, for example:
>
> ...
>
> "(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).
>
> "As to (E) above, the decision of *In re Recreative Technologies Corp.*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996) is to be noted."

MPEP 2242, Part II.A., states, in part:

> "A 'substantial new question of patentability' is not raised by prior art presented in a reexamination request if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).
>
> "In deciding whether to grant a request for reexamination of a patent, the examiner should check the patent's file history to ascertain whether any of the prior art now advanced by requester was previously cited/considered in an earlier concluded Office examination of the patent (e.g., in the examination of the application for the patent)."

In this instance, the patent owner petitioner urges that the Office has previously considered (in an earlier concluded examination of the patent) the questions of patentability of the '168 patent claims on which the two orders for reexamination are based, and that the previous consideration was favorable to the patent owner. Accordingly, the patent owner petitions that the '7280 and '7387 orders for reexamination of the '168 patent be vacated as *ultra vires* actions taken by the Office.

Review of the requests for reexamination

The '7280 Request for Reexamination, filed November 3, 2004, urges that Keystone Retaining Walls (Beautiful Do-It Yourself Retaining Walls! (1989)) raises a substantial new question of patentability (SNQ) with respect to claims 1-14 of the '168 patent. Specifically, the Request urges that the Keystone reference anticipates the claims and has a publication date earlier than the '168 filing date.

The '7387 Request for Reexamination, filed January 21, 2005, urges that Keystone Retaining Walls (Beautiful Do-It Yourself Retaining Walls! (1989)), Keystone Retaining Walls (Introducing the Keystone Retaining Wall System (1989)) and Johnson Block (Johnson Block Retaining Wall Systems(1989)) raise substantial new questions of patentability with respect to claims 1-14 of the '168 patent. Specifically, the Request urges that the two Keystone references each individually anticipates the claims, or renders the claims obvious in view of Johnson Block, and have publication dates earlier than the '168 filing date.

Both requests allege that the dates of the Keystone references are no later than March 1989 for one, and May 1989 for the other, the dates being established by trademark registration documents and by affidavits of Keystone sales representatives.

Review of the Patent Owner's Argument for Vacatur

The petition admits that the Keystone references would anticipate the indicated claims if the references were prior art. The petition argues that the references are undated and have never had a date of publication established. The petitioner alleges that the source of the references pays substantial royalties to license the patented subject matter (of the '168 patent), and this is submitted to be evidence that the source of the references does not believe it could antedate the patent.

Further, the petition states that "both documents are of record *and were considered* during the prosecution of Serial No. 09/497,250 ('the '250 application'), which subsequently issued as the '168 patent." The evidence proffered for this assertion is the paper entitled "Comments On Statement Of Reasons For Allowance" entered in the '250 application on March 20, 2000.

The petition also argues the impropriety of applying other references in the request on the grounds that those references were listed on information disclosure statements initialed by the examiner, and that all those references are secondary references for obviousness patentability issues.

Review of the orders for reexamination

In the orders granting the reexamination request, the examiner stated that each of the Keystone references was cited but never applied in the '168 prosecution. This appears to be correct based on a review of the '168 file.

Evaluation as to any prior consideration of the references:

A review of the record reveals that all of the references which the orders for reexamination cite as raising substantial new questions of patentability were cited in the '168 prosecution; however, none of them were applied, nor were they commented upon by the examiner. The petition urges that the fact that the examiner initialed the citations in the '168 prosecution evidences the examiner's consideration - such that those references cannot be the basis for a new question of patentability. This is an incorrect reading of the law. 35 U.S.C. 303(a) states, in part, "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."

The petition further urges that the examiner previously considered the precise question raised and addressed in the orders - of whether the Keystone references were prior art. Petitioner cites as evidence of this - the paper titled "Comments On Statement Of Reasons For Allowance" filed on March 20, 2000, in the '916 file, in which the applicant stated "[t]he Keystone brochure referred to in the 'Reasons for Allowance' is not the brochure which bears the copyright office date stamp of 'June 27, 1988', which is referred to in the earlier Office Action, but is the undated brochure which was attached to the 'Statutory Declaration of All Pfannestein dated August 28, 1998' filed with the Australian litigation between Keystone and Anchor Wall Systems," and "[t]he issue of the undated brochure and various related allegations of its purported author (Keystone) have previously been discussed with the Examiner in the prosecution of the parent case."

Although the Comments On Statement of Reasons For Allowance further state that "[t]hese remarks are being submitted with the consent of and at the request of Examiner Taylor," the record provides no corroborating evidence that the examiner reviewed the comments or agreed with them, much less requested them. These applicant comments are deemed to be self serving, and they were delayed until after the close of prosecution, with no further comment by the examiner. Accordingly, the comments are not deemed to be persuasive that the precise question of the date of the references purportedly presenting a substantial new question of patentability was ever evaluated in view of the documents suggesting a date of March 1989.

As to the issue of any oral statement the examiner might have made, and any weight to be accorded same, oral statements are open to misinterpretation. Accordingly, 37 CFR 1.2 clearly states:

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

As to the examiner's not having commented on applicant's March 20, 2000 "Comments On Statement Of Reasons For Allowance," 37 C.F.R. 104(e) states that:

> "Failure by the examiner to respond to any statement commenting on reasons for allowance does not give rise to any implication."

As to whether the issue of the date of publication may present a substantial new question of patentability, this is readily answered by the opinion in *Heinl v Godici*, (E.D.Va. 2001), 143 F. Supp. 2d 593, which found that art cited in the original patent proceedings, but for which no findings as to their status as prior art were made in the original proceedings, could raise a substantial new question of patentability in light of evidence as to their status as prior art.

It is also to be noted that the *Heinl* opinion further states that "Courts are uniform in recognizing that the decision to grant reexaminations of a patent is preliminary, not final agency action." *Heinl*, 143 F. Supp. 2d at 597. Both the fact that the issue as to the status of the cited references as prior art has never been determined in the prior proceedings, and the fact that an order granting reexamination is not a final agency action, weigh in favor of allowing the reexamination proceedings to continue.

Evaluation of the petitioner's arguments regarding the prior petition decision:

The petitioner argues that the prior decision was premised on two erroneous assumptions, i.e., (1) that the documents under consideration were not adequately considered during the course of prosecution, and (2) that the evidence relied on in finding a significant new question of patentability is being presented in a new light, as compared with the original prosecution. The petitioner argues that both of these premises are incorrect.

Petitioner's argument omits the essential aspect in these proceedings, which is that the evidence now before the Office (that was not so in the original, i.e., application, proceeding) is evidence as to the date the documents were disseminated and made accessible to the public. It is this evidence that casts the documents that are applied against the '168 patent in a new light, i.e. as being prior art rather than indeterminate art. Although the petitioner makes reference to the House Report 107-120[1] indication that the most recent revision to 35 U.S.C. 303 permits reexamination only where there is substantial evidence that the examiner did not properly understand the reference or did not consider a portion of the reference in making his decision, such is not at odds with the evidence before the examiner in this merged reexamination proceeding. Where the examiner in the original prosecution could not determine the date of a reference, and therefore could not sustain a rejection based on that reference because of the absence of a "good" date, evidence subsequently provided in the instant reexamination proceedings as to the date that antedates the date of invention can

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[1] http://thomas.loc.gov/cgi-bin/cpquery/?&dbname=cp107&sid=cp107VYubX&refer=&r_n=hr120.107&item=&sel=TOC_2687&

change the consideration of that reference from consideration of an indeterminate document to consideration of a prior art document.

As alluded to above, this set of facts is directly analogous to those in *Heinl*, 143 F.Supp.2d at 602, in which the court stated, in a decision seeking termination of reexamination based on the absence of a new question of patentability:

> "There, plaintiff did not argue that the examiner should make a finding that the catalogs were not prior art, but rather, he argued that the evidence did not permit the examiner to make any finding regarding their status as prior art. ... Accordingly, the catalogs are not prior art that was previously relied upon to reject a claim, and therefore, their submission in the '275 Reexamination does not bar their submission and consideration in the subsequent '809 Reexamination."

In one of the parent cases to the '168 patent (to which this merged reexamination is directed), the examiner set forth that he could not determine the date of a document which was not clearly identified by the examiner. The record suggests that such unidentified document is a document different from that asserted by the petitioner, but has a similar shorthand name used for identification. Regardless as to which document the examiner referred, the examiner did not have sufficient evidence to make, and the record shows no evidence that the examiner did make, a finding as to the specific date of the document then at issue. The examiner did not even make a finding that the document was definitively not prior art.

The requester also makes reference to a petition decision in a related reexamination request by a Technology Center Director. Because this is a separate proceeding with different claims and facts, the decision in a petition in any such related proceeding is not determinative of the decision in this proceeding.

It is further pointed out that, in this instance, the patent owner's belief that a rejection based upon the Keystone references is legally impermissible in this merged proceeding (based on the alleged prior consideration of the reference date issue) does not convert the proceeding into a question of the examiner's jurisdiction to reexamine, which would create a petition right to contest the propriety of taking that action. Rather, the patent owner is free to contest such an issue before the examiner, and then the Board of Patent Appeals and Interferences ("Board"), if the claims would be rejected based upon the Keystone references. 37 CFR 1.181(a)(1) permits petitions only from matters that are not subject to appeal; in this instance, if a rejection based on the Keystone references would be made and maintained, the route to contest that rejection would be via appeal.

Finding:

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 determinations to order reexamination, and in the determinations that the questions of patentability raised in the January 21, 2005 and April 4, 2005 requests were not previously considered in an earlier concluded examination of the patent. The petition is thus denied as to the issue of the propriety of the two orders for reexamination, and the two reexamination proceedings will continue.

As to petitioner's request that the instant decision be designated a final agency decision, that request is granted since the merged proceeding is ripe for such a designation.

CONCLUSION

1. The petition under 37 CFR 1.181 is <u>denied</u> as to the request to vacate the orders for the 90/007,280 and 90/007,387 proceedings, and is <u>granted to the extent that</u> (a) the prior decision has been fully reconsidered and (b) the instant decision is designated as a final agency decision.

2. The '7280 and '7387 reexamination proceedings remain merged into a single proceeding, over which the Office properly has jurisdiction.

3. This decision is a <u>final agency action</u> within the meaning of 5 U.S.C. 704.

4. Jurisdiction over the instant merged reexamination proceeding is being forwarded to the Technology Center.

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

Roberta Clarke for Robert J. Spar

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

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DECISION ON PETITION FOR REVIEW OF DENIAL OF REQUEST FOR REEXAMINATION UNDER 37 CFR 1.515(c)

In re Reexamination proceeding 90/007,281
Filed: November 2, 2004
For: COMPOSITE MASONRY BLOCK

This is in response to Requester's petition filed February 14, 2005 under 37 CFR 1.181 and 1.515(c) requesting review of the January 31, 2005 Order Denying Request For Reexamination.

The petition is **DENIED**.

On November 2, 2004, the Requester filed a request for Reexamination of U.S. Patent No. 5,827,015 alleging that the majority of the claims of the patent were unpatentable over U. S. Patent 2,313,363 (the '363 patent) in view of the publication "Diamond Wall System Tech Spec" (the Diamond Publication). The request also provided additional references that were to be applied as modifying the above combination to meet the limitations of further dependent claims. On January 31, 2005 the Examiner issued an Order Denying Request for Reexamination. In the Denial Order the Examiner indicated that the '363 patent and the Diamond Publication were considered to be "old art" since both were used in combination to reject claims in a parent application 07/413,400 (the '400 application) of the application that eventually became the '015 patent. Since these references were considered "old art" and the request did not provide any explanation of how these references were to be viewed in a "new light" as compared with their use in the earlier proceeding, they failed to provide a substantial new question of patentability (SNQ). The examiner felt that the teachings of the additional art provided also failed to contain any teachings that would be important to a reasonable examiner in deciding whether or not the claims of the '015 patent were patentable and thus also failed to raise an SNQ.

Requester's petition outlines four reasons as to why it is believed that the decision to deny the request for Reexamination was in error:

1.) The "Keystone" publication cited with the request raises an SNQ,
2.) The combination of the '363 patent and the Diamond publication does raise an SNQ because the rejection made in the earlier prosecution was never overcome by the Patent Owner.
3.) The request did present the '363 patent and the Diamond publication in a "new light".
4.) The remaining references cited in the request raise an SNQ.

As to the first reason above, the petition indicates that an additional reference "Keystone Garden Walls, Beautiful Do-It-Yourself Retaining Walls!" (the Keystone reference) also anticipates some of the claims of the '015 patent. In this reexamination request, however, the requester made no mention of this publication nor was there any detailed explanation of how it would be applied to the claims of the patent. The requester in his petition indicates that this was an oversight but since the publication was cited and since it did raise an SNQ in the requests for reexamination of 5 other related patents, the examiner should have found this publication to also have provided an SNQ in this proceeding.

This argument is not agreed with. 37 CFR 1.510(b)(2) clearly provides that a request must include: "An identification of every claim for which reexamination is requested, and a detailed explanation of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested." MPEP 2217 further goes on to state that the "mere citation of new patents or printed publications without an explanation does not comply with 37 CFR 1.510(b)(2)". Since every patent is patentably distinct, the examiner cannot be required to search for, or be held in error for not reviewing, art applied in other, related proceedings not alleging an SNQ in the request. And, because of the absence of an explanation of it's applicability, it was believed that the position of the requester was that this publication would not raise an SNQ in this particular patent.

The second reason in the petition is that it is alleged that the '363 patent and the Diamond publication raise an SNQ because a rejection made in an earlier parent application based upon the above combination of references was never overcome. The petition cites MPEP 2242 and argues that "a prior adverse decision" would usually mean that an SNQ is present. The petition outlines a timeline of cases running from the '400 application, where the above combination was applied by the examiner to pending claims, to the patent upon which the instant reexamination request was filed. It is the requester's implied position that because the prosecution ran for some nine years and included numerous continuing applications, the original rejection was obscured by the voluminous amount of documents and art in this chain of applications, and that if the examiner had known of the art in question a rejection would have been made in the application that became the '015 patent.

This argument is also not agreed with. This argument assumes that the examiner was unaware of the art in question and would have used it to reject claims. This is pure speculation. When a patent is allowed it is generally assumed that the examiner has reviewed all the art before him or her and has determined that the claims distinguish themselves over that art. There is no reason to think that the examiner did any less in the prosecution of the '015 patent. A speculative argument that the examiner just missed "old art" cannot suffice as the grounds for raising an SNQ absent a showing of presenting that "old art" in a "new light". The "prior adverse decision" cited in MPEP 2242 provides as an example a rejected claim in an abandoned Reissue application. Clearly that example case still has an open unresolved rejection. The situation here is different in that the rejection was not maintained and thus not similarly unresolved.

The third reason deals with the allegation that the '363 patent and the Diamond publication were presented in a "new light" in two ways; making the '363 patent the primary reference of the combination and alerting the Office to the protest of the patentee in another patent application.

As to the first argued manner of presenting the combination in a "new light", that reversing the primary reference would provide such a new light, that argument is not agreed with. MPEP 2242 provides that "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". However, it is not seen that this "reorientation" of the references of the combination was considered a "material" new argument by the examiner or by the requester. Indeed, the request itself makes no mention of this change of the way the combination is applied from that of the earlier application of the references. If this was material enough to be the basis for providing the "new light" and thus providing an SNQ on "old art" alone, it surely would have been stressed in the request itself.

As to the second manner of providing a "new light" to the "old art", the admission by the patentee of the applicability of the combination of the above references in a protest in another application, MPEP 2217 does provide that "admissions by the patent owner as to any matter affecting patentability may be utilized to determine the scope and content of the prior art in conjunction with patents and printed publications in a prior art rejection". However, the MPEP goes on to say that "a third, party, however, may not submit admissions of the patent owner made outside the record of the file or the court record. Such a submission would be outside the scope of reexamination." Since this "admission" was made in a protest outside the record of the file or the court record, it is not seen as proper to create a "new light' under which to view the "old art".

Finally, the fourth reason argues that the other references cited and applied as modifying references for the combination above, additionally raised an SNQ. This is also not agreed with. All of the independent claims of the '015 patent are proposed to be rejected in the request by the '363 patent and the Diamond publication, exclusively. Since none of the additional references were used to modify the combination of

references with respect to independent claims, their applicability to dependent claims dependent upon allowable independent claims (or at least independent claims where there is no SNQ present) would not serve to place the patentability of the claims in question nor to raise an SNQ against the patent as a whole.

In conclusion, the request for reexamination filed November 2, 2004 did not raise a substantial new question of patentability concerning U.S. Patent 5,827,015 and the decision to deny said request by the examiner on January 31, 2005 was proper and will not be withdrawn.

This decision is final and nonappealable. 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

The conditional request to "accept the enclosed complete request for Ex Parte Reexamination as a new filing" is not understood as there doesn't appear to be any such reexamination request enclosed.

Inquiries related to this decision may be directed to Special Programs Examiner Steven N. Meyers at (571) 272-6611.

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

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(For Requester)

In re Michael E. Woolford et al. Reexamination Proceeding Control No.: 90/007,280 Filed: November 2, 2004 For: U.S. Patent No.: 6,142,713	DECISION TO *SUA SPONTE* MERGE *EX PARTE* REEXAMINATION PROCEEDINGS AND DISMISS PETITION TO VACATE REEXAMINATION ORDER AND TERMINATE REEXAMINATION
In re Michael E. Woolford et al. Reexamination Proceeding Control No.: 90/007,384 Filed: January 21, 2005 For: U.S. Patent No.: 6,142,713	

This is a decision on the March 16, 2005 and May 17, 2005 patent owner petitions under 37 CFR 1.181(a)(3), to vacate the orders granting the two captioned reexamination proceedings. Oppositions to the two patent owner petitions were received March 24, 2005 and June 3, 2005, respectively.

This is also a decision to *sua sponte* merge the *ex parte* re-examination proceedings.

The two proceedings, the two petitions, and the two oppositions are before the Office of Patent Legal Administration.

SUMMARY

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For the reasons set forth below, the two petitions are dismissed. The January 31, 2005 order granting reexamination in the 90/007,282 proceeding and the April 4, 2005 order granting reexamination in the 90/007,384 proceeding remain intact.

Pursuant to 37 CFR 1.565(c), reexamination Control Nos. 90/007,282 and 90/007,384 are *sua sponte* merged into a single proceeding.

A single decision is being issued to address the above matters.

REVIEW OF FACTS

1. U.S. Patent No. 6,142,713 (the '713 patent) issued on February 6, 2001.
2. A first request for reexamination of the '713 patent was filed by a third party requester on November 2, 2004. The first request was assigned control No. 90/007,282 (the '7282 proceeding).
3. A second request for reexamination of the '713 patent was filed by a third party requester on January 21, 2005. The second request was assigned control No. 90/007,384 (the '7384 proceeding).
4. Reexamination was ordered for the '7282 proceeding on January 31, 2005.
5. A petition under 37 CFR 1.181(a)(3) to vacate the '7282 reexamination order was received from the patent owner on March 16, 2005.
6. An opposition to the March 16, 2005 patent owner petition to vacate was received from the '7282 requester on March 24, 2005.
7. Reexamination was ordered for the '7384 proceeding on April 4, 2005.
8. A petition under 37 CFR 1.181(a)(3) to vacate the '7384 reexamination order was received from the patent owner on May 17, 2005.
9. An opposition to the May 17, 2005 patent owner petition to vacate was received from the '7384 requester on June 3, 2005.
10. A patent owner's statement under 37 CFR 1.530 has not been received in the '7282 and '7384 reexamination proceedings.

DECISION ON PETITIONS

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

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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."

MPEP 2246, Part I, states, in part:

"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 no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained. "Appropriate circumstances" under 37 CFR 1.181(a)(3) exist to vacate the order granting reexamination where, for example:

...

"(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).

"As to (E) above, the decision of *In re Recreative Technologies Corp.*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996) is to be noted."

MPEP 2242, Part II.A., states, in part:

"A "substantial new question of patentability" is not raised by prior art presented in a reexamination request if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

"In deciding whether to grant a request for reexamination of a patent, the examiner should check the patent's file history to ascertain whether any of the prior art now advanced by requester was previously cited/considered in an earlier concluded Office examination of the patent (e.g., in the examination of the application for the patent)."

In this instance, the patent owner petitioner urges that the Office has previously considered (in an earlier concluded examination of the patent) the question of patentability of the '713 patent claims on which the two orders for reexamination were based, and that the previous consideration was favorable to the patent owner. Accordingly, the patent owner petitions that the '7282 and '7384 orders for reexamination of the '713 patent be vacated as *ultra vires* actions taken by the Office.

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Review of the requests for reexamination

The '7282 Request for Reexamination, filed November 3, 2004, urges that Keystone Retaining Walls (Beautiful Do-It Yourself Retaining Walls! (1989)) raises a substantial new question of patentability (SNQ) with respect to claims 1-75 of the '713 patent. Specifically, the Request urges that the Keystone reference anticipates the claims and has a publication date earlier than the '713 filing date.

The '7384 Request for Reexamination, filed January 21, 2005, urges that Keystone Retaining Walls (Beautiful Do-It Yourself Retaining Walls! (1989)), Keystone Retaining Walls (Introducing the Keystone Retaining Wall System (1989)) and Johnson Block (Johnson Block Retaining Wall Systems(1989)) raise substantial new questions of patentability with respect to claims 1-75 of the '713 patent. Specifically, the Request urges that the two Keystone references each individually anticipates the claims, or renders the claims obvious in view of Johnson Block, and have publication dates earlier than the '713 filing date.

Both requests allege that the dates of the Keystone references are no later than March 1989 for one, and May 1989 for the other, the dates being established by trademark registration documents and by affidavits of Keystone sales representatives.

Review of the Patent Owner's Argument for Vacatur

Both petitions admit that the Keystone references would anticipate the indicated claims if the references were prior art. The petitions argue that the references are undated and have never had a date of publication established. The petitioner alleges that the source of the references pays substantial royalties to license the patented subject matter (of the '713 patent) and this is submitted to be evidence that the source of the references does not believe it could antedate the patent.

Further, both petitions state that "both documents are of record *and were considered* during the prosecution of Serial No. 09/497,250 ("the '250 application"), which subsequently issued as the '713 patent." The evidence proffered for this assertion is the paper entitled "Comments On Statement Of Reasons For Allowance" entered in the '250 application on March 20, 2000.

The petitions also argue, as to the impropriety of other references in the request on the grounds, that those references were listed on information disclosure statements initialed by the examiner and that all those references are secondary references for obviousness patentability issues.

Review of the order for reexamination

In the orders granting the reexamination request, the examiner stated that each of the

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Keystone references are newly cited in the reexamination request and that the remaining references were cited but never applied in the '713 prosecution. As to the Keystone references, the assertion that they are newly cited is in error, given that those same references are included in the file history of the '713 patent.

Evaluation as to any prior consideration of the references:

A review of the record reveals that all of the references which the orders for reexamination cite as raising substantial new questions of patentability were cited in the '713 prosecution; however, none of them were applied, nor were they commented upon by the examiner. The petition urges that the fact that the examiner initialed the citations in the '713 prosecution evidences the examiner's consideration such that those references cannot be the basis for a new question of patentability. This is an incorrect reading of the law. 35 U.S.C. 303(a) states, in part, "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."

The petition further urges that the precise question, raised and addressed in the orders, of whether the references were prior art was considered by the examiner. Petitioner cites as evidence of this - the paper titled "Comments On Statement Of Reasons For Allowance" filed on March 20, 2000, in the '916 file, in which the applicant stated "[t]he Keystone brochure referred to in the 'Reasons for Allowance' is not the brochure which bears the copyright office date stamp of 'June 27, 1988', which is referred to in the earlier Office Action, but is the undated brochure which was attached to the 'Statutory Declaration of All Pfannestein dated August 28, 1998' filed with the Australian litigation between Keystone and Anchor Wall Systems' and "[t]he issue of the undated brochure and various related allegations of its purported author (Keystone) have previously been discussed with the Examiner in the prosecution of the parent case."

Although the Comments On Statement of Reasons For Allowance further states that '[t]hese remarks are being submitted with the consent of and at the request of Examiner Taylor," the record provides no corroborating evidence that the examiner reviewed the comments or agreed with them, much less requested them. These applicant comments are deemed to be self serving, and they were delayed until after the close of prosecution, with no further comment by the examiner. Accordingly, the comments are not deemed to be persuasive that the precise question of whether the issue of the date of the references purportedly presenting a substantial new question of patentability was ever evaluated in view of the documents suggesting a date of March 1989.

As to the issue of any oral statement the examiner might have made, and any weight to be accorded same, oral statements are open to misinterpretation. Thus, 37 CFR 1.2 clearly states:

> "All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and

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> Trademark Office is unnecessary....No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt."

As to the examiner's not having commented on applicant's March 20, 2000 "Comments On Statement Of Reasons For Allowance," 37 C.F.R. 104(e) states that :

> "Failure by the examiner to respond to any statement commenting on reasons for allowance does not give rise to any implication."

As to whether the issue of the date of publication may present a substantial new question of patentability, this is readily answered by the opinion in *Heinl v Godici*, (E.D.Va. 2001), 143 F. Supp. 2d 593, which found that art cited in the original patent proceedings, but for which no findings as to their status as prior art were made in the original proceedings, could raise a substantial new question of patentability in light of evidence as to their status as prior art.

It is further to be noted that the *Heinl* opinion further states that "Courts are uniform in recognizing that the decision to grant reexaminations of a patent is preliminary, not final agency action." *Heinl*, 143 F. Supp. 2d at 597. Both the fact that the issue as to the status of the cited references as prior art has never been determined in the prior proceedings, and the fact that an order granting reexamination is not a final agency action, weigh in favor of allowing the reexamination proceedings to continue.

Finding:

In *Heinl*, 143 F.Supp.2d at 601, the Court stated, in a decision seeking termination of reexamination based on the absence of a new question of patentability:

> "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" it the Office determination that the questions of patentability raised in the January 21, 2005 and April 4, 2005 requests were not previously considered in an earlier concluded examination of the patent. The petition is thus dismissed, and the two reexamination proceedings will continue.

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DISCUSSION REGARDING MERGER

Under 37 CFR 1.565(c):

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

As evidenced by the above review of facts, reexamination control No. 90/007,282 and reexamination control No. 90/007,384 are currently pending. Since the order to reexamine has been mailed in both reexamination proceedings, a decision under 37 CFR 1.565(c) is timely.

DECISION MERGING REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-noted 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

The patent owner is required to maintain identical amendments in the two 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(c).

A review of the reexamination file for the proceedings of reexamination control No. 90/007,282 and 90/007,384 shows that, in both proceedings, original patent claims 1-75 are present and no claims are added or altered by amendment. Accordingly, the claims are identical in number and are identical as to content in both proceedings.

III. Conduct of the Merged Proceeding

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

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2. Any response by the 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 two requesters, who will also be sent copies of Office actions.

3. Where a paper is filed which requires payment of a fee (e.g., petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appellant brief, 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.

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

CONCLUSION

1. The petition under 37 CFR 1.181 is dismissed.

2. The '7282 and '7384 reexamination proceedings are merged into a single proceeding.

3. The reexamination file is being forwarded to the Technology Center for the issuance of a first Office action in due course.

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

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

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DEC 29 2005

REEXAM UNIT

MERCHANT & GOULD PC
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(For Requester)

In re Michael E. Woolford et al.
Reexamination Proceeding
Control No.: 90/007,282
Filed: November 2, 2004
For: U.S. Patent No.: 6,142,713

In re Michael E. Woolford et al.
Reexamination Proceeding
Control No.: 90/007,384
Filed: January 21, 2005
For: U.S. Patent No.: 6,142,713

: DECISION DENYING
: PETITION TO VACATE
: REEXAMINATION ORDERS
: AND TERMINATE
: REEXAMINATIONS

This is a decision on the October 18, 2005 patent owner petition under 37 CFR 1.181, seeking supervisory review and final agency decision on the August 18, 2005 decision dismissing the petition to vacate the orders granting the two above-captioned reexamination proceedings. A requester opposition to the patent owner petition was received November 1, 2005.

The merged proceeding of reexamination Control Numbers 90/007,282 and 90/007,384, the present petition, and the present opposition are before the Office of Patent Legal Administration.

For the reasons set forth below, the petition under 37 CFR 1.181(a)(3) is denied as to the request to vacate the orders for the 90/007,278 and 90/007,386 proceedings. In addition, the petition is granted to the extent that (a) the prior decision has been fully reconsidered and (b) the instant decision is designated as a final agency decision.

The January 31, 2005 order granting reexamination in the 90/007,282 proceeding and the April 4, 2005 order granting reexamination in the 90/007,384 proceeding remain intact. Given the August 18, 2005 merger of the two proceedings, a single decision is being issued for the two proceedings.

REVIEW OF FACTS

1. U.S. Patent No. 6,142,713 (the '713 patent) issued on February 6, 2001.
2. A first request for reexamination of the '713 patent was filed by a third party requester on November 2, 2004. The first request was assigned control No. 90/007,282 (the '7282 proceeding).
3. A second request for reexamination of the '713 patent was filed by a third party requester on January 21, 2005. The second request was assigned control No. 90/007,384 (the '7384 proceeding).
4. Reexamination was ordered for the '7282 proceeding on January 31, 2005.
5. A petition under 37 CFR 1.181(a)(3) to vacate the '7282 reexamination order was received from the patent owner on March 16, 2005.
6. An opposition to the March 16, 2005 patent owner petition to vacate was received from the '7282 requester on March 24, 2005.
7. Reexamination was ordered for the '7384 proceeding on April 4, 2005.
8. A petition under 37 CFR 1.181(a)(3) to vacate the '7384 reexamination order was received from the patent owner on May 17, 2005.
9. An opposition to the May 17, 2005 patent owner petition to vacate was received from the '7384 requester on June 3, 2005.
10. On August 18, 2005, the Office mailed a decision (a) dismissing the two petitions to vacate the orders, and (b) to merge the two reexamination proceedings.
11. The present petition under 37 CFR 1.181 seeking supervisory review and final agency decision concerning the petition by patent owner to vacate order granting reexamination was received in the present merged proceeding on October 18, 2005.
12. An opposition to the October 18, 2005 petition was received from the '7282 third party requester on November 1, 2005.
13. A patent owner's statement under 37 CFR 1.530 has <u>not</u> been received in the '7282 and '7384 reexamination proceedings.

DECISION ON PETITION

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."

MPEP 2246, Part I, states, in part:

> "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 no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained. "Appropriate circumstances" under 37 CFR 1.181(a)(3) exist to vacate the order granting reexamination where, for example:
>
> ...
>
> "(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).
>
> "As to (E) above, the decision of *In re Recreative Technologies Corp.*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996) is to be noted."

MPEP 2242, Part II.A., states, in part:

> "A 'substantial new question of patentability' is not raised by prior art presented in a reexamination request if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).
>
> "In deciding whether to grant a request for reexamination of a patent, the examiner should check the patent's file history to ascertain whether any of the prior art now advanced by requester was previously cited/considered in an earlier concluded Office examination of the patent (e.g., in the examination of the application for the patent)."

In this instance, the patent owner petitioner urges that the Office has previously considered (in an earlier concluded examination of the patent) the questions of patentability of the '713 patent claims on which the two orders for reexamination are based, and that the previous consideration was favorable to the patent owner. Accordingly, the patent owner petitions that the '7282 and '7384 orders for reexamination of the '713 patent be vacated as *ultra vires* actions taken by the Office.

Review of the requests for reexamination

The '7282 Request for Reexamination, filed November 3, 2004, urges that Keystone Retaining Walls (Beautiful Do-It Yourself Retaining Walls! (1989)) raises a substantial new question of patentability (SNQ) with respect to claims 1-75 of the '713 patent. Specifically, the Request urges that the Keystone reference anticipates the claims and has a publication date earlier than the '713 filing date.

The '7384 Request for Reexamination, filed January 21, 2005, urges that Keystone Retaining Walls (Beautiful Do-It Yourself Retaining Walls! (1989)), Keystone Retaining Walls (Introducing the Keystone Retaining Wall System (1989)) and Johnson Block (Johnson Block Retaining Wall Systems(1989)) raise substantial new questions of patentability with respect to claims 1-75 of the '713 patent. Specifically, the Request urges that the two Keystone references each individually anticipates the claims, or renders the claims obvious in view of Johnson Block, and have publication dates earlier than the '713 filing date.

Both requests allege that the dates of the Keystone references are no later than March 1989 for one, and May 1989 for the other, the dates being established by trademark registration documents and by affidavits of Keystone sales representatives.

Review of the Patent Owner's Argument for Vacatur

The petition admits that the Keystone references would anticipate the indicated claims if the references were prior art. The petition argues that the references are undated and have never had a date of publication established. The petitioner alleges that the source of the references pays substantial royalties to license the patented subject matter (of the '713 patent), and this is submitted to be evidence that the source of the references does not believe it could antedate the patent.

Further, the petition state that "both documents are of record *and were considered* during the prosecution of Serial No. 09/497,250 ('the '250 application'), which subsequently issued as the '713 patent." The evidence proffered for this assertion is the paper entitled "Comments On Statement Of Reasons For Allowance" entered in the '250 application on March 20, 2000.

The petition also argues, as to the impropriety of other references in the request, on the grounds that those references were listed on information disclosure statements initialed by the examiner, and that all those references are secondary references for obviousness patentability issues.

Review of the orders for reexamination

In the orders granting the reexamination request, the examiner stated that each of the Keystone references was cited but never applied in the '713 prosecution. This appears to be correct based on a review of the '713 file.

Evaluation as to any prior consideration of the references:

A review of the record reveals that all of the references which the orders for reexamination cite as raising substantial new questions of patentability were cited in the '713 prosecution; however, none of them were applied, nor were they commented upon by the examiner. The petition urges that the fact that the examiner initialed the citations in the '713 prosecution evidences the examiner's consideration - such that those references cannot be the basis for a new question of patentability. This is an incorrect reading of the law. 35 U.S.C. 303(a) states, in part, "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."

The petition further urges that the examiner previously considered the precise question raised and addressed in the orders - of whether the Keystone references were prior art. Petitioner cites as evidence of this - the paper titled "Comments On Statement Of Reasons For Allowance" filed on March 20, 2000, in the '916 file, in which the applicant stated "[t]he Keystone brochure referred to in the 'Reasons for Allowance' is not the brochure which bears the copyright office date stamp of 'June 27, 1988', which is referred to in the earlier Office Action, but is the undated brochure which was attached to the 'Statutory Declaration of All Pfannestein dated August 28, 1998' filed with the Australian litigation between Keystone and Anchor Wall Systems" and "[t]he issue of the undated brochure and various related allegations of its purported author (Keystone) have previously been discussed with the Examiner in the prosecution of the parent case."

Although the Comments On Statement of Reasons For Allowance further states that '[t]hese remarks are being submitted with the consent of and at the request of Examiner Taylor," the record provides no corroborating evidence that the examiner reviewed the comments or agreed with them, much less requested them. These applicant comments are deemed to be self serving, and they were delayed until after the close of prosecution, with no further comment by the examiner. Accordingly, the comments are not deemed to be persuasive that the precise question of the date of the references purportedly presenting a substantial new question of patentability was ever evaluated in view of the documents suggesting a date of March 1989.

As to the issue of any oral statement the examiner might have made, and any weight to be accorded same, oral statements are open to misinterpretation. Accordingly, 37 CFR 1.2 clearly states:

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

As to the examiner's not having commented on applicant's March 20, 2000 "Comments On Statement Of Reasons For Allowance," 37 C.F.R. 104(e) states that:

> "Failure by the examiner to respond to any statement commenting on reasons for allowance does not give rise to any implication."

As to whether the issue of the date of publication may present a substantial new question of patentability, this is readily answered by the opinion in *Heinl v Godici*, (E.D.Va. 2001), 143 F. Supp. 2d 593, which found that art cited in the original patent proceedings, but for which no findings as to their status as prior art were made in the original proceedings, could raise a substantial new question of patentability in light of evidence as to their status as prior art.

It is also to be noted that the *Heinl* opinion further states that "Courts are uniform in recognizing that the decision to grant reexaminations of a patent is preliminary, not final agency action." *Heinl*, 143 F. Supp. 2d at 597. Both the fact that the issue as to the status of the cited references as prior art has never been determined in the prior proceedings, and the fact that an order granting reexamination is not a final agency action, weigh in favor of allowing the reexamination proceedings to continue.

Evaluation of the petitioner's arguments regarding the prior petition decision:

The petitioner argues that the prior decision was premised on two erroneous assumptions, i.e., (1) that the documents under consideration were not adequately considered during the course of prosecution, and (2) that the evidence relied on in finding a significant new question of patentability is being presented in a new light, as compared with the original prosecution. The petitioner argues that both of these premises are incorrect.

Petitioner's argument omits the essential aspect in these proceedings, which is that the evidence now before the Office (that was not so in the original, i.e., application, proceeding) is evidence as to the date the documents were disseminated and made accessible to the public. It is this evidence that casts the documents that are applied against the '713 patent in a new light, i.e. as being prior art rather than indeterminate art. Although the petitioner makes reference to the House Report 107-120[1] indication that the most recent revision to 35 U.S.C. 303 permits reexamination only where there is substantial evidence that the examiner did not properly understand the reference or did not consider a portion of the reference in making his decision, such is not at odds with the evidence before the examiner in this merged reexamination proceeding. Where the examiner in the original prosecution could not determine the date of a reference, and therefore could not sustain a rejection based on that reference because of the absence of a "good" date, evidence subsequently provided in the instant reexamination proceedings as to the date that antedates the date of invention can

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[1] http://thomas.loc.gov/cgi-bin/cpquery/?&dbname=cp107&sid=cp107VYubX&refer=&r_n=hr120.107&item=&sel=TOC_2687&

change the consideration of that reference from consideration of an indeterminate document to consideration of a prior art document.

As alluded to above, this set of facts is directly analogous to those in *Heinl*, 143 F.Supp.2d at 602, in which the Court stated, in a decision seeking termination of reexamination based on the absence of a new question of patentability:

> "There, plaintiff did not argue that the examiner should make a finding that the catalogs were not prior art, but rather, he argued that the evidence did not permit the examiner to make any finding regarding their status as prior art. ... Accordingly, the catalogs are not prior art that was previously relied upon to reject a claim, and therefore, their submission in the '275 Reexamination does not bar their submission and consideration in the subsequent '809 Reexamination."

In one of the parent cases to the '713 patent (to which this merged reexamination is directed), the examiner set forth that he could not determine the date of a document which was not clearly identified by the examiner. The record suggests that such unidentified document is a document different from that asserted by the petitioner, but has a similar shorthand name used for identification. Regardless as to which document the examiner referred, the examiner did not have sufficient evidence to make, and the record shows no evidence that the examiner did make, a finding as to the specific date of the document then at issue. The examiner did not even make a finding that the document was definitively not prior art.

The requester also makes reference to a petition decision in a related reexamination request by a Technology Center Director. Because this is a separate proceeding with different claims and facts, the decision in a petition in any such related proceeding is not determinative of the decision in this proceeding.

It is further pointed out that, in this instance, the patent owner's belief that a rejection based upon the Keystone references is legally impermissible in this merged proceeding (based on the alleged prior consideration of the reference date issue) does not convert the proceeding into a question of the examiner's jurisdiction to reexamine, which would create a petition right to contest the propriety of taking that action. Rather, the patent owner is free to contest such an issue before the examiner, and then the Board of Patent Appeals and Interferences ("Board"), if the claims would be rejected based upon the Keystone references. 37 CFR 1.181(a)(1) permits petitions only from matters that are not subject to appeal; in this instance, if a rejection based on the Keystone references would be made and maintained, the route to contest that rejection would be via appeal.

Finding:

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 determinations to order reexamination, and in the determinations that the questions of patentability raised in the January 21, 2005 and April 4, 2005 requests were not previously considered in an earlier concluded examination of the patent. The petition is thus denied as to the issue of the propriety of the two orders for reexamination, and the two reexamination proceedings will continue.

As to petitioner's request that the instant decision be designated a final agency decision, that request is granted since the merged proceeding is ripe for such a designation.

CONCLUSION

1. The petition under 37 CFR 1.181 is <u>denied</u> as to the request to vacate the orders for the 90/007,282 and 90/007,384 proceedings, and is <u>granted to the extent that</u> (a) the prior decision has been fully reconsidered and (b) the instant decision is designated as a final agency decision.

2. The '7282 and '7384 reexamination proceedings remain merged into a single proceeding, over which the Office properly has jurisdiction.

3. This decision is a <u>final agency action</u> within the meaning of 5 U.S.C. 704.

4. Jurisdiction over the instant merged reexamination proceeding is being forwarded to the Technology Center.

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

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

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12-28-05

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JUL 12 2005

TECHNOLOGY CENTER 3600

Reexamination Control No. 90/007,283

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FOR REQUESTER:

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Buchanan Ingersoll, P.C.
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301 Grant Street, 20th Floor
Pittsburgh, PA 15219-1410

DECISION ON PETITION UNDER 37 CFR 1.181 FOR RECONSIDERATION OF DECISION ON REQEST FOR REEXAMINATION

This is in reply to petitioner's communication filed February 16, 2005 under 37 CFR 1.181 requesting Reconsideration of the Decision on Request for Reexamination. There is no fee required for this petition. The delay in treating this petition is sincerely regretted.

The petition to provide reconsideration of the decision on the request for reexamination is **GRANTED** to the extent indicated below.

A review of the above reexamination file indicates that a Reexamination request was filed on November 2, 2004 requesting reexamination of U. S. Patent 6,055,782. Amongst the prior art submitted by the requester that was indicated as providing a substantial new question of patentability was a window brochure from Henley Supply Millwork. Apparently, when the original request was "scanned in" to create the electronic file wrapper less that the entirety of the brochure was scanned. Without the entirety of the original brochure available the examiner assigned to decide the Reexamination request found that the scanned portion of the brochure was insufficient to raise a substantial new question of patentability, and denied the request on January 26, 2005. It was only recently that the original complete brochure was able to be located. The original brochure did indeed have additional subject matter not scanned in when the electronic file wrapper was created.

Because the decision the examiner made on January 26, 2005 on the request for Reexamination was not made with a review of the totality of the material included in the request, the petition to re-review the request in light of the complete window brochure is hereby **GRANTED**.

Attached to this decision is a new decision on the request for Reexamination.

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

Steven N. Meyers
Special Programs Examiner,
Technology Center 3600
(571) 272-6611

snm: 7/8/05

Attachment: Substitute Decision on Request for Reexamination

ORDER GRANTING/DENYING REQUEST FOR* INTER PARTES *REEXAMINATION	**Control No.** 90/007,283	**Patent Under Reexamination** 6055782	
	Examiner Yvonne M. Horton	**Art Unit** 3635	

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

The request for *inter partes* reexamination has been considered. Identification of the claims, the references relied on, and the rationale supporting the determination are attached.

Attachment(s): ☐ PTO-892 ☐ PTO-1449 or PTO/SB/08 ☐ Other: _____

1. ☐ The request for *inter partes* reexamination is GRANTED.

   ☐ An Office action is attached with this order.

   ☐ An Office action will follow in due course.

2. ☒ The request for *inter partes* reexamination is DENIED.

This decision is not appealable. 35 U.S.C. 312(c). Requester may seek review of a denial by petition to the Director of the USPTO within ONE MONTH from the mailing date hereof. 37 CFR 1.927. EXTENSIONS OF TIME ONLY UNDER 37 CFR 1.183. In due course, a refund under 37 CFR 1.26(c) will be made to requester.

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

Reexamination

It remains that no substantial new question of patentability is raised by the request for reexamination and prior art cited therein for the reasons set forth below.

The request indicates that the Requester considers that claims 1-15 of the Morton et al. '782 Patent are unpatentable over a window brochure published by Henley Supply Work and a cross-sectional drawing supposedly of the window frame shown in the brochure.

First, the cross-sectional drawing, as noted in the previous "Denial" dated 1/26/05, the cross-sectional drawing is not available against the claims as prior art because the drawing is not a patent or printed publication. Thus, the request is based solely on the contents of the brochure.

Regarding the brochure, a complete version of the brochure has now been reviewed. The brochure merely depicts a window and a J-channel. Windows with J-channels were provided in the art considered by the examiner in the prosecution of the original patent. For Example, Figure 2 of US Patent #5,660,010 to SAYERS details a window having a J-channel (46) and (80). Therefore, the brochure is simply a teaching cumulative of the prior art already presented and readily available to the examiner during prosecution of the original application.

Therefore, the brochure fails to raise a substantial new question of patentability as to any one of the Morton et al. patent claims. Accordingly, the request for reexamination is denied.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvonne M. Horton whose telephone number is (571) 272-6845. The examiner can normally be reached on 6:30 am - 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on (571) 272-6842. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Yvonne M. Horton
Examiner
Art Unit 3635
7/5/05

Peter M. Cuomo
Supervisory Patent Examiner
Technology Center 3600

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

MAY 25 2006

Dean J. Lechtenberger
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(For 3rd Party Requester)

Stephen H. Cagle
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(For 3rd Party Requester)

Reexam Control No.: 90/007,108
Filed : July 6, 2004
For U.S. Patent No. : 5,271,468

Reexam Control No.: 90/007,284
Filed : November 3, 2004
For U.S. Patent No. : 5,271,468

Reexam Control No.: 90/007,289
Filed : November 8, 2004
For U.S. Patent No. : 5,271,468

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination proceedings are before the Director of the Central Reexamination Unit for consideration of merger as provided for in 37 CFR 1.565(c).

Reexamination in application control No. 90/007,108 was ordered in a decision mailed September 16, 2004. A timely owner's statement along with a preliminary amendment amending some claims and adding some new ones was filed November 16, 2004. No Office action has been issued.

Reexamination in application control No. 90/007,284 was ordered in a decision mailed December 29, 2004. Patent owner filed a notice waiving patent owner's right to file a patent owner's statement on January 21, 2005. No amendment has been filed in this proceeding nor has an Office action been issued.

Reexamination in application control No. 90/007,289 was ordered in a decision mailed December 29, 2004. Patent owner filed a notice waiving patent owner's right to file a patent owner's statement on January 21, 2005. No amendment has been filed in this proceeding nor has an Office action been issued.

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.

Requirement for Same Claims, Drawings, and Specification in All Three Proceedings

As noted above, the claims have been amended in the '108 reexamination proceeding by virtue of the preliminary amendment filed November 16, 2004. No amendments have been filed in the '284 and '289 proceedings. The patent owner is required to maintain identical claims, claim numbering, specifications, and drawings in each of the files. **Accordingly, patent owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in each of the three 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 all three proceedings. All papers issued by the Office or as filed by the patent owner will contain the identifying data for all three files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in triplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requesters and requesters will be sent copies of all papers mailed by the Office. See 37 CFR 1.565(d).

Dual Correspondence

It is noted that currently communications to patent owner regarding the instant proceedings, are being sent to two different addresses. In the '108 proceeding, communications are being mailed to the firm of Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P. A power of attorney was allegedly filed with the request indicating that the firm of Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P. will be representing patent owner. However, an inspection of the file failed to uncover such a paper. If such a paper was indeed filed, it is respectfully requested that a copy be submitted along with any supporting documentation indicating receipt by the Office (such as a P.T.O. stamped receipt). In the '284 and '289 proceedings, communications are being sent to the address of record, namely, that of Halliburton Energy Services. Under 37 CFR 1.33(a), the Office will not engage in double correspondence. Accordingly, the patent owner is hereby required to notify the Office by filing the necessary papers (i.e., power of attorney and/or change of correspondence address) in the appropriate files so as to have but a single representative/address to whom/where all communications will be mailed. The notification must be submitted within one month of the mailing date of this decision. A courtesy copy of this communication will be sent to the firm of Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P.

Conclusion

Reexamination Control Nos. 90/007,108, 90/007,284 and 90/007,289 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 each of the files and to name but a single representative/address.** Upon receipt of the response, an Office action will issue in due course.

Any inquiry concerning this decision should be directed to Andres Kashnikow, Special Programs Examiner, at telephone No. (571) 272-4361.

Lissi Mojica Marquis, Director
Central Reexamination Unit

cc: Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P.
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UNITED STATES PATENT AND TRADEMARK OFFICE

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Stephen H. Cagle (For '7289 Third Party Requester)
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750 Bering Drive
Houston, TX 77057

MAILED

OCT 17 2006

CENTRAL REEXAMINATION UNIT

In re Streich et al
Reexamination Proceeding
Control No. 90/007,108
Filed: July 6, 2004
For: U.S. Patent No. 5,271,468

In re Streich et al
Reexamination Proceeding
Control No. 90/007,284
Filed: November 3, 2004
For: U.S. Patent No. 5,271,468

In re Streich et al
Reexamination Proceeding
Control No. 90/007,289
Filed: November 8, 2004
For: U.S. Patent No. 5,271,468

DECISION
DISMISSING
PETITION

This is a decision on the patent owner petition filed October 3, 2006, titled "PETITION UNDER 37 C.F.R. § 1.182 REGARDING RECORDATION/TRANSCRIPTION OF ORAL CONFERENCES BETWEEN PATENT OWNER AND U.S. PATENT AND TRADEMARK OFFICE DURING THE MERGED PROCEEDINGS."

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

The fee set forth in 37 CFR 1.17(f) for a petition under 37 CFR 1.182 is $400, and has been paid by petitioner.

The petition is dismissed for the reasons set forth below.

DECISION

Petitioner has requested that the Office permit recordation or transcription of "any oral conferences between Patent Owner and personnel of the U.S. Patent and Trademark office" during the instant merged proceeding for Reexamination Control Nos. 90/007,108, 90/007,284, and 90/007,289.

This request will not be granted.

MPEP 2281 states:

> "[O]nly *ex parte* interviews between the examiner and patent owner and/or the patent owner's representative are permitted. Requests by reexamination requesters to participate in or to attend interviews will not be granted."

The relief requested by petitioner would, in effect, permit attendance by a third party at interviews (oral conferences), in addition to the examiner and the patent owner, by providing access to the content of the interview in a manner not contemplated by the *ex parte* reexamination statute. It is to be also to be noted that a stenographer, or other party facilitating recordation or transcription, would be, in effect, functioning as a representative to parties other than the patent owner and the Office (i.e., a representative to third parties) to record the content of the interview. This would not be justified, in view of the provisions and intent of the legislation and regulations to make reexamination an *ex parte* proceeding. *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 882 F.2d 1570, 11 USPQ2d 1866 (Fed. Cir. 1989)(a

reexamination is conducted *ex parte* after it is instituted); [1] *In re Opprecht*, 10 USPQ2d 1718 (Fed. Cir. 1989)(third parties do not participate before the Office). Thus, the requested relief cannot, and will not, be granted.

The recordation of an interview in *ex parte* reexamination is set forth as follows:

Pursuant to MPEP 2281:

> "The examiner must complete an Interview Summary form PTOL-474 for each interview held where a matter of substance has been discussed (see MPEP § 713.04)....The original should be made of record in the reexamination file, and a copy should be mailed to any third party requester.
>
> "The general procedure for conducting interviews and recording same is described at MPEP § 713.01 - § 713.04....
>
> "In every instance of an interview with the examiner, a patent owner's statement of the interview, including a complete written statement of the reasons presented at the interview as warranting favorable action, must be filed by the patent owner.... The requirement for a patent owner's statement of the interview cannot be waived by the examiner."

Pursuant to MPEP 713.04:

> "Applicant's summary of what took place at the interview should be carefully checked to determine the accuracy of any argument or statement attributed to the examiner during the interview.... If the record is complete and accurate, the examiner should place the

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[1] The Federal Circuit stated as follows as to third party requester participation:

"If reexamination is granted, a third-party requester has the right to reply to any statement submitted by the patent owner in response to the PTO's order granting reexamination (section 304). **The statute gives third-party requesters no further, specific right to participate in the reexamination proceeding. Indeed, the statute specifically prohibits further participation by third-party requesters during reexamination.** ***See*** **35 U.S.C. § 305 ("[a]fter the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination").** Thus, a reexamination is conducted *ex parte* after it is instituted. *See In re Etter*, 756 F.2d 852, 859 n.6, 225 USPQ 1 , 5-6 n.6 (Fed. Cir.), *cert.* denied, 474 U.S. 828 (1985)." *Id.*, at 1573, at 1868-1869. [Emphasis added in bold]

The Federal Circuit also reviewed the legislative history of the *ex parte* reexamination statute, and concluded that:

"... contrary to Syntex's view, the legislative history provides no support for Syntex's position that it has a right to challenge the reexamination decision." *Id.*, at 1574, at 1869

indication "Interview record OK" on the paper recording the substance of the interview along with the date and the examiner's initials."

The information generated by the above procedure provides the entirety of the substance of the interview that is made of record.[2] That record is available to the public and any forum that has an occasion to review the patent that was reexamined.

CONCLUSION

The petition is dismissed.

Jurisdiction over the reexamination proceeding is being returned to the Central Reexamination Unit.

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

10-17-06
C:\Kiva\Kenpet6\7108_req_transcription of_interview.wpd

[2] Pursuant to 37 CFR 1.2, "[t]he action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt."

UNITED STATES PATENT AND TRADEMARK OFFICE

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MAY 16 2005

For the Patent Owner:

Bell, Boyd & Lloyd LLC
Robert M. Barrett
P.O. Box 1135
Chicago, IL 60690-1135

For the Requester:

Rick McLeod
Klarquist Sparkman LLP
121 SW Salmon Street, Suite 1600
Portland, OR 97204

NOTICE OF IMPROPER ACCEPTANCE OF REVOCATION OF POWER OF ATTORNEY

In re Reexamination proceeding 90/007,286
Filed: November 3, 2004
For: NETWORK SALES SYSTEM

The Notice of Acceptance of Power of Attorney mailed on 3/2/05 was sent in error, and is hereby vacated. The Revocation of Power of Attorney and Appointment of New Attorney filed 2/1/05 is an improper submission and will not be considered until the Certificate of Service, MPEP 2266.03 is received. The power remains with the attorney representing the Patent Owner above.

Any questions concerning this notice should be directed to Toi Johnson at (571) 272-6601.

Toi Johnson
Supervisory Legal Instrument Exam
571-272-6601

cc : David B Cochrane
Jones Day
North Point- 901 Lakeside Ave.
Cleveland, OH 44114

UNITED STATES PATENT AND TRADEMARK OFFICE

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JAN 25 2005

MAILED
JAN 25 2005
OFFICE OF THE DIRECTOR
TC 3600

Reexamination Control No. 90/007,287

FOR PATENT OWNER:

Dennison, Schultz & Dougherty
1745 Jefferson Davis Highway
Arlington, VA 22202

FOR REQUESTER:

Rick McLeod
Klarquist Sparkman LLP
121 SW Salmon Street, Suite 1600
Portland, OR 97204

DECISION NOT ENTERING IMPROPER PAPER

On January 3, 2005, Richard McLeod, the Requester in Reexam Control No. 90/007,287, submitted a paper by mail. MPEP 2267 states:

> "Unless a paper submitted by a third party raises only issues appropriate under 37 CFR 1.501, or consists solely of a prior decision on the patent by another forum, e.g. a court, or presentation of a paper of record in litigation, it will be returned to an identified third party."

The paper filed by the requester, is an improper submission under §1.565(a) and will not be considered. The paper cannot be returned since it now part of an electronic file wrapper. The paper has been "closed", however, so that it is no longer viewable in the electronic file wrapper. This decision will be made of record in the reexamination file.

Any questions concerning this decision should be directed to Steven N. Meyers at (703) 308-3868.

John Love, Director,
Technology Center 3600
(703) 308-1020

snm: 1/24/05

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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FEB 10 2005

Reexamination Control No. 90/007,287

MAILED

FEB 10 2005

OFFICE OF THE DIRECTOR
TC 3600

FOR PATENT OWNER:

Bell, Boyd & Lloyd
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FOR REQUESTER:

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The paper filed by the requester, is an improper submission under §1.565(a) and will not be considered. The paper cannot be returned since it now part of an electronic file wrapper. The paper has been "closed", however, so that it is no longer viewable in the electronic file wrapper. This decision will be made of record in the reexamination file.

The original decision mailed January 25, 2004 used an incorrect Patent Owner's address. This has been corrected above. Any questions concerning this decision should be directed to Steven N. Meyers at (703) 308-3868.

John J Love

John Love, Director,
Technology Center 3600
(703) 308-1020

snm: 2/2/05
SM

UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Reexamination proceeding 90/007,287
Filed: November 3, 2004
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The Notice of Acceptance of Power of Attorney mailed on 3/2/05 was sent in error, and is hereby vacated. The Revocation of Power of Attorney and Appointment of New Attorney filed 2/1/05 is an improper submission and will not be considered until the Certificate of Service, MPEP 2266.03 is received. The power remains with the attorney representing the Patent Owner above.

Any questions concerning this notice should be directed to Toi Johnson at (571) 272-6601.

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Reexam Control No.: 90/007,107
Filed : July 6, 2004
For U.S. Patent No. : 5,224,540

Reexam Control No.: 90/007,288
Filed : November 8, 2004
For U.S. Patent No. : 5,224,540

Reexam Control No.: 90/007,312
Filed : November 22, 2004
For U.S. Patent No. : 5,224,540

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination proceedings are before the Director of the Central Reexamination Unit for consideration of merger as provided for in 37 CFR 1.565(c).

Reexamination in application control No. 90/007,107 was ordered in a decision mailed September 16, 2004. A timely owner's statement along with a preliminary amendment amending some claims and adding some new ones was filed November 16, 2004. No Office action has been issued.

Reexamination in application control No. 90/007,288 was ordered in a decision mailed December 29, 2004. Patent owner filed a notice waiving patent owner's right to file a patent

owner's statement on January 21, 2005. No amendment has been filed in this proceeding nor has an Office action been issued.

Reexamination in application control No. 90/007,312 was ordered in a decision mailed June 2, 2006. No patent owner's statement was filed (see interview Summary Record of August 7, 2006). No amendment has been filed in this proceeding nor has an Office action been issued.

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.

Requirement for Same Claims, Drawings, and Specification in All Three Proceedings

As noted above, the claims have been amended in the '107 reexamination proceeding by virtue of the preliminary amendment filed November 16, 2004. No amendments have been filed in the '288 and '312 proceedings. The patent owner is required to maintain identical claims, claim numbering, specifications, and drawings in each of the files. **Accordingly, patent owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in each of the three 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 all three proceedings. All papers issued by the Office or as filed by the patent owner will contain the identifying data for all three files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in triplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requesters and requesters will be sent copies of all papers mailed by the Office. See 37 CFR 1.565(d).

Conclusion

Reexamination Control Nos. 90/007,107, 90/007,288 and 90/007,312 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 each of the files.** Upon receipt of the response, an Office action will issue in due course.

Any inquiry concerning this decision should be directed to Andres Kashnikow, Special Programs Examiner, at telephone No. (571) 272-4361.

Lissi Mojica Marquis, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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MAY 25 2006

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Filed : July 6, 2004
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Filed : November 3, 2004
For U.S. Patent No. : 5,271,468

Reexam Control No.: 90/007,289
Filed : November 8, 2004
For U.S. Patent No. : 5,271,468

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination proceedings are before the Director of the Central Reexamination Unit for consideration of merger as provided for in 37 CFR 1.565(c).

Reexamination in application control No. 90/007,108 was ordered in a decision mailed September 16, 2004. A timely owner's statement along with a preliminary amendment amending some claims and adding some new ones was filed November 16, 2004. No Office action has been issued.

Reexamination in application control No. 90/007,284 was ordered in a decision mailed December 29, 2004. Patent owner filed a notice waiving patent owner's right to file a patent owner's statement on January 21, 2005. No amendment has been filed in this proceeding nor has an Office action been issued.

Reexamination in application control No. 90/007,289 was ordered in a decision mailed December 29, 2004. Patent owner filed a notice waiving patent owner's right to file a patent owner's statement on January 21, 2005. No amendment has been filed in this proceeding nor has an Office action been issued.

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.

Requirement for Same Claims, Drawings, and Specification in All Three Proceedings

As noted above, the claims have been amended in the '108 reexamination proceeding by virtue of the preliminary amendment filed November 16, 2004. No amendments have been filed in the '284 and '289 proceedings. The patent owner is required to maintain identical claims, claim numbering, specifications, and drawings in each of the files. **Accordingly, patent owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in each of the three 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.

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It is noted that currently communications to patent owner regarding the instant proceedings, are being sent to two different addresses. In the '108 proceeding, communications are being mailed to the firm of Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P. A power of attorney was allegedly filed with the request indicating that the firm of Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P. will be representing patent owner. However, an inspection of the file failed to uncover such a paper. If such a paper was indeed filed, it is respectfully requested that a copy be submitted along with any supporting documentation indicating receipt by the Office (such as a P.T.O. stamped receipt). In the '284 and '289 proceedings, communications are being sent to the address of record, namely, that of Halliburton Energy Services. Under 37 CFR 1.33(a), the Office will not engage in double correspondence. Accordingly, the patent owner is hereby required to notify the Office by filing the necessary papers (i.e., power of attorney and/or change of correspondence address) in the appropriate files so as to have but a single representative/address to whom/where all communications will be mailed. The notification must be submitted within one month of the mailing date of this decision. A courtesy copy of this communication will be sent to the firm of Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P.

Conclusion

Reexamination Control Nos. 90/007,108, 90/007,284 and 90/007,289 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 each of the files and to name but a single representative/address**. Upon receipt of the response, an Office action will issue in due course.

Any inquiry concerning this decision should be directed to Andres Kashnikow, Special Programs Examiner, at telephone No. (571) 272-4361.

Lissi Mojica Marquis, Director
Central Reexamination Unit

cc: Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P.
901 New York Avenue, N.W.
Washington, DC 20001

mcw

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MAILED

OCT 17 2006

CENTRAL REEXAMINATION UNIT

In re Streich et al
Reexamination Proceeding
Control No. 90/007,108
Filed: July 6, 2004
For: U.S. Patent No. 5,271,468

In re Streich et al
Reexamination Proceeding
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Filed: November 3, 2004
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In re Streich et al
Reexamination Proceeding
Control No. 90/007,289
Filed: November 8, 2004
For: U.S. Patent No. 5,271,468

DECISION
DISMISSING
PETITION

This is a decision on the patent owner petition filed October 3, 2006, titled "PETITION UNDER 37 C.F.R. § 1.182 REGARDING RECORDATION/TRANSCRIPTION OF ORAL CONFERENCES BETWEEN PATENT OWNER AND U.S. PATENT AND TRADEMARK OFFICE DURING THE MERGED PROCEEDINGS."

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

The fee set forth in 37 CFR 1.17(f) for a petition under 37 CFR 1.182 is $400, and has been paid by petitioner.

The petition is dismissed for the reasons set forth below.

DECISION

Petitioner has requested that the Office permit recordation or transcription of "any oral conferences between Patent Owner and personnel of the U.S. Patent and Trademark office" during the instant merged proceeding for Reexamination Control Nos. 90/007,108, 90/007,284, and 90/007,289.

This request will not be granted.

MPEP 2281 states:

> "[O]nly *ex parte* interviews between the examiner and patent owner and/or the patent owner's representative are permitted. Requests by reexamination requesters to participate in or to attend interviews will not be granted."

The relief requested by petitioner would, in effect, permit attendance by a third party at interviews (oral conferences), in addition to the examiner and the patent owner, by providing access to the content of the interview in a manner not contemplated by the *ex parte* reexamination statute. It is to be also to be noted that a stenographer, or other party facilitating recordation or transcription, would be, in effect, functioning as a representative to parties other than the patent owner and the Office (i.e., a representative to third parties) to record the content of the interview. This would not be justified, in view of the provisions and intent of the legislation and regulations to make reexamination an *ex parte* proceeding. *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 882 F.2d 1570, 11 USPQ2d 1866 (Fed. Cir. 1989)(a

reexamination is conducted *ex parte* after it is instituted); [1] *In re Opprecht*, 10 USPQ2d 1718 (Fed. Cir. 1989)(third parties do not participate before the Office). Thus, the requested relief cannot, and will not, be granted.

The recordation of an interview in *ex parte* reexamination is set forth as follows:

Pursuant to MPEP 2281:

> "The examiner must complete an Interview Summary form PTOL-474 for each interview held where a matter of substance has been discussed (see MPEP § 713.04)....The original should be made of record in the reexamination file, and a copy should be mailed to any third party requester.
>
> "The general procedure for conducting interviews and recording same is described at MPEP § 713.01 - § 713.04....
>
> "In every instance of an interview with the examiner, a patent owner's statement of the interview, including a complete written statement of the reasons presented at the interview as warranting favorable action, must be filed by the patent owner.... The requirement for a patent owner's statement of the interview cannot be waived by the examiner."

Pursuant to MPEP 713.04:

> "Applicant's summary of what took place at the interview should be carefully checked to determine the accuracy of any argument or statement attributed to the examiner during the interview.... If the record is complete and accurate, the examiner should place the

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[1] The Federal Circuit stated as follows as to third party requester participation:

"If reexamination is granted, a third-party requester has the right to reply to any statement submitted by the patent owner in response to the PTO's order granting reexamination (section 304). **The statute gives third-party requesters no further, specific right to participate in the reexamination proceeding. Indeed, the statute specifically prohibits further participation by third-party requesters during reexamination.** ***See*** **35 U.S.C. § 305 ("[a]fter the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination").** Thus, a reexamination is conducted *ex parte* after it is instituted. *See In re Etter*, 756 F.2d 852, 859 n.6, 225 USPQ 1 , 5-6 n.6 (Fed. Cir.), *cert.* denied, 474 U.S. 828 (1985)." *Id.*, at 1573, at 1868-1869. [Emphasis added in bold]

The Federal Circuit also reviewed the legislative history of the *ex parte* reexamination statute, and concluded that:

"... contrary to Syntex's view, the legislative history provides no support for Syntex's position that it has a right to challenge the reexamination decision." *Id.*, at 1574, at 1869

indication "Interview record OK" on the paper recording the substance of the interview along with the date and the examiner's initials."

The information generated by the above procedure provides the entirety of the substance of the interview that is made of record.[2] That record is available to the public and any forum that has an occasion to review the patent that was reexamined.

CONCLUSION

The petition is dismissed.

Jurisdiction over the reexamination proceeding is being returned to the Central Reexamination Unit.

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

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

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[2] Pursuant to 37 CFR 1.2, "[t]he action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt."

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

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REEXAM UNIT

John W. Chestnut
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(For Third Party Requester)

In re Reexamination Proceeding :
Crabb et al. :
Control No. 90/007,290 : DECISION GRANTING PETITION
Filed: November 12, 2004 :
U.S. Patent No. 6,109,193 :
Attorney Docket No. A9145 :

This is a decision on the copy of the petition under 37 CFR 1.137(b) filed by the patent owner on April 11, 2006, for entry of late papers based upon unintentional delay.

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

In response to a telephonic communication between counsel G. Rowan and Senior Legal Advisor K. Schor, on April 11, 2006, inter alia, copies of a petition, a $1,500.00 check for a petition fee, an amendment under §1.530, a Revocation of Power of Attorney with New Power of Attorney and Change of Correspondence Address, and a Statement Under §3.73(b) were filed. Petitioners argue that the present petition, the check for the $1,500.00 petition fee and the amendment under §1.530 were filed on March 16, 2006; and a Revocation of Power of Attorney with New Power of Attorney and Change of Correspondence Address, and a Statement Under §3.73(b) were filed on March 22, 2006. As evidence thereof, petitioners submitted a copy of their postcard receipts which acknowledge receipt of the present petition, the check for the $1,500.00 petition fee and the amendment under §1.530 as filed on March 16, 2006; and a Revocation of Power of Attorney with New Power of Attorney and Change of Correspondence Address, and a Statement Under §3.73(b) as filed on March 22, 2006.

A review of the record reveals $1,500.00 for the petition fee was paid on March 16, 2006; however, neither a petition, an amendment under §1.530, a Revocation of Power of Attorney with New Power of Attorney and Change of Correspondence Address nor a Statement Under §3.73(b) have been located in the Image File Wrapper.

In view of the above, the evidence is convincing that present petition, the check for the $1,500.00 petition fee and the amendment under §1.530 were filed on March 16, 2006; and a Revocation of Power of Attorney with New Power of Attorney and Change of Correspondence Address, and a Statement Under §3.73(b) were filed on March 22, 2006. The petition, the amendment under §1.530, the Revocation of Power of Attorney with New Power of Attorney and Change of Correspondence Address, and the Statement Under §3.73(b) submitted on April 11, 2006, will be used to make these items of record on the aforementioned dates in the Image File Wrapper.

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 - an amendment under §1.530 (item 1), a $1500.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3).

The petition for entry of the late papers is granted.

Jurisdiction over the reexamination proceeding is being returned to Central Reexamination Unit (CRU), Art Unit 3993 for further examination and consideration of the amendment under §1.530 filed April 11, 2006, along with the present petition, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Matthew Graham, in CRU Art Unit 3993, who can be reached at 571-272-7116.

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

Fred A. Silverberg

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

Kenneth M. Schor

Conferee: Kenneth M. Schor

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CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

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(For Third Party Requester)

In re Reexamination Proceeding :
Crabb et al. :
Control No. 90/007,290 : DECISION GRANTING PETITION
Filed: November 12, 2004 :
U.S. Patent No. 6,109,193 :
Attorney Docket No. A9145 :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on July 24, 2006, by facsimile transmission, for entry of late papers based upon unintentional delay.

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

37 CFR 1.137(b) states:

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

On June 1, 2006, an interview on the substance of the reexamination proceeding was held in the Office with a copy of an interview summary record being given to the patent owner. The mandatory statement of the substance of the interview, however, was not filed by the patent owner within the one month period set forth in the interview summary record.

On July 24, 2006, the present petition, petition fee and the mandatory statement of the substance of the interview were filed by facsimile transmission.

The present petition under 37 CFR 1.137(b) includes the requisite response (a statement of substance of interview - item 1), a $1500.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3).

The petition for entry of the late papers is granted.

$1,500.00 has been charged to counsel's deposit account no. 19-4880 in accordance with the present petition.

Jurisdiction over the reexamination proceeding is being returned to Central Reexamination Unit (CRU), Art Unit 3993, for further examination, and consideration of a statement of substance of interview filed July 24, 2006, along with the present petition and consideration of a supplemental amendment filed July 11, 2006, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Matthew Graham, in CRU Art Unit 3993, who can be reached at 571-272-7116.

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

Fred A. Silverberg

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

Kenneth M. Schor

Conferee: Kenneth M. Schor

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REEXAM UNIT

R. Joseph Trojan
TROJAN LAW OFFICES
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(For Patent Owner)

Enclosures: (1) Patent Owner's Supplemental Statement Pursuant to 37 C.F.R. 1.530 and Petition for Extension of time Pursuant to 37 C.F.R. 1.550(c) filed May 24, 2005.
(2) Patent Owner's Supplemental Statement Pursuant to 37 C.F.R. 1.530 and Petition for Extension of time Pursuant to 37 C.F.R. 1.550(c) filed August 17, 2005.
(3) Patent Owner's Revised Statement Pursuant to 37 C.F.R. 1.530 filed October 18, 2005.
(4) Petition for Extension of Time Pursuant to 37 C.F.R. 1.550(c) filed October 18, 2005.

Richard B. Klar
28 East Old Country Road
Hicksville, NY 11801

(For Requester)

In re Hidehei Kageyama et al. Reexamination Proceeding Control No.: 90/007,294 Filed: November 15, 2004 For: U.S. Patent No.: 4,714,365 In re Hidehei Kageyama et al. Reexamination Proceeding Control No.: 90/007,620 Filed: July 1, 2005 For: U.S. Patent No.: 4,714,365	DECISION TO *SUA SPONTE* MERGE *EX PARTE* REEXAMINATION PROCEEDINGS AND DISMISS PETITION TO VACATE REEXAMINATION ORDER AND TERMINATE REEXAMINATION

This is a decision on the August 19, 2005, patent owner PROTEST UNDER 37 C.F.R. 1.291(a), taken as a petition under 37 CFR 1.181 to vacate the order granting the above-captioned 90/007,620 reexamination proceeding as an *ultra vires* action taken by the Office.[1] Requester's opposition to the patent owner protest was received August 31, 2005.

[1] The order granting the 90/007,620 reexamination request was mailed prior to the Examiner's consideration of the protest by the patent owner received on August 19, 2005. Accordingly, the protest is taken as a petition to vacate the '7620 order for reexamination of the '365 patent.

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This is also a decision (a) to *sua sponte* merge the two above-captioned *ex parte* reexamination proceedings into a single proceeding, and (b) to close and return certain papers.

The two proceedings, the protest, and the opposition are before the Office of Patent Legal Administration.

SUMMARY

For the reasons set forth below, the protest under 37 CFR 1.291, taken as a petition under 37 CFR 1.181, is dismissed. The January 24, 2005, order granting reexamination in the 90/007,294 proceeding and the August 23, 2005, order granting reexamination in the 90/007,620 proceeding remain intact.

Pursuant to 37 CFR 1.565(c), reexamination proceedings 90/007,294 and 90/007,620 are *sua sponte* merged into a single proceeding.

The owner statements filed May 24, 2005, August 17, 2005, and October 18, 2005, (and the petition for extension of time filed October 18, 2005) will be closed by the CRU from the public record of the reexamination file, and copies of same are being returned to the patent owner with this decision.

A single decision is being issued to address the above matters.

REVIEW OF FACTS

1. U.S. Patent No. 4,714,365 (the '365 patent) issued on December 22, 1987.

2. A first request for reexamination of the '365 patent was filed by the patent owner on November 15, 2004. The first request was assigned control No. 90/007,294 (the '7294 proceeding).

3. Reexamination was ordered in the '7294 proceeding on January 24, 2005.

4. A patent owner statement under 37 CFR 1.530 was filed in the Office on March 23, 2005, for the '7294 proceeding.

5. A supplemental patent owner statement, along with an extension of time, was filed in the Office on May 24, 2005, for the '7294 proceeding.

6. A second request for reexamination of the '365 patent was filed by a third party requester on July 1, 2005. The second request was assigned control No. 90/007,620 (the '7620 proceeding).

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7. A second supplemental patent owner statement in the '7294 proceeding, along with an extension of time, was filed in the Office on August 17, 2005.

8. A protest under 37 CFR 1.291(a) requesting denial of the request for reexamination of '365 patent in the '7620 proceeding was filed by the patent owner on August 19, 2005.

9. Reexamination was ordered for the '7620 proceeding on August 23, 2005.

10. An opposition from the third party requestor to the patent owner's protest under 37 CFR 1.291(a) in the '7620 proceeding was filed on August 31, 2005.

11. A patent owner's statement under 37 CFR 1.530 in the '7620 proceeding was filed on October 17, 2005.

12. A revised patent owner statement in the '7294 proceeding, along with an extension of time, was filed in the Office on October 18, 2005.

13. On December 13, 2005, the third party requestor filed a reply under 37 CFR 1.535 to the patent owner's statement, in the '7620 proceeding.

RETURN OF SUPPLEMENTAL PATENT OWNER STATEMENTS

37 CFR 1.530(b) states:

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

37 CFR 1.550(c) states, in part:

> The time for taking any action by a patent owner in an ex parte re-examination 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) (emphasis added).

The Order issued in the '7294 proceeding on January 24, 2005, provided the patent owner with a two-month time period for filing a statement regarding the new question of patentability. This two-month period expired on March 24, 2005. The patent owner filed a first supplemental patent owner statement and a petition for an extension of time on May 24, 2005. A second supplemental patent owner statement and petition for an extension of time were filed on August 17, 2005. Further, a revised patent owner

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statement and petition for an extension of time were filed on October 18, 2005. Pursuant to 37 CFR 1.550(c), any petition for an extension of time to file a statement regarding the new question of patentability must have been filed within the two-month period set in the Order (on or before March 24, 2005). The supplemental patent owner statements of May 24, 2005, and August 17, 2005, and the revised patent owner statement of October 18, 2005, as well as their accompanying petitions for extensions of time, were clearly filed after the expiration of the two-month period. Accordingly, they were not timely and will not be considered.

In addition to the supplemental statements not having been timely filed, they are improper papers and will not be considered, as follows:

37 CFR 1.540 states:

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

The examination stage of the present proceeding has not yet begun, as a first Office action on the merits has not yet been issued. Each of the present supplemental statements is not a "reply by the ex parte reexamination requester pursuant to § 1.535," since it is filed by the patent owner. Further, each submission is not a patent owner's statement pursuant to § 1.530, because the patent owner's statement pursuant to § 1.530 was already filed on March 23, 2005. Pursuant to 35 U.S.C. 304, the patent owner is given a reasonable period "within which he may file **a statement**." [Emphasis added] on the question of patentability raised in the order for reexamination. There is no provision in the statute for more than one statement, i.e., there is no provision for a second statement to supplement the first statement.

Since each of the present supplemental statements is not is not a "statement," nor a "reply," entry of same is barred under 37 CFR 1.540.

In view of the above, the three supplemental patent owner statements are improper submissions under 37 CFR 1.530(b) and under 37 CFR 1.540. Accordingly, the submissions (and Petition for Extension of Time Pursuant to 37 C.F.R. 1.550(c) filed October 18, 2005) will be closed from the public record of the reexamination file and copies of the submissions are being returned with this decision. MPEP 2267. See *In re Knight*, 217 USPQ 294 (Comm'r Pat. 1982); *Patlex Corp. v Mossinghoff*, 226 USPQ 985, 986 (Fed. Cir. 1985). The present decision will, however, be made of record in the reexamination file.

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DECISION ON PETITION

35 USC 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."

MPEP 2246, Part I, states, in part:

> "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 no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained. "Appropriate circumstances" under 37 CFR 1.181(a)(3) exist to vacate the order granting reexamination where, for example:
>
> ...
>
> "(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).
>
> "As to (E) above, the decision of *In re Recreative Technologies Corp.*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996) is to be noted."

MPEP 2242, Part II.A., states, in part:

> "A "substantial new question of patentability" is not raised by prior art presented in a reexamination request if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996)."
>
> "In a decision to order reexamination made on or after November 2, 2002, reliance on old art does not necessarily preclude the existence of a substantial new question of patentability (SNQ) that is based exclusively on that old art. See Public Law 107-273, 116 Stat. 1758, 1899-1906 (2002), which expanded the scope of what qualifies for a substantial new

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> question of patentability upon which a reexamination may be based. 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."[2]

In this instance, the patent owner urges that the Office has previously considered (in the currently pending '7294 reexamination proceeding) the questions of patentability of the '365 patent claims on which the order for reexamination in the '7620 proceeding is based. Accordingly, the patent owner's protest is taken as a petition to vacate the '7620 order for reexamination of the '365 patent as an *ultra vires* action taken by the Office.

Review of the requests for reexamination

The '7294 request for reexamination requested that claims 1-4 of the '365 patent be reexamined for anticipation under 35 U.S.C. § 102 and for obviousness under 35 U.S.C. § 103 in view of US Patent No. 4,171,170 to Kageyama et al., European Patent Application No. 0 093 815 to Kageyama et al., and UK Patent Application No. 2 080 206 to Kageyama et al.[3] In the '7294 request, the patent owner states that these publications raise a substantial new question of patentability with respect to claims 1-4 of the '365 patent. The patent owner also describes how each publication individually applies to the claims of the '365 patent. Further, the '7294 request merely includes a generic assertion that the combination of the three publications does not render the claims of the '365 patent obvious under 35 U.S.C. § 103.

The '7620 request for reexamination relies on the same three publications[4] as relied upon in the '7294 proceeding when asserting that a substantial new question of patentability exists. The request in the '7620 proceeding sets forth interpretations and applications of each publication that are not present in the '7294 proceeding. For example, the '7620 request provides a detailed explanation of how the combination of these three publications applies to claims 1-3 of the '365 patent. Such an interpretation and application of these publications is not raised in the '7294 proceeding. Additionally, the '7620 request provides an interpretation and application of US Patent No. 4,171,170 to Kageyama et al. with respect to claim 4 that is not advanced in the '7294 proceeding.

Review of the Patent Owner's Argument for Vacatur

The patent owner argues that the request for reexamination in the '7620 proceeding fails to raise a "material new question of patentability in addition to those raised" by the

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[2] See *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351 (B.P.A.I. 1984).
[3] These documents do not appear to have been considered during the prosecution of the '365 patent.
[4] US Patent No. 4,171,170 to Kageyama et al., European Patent Application No. 0 093 815 to Kageyama et al., and UK Patent Application No. 2 080 206 to Kageyama et al.

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patent owner in the '7294 proceeding.[5] The patent owner asserts that the "same questions of patentability based on the same three references are already being decided by the USPTO" in the '7294 proceeding. The patent owner also asserts that by virtue of these publications being before the examiner, the manner of combining the three publications suggested in the second request is already being considered by the Office in the '7294 proceeding. As evidence of these assertions, patent owner appended a copy of the request for reexamination in the '7294 proceeding to the protest received in the '7620 proceeding.

Review of the orders for reexamination

From a review of both reexamination proceedings, the three publications forming the basis for the order in the '7294 proceeding also form the basis for the order in the '7620 proceeding. However, as discussed above, the request for *ex parte* reexamination filed in the '7620 proceeding raises substantial new questions of patentability that were not raised in the '7294 proceeding. These substantial new questions of patentability are found in the interpretations of the cited publications by the third party requestor and the application of these interpretations to the claims of the '365 patent. For example, the interpretation and application of US Patent No. 4,171,170 to Kageyama et al. set forth in the '7620 request with respect to claim 4 raises a substantial new question of patentability that has not been raised in the '7294 proceeding.

As set forth in MPEP § 2242, a substantial new question of patentability "may be based solely on old art where the old art is being presented/viewed in a new light, or in a different way." The request for reexamination in the '7620 proceeding interprets and applies the publications in a new light and in a different way. Accordingly, it presents a substantial new question of patentability.

Finding:

In *Hein v. Godici*, 143 F.Supp.2d 593, 601 (E.D.Va. 2001), the Court stated, in a decision seeking termination of reexamination based on the absence of a new question of patentability:

> "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:

[5] The patent owner states that a "material" new question of patentability has not been raised. However, the standard is not whether a material new issue has been raised; rather, it is whether or not a substantial new question of patentability has been raised. See 35 USC 303(a); 37 CFR § 1.515.

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> "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 the patent owner has not shown the Office to have "clearly exceeded its statutory authority" nor acted "in brazen defiance of its statutory authorization" in the Office determination that the questions of patentability raised in the '7620 request were not previously considered in the pending '7294 reexamination proceeding. The petition is thus dismissed, and the two reexamination proceedings will continue.

DISCUSSION REGARDING MERGER

Under 37 CFR 1.565(c):

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

As evidenced by the above review of facts, reexamination control No. 90/007,294 and reexamination control No. 90/007,620 are currently pending. Since the order to reexamine has been mailed in both reexamination proceedings, a decision under 37 CFR 1.565(c) is timely.

I. Merger of Proceedings

The above-captioned 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

The patent owner is required to maintain identical amendments in the two 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(c).

A review of the reexamination files for the proceedings of reexamination control Nos. 90/007,294 and 90/007,620 shows that the preliminary amendment filed in the '7294 proceeding has not been filed in the '7620 proceeding. Since the claims in both proceedings are not identical, the patent owner is given **ONE (1) MONTH** from the mailing date of this decision to provide an amendment that makes the claims the same in each proceeding.

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III. Conduct of the Merged Proceeding

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

2. In the event that a housekeeping amendment is not timely submitted, any claim 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. Each Office action issued by the examiner will take the form of a single action that jointly applies to both reexamination proceedings. Each action will contain identifying data for both cases, and each action will be entered into both files (which will be maintained as separate files).

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

5. 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 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.

4. 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.

CONCLUSION

1. The protest under 37 CFR 1.291(a), taken as a petition under 37 CFR 1.181, is dismissed.

2. The '7294 and '7620 reexamination proceedings are merged into a single proceeding.

3. The patent owner is given **ONE (1) MONTH** from the mailing date of this decision to provide, pursuant to Part II of the merger decision, a housekeeping amendment, placing the same amendments in both cases of the present merged proceeding.

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4. Jurisdiction of the merged reexamination proceeding is returned to the Central Reexamination Unit (CRU).

5. The untimely patent owner statements filed May 24, 2005, August 17, 2005, and October 18, 2005, (and the petition for extension of time filed October 18, 2005) will be closed by the CRU from the public record of the reexamination file, and copies of same are being returned to the patent owner with this decision.

6. The examiner should not issue an Office action for the present merged proceeding of the reissue and reexamination proceedings until after the earlier of (a) the submission of the housekeeping amendment to place the same amendments in both cases or (b) the expiration of the ONE (1) month period from the mailing of this decision for filing the amendment.

7. Telephone inquiries related to this decision should be directed to Brian E. Hanlon, Legal Advisor, at (571) 272-5407, or in his absence, Kenneth Schor, Senior Legal Advisor, at (571) 272-7710.

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

May 5, 2006
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Joseph E. Palys (For Patent Owner)
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REEXAM UNIT

Daniel R. McClure (For Third Party Requester)
Thomas, Kayden, Horstemyer &
Riseley, LLP
100 Galleria Pkwy.
Suite 1750
Atlanta, GA 30339

Enclosure: Third party requester petition filed January 24, 2006.

In re Wu	:	
Reexamination Proceeding	:	DECISION DISMISSING
Control No. 90/007,303	:	PETITION AND RETURNING
Filed: November 15, 2004	:	IMPROPER PAPER
For: U.S. Patent No. 6,765,788	:	

This is a decision on the third party requester petition filed January 24, 2006, titled "REQUESTER'S PETITION TO DIRECTOR UNDER 37 C.F.R. §§ 1.181 AND 1.182."

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

The fee set forth in 37 CFR 1.17(f) for a petition under 37 CFR 1.182 is $400. The petition fee is being charged to the petitioner's deposit account No. 20-0778 as authorized by the petitioner in the last page of the petition.

The petition is <u>dismissed</u> and <u>returned</u> to the requester for the reasons set forth below.

DECISION

1. 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)."

The present petition of January 24, 2006, was filed after the period for active participation of the reexamination requester had ended. The present petition is not in compliance with the requirements of 37 CFR §§ 1.510 or 1.535, nor does the present petition qualify as a prior art statement under 37 CFR 1.501. Accordingly, it is an improper submission under the above quoted portions of 37 CFR 1.550. See *Syntex (USA) Inc. v. U.S. Patent and Trademark Office,* 11 USPQ 2d 1866, 1868-1869 (Fed. Cir. 1989).

As the present petition is not a proper submission, it will not be made of record in the reexamination file and is being <u>returned</u> to the third party requester. This decision will be made of record in the reexamination file. See also MPEP 2267.

2. Petitioner has requested that the Office issue an order permitting requester to "arrange and pay for stenographic recordation of any and all interviews conducted between the Patent Owner's representative(s) and the Examiner in the proceeding."

MPEP 2281 states:

> "[O]nly *ex parte* interviews between the examiner and patent owner and/or the patent owner's representative are permitted. Requests by reexamination requesters to participate in or to attend interviews will not be granted."

The relief requested by petitioner would permit attendance by a third party in interviews, in addition to the examiner and the patent owner. It is also to be noted that the requested stenographer would be functioning as a representative of the third party requester to record the content of the interview. This third party intervention requested in the petition would not be justified, in view of the intent of the legislation and rules to make reexamination an *ex parte* proceeding. *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 11 USPQ2d 1866, 1869 (Fed. Cir. 1989) (a reexamination is conducted *ex parte* after it is instituted); *In re Opprecht*, 10 USPQ2d 1718 (Fed. Cir. 1989)(third parties do not participate before the Office). Thus, the requested relief cannot be granted.

The recordation of an interview in *ex parte* reexamination is set forth as follows:

Pursuant to MPEP 2281:

> "The examiner must complete an Interview Summary form PTOL-474 for each interview held where a matter of substance has been discussed (see MPEP § 713.04)....The original should be made of record in the reexamination file, and a copy should be mailed to any third party requester.
>
> "The general procedure for conducting interviews and recording same is described at MPEP § 713.01 - § 713.04....
>
> "In every instance of an interview with the examiner, a patent owner's statement of the interview, including a complete written statement of the reasons presented at the interview as warranting favorable action, must be filed by the patent owner.... The requirement for a patent owner's statement of the interview cannot be waived by the examiner."

Pursuant to MPEP 713.04:

> "Applicant's summary of what took place at the interview should be carefully checked to determine the accuracy of any argument or statement attributed to the examiner during the interview.... If the record is complete and accurate, the examiner should place the indication "Interview record OK" on the paper recording the substance of the interview along with the date and the examiner's initials."

The information generated by the above procedure provides the entirety of the substance of the interview that is made of record. [1] That record is available to the public and any forum that has an occasion to review the patent that was reexamined.

CONCLUSION

The petition is dismissed, and it is returned to third party requester.

Jurisdiction over the reexamination proceeding is being returned to the Central Reexamination Unit.

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

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

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[1] Pursuant to 37 CFR 1.2, "[t]he action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt."

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Thomas J. Mielke
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401 N. Lake St.
Neenah, WI 54956

(For Patent Owner)

NOV 6 2006

George M. Cooper
Jones Tullar & Cooper PC
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Arlington, VA 22202

(For Third Party Requestor)

In re US Patent No. 5,899,896 of
SUPRISE *et al.*
Ex Partes Reexamination Proceeding
Control No. 90/007,304
Filed: November 17, 2004
Title: **ABSORBENT ARTICLE WITH FASTENING SYSTEM TO PREVENT DROOPING**

DECISION ON PETITION

The petition filed Septermber 18, 2006, under 37 C.F.R. § 1.181, is before the Director of the Central Reexamintion Unit. The petition seeks to invoke the Commissioner's Supervisory Authority to review the denial of entry of the amendment filed after final in ex partes reexamination.

The petition is **DENIED**.

M.P.E.P § 2272 states:

> *It is intended that prosecution before the examiner in a reexamination proceeding will be concluded with the final action. Once a final rejection that is not premature has been entered in a reexamination proceeding, the patent owner no longer has any right to unrestricted further prosecution. Consideration of amendments submitted after final rejection >and prior to, or with, the appeal< will be governed by the strict standards of 37 CFR 1.116. >Further, consideration of amendments submitted after appeal will be governed by the strict standards of 37 CFR 41.33.< Both the examiner and the patent owner should recognize that substantial patent rights will be at issue with no opportunity for the patent owner to refile under 37 CFR 1.53(b), >or< 1.53(d), ** and with no*

> *opportunity to file a request for continued examination under 37 CFR 1.114. Accordingly, both the examiner and the patent owner should identify and develop all issues prior to the final Office action, including the presentation of evidence under 37 CFR 1.131 and 1.132.*

Pursuant to 37 C.F.R. § 1. 116:

> *(b) After a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):*
>
> *(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;*
>
> *(2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or*
>
> *(3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.*

A review of the record reveals that the Examiner's final Action mailed March 30, 2006 was not premature, and appears to have been proper. A further review of the record reveals that the after final amendment filed May 30, 2006 does not comply with the requirements of 37 C.F.R. § 1. 116, as set forth above. Specifically, the amendment does not cancel any claims, nor does it make changes to comply requirement of form expressly set forth in a previous Office action. In fact, the amendment proposes adding two new claims and an extensive amendment to the specification. The proposed after final amendment also does not present any of the rejected claims in better form for consideration on appeal. Quite to the contrary, the amendment adds additional limitations to claim 1. Those limitations have never been before the examiner for consideration.

The remarks accompanying the after final amendment do not provide any showing of good and sufficient reasons why the amendment is necessary and was not earlier presented. In the petition, the Patent Owner argues that there are good and sufficient reasons why entry amendment is necessary and why the amendment was not presented earlier. Firstly, it is argued that entry of the amendment is necessary because it will overcome the rejections and place all the claims in condition for allowance, or failing that, in better form for appeal. The examiner has already commented on whether the claims are allowable or not, in the advisory action mailed September 11, 2006. Therefore, the reasons argued by the Patent Owner do not appear to be valid. Also, as pointed out above, the amendment adds additional limitations to the claims which have not been considered by the examiner. The addition of new limitations does not reduce the issues that the examiner must consider, nor does it place the claims in better condition for appeal.

Secondly, it is argued that there are good and sufficient reasons why the amendment was not presented earlier. The Patent Owner argues that the amendment was not presented earlier

because it was in response to the objections, and rejections raised by the examiner for the first time in the preceding Office action. The objections and rejections raised by the examiner resulted from an amendment filed by the patent owner which included the addition of new limitations to the claims. Patent Owner argues that the issues raised by the examiner were unanticipated. It is agreed that the specific objections and rejections may have been unanticipated, however, a response, in some form, to the amendments made by the Patent Owner should not have been un-expected. A substantial amendment like the one filed December 07, 2005, changed the scope of the claims considerably. As such, the Patent Owner should have anticipated the possibility of the examiner changing his position with respect to the claims.

The petition states that the Patent Owner is entitled to a Fair Opportunity to Obtain Patent Protection of Proper Scope. A review reexamination file does not reveal any irregularity in the examination, or handling of the file which would indicate that the Patent Owner has being treated unfairly.

In light of the above, it is apparent that the examiner did not err in denying entry of the after final amendment, since the examiner determined that the amendment did not meet all of the requirements of 37 C.F.R. § 1. 116. The examiner properly informed the Patent Owner of the decision and the reasons in the advisory action. Accordingly, the petition is denied.

Any inquiry concerning this decision should be directed to Andres Kashnikow, Special Program Examiner, at telephone No. (571) 272-4361.

Andres Kashnikow

Lissi M. Marquis, Director
Central Reexamination Unit

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(For Patent Owner)

MAILED

NOV 29 2006

CENTRAL REEXAMINATION UNIT

George M. Cooper
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Arlington, VA 22202

(For Third Party Requester)

In re Kimberly-Clark Worldwide, Inc.	:	DECISION GRANTING
Ex Parte Reexamination Proceeding	:	PETITION FOR
Control No.: 90/007,304	:	CONTINUED
Filed: November 17, 2004	:	REEXAMINATION
For: U.S. Patent No. 5,899,896	:	(37 CFR 1.182)

This is a decision on patent owner's "Petition Under 37 CFR 1.182 Seeking Relief In The Nature Of A Request For Continued Examination" filed by facsimile transmission on November 13, 2006. The petition is before the Office of Patent Legal Administration for decision.

FEES

Petitioner patent owner has authorized a charge against Deposit Account No. 19-1345 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. 5,980,667 (the '896 patent) issued on May 4, 1999.

2. A request for reexamination was filed by a third party requester on November 17, 2004, was assigned control No. 90/007,304, and is hereinafter referred to as the '304 reexamination proceeding.

3. Reexamination was ordered in the '304 reexamination proceeding on February 4, 2005.

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4. A patent owner's statement under 37 CFR 1.530 was not received in the '304 reexamination proceeding.

5. A non-final Office action was mailed in the '304 reexamination proceeding on October 7, 2005.

6. A timely response by the patent owner to the non-final Office action was received in the Office on December 7, 2005, and was entered into the record.

7. A final rejection was mailed in the '304 reexamination proceeding on March 30, 2006.

8. A timely proposed response by the patent owner to the final rejection was received in the Office on May 30, 2006.

9. An advisory action was mailed on September 11, 2006 refusing entry into the record of the May 30, 2006 proposed response after final rejection, and extending the period for filing a proper response to the final rejection to run through September 30, 2006, a Saturday.

10. On September 18, 2006, patent owner filed a petition under 37 CFR 1.181 seeking supervisory review of the refusal to enter the May 30, 2006 proposed response to the final rejection.

11. On October 2, 2006, a Monday, patent owner filed a Notice of Appeal together with an authorization to charge the appeal fee.

12. On November 6, 2006, the Central Reexamination Unit Director denied the relief requested by patent owner in the September 18, 2006 petition.

13. On November 13, 2006, patent owner filed the present 37 CFR 1.182 with authorization to charge the necessary petition fee.

14. On November 17, 2006, patent owner filed a petition for extension of time in order to allow adequate time for a decision on the November 13, 2006 petition under 37 CFR 1.182. The petition for extension of time is also pending before the Office of Patent Legal Administration.

DECISION

The present petition under 37 CFR 1.182 requests relief in the form of continued examination in the '304 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 March 1, 2005 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 an amendment and/or evidence filed after final rejection, the Notice provided that a patent owner could file a petition under 37 CFR 1.182 to seek continued reexamination, a relief that is not currently provided by an existing rule.

The present patent owner 37 CFR 1.182 petition requests relief in the form of entry of the previously filed May 30, 2006 amendment after final rejection (Amendment B). In the present 37 CFR 1.182 petition, patent owner points out that at present, patent owner's choices are to either accept cancellation of all patent claims or to appeal the final rejection. [1] Patent owner believes that the claims presently of record, *i.e.*, the finally rejected claims, are not of appropriate scope. Patent owner notes that although the Office has determined that the final rejection was proper, the final rejection was in fact based large part on a newly submitted prior art patent, as noted in the 37 CFR 1.181 petition filed on September 18, 2006, and the examiner's position as to that art is being addressed. Patent owner further states the belief that the entry of Amendment B will advance the prosecution and "provide Patent Owner with a full and fair opportunity to obtain the proper cope of patent protection on the invention described in the patent under reexamination." [2]

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 '304 reexamination proceeding for the purpose of entering the amendment after final rejection filed on May 30, 2006.

2. The examiner will reconsider patentability of the claims, as amended, 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.

---

[1] "Petition Under 37 CFR 1.182 ...", paragraph bridging pages 1 and 2.
[2] *Id.*, at page 2, last paragraph.

CONCLUSION

1. The petition under 37 CFR 1.182 is granted.

2. The prosecution of the present '304 reexamination proceeding is continued.

3. The finality of the May 30, 2006 Office action is withdrawn, and prosecution of the proceeding is reopened to the extent that the response submitted on May 30, 2006 will be addressed and treated as a response received after a first, non-final Office action.

4. The amendment filed with the present petition, 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. Jurisdiction over the present '304 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 Andres Kashnikow at (571) 272-4361.

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

sm
November 27, 2006

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(For Patent Owner)

MAILED

NOV 29 2006

CENTRAL REEXAMINATION UNIT

George M. Cooper
Jones Tullar & Cooper PC
P.O. Box 2266 Eads Station
Arlington, VA 22202

(For Third Party Requester)

In re Kimberly-Clark Worldwide, Inc. *Ex Parte* Reexamination Proceeding Control No.: 90/007,304 Filed: November 17, 2004 For: U.S. Patent No. 5,899,896	:	DECISION DISMISSING PETITION FOR EXTENSION OF TIME (37 CFR 1.550(c))

This is a decision on patent owner's "Petition For One-Month Extension Of Time To File Appeal Brief" filed on November 17, 2006.

FEES

Petitioner patent owner has authorized a charge against Deposit Account No. 19-1345 for the $200.00 petition fee under 37 CFR 1.17(g) for filing the present 37 CFR 1.550(c).

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 5,980,667 (the '896 patent) issued on May 4, 1999.

2. A request for reexamination was filed by a third party requester on November 17, 2004, was assigned control No. 90/007,304, and is hereinafter referred to as the '304 reexamination proceeding.

3. Reexamination was ordered in the '304 reexamination proceeding on February 4, 2005.

4. A patent owner's statement under 37 CFR 1.530 was not received in the '304 reexamination proceeding.

5. A non-final Office action was mailed in the '304 reexamination proceeding on October 7, 2005.

6. A timely response by the patent owner to the non-final Office action was received in the Office on December 7, 2005, and was entered into the record.

7. A final rejection was mailed in the '304 reexamination proceeding on March 30, 2006.

8. A timely proposed response by the patent owner to the final rejection was received in the Office on May 30, 2006.

9. An advisory action was mailed on September 11, 2006 refusing entry into the record of the May 30, 2006 proposed response after final rejection, and extending the period for filing a proper response to the final rejection to run through September 30, 2006, a Saturday.

10. On September 18, 2006, patent owner filed a petition under 37 CFR 1.181 seeking supervisory review of the refusal to enter the May 30, 2006 proposed response to the final rejection.

11. On October 2, 2006, a Monday, patent owner filed a Notice of Appeal together with an authorization to charge the appeal fee.

12. On November 6, 2006, the Central Reexamination Unit Director denied the relief requested by patent owner in the September 18, 2006 petition.

13. On November 13, 2006, patent owner filed a petition under 37 CFR 1.182 requesting continued prosecution in the '304 reexamination proceeding in the form of entry of the May 30, 2006 response after final rejection.

14. On November 17, 2006, patent owner filed the present petition for a one month extension of time, with authorization to charge the extension fee, in order to permit time for consideration of the November 13, 2006 patent owner petition.

DECISION

The patent owner petition under 37 CFR 1.182 has been reviewed, and a Decision granting the relief requested by patent owner has been prepared for mailing. Accordingly, the petition for extension of time to permit consideration of the 37 CFR 1.182 petition previously filed on November 13, 2006 is dismissed as being moot. The $200.00 petition fee required for the extension of time petition will be refunded to Deposit Account No. 19-1345.

CONCLUSION

1. The petition for extension of time under 37 CFR 1.550(c) is dismissed.

2. Jurisdiction over the present '304 reexamination proceeding is being forwarded to the Central Reexamination Unit for further handling and examination not inconsistent with the decision granting patent owner's November 13, 2006 37 CFR 1.182 petition.

3. The Central Reexamination Unit will refund the $200.00 fee for the extension of time petition.

4. Any further communications as to the merits of the reexamination proceeding should be directed to Central Reexamination Special Program Examiner Andres Kashnikow at (571) 272-4361.

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.

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

sm
November 27, 2006

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1/16/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

George M. Cooper

Jones Tullar & Cooper PC

P.O. Box 2266 Eads Station

Arlington, VA 22202

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007304

PATENT NO. 5,899,896

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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,304	11/17/2004	5899896	SUPRISE REEX	6346

EXAMINER

ART UNIT	PAPER NUMBER

7590 01/16/2007

Thomas J. Mielke
KIMBERLY-CLARK CORP.
401 N. Lake St.
Neenah, WI 54956

DATE MAILED: 01/16/2007

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

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Kimberly-Clark Corp.
401 N. Lake St.
Neenah,
WI 54956

(For Patent Owner)

MAILED

JAN 16 2007

CENTRAL REEXAMINATION UNIT

George M. Cooper
Jones Tullar & Cooper PC
P.O. Box 2266 Eads Station
Arlington, VA 22202

(For Third Party Requester)

In re Kimberly-Clark Worldwide, Inc. *Ex Parte* Reexamination Proceeding Control No.: 90/007,304 Filed: November 17, 2004 For: U.S. Patent No. 5,899,896	:	DECISION DISMISSING PETITION FOR MERGER OR STAY OF REEXAMINATION (37 CFR 1.182)

This is a decision on patent owner's "Petition Under 37 CFR 1.182 Requesting Merger Of Reexamination Proceeding And Pending Reissue Application Or, Alternatively, For Stay Of The Reexamination Proceeding In View Of The Reissue Application." The patent owner's petition was filed by facsimile transmission on December 5, 2006. The petition is before the Office of Patent Legal Administration for decision.

FEES

Petitioner patent owner has authorized a charge against Deposit Account No. 19-1345 for the $400.00 petition fee under 37 CFR 1.17(f) for filing the present 37 CFR 1.182 petition.

The petition is dismissed as being premature.

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 5, 899,896 (the '896 patent) issued on May 4, 1999.

2. A request for reexamination was filed by a third party requester on November 17, 2004, was assigned control No. 90/007,304, and is hereinafter referred to as the '304 reexamination proceeding.

3. Reexamination was ordered in the '304 reexamination proceeding on February 4, 2005.

4. A patent owner's statement under 37 CFR 1.530 was not received in the '304 reexamination proceeding.

5. A non-final Office action was mailed in the '304 reexamination proceeding on October 7, 2005.

6. A timely response by the patent owner to the non-final Office action was received in the Office on December 7, 2005, and it was entered into the record.

7. A final rejection was mailed in the '304 reexamination proceeding on March 30, 2006.

8. A timely proposed response by the patent owner to the final rejection was received in the Office on May 30, 2006.

9. An advisory Office action was mailed on September 11, 2006, refusing entry into the record of the May 30, 2006 proposed response after final rejection, and extending the period for filing a proper response to the final rejection to run through September 30, 2006, a Saturday.

10. On September 18, 2006, patent owner filed a petition under 37 CFR 1.181 seeking supervisory review of the refusal to enter the May 30, 2006 proposed response to the final rejection.

11. On October 2, 2006, a Monday, patent owner filed a Notice of Appeal together with an authorization to charge the appeal fee.

12. On November 6, 2006, the Central Reexamination Unit Director issued a decision denying the relief requested by patent owner in the September 18, 2006 petition.

13. On November 13, 2006, patent owner filed a petition under 37 CFR 1.182 pursuant to the "Notice of Changes In Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending" (the "O.G. Notice") published in the March 1, 2005 *Official Gazette*. In the petition, patent owner requested that prosecution in the '304 reexamination proceeding be reopened for the purpose of entry and consideration of the May 30, 2006 response to the final rejection.

14. On November 17, 2006, patent owner filed a petition for extension of time in order to permit adequate time for a decision on the November 13, 2006 petition under 37 CFR 1.182.

15. On November 29. 2006, the November 13, 2006 patent owner petition under 37 CFR 1.182 was granted in a decision of the Senior Legal Advisor of the Office of Patent Legal Administration, and the petition for extension of time was dismissed as being moot in view of the timely grant of the 37 CFR 1.182 petition.

16. On December 5, 2006, patent owner filed the present petition for merger. The petition indicates that patent owner has deposited an application to reissue the '896 patent.

17. On January 3, 2007, a final rejection was mailed in the '304 reexamination proceeding.

DECISION

A. Relevant Statutes, Regulations and Practice

35 U.S.C. § 305 provides, in part:

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

37 CFR 1.565(d) provides, in part:

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

MPEP § 2285 provides, in part:

> The general policy of the Office is that a reissue application examination and an *ex parte* reexamination proceeding will not be conducted separately at the same time as to a particular patent. ... The decision as to whether the proceedings are to be merged, or which proceeding **(if any)** is to be stayed is made in the Office of Patent Legal Administration (OPLA). ...
>
> A decision whether or not to merge the reissue application examination and the *ex parte* reexamination proceeding, or to stay one of the two proceedings, will not be made prior to the mailing of an order to reexamine the patent pursuant to 37 CFR 1.525. Until such time as reexamination is ordered, the examination of the reissue application will proceed. ...
>
> The decision on whether to merge the proceedings or stay a proceeding will be made on a case-by-case basis based upon the status of the various proceedings. Due consideration will be given to the finality of the reexamination requested. ...
>
> Where reexamination has already been ordered prior to the filing of a reissue application, the OPLA should be notified as promptly as possible **after the reissue application reaches the TC**, that the proceedings are ready for consideration of merger. ...
>
> In making a decision on whether or not to merge the reissue application examination and the reexamination proceeding, consideration will be given as to whether issues are raised in the reissue application that would not be proper for consideration in reexamination. **In addition, consideration will also be given to the status of the reexamination proceeding.** (Emphasis in bold added.)

B. Findings and Analysis

A review of the PALM/PAIR database does not show that an application to reissue the '896 patent has been received in the Office. Moreover, in accordance with MPEP § 2285, merger of the '304 reexamination proceeding and the reissue application for the '896 patent will not be considered until the reissue application reaches the Technology Center. In the absence of a reissue application that has been (a) granted a filing date, (b) accepted as being complete and ready for examination, and (c) forwarded to the Technology Center, consideration of the question of merger is premature. Accordingly, no consideration will be given to the presently requested merger.

For the same reason, no consideration will presently be given to the requested alternative relief of staying (suspending) the '304 reexamination proceeding. It would be premature to consider staying or suspending the '304 reexamination proceeding, which must be treated by the Office with special dispatch as required by 35 U.S.C. § 305, since a reissue application for the '896

patent has not been forwarded to the Technology Center. In fact, there is no indication of when a reissue application for the '896 patent might be forwarded to the Technology Center. It would also be premature to consider whether a limited suspension of the '304 reexamination proceeding is legally permissible despite the special dispatch requirement of 35 U.S.C. § 305, [1] and if so, whether a suspension of the '304 reexamination proceeding would be warranted in light of the relatively advanced stage of the '304 reexamination proceeding, as compared to the relatively recent filing of the reissue application.

ADDITIONAL DISCUSSION

At the point in time when an application to reissue the '896 patent is determined by the Office to be complete, and is forwarded to the Technology Center for examination, a renewed petition for merger or, in the alternative, to suspend the '304 reexamination proceeding, may be filed without additional fee. Any such renewed petition must explain, in detail, why merger, or in the alternative, suspension is necessary.

It has been noted that patent owner's November 13, 2006 petition under 37 CFR 1.182, by which patent owner requested entry of the response to the May 30, 2006 final rejection shows that the relief requested in the petition was to "permit the entry of Amendment B [2] for consideration and provide Patent Owner with a full and fair opportunity to obtain the proper scope of patent protection on the invention described in the patent under reexamination. " [3] The petition was filed on the basis set forth in the O.G. Notice (see Item 13 of the above REVIEW OF SALIENT FACTS), to obtain such relief as would be available when the Office proposes and adopts regulations permitting the filing of a "request for continued examination" (RCR). The petition was granted on that basis. [4] It now appears from the present patent owner petition [5] that an application to reissue the '896 patent was filed to continue the prosecution of the '304 reexamination proceeding. Any renewed petition for merger of a reissue application with the '304 reexamination proceeding, or for a stay of the latter, must explain why the filing of the reissue application was necessary, since the reissue application appears to be requesting the same relief that was granted in response to the November 13, 2006 petition.

CONCLUSION

1. The present patent owner petition is <u>dismissed</u> as being premature.

2. Merger between an application to reissue the '896 patent and the '304 reexamination proceeding will not be considered until any such reissue application is complete and is forwarded to the appropriate Technology Center for examination.

3. The question of suspension of the '304 reexamination proceeding will not be considered in view of an application to reissue the '896 patent, until such reissue application has been forwarded to the Technology Center for examination.

4. Patent owner may file a renewed petition requesting merger of an application to reissue the '896 with the '304 reexamination proceeding, or in the alternative, suspension of the '304

---

[1] See Ethicon v. Quigg, 878 F.2d 1422, 1427-1428 (Fed. Cir. 1989)
[2] Amendment B is the amendment after final action filed on May 30, 2006
[3] 37 CFR 1.182 petition filed on November 13, 2006, page 2, last paragraph.
[4] Decision on Petition (37 CFR 1.182), November 29, 2006, page 3.
[5] See page 5, first complete sentence.

reexamination proceeding, only after a reissue application for the '896 patent has been forwarded to the Technology Center for examination.

5. Any such renewed petition requesting merger or suspension must set forth the basis for filing the application for reissue of the '896 patent, for which merger with the '304 examination proceeding is requested.

5. Telephone inquiries relating 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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January 10, 2007

January 10, 2007
C:\Kiva\Kenpetmerger\ 7304_1.182 RCR merge with reissue dismissed.doc

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Kenneth C. Hill
Hill Law Firm
P.O. Box 2527
Fort Worth, TX 76113

(For Patent Owner)

MAILED

NOV 29 2007

CENTRAL REEXAMINATION UNIT

Gibbons, Del Deo, Dolan, Griffinger & Vecchione
1 Riverfront Plaza
Newark, NJ 07102-5497

(For Requester)

In re: Zwolinski	:
Reexamination Proceeding	: DECISION ON PETITION
Control No. 90/007,306	: FILED UNDER 37 CFR 1.181
Request Deposited: November 19, 2004	:
For: U.S. Patent No. 6,208,435	:

The *ex parte* reexamination is before the Director of the Central Reexamination Unit for consideration of the petition filed November 14, 2007 remailing of the office action of October 1, 2007. The petition is considered pursuant to 37 CFR 1.181 and no fee is required.

The petition is **DISMISSED AS MOOT**.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,208,435 (hereinafter, the '435 patent), issued to Zwolinski, on March 27, 2001.

2. On November 19, 2004, a third party deposited a Request for *Ex Parte* Reexamination of the '435 patent. The reexamination proceeding was assigned Control No. 90/007,306 (hereinafter, the '7306 proceeding).

3. The reexamination order was granted in the '7306 proceeding on December 29, 2004.

4. Later in prosecution, on October 1, 2007, a final rejection was mailed to Patent Owner at Felsman Bradley Gunter & Dillon, 201 Main Street, Suite 1400, Fort Worth, TX 76102.

5. On November 15, 2007, a final rejection was mailed to

Kenneth C. Hill
Hill Law Firm
P.O. Box 2527
Fort Worth, TX 76113

The office action of November 15, 2007, withdrew the office action of October 1, 2007 and reset the period for response to expire two months from the mail date of November 15, 2007.

DECISION

On November 14, 2007, Petitioner requested the office resend the office action of October 1, 2007. Before the petition of November 14, 2007 could be decided, the office issued a new action on November 15, 2007. Accordingly, petitioner's request is dismissed as moot.

CONCLUSION

1. Petitioner's request is dismissed as moot. The final office action mailed November 15, 2007 is before Patent Owner for response.

2. Any response to this decision should be directed to:

By Mail: Mail Stop *Ex Parte* Reexam"
Attn: Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

By hand: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

3. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929 or Mark Reinhart, at (571) 272-1611.

Eric Keasel For

Lissi M. Marquis
Director, Center Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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Robert Tendler
65 Atlantic Avenue
Boston, MA 02110

(For Patent Owner)

MAILED

JUL 10 2008

CENTRAL REEXAMINATION UNIT

Gibbons, Del Deo, Dolan, Griffinger & Vecchione
1 Riverfront Plaza
Newark, NJ 07102-5497

(For Third Party Requester)

In re: Zwolinski
Reexamination Proceeding
Control No. 90/007,306
Request Deposited: November 19, 2004
For: U.S. Patent No. 6,208,435

: **DECISION ON PETITION**
: **TO CONTINUE**
: ***EX PARTE***
: **REEXAMINATION**
: **PROCEEDINGS**

This is a decision on the June 19, 2008 patent owner Petition Under 37 CFR 1.182 and Request for Continued Reexamination.

The petition is before the Office of Patent Legal Administration.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182 has been charged to patent owner's credit card, pursuant to petitioner's instructions, as has been the notice of appeal fee of $510.

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

REVIEW OF FACTS

1) United States Patent No. 6,208,435 to Zwolinski (the '435 patent) issued on March 27, 2001.

2) A request for *ex parte* reexamination of the '435 patent was filed by a third party requester on November 19, 2004, and was assigned control number 90/007,306 (the '7306 proceeding).

3) An Order granting reexamination in the '7306 proceeding was mailed on December 29, 2004.

4) The Office issued a non-final action in the '7306 proceeding on November 7, 2005, and a second non-final action on October 5, 2006.

5) The Office mailed a final rejection in the '7306 proceeding on October 1, 2007.

6) The Office remailed the final rejection in the '7306 proceeding on November 15, 2007.

7) On February 19, 2008, patent owner filed a paper addressing the final Office action, including with it an affidavit..

8) On April 2, 2008, an advisory action was mailed indicating that the affidavit would not be entered, because is insufficient to establish evidence of conception of the invention claimed prior to the prior art date.

The present petition requesting continued reexamination of the '435 patent was filed on June 23, 2008, along with a notice of appeal.

DECISION ON PETITION UNDER 37 CFR 1.182

In the present petition, it is requested that the Office continue the prosecution of the instant reexamination proceeding to provide consideration of the February 19, 2008 response.[1] The petition asserts that the evidence submitted with that response will be persuasive with respect to acceptance of Applicant's Rule 131 Declaration to swear behind the cited prior art reference.

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

[1] Item 6 in the Review of Facts.

Reexamination While an Earlier Filed Reexamination is Pending."[2] Notice was provided therein that a second (or subsequent) reexamination would no longer be ordered on the basis of a "substantial new question of patentability" (SNQ) that is the same as a SNQ raised in an earlier pending reexamination. Notice was also provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding.

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

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

In this case, patent owner has advanced the following explanation of why the additional Affidavit and other evidence were not earlier presented: First, the inventor's attorney died, taking with him a large number of his records which could not be recovered. Second, the Office transmitted the final rejection to patent owner's late attorney on October 1, 2007, instead of the attorney for whom patent owner filed a power of attorney on January 17, 2006. Further, the inventor had believed that the records of his invention were stored in a storage unit which was damaged by a tornado, and existence of some of the records that had been taken and stored at a new location only came to light when the new location was searched. Finally, individuals are averred to only recently have been discovered to testify in the inventor's behalf as to conception of the invention, both individually and cumulatively.

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[2] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

Based on the facts and circumstances of the present situation, it is found that Petitioner patent owner's presentation of Affidavit and further evidence 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."

In view of the above and the fact situation presented by the present record, the petition is granted, and the prosecution in the above-noted reexamination proceeding is hereby continued. Prosecution is reopened for consideration of the February 19, 2008 response and affidavit. This paper 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 February 19, 2008 response and affidavit and then issue an Office action treating this paper as a patent owner response received **after** a first Office action.

CONCLUSION

1) The petition under 37 CFR 1.182 is granted.

2) The prosecution of the present '7306 *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 November 15, 2007 final Office action is withdrawn, and prosecution of the proceeding is reopened.

4) The February 19, 2008 response and affidavit will be entered [3] by the Central Reexamination Unit, and will then be considered by the examiner. These papers will be treated as a response by patent owner received **after** a first Office action.

5) Jurisdiction over the reexamination proceeding is being forwarded to the Central

[3] This decision takes no position on the propriety of the response. Any issues raised by the response will be addressed by the examiner in the next Office action.

Reexamination Unit for further handling and examination not inconsistent with this decision.

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

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

July 9, 2008
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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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,310	11/18/2004	6277919	060099-5001-00	5944

32692 7590 01/23/2006

3M INNOVATIVE PROPERTIES COMPANY
PO BOX 33427
ST. PAUL, MN 55133-3427

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/23/2006

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
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1/23/06

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

MORGAN LEWIS & BOCKIUS LLP

1111 PENNSYLVANIA AVENUE NW

WASHINGTON, DC 20004

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007310

PATENT NO. 6,277,919

ART UNI 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a 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

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United States Patent and Trademark Office
P.O. Box 1450
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3M Innovative Properties, Co.
PO Box 33427
St. Paul MN 55133-3427

For Patent Owner

Elizabeth C. Weimer
Morgan Lewis & Bockius LLP
1111 Pennsylvania Ave NW
Washington DC 20004

For Requester

Ex Parte Reexamination Proceeding
Control No. 90/007,310
Filed: November 18, 2004
For: US Patent No. 6,277,919

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

This is a decision on the petition filed January 19, 2006 to request a two-week extension of time pursuant to 37 CFR 1.550 for responding to the Office action dated December 23, 2005.

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

The petition is granted 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 December 23, 2005, 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 there is a need to consult with litigation counsel to review arguments made in the litigation regarding the same or similar prior art because outside counsel involved in the reexamination and litigation are different. The litigation has been stayed pending the outcome of the present reexamination proceedings. Upon receipt of the Office action, Patent owner engaged local counsel to facilitate proceedings. Consideration and review

of the litigation records and the outstanding Office action by new counsel are necessary. Additional time of two (2) weeks is requested to complete this review and to conduct a personal interview with the Examiner before filing a written reply. An extension of time until February 6, 2006 to facilitate the completion of the reply is requested.

Analysis and Findings

On balance, it is considered that the petition explains the "sufficient cause" for why an extension of time should be granted. The review of the litigation documents and the invalidity contentions provided in the Reexamination Request are essential to the preparation of a reply and cannot be accomplished by the present due date of January 23, 2006. It is clear that the Patent Owner is relying upon this consultation to prepare the response to the outstanding Office action. Patent owner is advised that a personal interview with the examiner on the issues raised in the Office action will **not** be considered to present a compelling reason in support of an additional extension of time.

Conclusion

1. The patent owner's petition for extension of time in which to file a response to the Office action dated December 23, 2005 is **granted**.

2. The Patent Owner's response is due February 6, 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.

Lissi M. Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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3M INNOVATIVE PROPERTIES, CO.
PO BOX 33427
ST PAUL MN 55133-3427

For Patent Owner

ELIZABETH C. WEIMER
MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON DC 20004

For Requester

COPY MAILED

JUL 10 2006

OFFICE OF PETITIONS

Ex Parte Reexamination Proceeding of:	:	
U.S. Patent No. 6,277,919	:	
Reexamination Control No.	:	
90/007,310	:	
For: POLYMER PROCESSING ADDITIVE	:	ON PETITION
CONTAINING A MULTIMODAL FLOUROPOLYMER	:	
AND MELT PROCESSABLE THERMOPLASTIC	:	
POLYMER COMPOSITION EMPLOYING THE SAME	:	

This is a decision on the petition filed March 26, 2006, under 37 CFR 1.182 requesting that the IDS filed February 21, 2006, be closed to the public and removed from the file record.

The petition is granted.

Petitioner (Patent Owner) requests the above-noted relief and acceptance of the concurrently submitted IDS in lieu of the previously filed IDS on the grounds that some of the previously submitted documents may contain unredacted information that was covered under a protective order arising from litigation concerning the above-captioned patent. It is agreed that, under the circumstances recited in the petition, expungement of the IDS is appropriate.

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

Brian Hearn

Brian Hearn
Petitions Examiner
Office of Petitions

OIPE JC99
MAR 16 2005
PATENT & TRADEMARK OFFICE

3-17-05

Reehan
$

CERTIFICATE OF EXPRESS MAIL

NUMBER EV317621174US

DATE OF DEPOSIT 16 March 2005

I hereby certify that this paper or fee is being deposited with the United States Postal Service "EXPRESS MAIL POST OFFICE TO ADDRESSEE" service under 37 C.F.R. 1.10 on the date indicated above and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Greta Dowden

Greta Dowden

PATENT

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

PETITION UNDER 37 C.F.R. §§ 1.181 AND 1.515

Attorney Docket No. 10286.0378.RXUS00
Reexamination Control No. 90/007,312
Patent No. 5,224,540
Art Unit: 3672
Examiner Zakiya N. Walker
Date: March 16, 2005

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

1. ☒ This is a Petition pursuant to 37 C.F.R. §§ 1.181 and 1.515 of the Examiner's denial of BJ Services Company's request for reexamination of U.S. Patent 5,224,540, assigned to Halliburton Energy Services ("Halliburton").

2. ☒ The name and address of the third-party requester is:
BJ Services Company
5500 Northwest Central Drive
Houston, Texas 77092

3. ☒ The Commissioner is hereby authorized to charge the fee of $130 to the deposit account of Howrey, Simon, Arnold and White, deposit account no. 01-2508/10286.0378.RXUS00.

4. ☒ It is certified that a copy of the petition (if filed by other than the patent owner) has been served in its entirety on the patent owner as provided in 37 CFR 1.33(c). The name and address of the party served and the date of service are:

William Shull
Halliburton Law Dept.
2101 City West Blvd.
Bldg. 1, Suite 200
Houston TX 77042

Richard L. Stroup
Elizabeth M. Burke
Finnegan, Henderson, Farabow,
Garrett & Dunner, LLP
1300 I Street, NW
Washington DC 20005

on March 16, 2005.

5. ☒ The requester's correspondence address (if different from No. 2 above);

☒ Attorney Name	J. Dean Lechtenberger				
Firm Name	Howrey Simon Arnold & White, LLP				
Address	2941 Fairview Park Drive Box 7				
City	Falls Church	State	Virginia	Zip	22042
Country	U.S.A.				
Telephone	713.787.1630	Fax	713.787.1440		

6. ☒ The patent is currently the subject of the following concurrent proceeding(s):

☐ a. Copending reissue Application No._____.
☒ b. Copending reexamination Control No. 90/007,107
☐ c. Copending Interference No._____.
☐ d. Copending litigation styled:

7. ☒ Direct all future correspondence to the following address:

Customer Number 23369
J. Dean Lechtenberger
Howrey Simon Arnold & White, LLP
2941 Fairview Park Drive, Box 7
Falls Church, Virginia 22042
(713) 787-1400

Date: 3-16-05

J. Dean Lechtenberger
Reg. No. 34,859
☐ Patent Owner
☐ Third Party Requester
☐ Attorney or Agent for Patent Owner
☒ Attorney or Agent for Third-Party Requester

OIPE JC99
MAR 1 6 2005
PATENT & TRADEMARK OFFICE

- Copy -

CERTIFICATE OF EXPRESS MAIL

NUMBER EV317621174US

DATE OF DEPOSIT 16 March 2005

I hereby certify that this paper or fee is being deposited with the United States Postal Service "EXPRESS MAIL POST OFFICE TO ADDRESSEE" service under 37 C.F.R. 1.10 on the date indicated above and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Greta Dowden

PATENT

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

PETITION UNDER 37 C.F.R. §§ 1.181 AND 1.515

Attorney Docket No. 10286.0378.RXUS00
Reexamination Control No. 90/007,312
Patent No. 5,224,540
Art Unit: 3672
Examiner Zakiya N. Walker
Date: March 16, 2005

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

1. ☒ This is a Petition pursuant to 37 C.F.R. §§ 1.181 and 1.515 of the Examiner's denial of BJ Services Company's request for reexamination of U.S. Patent 5,224,540, assigned to Halliburton Energy Services ("Halliburton").

2. ☒ The name and address of the third-party requester is:
BJ Services Company
5500 Northwest Central Drive
Houston, Texas 77092

3. ☒ The Commissioner is hereby authorized to charge the fee of $130 to the deposit account of Howrey, Simon, Arnold and White, deposit account no. 01-2508/10286.0378.RXUS00.

4. ☒ It is certified that a copy of the petition (if filed by other than the patent owner) has been served in its entirety on the patent owner as provided in 37 CFR 1.33(c). The name and address of the party served and the date of service are:

William Shull
Halliburton Law Dept.
2101 City West Blvd.
Bldg. 1, Suite 200
Houston TX 77042

Richard L. Stroup
Elizabeth M. Burke
Finnegan, Henderson, Farabow,
Garrett & Dunner, LLP
1300 I Street, NW
Washington DC 20005

on March 16, 2005.

5. ☒ The requester's correspondence address (if different from No. 2 above);

☒ Attorney Name	J. Dean Lechtenberger				
Firm Name	Howrey Simon Arnold & White, LLP				
Address	2941 Fairview Park Drive Box 7				
City	Falls Church	State	Virginia	Zip	22042
Country	U.S.A.				
Telephone	713.787.1630	Fax	713.787.1440		

6. ☒ The patent is currently the subject of the following concurrent proceeding(s):

☐ a. Copending reissue Application No._____.
☒ b. Copending reexamination Control No. 90/007,107
☐ c. Copending Interference No._____.
☐ d. Copending litigation styled:

7. ☒ Direct all future correspondence to the following address:

Customer Number 23369
J. Dean Lechtenberger
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Date: 3-16-05

J. Dean Lechtenberger
Reg. No. 34,859
☐ Patent Owner
☐ Third Party Requester
☐ Attorney or Agent for Patent Owner
☒ Attorney or Agent for Third-Party Requester

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MAR 1 6 2005
PATENT & TRADEMARK OFFICE

EXPRESS MAIL MAILING LABEL
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NUMBER EV317621174US
DATE OF DEPOSIT March 16, 2005
I hereby certify that this paper or fee is being deposited with the United States Postal Service "EXPRESS MAIL POST OFFICE TO ADDRESSEE" service under 37 C.F.R. 1.10 on the date indicated above and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.
Greta Dowden

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reexamination of U.S. Patent No. 5,224,540	Group Art Unit: 3672
Reexamination Control No.: 90/007,312	Examiner: Zakiya N. Walker
Reexamination Request Filed: November 22, 2004	Atty. Dkt. No.: 10286.0378.RXUS00/LEC

PETITION UNDER 37 C.F.R. §§ 1.181 AND 1.515

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

In accordance with 37 C.F.R. §§ 1.181(a)(1) and 1.515(c), BJ Services Company ("BJ" or "Requester") petitions the Director based on an action of the examiner in the *ex parte* reexamination of the above patent, which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court. Specifically, Requester petitions for review of the examiner's denial of BJ's request for reexamination of U.S. Patent No. 5,224,540, assigned to Halliburton Energy Services ("Halliburton"). The order denying the request for *ex parte* reexamination, attached as Exhibit 1, was mailed February 17, 2005. Requester asks that the Director grant BJ's request for reexamination.

STATEMENT OF FACTS

On June 27, 2002, Halliburton filed a patent infringement suit against Requester and Weatherford International, Inc. ("Weatherford"), in the Northern District of Texas alleging, *inter*

alia, infringement of U.S. Patent No. 5,224,540 ("the '540 patent"). Upon filing the suit, Halliburton moved for a preliminary injunction to stop Requester and Weatherford from making and using products that Halliburton alleged were infringing claim 3 of the '540 patent. The District Court denied Halliburton's motion for preliminary injunction in part because it found that the Defendants had raised substantial questions regarding the validity of claim 3 of the '540 patent in light of prior art not before the U.S. Patent and Trademark Office ("PTO") during the original prosecution of the patent. Instead of immediately filing for reexamination, Halliburton appealed the decision of the District Court to the Court of Appeals for the Federal Circuit, which upheld the denial of the preliminary injunction. Subsequently, Halliburton filed a reexamination request where Halliburton submitted to the PTO the prior art references that Requester and Weatherford submitted in opposition to the motion for preliminary injunction.

Halliburton only sought reexamination of claims 19 and 20 of the '540 patent (see Reexamination Control No. 90/007,107). Neither of the claims for which Halliburton sought reexamination were at issue during the preliminary injunction proceedings or asserted against Requester and Weatherford in the lawsuit. However, only four pages of Halliburton's 51-page request for reexamination mentions the two claims (claims 19 and 20), which were requested to be reexamined. In the remaining pages, Halliburton improperly "appealed" the District Court's order that found a likelihood that the asserted claims are invalid over the prior art. Halliburton's request includes numerous gratuitous statements designed to bolster the intrinsic record to support Halliburton's previously unsupported litigation contentions. *See, e.g.*, pages 5-12 of Halliburton's request for reexamination. These arguments are essentially the same arguments that the District Court and/or the Federal Circuit rejected. On September 16, 2004, the examiner determined that a substantial new question of patentability only existed as to the two claims and issued an order granting reexamination. Shortly thereafter, Halliburton moved to stay the litigation pending the outcome of the request for reexamination proceeding.[1]

[1] Instead of staying the case, the court, *sua sponte*, dismissed the lawsuit without prejudice, thereby allowing Halliburton to refile the lawsuit pending the outcome of the reexamination.

Both Requester and Weatherford submitted their own reexamination requests for the '540 patent. Weatherford's request, attached as Exhibit 2, was filed November 8, 2004. Requester BJ submitted its request (attached as Exhibit 3) on November 22, 2004. Weatherford's request (Reexamination Control No. 90/007,288) cited most of the same prior art as Requester, except for U.S. Patent No. 4,307,781 to Preston (the "Preston" patent) and the EZ Drill SV Squeeze Packer. Based on the prior art submitted by Weatherford, the examiner found a substantial new question of patentability as to all of the claims of the '540 patent. The same examiner, however, erroneously denied BJ's Request on the ground that it did not raise a substantial new question of patentability different from that raised by Weatherford.

POINTS TO BE REVIEWED

A second request for reexamination should be granted when there exits a substantial new question of patentability different from that raised in a pending reexamination. *See* MPEP § 2240 (8th ed. 2001) (Rev. 2, May 2004) ("If a requester includes in the second or subsequent request prior art which raised a substantial new question in the pending reexamination, reexamination should be ordered only if the prior art cited raises a substantial new question of patentability which is different than that raised in the pending reexamination proceeding.") Moreover, a substantial new question of patentability "may be based solely on old art where the old art is being presented [or] viewed in a new light, or in a different way ... in view of a material new argument or interpretation presented in the request." MPEP § 2258.01(A). Requester believes that it has presented substantial new questions of patentability different from that raised by Weatherford and, therefore, the examiner should have granted Requester's request.

For example, in denying Requester's request, the examiner found Preston cumulative of U.S. Patent No. 2,160,804 to Hall (the "Hall" patent), U.S. Patent No. 4,151,875 to Sullaway (the "Sullaway" patent), and U.S. Patent No. 1,684,266 to Fisher (the "Fisher" patent). According to the examiner, "Preston teaches a packer apparatus having upper and lower slips and a seal" and "does not add anything new to the configuration of the claimed apparatus." *See* Exhibit 1, p. 5. Requester respectfully traverses this contention. Requester cited Preston because Preston is directed to a retrievable packer, whereas, Fisher, Hall, and Sullaway are directed to permanent

packers. Halliburton has improperly tried to characterize its claimed invention as being directed to permanent packers and bridge plugs in an attempt to distinguish the prior art. *See, e.g.,* pages 5-12 of Halliburton's request for reexamination. More particularly, because the Baker all-fiberglass packers are retrievable, Halliburton contends that Baker teaches away from the claimed invention. Halliburton further contends that because the Baker packers are retrievable, the packers do not include a lower slip assembly, and thus, the Baker packers teach away from the specific configuration set forth in claim 3 of the '540 patent. Preston discloses a retrievable packer for use in a wellbore. The packer has a center mandrel, upper and lower slip means for grippingly engaging the wellbore in the set position and a packing means disposed on the mandrel for sealingly engaging the wellbore. The upper slip means of Preston is disposed above the packing means and the lower slip means is disposed below the packing means. This is the identical configuration of the apparatus of claim 3. Furthermore, Preston discloses the rocker-type slips (shown as item 218 in Fig. 1A of Preston) that are also shown as part of the Baker fiberglass Model D packer disclosed in the Baker Advertisement (attached as Exhibit 4 of BJ's Request as filed). Thus, Requester submitted that it would have been obvious to one of skill in the art to use the all fiberglass construction taught by Baker with the configuration taught by Preston, thereby invalidating claim 3 of the '540 patent.[2]

Weatherford did not cite Preston and, therefore, did not present this ground for invalidating claim 3 of the '540 patent. Since Fisher, Hall, and Sullaway do not disclose retrievable packers, and since Halliburton has (improperly) attempted to use the type of packer (i.e., permanent vs. retrievable) as a ground for distinguishing the prior art, Preston is not cumulative of these references. Thus, Requester has raised a substantial new question of patentability, and the Examiner improperly denied Requester's request for reexamination.

The examiner also determined that U.S. Patent No. 4,708,202 to Sukup (the "Sukup" patent) was before the PTO during the prosecution of the original patent and parent application. Consequently, the examiner concluded that Sukup did not raise a substantial new question of

[2] Halliburton has accused Requester and Weatherford of infringing claim 3 of the '540 patent and thus, the patentability of this claim is highly relevant to the parties.

patentability. *Id.* at 4. Unlike Weatherford, Requester addressed in its Request the prosecution of the parent application to the '540 patent, wherein the original examiner correctly concluded, and Halliburton acquiesced, that the claims of comparable scope to claim 1 of the '540 patent were anticipated by Sukup.[3] Halliburton's litigation/reexamination claim construction of the term "slip means . . . for grippingly engaging said wellbore when in a set position" in claim 1 of the '540 patent is inconsistent with the construction used by Halliburton and the original examiner during the prosecution of the '540 patent and its parent application. In applying the Sukup reference, BJ's Request for Reexamination presents a material new argument and/or interpretation that raises a substantial new question of patentability by pointing out that Sukup anticipates claim 1 using Halliburton's present (and erroneous) claim construction. *See* BJ's Request (Exhibit 3) at 12, 13, and 17-20 (detailing proper claim construction); *id.* at 26-27 (applying Sukup); *see also* MPEP § 2258.01A.

As pointed out in BJ's Request (Exhibit 3 at 12), Halliburton now argues that the term "slip means for grippingly engaging said wellbore when in a set position" is a means-plus-function limitation and must include the slips, slip wedges, and slip supports.[4] Because claim 1 of the '540 patent also requires that the "slip means" be at least partially made of non-metallic material, all that is required to satisfy this limitation, according to Halliburton's new construction, is a "slip means" having a slip, a slip wedge, or a slip support made of non-metallic material. However, as pointed out in Requester's Request for Reexamination at p. 17-19, during prosecution of the parent application (Application No. 719,740), the PTO correctly rejected claims of similar scope as anticipated by Sukup, which discloses a packer having slip wedges and slip supports made of non-metallic material.

---

[3] Claim 1 of the '540 patent is directed to a downhole apparatus for use in a well bore, said apparatus comprising: a center mandrel; and slip means disposed on said mandrel for grippingly engaging said well bore when in a set position, said slip means being *at least partially* made of a non-metallic material. (emphasis added)

[4] Halliburton has, on occasion, asserted that the "slip means" also includes "retaining means," as pointed out in BJ's Request for Reexamination, p. 12. Such a contention is clearly erroneous since the retaining means holds the slips in the initial position out of engagement with the wellbore to prevent premature setting of the slips. Furthermore, during the setting sequence the retaining means are destroyed and thus no longer exist when the claimed slip means grippingly engages the wellbore. *See, e.g.*, col. 3, lines 28-43, and col. 15, lines 50-60 and claim 19 of the '540 patent.

More particularly, original claims 21 and 24 of the parent application called for a downhole apparatus having a center mandrel and slip means comprising, respectively, a slip wedge and a slip support made of non-metallic material. *See* BJ's Request (Exhibit 3) at 18. Both of these claims were rejected as anticipated by Sukup. *Id.* However, the PTO allowed original claim 25 in the parent application, which called for a downhole apparatus having a center mandrel and slip means comprising slips made of non-metallic material. *Id.* In response to the rejections, Halliburton acquiesced and cancelled claims 21 and 24 and amended claim 25 to call for a downhole apparatus having a center mandrel and "slip means made of non-metallic material." *See id.* at 18.

As Requester's Request points out, Halliburton's litigation/reexamination construction of "slip means" to now includes slip supports and slip wedges attempts to recapture the claim scope originally claimed by claims 21 and 24 of the parent application: if only a portion of the "slip means" must be non-metallic, then the non-metallic slip wedge or slip support of Sukup satisfies the limitation. Requester has thus presented Sukup in a new light and in a different way (i.e., based on the prosecution history and Halliburton's erroneous claim construction). Consequently, Requester's Request presents a material new argument that raises a substantial new question of patentability with respect to Sukup. Weatherford's Request does not raise this argument Therefore, Requester raised a substantial new question of patentability that was not presented by previous Requests.

In its Request, Requester has also identified combinations of new and old art -- different from that identified by others -- that Requester asserts invalidates one or more claims of the '540 patent. Requester's combinations are based on its interpretations of what the prior art teaches. Specifically, Requester argues that at least the combination of Sukup in light of the Baker Publications invalidates claims 16-18, a combination that is not made by Weatherford and omitted by Halliburton. *Compare* Exhibit 3, pages 41-2 with Exhibit 2, pages 5-6, 25, 40-1 (noting in particular that on page 25 of Exhibit 2, Weatherford does not identify Sukup as relevant to these claims). Further, in its Request, BJ points out that high-strength synthetic resin includes nylon, glass-fiber filled materials, injected or molded thermoplastics and thermoset

synthetic resins. This teaching presented in BJ's Request at 42, when combined with the Baker Publications, which were not before the PTO during the original prosecution, invalidates all of these claims. Weatherford has not identified this teaching, nor has Weatherford applied it to these claims. Consequently, Requester has identified substantial new questions of patentability that are different from that identified by Weatherford.[5]

ACTIONS REQUESTED

For the reasons stated above, Requester believes that it has raised substantial new questions of patentability that are different from that raised by previous requests. Consequently, Requester asks the Director to withdraw the examiner's denial and grant Requester's request for reexamination of the '540 patent.

* * * *

As required by 37 C.F.R. § 1.181(d), an authorization to charge the fee for this petition to the Commissioner is indicated herein. The Commissioner is authorized to charge the required fee of $130.00 to Deposit Account No. 01-2508, referencing Order No. 10286.0378.RXUS00, per 37 C.F.R. 1.17(h). The undersigned representative authorizes the Commissioner to charge any additional fees under 37 C.F.R. 1.16 or 1.17 that may be required, or credit any overpayment, to Deposit Account No. 01-2508, referencing Order No. 10286.0378.RXUS00.

As required by 37 C.F.R. § 1.181(f), this petition is being filed within one month of the mailing date of the action or notice from which relief is requested and is therefore believed to be timely filed.

[5] Other combinations not mentioned in any prior request and based on arguments exclusively raised by Requester include the following: for claim 5 Hall alone or in combination with other art, including Fisher; for claims 14 and 21, Hall alone and in combination with the Baker Publications; for claims 5, 14, 21 and 25 Sukup in combination with the Baker Publications; and for claims 3 and 4 Fisher in combination with Sullaway. *See* BJ's Request, Exhibit 3, pp. 36-37, 39-41, and 43 and *compare* with Exhibit 2, pp. 38-41.

The undersigned representative requests the prompt consideration of this matter. In order to facilitate the resolution of any issues or questions presented by this paper, the Commissioner or the Examiner may directly contact the undersigned by phone to further the discussion.

Respectfully submitted,

Date: 3-16-05

J. Dean Lechtenberger
Reg. No. 34,859
Tel. 713.787.1630

Attorney for Requester
BJ SERVICES COMPANY

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Reexamination Control No. 90/007,312

FOR PATENT OWNER:

Finnegan Henderson Farabow
Garrett & Dunner LLP
1300 I Street NW
Washington, DC 20005

MAILED
FROM DIRECTORS OFFICE

JUN 0 2 2006

TECHNOLOGY CENTER 3600

DECISION ON PETITION UNDER 37 CFR 1.181 AND 1.515 FOR RECONSIDERATION OF DECISION ON REQUEST FOR REEXAMINATION

FOR REQUESTER:

J. Dean Lechtenberger
Howrey Simon Arnold & White, LLP
2941 Fairview Park Drive, Box 7
Falls Church, VA 22042

This is a decision on petitioner's petition filed March 16, 2005 under 37 CFR 1.181 and 1.515 requesting reconsideration of the February 17, 2005 Decision on Request for Reexamination. There is no fee required for this petition.

The petition is **GRANTED.**

A review of the above reexamination file indicates that a Reexamination request was filed on November 22, 2004 requesting reexamination of U.S. Patent 5,224,540. The request was denied primarily on the basis that the patent to Preston was cumulative of the patents to Hall, Sullaway, and Fisher, and that the Sukup patent was considered during the prosecution of the parent application.

The requester argues that the patent to Preston is not cumulative because Preston is drawn to a retrievable packer, while Hall, Sullaway and Fisher are drawn to permanent packers. This argument is found persuasive because of the fact that Preston is drawn to a retrievable packer. Therefore, even though Preston teaches the same structural limitations that were already taught by Hall, Sullaway, and Fisher, Preston teaches these limitations in the field of retrievable packers and not permanent packers. Thus, this would raise a substantial new question of patentability.

In regard to the Sukup patent, the requester argues that this reference is presented in a new light and a different way. This is not found persuasive because, as pointed out by requestor, the examiner originally rejected claims 21 and 24 having the limitation of a slip means comprising, respectively, a slip wedge and a slip support made of non-metallic material in view of the Sukup patent. However, the examiner allowed original claim 25 in the parent application that claimed the slip means comprising slips made of non-metallic material. Then, when the application was amended, claims 21 and 24 were canceled and claim 25 was rewritten into independent form. However, when claim 25 was rewritten, it merely claimed the slip means comprising a non-metallic material. It did not specifically claim that the slips are made of a non-metallic material. Therefore, since the limitations of the slip means comprising a slip wedge, a slip support, or a slip made of a non-metallic material have already been considered in view of the Suckup patent, the Suckup patent has not been presented in a new light or different way.

Since the petition has been granted, a shortened statutory period of 2-months for the Patent Owner to file a statement under 37 CFR 1.530 is set to commence with the mailing date of this decision.

The reexamination file will be returned to the supervisory patent examiner (SPE) of the art unit that will handle the reexamination for consideration of reassignment to another examiner.

SUMMARY: The petition and the request for reexamination are **GRANTED.**

Donald T. Hajec
Director
Patent Technology Center 3600
571-272-5150
bg/kjd: 2/7/06

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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AUG 21 2006

Richard L. Stroup & Elizabeth M. Burke
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(For Patent Owner)

Dean J. Lechtenberger
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2941 Fairview Park Drive, Box 7
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(For 3rd Party Requester)

Stephen H. Cagle
Howrey Simon Arnold & White LLP
750 Bering Drive
Houston, TX 77057

(For 3rd Party Requester)

Reexam Control No.: 90/007,107
Filed : July 6, 2004
For U.S. Patent No. : 5,224,540

Reexam Control No.: 90/007,288
Filed : November 8, 2004
For U.S. Patent No. : 5,224,540

Reexam Control No.: 90/007,312
Filed : November 22, 2004
For U.S. Patent No. : 5,224,540

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination proceedings are before the Director of the Central Reexamination Unit for consideration of merger as provided for in 37 CFR 1.565(c).

Reexamination in application control No. 90/007,107 was ordered in a decision mailed September 16, 2004. A timely owner's statement along with a preliminary amendment amending some claims and adding some new ones was filed November 16, 2004. No Office action has been issued.

Reexamination in application control No. 90/007,288 was ordered in a decision mailed December 29, 2004. Patent owner filed a notice waiving patent owner's right to file a patent

owner's statement on January 21, 2005. No amendment has been filed in this proceeding nor has an Office action been issued.

Reexamination in application control No. 90/007,312 was ordered in a decision mailed June 2, 2006. No patent owner's statement was filed (see interview Summary Record of August 7, 2006). No amendment has been filed in this proceeding nor has an Office action been issued.

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.

Requirement for Same Claims, Drawings, and Specification in All Three Proceedings

As noted above, the claims have been amended in the '107 reexamination proceeding by virtue of the preliminary amendment filed November 16, 2004. No amendments have been filed in the '288 and '312 proceedings. The patent owner is required to maintain identical claims, claim numbering, specifications, and drawings in each of the files. **Accordingly, patent owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in each of the three 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 all three proceedings. All papers issued by the Office or as filed by the patent owner will contain the identifying data for all three files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in triplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requesters and requesters will be sent copies of all papers mailed by the Office. See 37 CFR 1.565(d).

Conclusion

Reexamination Control Nos. 90/007,107, 90/007,288 and 90/007,312 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 each of the files.** Upon receipt of the response, an Office action will issue in due course.

Any inquiry concerning this decision should be directed to Andres Kashnikow, Special Programs Examiner, at telephone No. (571) 272-4361.

Lissi Mojica Marquis, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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a1

3M INNOVATIVE PROPERTIES COMPANY (For Patent Owner)
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HOVEY WILLIAMS (For Third Party Requester)
2405 GRAND BOULEVARD, SUITE 400
KANSAS CITY, MO 64108

MAILED

SEP 11 2007

CENTRAL REEXAMINATION UNIT

In re Reexamination Proceeding :
A. Miles et al. :
Control No. 90/007,315 : DECISION GRANTING PETITION
Filed: November 24, 2004 :
U.S. Patent No. 4,907825 :
For: SHEET AND DISPENSER PACKAGE THEREFOR :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on January 22, 2007, for entry of late papers based upon unintentional delay. The petition has just recently been forwarded to this Office for consideration. Any delay in considering the petition is regretted.

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 (Appeal Brief and an authorization to charge counsel's deposit account for the Appeal Brief fee - 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 on the Third Party Requester.

The petition for entry of the late papers is granted.

$2,000.00 ($1,500.00 for the petition fee and $500.00 for the Appeal Brief fee) has been charged to counsel's deposit account no. 13-3723 in accordance with the present petition.

Jurisdiction over the reexamination proceeding is being returned to Central Reexamination Unit (CRU) Art Unit 3993 for further examination and consideration of the Appeal Brief filed January 22, 2007, along with the present petition, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, David Reip, in CRU Art Unit 3993, who can be reached at 571-272-4702.

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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,315	11/24/2004	4907825		8278

32692 7590 09/11/2007
3M INNOVATIVE PROPERTIES COMPANY
PO BOX 33427
ST. PAUL, MN 55133-3427

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/11/2007

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.
90/007,315	11/24/2004	4907825		8278

32692 7590 09/14/2007

3M INNOVATIVE PROPERTIES COMPANY
PO BOX 33427
ST. PAUL, MN 55133-3427

EXAMINER
REIP, D

ART UNIT	PAPER NUMBER
3993	

DATE MAILED: 09/14/2007

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United States Patent and Trademark Office
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9/14/2007

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

HOVEY WILLIAMS LLP

2405 GRAND BOULEVARD

SUITE 400

KANSAS CITY,MO 64108

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007315

PATENT NO. 4,907,825

ART UNI 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a replly has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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In re Application of 4907825
Appl. No.: 90/007,315
Filed: November 24, 2004
For: Sheet and Dispenser Package Therefor

DECISION ON PETITION UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b), filed January 22, 2007, to expunge information from the above identified application.

The petition is granted.

Petitioner requests that a document entitled Declaration of Kelly Dahl executed August 30, 2004, filed January 22, 2007, be expunged from the record. Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

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

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

The expunged material has been removed from the official file.

Lissi Marquis Mojica
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.
90/007,317	11/23/2004	6425035	HOESE1/WAB	1634

25094 7590 03/17/2005

DLA PIPER RUDNICK GRAY CARY US, LLP
2000 University Avenue
E. Palo Alto, CA 94303-2248

EXAMINER
Fleming, Fritz

ART UNIT	PAPER NUMBER
2182	

DATE MAILED: 03/17/2005

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.
90/007,317	11/23/2004	6425035	HOESE1/WAB

EXAMINER
Fleming, Fritz

ART UNIT	PAPER
2182	

DATE MAILED: 03/17/05

Larry E. Servin
WANG, HARTMANN & GIBBS, PC
1301 Dove Street, #1050
Newport Beach, CA 92660

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

Commissioner of Patents and Trademarks

CC: DLA PIPER RUDNICK GRAY CARY US, LLP
2000 University Avenue
E. Palo Alto, CA 94303-22489

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.
90/007,317	11/23/2004	6425035	HOESE1/WAB

EXAMINER
Fleming, Fritz

ART UNIT	PAPER
2182	

DATE MAILED: 03/17/05

William A. Blake
JONES, TULLAR & COOPER, PC
P.O. Box 2226 Eads Station
Alexandiria, VA 22202

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

Commissioner of Patents and Trademarks

CC: DLA PIPER RUDNICK GRAY CARY US, LLP
2000 University Avenue
E. Palo Alto, CA 94303-2248

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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Steven R. Sprinkle Sprinkle Law Group 1301 W. 25th Street Suite 408 Austin, Texas 78705	)	**FOR OWNER**
Larry E. Severin Wang, Hartmann & Gibbs, PC 1301 Dove Street, #1050 Newport Beach, California 92660	)	**FOR FIRST THIRD PARTY REQUESTER**
William A. Blake Jones, Tullar & Cooper, PC P.O. Box 2226 Eads Station Alexandria, Virginia 22202	)	**FOR SECOND THIRD PARTY REQUESTER**
In re Hoese et al. Reexamination Proceeding Control No. 90/007,125 Filed: July 19, 2004 For: U.S. Patent No. 6,425,035	)	**DECISION *SUA SPONTE*, MERGING REEXAMINATION PROCEEDINGS**
In re Hoese et al. Reexamination Proceeding Control No. 90/007,317 Filed: November 23, 2004 For: U.S. Patent No. 6,425,035	)	

The above noted reexamination proceedings are before the Director of Technology Center 2100 for consideration of merger of the proceedings under 37 CFR § 1.565(c).

BACKGROUND

1. Patent No. 6,425,035 issued on July 23, 2002.

'7125 Proceeding

2. A first request for reexamination, Control No. 90/007,125 ('7125) was filed by the Third Party Requester on July 19, 2004.

3. Reexamination was ordered in the '7125 reexamination proceeding on September 22, 2004.

4. A Notification of litigation under 37 C.F.R. §1.565 filed by Patent Owner was received in the USPTO on December 13, 2004.

5. A Notification of concurrent proceedings under 37 C.F.R. §1.565 filed by Patent Owner was received in the USPTO on January 14, 2005.

6. A revocation and appointment of attorneys was filed on December 8, 2004.

7. A first Office action was mailed on February 7, 2005.

8. A Change of correspondence address for third party requester was filed on February 24, 2005.

'7317 Proceeding

9. A second request for reexamination, Control No. 90/007,317 ('7317) was filed by another Third Party Requester on November 23, 2004.

10. Reexamination was ordered in the '7317 reexamination proceeding on December 16, 2004.

11. A Notification of concurrent proceedings under 37 C.F.R. §1.565 filed by Patent Owner was received in the USPTO on January 14, 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 '7125 and '7317 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

cc: DLA Piper Rudnick Gray Cary US, LLP
Attn: Mark Berrier
2000 University Avenue
E. Palo Alto, California 94303-2248

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,664	06/12/2003	5537135		2094

90/007,322

7590 04/13/2005

Joseph J. Catanzaro
ABELMAN, FRAYNE & SCHWAB
150 East 42nd Street
New York, NY 10017-5612

EXAMINER
H. PHAM

ART UNIT	PAPER NUMBER
2861	

DATE MAILED: 04/13/2005

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

DO NOT USE IN PALM PRINTER

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Charles Gorenstein
BIRCH, STEWART, KOLASH & BIRCH
8110 Gatehouse Road, Suite 100 East
Falls Church, VA 22042-1248.

REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/006,664, 90/007,322

PATENT NO. 5,537,135 .

ART UNIT 2861 .

Enclosed is a copy of the latest communication from the Patent and Trademark Office in the above identified reexamination proceeding (37 CFR 1.550 (e)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the reexamination requester will be acknowledge or considered (37 CFR 1.550 (e)).

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Paper No. 15

Joseph J. Catanzaro
ABELMAN FRAYNE & SCHWAB
185 Asylum Street
150 East 42nd Street
New York NY 10017-5612

(for Patent Owner)

Charles Gorenstein
BIRCH, STEWART, KOLASH & BIRCH, LLP
8110 Gatehouse Road, Suite 100 East
Falls Church, VA 22042-1248

(for Third Party Requester)

In re Charles M. Hevener *et al.*
Reexamination Proceeding
Control No. 90/006,664
Filed: June 12, 2003
For: U.S. Patent No. 5,537,135

In re Charles M. Hevener *et al.*
Reexamination Proceeding
Control No. 90/007,322
Filed: November 30, 2004
For: U.S. Patent No. 5,537,135

DECISION MERGING
REEXAMINATION PROCEEDINGS

The above-identified reexamination files are before the Director of Examining Group 2850, Technology Center 2800, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 5,537,135 issued on July 16, 1996.

2. Reexamination Control No. 90/006,664 was filed by the third party requester on

June 12, 2003.

3. Reexamination was ordered in the '6664 reexamination proceeding on August 29, 2003.

4. A non-final Office action was issued on April 5, 2004, setting a two-month shortened statutory period for filing a reply.

5. A request for extension of time was filed on June 3, 2004.

6. The request for extension of time was granted in a decision mailed June 9, 2004, extending the shortened statutory period for filing a reply to July 5, 2004.

7. A further request for another extension of time of two weeks was filed on July 1, 2004.

8. The further request for extension of time was granted in a decision mailed July 8, 2004, extending the shortened statutory period for filing a reply to July 19, 2004.

9. A response to the Office action of April 5, 2004 was filed on July 16, 2004. This response contained no amendment to the patent.

10. Reexamination Control No. 90/007,322 was filed by the same third party requester on November 30, 2004.

11. Reexamination was ordered in the '7322 reexamination proceeding on February 4, 2005. The patent owner had the option of filing a patent owner's statement within two months of the date reexamination was ordered. 37 C.F.R. § 1.550(c). The two-month time period for filing a patent owner's statement expired April 4, 2005. No patent owner's statement has been received.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

As noted in the above noted facts, reexamination has been ordered in both of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is appropriate.

DECISION

I. Merger of Proceedings:

In accordance with 37 C.F.R. § 1.565(c), the '6664 and '7322 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Conduct of Merged Proceeding:

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

CONCLUSION

Reexamination Control Nos. '6664 and '7322 are merged. An Office action will be issued in due course.

Any inquiry concerning this decision should be directed to Hien H. Phan, Special Program Examiner, at telephone No. (571) 272-1606.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,327	12/01/2004	5804596	108064-00105	8711

4372 7590 03/06/2008

ARENT FOX LLP
1050 CONNECTICUT AVENUE, N.W.
SUITE 400
WASHINGTON, DC 20036

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/06/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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www.uspto.gov

Amy E.L. Schoenhard
Arent Fox LLP
1050 Connecticut Ave., NW, Suite 400
Washington, DC 20036-5339

(For Patent Owner)

Ex parte Majeed et al.
Reexamination Proceeding
Control No.: 90/007,327
Filed: December 1, 2004
For: U.S. Patent 5,804,596

: **DECISION ON PETITION**
: **TO CONTINUE**
: ***EX PARTE***
: **REEXAMINATION**
: **PROCEEDINGS**

MAILED

MAR 0 6 2008

CENTRAL REEXAMINATION UNIT

This is a decision on the February 11, 2008 patent owner Petition Under 37 CFR 1.182 to request continued reexamination.

The petition is before the Office of Patent Legal Administration.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182 has been charged to patent owner's deposit account, pursuant to petitioner's instructions.

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

REVIEW OF FACTS

1) U.S. Patent No. 5,804,596 (the '596 patent) issued on Sept. 8, 1998 with 8 claims.

2) A request for *ex parte* reexamination of the '596 patent was filed by the patent owner on December 1, 2004, and assigned control number 90/007,327 (the '7327 proceeding).

3) An Order granting reexamination of all of the claims of the '596 patent in the '7327 proceeding was mailed on February 4, 2005.

4) The proceeding progressed to the point where, on December 23, 2005, a final Office action was mailed, in which claims 1-34, then in the proceeding, were all rejected.

5) An improper Request for Continued Examination (RCE) with an amendment, affidavit, drawings and translation, was submitted on February 23, 2006. On March 9, 2006 the patent owner was notified that the amendment was improper as it did not comply with 37

CFR 1.530(d)-(j). Another response was filed on March 20, 2006.

6) In a decision mailed April 6, 2006, the improper RCE papers were returned to the patent owner and the amendment was placed in the file for consideration by the examiner as a response to the final rejection.

7) The response to the final rejection was considered and deemed not to overcome all of the rejections, as indicated in an advisory action mailed April 13, 2006. The advisory action indicated that the amendment would be entered upon filing an appeal.

8) The final rejection was appealed, and an examiner's answer was mailed November 7, 2006.

9) After an oral hearing on October 17, 2007, a decision by the BPAI was mailed on December 13, 2007. In the decision, the rejection of claims 31 and 32 under 35 U.S.C. 112, first paragraph, was reversed; the BPAI affirmed the rejections of (a) claims 1, 5, 9-10, and 31-34 under 35 U.S.C. 102(b) based on Kasuo, (b) claims 1, 5, 11-12, and 31-34 under 35 USC 102(b) based on Greenway III or Greenway IV, and (c) claims 1-34 under 35 USC 103 based on Kazuo.

10) The present petition to request continued reexamination of the '596 patent was filed on February 11, 2008. Included is a supplemental response amending claims 1, 9, 11, 13, 15, 17, 19, 21, 23, 25, 27, 29, 31, and 33 and cancelling claims 5-8, 10, 12, 14, 16, 18, 20, 22, 24, 26, 28, 30, 32, and 34. A notice of appeal to the U.S. Court of Appeals for the Federal Circuit was filed concurrently therewith. The present petition asserts that the proposed amendments to the claims are responsive to a new interpretation of claim terms by the BPAI and thus advances prosecution of the reexamination proceeding by overcoming the outstanding rejections of the claims.

DECISION ON PETITION UNDER 37 CFR 1.182

In the present petition, it is requested that the Office continue the prosecution of the instant reexamination proceeding to provide consideration of the February 11, 2008 response.[1]

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."[2] Notice was provided therein that a second (or subsequent) reexamination would no longer be ordered on the basis of a "substantial new question of patentability" (SNQ) that is the same as a SNQ raised in an earlier pending reexamination. Notice was also provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final

[1] Item 18 in the Review of Facts.
[2] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding.

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

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

In this instance, the patent owner has amended and canceled claims in response to a newly understood interpretation of the previously recited claim terms as explained in the BPAI decision. The patent owner proposes to amend the claims <u>with a more narrow term</u> in order to distinguish the claims from the applied prior art. The amendment could not have been presented earlier, as the patent owner was not aware of the claim term interpretation until receiving the BPAI decision. Based on the facts and circumstances of the present situation, it is found that petitioner patent owner's presentation of an amendment paper amending the claims in a manner directly responsive to the interpretation of the terms by the BPAI, in an attempt to distinguish the claims over the prior art, is a *bona fide* effort to advance the prosecution toward the issuance of a reexamination certificate. As such, the granting of the present petition is consistent with the requirement of 35 U.S.C. 305 to conduct reexamination proceedings "with special dispatch within the Office."

In view of the above and the fact situation presented by the present record, the petition is granted, and the prosecution in the above-noted reexamination proceeding is hereby continued. Prosecution is reopened for consideration of the February 11, 2008 Amendment. This paper 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 February 11, 2008 Amendment and then issue an Office action <u>treating this paper as a patent owner response received **after** a first Office action</u>.

CONCLUSION

1. The petition under 37 CFR 1.182 is granted.

2. The prosecution of the present '7327 *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 13, 2007 BPAI decision is withdrawn, and prosecution of the proceeding is reopened.

4. The February 11, 2008 response will be entered [3] by the Central Reexamination Unit, and will then be considered by the examiner. **These papers will be treated as a response by patent owner received after a first Office action.**

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

6. 6. Telephone inquiries related to this decision should be directed to Caroline D. Dennison, Legal Advisor, at (571) 272-7729.

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

March 5, 2008
C:\Kiva\Kenpet6\RCR\ 7327_RCR-grant-amdt-to-go-w-claim const-after-bpai-dec.doc

[3] 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.

UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE GENERAL COUNSEL

OFFICE OF THE SOLICITOR

July 28, 2008

Amy E.L. Schoenhard
Arent Fox LLP
1050 Connecticut Ave, NW, Suite 400
Washington, DC 20036-5339

Ex parte Majeed et al.
Reexamination Proceeding
Control No.: 90/007,327
Filed: December 1, 2004
For U.S. Patent 5,804,596

DECISION ON PETITION TO CONTINUE *EX PARTE* REEXAMINATION PROCEEDINGS

This is a decision on the February 11, 2008 patent owner Petition under 37 CFR §1.182 to request continued reexamination.

The petition is before the Solicitor.

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

In view of the unusual circumstances in this case, the Board, in a separate paper, is GRANTING a waiver of the applicable rules to allow the patent owner 60 days from the date of mailing of this decision to file a request for rehearing under 37 CFR § 41.52 with the Board, if the patent owner chooses to do so.

REVIEW OF FACTS

1) U.S. Patent No. 5,804,596 (the '596 patent) issued on Sept. 8, 1998 with 8 claims.

2) A request for *ex parte* reexamination of the '596 patent was filed by the patent owner on December 1, 2004, and assigned control number 90/007,327 (the '7327 proceeding).

3) An Order granting reexamination of all of the claims of the '596 patent in the '7327 proceeding was mailed on February 4, 2005.

4) The proceeding progressed to the point where, on December 23, 2005, a final Office Action was mailed, in which claims 1-34, then in the proceeding, were all rejected.

5) An improper Request for Continued Examination (RCE) with an amendment, affidavit and translation, was submitted on February 23, 2006. On March 9, 2006 the patent owner was notified that the amendment was improper as it did not comply with 37 CFR 1.530(d)-(j). Another response was filed on March 20, 2006.

6) In a decision mailed April 6, 2006, the improper RCE papers were returned to the patent owner and the amendment was placed in the file for consideration by the examiner as a response to the final rejection.

7) The response to the final rejection was considered and deemed not to overcome all of the rejections, as indicated in an advisory action mailed April 13, 2006. The advisory action indicated that the amendment would be entered upon filing an appeal.

8) The final rejection was appealed, and an examiner's answer was mailed November 7, 2006.

9) After an oral hearing on October 17, 2007, a decision by the BPAI was made on December 13, 2007. In the decision, the rejection of claims 31 and 32 under 35 U.S.C. §112, first paragraph, was reversed; the BPAI affirmed the rejections of (a) claims 1, 5, 9-10, and 31-34 under 35 U.S.C. §102(b) based on Kazuo, (b) claims 1, 5, 11-12, and 31-34 under 35 U.S.C. §102(b) based on Greenway III or Greenway IV, and (c) claims 1-34 under 35 U.S.C. §103 based on Kazuo.

10) On February 11, 2008, the patent owner filed a petition under 37 CFR § 1.182 to request continued reexamination. Included was a supplemental response amending claims 1, 9, 11, 13, 15, 17, 19, 21, 23, 25, 27, 29, 31 and 33 and cancelling claims 5-8, 10, 12, 14, 16, 18, 20, 22, 24, 26, 28, 30, 32 and 34. The petition asserts that the proposed amendments to the claims are "responsive to a new interpretation of the scope of claims presented by the Board of Patent Appeals and Interferences". The petition states that the claim amendments "clearly advance prosecution" of the reexamination proceeding and "overcome the pending rejections". A notice of appeal to the U.S. Court of Appeals for the Federal Circuit was filed concurrently with the petition. The petition states that the supplemental response and Notice of Appeal were being filed pursuant to instructions from an attorney at the Office of Patent Legal Administration.

11) On March 6, 2008, the Office of Patent Legal Administration mailed a decision granting the petition under 37 CFR § 1.182.

12) On March 28, 2008, the Office of Patent Legal Administration mailed a decision vacating the March 6, 2008 decision. The March 28, 2008 decision states that the Office of Patent Legal Administration did not have jurisdiction to issue the March 6, 2008 decision on the petition under 37 CFR § 1.182.

13) On April 3, 2008, the patent owner filed an unopposed motion requesting a limited remand from the Federal Circuit to the Office for the purpose of allowing the Office to decide the patent owner's February 11, 2008 petition.

14) On May 29, 2008, the Federal Circuit granted the patent owner's motion for a limited remand. The Federal Circuit's order stated that the "motion for a limited remand is granted for the purpose of allowing the Board to consider" the patent owner's petition.

15) On June 9, 2008, the patent owner and the USPTO jointly moved under Federal Circuit Rule 27(l) for reconsideration of the Court's May 29, 2008 order. The parties requested that the Court clarify its order to specify that the remand is to the USPTO as opposed to the Board.

16) On July 17, 2008, the Federal Circuit issued an order granting the parties' motion for reconsideration and clarifying that the "case is remanded for the limited purpose of allowing the PTO to consider Sami Chemicals' petition."

DISCUSSION

Jurisdiction

On February 11, 2008, the patent owner filed both a Notice of Appeal to the Federal Circuit and a Petition to Continue Reexamination. When a case is pending in Court, the USPTO lacks jurisdiction to decide a petition. See, e.g., Hofstein v. Silver, 201 USPQ 77, 78 (CCPA 1979); Loshbough v. Allen, 359 F.2d 910, 912 (CCPA 1966).

Thus, when the Office granted the patent owner's petition on March 6, 2008, the Office did not have jurisdiction to do so. Accordingly, on March 28, 2008, the Office VACATED its March 6, 2008 petition decision, citing its lack of jurisdiction.

On July 17, 2008 the Federal Circuit issued an order that the "case is remanded for the limited purpose of allowing the PTO to consider Sami Chemicals' petition."

MPEP 1002.02 (k)(3), titled "Petitions Decided by the Solicitor", delegates to the Solicitor decisions on:

> "2. Petitions relating to *ex parte* questions in cases before the Court of Appeals for the Federal Circuit."

The Patent Owner's Petition to Continue Reexamination

On December 13, 2007, the Board issued its final decision, rejecting all of the patent's claims under either 35 U.S.C. §102 or 35 U.S.C. §103.

On February 11, 2008, the patent owner filed a petition requesting continued reexamination. In its petition, the patent owner stated that it was proposing claim amendments that "clearly advance" prosecution and "overcome the pending rejections". The patent owner further stated that the proposed amendments were "not presented earlier in prosecution as they are responsive to a new interpretation of the scope of claims" presented by the Board.

Prosecution can be reopened after a final decision of the Board only in limited circumstances. 37 CFR §1.198, titled "Reopening after a final decision of the Board of Patent Appeals and Interferences", sets forth those circumstances:

> When a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review, prosecution of the proceeding before the primary examiner will not be reopened or reconsidered by the primary examiner *except under the provisions of §1.114 or §41.50 of this title without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.* (emphasis added).

37 CFR §1.114 explicitly states that it does not apply to reexaminations. §1.114(e)(5). Thus, the patent owner's petition to reopen prosecution of its reexamination proceeding cannot be granted under §1.114.

The only section of 37 CFR §41.50 that might apply to this case is §41.50(b), which provides that if the Board specifically states that it is entering a new ground of rejection, the appellant has the option of reopening prosecution. We view the patent owner's petition in this case as an attempt to argue that the Board has entered a new ground of rejection, and that the appellant should thus be afforded the right to continue prosecution as permitted under §41.50(b). As such, however, the patent owner has directed its argument to the wrong entity. The Board should in the first instance decide whether or not the Board decision contains a new ground of rejection. Accordingly, the Solicitor will deny the petition.

However, in view of the facts in this case, the Board *sua sponte* is granting a waiver of the applicable rules to allow the patent owner 60 days from the date of mailing of this decision to file a request for rehearing with the Board. In reaching this result, the Board exercises its discretion in view of the unusual circumstances of this case. See, e.g., Ex Parte Letts, No. 2007-1392, 2008 WL 275515 (B.P.A.I. January 31, 2008). In its request for rehearing with the Board, the patent owner can present its arguments, including any argument that the Board's claim interpretation qualifies as a "new ground of rejection" for which continued prosecution should be permitted under §41.50(b).

CONCLUSION

The patent owner's Petition to Continue Reexamination is hereby DENIED.

Stephen Walsh

Stephen Walsh
Acting Solicitor

28 JULY 2008
Date

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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San Francisco, CA 94111

Steven M. Hoffberg (For Third Party Requester)
Milde & Hofberg LLP
Suite 460, 10 Bank Street
White Plains, NY 10606

MAILED
FEB 07 2006
REEXAM UNIT

In re Reexamination Proceeding :
D. Taylor :
Control No. 90/007,330 : DECISION GRANTING PETITION
Filed: December 3, 2004 :
U.S. Patent No. 5,797,864 :
Attorney Docket No. 86767 :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on January 4, 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), 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.

$1,500.00 has been charged to counsel's deposit account no. 20-1430 in accordance with the present petition.

Jurisdiction over the reexamination proceeding is being returned to Central Reexam Unit for further examination and consideration of the response filed January 4, 2006, along with the present petition, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Peter C. English, in Central Reexam Unit, who can be reached at 571-272-6671.

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

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

Conferee: Kenneth M. Schor

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,331	11/30/2004	5539930	RES-041054	2554

26371 7590 03/19/2009

FOLEY & LARDNER LLP
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/19/2009

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

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Richard J. McKenna Foley & Lardner, LLP 777 East Wisconsin Avenue Milwaukee, Wisconsin 53202-5306	))))	**FOR PATENT OWNER**

MAILED

MAR 19 2009

CENTRAL REEXAMINATION UNIT

Jovan N. Jovanovic King & Jovanovic, PLC 170 College Avenue Suite 230 Holland, Michigan 49423	)))))	**FOR THIRD PARTY REQUESTER**

In re Gregory J. Sesselmann Reexamination Proceeding Control No. 90/007,331 Filed: November 30, 2004 For: U.S. Patent No. 5,539,930	)))))	**DECISION WAIVING 37 CFR 41.33(d)(2)**

This is a decision on the March 9, 2009 patent owner "PETITION FOR SUSPENSION OF RULES UNDER 37 C.F.R.§ 1.183" requesting waiver of 37 CFR 41.33(d)(2) to permit the acceptance of a supplemental declaration after the filing of the brief on appeal.

The petition and reexamination control number 90/007,731 are before the Office of Patent Legal Administration.

The petition is **granted.**

RELEVANT BACKGROUND

1. Patent No. 5,539,331 (the '331 patent) issued on July 30, 1996.

2. A request for reexamination, assigned Control No. 90/007,331 (the '7331 proceeding), was filed by the Third Party Requester on November 30, 2004.

3. Reexamination was ordered in the '7331 reexamination proceeding on February 7, 2005.

4. Prosecution progressed to the point that the patent owner filed an appeal brief on November 24, 2008.

5. On March 9, 2009, the patent owner filed the petition which is the subject of this decision

RELEVANT STATUTORY, REGULATORY, AND PROCEDURAL PROVISIONS

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 41.33 Amendments and affidavits or other evidence after appeal

(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.

(b) Amendments filed on or after the date of filing a brief pursuant to § 41.37 may be admitted:

(1) To cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, or

(2) To rewrite dependent claims into independent form.

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

(d)(1) An affidavit or other evidence filed after the date of filing an appeal pursuant to § 1.31(a)(1) through (a)(3) and prior to the date of filing a brief pursuant to § 41.37 may be admitted if the examiner determines that the affidavit or other evidence overcomes all rejections under appeal and that a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented has been made.

(2) 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).

DECISION

Patent owner requests waiver of 37 CFR 41.33 to permit entry of evidence after the filing of an appeal brief. Patent owner explains that waiver of the rule is necessary in this instance because none of the provisions of the rule permitting entry of the evidence are currently applicable.

In view of the nature of the evidence, and the facts and circumstances of this particular proceeding, it is determined that a situation exists in which justice requires the waiver of 37 CFR 41.33 to permit entry of the supplemental declaration of Greg Paquin submitted on March 9, 2009.

Accordingly, the petition is granted.

CONCLUSION

1. The petition under 37 CFR 1.183 for waiver of 37 CFR 41.33(d)(2) is granted.

2. The evidence filed with the petition of March 9, 2008, is entered into the record.

3. Jurisdiction is being transferred to the Central Reexamination Unit for appropriate action on the proceeding by the examiner in due course.

4. Telephone inquiries related to this decision should be directed to to Pinchus M. Laufer, Legal Advisor, at 571-272-7726, or, in his absence, to the undersigned at 571-272-7710.

Kenneth M. Schor

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

March 18, 2009
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(For Patent Owner)

MAILED

AUG 21 2009

CENTRAL REEXAMINATION UNIT

King & Jovanovic, PLC
170 College Avenue, Suite 230
Holland, MI 49423

(For Requester)

In re Sesselmann	:	
Reexamination Proceeding	:	DECISION ON PETITION
Control No.: 90/007,331	:	UNDER 37 CFR 1.181
Filed: November 30, 2004	:	
For: U.S. Patent No.: 5,539,930	:	

This is a decision on a petition filed by the patent owner on June 22, 2009. The petition is entitled "PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.181(a)" [hereinafter "the petition"], and is a request to the Director to exercise his discretion pursuant to 37 CFR 1.181 and to designate the grounds of rejection as a new grounds of rejection in the Examiner's Answer, mailed April 22, 2009.

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

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated June 22, 2009 is denied with respect to designating the grounds of rejection as new grounds of rejection.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,539,930 (hereinafter, the '930 patent) issued on July 30, 1996.

2. A request for *ex parte* reexamination, assigned control No. 90/007,331 (hereinafter, the '331 proceeding), was filed by a third party requester on November 30, 2004.

3. *Ex parte* reexamination was ordered for the '331 proceeding on February 7, 2005.

4. The patent owner did not filed comments on the order.

5. On May 11, 2005, a non-final Office action, which rejected claims 1-10, was mailed in the '331 reexamination proceeding.

6. On July 8, 2005, the patent owner filed a response, including evidence of secondary consideration, and amendment that added proposed new claims 11-59. The amendment was not in compliance with 37 CFR 1.530. On September 20, 2005, the patent owner filed the response in compliance with 37 CFR 1.530.

7. On February 22, 2006, a non-final Office action, which rejected claims 1-59, was mailed.

8. On March 27, 2006, a personal interview was conducted.

9. On May 22, 2006, after a one-month extension of time, Patent Owner filed a response and a proposed amendment to proposed new claims 22, 28, 34, and 39.

10. On December 22, 2006, a non-final Office action, which rejected claims 1-59, was mailed. This Office action rejected claim 8 under 35 U.S.C. 103(a) over Dawson or the Outdoor Life Deer Hunter's Yearbook (1989) and took Official Notice that typical hunting outfits included camouflage fabric face cover at the time of the invention. See pages 15-16 of the action. This Office action also addressed the evidence of secondary considerations. See pages 10-12 of the action.

11. On March 20, 2007, a personal interview was conducted.

12. On March 22, 2007, after a one-month extension of time, patent owner filed a response and a proposed amendment to claim 5 and proposed new claims 39, 41, 43-57, cancelled claims 9, 11-33, and 40, and added proposed new claims 60-93. The response included further declarations as evidence of secondary considerations. The amendment was not in

compliance with 37 CFR 1.530. On June 8, 2007, the patent owner filed the response in compliance with 37 CFR 1.530.

13. On September 13, 2007, the Office issued a Final rejection Office action, which rejected claims 1-8, 10, 34-39 and 41-93. This Office action rejected claims 5-8, 39 and 41 under 35 U.S.C. 103(a) over Dawson or the Outdoor Life Deer Hunter's Yearbook (1989) in view of Popper and took Official Notice that typical hunting outfits included camouflage fabric face cover at the time of the invention. See pages 7-13 of the action. The Popper reference was added to teach the new limitation added to independent claim 5 by the June 8, 2007 amendment. Claim 8 depends on claim 7, which depends on claim 6, which depends on claim 5. The action also addresses the declarations filed as evidence, e.g., see pages 5-6 and 11-13 of the action.

14. On November 13, 2007, the patent owner filed a response and a proposed amendment to proposed new claims 39, 46, 50, 54, 71, 78-80, and 82.

15. On December 4, 2007, an advisory action was mailed. The advisory action stated that the November 13, 2007 amendment would be entered for purposes of appeal.

16. On January 11, 2008, a Notice of Appeal was filed.

17. On March 11, 2008, an appeal brief was filed.

18. On May 23, 2008, the Office issued an action which reopened prosecution. This Office action maintained the rejection of claims 5-8, 39 and 41 under 35 U.S.C. 103(a) over Dawson or the Outdoor Life Deer Hunter's Yearbook (1989) in view of Popper and for the third time took Official Notice that typical hunting outfits included camouflage fabric face cover at the time of the invention. See pages 17-25 of the action. The action also includes an affidavit by the examiner to support the Official Notice, which was requested by the patent owner. See pages 20-21 of the action. The action also addresses the declarations filed as evidence, e.g., see pages 13-15 and 22-25 of the action.

19. On August 22, 2008, a Notice of Appeal was filed.

20. On September 23, 2008, the patent owner filed a response, which included further declarations.

21. On October 14, 2008, the Office mailed an advisory action stating that the request for reconsideration and the further declarations were entered. The advisory addresses the

arguments in the request for reconsideration and the declarations. See pages 2-7 in the action.

22. On November 24, 2008, the patent owner filed an appeal brief, which was not in compliance with 37 CFR 41.37. See the notice mailed January 13, 2009. On February 12, 2009, patent owner filed a corrected appeal brief.

23. On April 22, 2009, the Office mailed an Examiner's Answer.

24. On June 22, 2009, the patent owner filed a reply brief and the instant petition.

DECISION

The patent owner (petitioner) states that the examiner made, in effect, new grounds of rejection in the Examiner's Answer. See page 2 of the petition. The petitioner explains that the Examiner's Answer contains "new" reasoning with respect to the rejections of claims 1-8, 10, 34-39, and 41-93 and that the examiner relies upon a new reference not listed in the grounds of rejection in support of the rejection of claim 8. See pages 2-5 of the petition.

In response to patent owner's arguments that the examiner introduced new grounds of rejection because of the "expanded" reasoning in the Examiner's Answer regarding the evidence of secondary consideration or the reference cited to support the Official Notice, the director finds there are not good and sufficient reasons to designate the rejections as new grounds of rejection. First, 35 U.S.C. 305 requires that all *ex parte* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing a final rejection, for consideration of after final responses, and for designating new grounds of rejection in Examiner's Answers. See MPEP 2272 and 1207.03.

Turning to the facts in this proceeding, the record is clear that patent owner has been given numerous opportunities to respond to the prior art rejections. The record does not support patent owner's statement that prior Office actions only gave "scant" attention to the evidence of secondary considerations. See the facts section above for examples of portions of the Office actions that addressed the secondary considerations. It is true that the evidence of secondary considerations were addressed in various portions of the prior Office actions and not addressed in a single section as is done in the Examiner's Answer, which was done to correspond to the format of patent owner's appeal brief. Therefore, it is understandable that it might appear that the Examiner's Answer contains a new analysis on pages 21-34 of the Examiner's Answer because of the consolidated nature of the response. However, it is noted that the petitioner did

not point to any specific response or explanation by the examiner that was not present in the prior Office actions. Therefore, petitioner's allegation that the explanation provided on pages 21-34 of the Examiner's Answer amounts to a new ground of rejection is not persuasive. Finally, to the extent that the petitioner is requesting review of the substance of the examiner's response to the evidence of secondary considerations, this issue touches on matters that are appealable, and therefore will not be addressed in this petition. See MPEP 1002 and 1201. Specifically, MPEP 1202 states "[t]he 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 regards to petitioner's arguments pertaining to the Official Notice, first, it is noted that the Final rejection of May 23, 2008 sets forth essentially the same grounds of rejection based on prior art as set forth in the December 22, 2006 and September 13, 2007 Office actions. This Final rejection was actually the third time Official Notice was taken of the same fact in the case. The patent owner has had many opportunities to enter amendments to the claims and/or to introduce evidence to rebut the examiner's finding in the Official Notice. The patent owner chose not to file any evidence to rebut the examiner's finding and chose to only present arguments about the appropriateness of the Official Notice and to invite the examiner to provide an affidavit. See, e.g., page 36 of the appeal brief dated March 11, 2008. In the May 23, 2008 action, the examiner did provide the affidavit as requested by the patent owner. In the petition, patent owner alleges that the citation to U.S. Patent No. 4,285,068 to Ross in support of the Official Notice amounts to a new ground of rejection. It is noted, however, that the citation to Ross was present in the affidavit by the examiner in the May 23, 2008 action. See page 21 of the Office action. Therefore, the record does not support that the citation to the Ross patent was newly made in the Examiner's Answer. It is also noted that MPEP 1207.03 states "[w]here a newly cited reference is added merely as evidence of the prior statement made by the examiner as to what is "well-known" in the art which was challenged for the first time in the appeal brief, the citation of the reference in the examiner's answer would not ordinarily constitute a new ground of rejection within the meaning of 37 CFR 41.39(a)(2)." While the Official Notice was not challenged for the first time in the appeal brief, the Examiner's Answer merely repeats the same support provided in the May 23, 2008 Final rejection. Therefore, petitioner's allegation that the citation to the Ross patent amounts to a new ground of rejection is not supported by the record. Finally, to the extent that the petitioner is requesting review of the substance of the examiner's Official Notice, this issue touches on matters that are appealable, and therefore will not be addressed in this petition. See MPEP 1002 and 1201.

Upon review of the entire record, the examiner appropriately applied Office policies and procedures in determining that the Examiner's Answer did not introduce new grounds of rejection. For the reasons set forth above, it is deemed that the examiner followed Office rules

and procedures and did not abuse his discretion in deciding to not designate certain rejections as new grounds of rejection.

Accordingly, good and sufficient reasons to designate certain rejections as new grounds of rejection in the Examiner's Answer in the reexamination proceeding have not been provided and the patent owner's petition is denied.

CONCLUSION

1. The petition under 37 CFR 1.181 for consideration of designating certain rejections as new grounds of rejection in the Examiner's Answer is denied.

2. This proceedings will be forwarded to the examiner for consideration of whether the reply brief, filed June 22, 2009, should be entered or not entered. If appropriate, the proceedings will be forwarded to the Board of Patent Appeals and Interferences in due course.

3. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361 or in his absence to the undersigned at (571) 272-3838.

Gregory A. Morse
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.
90/007,333	12/07/2004	6659375		8968

3000 7590 04/25/2007

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/25/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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4/26/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Edward J. Kondracki
MILES & STOCKBRIDGE PC
1751 Pinnacle Dr., Suite 500
McLean VA 22102

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007333
PATENT NO. 6,659,375
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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COHEN & POKOTILOW, LTD.
11TH FLOOR, SEVEN PENN CENTER
1635 MARKET STREET
PHILADELPHIA PA 19103-2212

(For Patent Owner)

MAILED

APR 25 2007

CENTRAL REEXAMINATION UNIT

EDWARD KONDRACKI
MILES & STOCKBRIDGE PC
1751 PINNACLE DR.
SUITE 500
MCLEAN, VA 22102

(For Third Party Requester)

In re Reexamination Proceeding :
Mudge et al. :
Control No. 90/007,333 : DECISION DISMISSING PETITION
Filed: December 7, 2004 :
U.S. Patent No. 6,659,375 :
Attorney Docket No. R1122/20001 :

This is a decision on the petition under 37 CFR 1.137(a) filed by the patent owner on April 3, 2007, for entry of late papers based upon unavoidable delay.

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

37 CFR 1.137(a) states:

> "*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."

The present petition under 37 CFR 1.137(a) includes, *inter alia*, an authorization to charge counsel's deposit account for the $250.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite showing (item 3).

A review of the record reveals that a response to the outstanding Office action (item 1) has not

been filed. A copy of the outstanding Office action mailed June 16, 2006, has been attached for patent owner's convenience. As a grantable petition under 37 CFR 1.137(a) requires a proper response to the outstanding Office action, a proper response to the outstanding Office action is required.

A further review of the present petition reveals that the requisite proof of service on the third party requester has not been included with the present petition papers.

Since there is no indication that the third party requester was provided with a copy of these papers, any response by patent owner to this decision must include a Certificate that the present petition papers have been served on the third party requester in the manner provided by § 1.248.

In addition, any future communications filed by patent owner in this proceeding (including any response to this decision) must include proof of service on the third party requester in accordance with 37 CFR 1.550(f).

CONCLUSION

1. In view of the above, the present petition under 37 CFR 1.137(a) is **dismissed**.

2. $250.00 has been charged to counsel's deposit account no. 03-0075 in accordance with the present petition.

3. For the granting of the present petition, it is required that patent owner provide:

   a. A Certificate that the present petition papers and any request for reconsideration have been served on the third party requester; and

   b. A proper response to the outstanding Office action mailed June 16, 2006.

4. The submissions should be included in a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)."

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(a)."

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

   By mail: Attn: Mail Stop "*Ex Parte* Reexam"
   Central Reexamination Unit
   Commissioner for Patents

United States Patent and Trademark Office
P. O. Box 1450
Alexandria VA 22313-1450

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

By hand: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

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

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

Conferee: Kenneth M. Schor, Senior Legal Advisor

Enclosures:
Copy of the outstanding Office action mailed June 16, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,333	12/07/2004	6659375		8968

3000 7590 07/11/2007

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/11/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

7/12/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Edward J. Kondracki
MILES & STOCKBRIDGE PC
1751 Pinnacle Dr., Suite 500
McLean VA 22102

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007333
PATENT NO. 6,659,375
ART UNI 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a replly has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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JUL 11 2007

CENTRAL REEXAMINATION UNIT

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

(For Patent Owner)

EDWARD KONDRACKI
MILES & STOCKBRIDGE PC
1751 PINNACLE DR.
SUITE 500
MCLEAN, VA 22102

(For Third Party Requester)

In re Reexamination Proceeding :
Mudge et al. :
Control No. 90/007,333 : DECISION GRANTING PETITION
Filed: December 7, 2004 :
U.S. Patent No. 6,659,375 :
Attorney Docket No. R1122/20001 :

This is a decision on the renewed petition under 37 CFR 1.137(a) filed May 25, 2007, by facsimile transmission and the supplement to renewed petition under 37 CFR 1.137(a) filed June 28, 2007, by facsimile transmission, by the patent owner in response to the Decision mailed April 25, 2007, for entry of late papers based upon unavoidable delay.

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

37 CFR 1.137(a) states:

> "*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."

On April 25, 2007, a decision dismissing the April 3, 2007 petition was mailed. The decision set forth that the petition under 37 CFR 1.137(a) included the $250.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite showing (item 3), but did not include a response to the

outstanding Office action (item 1). It was noted that the petition papers did not include the requisite proof of service on the third party requester in the manner provided by § 1.248. It was further noted that any future communications filed by patent owner in this proceeding (including any response to this decision) must include proof of service on the third party requester in accordance with 37 CFR 1.550(f).

In response, on May 25, 2007, a renewed petition was filed including the requisite proof of service on the third party requester, while omitting a response to the outstanding Office action (item 1).

On June, 15, 2007, in a telephone communication from Senior Legal Advisor Fred Silverberg, counsel was informed that a response to the outstanding Office action (item 1) was still required.

In response, on June 28, 2007, the present supplement to renewed petition under 37 CFR 1.137(a) was filed including an amendment - a response to the outstanding Office action (item 1) and the requisite proof of service on the third party requester.

The petition for entry of the late papers is granted.

Jurisdiction over the reexamination proceeding is being returned to Central Reexamination Unit (CRU) Art Unit 3993 for further examination and consideration of the amendment filed June 28, 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, Aaron Lewis, in CRU Art Unit 3993, who can be reached at 571-272-4795.

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

Fred A. Silverberg

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

Kenneth M. Schor

Conferee: Kenneth M. Schor, Senior Legal Advisor

RECEIVED

MAY 25 2007

CENTRAL REEXAMINATION UNIT

(Substitute for PTO/SB/21 (09-04))

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission: 6

Application Number	90/007,333
Filing Date	December 7, 2004
First Named Inventor	R. Mudge et al.
Art Unit	3993
Examiner Name	Aaron J. Lewis
Attorney Docket Number	R1122/20002

ENCLOSURES *(Check all that apply)*

- [ ] Fee Transmittal Form
  - [ ] Fee Attached
- [ ] Amendment/Reply
  - [ ] After Final
  - [ ] Affidavits/declaration(s)
- [ ] Extension of Time Request
- [ ] Express Abandonment Request
- [ ] Information Disclosure Statement
- [ ] Certified Copy of Priority Document(s)
- [ ] Reply to Missing Parts/ Incomplete Application
  - [ ] Reply to Missing Parts under 37 CFR 1.52 or 1.53
- [ ] Drawing(s)
- [ ] Licensing-related Papers
- [x] Petition
- [ ] Petition to Convert to a Provisional Application
- [ ] Power of Attorney, Revocation Change of Correspondence Address
- [ ] Terminal Disclaimer
- [ ] Request for Refund
- [ ] CD, Number of CD(s) _____
  - [ ] Landscape Table on CD
- [ ] After Allowance Communication to TC
- [ ] Appeal Communication to Board of Appeals and Interferences
- [ ] Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
- [ ] Proprietary Information
- [ ] Status Letter
- [x] Other Enclosure(s) (please identify below):

Renewed Petition Under 37 CFR 1.137(a)

Remarks

Please charge Attorney Account No. 03-0075 as necessary to effect entry and/or ensure consideration of this submission.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Caesar, Rivise, Bernstein, Cohen & Pokotilow, Ltd., Customer No. 03000		
Signature	E S Marzluf		
Printed name	Eric S. Marzluf		
Date	May 25, 2007	Reg. No.	27,454

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below: Transmitted to Facsimile No. (571) 273-8300 and 571-273-9900 (Central Reexamination Unit)

Signature	E S Marzluf		
Typed or printed name	Eric S. Marzluf	Date	May 25, 2007

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: **Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PATENT
Customer No. 03000
Docket No. R1122/20002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT EXAMINING OPERATION

In re Reexamination Proceeding:
Mudge et al
Reexamination Control No. 90/007333
U.S. Patent No. 6,659,375

RECEIVED
MAY 25 2007
CENTRAL REEXAMINATION UNIT

Filing Date: December 7, 2004 Art Unit: 3993

For: ATOMIZER LID ASSEMBLY FOR AN ATOMIZER Examiner: Aaron J. Lewis

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

Central Reexamination Unit

RENEWED PETITION UNDER 37 CFR 1.137(a)

This renewed petition is timely submitted in response to the Decision Dismissing Petition dated April 25, 2007.

Background

In Petitioner's prior petition, the following information was presented for consideration:

> **Nature of Abandonment**: In an Office communication from the Patent and Trademark Office dated January 3, 200[7], Claims 1-5 in the above-identified Letters Patent have been cancelled because the patent owner failed to file an appropriate response to the Office Action mailed June 16, 2006.
>
> A declaration by the patent owner's attorney is submitted herewith and sets forth the necessary showings as to the cause of the unavoidable delay in responding to

PAGE 2/6 * RCVD AT 5/25/2007 1:56:33 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-5/7 * DNIS:2739900 * CSID:215 751 1142 * DURATION (mm-ss):01-24

> the June 16, 2006 Office Action. These showings establish that the entire delay in filing the required reply from the due date for the replay until the filing of this petition was unavoidable. 37 C.F.R. § 1.137(a)(3).
>
> It will be seen from the attached showings that **the Office Action dated June 16, 2006 was never received by the patent owner's attorneys, and therefore, no response was possible.**
>
> It will also be seen from the attached showings that the attorneys' processing procedures have been carefully reviewed and there is no evidence of the Office Action having been received or docketed. [Emphasis added]

In addition to the above explanation contained in the prior petition, the patent owner's attorney submitted a declaration setting forth the facts surrounding the unavoidable nature of the delay in responding to the June 16, 2006 Office Action – namely, the Office action was never received. And as a consequence of never having received the Office action, it was requested in the Petition:

> In view of the fact that the Office Action was never received by the patent owner's attorneys, it is respectfully requested that the cancellation of Claims 1-5 be withdrawn; that the Office Action be resent, **and that an appropriate period for response be granted.** [Emphasis added.]

The requisite petition fee of $250 was also charged to the attorneys' Deposit Account.

Decision Dismissing Petition

The previous petition was denied because no response to the outstanding June 16, 2006 Office action was filed along with the Petition. Also, Petitioner was advised that it is necessary to serve the petition on the third party requester.

Petitioner has been given one (1) month to file any request for reconsideration.

PAGE 3/6 * RCVD AT 5/25/2007 1:56:33 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-5/7 * DNIS:2739900 * CSID:215 751 1142 * DURATION (mm-ss):01-24

Discussion

It is respectfully requested that refusal to grant the petition to withdraw the cancellation of Claims 1-5 and reinstate prosecution on the pending reexamination be reconsidered. While it is understood that under most circumstances a response to the Office action is necessary, in those cases the petitioner has actually *received an Office action* to which to respond. That is not the instant case. Petitioner explained in the petition and in the accompanying declaration that the June 16, 2006 Office action was never received.

Not having received the Office action in the first place it was not possible to respond in the petition. Indeed, the petition specifically requested service of the Office action and that appropriate time for responding be reset.

Furthermore, while the Decision Dismissing Petition states that a copy of the June 16, 2006 Office action was to be included therewith, and is listed as an enclosure, ***the Decision did not contain the copy of the Office action.*** Again, for reasons not in Petitioner's control, these materials ***were not received.***

Petitioner's attorneys are doing everything possible to work with this reexamination, but for whatever reasons, there have been lengthy delays at the PTO in examining the application, and through no fault of the Petitioner, the materials are not being received. As pointed out in the earlier declaration, this office receives hundreds of communications from the PTO every year, and has been in the business of prosecuting patent applications for over eighty (80) years. Systems are in place for properly handling all incoming materials from the PTO and the court systems to ensure that mailings and enclosures are not lost.

PAGE 4/6 * RCVD AT 5/25/2007 1:56:33 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-5/7 * DNIS:2739900 * CSID:215 751 1142 * DURATION (mm-ss):01-24

Finally, as required by the Decision Dismissing the Petition, this request for reconsideration is accompanied by a Certification that the present petition papers, namely, the Petition for Revival and Declarations of Eric S. Marzluf, and this request for reconsideration have been served on the third party requester.

Conclusion

It is respectfully requested that the decision dismissing the petition be reconsidered in view of the fact that it was not possible to provide a response to the Office action, since was not previously, *and still has not been*, received. It is submitted that nothing can be more unavoidable than not receiving the communication from the PTO in the first place. If, however, the stated basis for requesting reinstatement of the reexamination is incorrect, it is requested that whatever appropriate basis covers not receiving materials from the PTO be adopted instead.

Upon reconsideration of the petition, it is respectfully requested that the cancellation of Claims 1-5 be withdrawn; that the Office Action be resent; and that an appropriate period for response be granted. The Petitioner's attorney may also be reached at the address and telephone number set forth below.

Respectfully submitted,

CAESAR, RIVISE, BERNSTEIN,
COHEN & POKOTILOW, LTD.

May 25, 2007

By: E S Marzluf

Eric S. Marzluf
Registration No. 27,454
Customer No. 03000
11th Floor Seven Penn Center
1635 Market Street
Philadelphia, PA 19103-2212
(215) 567-2010
Attorneys for Patent Owner

PAGE 5/6 * RCVD AT 5/25/2007 1:56:33 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-5/7 * DNIS:2739900 * CSID:215 751 1142 * DURATION (mm-ss):01-24

CERTIFICATE OF MAILING

I hereby certify that a copy of the foregoing RENEWED PETITION UNDER 37 CFR 1.137(a) and the entire filing of April 3, 2007 re Application Serial No. 90/007,333 that includes the following:

Petition for Revival of a Reexamination Application Abandoned Unavoidably Under 37 C.F.R. §1.137(a)

Declaration of Eric S. Marzluf in Support of Petition for Revival of a Reexamination Application Abandoned Unavoidably Under 37 C.F.R. §1.1137(a)

Also included are the exhibits to the Declaration; the Transmittal Form; Petition Fee Transmittal and Fax Confirmation

are being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to:

Edward Kondracki, Esq.
Miles & Stockbridge PC
1751 Pinnacle Drive
Suite 500
McLean, VA 22102

this 25th day of May, 2007.

Eric S. Marzluf

PAGE 6/6 * RCVD AT 5/25/2007 1:56:33 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-5/7 * DNIS:2739900 * CSID:215 751 1142 * DURATION (mm-ss):01-24

PATENT
Customer No. 03000
Docket No. R1122/20002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT EXAMINING OPERATION

FAX RECEIVED
JUN 28 2007
CENTRAL REEXAMINATION UNIT

In re Reexamination Proceeding:
Mudge et al
Reexamination Control No. 90/007333
U.S. Patent No. 6,659,375

Filing Date: December 7, 2004

Art Unit: 3993

For: ATOMIZER LID ASSEMBLY FOR AN ATOMIZER

Examiner: Aaron J. Lewis

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

Central Reexamination Unit

SUPPLEMENT TO RENEWED PETITION UNDER 37 CFR 1.137(a)

Dear Sir:

In accordance with the telephone conference with Mr. Silverberg on June 15, 2007, Petitioner is providing herewith as Exhibit A the appropriate response to the June 16, 2006 Office Action (obtained from the PAIR system) in the reexamination.

In view of this further submission of the response to the June 16, 2006 Office Action and the remarks provided in the previously filed Petitions in this matter, it is respectfully requested that the reexamination application be revived.

PAGE 2/16 * RCVD AT 6/28/2007 5:16:41 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-5/15 * DNIS:2739900 * CSID:215 751 1142 * DURATION (mm-ss):02-40

Respectfully submitted,

CAESAR, RIVISE, BERNSTEIN,
COHEN & POKOTILOW, LTD.

June 28, 2007

By: E. S. Marzluf

Eric S. Marzluf
Registration No. 27,454
Customer No. 03000
11th Floor – Seven Penn Center
1635 Market Street
Philadelphia, PA 19103-2212
(215) 567-2010
Attorneys for Patent Owner

CERTIFICATE OF MAILING

I hereby certify that a copy of the foregoing SUPPLEMENT TO RENEWED PETITION UNDER 37 CFR 1.137(a) and AMENDMENT re Application Serial No. 90/007,333 is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to:

Edward Kondracki, Esq.
Miles & Stockbridge PC
1751 Pinnacle Drive
Suite 500
McLean, VA 22102

this 28th day of June, 2007.

E. S. Marzluf
Eric S. Marzluf

PAGE 3/16 * RCVD AT 6/28/2007 5:16:41 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-5/15 * DNIS:2739900 * CSID:215 751 1142 * DURATION (mm-ss):02-40

EXHIBIT A

PATENT
Customer No. 03000
Docket No. R1122/20002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT EXAMINING OPERATION
(EX PARTE REEXAM)

First Named Inventor: Mudge, Robert

Reexamination Control No: 90/007,333 Group Art Unit: 3993

U.S. Patent No. 6,659,375

Filed: December 7, 2004 Examiner: Kenneth Bomberg

Att. Docket No.: R1122/20002 Confirmation No.: 8968

For: ATOMIZER LID ASSEMBLY FOR AN ATOMIZER

AMENDMENT

Attn: Mail Stop "Ex Parte Reexam"
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

INTRODUCTORY COMMENTS

This amendment is submitted in response to the Office Action dated June 16, 2006. The Office Action was never received by the Patentees' attorneys. A second Office Action dated January 3, 2006(7), however, was received stating that prosecution on the merits of the reexamination was closed due to failure to respond to the June 16, 2006 Office Action.

A timely Petition for Revival was filed and dismissed due to failure to provide a response to the Office Action that was never received. The dismissal was stated to have included a copy of the June 16, 2006 Office Action, but did not include same. A renewed Petition was timely filed on May 25, 2007.

This response is submitted in response to the Office Action of June 16, 2006 (which was obtain from PAIR) and is submitted to supplement the Renewed Petition at the requirement of Mr. Silverberg, Senior Legal Advisor.

ACCORDINGLY, please amend the above-identified reexamination application as follows:

Amendments to the Claims are reflected in the listing of claims, which begins on page 3 of this paper.

Remarks/Arguments begin on page 5 of this paper.

PAGE 6/16 * RCVD AT 6/28/2007 5:16:41 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-5/15 * DNIS:2739900 * CSID:215 751 1142 * DURATION (mm-ss):02-40

AMENDMENTS TO THE CLAIMS

This listing of claims will replace all prior versions, and listings, of claims in the application:

Listing of Claims:

1. (Currently Amended) A lid assembly for a rotatable atomizer wheel having an atomizing chamber therein, said lid assembly comprising:

a lid member adapted to fit onto the rotatable atomizer wheel over the atomizing chamber, said lid member having an first opening there through into the atomizing chamber when said lid member is positioned on the atomizer wheel; and

a wear ring for protecting the first opening through said lid member, said wear ring being independent of and fitted inside and extending through the first opening through said lid member, said wear ring having a second opening there through into the atomizing chamber when said lid member with said wear ring fitted therein is positioned on the atomizer wheel

2. (Previously Presented) A lid assembly as claimed in Claim 1, further comprising a containment ring adjacent said lid member and surrounding said wear ring.

3. (Currently Amended) A lid assembly as claimed in Claim 1, wherein said wear ring is comprised of a wear resistant material having greater wear resistance [that] than the lid member.

4. (Currently Amended) A lid assembly as claimed in Claim 1, wherein said wear ring is comprised of a material selected from the group of materials consisting of silicon carbide material, tool steel, heat treated stainless steel and carbide castings.

PAGE 7/16 * RCVD AT 6/28/2007 5:16:41 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-5/15 * DNIS:2739900 * CSID:215 751 1142 * DURATION (mm-ss):02-40

5. (Currently Amended) A lid assembly as claimed in Claim 1, wherein said lid member is comprised of a material selected [form] from the group of materials consisting of stainless steel, Hastelloy and titanium.

6. (Currently Amended) A lid assembly as claimed in Claim 1, wherein said first opening through said lid member has a first recess around the [circumferences] circumference thereof; and

wherein said lid assembly further comprises first cushioning and sealing means within the first recess in said lid member and adjacent said wear ring.

7. (Previously Presented) A lid assembly as claimed in Claim 6, further comprising a containment ring adjacent said lid member and surrounding said wear ring, and

wherein said lid member has a second recess therein adjacent said containment ring, and

wherein said lid assembly further comprises second cushioning and sealing means within the second recess in said lid member and adjacent said wear ring.

PAGE 8/16 * RCVD AT 6/28/2007 5:16:41 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-5/15 * DNIS:2739900 * CSID:215 751 1142 * DURATION (mm-ss):02-40

REMARKS/ARGUMENTS

By this Amendment, claims 1,3,4,5 and 6 are amended. Claims 1-7 are currently pending in this reexamination. Reexamination and reconsideration in view of the above amendments and the following remarks is respectfully requested.

Informal Matters

Except as explained in the remarks set forth below, the amendments to Claims 3-6 are made for the purpose of addressing informalities pointed by the Examiner (Claim 3) or for the purpose of clarifying additional informalities that have been discovered upon review of Claims 4-6. These changes to informalities have not been made to overcome any prior art. Claim 1 has been amended to include a new limitation, as discussed below.

Formal Matters

Claims Rejections – 35 USC §102(b)

Claims 1 and 2 have been rejected under 35 U.S.C. 102(b) as being anticipated by the 1999 Dry Scrubber Users Conference publications (Conference 1999) or the 2000 Dry Scrubber User Conference publications (Conference 2000).

In particular, the Examiner has applied the claim language of Claim 1 to Figures 4-8 and 4-9 of the section entitled New Parts for Old Atomizers (Conference 1999). Support for the rejection is also considered to be found in paragraph 3 of the section entitled New Designs Which Can be Implemented on Old Atomizers. The Examiner also submitted that figures 2-14, 2-15 and 2-16 from the section entitled Preventive Maintenance provide support for the claim

PAGE 9/16 * RCVD AT 6/28/2007 5:16:41 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-5/15 * DNIS:2739900 * CSID:215 751 1142 * DURATION (mm-ss):02-40

rejection, though were not reproduced as they are considered substantially duplicative.

The Examiner also applied the language of Claim 1 to materials from the Conference 2000 materials, namely Figures 6 and 7 from the section entitled Failures with Operation of Atomizer and How They Can Be Prevented. Further support for the rejection was also considered to be found in paragraph 1.2 of the section entitled Failures and Prevention 2000, which references Figures 6 and 7. Also, figures 2, 5 and 12 from Failures with Operation of Atomizers and How They Can Be Prevented are submitted as providing support for the claim rejection.

For ease of discussion and comparison of the figures addressed by the Examiner, the following figures have been reproduced and are included hereafter, i.e., Fig 4-8, Fig. 4-9, Fig 2-14 and Fig 2-16.

In order not to duplicate the considerations with regard to the various figures acknowledged by the Examiner, it is pointed out that the figures contained in the Conference 2000 documents are the same figures presented in the Conference 1999, although the figure numbers have been changed. This is evident even from the figures copied and made part of the June 16 Office Action. For Example, Figure 4-8 is the same figure as Figure 7, and Figure 4-9 is the same figure as Figure 6.

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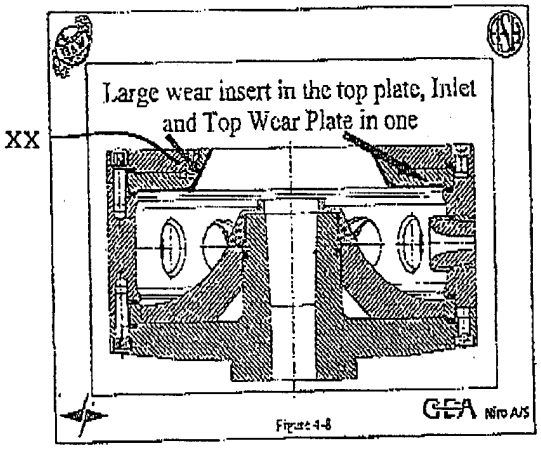

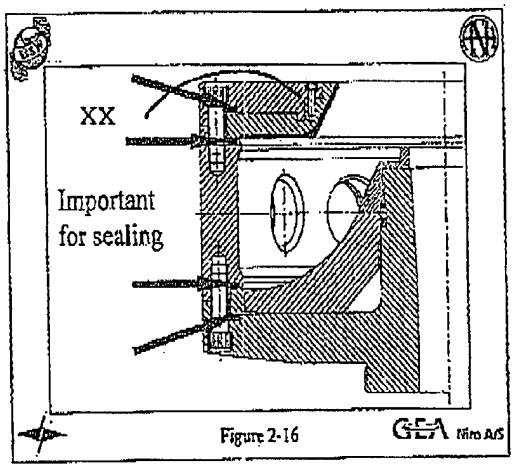

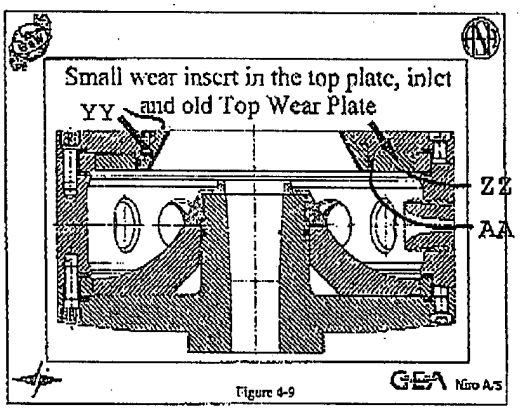

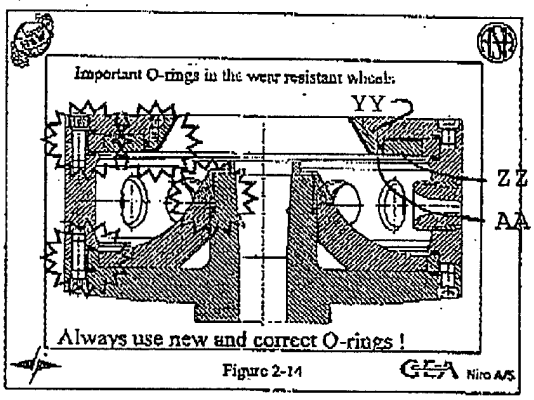

A further review and reconsideration of the atomizer lids and wear plates suggested in the foregoing figures discloses several very important distinctions between the invention of the patent and what are considered to be 102(b) inventions patented or described in a printed publication more than one year prior to the date of application (2004) for the present patent.

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publication more than one year prior to the date of application (2004) for the present patent.

While it is understood that Fig. 4-8 discloses what is considered to be large wear insert, what is not so clear from Fig 4-8, but what is quite clear from Fig 2-16 is the fact that the large wear insert is *bolted* to the atomizer lid. See reference XX in each figure. As is clear from the figures of the present patent, the atomizer lid 112 and the wear ring 114 are not joined together, and indeed are independent of each other. Claim 1 has been amended to specifically claim this "independence" of the lid and the wear ring. Because of this striking difference between the invention disclosed in Fig 4-8 and the presently disclosed and claimed invention of the patent (Claim 1, as amended), it is submitted that the invention of the patent was not previously disclosed and thus not anticipated by either the Conference 1999 or Conference 2000 materials.

A different wear ring configuration is disclosed in Fig. 4-9 and Fig 2-14. Rather than have just a single, unitary wear ring surround the opening through the lid, this embodiment provides two wear ring members (YY and ZZ) separated from each other by an O-ring (AA). And again in this embodiment, unlike the invention of Claim1 (amended) the *"small wear insert" YY is not independent of the* lid, but rather is bolted to the lid. It is pointed out that the "large wear insert" ZZ is substantially the same as the prior art wear ring 14 discussed in the patent – down to the fact that the two wear rings YY and ZZ are separated from each with an O-ring therein between, similar to the O-ring 26 discussed in the patent. As further discussed in the patent, leaving the O-ring is this position is detrimental to the life of the wear ring. This is specifically why the O-ring 136 was repositioned in the present invention.

In view of the fact that the present invention does not affix its wear ring, or any portion

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thereof to the lid member, as seen in the drawing, Claim 1 has been amended is patently distinct from the invention disclosed in the Conference 1999 and Conference 2000 figures and written disclosures referring to the figures.

With reference to the rejection of Claim 2, the Examiner points out that a containment ring (H) is adjacent the lid member (D) and surrounds the wear ring (F). As previously discussed, however, the wear ring (F) is not the same as the wear ring of the patent that is independent of the lid member. Therefore, it is submitted that the distinctions in the wear rings of the embodiments of Figs. 4-9 and 6 and the present invention cannot be considered to anticipate the wear ring, lid and containment ring combination of Claims 1 and 2.

Claim Rejections – 35 USC § 103

Claims 2-5 have been rejected under 35 U.S.C. 103(a) as being unpatentable over the disclosure of the Patent and the 2000 Dry Scrubber User conference publications (Conference 2000). In particular, the Examiner has stated:

> It would have been obvious to one having ordinary skill in the art to have modified the shape of the wear ring (14) and the lid member (12) of the prior art lid assembly (10) of Mudge such that the wear ring fits inside and extends through the first opening through the lid member, the wear ring having a second opening there through into the atomizing chamber when the lid member with the wear ring fitted therein is positioned on the atomizer wheel in order to prevent wear in the top inlet and prevent slurry penetration into the seal area behind the top wear plate as explicitly taught by Conference 2000.

<u>In Reference to Claim 2</u>

The Examiner further explains, "When the wear ring (14) of the prior art lid assembly

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(10) of Mudge is modified as taught by Conference 2000, the containment ring (16) would continue to surround the wear ring."

As discussed above, the wear ring of the present invention is *not* the same as the wear ring of the Conference 2000 teachings. The wear ring of the invention is independent of the atomizer lid. The teachings of both Conferences clearly teach that to provide a wear ring that surrounds the inner surface of the atomizer opening it is necessary to *bolt* the wear ring into place, and in fact by so doing it is possible to eliminate the containment ring altogether as shown in Fig 4-8. And as shown in Fig. 4-9, the wear ring extending into the lid opening is again bolted into position at one end, teaching away from the ability to hold the wear ring in place solely by use of a containment ring.

In view of the important difference between wear ring claimed in amended Claim 1 and the wear rings and containment mechanisms discussed or shown in the Conference papers, it is submitted that the inclusion of a containment right as claimed in Claim 2 should not be considered obvious.

<u>In Reference to Claims 3-5</u>

The Examiner has stated, "The materials of the prior art wear ring and lid member of Mudge are as claimed.

It is pointed out that Claims 3 -5 are dependent from what it is submitted is a properly allowable Claim 1 as amended, and therefore, it is submitted that rejection of Claims 3-5 should be withdrawn.

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Allowable/Confirmed Subject Matter

The Examiner has confirmed Claims 6 and 7.

CONCLUSION

In view of the above amendments and the foregoing remarks, reconsideration is respectfully requested. While the various figures and discussions cited disclose wear rings fitted into the opening of the atomizer lid, not one of the disclosures teaches a wear ring extending along the entire opening in the atomizer that is independent of the atomizer lid, i.e., is not bolted to the atomizer. Furthermore, there are no teachings to suggest that maintaining such a novel configuration and placement of a wear ring as taught and claimed in the present patent without the use of some means of affixing the wear ring (e.g., a bolt) to the atomizer lid would be obvious. Accordingly, withdrawal of the rejections of Claims 1-5 is respectfully requested.

Should the Examiner believe that anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact the undersigned attorney at the telephone number listed below.

Respectfully submitted,

CAESAR, RIVISE, BERNSTEIN,
COHEN & POKOTILOW, LTD.

June 28, 2007

By _____

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Please charge or credit our Account No. 03-0075 as necessary to effect entry and/or ensure consideration of this submission.

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Reexamination Control No. 90/007333
U.S. Patent No. 6,659,375
Amendment Dated 06/28/2007
Reply to Office Action of 06/16/2006

Attorneys for Patent Owner

Copy to Third-Party:

Edward Kondracki, Esq.
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(Substitute) PTO/SB/21 (09-04)
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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission: 16

Application Number	90/007,333
Filing Date	December 7, 2004
First Named Inventor	R. Mudge
Art Unit	3993
Examiner Name	Kenneth Bomberg
Attorney Docket Number	R1122/20002

MAILED JUN 28 2007 CENTRAL REEXAMINATION UNIT

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ENCLOSURES *(Check all that apply)*

- [ ] Fee Transmittal Form
  - [ ] Fee Attached
- [x] Amendment/Reply
  - [ ] After Final
  - [ ] Affidavits/declaration(s)
- [ ] Extension of Time Request
- [ ] Express Abandonment Request
- [ ] Information Disclosure Statement
- [ ] Certified Copy of Priority Document(s)
- [ ] Reply to Missing Parts/ Incomplete Application
  - [ ] Reply to Missing Parts under 37 CFR 1.52 or 1.53
- [ ] Drawing(s)
- [ ] Licensing-related Papers
- [ ] Petition
- [ ] Petition to Convert to a Provisional Application
- [ ] Power of Attorney, Revocation Change of Correspondence Address
- [ ] Terminal Disclaimer
- [ ] Request for Refund
- [ ] CD, Number of CD(s) _____
  - [ ] Landscape Table on CD
- [ ] After Allowance Communication to TC
- [ ] Appeal Communication to Board of Appeals and Interferences
- [ ] Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
- [ ] Proprietary Information
- [ ] Status Letter
- [x] Other Enclosure(s) (please identify below):

Supplement to Renewed Petition Under 37 CFR 1.137(a)

Remarks

Please charge Attorney Account No. 03-0075 as necessary to effect entry and/or ensure consideration of this submission.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Caesar, Rivise, Bernstein, Cohen & Pokotilow, Ltd., Customer No. 03000		
Signature	E S Marzluf		
Printed name	Eric S. Marzluf		
Date	June 28, 2007	Reg. No.	27,454

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below: [Transmitted to Facsimile No. (571) 273-9900]

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Typed or printed name	Eric S. Marzluf	Date	June 28, 2007

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: **Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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PMB 955
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DEC 20 2007

In re Shunpei Yamasaki et al.
Reexamination Proceeding
Control No.: 90/007,334
Filed: December 10, 2004
U.S. Patent No. 6,624,450
Issued: September 23, 2003
Title: SEMICONDUCTOR DEVICE AND METHOD FOR MAKING THE SAME

DECISION ON PETITION

This is a decision on the petition filed April 11, 2005, by the patent owner, entitled "Petition Under 37 CFR 1.181 for Reconsideration and/or Clarification of Decision Denying Request for *Ex Parte* Reexamination," requesting that the decision denying reexamination of U.S. patent No. 6,624,450 mailed March 7, 2005, be reconsidered or clarified.

The petition is GRANTED to the extent that the reexamination record has been reviewed but is DENIED as to making any change to the decision denying reexamination.

Petitioner asserts that in the decision denying reexamination, control No. 90/007,334 (hereinafter "the '334 reexam"), mailed March 7, 2005, the prior art relied upon to establish a substantial new question of patentability was misinterpreted and/or the claims of U.S. patent No. 6,624,450 was misconstrued.

As stated in MPEP § 2242 (rev. 3, August 2005), "[f]or 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 claims 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 claims."

The file records have been reviewed and this decision is based on whether the examiner's decision to deny the '334 reexam request was proper and whether the examiner's decision was made based upon the entirety of the evidence before the examiner and the examiner had a rational basis for reaching the decision. The question raised by the petition is whether the examiner properly considered the prior art in view of the request and whether the examiner has properly construed the claims of the patent.

BACKGROUND

U.S. Pat. No. 6,624,450 (hereinafter "the '450 patent") issued on September 23, 2003 to Yamazaki et al.

A reexamination proceeding, control No. 90/007,334 was requested by the patent owner on December 10, 2004,

Reexamination was denied in a decision mailed March 7, 2005.

The instant petition was filed on April 11, 2005. This petition was matched with the patent file because it listed the patent number and the application serial number but did not list the reexamination control number.

A copy of the petition of April 11, 2005 was resubmitted, via facsimile transmission, on March 6, 2007.

SUBSTANTIAL NEW QUESTION OF PATENTABILITY:

The examiner has denied the request for reexamination because the request was not found to have raised a new question of patentability of at least one claim of the '450 patent.

As correctly pointed out in the request, 35 USC 303(a) states in part:

> "...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."

The patent owner asserts that the prior art considered by the examiner during prosecution of the '450 patent raises a substantial new question of patentability as to independent claims 1, 4, 7, 10, 12, 15, 18 and 20. Specifically, it is asserted the Japanese Laid-Open Patent No. 23575/1989 (64-023575) and U.S. Patent No. 4,851,363 to Troxell, taken alone or in combination, raise a substantial new question of patentability as to independent claims 1, 4, 7, 10, 12, 15, 18 and 20 of the '450 patent, and U.S. Patent No. 5,306,651 to Masumo et al. raises a substantial new question of patentability as to independent claims 1, 4, 7, 10, 12, 15, 18 and 20 of the '450 patent.

The above-cited prior art was considered and made of record by the examiner during the prosecution of the patent.

As noted in the petition, the request relies on three prior art references: Japanese Laid-Open Patent No. 23575/1989 (64-023575) and U.S. Patent No. 4,851,363 to Troxell, and U.S. Patent No. 5,306,651 to Masumo et al. The request does not cite any prior art that was not already of record in the patent in support of the request for reexamination.

MPEP § 2242.II sets forth guidance for determining whether a substantial new question of patentability is raised by the prior art patents and publications already of record in the patent. "In a decision to order reexamination made on or after November 2, 2002, reliance on old art does not necessarily preclude the existence of a substantial new question of patentability (SNQ) that is based exclusively on that old art. See Public Law 107-273, 116 Stat. 1758, 1899-1906 (2002), which expanded the scope of what qualifies for a substantial new question of patentability upon which a reexamination may be based. 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."

In the decision denying reexamination of March 7, 2005, the examiner clearly indicated that the request for reexamination had been considered and concluded that the prior art cited in the request did not raise a substantial new question of patentability as to any claim of the '450 patent to Yamazaki et al. The record reveals that the examiner properly considered the prior art in view of the request and properly construed the claims of the patent in reaching the decision denying the request for reexamination.

Petitioner requests reconsideration of the decision denying reexamination of the '450 patent to Yamazaki et al. because the decision appears to misconstrue the cited prior art and/or the issue claims of the '450 patent and argues about the examiner's statements vis a vis the cited prior art and the claims of the patent. At no time does the petition argue that the determination and conclusion by the examiner that no substantial new question of patentability was raised by the request was incorrect or in error, or that the prior art in fact raises a substantial new question of patentability of at least one claim of the patent.

In the absence of any assertion that the examiner erred in concluding that the request for reexamination fails to raise a substantial new question of patentability as to at least one claim of the '450 to Yamazaki et al., and in the absence of any abuse of discretion by the examiner, the petition must be denied.

CONCLUSION

The decision denying reexamination, mailed March 7, 2005, has been reviewed and found to have addressed all issues presented in the request for reexamination filed October 1, 2004, in a full and complete manner that was neither arbitrary nor capricious. The arguments submitted in the petition for reconsideration filed April 11, 2005 were given due consideration in the course of evaluating the petition but found not persuasive. The conclusion by the examiner that the '334 reexam request does not raise a substantial new question of patentability is proper.

For the above-stated reasons, the petition is denied.

This decision is final and non-appealable. 37 C.F.R. § 1.515(c). No further communication on this matter will be acknowledged or considered.

Any inquiry concerning this decision should be directed to Carl Whitehead, Jr., Supervisory Patent Examiner, at (571) 272- 1702.

Richard K. Seidel, TC 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.
90/007,336	12/08/2004	5068846	HAN0001Reexam	2542

7590 09/07/2006

Philips Intellectual Property & Standards
P. O. Box 3001
Briarcliff Manor, NY 10510

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/07/2006

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

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9/7/06

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Mr. William C. Fuess

10951 Sorrento Valley Road, Suite 2G

San Diego, CA 92121

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007336

PATENT NO. 5,068,846

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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SEP 07 2006

CENTRAL REEXAMINATION UNIT

Mr. William C. Fuess (For Requester)
10951 Sorrento Valley Road, Suite 2G
San Diego, CA 92121

In re Pieter Kramer	:
Reexamination Proceeding	: **DECISION**
Control No.: 90/007,336	: **DISMISSING**
Filed: December 8, 2004	: **PETITION**
For: U.S. Patent No.: 5,068,846	:

This is a decision on the August 3, 2006 patent owner petition titled PETITION UNDER 37 C.F.R. 1.182.

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

The petition is dismissed for the reasons set forth below.

REVIEW OF FACTS

1. Patent number 5,068,846 (the '846 patent) issued November 26, 2991.

2. On December 8, 2004, a request for reexamination of the '846 patent was filed. The resulting proceeding was assigned control No. 90/007,336 (the '7336 proceeding).

3. On February 14, 2005, the Office issued an order granting the request for reexamination in the '7336 reexamination proceeding.

4. The proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed on May 2, 2006.

5. On August 3, 2006, the patent owner filed the present petition under 37 CFR 1.182 for consideration of an Information Disclosure Statement filed with the petition.

6. The reexamination proceeding is in the final phase of being prepared for printing of the reexamination certificate (it is in the "printing cycle").

DECISION DISMISSING THE PETITION TO CONSIDER INFORMATION DISCLOUSRE STATEMENT

There is no issue fee in reexamination, and the present reexamination proceeding has entered the final phase of the publication process (the "printing cycle"). In a reexamination proceeding, there is no withdrawal under 37 CFR 1.313 of the proceeding from the publication process for consideration of an Information Disclosure Statement (IDS), because 37 CFR 1.313(a) applies to applications and not to reexamination proceedings. Accordingly, in this instance the petition for withdrawal of the proceeding from the publication process for consideration of the accompanying IDS has been filed under 37 C.F.R. 1.182.

While there is no regulatory provision for withdrawal of a reexamination proceeding from the publication process for consideration of an IDS, 37 CFR 1.313 provides such a mechanism for an application. Accordingly, the requirements of 37 CFR 1.313 for withdrawal of an application from the printing cycle (after the issue fee has been paid) will be applied analogously to the requirements for withdrawal of the present reexamination proceeding from the printing cycle.

37 CFR 1.313 states (emphasis added):

"(a) **Applications** may be withdrawn from issue for further action at the initiative of the Office or upon petition by the **applicant**. To request that the Office withdraw an application from issue, applicant must file a petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why withdrawal of the application from issue is necessary....

(c) Once the issue fee has been paid, **the application will not be withdrawn from issue upon petition by the applicant for any reason except:**

(1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;

(2) Consideration of a request for continued examination in compliance with § 1.114; or

(3) Express abandonment of the application. Such express abandonment may be in favor of a continuing application."

In the present instance, the fact situation fails to satisfy any grounds that would be analogous to those of 37 CFR 1.313(c). The instant petition was filed very late in the examination of the reexamination, and it fails to provide a statement with sufficient specificity as to why the submitted IDS items of information (art citations) make at least one specific claim unpatentable. To the contrary, patent owner merely states that DE 1 185 233 was presented to the patentee's counsel during a meeting with representatives of a licensee, with an allegation by the licensee that DE 1 185 233 in combination with U.S. Patent No. 4,041,530 rendered unspecified claims unpatentable. Patent owner does not provide a sufficient discussion of the substance of either of the two recited references, and does not provide a statement of which claim(s) are unequivocally rendered unpatentable. Additionally, patent owner provides items of information from foreign counterpart applications which had not been cited during prosecution of the original patent nor the present reexamination proceedings. Moreover, patent owner has not applied the teachings of the any of the references to the claim limitations in the present reexamination proceeding.

For reexamination, there is a statutory requirement pursuant to 35 U.S.C. 305 that all *ex parte* reexamination proceedings "will be conducted with special dispatch within the Office." Since 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, then such criteria must certainly be complied with for a reexamination proceeding where there is a statutory requirement for special dispatch.

Accordingly, the present proceeding will not be withdrawn from the publication process for consideration of the IDS submitted with the petition, and the petition must be dismissed. If, however, the patent owner believes that one or more of the submitted information items (art citations) raises a substantial question of patentability as to at least one claim of the '846 patent which is different than already raised and considered thus far, then the patent owner can always file a new request for reexamination for consideration of such information item(s).

The following is provided for advisory purposes:

As to any IDS that is submitted after a Notice of Intent to Issue a Reexamination Certificate (NIRC) has been mailed, even where the reexamination proceeding has not entered the printing cycle, consideration of an IDS would run contrary to the statutory requirement of 35 U.S.C. 305 that "[a]ll reexamination proceedings under this section...will be conducted with special dispatch within the Office." This statutory provision is grounded on the need for certainty and finality as to the question of patentability raised by the request for reexamination. Accordingly, once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. The granting of a petition to consider an IDS filed after the NIRC would require withdrawal of the reexamination proceeding from the publication process, evaluation of the citations, and issuance of another action. This clearly would not carry out the special dispatch mandated by the statute. In order to justify a withdrawal from the publication process to consider an IDS, in the face of the mandate for special dispatch, there is a need for the patent owner (submitting the IDS) to assert that the information submitted raises a question of patentability as to the claims, and to apply the information to the claims' limitations, to facilitate consideration and to further the statutory mandate for special dispatch. If the patent owner fails to do so, it is not appropriate that the reexamination proceeding should be reopened at this late point in the proceeding for consideration of the information. Instead, the patent owner can file a new request for reexamination for consideration of the information, where the patent owner believes that the submitted information raises a substantial question of patentability (as to at least one claim of the patent) which is different than already raised and considered.

CONCLUSION

1. The patent owner petition to consider the Information Disclosure Statement filed with the petition is dismissed.

2. The Information Disclosure Statement is however entered into the file for the present reexamination proceeding.

3. The present proceeding will continue in the publication process, toward issuance of a reexamination certificate.

4. Telephone inquiries related to this decision should be directed to Mary C. Till at 571-272-7755.

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

September 7, 2006
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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Michael I. Wolfson
GREENBERG TRAURIG, LLP
200 Park Avenue
New York, NY 10166

For Patent Owner

Stanley Green
CONNOLLY BOVE LODGE & HUTZ
1990 M Street, NW, suite 800
Washington, DC 20036

For Requester

Ex Parte Reexamination Proceeding
Control No. 90/007,341
Filed: December 9, 2004
For: US Patent No. 6,444,058

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

This is a decision on the petition filed February 21, 2006 to request a one-month extension of time pursuant to 37 CFR 1.550 for responding to the Office action dated January 6, 2006.

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

The petition is granted 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 January 6, 2006, which set a two 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 the Office action was received and docketed at Alcoa and brought to the attention of counsel during the week of February 6, 2006. Since that time, an extensive file of the underlying patent and the reexamination file has been assembled. The files are presently under review together with the outstanding Office action issued in the related reexamination file of US Patent No. 6,576, 071 which is a divisional application with a similar extensive file. The request indicates the additional time will allow patentees to complete and submit a thorough reply to the outstanding Office action in both

reexamination files. An extension of time until April 6, 2006 is requested to facilitate the completion of the reply.

Analysis and Findings

On balance, it is considered that the petition explains the "sufficient cause" for an extension of time. It is clear that the Reexamination file is substantial and that counsel requires consultation with the patentee to prepare a complete response. One should note, however, given the time allotted for response in reexamination proceedings, one should reasonably anticipate the time needed for file review and for consultation with inventors and patent owners. An extension of time of one month is considered sufficient to compile the information and complete the response.

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 January 6, 2006 is **granted**.

2. The Patent Owner's response is due April 6, 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.

for Deborah Jones
Lissi M. Marquis,
Director,
Central Reexamination Unit

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

Michael I. Wolfson
GREENBERG TRAURIG, LLP
200 Park Avenue
New York, NY 10166

For Patent Owner

Stanley Green
CONNOLLY BOVE LODGE & HUTZ
1990 M Street, NW, suite 800
Washington, DC 20036

For Requester

Ex Parte Reexamination Proceeding
Control No. 90/007,342
Filed: December 9, 2004
For: US Patent No. 6,576,071

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

This is a decision on the petition filed February 21, 2006 to request a one-month extension of time pursuant to 37 CFR 1.550 for responding to the Office action dated January 6, 2006.

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

The petition is granted 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 January 6, 2006, which set a two 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 the Office action was received and docketed at Alcoa and brought to the attention of counsel during the week of February 6, 2006. Since that time, an extensive file of the underlying patent and the reexamination file has been assembled. The files are presently under review together with the outstanding Office action issued in the related reexamination file of US Patent No. 6,444,058 which is a divisional application with a similar extensive file. The request indicates the additional time will allow patentees to complete and submit a thorough reply to the outstanding Office action in both

reexamination files. An extension of time until April 6, 2006 is requested to facilitate the completion of the reply.

Analysis and Findings

On balance, it is considered that the petition explains the "sufficient cause" for an extension of time. It is clear that the Reexamination file is substantial and that counsel requires consultation with the patentee to prepare a complete response. One should note, however, given the time allotted for response in reexamination proceedings, one should reasonably anticipate the time needed for file review and for consultation with inventors and patent owners. An extension of time of one month is considered sufficient to compile the information and complete the response.

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 January 6, 2006 is **granted**.

2. The Patent Owner's response is due April 6, 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.

for Deborah Jones
Lissi M. Marquis,
Director,
Central Reexamination Unit

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

James E. Lake
Wells St. John P.S.
601 W. First Avenue, Suite 1300
Spokane, WA 99201-3828

For Patent Owner

Mark A. Sweval
Futago Enterprises, Inc.
1226 Old Mill Lane
Lafayette, IN 47905

For Requester

Ex Parte Reexamination Proceeding
Control No. 90/007,343
Filed: December 8, 2004
For: US Patent No. 5,124,053

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

This is a decision on the petition filed February 15, 2006 to request a two month extension of time pursuant to 37 CFR 1.550 for responding to the Office action dated December 29, 2005.

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 December 29, 2005, which set a two 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, after an initial draft of the complete reply was prepared and a collaborative review was held, the decision was made to include evidence pertaining to secondary considerations of non-unobviousness. Patent Owner is seeking evidence of unexpected results, commercial success, long felt need, and/or failure by others, copying, initial disbelief or acclaim by experts, and licensing. Patent Owner has encountered difficulty in locating documentation

and individuals who can provide such evidence. This is believed to be due to the significant amount of time that has passed since the relevant applications were filed and marketing and implementation of the patented invention began. One of the inventors is now employed by the requestor, Futago Enterprises, and the other is employed by E.I. duPont de Nemours, which is the plaintiff in a suit involving the subject patent. Accordingly, none of the inventors are practically available for assistance. It is Patent Owner's intention to expedite collection, evaluation, and presentation of the evidence sought. The information is believed necessary to comply with paragraph 11 in the Office action that states "[I]n order to ensure full consideration of any amendments, affidavits or declarations or other documents as evidence of patentability must be submitted in response to this office action." An extension of time until April 29, 2006 to facilitate the completion of the reply is requested.

Analysis and Findings

On balance, it is considered that, while the petition explains the "sufficient cause" for an extension of time, such cause does not merit an extension of two months. It is clear that Patent Owner is being diligent in preparing and submitting a complete response and that Patent Owner requires consultation with the inventors and experts to prepare this document; however, given the time allotted for response in reexamination proceedings, one should reasonably anticipate the time needed for collection of information and data and for consultation with inventors. An extension of time of one month is considered sufficient to compile the information and complete the response.

Conclusion

1. The patent owner's petition for extension of time in which to file a response to the Office action dated December 29, 2005 is **granted**.

2. The Patent Owner's response is due March 29, 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.

for Lissi M. Marquis,
Director,
Central Reexamination Unit

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ALEXANDRIA, VA 22313-1450
www.uspto.gov

ARENT FOX KINTNER PLOTKIN & KAHN
1050 Connecticut Avenue, N.W.
Suite 400
Washington, DC 20036

(For Patent Owner)

MAILED

JUN 2 0 2006

CENTRAL REEXAMINATION UNIT

In re Majeed et al.	:	
Reexamination Proceeding	:	DECISION
Control No.: 90/007,344	:	GRANTING
Filed: December 15, 2004	:	PETITION
For: U.S. Patent No. 5,972,382	:	

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 June 15, 2005.[1] The petition is before the Office of Patent Legal Administration for decision.

The petition is **granted**.

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 5,972,382 (the '382 patent) issued on October 26, 1999.

2. The present request for reexamination was filed by patent owner on December 15, 2004, was assigned control No. 90/007,344, and is hereinafter referred to as the '344 reexamination proceeding.

3. Reexamination was ordered in the '344 reexamination proceeding on February 9, 2005.

4. A patent owner's statement under 37 CFR 1.530 was not received in the '344 reexamination proceeding.

5. A non-final Office action was mailed in the '344 reexamination proceeding on June 13, 2005.

6. A timely response by the patent owner to the non-final Office action was received in the Office on October 8, 2005, and was entered into the record.

[1] The instant proceeding is not an abandoned application. However, 37 CFR 1.137(b) also provides a petition right for entry of late papers to revive a reexamination proceeding terminated under 37 CFR 1.550(d), and is, therefore, applicable here. See MPEP § 2268.

7. A final rejection was mailed in the '344 reexamination proceeding on November 22, 2005.

8. On January 23, 2006, a Notice of Appeal was filed in the '344 reexamination proceeding.

9. On March 17, 2006, a request for continued examination (RCE) paper was filed by the patent owner.

10. The RCE paper included a Request for Continued Reexamination (RCE) Transmittal form, a submission in the form of a response with remarks (arguments) to the final Office action, a declaration under 37 CFR 1.132, an article entitled "Influence of Piperine on Rifampicin Blood Levels in Patients of Pulmonary Tuberculosis," and a check in the amount of $790.00 as payment of the RCE fee under 37 CFR 1.17(e).

11. The present '344 reexamination prosecution terminated on March 24, 2006, for failure to timely file a timely appeal brief.

12. On April 28, 2006, the instant petition to accept a delayed appeal brief was filed under 37 CFR 1.137(b) for the '344 reexamination proceeding. The petition under 37 CFR 1.137(b) was accompanied by an appeal brief.

13. Also on April 28, 2006, a petition under 1.182 for the continued examination of the '344 reexamination proceeding was filed. Accompanying the petition under 1.182 was a "Response Under 37 CFR 1.114," which addresses the November 22, 2005 rejection and includes a 37 CFR 1.132 declaration.

14. On June 16, 2006, the RCE paper filed on March 17, 2006 was **returned** to patent owner, because a RCE paper is not enterable in a reexamination proceeding.

DECISION

A grantable petition under 37 CFR 1.137(b) must be accompanied by:

(1)The reply[2] required to the outstanding Office action or notice, unless previously filed;
(2)The petition fee as set forth in § 1.17(m);
(3)A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional.

[2]For reexamination proceedings, the word "reply" is to be replaced by "response." See 37 CFR 1.550(d)and (e)(2).

Petitioner has satisfied items (1)-(3). With respect to item (1), it is noted that the response filed by petitioner (an Appeal brief) relies on information (a declaration under 37 CFR 1.132) not yet considered or entered by the examiner. However, the response will be accepted as proper, because pursuant to the decision on the § 1.182 petition mailed on even date with the instant § 1.137(b) petition, the prosecution of the instant '344 proceeding has now been continued thereby providing an entry right for such information.

The petition fee has been paid by check filed on April 28, 2006. Therefore, item (2) is satisfied.

With respect to item (3), the statement on page 2 of the instant petition satisfies the rule.

CONCLUSION

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

II. A decision granting the April 28, 2006 petition under 1.182 for the continued examination of the '344 reexamination proceeding is being mailed concurrently with the present decision.

III. Jurisdiction over the '344 reexamination proceeding is being returned to Technology Center 1600.

IV. Any further communications as to the merits of the reexamination proceeding should be directed to the examiner, J. Venkat, in Technology Center Art Unit 1615, at (571) 272-0607.

IV. Telephone inquiries related to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or in his absence, to Karen Hastings, Legal Advisor, at (571) 272-7717.

Kenneth Schor,
Senior Legal Advisor
Office of Patent Legal Administration

kmh

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6-19-06

UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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ARENT FOX KINTNER PLOTKIN & KAHN
1050 Connecticut Avenue, N.W.
Suite 400
Washington, DC 20036

(For Patent Owner)

MAILED

JUN 20 2006

CENTRAL REEXAMINATION UNIT

In re Majeed et al.
Reexamination Proceeding
Control No.: 90/007,344
Filed: December 15, 2004
For: U.S. Patent No. 5,972,382

DECISION
GRANTING
PETITION

This is a decision on patent owner's "Petition Under 37 CFR 1.182" filed on April 28, 2006. Patent owner seeks relief pursuant to the "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending" published in the Official Gazette on March 1, 2005. [1]

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

The petition is granted.

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 5,972,382 (the '382 patent) issued on October 26, 1999.

2. The present request for reexamination was filed by patent owner on December 15, 2004, was assigned control No. 90/007,344, and is hereinafter referred to as the '344 reexamination proceeding.

3. Reexamination was ordered in the '344 reexamination proceeding on February 9, 2005.

4. A patent owner's statement under 37 CFR 1.530 was not received in the '344 reexamination proceeding.

5. A non-final Office action was mailed in the '344 reexamination proceeding on June 13, 2005.

6. A timely response by the patent owner to the non-final Office action was received in the Office on October 8, 2005, and was entered into the record.

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

7. A final rejection was mailed in the '344 reexamination proceeding on November 22, 2005.

8. On January 23, 2006, a Notice of Appeal was filed in the '344 reexamination proceeding.

9. On March 17, 2006, patent owner filed a request for continued examination (RCE) paper under 37 CFR 1.114.

10. The RCE paper included a Request for Continued Reexamination (RCE) Transmittal form, a submission in the form of a response with remarks (arguments) to the final Office action, a declaration under 37 CFR 1.132, an article entitled "Influence of Piperine on Rifampicin Blood Levels in Patients of Pulmonary Tuberculosis," and a check in the amount of $790.00 as payment of the RCE fee under 37 CFR 1.17(e).

11. On March 24, 2006, the '344 reexamination prosecution became terminated for failure to timely file a timely appeal brief.

12. On April 28, 2006, a patent owner petition to accept a delayed appeal brief was filed under 37 CFR 1.137(b) for the '344 reexamination proceeding. The petition under 37 CFR 1.137(b) was accompanied by the appropriate fee and a response in the form of an appeal brief.

13. Also on April 28, 2006, patent owner filed the present petition under 1.182 for the relief in the form of a request for continued examination (RCR) of the '344 reexamination proceeding was filed, together with the fee therefor. Accompanying the petition under 1.182 was a "Response Under 37 CFR 1.114," which addresses the November 22, 2005 rejection and includes a 37 CFR 1.132 declaration.

14. On June 16, 2006, the RCE paper filed on March 17, 2006 was returned to patent owner, because a RCE paper is not enterable in a reexamination proceeding.

DECISION

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

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending." Notice was provided therein that a second (or subsequent) reexamination will no longer be ordered on the basis of a "substantial new question of patentability" (SNQ) that is the same as a SNQ raised in an earlier pending reexamination. The Notice stated that:

> "a patent owner will now be prevented from obtaining entry of an amendment and/or evidence not entered after final rejection in an ex parte reexamination proceeding by filing another request for reexamination based on the same substantial question of patentability raised/existing in the pending reexamination proceeding. In order to provide relief to the patent owner, the Office plans to propose a revision to the patent rules to provide for the filing of a request for continued reexamination (RCR) which would be similar to the request for continued examination (RCE) practice for applications. If the RCR practice is implemented, the patent owner, by filing an RCR, could obtain continued prosecution on the

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

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

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

To support the present petition, patent owner has submitted a paper styled as "Response Under 37 CFR 1.114" together with a declaration pursuant to 37 CFR 1.132 by Dr. Vladimir Badmaev, one of the co-inventors of the '382 patent. By its terms, 37 CFR 1.114 does not apply to reexamination proceedings. However, as part of the present petition under 37 CFR 1.182, the paper is being treated as a paper submitted to satisfy the requirements of a RCR petition. As discussed in the present petition, the response explains that the Badmaev declaration:

> "[r]eports the results from a clinical study of a piperine extract covered by the present invention. [T]he study showed that the administration of a comparatively low dose of piperine (5 mg per day) resulted in a statistically significant increase in the blood levels of a nutrient (vitamin C), but had no significant effect on the blood levels of a drug (propranolol)."

Patent owner believes that the response to the November 22, 2005 Office action, including the Badmaev declaration, will further the prosecution of the reexamination proceeding rather than delay it. It is also noted that the appeal brief filed as part of the petition under 37 CFR 1.137(b) that was filed concurrently with the present petition references the Badmaev declaration, so that entry of the Badmaev declaration will not delay the prosecution of the reexamination proceeding.

Based on the present facts and circumstances, the petition is granted, and the prosecution in the above-noted reexamination proceeding is hereby continued. The finality of the November 22, 2005 Office action is withdrawn, and the prosecution is reopened for entry into the record of the Badmaev declaration and consideration of both the Badmaev declaration and the patent owner's position of record. The proceeding will be forwarded to the examiner for such consideration. The examiner will then issue an Office action treating the amendment as a response received <u>after a first Office action</u>. In the event that the patent owner again appeals from a new final rejection, patent owner would be required to submit a new notice of appeal and a fresh copy of the appeal brief. Since the fees for filing a notice of appeal and an appeal

brief have already been paid, these fees would not need to be paid again; however, patent owner would be required to pay the difference between the fees that have been paid and any increased fee at the time of such a second appeal. [2]

CONCLUSION

1. The petition under 37 CFR 1.182 is granted.

2. The prosecution of the present '344 reexamination proceeding is continued.

3. The finality of the November 22, 2005 Office action is withdrawn, and prosecution of the proceeding is reopened to the extent that the response submitted with the petition under 37 CFR 1.182 will be addressed and treated as a response received after a first, non-final Office action.

4. The response filed with the present petition, including the Badmaev 37 CFR 1.132 declaration, will be entered by the Technology Center, and then considered by the examiner.

5. Any further relief via a Request for Continued Reexamination is barred, absent a showing of an extraordinary situation where justice requires further such relief.

6. A decision granting the April 28, 2006 petition to accept the delayed filing of the appeal brief is being mailed concurrently with the present decision.

7. Jurisdiction over the present '344 reexamination proceeding is being forwarded to the Technology Center for further handling and examination not inconsistent with this decision.

8. Telephone inquiries related to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or in his absence, Kenneth Schor, Senior Legal Advisor, at (571) 272-7710.

Kenneth Schor,
Senior Legal Advisor
Office of Patent Legal Administration

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June 19, 2006

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June 19, 2006

[2] See MPEP § 1207.04

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,344	12/15/2004	5972382	108064-00103	7286

4372 7590 06/20/2008

ARENT FOX LLP
1050 CONNECTICUT AVENUE, N.W.
SUITE 400
WASHINGTON, DC 20036

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/20/2008

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

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For Patent Owner

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CENTRAL REEXAMINATION UNIT

Ex Parte Reexamination Proceeding
Control No. 90/007,344
Filed: December 15, 2004
For: US Patent No. 5,972,382

DECISION DISMISSING PETITION FOR ENTRY OF AFTER FINAL AMENDMENT UNDER [37 CFR §1.181]

This is a decision on the petition pursuant to 37 CFR 1.181 filed April 4, 2008 requesting entry of the After Final Amendment filed February 15, 2008 in response to the Final Office Action mailed September 28, 2007. The petition is timely.

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

The petition requesting entry of the after final amendment filed February 15, 2008 is **dismissed** for the reasons set forth below.

Legal Basis

37 CFR §1.116(b) reads:

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

(1) An amendment may be made canceling claims or complying

with any requirement of form expressly set forth in a previous Office action;

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

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

MPEP §2272 reads in-part:

II. Action by Examiner

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

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

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

Analysis and Findings

The Patent Owner has presented an after final amendment which narrows some parts of the claims by replacing the open language "comprises" or "comprising" with the closed language "consisting of." However, this amendment raises new issues regarding the scope and meaning of the claims. For instance, in representative claim 3 the Patent Owner changes "comprising" to "consisting of" in line 2 and inserts the phrase

"a composition consisting of" into lines 2 - 3. While these changes at first appear to have narrowed the claimed invention, there still remains the open language "comprises" and "comprising" in lines 5 and 6. This mixing of open and closed language raises new issues of indefiniteness in both the breadth and meaning of the amended claim.

The Patent Owner argues that the proposed amendment (1) does not raise new issues that would require further search and/or consideration, (2) does not raise the issue of new matter, and (3) places the claims in better form for consideration on appeal by reducing or simplifying the issues. These arguments have been fully considered but are not deemed persuasive.

Contrary to the Patent Owner's position, the amendment does raise new issues and questions about the meaning and breadth of the amended claims. Because this lack of clarity with regard to the meaning and scope of the claims, the amendment fails to place the claim in better form for consideration on appeal. Finally, the Patent Owner has failed to provide good an sufficient reasons why the amendment was not earlier presented.

Decision

The Patent Owner failed to argue persuasively that the after final amendment does not raise new issues and places the claims in better condition for consideration upon appeal. Additionally, he has failed to provide any good and sufficient reason why the amendment was not presented earlier. The amendment does not place the claims in condition for allowance nor does it reduce or simplify the issue for consideration on appeal. Therefore, the petition under 37 CFR §1.181 requesting to have the after final amendment of February 15, 2008, entered into the record is **dismissed** for failing to comply with the requirements of 37 CFR §1.116(b) and MPEP §2272.

Conclusion

The Patent Owner's petition under 37 CFR 1.181 requesting entry of the after final amendment of February 15, 2008, is **dismissed** for failing to comply with 37 CFR §1.116(b) and MPEP §2272.

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

for Lissi M. Marquis,
Director,
Central Reexamination Unit

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Reexam Control No.: 90/007,349
Filed : December 21, 2004
For U.S. Patent No. : 6,401,824

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexam Control No.: 90/007,585
Filed : June 13, 2005
For U.S. Patent No. : 6,401,824

The above noted reexamination proceedings are before the Director of the Central Reexamination Unit for consideration of merger as provided for in 37 CFR 1.565(c).

Reexamination in application control No. 90/007,349 was ordered in a decision mailed March 4, 2005. A preliminary amendment amending some claims and adding some new ones was filed with the request on December 21, 2004. No patent owner's statement has been filed in the instant proceeding, nor has an Office action been issued.

Reexamination in application control No. 90/007,585 was ordered in a decision mailed September 6, 2005. No patent owner's statement has been filed in the instant proceeding, nor has an Office action been issued.

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.

Requirement for Same Claims, Drawings, and Specification in Both Proceedings

As noted above, the claims have been amended in the '349 reexamination proceedings by virtue of the preliminary amendment filed December 21, 2004. The patent owner is required to maintain identical claims, claim numbering, specifications, and drawings in both files.

Accordingly, patent owner is hereby 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 the third party 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 Director. Accordingly, the patent owner is hereby required to notify the Office who his single representative will be by filing the necessary papers in the appropriate file(s). The notification must be submitted within one month of the mailing date of this decision.

Conclusion

Reexamination Control Nos. 90/007,349 and 90/007,585 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.

Any inquiry concerning this decision should be directed to Andres Kashnikow, Special Programs Examiner, at telephone No. (571) 272-4361.

Lissi Mojica Marquis, Director
Central Reexamination Unit

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Reexam Control No.: 90/007,350
Filed : December 21, 2004
For U.S. Patent No. : 6,679,336

Reexam Control No.: 90/007,586
Filed : June 13, 2005
For U.S. Patent No. : 6,679,336

DECISION MERGING REEXAMINATION PROCEEDINGS

The above noted reexamination proceedings are before the Director of the Central Reexamination Unit for consideration of merger as provided for in 37 CFR 1.565(c).

Reexamination in application control No. 90/007,350 was ordered in a decision mailed March 4, 2005. A preliminary amendment amending some claims and adding some new ones was filed with the request on December 21, 2004. No patent owner's statement has been filed in the instant proceeding, nor has an Office action been issued.

Reexamination in application control No. 90/007,586 was ordered in a decision mailed September 6, 2005. No patent owner's statement has been filed in the instant proceeding, nor has an Office action been issued.

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.

Requirement for Same Claims, Drawings, and Specification in Both Proceedings

As noted above, the claims have been amended in the '350 reexamination proceedings by virtue of the preliminary amendment filed December 21, 2004. The patent owner is required to maintain identical claims, claim numbering, specifications, and drawings in both files.

Accordingly, patent owner is hereby 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 the third party 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 Director. Accordingly, the patent owner is hereby required to notify the Office who his single representative will be by filing the necessary papers in the appropriate file(s). The notification must be submitted within one month of the mailing date of this decision.

Conclusion

Reexamination Control Nos. 90/007,350 and 90/007,586 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.

Any inquiry concerning this decision should be directed to Andres Kashnikow, Special Programs Examiner, at telephone No. (571) 272-4361.

Lissi Mojica Marquis, Director
Central Reexamination Unit

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JUN 30 2005

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In re Fischell et al
Reexamination Proceeding
Control No. 90/007,355
Filed: December 22, 2004
For: U.S. Patent No. 6,547,817

: DECISION ON
: PETITION
: (37 CFR 1.515(c))

The paper filed by requester on April 15, 2005, styled as "Petition To The Director Under 37 CFR § 1.181", is before the Director of Technology Center 3700.[1] Petitioner, the reexamination requester, seeks review under 37 CFR § 1.181 of the examiner's Order dated March 15, 2005 denying the request for reexamination. Specifically, petitioner requests that the Technology Center Director:

(1) Reverse the Examiner's March 15, 2005 denial of the request for *ex parte* reexamination of United States Patent No. 6,547,817 (hereinafter the '817 patent) that was filed on December 22, 2004 on the grounds that the examiner's reliance on In re Portola Packaging, Inc.[2] is misplaced;

(2) Reverse the Examiner's March 15, 2005 denial of the request for *ex parte* reexamination of the '817 patent on the grounds that the examiner exceeded his authority in ruling that MPEP § 2217 is only applicable to continuation-in-part (CIP) applications and priority claims under 35 USC §119(a)-(d)[3]; and

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1 See 37 CFR 1.515(c) and MPEP § 2249.

2 110 F.3d 786, 42 USPQ2d 1295 (Fed Cir. 1997), 122 F.3d 1473,44 USPQ.2d 1060, Rehearing Denied

3 So-called "foreign priority claims."

(3) Direct the examiner to institute an *ex parte* reexamination of the '817 patent on the grounds that the request for reexamination raises a substantial new question of patentability with respect to all of the claims of the '817 patent based on certain identified patents that qualify as prior art if the '817 patent is denied benefit of the filing dates of the parent patents.

Petitioner's Grounds in Support of the Requested Relief

Petitioner alleges that the request for *ex parte* reexamination is based upon the "fact" that the '817 patent is not entitled to 35 USC § 120 benefit of the filing dates of certain prior patents[4] because the claims of the '817 patent are not enabled by the specification and claims of these prior patents.[5] Petitioner further alleges that absent benefit of the filing dates of these prior patents, the claims of the '817 patent are anticipated by, or obvious over, either one or both of U. S. Patent No. 6,053,940 and U. S. Patent 5,931,866, that neither of these patents was cited during the prosecution of the '817 patent, and that the reexamination request therefore raises a substantial new question of patentability. Accordingly, petitioner concludes that the request for reexamination was improperly denied.

Petitioner relies upon MPEP § 2217 as authority for the proposition that a request for *ex parte* reexamination may point out that claims in a patent for which reexamination is requested are entitled only to the filing date of the patent and are not supported by an earlier foreign or United States patent application whose filing date is claimed. It appears to have been petitioner's intention to file a petition pursuant to 37 CFR 1.183 to suspend the rules in order that the examiner could be directed to consider 35 USC § 112 issues and inequitable conduct issues with respect to the '817 patent.[6]

Summary of Decision

The petition is denied, because the reexamination request fails to raise a substantial new question of patentability as required by 35 USC §§ 303 and 304.

Discussion

I. Standard of Review

35 USC § 303(c) and 37 CFR 1.515(c) provide for the filing of a petition to review an examiner's determination refusing to order *ex parte* reexamination. The TC Director's review on petition is *de novo*.[7] Therefore, the review will determine whether the examiner's refusal to order reexamination was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of the request to order reexamination.

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[4] The '817 patent claims benefit under 35 USC § 120 as a continuation of U.S. Pat. No. 6,086,604, which in turn claims 35 USC § 120 benefit as a continuation of U. S. Patent No. 5,879,370, which in turn claims 35 USC § 120 benefit as a continuation of U. S. Pat. No. 5,643,312.

[5] Petition, pages 2-3.

[6] Petition, page 3 –4; request for reexamination filed December 22, 2004, page 18. See also the Order Denying Request for *Ex Parte* Reexamination dated March 15, 2005, page 4, penultimate paragraph wherein it is noted that the 37 CFR 1.183 petition mentioned in the request for reexamination does not appear to have been included with the request for reexamination papers.

[7] MPEP § 2249

II. The Legal Standard for Ordering Reexamination

A review of 35 USC §§ 302-307 and 37 CFR 1.510-1.570 shows that *ex* parte reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. In particular, 35 USC § 302(a) requires that a request for *ex parte* reexamination be based upon prior art as set forth in 35 USC § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.510(b)(1) requires that a request for *ex parte* reexamination include "a statement pointing out each substantial new question of patentability based on prior patents and printed publications." Questions relating to grounds of rejection other than those based on prior art patents or printed publications should **not** be included in the request and will not be considered by the examiner if included.[8] A substantial question of patentability is raised by a prior art patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final holding of invalidity after all appeals, or by the Office in a previous examination or in a reexamination of a patent.[9] If a substantial new question of patentability is found, an order for *ex parte* reexamination of the patent is issued.[10]

III. Analysis of the Request for Reexamination

A review of the position taken by requester in the *ex parte* reexamination request clearly shows that the request is predicated on showing that the claims of the '817 patent are based upon a specification that is alleged to be defective under 35 USC 112, first paragraph because the specification allegedly fails to enable the practice of the subject matter claimed in the '817 patent. Although petitioner argues[11] that the reexamination request merely addresses the question of whether the '817 patent is entitled to 35 USC § 120 benefit of the three prior United States patents,[12] the request in fact is not directed to the issue of whether the '817 is entitled to a given *prima facie* date of invention for any or all of its claimed subject matter based upon the parent patents or is limited to its actual filing date. Instead, the request for reexamination is premised on evidence, and argument based on that evidence, which allegedly demonstrates that the claims of the '817 patent are not enabled by the specification of the '817 patent under 35 USC § 112, first paragraph.[13]

For example the reexamination request presents "extracts" from deposition testimony of the inventors of the '817 patent taken with respect to certain litigation. As filed, the request for reexamination states that the inventors' testimony shows that "[t]he '817 Patent is not entitled to the claimed February 25, 1994,

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[8] MPEP §§ 2216 and 2217

[9] In general see MPEP § 2242 for a detailed discussion of the meaning of "substantial new question of patentability."

[10] 35 USC § 304(a)

[11] For example, see the paragraph bridging pages 2 and 3 of the petition, and the material beginning at the bottom of page 6 of the petition.

[12] See note 4., *supra*.

[13] 35 USC 112, first paragraph states that "The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention."

May 28, 1997, March 1999 (**and perhaps June 16, 2000**) filing dates because inventors Robert E. Fischell, David R. Fischell, and Tim A. Fischell (the only named inventors of the '817 Patent) have admitted under oath that **the specification is not enabling as to the combination of features recited in the claims**."(Emphasis supplied.)[14] The request then proceeds to discuss specific limitations recited in independent claim 1 of the '817 patent, **and clearly states that those limitations are not enabled by the disclosure of the '817 patent.**[15] Given the manner in which the reexamination request repeatedly emphasizes that the '817 patent does not enable the claimed invention, petitioner's attempt[16] to characterize the request for reexamination as not being based on lack of enablement and failure to meet the written description requirement in the '817 patent itself, because such attack would clearly be "prohibited by the rules", is simply not persuasive. The request quite clearly indicates that the specification of the '817 patent does not enable the claimed invention in the '817, and does not merely argue that the '817 patent is restricted to its actual filing date as the *prima facie* date for the invention claimed therein.

Moreover, a review of the disclosure of the '817 patent and the disclosures of the three parent patents in the 35 USC § 120 benefit chain shows that each succeeding document is alleged to be a continuation of the preceding document,[17] **and that the disclosures of these documents are essentially verbatim duplicates.**[18] Therefore, it logically follows that an argument asserting that the disclosure of any of the parent patents as not enabling for a particular invention disclosed in any of the three parent patents is, perforce, an argument that the '817 specification is itself not enabling for that particular invention. Reexamination of a patent cannot be based upon an argument that one or more claims in that patent are not enabled.[19]

Petitioner has argued[20] that when reexamining a patent, it is appropriate to reassess benefit claims and/or foreign priority claims in light of new facts.[21] However, such reassessment is **not** appropriate in the instant *ex parte* reexamination proceeding because of the specific facts presented in this reexamination proceeding. In the instant proceeding, it is logically impossible to make an allegation that one or all of the parent patents does not enable one or more claims of the '817 patent because **the '817 patent is a continuation patent containing essentially the identical disclosure set forth in each of the parent patent(s).** Unlike the situation in which a patent having a 35 USC § 120 benefit claim or a 35 USC 119(a)-(d) foreign priority claim may enable a claimed invention based on the disclosure in its own specification even if the benefit or priority document does not enable the invention claimed in the patent so as to entitle the patent to an earlier effective filing date for the claimed invention, **the '817 patent and its parents contain virtually identical disclosures**. This critical fact precludes the United States Patent Trademark Office from reassessing whether the parent patent(s) that are the subject of 35 USC § 120

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[14] Reexamination request, page 6.

[15] Reexamination request, pages 6-9, and page 17, second paragraph of the reexamination request in which the reexamination request discusses the testimony that is presented at 10-13 or the reexamination request.

[16] For example, see Argument 1, pages 5-6 of the petition and compare the material referenced in footnotes 14 and 15.

[17] As set forth in MPEP § 201.07, "A continuation is a second application for the same invention claimed in a prior nonprovisional application ... The disclosure presented in the continuation **must be the same as that of the original application ...**" See also MPEP § 201.06 regarding divisional applications which are defined as being "[a] later application for an independent or distinct invention, carved out of a pending application and **disclosing and claiming only subject mater disclosed in the earlier or parent application** ... The divisional application should set forth at least the portion of the earlier disclosure that is germane to the invention as claimed in the divisional application. (Emphasis supplied.)

[18] Petitioner has not pointed out any substantive differences between the disclosure in the '817 patent and the disclosures of the parent patents.

[19] 35 USC § 302(a); 37 CFR 1.510(b); MPEP §§ 2216, 2217 and 2242.

[20] Pages 8-9 of the petition.

[21] MPEP § 2217 supports this view, but does not do expressly do so with respect to a continuation (i.e. "child") patent having a disclosure that is essentially identical to the disclosure in its parent patent.

benefit claims in the '817 patent enable the invention claimed in the '817 patent within the meaning of 35 USC § 112, first paragraph, because to reassess that issue with respect to the parent patent(s) would **necessarily** amount to a reassessment of that enablement issue with respect to the specification of the '817 patent. **However, the United States Patent and Trademark Office cannot conduct an initial reassessment of the original specification and claims of the '817 patent for compliance with 35 USC § 112, first paragraph in an ex parte reexamination proceeding before the Office, whether that initial reassessment is explicitly requested or merely implicit in the reexamination request.**[22]

A 35 USC 112, first paragraph assessment of the sort necessitated by the instant reexamination request might be proper during certain proceedings in the United States Patent and Trademark Office when not precluded by statute, or during proceedings by a court of competent jurisdiction during proceedings before the court. For example, a prior final court decision holding that the claims of a given parent patent are not enabled by the disclosure of that patent might later be utilized as a basis for limiting the effective date of an invention claimed in a "child" patent being reexamined in the United States Patent and Trademark Office, **because the court proceedings in which the determination was made were not an *ex parte* reexamination proceeding within the Patent and Trademark Office, and therefore were not subject to the provisions of 35 USC §§ 302-307**. Thus, a substantial new question of patentability could be raised in an **ex parte** reexamination proceeding before the Office, based upon the limitation of the effective date of the patent for which reexamination is requested, without the Office raising any question regarding 35 USC § 112, first paragraph enablement of the invention claimed in the patent for which reexamination was requested. Again, in the instant *ex parte* reexamination proceeding, the argument that the specification of a parent patent is not enabling for subject matter claimed in a '817 patent is also **necessarily** an argument that the invention claimed in the '817 patent is not enabled by the specification of the '817 patent. That argument, **advanced for the first time in an ex parte reexamination proceeding governed by 35 USC §§ 302-307**, is clearly not a permissible argument. [23]

For the sake of completeness, it may be observed that the evidentiary foundation for the arguments made by petitioner in the request for reexamination of the '817 patent consists of the extracts from the deposition testimony of the three named inventors of the '817 patent. Assuming, *arguendo*, that petitioner had presented a persuasive argument to the effect that the request for reexamination was not merely based upon 35 USC § 112, first paragraph issues, it would then be necessary to examine the evidentiary foundation presented by the deposition testimony in order to determine whether it in fact raises a question of patentability that is both "new" and "substantial."[24]

A review of the reexamination request shows that the deposition testimony supplied in the reexamination request is characterized as being "extracts." The reexamination request does not provide any information as to the context of that testimony in the sense that it is not clear what, if any, additional and/or clarifying testimony may have been adduced during the deposition. In addition, it appears that that the deposition testimony is extremely conclusory in nature. The testimony in no way explains **why** the inventors, or one of ordinary skill in the appropriate manufacturing art, could not have made the invention claimed in the '817 patent as they have asserted in the testimony. In this regard, attention is directed to United States Patent No. 5,421,955, which appears to contain detailed disclosure regarding the manufacture of a stent that may be expanded from a flattened configuration for mounting on the balloon of a catheter, and then expanded within an artery.[25] The manufacturing method utilized is a

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[22] See note 19, *supra*.
[23] See note 19, *supra*.
[24] See note 10, *supra*.
[25] United States Patent 5,421,955, effective filing date December 9, 1993, column 1, line 53 *et seq.*

method in which a coating is applied to a thin-walled stainless steel tubular member by electrophoretic deposition and then removing portions of the coating to expose portions of the tubular member, which are then chemically etched.[26] Given that the inventors filed four 37 CFR 1.63 declarations over a period of more than six years in which they declared, pursuant to 18 USC § 1001, that they were the original and first inventors of the subject matter claimed in the '817 patent and in the three parent patents, and stating that they "reviewed and understand the contents of the attached **specification**[27] and claims", it would be necessary to understand considerably more about the reasons why the inventors believe that the invention claimed in the '817 patent could not have been made by them, and if they believe that it could not have been made by others of ordinary skill in the relevant art, why they hold that belief. The extracts from the deposition testimony that are presented in the reexamination request do not provides sufficiently detailed and clear information from which it is possible to conclude that the extracts from the deposition testimony in fact raise a substantial new question of patentability.

IV. Holding

Given the facts involved in this proceeding, the request for *ex parte* reexamination of the '817 patent was properly denied by the examiner. Because the facts are that the '817 patent claims 35 USC § 120 benefit of a parent patent, there are two additional parent patents in the chain, all of the patents are recited as being continuations of their immediate parents patent, **and the disclosures of all of the patents are essentially identical**, in the final analysis, notwithstanding petitioner's attempt to limit the "reassessment" of the enablement question to the parent patent(s), the request for reexamination is necessarily and clearly based upon an alleged 35 USC § 112, first paragraph defect in the specification of the '817 patent for which reexamination was requested. This interpretation is reinforced by the fact that in the reexamination request, petitioner stated several times that the '817 patent specification itself does not enable the '817 patent claims. Therefore, granting of the request for reexamination would necessarily require, even if only by implication, that the specification of the '817 be found to not enable the claims of the '817 patent. This is impermissible pursuant to 35 USC § 302(a), and the regulations promulgated in accordance therewith. And even if the reexamination request were somehow perceived as being confined only to the question of whether the parent patent(s) support a particular invention date for the claims of the '817 patent, the evidence presented on that question is not regarded as being of sufficient clarity and detail so as to support a finding that substantial new question of patentability is raised by the request for *ex parte* reexamination.

This decision is final and nonappealable. 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

PETITION DENIED.

Frederick R. Schmidt, Director
Technology Center 3700

[26] Ibid, column 2, lines 18-20; column 6, line 7 *et seq.*
[27] Emphasis supplied.

US005421955A

United States Patent [19]

Lau et al.

[11] Patent Number: 5,421,955

[45] Date of Patent: Jun. 6, 1995

[54] EXPANDABLE STENTS AND METHOD FOR MAKING SAME

[75] Inventors: Lilip Lau, Cupertino; William M. Hartigan, Fremont; John J. Frantzen, San Jose, all of Calif.

[73] Assignee: Advanced Cardiovascular Systems, Inc., Santa Clara, Calif.

[21] Appl. No.: 214,402

[22] Filed: Mar. 17, 1994

Related U.S. Application Data

[60] Division of Ser. No. 164,986, Dec. 9, 1993, abandoned, which is a continuation of Ser. No. 783,558, Oct. 28, 1991, abandoned.

[51] Int. Cl.[6] B44C 1/22; C23F 1/02

[52] U.S. Cl. 216/48; 156/644; 156/654; 156/659.1; 604/95; 606/198

[58] Field of Search 156/643, 644, 654, 656, 156/659.1, 664; 604/95; 606/198

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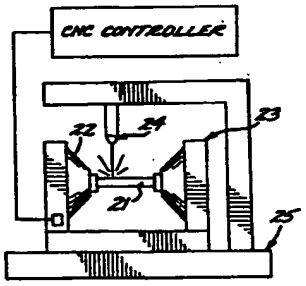
Primary Examiner—William Powell

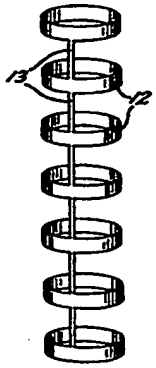
Attorney, Agent, or Firm—Fulwider Patton Lee & Utecht

[57] ABSTRACT

The invention is directed to an expandable stent for implantation in a body lumen, such as an artery, and a method for making it from a single length of tubing. The stent consists of a plurality of radially expandable cylindrical elements generally aligned on a common axis and interconnected by one or more interconnective elements. The individual radially expandable cylindrical elements consist of ribbon-like material disposed in an undulating pattern. The stents are made by coating a length of tubing with an etchant-resistive material and then selectively removing portions of the coating to form a pattern for the stent on the tubing and to expose the portions of the tubing to be removed. This may done by machine-controlled activation and relative positioning of a laser in conjunction with the coated tubing. After the patterning of the tubing, the stent is formed by removing exposed portions of the tubing by an etching process.

15 Claims, 3 Drawing Sheets





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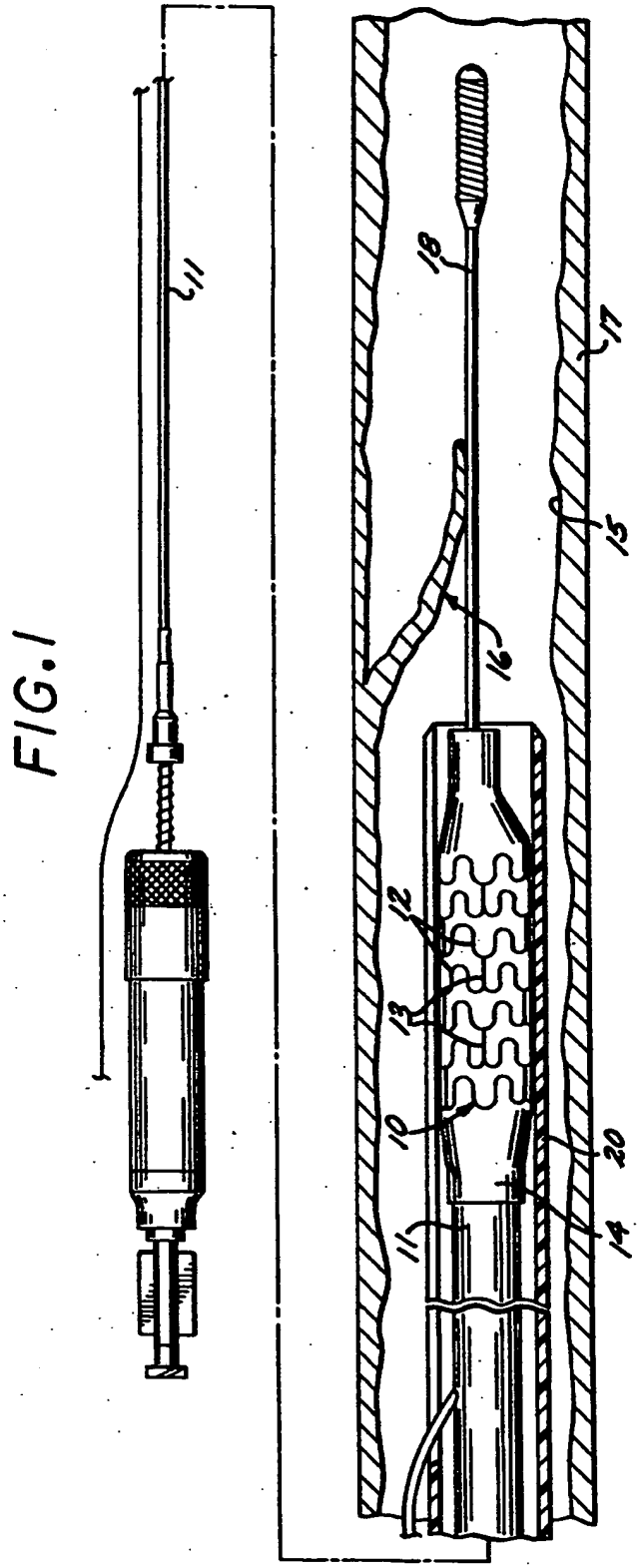


FIG. 1

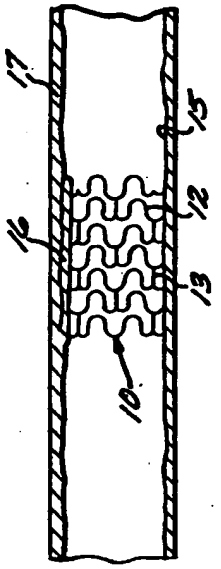


FIG. 3

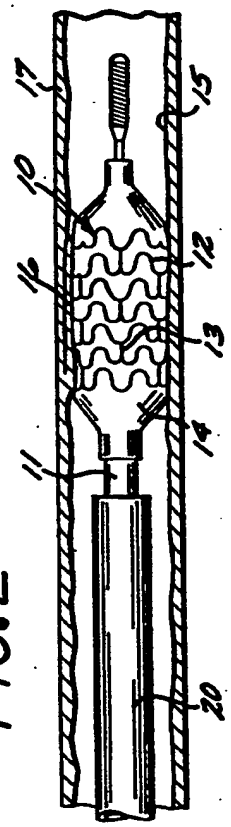


FIG. 2

FIG. 4

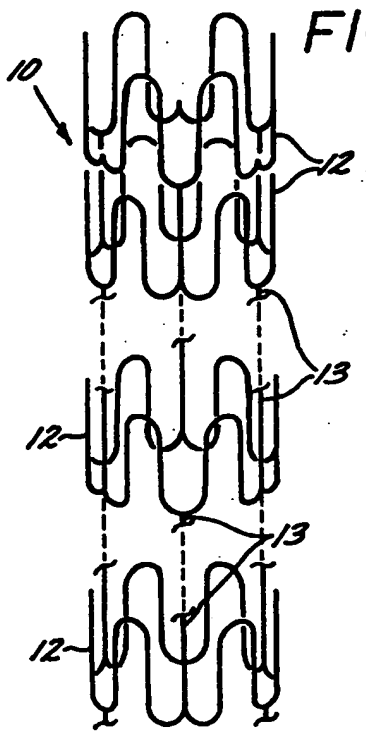


FIG. 6

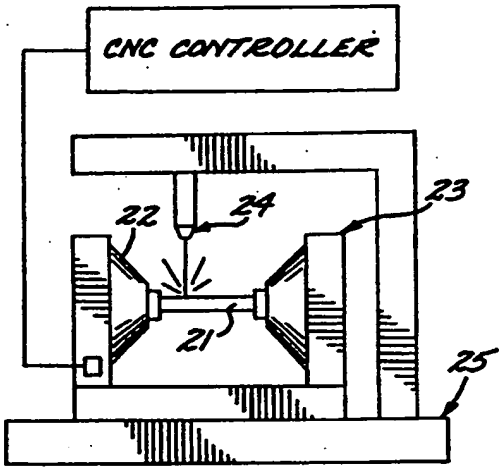


FIG. 5

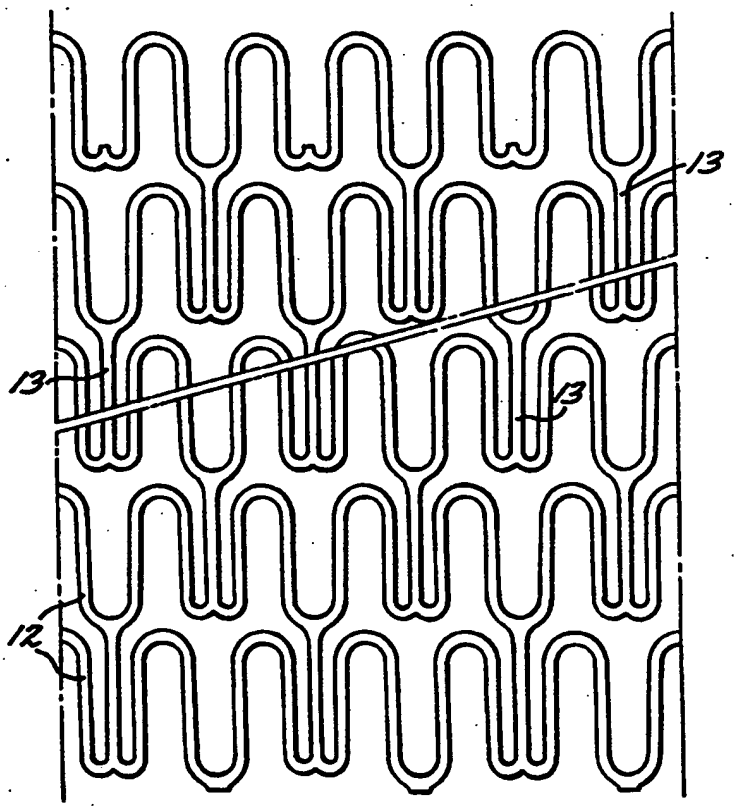


FIG. 7

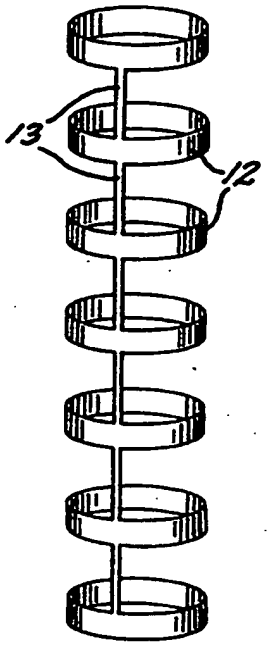


FIG. 8

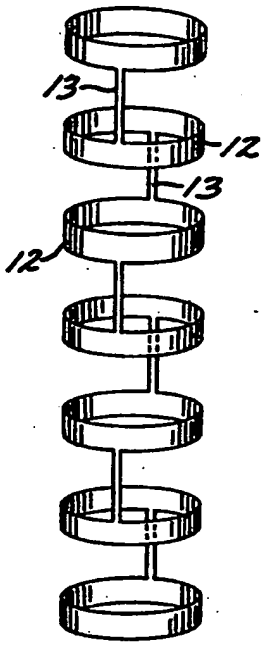


FIG. 9

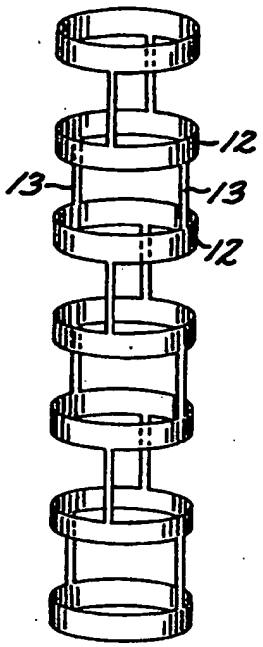


FIG. 10

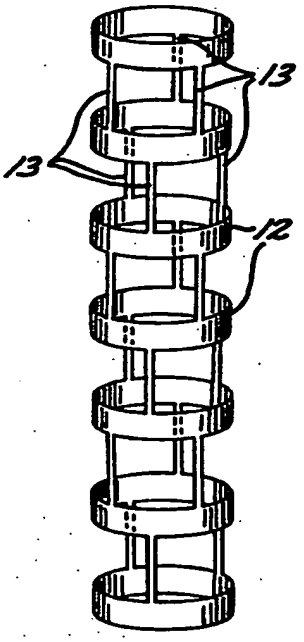
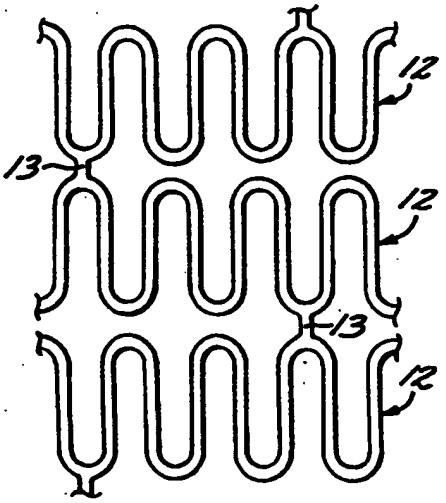


FIG. 11



EXPANDABLE STENTS AND METHOD FOR MAKING SAME

This application is a divisional application of Ser. No. 08/164,986, filed Dec. 9, 1993, now abandoned, which is a continuation of U.S. Ser. No. 07/783,558, filed Oct. 28, 1991, (now abandoned).

BACKGROUND OF THE INVENTION

This invention relates to expandable endoprosthesis devices, generally called stents, which are adapted to be implanted into a patient's body lumen, such as blood vessel, to maintain the patency thereof. These devices are very useful in the treatment of atherosclerotic stenosis in blood vessels.

Stents are generally tubular shaped devices which function to hold open a segment of a blood vessel or other anatomical lumen. They are particularly suitable for use to support and hold back a dissected arterial lining which can occlude the fluid passageway therethrough.

Further details of prior art stents can be found in U.S. Pat. No. 3,868,956 (Alfidi et al.); U.S. Pat. No. 4,512,338 (Balko et al.); U.S. Pat. No. 4,553,545 (Maass et al.); U.S. Pat. No. 4,733,665 (Palmaz); U.S. Pat. No. 4,762,128 (Rosenbluth); U.S. Pat. No. 4,800,882 (Gianturco); U.S. Pat. No. 4,856,516 (Hillstead); and U.S. Pat. No. 4,886,062 (Wiktor), which are hereby incorporated herein in their entirety by reference thereto.

Various means have been described to deliver and implant stents. One method frequently described for delivering a stent to a desired intralumenal location includes mounting the expandable stent on an expandable member, such as a balloon, provided on the distal end of an intravascular catheter, advancing the catheter to the desired location within the patient's body lumen, inflating the balloon on the catheter to expand the stent into a permanent expanded condition and then deflating the balloon and removing the catheter. One of the difficulties encountered using prior stents involved maintaining the radial rigidity needed to hold open a body lumen while at the same time maintaining the longitudinal flexibility of the stent to facilitate its delivery.

What has been needed and heretofore unavailable is a stent which has a high degree of flexibility so that it can be advanced through tortuous passageways and can be readily expanded and yet have the mechanical strength to hold open the body lumen into which it expanded. The present invention satisfies this need.

SUMMARY OF THE INVENTION

The present invention is directed to an expandable stent which is relatively flexible along its longitudinal axis to facilitate delivery through tortuous body lumens, but which is stiff and stable enough radially in an expanded condition to maintain the patency of a body lumen such as an artery when implanted therein.

The stent of the invention generally includes a plurality of radially expandable cylindrical elements which are relatively independent in their ability to expand and to flex relative to one another. The individual radially expandable cylindrical elements of the stent are dimensioned so as to be longitudinally shorter than their own diameters. Interconnecting elements or struts extending between adjacent cylindrical elements provide increased stability and are preferably positioned to prevent warping of the stent upon the expansion thereof.

The resulting stent structure is a series of radially expandable cylindrical elements which are spaced longitudinally close enough so that small dissections in the wall of a body lumen may be pressed back into position against the lumenal wall, but not so close as to compromise the longitudinal flexibility of the stent. The individual cylindrical elements may rotate slightly relative to adjacent cylindrical elements without significant deformation, cumulatively giving a stent which is flexible along its length and about its longitudinal axis but which is still very stiff in the radial direction in order to resist collapse.

The stent embodying features of the invention can be readily delivered to the desired lumenal location by mounting it on an expandable member of a delivery catheter, for example a balloon, and passing the catheter-stent assembly through the body lumen to the implantation site. A variety of means for securing the stent to the expandable member on the catheter for delivery to the desired location are available. It is presently preferred to compress the stent onto the balloon. Other means to secure the stent to the balloon include providing ridges or collars on the inflatable member to restrain lateral movement, or using bioresorbable temporary adhesives.

The presently preferred structure for the expandable cylindrical elements which form the stents of the present invention generally have a circumferential undulating pattern, e.g. serpentine. The transverse cross-section of the undulating component of the cylindrical element is relatively small and preferably has an apect ratio of about two to one to about 0.5 to one (e.g., the ratio of the height to the width of an undulation). A one to one apect ratio has been found particularly suitable. The open reticulated structure of the stent allows for the perfusion of blood over a large portion of the arterial wall which can improve the healing and repair of a damaged arterial lining.

The radial expansion of the expandable cylinder deforms the undulating pattern thereof similar to changes in a waveform which result from decreasing the waveform's amplitude and the frequency. Preferably, the undulating patterns of the individual cylindrical structures are in phase with each other in order to prevent the contraction of the stent along its length when it is expanded. The cylindrical structures of the stent are plastically deformed when expanded (except with NiTi alloys) so that the stent will remain in the expanded condition and, therefore, they must be sufficiently rigid when expanded to prevent the collapse thereof in use. With superelastic NiTi alloys, the expansion occurs when the stress of compression is removed so as to allow the phase transformation from austenite back to martensite and as a result the expansion of the stent.

The elongated elements or members which interconnect adjacent cylindrical elements should have a transverse cross-section similar to the transverse dimensions of the undulating components of the expandable cylindrical elements. The interconnecting elements may be formed in a unitary structure with the expandable cylindrical elements from the same intermediate product, such as a tubular element, or they may be formed independently and connected by suitable means, such as by welding or by mechanically securing the ends of the interconnecting elements to the ends of the expandable cylindrical elements. Preferably, all of the interconnecting elements of a stent are joined at either the peaks or the valleys of the undulating structure of the cylindrical

elements which form the stent. In this manner there is no shortening of the stent upon expansion, when measured from the outermost ends of the interconnecting members connected to the cylindrical elements at opposite ends of the stent.

The number and location of elements interconnecting adjacent cylindrical elements can be varied in order to develop the desired longitudinal flexibility in the stent structure both in the unexpanded as well as the expanded condition. These properties are important to minimize alteration of the natural physiology of the body lumen into which the stent is implanted and to maintain the compliance of the body lumen which is internally supported by the stent. Generally, the greater the longitudinal flexibility of the stent, the easier and the more safely it can be delivered to the implantation site.

In a presently preferred embodiment of the invention the stent is conveniently and easily formed by coating stainless steel hypotubing with a material resistant to chemical etching, and then removing portions of the coating to expose portions of underlying tubing which are to be removed to develop the desired stent structure. The exposed portions of the tubing are removed by chemically etching from the tubing exterior leaving the coated portion of the tubing material in the desired pattern of the stent structure. The etching process develops smooth openings in the tubing wall without burrs or other artifacts which are characteristic of mechanical or laser machining processes in the small sized products contemplated. Moreover, a computer controlled laser patterning process to remove the chemical resistive coating makes photolithography technology adaptable to the manufacture of these small products. The forming of a mask in the extremely small sizes needed to make the small stents of the invention would be a most difficult task. A plurality of stents can be formed from one length of hypotubing by repeating the stent pattern and providing small webs or tabs to interconnect the stents. After the etching process, the stents can be separated by severing the small webs or tabs which connect them.

Other features and advantages of the present invention will become more apparent from the following detailed description of the invention, when taken in conjunction with the accompanying exemplary drawings.

BRIEF DESCRIPTION OF THE DRAWINGS

FIG. 1 is a elevational view, partially in section, of a stent embodying features of the invention which is mounted on a delivery catheter and disposed within a damaged artery.

FIG. 2 is an elevational view, partially in section, similar to that shown in FIG. 1 wherein the stent is expanded within an damaged artery, pressing the damaged lining against the arterial wall.

FIG. 3 is an elevational view, partially in section showing the expanded stent within the artery after withdrawal of the delivery catheter.

FIG. 4 is a perspective view of a stent embodying features of the invention in an unexpanded state, with one end of the stent being shown in an exploded view illustrate the details thereof.

FIG. 5 is a plan view of a flattened section of a stent of the invention which illustrates the undulating pattern of the stent shown in FIG. 4.

FIG. 6 is a schematic representation of equipment for selectively removing coating applied to tubing in the manufacturing of the stents of the present invention.

FIGS. 7 through 10 are perspective views schematically illustrating various configurations of interconnective element placement between the radially expandable cylindrical elements of the stent.

FIG. 11 is a plan view of a flattened section of a stent illustrating an alternate undulating pattern in the expandable cylindrical elements of the stent which are out of phase.

DETAILED DESCRIPTION OF THE INVENTION

FIG. 1 illustrates a stent 10 incorporating features of the invention which is mounted onto a delivery catheter 11. The stent generally comprises a plurality of radially expandable cylindrical elements 12 disposed generally coaxially and interconnected by elements 13 disposed between adjacent cylindrical elements. The delivery catheter 11 has an expandable portion or balloon 14 for expanding of the stent 10 within an artery 15. The artery 15, as shown in FIG. 1, has a dissected lining 16 which has occluded a portion of the arterial passageway.

The delivery catheter 11 onto which the stent 10 is mounted, is essentially the same as a conventional balloon dilatation catheter used for angioplasty procedures. The balloon 14 may be formed of suitable materials such as polyethylene, polyethylene terephthalate, polyvinyl chloride, nylon and ionomers such as Surlyn® manufactured by the Polymer Products Division of the Du Pont Company. Other polymers may also be used. In order for the stent 10 to remain in place on the balloon 14 during delivery to the site of the damage within the artery 15, the stent 10 is compressed onto the balloon. A retractable protective delivery sleeve 20 as described in co-pending application Ser. No. 07/647,464, filed on Apr. 25, 1990 and entitled STENT DELIVERY SYSTEM may be provided to further ensure that the stent stays in place on the expandable portion of the delivery catheter 11 and prevent abrasion of the body lumen by the open surface of the stent 10 during delivery to the desired arterial location. Other means for securing the stent 10 onto the balloon 14 may also be used, such as providing collars or ridges on the ends of the working portion, i.e. the cylindrical portion, of the balloon.

Each radially expandable cylindrical element 12 of the stent 10 may be independently expanded. Therefore, the balloon 14 may be provided with an inflated shape other than cylindrical, e.g. tapered, to facilitate implantation of the stent 10 in a variety of body lumen shapes.

In a preferred embodiment, the delivery of the stent 10 is accomplished in the following manner. The stent 10 is first mounted onto the inflatable balloon 14 on the distal extremity of the delivery catheter 11. The balloon 14 is slightly inflated to secure the stent 10 onto the exterior of the balloon. The catheter-stent assembly is introduced within the patient's vasculature in a conventional Seldinger technique through a guiding catheter (not shown). A guidewire 18 is disposed across the damaged arterial section with the detached or dissected lining 16 and then the catheter-stent assembly is advanced over a guidewire 18 within the artery 15 until the stent 10 is directly under the detached lining 16. The balloon 14 of the catheter is expanded, expanding the stent 10 against the artery 15, which is illustrated in FIG. 2. While not shown in the drawing, the artery 15

is preferably expanded slightly by the expansion of the stent 10 to seat or otherwise fix the stent 10 to prevent movement. In some circumstances during the treatment of stenotic portions of an artery, the artery may have to be expanded considerably in order to facilitate passage of blood or other fluid therethrough.

The stent 10 serves to hold open the artery 15 after the catheter 11 is withdrawn, as illustrated by FIG. 3. Due to the formation of the stent 10 from an elongated tubular member, the undulating component of the cylindrical elements of the stent 10 is relatively flat in transverse cross-section, so that when the stent is expanded, the cylindrical elements are pressed into the wall of the artery 15 and as a result do not interfere with the blood flow through the artery 15. The cylindrical elements 12 of stent 10 which are pressed into the wall of the artery 15 will eventually be covered with endothelial cell growth which further minimizes blood flow interference. The undulating portion of the cylindrical sections 12 provide good tacking characteristics to prevent stent movement within the artery. Furthermore, the closely spaced cylindrical elements 12 at regular intervals provide uniform support for the wall of the artery 15, and consequently are well adapted to tack up and hold in place small flaps or dissections in the wall of the artery 15 as illustrated in FIGS. 2 and 3.

FIG. 4 is an enlarged perspective view of the stent 10 shown in FIG. 1 with one end of the stent shown in an exploded view to illustrate in greater detail the placement of interconnecting elements 13 between adjacent radially expandable cylindrical elements 12. Each pair of the interconnecting elements 13 on one side of a cylindrical element 12 are preferably placed to achieve maximum flexibility for a stent. In the embodiment shown in FIG. 4 the stent 10 has three interconnecting elements 13 between adjacent radially expandable cylindrical elements 12 which are 120 degrees apart. Each pair of interconnecting elements 13 on one end of a cylindrical element 12 are offset radially 60 degrees from the pair on the other side of the cylindrical element. The alternation of the interconnecting elements results in a stent which is longitudinally flexible in essentially all directions. Various configurations for the placement of interconnecting elements are possible, and several examples are illustrated schematically in FIGS. 7-10. However, as previously mentioned, all of the interconnecting elements of an individual stent should be secured to either the peaks or valleys of the undulating structural elements in order to prevent shortening of the stent during the expansion thereof.

FIG. 10 illustrates a stent of the present invention wherein three interconnecting elements 13 are disposed between radially expandable cylindrical elements 11. The interconnecting elements 12 are distributed radially around the circumference of the stent at a 120 degree spacing. Disposing four or more interconnecting elements 13 between adjacent cylindrical elements 12 will generally give rise to the same considerations discussed above for two and three interconnecting elements.

The properties of the stent 10 may also be varied by alteration of the undulating pattern of the cylindrical elements 13. FIG. 11 illustrates an alternative stent structure in which the cylindrical elements are in serpentine patterns but out of phase with adjacent cylindrical elements. The particular pattern and how many undulations per unit of length around the circumference of the cylindrical element 12, or the amplitude of the undulations, are chosen to fill particular mechanical requirements for the stent such as radial stiffness.

The number of undulations may also be varied to accommodate placement of interconnecting elements 13, e.g. at the peaks of the undulations or along the sides of the undulations as shown in FIGS. 5 and 11.

The stent 10 of the present invention can be made in many ways. However, the preferred method of making the stent is to coat a thin-walled tubular member, such as stainless steel hypotubing, with a material which is resistive to chemical etchants, and then to remove portions of the coating to expose the underlying hypotubing which is to be removed but to leave coated portions of the hypotubing in the desired pattern for the stent so that subsequent etching will remove the exposed portions of the metallic tubing, but will leave relatively untouched the portions of the metallic tubing which are to form the stent. The coated portion of the metallic tube is in the desired shape for the stent. An etching process avoids the necessity of removing burrs or slag inherent in conventional or laser machining processes. It is preferred to remove the etchant-resistive material by means of a machine-controlled laser as illustrated schematically in FIG. 6.

A coating is applied to a length of tubing which, when cured, is resistive to chemical etchants. "Blue Photoresist" made by the Shipley Company in San Jose, Calif., is an example of suitable commercially available photolithographic coatings. The coating is preferably applied by electrophoretic deposition.

To ensure that the surface finish is reasonably uniform, one of the electrodes used for the electrochemical polishing is a doughnut-shaped electrode which is placed about the central portion of the tubular member.

The tubing may be made of suitable biocompatible material such as stainless steel, titanium, tantalum, superelastic NiTi alloys and even high strength thermoplastic polymers. The stent diameter is very small, so the tubing from which it is made must necessarily also have a small diameter. Typically the stent has an outer diameter on the order of about 0.06 inch in the unexpanded condition, the same outer diameter of the hypotubing from which it is made, and can be expanded to an outer diameter of 0.1 inch or more. The wall thickness of the hypotubing is about 0.003 inch. In the instance when the stent was plastic, it would have to be heated within the arterial site where the stent is expanded to facilitate the expansion of the stent. Once expanded, it is cooled to retain its expanded state. The stent may be conveniently heated by heating the fluid within the balloon or by heating the balloon directly by a suitable system such as disclosed in application Ser. No. 07/521,337, filed Jan. 26, 1990, now U.S. Pat. No. 5,114,423, entitled "DILATATION CATHETER ASSEMBLY WITH HEATED BALLOON" which is incorporated herein in its entirety by reference. The stent may also be made of materials such as superelastic NiTi alloys such as described in application Ser. No. 07/629,381, filed Dec. 18, 1990, now abandoned, entitled SUPERELASTIC GUIDING MEMBER which is incorporated herein in its entirety by reference. In this case the stent would be formed full size but deformed (e.g. compressed) into a smaller diameter onto the balloon of the delivery catheter to facilitate transfer to a desired intralumenal site. The stress induced by the deformation transforms the stent from a martensite phase to a austenite phase and upon release of the force, when the stent reaches the desired intralumenal loca-

tion, allows the stent to expand due to the transformation back to the martensite phase.

Referring to FIG. 6, the coated tubing 21 is put in a rotatable collet fixture 22 of a machine controlled apparatus 23 for positioning the tubing 21 relative to a laser 24. According to machine-encoded instructions, the tubing 21 is rotated and moved longitudinally relative to the laser 24 which is also machine controlled. The laser selectively removes the etchant-resistive coating on the tubing by ablation and a pattern is formed such that the surface of the tube that is to be removed by a subsequent chemical etching process is exposed. The surface of the tube is therefore left coated in the discrete pattern of the finished stent.

A presently preferred system for removing the coating on the tubing includes the use of an 80 watt CO_2 laser, such as a Coherent Model 44, in pulse mode (0.3 mS pulse length); 48 mA key current and 48 W key power with 0.75 W average power, at 100 Hz; Anorad FR=20; 12.5 Torr; with no assist gas. Low pressure air is directed through the fine focus head to ensure that no vapor contacts the lens. The assist gas jet assembly on the laser unit may be removed to allow a closer proximity of the fine focus head and the collet fixture. Optimum focus is set at the surface of the tubing. Cured photoresist coating readily absorbs the energy of the CO_2 wavelength, so that it can be readily removed by the laser. A coated 4 inch length of 0.06 inch stainless steel tubing is preferred and four stents can be patterned on the length of tubing. Three tabs or webs between stents provide good handling characteristics for the tubing after the etching process.

The process of patterning the resistive coating on the stent is automated except for loading and unloading the length of tubing. Referring again to FIG. 6 it may be done, for example, using a CNC opposing collect fixture 22 for axial rotation of the length of tubing, in conjunction with a CNC X/Y table 25 to move the length of tubing axially relative to a machine controlled laser as described. The entire space between collets can be patterned using the CO_2 laser set-up of the foregoing example. The program for control of the apparatus is dependent on the particular configuration used and the pattern to be ablated in the coating, but is otherwise conventional.

This process makes possible the application of present photolithography technology in manufacturing the stents. While there is presently no practical way to mask and expose a tubular photoresist-coated part of the small size required for making intravascular stents, the foregoing steps eliminate the need for conventional masking techniques.

After the coating is thus selectively ablated, the tubing is removed from the collet fixture 22. Next, wax such as ThermoCote N-4 is heated to preferably just above its melting point, and inserted into the tubing under vacuum or pressure. After the wax has solidified upon cooling, it is reheated below its melting point to allow softening, and a smaller diameter stainless steel shaft is inserted into the softened wax to provide support. The tubing is then etched chemically in a conventional manner. After cutting the tabs connecting the stents any surface roughness or debris from the tabs is removed. The stents are preferably electrochemically polished in an acidic aqueous solution such as a solution of ELECTRO-GLO #300, sold by the ELECTRO-GLO CO., Inc. In Chicago, Ill., which is a mixture of sulfuric acid, carboxylic acids, phosphates, corrosion inhibitors and a biodegradable surface active agent. The bath temperature is maintained at about 110–135 degrees F. and the current density is about 0.4 to about 1.5 amps per in.^{2} Cathode to anode area should be at least about two to one. The stents may be further treated if desired, for example by applying a biocompatible coating.

While the invention has been illustrated and described herein in terms of its use as an intravascular stent, it will be apparent to those skilled in the art that the stent can be used in other instances such as to expand prostatic urethras in cases of prostate hyperplasia. Other modifications and improvements can be made without departing from the scope of the invention.

What is claimed is:

1. The process of making a stent which includes the steps of:
   a) applying a coating resistive to chemical etching to a length of tubing;
   b) selectively removing portions of the resistive coating to expose sections of the tubing; and
   c) removing exposed portions of the tubing.

2. The process of claim 1, wherein a plurality of stents are made from a single piece of tubing.

3. The process of claim 1, wherein the stent is made from a biocompatible material selected from the group consisting of polymers, stainless steel, titanium, superelastic NiTi alloys and tantalum.

4. The process of claim 1, wherein the coating is applied by electrophoretic deposition.

5. A method for making an open reticulated tubular structure, comprising the steps of:
   a) providing a discrete length of thin walled tubing;
   b) forming a resistive coating onto the exterior of the tubing;
   c) selectively removing portions of the resistive coating on the exterior of the tubing to leave the desired pattern of the complete open reticulated tubular structure coated with resistive coating and to expose portion of the tubing to be removed; and
   d) removing the exposed portions of the tubing.

6. The method of claim 5 wherein the exposed portions of the tubing is removed by etching.

7. The method of claim 5 wherein the selective removal of the resistive coating is accomplished by machine controlled relative movement of the tubing and laser.

8. The method of claim 5 wherein the laser used to selectively remove the resistive coating emits a particular wavelength of light which is readily absorbable by said coating.

9. The method of claim 5 wherein the laser is a CO_2 gas laser.

10. The method of claim 5 wherein the resistive coating used is a photolithographic chemically resistive coating.

11. A kit comprising:
   a) an elongated stent delivery catheter having proximal and distal extremities, and an expandable member on the distal extremity; and
   b) a longitudinally flexible stent which is adapted to be slidably mounted onto the expandable member of said catheter and which comprising a plurality of cylindrical elements which are independently expandable in the radial direction and which are interconnected so as to be generally aligned on a common axis.

12. A stent delivery system comprising:

an elongated stent delivery catheter having proximal and distal extremities, and an expandable member on the distal extremity; and

a longitudinally flexible stent which is adapted to be slidably mounted onto the expandable member of said catheter and which comprises a plurality of cylindrical elements which are independently expandable in the radial direction and which are interconnected so as to be generally aligned on a common axis.

13. A method for making a pattern in an intravascular stent comprising the steps of:

providing a discrete length of thin-walled hypotube;

applying a resistive coating on to the exterior of at least a portion of said hypotube;

means for selectively removing portions of the resistive coating from the exterior of said hypotube;

applying a chemical etchant to said hypotube so that said chemical etchant removes those portions of said hypotube where said resistive coating has been removed; and

removing the remaining resistive coating to provide an intravascular stent having a distinctive pattern.

14. The method for making the intravascular stent of claim 13, wherein said means for selectively removing said resistive coating is by a machine controlled laser.

15. The method for making the intravascular stent of claim 14, wherein said laser is a CO_2 gas laser operating in a pulsed mode.

* * * * *

US005421955B1

REEXAMINATION CERTIFICATE (3428th)

United States Patent [19]

Lau et al.

[11] B1 5,421,955

[45] Certificate Issued Jan. 20, 1998

[54] EXPANDABLE STENTS AND METHOD FOR MAKING SAME

[75] Inventors: Lilip Lau, Cupertino; William M. Hartigan, Fremont; John J. Frantzen, San Jose, all of Calif.

[73] Assignee: Advanced Cardiovascular Systems Inc., Santa Clara, Calif.

Reexamination Request:
No. 90/004,240, May 10, 1996

Reexamination Certificate for:

Patent No.:	5,421,955
Issued:	Jun. 6, 1995
Appl. No.:	214,402
Filed:	Mar. 17, 1994

Related U.S. Application Data

[62] Division of Ser. No. 164,986, Dec. 9, 1993, abandoned, which is a continuation of Ser. No. 783,558, Oct. 28, 1991, abandoned.

[51] Int. Cl.[6] B44C 1/22; C23F 1/02

[52] U.S. Cl. 216/48; 216/65; 604/95; 606/198

[58] Field of Search 216/48, 56, 65, 216/75, 100; 604/95; 606/198

[56] **References Cited**

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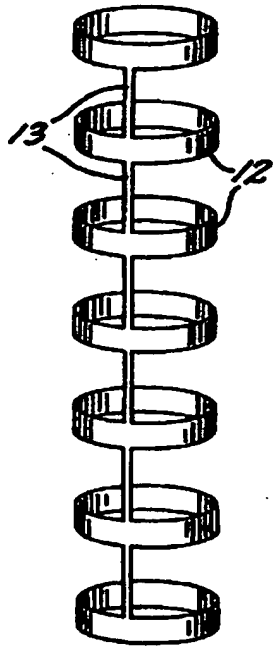
Primary Examiner—William A. Powell

[57] **ABSTRACT**

The invention is directed to an expandable stent for implantation in a body lumen, such as an artery, and a method for making it from a single length of tubing. The stent consists of a plurality of radially expandable cylindrical elements generally aligned on a common axis and interconnected by one or more interconnective elements. The individual radially expandable cylindrical elements consist of ribbon-like material disposed in an undulating pattern. The stents are made by coating a length of tubing with an etchant-resistive material and then selectively removing portions of the coating to form a pattern for the stent on the tubing and to expose the portions of the tubing to be removed. This may done by machine-controlled activation and relative positioning of a laser in conjunction with the coated tubing. After the patterning of the tubing, the stent is formed by removing exposed portions of the tubing by an etching process.



REEXAMINATION CERTIFICATE ISSUED UNDER 35 U.S.C. 307

THE PATENT IS HEREBY AMENDED AS INDICATED BELOW.

Matter enclosed in heavy brackets [ ] appeared in the patent, but has been deleted and is no longer a part of the patent; matter printed in italics indicates additions made to the patent.

AS A RESULT OF REEXAMINATION, IT HAS BEEN DETERMINED THAT:

The patentability of claims 11 and 12 is confirmed.

Claims 1, 5–10 and 13 are determined to be patentable as amended.

Claims 2–4, 14 and 15, dependent on an amended claim, are determined to be patentable.

New claims 16–34 and 35 are added and determined to be patentable.

1. The process of making a stent [which includes] *for use in a human vascular system, comprising* the steps of:

a) applying a coating resistive to chemical etching to a length of tubing;

b) selectively removing portions of the resistive coating to expose sections of the tubing; and

c) removing exposed portions of the tubing.

5. A method for making an open reticulated tubular structure, comprising the steps of:

a) providing a discrete length of thin walled tubing;

b) forming a resistive coating onto the exterior of the tubing;

c) selectively removing portions of the resistive coating on the exterior of the tubing *with a laser* to leave the desired pattern of the complete open reticulated tubular structure coated with resistive coating and to expose [portion] *the portions* of the tubing to be removed; and

d) removing the exposed portions of the tubing.

6. The method of claim 5, wherein the exposed portions of the tubing [is] *are* removed by etching.

7. The method of claim 5, wherein the selective removal of the resistive coating is accomplished by machine controlled relative movement of the tubing and *the* laser.

8. the method of claim 5, wherein the laser used to selectively remove the resistive coating emits a particular wavelength of light which is readily absorbable by said coating.

9. the method of claim 5, wherein the laser is a CO_2 gas laser.

10. The method of claim 5, wherein the resistive coating used is a photolithographic chemically resistive coating.

13. A method for making a pattern in an intravascular stent, comprising the steps of:

providing a discrete length of thin-walled hypotube;

applying a resistive coating on to the exterior of at least a portion of said hypotube;

means for selectively removing portions of the resistive coating from the exterior of said hypotube;

applying a chemical etchant to said hypotube so that said chemical etchant removes those portions of said hypotube where said resistive coating has been removed; and

removing the remaining resistive coating to provide an intravascular stent having a distinctive pattern.

16. The process of making a stent for use in a human vascular system, comprising the steps of:

a) applying a coating resistive to chemical etching to a length of tubing;

b) selectively removing portions of the resistive coating to expose sections of the tubing;

c) removing exposed portions of the; and

d) forming a repeating pattern of elements in the tubing which define the stent.

17. The process of claim 16, wherein a plurality of stents are made from a single piece of tubing.

18. The process of claim 16, wherein the stent is made from a biocompatible material selected from the group consisting of polymers, stainless steel, titanium, superelastic NiTi alloys and tantalum.

19. The process of claim 16, wherein the coating is applied by electrophoretic deposition.

20. A method for making an open reticulated tubular structure defining a stent, comprising the steps of:

a) providing a discrete length of thin-walled tubing;

b) applying a coating resistive to chemical etching to the discrete length of thin-walled tubing;

c) selectively removing portions of the resistive coating to expose sections of the tubing; and

d) removing exposed portions of the tubing thereby forming a pattern defining the stent.

21. The method of claim 20, wherein the exposed portions of the tubing are removed by chemical etching.

22. The method of claim 20, wherein the selective removal of the resistive coating is accomplished by machine controlled movement of the tubing relative to a stationary laser.

23. The method of claim 22, wherein the laser used to selectively remove the resistive coating emits a particular wavelength of light which is readily absorbable by said coating.

24. The method of claim 22, wherein the laser is a CO_2 gas laser.

25. The method of claim 20, wherein the resistive coating used is a photolithographic chemically resistive coating.

26. The process of making a stent for implanting in a body lumen, the method steps including:

a) applying a coating resistive to chemical etching to a length of tubing;

b) selectively removing portions of the resistive coating to expose sections of the tubing; and

c) removing all of the exposed portions of the tubing.

27. The process of claim 26, wherein a plurality of stents are made from a single piece of tubing.

28. The process of claim 26, wherein the stent is made from a biocompatible material selected from the group consisting of polymers, stainless steel, titanium, superelastic NiTi alloys and tantalum.

29. The process of claim 26, wherein the coating is applied by electrophoretic deposition.

30. A method for making an open reticulated tubular structure, comprising the steps of:

a) providing a discrete length of thin-walled tubing;

b) forming a resistive coating onto the exterior of the tubing;

c) selectively removing portions of the resistive coating on the exterior of the tubing to leave the desired pattern of the open reticulated tubular structure coated with resistive coating and to expose the portions of the tubing to be removed; and

d) removing all of the exposed portions of the thin-walled tubing.

31. The method of claim 30, wherein the exposed portions of the tubing are removed by chemical etching.

32. The method of claim 30, wherein the selective removal of the resistive coating is accomplished by machine controlled relative movement of the tubing and a laser.

33. The method of claim 32, wherein the laser used to selectively remove the resistive coating emits a particular wavelength of light which is readily absorbable by said coating.

34. The method of claim 33, wherein the laser is a CO_2 gas laser.

35. The method of claim 30, wherein the resistive coating used is a photolithographic chemically resistive coating.

* * * * *

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APR 15 2008

CENTRAL REEXAMINATION UNIT

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In re Smets et al.
Ex Parte Reexamination Proceeding
Control No.: 90/007,356
Filed: December 22, 2004
For: U.S. Patent No.: 6,778,282

DECISION ON PETITION FOR WITHDRAWAL FROM ISSUE UNDER 37 CFR 1.313(a) TREATED UNDER 37 CFR 1.182

This is a decision on the February 29, 2008 patent owner petition for withdrawal from issue filed under 37 CFR 1.313(a). As Rule 1.313(a) is only applicable to applications, not reexamination proceedings, the merits of the petition are being considered under 37 CFR 1.182, as explained below. The petition requests that the examiner reconsider an information disclosure statement (IDS) filed prior to mailing of the Notice of Intent to Issue a Reexamination Certificate (NIRC) and consider a Supplemental IDS filed prior to mailing of the NIRC.

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

The petition, as taken under 37 CFR 1.182, is granted, and the proceeding is remanded to the examiner for consideration of the IDSs.

FEES

The petition was submitted with a fee of $130, which is not adequate for a petition under Rule 1.182. Therefore, as authorized in the February 29, 2008 transmittal letter, Deposit Account No. 01-2511 has been charged $270 for the deficiency.

BACKGROUND

1. Patent number 6,778,282 issued on August 17, 2004.
2. A request for reexamination, assigned control No. 90/007,356 (the '7356 proceeding), was filed on December 22, 2004 by a third party requester.
3. On February 24, 2005 the Office issued an order granting the '7356 reexamination request.

4. An Information Disclosure Statement (IDS-1) was filed April 27, 2007, including PTO Form 1449 (nine pages) citing prior art.
5. A Supplemental Information Disclosure Statement (IDS-2) was filed May 4, 2007, including PTO Form 1449 (eight pages) citing prior art.
6. The '7356 proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) issued on May 25, 2007. The NIRC included a statement that IDS-1, filed April 27, 2007, failed to comply with 37 CFR 1.98(a)(3) because it did not include a concise explanation of the relevance of each patent listed that is not in the English language. IDS-1 was placed in the file, but the information was not considered. IDS-2, filed May 4, 2007, was not reviewed by Examiner.
7. On February 29, 2008, the instant petition was submitted requesting "withdrawal from issue" and advising that a statement of relevance was submitted with IDS-1, requesting that each English language reference in IDS-1 be considered, and requesting that IDS-2 be considered. Another Supplemental IDS (IDS-3) has been submitted concurrently with the petition on February 29, 2008, but consideration of IDS-3 was not explicitly requested in the petition.

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 (relevant portions)

.....Subject to the discussion below in this section, the examiner must also consider patents and printed publications ...(C) cited by the patent owner under a duty of disclosure (37 CFR 1.555) in compliance with 37 CFR 1.98.

.....Where patents, publications, and other such items of information are submitted by a party (patent owner or requester) in compliance with the requirements of the rules, the requisite degree of consideration to be given to such information will be normally limited by the degree to which the party filing the information citation has explained the content and relevance of the information.

.....Once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by **(A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding.** This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC.

Once the reexamination has entered the Reexamination Certificate publication process, pulling the proceeding from that process provides an even greater measure of delay. 37 CFR 1.313 states for an application (emphasis added):

> "(c) Once the issue fee has been paid, the application will not be withdrawn from issue upon petition by the applicant for any reason except:
> (1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;"

The publication process for an application occurs after the payment of the issue fee (there is no issue fee in reexamination), and thus 37 CFR 1.313(c) applies during the publication cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its publication cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). Accordingly, where a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), is made while a

proceeding is in its publication cycle, the patent owner must provide an unequivocal statement as to why the art submitted makes at least one claim unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable. This is in addition to the above-discussed (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier. The submission of patents and printed publications must be accompanied by a petition under 37 CFR 1.182 (with petition fee) for withdrawal of the reexamination proceeding from the publication process for entry and consideration of the information submitted by patent owner. A grantable petition must provide the requisite showing discussed in this paragraph. (Emphasis added)

DECISION

In a reexamination proceeding, there is no 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. In this instance, the petition for withdrawal from issue would constitute a withdrawal of the present proceeding from the publication process for consideration of IDS papers, which would have been appropriately filed under 37 CFR 1.182. It is under this rule that the petition is being considered.

Patent owner's petition requests withdrawal from issue and states the following:

(1) IDS-1 includes a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language.

(2) Patent owner requests that each patent, publication or other information listed in the information disclosure statement filed in IDS-1 that is in the English language be considered.

(3) Patent owner requests that IDS-2 be considered.

The patent owner has not petitioned for consideration of IDS-3, which was submitted after mailing of the NIRC.

The proceeding is remanded to the examiner for consideration of IDS-1, IDS-2, and IDS-3 to the extent that they comply with the requirements of 37 CFR 1.98(a). It is noted that in reexamination proceedings, consideration of material supplied under 37 CFR 1.555 is normally limited by the degree to which the party filing the information citation has explained the content and relevance of the information, as explained in MPEP 2256. The examiner will consider the IDS's and take appropriate action keeping in mind the mandate for handling reexamination proceedings with special dispatch within the Office.

CONCLUSION

1. The petition, as taken under 37 CFR 1.182, is granted.
2. The proceeding is remanded to the examiner for consideration of all three IDSs (the argument noted above as to IDS-1, and *ab initio*, IDS-2 and IDS-3) and appropriate action.

3. Telephone inquiries related to this decision should be directed to Caroline Dennison, Legal Advisor, at (571) 272-7729.

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,357	12/28/2004	5160842	803.900	2959

7590 07/17/2006

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/17/2006

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

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7/17/06

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007357

PATENT NO. 5,160,842

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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JUL 17 2006

CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

In re Ram Systems et al.	:	DECISION
Reexamination Proceeding	:	GRANTING
Control No.: 90/007,357	:	PETITION
Filed: December 28, 2004	:	TO REVIVE
For: U.S. Patent No. 5,160,842	:	(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 by facsimile transmission on July 14, 2006.[1] The petition is before the Office of Patent Legal Administration for decision.

FEES

The $750.00 small entity fee for the present petition to revive was charged to the patent owner's Deposit Account on May 19, 2006.

[1] This paper appears to have been filed at least twice previously. Previous filings appear not to have been associated with the Image File Wrapper (IFW), or have been incompletely associated with the IFW. For example, there is a paper associated with the IFW that was filed on May 19, 2006, but the paper is incomplete. A similar paper apparently filed on November 11, 2005 is appears in the IFW, but is also incomplete.

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 5,160,842 (the '842 patent) issued on November 3, 1992.

2. The present request for reexamination was filed by patent owner on December 28, 2004, was assigned control No. 90/007,357, and is hereinafter referred to as the '357 reexamination proceeding.

3. Reexamination was ordered in the '357 reexamination proceeding on February 3, 2005.

4. A patent owner's statement under 37 CFR 1.530 was not received in the '357 reexamination proceeding.

5. A non-final Office action was mailed in the '357 reexamination proceeding on June 22, 2005.

6. A timely response by the patent owner to the non-final Office action was received in the Office on July 26, 2005, and included a certificate of mailing under 37 CFR 1.8 dated July 22, 2006. [2]

7. Patent owner conducted a telephonic interview with the examiner on July 19, 2005. [3]

8. The examiner's summary of the July 19, 2005 interview was mailed to patent owner and third party requester on October 20, 2005.

9. Patent owner did not file a written statement of the reasons presented at the July 19, 2005 interview as warranting favorable action. [4]

10. The failure to file a written statement as required by 37 CFR 1.560 resulted in termination of the prosecution of the '357 reexamination proceeding.

11. On July 14, 2006, patent owner filed the present copy of petition to revive the '357 reexamination proceeding under 37 CFR 1.137(b).

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[2] Although this response appears in the IFW, it does not appear to have been docketed as a response.
[3] Interviews in *ex parte* reexamination proceedings are conducted pursuant to 37 CFR 1.560.
[4] 37 CFR 1.560(b) requires the filing of such written statement as a separate part of a response to an Office action outstanding at the time of the interview, or within one month from the date of the interview, whichever is later.

DECISION

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, patent owner has attached a written statement of the substance of the July 19, 2005 interview. Therefore item (1) is satisfied.

The petition fee was charged to petitioner patent owner's Deposit Account on May 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.

CONCLUSION

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

2. The patent owner response received on July 26, 2005 will be endorsed into the record and recorded in the PALM/PAIR system.

3. The '357 reexamination file will thereafter be returned to the examiner for issuance of an appropriate Office action in due course.

4. Any further communications as to the merits of the reexamination proceeding should be directed to Central Reexamination Unit Special Program Examiner Mark Reinhart at (571) 272-1611.

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.

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

sm
July 17, 2006

[5] For reexamination proceedings, the word "reply" is to be replaced by "response." See 37 CFR 1.550(d) and (e)(2)

ma-1

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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www.uspto.gov

Daniel C. Abeles
Eckert Seamans Cherin & Mellott, LLC
600 Grant Street - 44th Floor
Pittsburg, PA 15219 (For Patent Owner)

William H. Velke
Tylon Prototype Inc.
P.O.Box 154
Campbellville, Ontario
Canada, LOP 1B0 (For Requester)

MAILED
APR 12 2006
REEXAM UNIT

In re Briesch et al
Ex Parte Reexamination Proceeding
Control No.: 90/007,359
Filed: January 3, 2005
For: U.S. Patent No.: 5,845,481

DECISION DISMISSING PETITION

This is a decision on the petition filed by the requester on September 15, 2005, requesting that the reply filed July 28, 2005 be accepted as timely filed.

The petition is styled as a petition under 37 CFR 1.8 or 1.10, and it is before the Office of Patent Legal Administration for decision.

The petition is dismissed for the reasons set forth below.

DECISION

Pursuant to 37 CFR 1.6, correspondence received in the Patent and Trademark Office (the Office) is considered filed as of the date of receipt, subject to the exceptions set forth in the rules. The present situation does not fall within one of the exceptions.

A review of the record reveals that the reply filed July 28, 2005 was accorded a filing date as of the date the reply was received. The petition requests relief form this action of the Office under 37 CFR 1.8 or 1.10, to permit acceptance of the reply as timely filed. The reply papers do not, however, include a Certificate of Mailing pursuant to 1.8(a)(1)(ii), nor were they deposited with the U.S. Postal Service (USPS) with sufficient postage as first class mail pursuant to 1.8(a)(1)(i)(A). Thus, the reply fails to qualify for a designation of filing date other than the date of receipt under 37 CFR 1.8. Further, the reply papers also were not "delivered by the 'Express Mail Post Office to Addressee' service of the United States Postal Service (USPS)" pursuant to 37 CFR 1.10(a)(1). Thus, the reply fails to qualify for a designation of filing date other than the date of receipt under 37 CFR 1.10(a). In short, there is no basis for acceptance of the reply as timely filed.

The requester assumed the risk of any delay in delivery of the reply correspondence by employing a delivery service other than the USPS, and must accordingly accept the results of that choice. In this instance, it is further to be noted that 37 CFR 1.6(d) permitted the filing of the reply papers by facsimile transmission, and requester could have employed this vehicle to provide a timely filed reply. Accordingly, there is no basis *under any provision of the rules* to provide the relief requested.

CONCLUSION

I. The petition is dismissed.

II. Jurisdiction over the proceeding is being forwarded to the examiner for action on the proceeding in due course.

III. Any further communications as to the merits of the reexamination proceeding should be directed to examiner Matthew Graham, in the Central Reexamination Unit(CRU), at (571) 272-7116.

IV. Telephone inquiries related to this decision should be directed to Andres Kashnikow, Special Program Examiner, CRU, at (571) 272- 4361.

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

April 11, 2006
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(For Patent Owner)

MAILED

JUN 14 2006

CENTRAL REEXAMINATION UNIT

William H. Velke
Tylon Prototype Inc.
P.O.Box 154
Campbellville, Ontario
Canada, LOP 1B0

(For Requester)

In re Briesch et al
Ex Parte Reexamination Proceeding
Control No.: 90/007,359
Filed: January 3, 2005
For: U.S. Patent No.: 5,845,481

DECISION DISMISSING REQUEST FOR RECONSIDERATION

This is a decision on the papers filed by the third party requester on April 28, 2006, and May 2, 2006, which together are taken as a request for reconsideration of the "Decision Dismissing Petition" dated April 12, 2006. That decision dismissed the third party requester's petition filed on July 28, 2005 requesting acceptance of the untimely filed requester's 37 CFR 1.535 reply dated July 28, 2005.

The request for reconsideration and the present *ex parte* reexamination proceeding are before the Office of Patent Legal Administration for decision.

The petition is dismissed for the reasons set forth below.

BACKGROUND

1. U.S. Patent No. 5,845,481 (hereinafter the '481 patent) issued on December 8, 1998.

2. On January 3, 2005, the third party requester [1] filed a request for reexamination of the '481 that was accepted and assigned reexamination control number 90/007,359 (hereinafter the '359 reexamination proceeding).

3. Reexamination of the '481 patent was ordered on February 17, 2005.

4. On April 13, 2005, patent owner filed a patent owner's statement, together with certificate of service of the statement on the third party requester showing service on April 11, 2005.

[1] The third party requester is Tylon Prototype, Inc.

5. On July 28, 2005, the third party requester filed a reply to the patent owner's statement, marked as "second copy." [2]

6. On August 2, 2005, the third party requester filed a reply to the patent owner's statement marked as "third copy."

7. On September 15, 2005, the third party requester filed a paper entitled "Petition For Acceptance Of Requestor's (sic, Requester) Response As Timely."

8. On April 12, 2006, the September 15, 2005 third party requester petition was dismissed.

9. The present request for reconsideration was filed on April 28, 2006 and supplemented on May 2, 2006.

10. The third party requester papers comprising the request for reconsideration do not include a certificate of service on the patent owner.

DISCUSSION AND DECISION

The parties should note that this reexamination proceeding has been transferred from Technology Center 3700 and is currently pending in the Central Reexamination Unit, Art Unit 3993. The examiner is Matthew Graham and the Special Program Examiner is Andres Kashnikow.

37 CFR 1.248(a) and (b) provide:

> "(a) Service of papers must be on the attorney or agent of the party if there be such or on the party if there is no attorney or agent, and may be made in any of the following ways:
>
> (1) By delivering a copy of the paper to the person served;
>
> (2) By leaving a copy at the usual place of business of the person served with someone in his employment;
>
> (3) When the person served has no usual place of business, by leaving a copy at the person's residence, with some person of suitable age and discretion who resides there;
>
> (4) Transmission by first class mail. When service is by mail the date of mailing will be regarded as the date of service;
>
> (5) Whenever it shall be satisfactorily shown to the Director that none of the above modes of obtaining or serving the paper is practicable, service may be by notice published in the Official Gazette.
>
> (b) Papers filed in the Patent and Trademark Office which are required to be served shall contain proof of service. Proof of service may appear on or be affixed to papers filed. Proof of service shall include the date and manner of service. In the case of personal service, proof of service shall also include the name of any person served, certified by the person who made service. Proof of service may be made by:
>
> (1) An acknowledgement of service by or on behalf of the person served or
>
> (2) A statement signed by the attorney or agent containing the information required by this section."

[2] There is no "first copy" of the third party requester reply of record in the Image File Wrapper (IFW).

37 CFR 1.550(f) provides:

> "(f) The reexamination requester will be sent copies of Office actions issued during the *ex parte* reexamination proceeding. 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."

A review of the IFW record shows that neither the third party requester petition filed on September 15, 2005, nor the present request for reconsideration, includes a certificate of service evidencing that these papers were served on the patent owner. 37 CFR 1.550(f) requires that "any document" filed by the third party requester **must** be served on the patent owner. The regulation further provides that the Office may refuse to consider a document filed by either party, which fails to reflect service on the other party. In the present instance, the failure to serve the patent owner precluded an opportunity for the filing of a paper with respect to the petition by the patent owner, and accordingly the petition must be dismissed.

Petitioner is referred to *In re Hiniker Co.*, 150 F.3d 1362, 1367, 47 USPQ2d 1523, 1528 (Fed. Cir. 1998):

> "Hiniker next claims that it was unconstitutionally denied an opportunity to appear for a hearing before the Board. Hiniker is correct that PTO regulations provide that an oral hearing 'will' be provided where an appellant makes a proper request and pays the required fee. *See* 37 C.F.R. Section 1.194(c) (1997). However, the same regulations require that a patentee serve the reexamination requester with a copy of any document filed during the reexamination. *See* 37 C.F.R. Section 1.550(e). If a document is not properly served, 'the document may be refused consideration by the Office.' *Id.* Hiniker did not serve its competitors at the time it requested oral argument, and when it finally did file a certificate of service, the time for requesting oral argument had expired. Hiniker cannot lean on the regulations when it failed to satisfy a condition necessary to receive an oral argument, and Hiniker has not otherwise shown why its failure to receive an oral hearing in these circumstances has denied it due process of law, *see* 37 C.F.R. Section 1.194(a) ("An appeal decided without an oral hearing will receive the same consideration by the [Board] as appeals decided after oral hearing.").

Given that the patent owner is not in a position to file an opposition to a request for reconsideration with which it has not been served, service cannot be perfected by furnishing a copy of the third party requester papers to patent owner with a copy of a decision on petition. To decide the petition without affording patent owner an opportunity to file an opposition would be to deny patent owner due process of law as was the case in the *Hiniker Co.* decision. Accordingly, third party requester is required to serve patent owner with a copy of the present request for reconsideration, *i.e.*, a copy of the papers filed on August 28, 2006 and May 2, 2006 as set forth in the first paragraph of this decision. Service is to be in the manner set forth by 37 CFR 1.248. Third party requester is to file a certificate of service directed to this reexamination proceeding. The certificate must state that service of these papers has been made in a manner compliant with the requirements of 37 CFR 1.248. Failure to serve the papers, or failure to file a certificate of service, will result in a refusal to consider the request for reconsideration, and a return of the papers to third party requester. The papers will be closed in the IFW pending perfection of service.

Patent owner will have a period of **15 days from the date of service of the August 28, 2006 and May 2, 2006 papers** in which to file an opposition thereto; and such paper is not to be directed to the merits of the proceeding. Should patent owner not desire to file an opposition, a paper may be filed so indicating.

CONCLUSION

1. The request for reconsideration is dismissed.

2. Third party requester is required to perfect service of the papers comprising the request for reconsideration in accordance with 37 CFR 1.248 and 1.550(f).

3. Third party requester must also file a certificate of service.

4. Failure of third party requester to properly service the request for reconsideration, and/or failure to file a certificate of service, will result in the request for reconsideration being refused consideration and removed from the record by closing of the paper in the IFW file.

5. **All correspondence relating to an *ex partes* reexamination proceeding should be directed to:**

   By Mail: Mail Stop "*Ex Parte* Reexam"
   Attn: Central Reexamination Unit
   Commissioner for Patents
   P. O. Box 1450
   Alexandria VA 22313-1450

   By FAX: (571) 273-9900
   Central Reexamination Unit

   By hand: Customer Service Window
   Attn: Central Reexamination Unit
   Randolph Building, Lobby Level
   401 Dulany Street
   Alexandria, VA 22314

6. Telephone inquires with regard to this decision should be directed to Kenneth M. Schor, Senior Legal Advisor, at (571) 272-7710 or, in his absence, to Stephen Marcus, Legal Advisor, at (571) 272-7743

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

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June 12, 2006

April 11, 2006
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MAILED

JUL 28 2006

CENTRAL REEXAMINATION UNIT

William H. Velke
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In re Briesch et al
Ex Parte Reexamination Proceeding
Control No.: 90/007,359
Filed: January 3, 2005
For: U.S. Patent No.: 5,845,481

DECISION DENYING REQUEST FOR RECONSIDERATION

This is a decision on the petition papers filed by the third party requester on July 11, 2006, styled as PETITION FOR ACCEPTANCE OF REQUESTOR'S (*sic*, REQUESTER'S) RESPONSE AS TIMELY. The July 11, 2006 petition papers are together taken as a request for reconsideration of the "Decision Dismissing Request for Reconsideration" dated June 14, 2006, and of the underlying "Decision Dismissing Petition" dated April 12, 2006.

The request for reconsideration and the present *ex parte* reexamination proceeding are before the Office of Patent Legal Administration for decision.

The request for reconsideration is granted to the extent that the June 14, 2006 and April 12, 2006 decisions have been reconsidered, but is denied with respect to granting the requested relief for the reasons set forth below.

BACKGROUND

1. U.S. Patent No. 5,845,481 (hereinafter the '481 patent) issued on December 8, 1998.

2. On January 3, 2005, the third party requester [1] filed a request for reexamination of the '481 that was accepted and assigned reexamination control number 90/007,359 (hereinafter the '359 reexamination proceeding).

3. Reexamination of the '481 patent was ordered on February 17, 2005.

[1] The third party requester is Tylon Prototype, Inc..

4. On April 13, 2005, patent owner filed a patent owner's statement, together with a certificate of service of the statement on the third party requester showing service on April 11, 2005.

5. On July 28, 2005, the third party requester filed a reply to the patent owner's statement, marked as "second copy." [2]

6. On August 2, 2005, the third party requester filed a reply to the patent owner's statement marked as "third copy."

7. On September 15, 2005, the third party requester filed a paper entitled "Petition For Acceptance Of Requestor's (sic, Requester) Response As Timely."

8. On April 12, 2006, the September 15, 2005 third party requester petition was dismissed.

9. On April 28, 2006 and May 2, 2006, third party requester asked for reconsideration of the April 12, 2006 decision. The third party requester papers comprising the request for reconsideration did not include a certificate of service on the patent owner.

10. On June 14, 2006, the third party requester petition for reconsideration of the April 12, 2006 decision was dismissed for failure to perfect service of the petition in accordance with 37 CFR 1.248 and 1.550(f), as well as for failure to include a proper certificate of service when filing the petition papers in the Office. The Office perfected service of the April 28, 2006 and May 2, 2006 third party requester papers on patent owner by attaching a copy of the papers to the June 14, 2006 decision. Patent owner was accorded a period of 15 days from the date of service of the papers in which to file an opposition thereto.

13. Patent owner has not filed an opposition paper.

14. In the present third party requester petition, third party requester again seeks a holding that the third party requester 37 CFR 1.535 reply filed on August 2, 2005 was timely filed.

TRANSFER OF JURISDICTION TO CONDUCT REEXAMINATION

As a preliminary matter, the parties should note that this reexamination proceeding has been transferred from Technology Center 3700, and it is currently pending in the Central Reexamination Unit, Art Unit 3993. The examiner is Matthew Graham and the Special Program Examiner is Andres Kashnikow.

---

[2] There is no "first copy" of the third party requester reply of record in the Image File Wrapper (IFW). However as set forth, *infra*, it appears that third party requester alleges that the "first copy" of the third party requester reply was received in the Office June 14, 2005.

[3] See 35 U.S.C. § 305, last sentence.

APPLICABLE STATUTES, REGULATIONS AND PRACTICE

35 U.S.C. 304 provides:

"If, in a determination made under the provisions of subsection 303(a) of this title, the Director finds that a substantial new question of patentability affecting any claim of a patent is raised, the determination will include an order for reexamination of the patent for resolution of the question. The patent owner will be given a reasonable period, not less than two months from the date a copy of the determination is given or mailed to him, within which he may file a statement on such question, including any amendment to his patent and new claim or claims he may wish to propose, for consideration in the reexamination. If the patent owner files such a statement, he promptly will serve a copy of it on the person who has requested reexamination under the provisions of section 302 of this title. Within a period of two months from the date of service, that person may file and have considered in the reexamination a reply to any statement filed by the patent owner. That person promptly will serve on the patent owner a copy of any reply filed."

37 CFR 1.6 provides in pertinent part:

"(a) *Date of receipt and Express Mail date of deposit.* Correspondence received in the Patent and Trademark Office is stamped with the date of receipt except as follows:

(1) The Patent and Trademark Office is not open for the filing of correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia. Except for correspondence transmitted by facsimile under paragraph (a)(3) of this section, or filed electronically under paragraph (a)(4) of this section, no correspondence is received in the Office on Saturdays, Sundays, or Federal holidays within the District of Columbia.

(2) Correspondence filed in accordance with § 1.10 will be stamped with the date of deposit as "Express Mail" with the United States Postal Service.

(3) Correspondence transmitted by facsimile to the Patent and Trademark Office will be stamped with the date on which the complete transmission is received in the Patent and Trademark Office unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the date stamped will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia.

(4) [Reserved]

(b) [Reserved]

(c) *Correspondence delivered by hand.* In addition to being mailed, correspondence may be delivered by hand during hours the Office is open to receive correspondence.

(d) *Facsimile transmission.* Except in the cases enumerated below, correspondence, including authorizations to charge a deposit account, may be transmitted by facsimile. The receipt date accorded to the correspondence will be the date on which the complete transmission is received in the United States Patent and Trademark Office, unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. See § 1.6(a)(3). To facilitate proper processing, each transmission session should be limited to correspondence to be filed in a single application or other proceeding before the United States Patent and Trademark Office. The application number of a patent application, the control number of a reexamination proceeding, the interference number of an interference proceeding, or the patent number of a patent should be entered as a part of the sender's identification on a facsimile cover sheet."

37 CFR 1.8 provides in pertinent part:

"(a) Except in the situations enumerated in paragraph (a)(2) of this section or as otherwise expressly excluded in this chapter, correspondence required to be filed in the U.S. Patent and Trademark Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.

(1) Correspondence will be considered as being timely filed if:

(i) The correspondence is mailed or transmitted prior to expiration of the set period of time by being:

(A) Addressed as set out in § 1.1(a) **and deposited with the U.S. Postal Service with sufficient postage as first class mail**; or

(B) **Transmitted by facsimile to the Patent and Trademark Office in accordance with § 1.6(d)**; and

(ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.

...

(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the U.S. Patent and Trademark Office after a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence, or after the application is held to be abandoned, or after the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;

(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and

(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement."

(Emphasis supplied.)

37 CFR 1.10(a) provides:

"(1) Any correspondence received by the U.S. Patent and Trademark Office (USPTO) that was delivered by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) will be considered filed with the USPTO on the date of deposit with the USPS.

(2) The date of deposit with USPS is shown by the "date in" on the "Express Mail" label or other official USPS notation. If the USPS deposit date cannot be determined, the correspondence will be accorded the USPTO receipt date as the filing date. See § 1.6(a)."

37 CFR 1.530 provides in pertinent part:

(b) 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.

(c) Any statement filed by the patent owner shall clearly point out why the subject matter as claimed is not anticipated or rendered obvious by the prior art patents or printed publications, either alone or in any reasonable combinations. Where the reexamination request was filed by a third party requester, any statement filed by the patent owner must be served upon the ex parte reexamination requester in accordance with § 1.248.

37 CFR 1.535 provides:

> "A reply to the patent owner's statement under § 1.530 may be filed by the *ex parte* reexamination requester within **two months from the date of service of the patent owner's statement.** Any reply by the *ex parte* requester **must be served upon the patent owner in accordance with § 1.248.** If the patent owner does not file a statement under § 1.530, no reply or other submission from the ex parte reexamination requester will be considered. [Emphasis in bold added.]

MPEP 512 states in pertinent part:

> [T]he benefits of 37 CFR 1.8 or 37 CFR 1.10 apply only to documents delivered to the Office by the U.S. Postal Service. A number of instances have been uncovered where individuals are certifying that documents were deposited with the U.S. Postal Service when, in fact, the documents were hand-carried or delivered to the Office via commercial couriers, e.g., "Federal Express," "DHL," "Purolator," "Air Borne," "UPS." In those instances where documents include a Certificate of Mailing under 37 CFR 1.8 or "Express Mail" mailing label (commonly used to comply with 37 CFR 1.10) but were delivered to the Office by other than the U.S. Postal Service, Mail Center personnel are placing a notice indicating that fact on the correspondence involved to alert Office personnel that the benefits of 37 CFR 1.8 or 37 CFR 1.10 do not apply.

DECISION

A review of the Image File Wrapper (IFW) in the '359 *ex parte* reexamination proceeding reveals that (a) reexamination of the '481 patent was ordered on February 17, 2005, and (b) on April 13, 2005, patent owner filed a statement under 37 CFR 1.530, together with a certificate of service of the statement on requester showing service on April 11, 2005. Patent owner's statement was timely filed in accordance with the provisions of 35 U.S.C. § 304 and 37 CFR 1.530(b). Further, patent owner properly served the patent owner's statement on the third party requester in accordance with 37 CFR 1.530(c). The IFW further shows that a copy of third party requester's reply to the patent owner's statement was filed by third party requester on July 28, 2005, and again on August 2, 2005. The IFW does not contain the originally filed third party requester reply to the patent owner's statement. However, the IFW includes a verified statement by William H. Velke, president of requester Tylon Prototype, Inc. Affiant Velke stated as follows:

> "As the Re-Examination Department was in the process off relocating, Requestor's Response, was poorly addressed to the previous USPTO Mail Hand-Delivery address of 220 20th Street South, Crystal Plaza Two, Lobby Room 1B093, where it was however accepted and signed for on **June 14, 2005**, by L D 355, P. Barfield." [Emphasis added]

Affiant Velke then goes on to allege that the third party requester reply was thereafter mishandled in the Office.

Pursuant to 35 U.S.C. 304:

> "Within a period of **two months** from the date of service, that person [requester] may file and have considered in the reexamination a reply to any statement filed by the patent owner." [Emphasis added]

Whether or not the third party requester reply was in fact addressed correctly, [4] it is clear that the delivery on June 14, 2005 (a Tuesday) was not timely, because it was not within two months of the

[4] It was not correctly addressed. The April 5, 2005 paper reiterates information published in the February 1, 2005 *Official Gazette*. The April 5, 2005, Notice published in the *Official Gazette* states, in pertinent part:

April 11, 2005 service of patent owner's statement on the requester. Requester has admitted as much. [5] The correspondence was not delivered by the United States Postal Service or by facsimile transmission and, *ipso facto*, it is considered to have been "delivered by hand." [6,7] Moreover, the correspondence is conceded to have been delivered to the Office after the statutory deadline for filing the reply to patent owner's statement.

Requester argues that it is entitled to the date of delivery of the reply to Purolator Special Mail Delivery Service for next day delivery, as the filing date of the reply to patent owner's statement. Requester alleges that date to be May 24, 2005, and urges that the reply was therefore timely filed. However, in making this argument, requester ignores the fact that pursuant to 37 CFR 1.6(a), the date upon which a paper is filed in the Office is the date that the paper is received in the Office, unless the paper is filed in such a manner that it is entitled to the affect of the provisions of 37 CFR 1.8 or 37 CFR 1.10. Inasmuch as the third party requester's reply was not deposited with the U.S. Postal Service with sufficient postage as first class mail or transmitted by facsimile to the Office in accordance with 37 CFR 1.6(d), the reply was not entitled to the benefits of 37 CFR 1.8. Similarly, the requester's reply was not delivered by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS), and accordingly there is no date of deposit with USPS shown by the "date in" on an "Express Mail" label or other official USPS notation; thus, the third party requester's reply was not entitled to the benefits of 37 CFR 1.10.

Requester has made no attempt to show compliance with 37 CFR 1.8 by indicating the location on the correspondence in question of a certificate of mailing, as required by the regulation. In addition, requester has made no attempt to show compliance with 37 CFR 1.10, inasmuch as requester has not demonstrated where a USPS Express Mailing Post Office to Addressee label number appears, and requester has not provided a copy of a USPS Express Mailing Post Office to

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"Effective January 14, 2005, except for correspondence for Maintenance Fee payments, Deposit Account Replenishments (see 1.25(c)(4)), and Licensing and Review (see 37 CFR 5.1(c) and 5.2(c)), please address correspondence to be delivered by other delivery services (Federal Express (Fed Ex), UPS, DHL, Laser, Action, Purolater (*sic*, Purolator) etc.) as follows:

United States Patent and Trademark Office
Customer Service Window, Mail Stop ____
Randolph Building
401 Dulany Street
Alexandria, VA 22314"

[5] See page 1 of the attachment to the petition paper dated April 28, 2006, in which it is stated that " ... we have substantial proof and records to demonstrate that the Requestor's response was deposited with a special Delivery Agent for delivery to the Patent Office well before the required deadline, although the first accepted delivery was only 4 days late."

[6] In this regard, it should be noted that the February 1, 2005 *Official Gazette* Notice states in pertinent part:

"The location for the new Customer Service Window is on the first floor of the south side of the Randolph Building, with street level access from Ballenger Avenue. The specific **hand carry or delivery address** is:

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

If the appropriate mail stop is known, the mail stop should also be included in the address." (Emphasis added.)

[7] The purpose of mail stop designations is to facilitate handling of correspondence internally within the Office. See MPEP §501, penultimate paragraph.

Address label showing the "date in" on which the correspondence in question was delivered to the USPS.

In essence, petitioner is requesting that the Office accord the correspondence in question the same benefit as if it had been entrusted to the USPS under the Express Mail to Addressee Service provisions of 37 CFR 1.10. However, in order to obtain the benefits of 37 CFR 1.10, a party must comply with the provisions of 37 CFR 1.10, a circumstance that manifestly did not occur in this case. Petitioner has no basis, much less the right, to contend that his improperly addressed correspondence should be entitled, as the date of receipt at the Office, to the date the correspondence was entrusted to a commercial courier service. See MPEP 512.

In view of the above, the earliest date for the filing of the third party requester's reply to the patent owner's statement is June 14, 2005, the date alleged by Affiant Velke. 37 CFR 1.6(a) and 1.6(c). Since the statutory due date for the reply was June 11, 2005, the June 14, 2005 submission of the reply was not timely, and the underlying relief requested must be denied.

Additional discussion:

1. The third party requester's reliance upon the Notice published in the July 26, 2005 *Official Gazette* is not persuasive. Based on the content of this notice, requester appears to argue that because (1) Purolator is mentioned in the *Official Gazette* Notice and (2) the exception in the Notice for maintenance fee payments and Deposit Account replenishments does not include correspondence required to be filed in the Office within a set period of time, the filing of the requester's reply by using Purolator is not contrary to any rules or regulations of the Office and was acceptable. [8] However, the question here is not whether it was acceptable to use Purolator (or any delivery service or courier other than the USPS) to hand deliver correspondence to the Office. Pursuant to 37 CFR 1.6(c), correspondence may be delivered to the Office "by hand." It was acceptable to utilize Purolator as the courier for filing of requester's reply to patent owner's statement, as a filing (delivery) by hand. The question to be decided, however, is whether, in accordance with 37 CFR 1.8 or 37 CFR 1.10, (or any other exception to the general rule that correspondence is filed when received in the Office), requester is entitled to a filing date for the reply to patent owner's statement that is earlier than the actual delivery date of that reply to the Office. As has been pointed out, correspondence delivered to the Office by courier is hand carried, and it is not delivered by the USPS. Therefore, such correspondence is not entitled to the benefits of 37 CFR 1.8 or 37 CFR 1.10. Recognizing that a delivery service or other courier cannot deliver items to a postal address that includes a Post Office Box, the Office has provided a Customer Service Window to which papers may be carried by a delivery service or other courier. By employing a delivery service or courier other than the USPS, requester assumed the risk of any delay in delivery of the correspondence, and requester was bound by the actual date of delivery of the reply to the Office. Requester concedes that the earliest date that can be established for delivery of the reply to the Office is June 14, 2005, a date outside of the statutory two month period set to run from April 11, 2005. Therefore, third party requester must accept the results of that choice.

[8] Petition paper filed by facsimile transmission on April 28, 2006, page 2.

2. It is to be noted that the two month period for filing the reply is statutory, and thus, the failure to timely reply cannot be addressed by waiver of the rules. Even if a waiver were available, such would not be appropriate in this instance. Although requester could not have filed its reply to patent owner's statement utilizing the USPS because requester is based (located) outside of the United States, requester could have filed the reply by facsimile transmission as permitted by 37 CFR 1.6(d), and could have utilized the provisions of 37 CFR 1.8 when doing so. Accordingly, there is no basis for waiver of rules, even if such were available.

3. It is again pointed out that, if the content of the unentered papers of the third party requester reply to the patent owner's statement raises a substantial new question of patentability affecting any claim of the '481 patent, which is different than that raised in the instant reexamination proceeding, the third party requester is free to file a subsequent request for *ex parte* reexamination at this time.

CONCLUSION

1. The present petition is granted to the extent that the Office's April 12, 2006 decision has been has been thoroughly reconsidered in light of the papers filed on April 28, 2006 and May 2, 2006 requesting reconsideration of that decision, but the petition is denied with respect to granting the requested relief.

2. The third party requester has not established a date earlier than June 14, 2005 for the filing of requester's reply to the patent owner's statement that was served on the requester on April 11, 2006. Thus, the requester has failed to establish that the requester's reply to the patent owner's statement was timely filed.

3. The third party requester's reply to patent owner's statement will not be entered into the record, and will not be considered. The papers will be closed in the IFW and marked "not public."

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

5. Jurisdiction over the reexamination proceeding is being transferred to the CRU for preparation of an Office action in due course.

6. Any further communications as to the merits of the reexamination proceeding should be directed to examiner Matthew Graham, in the Central Reexamination Unit (CRU), at (571) 272-7116.

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

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

July 27, 2006
C:\kiva\kept-abe\WD\ 7359_WD_late-3PR-reply_recon_deny_Purolater Final Agency.doc

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.
90/007,359	01/03/2005	5845481		5638

28524 7590 02/27/2009

SIEMENS CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
170 WOOD AVENUE SOUTH
ISELIN, NJ 08830

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/27/2009

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

(For Patent Owner)

SIEMENS CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
170 WOOD AVENUE SOUTH
ISELIN, NJ 08830

MAILED

FEB 27 2009

CENTRAL REEXAMINATION UNIT

(For Requester)

Bill Velke
Tylon Prototype Inc.
P.O.Box 154
Campbellville, Ontado.
Canada, LOP 1B0

In re Briesch et al.	:	
Reexamination Proceeding	:	DECISION ON PETITION
Control No.: 90/007,359	:	UNDER 37 CFR 1.181
Filed: January 3, 2005	:	
For: U.S. Patent No.: 5,845,481	:	

This is a decision on a petition filed by the patent owner on January 12, 2009. The petition is entitled "PETITION UNDER 37 CFR § 1.181" [hereinafter "the petition"], and is a request to the Director to exercise his discretion pursuant to 37 CFR 1.181 and enter the amendment filed on January 12, 2009.

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

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated January 12, 2009 is denied with respect to entry of the amendment filed on January 12, 2009.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,845,481 (hereinafter, the '481 patent) issued on December 8, 1998.

2. A request for *ex parte* reexamination, assigned control No. 90/007,359 (hereinafter, the '359 proceeding), was filed by a third party requester on January 3, 2005.

3. *Ex parte* reexamination was ordered for the '359 proceeding on February 17, 2005.

4. The patent owner filed comments on April 13, 2005. The response included proposed amendments to claims 1, 2, 4, and 12 and added proposed new claims 18-32.

5. On August 13, 2007, a non-final Office action, which rejected claims 1-26 based upon anticipation by U.S. Patent No. 5,095,693 to Day or obviousness over Day alone or in view of secondary references, was mailed in the '359 reexamination proceeding.

6. On October 15, 2007, the patent owner filed a response and amendment of claims 1 and 21.

7. On May 7, 2008, the Office issued a Final rejection Office action, which addressed the patent owner's response of October 15, 2007. The Office action rejected claims 1-26 under 35 U.S.C. 305 as enlarging the scope of the claims of the patent being reexamined.

8. On July 7, 2008, Patent Owner filed a response and a proposed amendment to claims 1 and 21.

9. On August 10, 2008, the Office issued an action which withdrew the finality of the May 7, 2008 action and entered by July 7, 2008 amendment. The Office action rejected claims 1-26 under 35 U.S.C. 112, 1st paragraph, and set forth prior art rejections under 35 U.S.C. 102 and 103 based upon U.S. Patent No. 5,095,693 to Day.

10. On September 22, 2008, the patent owner filed a response and amendment to claims 1, 2, and 21.

11. On December 19, 2008, the Office mailed an advisory action which it is stated that the proposed amendment of September 22, 2008 will not be entered. The advisory states that the amendment to the claims is not compliant with Office rules and that entry of the amendment raised new issues that would require further consideration and is not deemed to place the proceeding in better form for appeal.

12. On January 12, 2009, the patent owner filed (1) a notice of appeal; (2) a proposed amendment to claims 1, 2, and 21; (3) remarks; and (4) the petition under 37 CFR 1.181 to invoke the supervisory authority of the Director and requesting that the amendment of January 12, 2009 be entered.

13. On January 22, 2009, the Office mailed advisory action which it is stated that the proposed amendment of January 12, 2009 will not be entered. The advisory states that entry of the amendment raised new issues that would require further consideration and is not deemed to place the proceeding in better form for appeal.

DECISION

The patent owner (petitioner) states that the examiner erred in deciding not to enter the proposed amendment of January 12, 2009 because the proposed amendment "corrects matters of form set forth in an Amendment that was filed on September 22, 2008."[1] See page 1 of the petition. The petitioner explains how the amendment of January 12, 2009 overcomes the rejection under 35 U.S.C. 112, 1st paragraph, issued in the Office action of August 10, 2008. See pages 1-3 of the petition. The petitioner also states that the addition of the term "automatically" to describe the controller does not introduce any new issues because the "... term 'automatically' is inherent in the definition of the term 'controller'." See page 3 of the petition.

In response to patent owner's arguments that the examiner erred in deciding not to enter the proposed amendment of January 12, 2009, the director finds there are not good and sufficient reasons to enter the proposed amendment. First, 35 U.S.C. 305 requires that all *ex parte* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing a final rejection and for consideration of after final responses. See MPEP 2272.

Turning to the facts in this proceeding, the Final rejection of August 10, 2008 sets forth essentially the same grounds of rejection based on prior art as set forth in the first Office action. This Final rejection was actually the third Office action in the case. The patent owner has had two opportunities to enter amendments to the claims. The patent owner had also filed a response and amendment on September 22, 2008 that was not entered because it was not compliant with Office rules; it introduced new issues; and was not deemed to place the proceedings in better form for appeal. In the petition, patent owner alleges that the examiner erred in deciding not to

[1] It is noted that the petition to enter the amendment of January 12, 2008 was filed concurrently with the amendment and prior to any decision by the examiner to enter or not enter the amendment. However, the examiner did decide to not enter the amendment prior to this decision, which is set forth in the advisory action of January 22, 2009.

enter the proposed amendment of January 12, 2009 because the proposed amendment would have corrected certain "matters of form."

In support of this allegation, the patent owner explains how the amendment of January 12, 2009 overcomes the rejection under 35 U.S.C. 112, 1st paragraph, issued in the Office action of August 10, 2008. See pages 1-3 of the petition. The petitioner also states that the addition of the term "automatically" to describe the controller does not introduce any new issues because the "... term 'automatically' is inherent in the definition of the term 'controller'." See page 3 of the petition. The petition does not address why the amendment deleting the phrase "prior to said fuel" was necessary and not presented earlier, and how this amendment does not enlarge the scope of the claims (e.g., creates issues pertaining to broadening).

Upon review of the entire record, the examiner appropriately applied Office policies and procedures in determining that the amendment of January 12, 2009 should not be entered because the deletion of the phrase "prior to said fuel" introduces new issues pertaining to enlarging the scope of the claims. For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures and did not abuse his discretion in deciding to not enter the amendment of January 12, 2009. The petition will not address the other issues as such is not required to decide this petition.

Accordingly, good and sufficient reasons to reopen prosecution in the reexamination proceeding have not been provided and the patent owner's petition is denied.

CONCLUSION

1. The petition under 37 CFR 1.181 for reconsideration of the entry of the amendment dated January 12, 2009 is denied.

2. Patent owner is advised that a petition under 37 CFR 1.182 requesting continuing reexamination may be filed. The petition should explain how the granting of continuing reexamination would further prosecution of the reexamination rather than delay it, such as a request for entry of a submission that provides a *bona fide* effort to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate. The petition should also explain why the patent owner did not become aware of the need for the new amendment or evidence earlier in the prosecution.

3. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361 or in his absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director, Central Reexamination Unit

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CENTRAL REEXAMINATION UNIT

Nixon & Vanderhye, PC 901 North Glebe Road, 11th Floor Arlington VA 22203	: : :	For Patent Owner
In re: Tokuya Kozaki *Ex Parte* Reexamination Proceeding Control No. 90/007,369 Filed: January 7, 2005 For: US Patent No. 6,586,762	: : : : :	DECISION DISMISSING PETITION FOR EXTENSION OF TIME [37 CFR 1.550(c)]

This is a decision on the June 27, 2006, Patent Owner "Request for Extension of Time in Accordance with 37 CFR 1.550" and June 28, 2006 Patent Owner "Supplemental Request for Extension of Time in Accordance with 37 CFR 1.550" requesting that the time for responding to the Office action dated April 28, 2006 be extended by one month.

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

The petition is dismissed as incomplete 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 April 28, 2006, which set a two month date for filing a response thereto. The Office action is a non-final Office action, and the request for extension is the first request for an extension of time with respect to the outstanding Office action. The present petition for extension of time was timely filed on June 27, 2006, together with authorization to debit a deposit account for the $200.00 petition fee required by 37 CFR 1.515(c), and was followed by a supplemental petition on June 28, 2006, which are treated together here.

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 reasons stated in the request will be evaluated by the TC Director, and the requests will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response within the statutory time period.

The present request is incomplete in that it fails to include a complete statement of "sufficient cause" as to why the requested extension is needed and warranted. The request does not include (a) a statement of what action the patent 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 one month is needed.

Patent Owner notes that 'extensive documents had to be transmitted to Japan and translations into Japanese had to be obtained before their analysis could even begin." This is however, not sufficient cause for an extension of time. Transmittal of documents to Japan is essentially instantaneous in today's electronic age. Further, Patent Owner is an international business and manages to maintain an extensive company web site in seven different languages. It is reasonable to expect the Patent Owner to anticipate that the reexamination of a US Patent will involve application of English language references and also reasonable to expect Patent Owner to have sufficient resources to translate such references in a timely manner.

Patent Owner further notes that the action "involved four separate rejections... and applied different combinations of six references" not all of which were known to Patent Owner, which must be "extensively review[ed]." It is unclear from the petition which references were not known to Patent Owner, and in any event, four rejections with six references does not represent such an unusually complicated Office action as would amount to sufficient cause for an extension of time.

Patent Owner lastly notes that several lawsuits have been filed or are being "contemplated." Again, it is reasonable to expect Patent Owner to have sufficient resources on hand to conduct its business and the presence or expectation of legal actions is not in and of itself a sufficient cause for an extension of time absent further explanation.

Moreover, the request fails to provide any factual information as to reasonably diligent behavior by all those responsible for preparing a response.

In order to complete the present petition for extension, the patent owner must renew the petition and provide the above-identified requisite information to enable the Director of the

Central Reexamination Unit to determine whether there is "sufficient cause" to grant the patent owner's request for an extension.

Conclusion

1. The patent owner's petition for extension of time filed on June 27, 2006 and June 28, 2006 is dismissed as incomplete.

2. The patent owner is invited to file a renewed petition for extension of time, without additional fee, addressing the matters raised above. The renewed petition would be directed to the following:

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

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

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

3. Telephone inquiries with regard to this decision should be directed to Gregory Mills, Quality Assurance Specialist in the Central Reexamination Unit, at (571) 272-1439.

Lissi Mojica Marquis,
Director
Central Reexamination Unit

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Deborah L. Lu, Esq.
Frommer Lawrence & Haug, LLP
745 Fifth Avenue
New York, NY 10151

(For Patent Owner)

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REEXAM UNIT

Dieterich, Douglas T.	:	
Reexamination Proceeding	:	**DECISION**
Control No. 90/007,370	:	**ON**
Filed: January 7, 2005	:	**PETITION**
For: U.S. Patent No. 6,833,351	:	

This is a decision on the January 30, 2006, patent owner SUPPLEMENTAL AMENDMENT AND RESPONSE TO OFFICE ACTION IN EX PARTE REEXAMINATION, (FURTHER) RECORD OF INTERVIEW, REQUEST FOR EXTENSION OF TIME PURSUANT TO 37 C.F.R. § 1.550(C), PETITION UNDER 37 C.F.R. § 1.17(G) OR 37 C.F.R. § 1.137(B) AND REQUEST FOR ANOTHER INTERVIEW, taken as a petition requesting:

1. Entry of a further record of interview as to matters discussed during a October 27, 2005 in-person interview and a January 30, 2006 telephonic interview;
2. A three-month extension of time pursuant to 37 CFR 1.550(c), if necessary, to extend the due date from November 22, 2005 to February 22, 2006; and
3. Acceptance of an unintentional delayed response, pursuant to 37 CFR 1.137(b).

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

The petition fee of $750.00 set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b) has been charged to petitioner's Deposit Account No. 50-0320, in accordance with petitioner's authorization on page four of the petition sent via facsimile on January 30, 2006.

The petition under 37 CFR 1.137(b) is <u>granted</u> as to requests (1) and (3), and is <u>dismissed</u> as to request (3).

DECISION

The instant petition under 37 CFR 1.137(b) is accompanied by the appropriate statement pursuant to 37 CFR 1.137(b)**(3)**. In addition, an amendment to the claims accompanied patent owner's January 30, 2006 petition. The amendment presents the claims in proper marked-up form and includes remarks providing support for the amended claims. The combination of the amendment and the remarks thereby provides the response "required to the outstanding Office action or notice" pursuant to 37 CFR 1.137(b)**(1)**. Further, the required petition fee is being charged to petitioner's deposit account as authorized on page four of the petition, thereby providing the "petition fee as set forth in 37 CFR 1.17(m)" pursuant to 37 CFR 1.137(b)**(2)**. Accordingly, the petition under 37 CFR 1.137(b) is granted.

Petitioner has also included a petition under 37 CFR 1.550(c) for a three month extension of time to accompany the petition to revive. A petition for an extension of time is not effective in a terminated prosecution. As the present reexamination proceeding was not pending at the time of filing of the petition for extension of time, the question of granting an extension of time is not ripe for consideration at this point. Therefore, the petition for extension of time is dismissed. It is noted, however, that the request for extension is moot in view of the present granting of the petition under 37 CFR 1.137(b).

CONCLUSION

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

2. The petition under 37 CFR 1.550(c) is **dismissed**.

3. Jurisdiction over the reexamination proceeding is being forwarded to Central Reexamination Unit for consideration, in due course, of the amendment, remarks, and (further) record of interview filed January 30, 2006, to accompany the petition.

4. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Bennett Celsa, in Art Unit 3991, who can be reached at (571) 272-0807.

5. Telephone inquiries related to this decision should be directed to Samuel Broda at (571)272-7711.

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

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6/1/06

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APR 25 2007

CENTRAL REEXAMINATION UNIT

Grace L. Pan, Esq.
Frommer, Lawrence & Haug LLP
745 Fifth Avenue
New York, NY 10151

(Patent Owner)

Patentee: Douglas T. Dietrich	:
Reexamination Control Number:	: DECISION REGARDING REQUEST
90/007,370	: TO STAY REEXAMINATION
Filed: January 7, 2005	: CERTIFICATE ISSUANCE
For: U.S. Patent No. 6,833,351	:

This is a decision on the patent owner's March 5, 2007 petition entitled "REQUEST FOR STAY OF REEXAMINATION CERTIFICATE ISSUANCE" for reexamination proceeding 90/007,370.

The petition is before the Office of Patent Legal Administration in the United States Patent and Trademark Office (the "Office") for a decision.

For the reasons set forth below, the petition to stay issuance of a reexamination certificate is taken as a petition under 37 C.F.R. 1.182, and is **dismissed.**

BACKGROUND

1. On January 7, 2005, patent owner submitted a request for *ex parte* reexamination of U.S. Patent No. 6,833,351 (the '351 patent), the resulting proceeding being assigned reexamination Control No. 90/007,370 (the '7370 proceeding).

2. Reexamination was ordered on March 15, 2005, for the '7370 proceeding.

3. A final Office action was mailed on May 11, 2006, for the '7370 proceeding.

4. The Patent Owner responded to the final Office action on July 10, 2006, after which the Office issued an advisory action on August 3, 2006.

5. A Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) was issued on December 28, 2006, canceling all the patent claims, based on the failure to respond to the final Office action. The NIRC reflects that a telephone interview was conducted on December 1, 2006, in which counsel stated that no response would be filed.

6. On March 5, 2007, the patent owner submitted the instant petition requesting a stay in the issuance of the reexamination certificate.

DECISION

The rules do not provide a mechanism for requesting a suspension of action in a reexamination proceeding. Accordingly, the present petition is taken as a petition under 37 CFR 1.182.

The fee set forth in 37 CFR 1.17(f) for a § 1.182 petition is $400, Accordingly, a debit of 400 USD will be charged to petitioner's deposit account no. 50-0320 as authorized by petitioner in the present petition.

In this instance, the prosecution terminated for failure to respond to the final Office action. The NIRC was not issued until after a telephone interview to counsel confirmed that no response would be filed. The '7370 proceeding is no longer pending, because a proper response was not timely submitted after the final rejection of May 11, 2006. Relief to suspend action in a proceeding cannot be granted in a proceeding, which is no longer pending. Accordingly, the petition requesting a stay of the issuance of a reexamination certificate must be dismissed.

CONCLUSION

1. The petition requesting a stay of the issuance of a reexamination certificate is **DISMISSED.**

2. Jurisdiction over the present reexamination proceeding is returned to the Central Reexamination Unit for forwarding the proceeding in the process of publishing a reexamination certificate for the '7370 proceeding.

3. 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

April 24, 2007
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,371 90/007,007	01/08/2005	5579517	04-10091	4955

41505 7590 03/22/2005

WOODCOCK WASHBURN LLP
ONE LIBERTY PLACE - 46TH FLOOR
PHILADELPHIA, PA 19103

EXAMINER
RONES, Charles

ART UNIT	PAPER NUMBER
2164	

DATE MAILED: 03/22/2005

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

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Steven B. Samuels Woodcock Washburn, LLP One Liberty Place - 46th Floor 1650 Market Street Philadelphia, Pennsylvania 19103	)	**FOR OWNER**
Public Patent Foundation 1375 Broadway Suite 600 New York, New York 10018	)	**FOR FIRST THIRD PARTY REQUESTER**
David L. Hoffman 27023 McBean Parkway Suite 422 Valencia, California 91355	)	**FOR SECOND THIRD PARTY REQUESTER**
In re Reynolds et al. Reexamination Proceeding Control No. 90/007,007 Filed: April 19, 2004 For: U.S. Patent No. 5,579,517	)	**DECISION *SUA SPONTE*, MERGING REEXAMINATION PROCEEDINGS**
In re Reynolds et al. Reexamination Proceeding Control No. 90/007,371 Filed: January 8, 2005 For: U.S. Patent No. 5,579,517	)	

The above noted reexamination proceedings are before the Director of Technology Center 2100 for consideration of merger of the proceedings under 37 CFR § 1.565(c).

BACKGROUND

1. Patent No. 5,579,517 issued on November 26, 1996.

'7007 Proceeding

2. A first request for reexamination, Control No. 90/007,007 ('7007) was filed by the Third Party Requester on April 19, 2004.

3. Reexamination was ordered in the '7007 reexamination proceeding on June 4, 2004

4. A revocation and appointment of attorneys was filed on August 11, 2004.

5. A first Office action was mailed on September 16, 2004.

6. An Information Disclosure Statement was filed on October 27, 2004.

7. An Interview was held on November 3, 2004 and an Interview Summary was mailed on that date recording the substance of that interview.

8. Applicant files a Response to the Office action on November 12, 2004. The response includes an Amendment, Remarks, Patent Owner's Statement of substance of the Interview (of Nov. 3) and the Declaration of Ralph Lipe.

9. A Supplemental Information Disclosure Statement was filed on December 7, 2004.

10. A Declaration of Annie Pearson in support of the contemporaneously filed IDS was filed on December 7, 2004.

11. A Second Supplemental Information Disclosure Statement was filed on January 19, 2005.

'7371 Proceeding

12. A second request for reexamination, Control No. 90/007,317 ('7317) was filed by another Third Party Requester on January 8, 2005.

13. Reexamination was ordered in the '7371 reexamination proceeding on March 11, 2005.

14. A Letter informing the Office that Patent Owner will not be filing a Statement under 37 CFR 1.530 was filed on March 18, 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.

Since the files do not currently maintain the same claims and specification, a "housekeeping" amendment is required. Applicant is required to file a proper housekeeping amendment, to make the claims the same in each file, within **ONE MONTH** of the mail date of this decision.

III. Conduct of Merged Proceeding

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

Pinchus M. Laufer

Pinchus M. Laufer
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security
(571) 272-3599

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(For Patent Owner)

MAILED
APR 0 5 2006
REEXAM UNIT

Mark G. Lappin
Greenberg Traurig, LLP
One International Place
Boston, MA 02110

In re VISICU, INC.	:
Ex Parte Reexamination Proceeding	: **DECISION**
Control No.: 90/007,377	: **DISMISSING**
Filed: January 19, 2005	: **PETITION**
For: U.S. Patent No.: 6,804,656 B1	:

This is a decision on the March 17, 2006 patent owner petition entitled PETITION UNDER 37 CFR 1.182 TO CORRECT CERTAIN INADVERTENT ERRORS IN CLAIMS ALLOWED PURSUANT TO A NOTICE OF INTENTION TO ISSUE EX PARTE REEXAMINATION CERTIFICATE ISSUED MARCH 8, 2006. The petition is filed pursuant to 37 CFR 1.182. The petition fee of $ 400.00 (37 CFR 1.17(f)) will be charged to Deposit Account No. 18-1579 as authorized in the patent owner petition.

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

The petition is dismissed for the reasons set forth below.

REVIEW OF FACTS

1. Patent number 6,804,656 issued October 12, 2004 with 26 claims.
2. A request for reexamination, assigned control No. 90/007,377 (the '377 reexamination proceeding), was filed on January 19, 2005.
3. The proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed on March 8, 2006.
4. The present petition was filed on March 17, 2006.
5. The reexamination proceeding is currently being reviewed in preparation for forwarding to the Office of Patent Publication for printing of a reexamination certificate.

DECISION DISMISSING THE PETITION TO ENTER CLAIM AMENDMENTS

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

> " ... 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."

35 U.S.C. § 307(a) states:

> "In a reexamination proceeding under this chapter, when the time for appeal has expired or any appeal proceeding has terminated, the Director will issue and publish a certificate canceling any claim of the patent finally determined to be unpatentable, confirming any claim of the patent determined to be patentable, and incorporating in the patent any proposed amended or new claim determined to be patentable.

37 CFR 1.530(e) states:

> "Whenever there is an amendment to the claims pursuant to paragraph (d) of this section, there must also be supplied, on pages separate from the pages containing the changes, the status (*i.e.*, pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes to the claims made by the amendment paper.

37 CFR 1.570(a) states:

> "(a) Upon the conclusion of ex parte reexamination proceedings, the Director will issue an *ex parte* reexamination certificate in accordance with 35 U.S.C. 307 setting forth the results of the *ex parte* reexamination proceeding and the content of the patent following the *ex parte* reexamination proceeding."

MPEP § 2287 states in pertinent part:

> "Upon conclusion of the ex parte reexamination proceeding, the examiner must prepare a "Notice of Intent to Issue Ex Parte Reexamination Certificate" (NIRC) by completing form PTOL-469. If appropriate, an examiner's amendment will also be prepared. Where claims are found patentable, reasons must be given for each claim found patentable. See the discussion as to preparation of an examiner's amendment and reasons for allowance at the end of this section. In addition, the examiner must prepare the reexamination file so that the Office of Publications can prepare and issue a certificate in accordance with 35 U.S.C. 307 and 37 CFR 1.570 setting forth the results of the reexamination proceeding and the content of the patent following the proceeding. See MPEP § 2288."
>
> "If it is the intent of the examiner to find any claim(s) patentable (confirmed or allowed) in concluding the reexamination proceeding, the examiner will so inform his/her supervisory patent examiner (SPE). The SPE will convene a patentability review conference (see MPEP § 2271.01), and the conference members will review the patentability of the claim(s). If the conference confirms the patentability of the claim(s), a NIRC shall be issued and signed by the examiner, with the two other conferees initialing the NIRC (as "conferee") to indicate their participation in the conference. Both conferees will initial, even though one of them may have dissented from the 3-party conference decision on the patentability of the claim(s). If the conference does not confirm the patentability of the claim(s), a NIRC will not be issued by the examiner; rather, the examiner will issue an appropriate Office action rejecting the claim(s), not confirmed as patentable." ...
>
> "Thus, a patentability review conference must be held in each instance where a NIRC is about to be issued, unless the NIRC is being issued: (A) following and consistent with a decision by the Board of Patent Appeals and Interferences (or court) on the merits of the proceeding; or (B) as a consequence of the patent owner's failure to respond or take other action where such a response or action is necessary to maintain pendency of the proceeding and, as a result of which failure to respond, all of the claims will be canceled."
>
> "A NIRC informs the patent owner and any third party requester that the reexamination *>prosecution< 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."

A review of the record shows that patent owner filed two amendments during the reexamination proceeding that were entered. The record further shows that the examiner conducted a patentability review conference as required. Thereafter, the examiner terminated prosecution on the merits and issued an NIRC on March 8, 2006. The file was forwarded, pursuant to MPEP § 2289, to the Office of Patent Legal Administration for screening in preparation to forwarding the file to the Office of Patent Publication for issuance of the reexamination certificate. The file is in the final phase of that review.

The instant petition was filed very late in the examination of the reexamination. The petition is accompanied by an amendment that proposes to amend thirteen (13) of the twenty-six (26) claims that were indicated as being patentable in the March 8, 2006 NIRC. The purpose of the amendment is not to continue prosecution, as would be the case if the regulations provided for filing a Request for Continued Reexamination. [1] Rather, the purpose of the amendment is more akin to the filing of an amendment after allowance pursuant to 37 CFR 1.312 in a patent application. While many of the proposed amendments can be characterized as being directed to formalities, certain of the proposed amendments appear to be directed to the addition of substantive claim limitations. Also, a cursory review of the amendment shows that there is at least one instance in which a limitation not appearing in original patent claim 1 appears in claim 1(twice amended) without being underlined as required by 37 CFR 1.530(d). [2] It also appears that there is a failure to comply with 37 CFR 1.530(e). [3] The proposed amendment does not explain the delay in providing a statement as to why the proposed claim amendments are necessary and were not earlier presented, or any explanation for the late filing of these claim amendments after the claims were twice amended, presumably after careful inspection and consideration. To the contrary, patent owner merely states, "petitioner reviewed the allowed claims and identified a number of inadvertent errors in claims 1-5, 8, 11, 14, 15, 17, 18 and 20."

It is to be noted that in a reexamination proceeding, there is a **statutory** mandate that the proceeding be conducted with **special dispatch**. There is also a need for certainty and finality. The following considerations all point to the fact that, if the requested amendment were to be entered, (a) issuance of the reexamination certificate will be unduly delayed, and (b) the expenditure of further Office resources would be needed to redo work already undertaken before the reexamination proceeding could be forwarded for publication of the reexamination certificate:

1) The claim amendments were submitted after prosecution had been concluded by issuance of a NIRC.

2) A cursory inspection of the claims reveals that there is at least one informality in the format of the amendment information submitted after termination of the prosecution in this reexamination proceeding, so that entry of the amendment will require communication with patent owner followed by submission of yet another amendment paper.

---

[1] See 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 OG 20 (March 1, 2005)

[2] See "continuously" in line 16 of claim 1.

[3] There is no discussion of the support for the claim changes. It should be noted that even changing the word "the" to "an" as in claim 1 may amount to a change in claim scope, and 37 CFR 1.530(e) requires that patent owner point out support for the amendatory language.

3) The proposed amendment to the claims appears to introduce changes that must be reviewed to determine whether they raise issues regarding the patentability of some of the claims.

4) The proposed amendment does not comply with 37 CFR 1.530(e).

4) If the claim amendment were entered another patentability review conference will have to be conducted to address the claims as amended.

5) Screening in the Office of Patent Legal Administration will have to be conducted again.

Therefore, it is considered that patent owner has not demonstrated any sound reason for reopening the reexamination proceeding. Further, if patent owner in fact believes that the claims are defective, patent owner may obtain relief by means other than the reopening this proceeding. Patent owner may file a reissue application to cure any claim defects that are regarded by patent owner as being substantive errors, and to address formal errors at the same time. If patent owner is concerned only with errors of form, then a certificate of correction can be requested.

CONCLUSION

1. The petition under 37 CFR 1.182 requesting entry of an amendment filed after NIRC (filed concurrently with the petition) 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
April 4, 2006

C:\kiva\kenpet6\7377_1.182 (312_not RCR) amend claims dismiss.doc
April 5, 2006

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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

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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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/007,378*.

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.
90/006,905	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

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

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/006,905*.

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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Miles & Stockbridge, P.C.
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McLean, Virginia 22102

(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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(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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Paper No. __

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(For Requester)

MAILED

AUG 1 8 2005

REEXAM UNIT

Daniel J. Polglaze
LEFFERT JAY & POLGLAZE
P.O. Box 581009
Minneapolis, MN 55458-1009

(For Requester)

In re Michael E. Woolford et al.
Reexamination Proceeding
Control No.: 90/007,280
Filed: November 2, 2004
For: U.S. Patent No.: 6,142,713

In re Michael E. Woolford et al.
Reexamination Proceeding
Control No.: 90/007,384
Filed: January 21, 2005
For: U.S. Patent No.: 6,142,713

: DECISION TO
: *SUA SPONTE* MERGE
: *EX PARTE* REEXAMINATION
: PROCEEDINGS
: AND
: DISMISS PETITION TO
: VACATE REEXAMINATION
: ORDER AND TERMINATE
: REEXAMINATION

This is a decision on the March 16, 2005 and May 17, 2005 patent owner petitions under 37 CFR 1.181(a)(3), to vacate the orders granting the two captioned reexamination proceedings. Oppositions to the two patent owner petitions were received March 24, 2005 and June 3, 2005, respectively.

This is also a decision to *sua sponte* merge the *ex parte* re-examination proceedings.

The two proceedings, the two petitions, and the two oppositions are before the Office of Patent Legal Administration.

SUMMARY

For the reasons set forth below, the two petitions are dismissed. The January 31, 2005 order granting reexamination in the 90/007,282 proceeding and the April 4, 2005 order granting reexamination in the 90/007,384 proceeding remain intact.

Pursuant to 37 CFR 1.565(c), reexamination Control Nos. 90/007,282 and 90/007,384 are *sua sponte* merged into a single proceeding.

A single decision is being issued to address the above matters.

REVIEW OF FACTS

1. U.S. Patent No. 6,142,713 (the '713 patent) issued on February 6, 2001.
2. A first request for reexamination of the '713 patent was filed by a third party requester on November 2, 2004. The first request was assigned control No. 90/007,282 (the '7282 proceeding).
3. A second request for reexamination of the '713 patent was filed by a third party requester on January 21, 2005. The second request was assigned control No. 90/007,384 (the '7384 proceeding).
4. Reexamination was ordered for the '7282 proceeding on January 31, 2005.
5. A petition under 37 CFR 1.181(a)(3) to vacate the '7282 reexamination order was received from the patent owner on March 16, 2005.
6. An opposition to the March 16, 2005 patent owner petition to vacate was received from the '7282 requester on March 24, 2005.
7. Reexamination was ordered for the '7384 proceeding on April 4, 2005.
8. A petition under 37 CFR 1.181(a)(3) to vacate the '7384 reexamination order was received from the patent owner on May 17, 2005.
9. An opposition to the May 17, 2005 patent owner petition to vacate was received from the '7384 requester on June 3, 2005.
10. A patent owner's statement under 37 CFR 1.530 has not been received in the '7282 and '7384 reexamination proceedings.

DECISION ON PETITIONS

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."

MPEP 2246, Part I, states, in part:

"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 no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained. "Appropriate circumstances" under 37 CFR 1.181(a)(3) exist to vacate the order granting reexamination where, for example:

...

"(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).

"As to (E) above, the decision of *In re Recreative Technologies Corp.*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996) is to be noted."

MPEP 2242, Part II.A., states, in part:

"A "substantial new question of patentability" is not raised by prior art presented in a reexamination request if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

"In deciding whether to grant a request for reexamination of a patent, the examiner should check the patent's file history to ascertain whether any of the prior art now advanced by requester was previously cited/considered in an earlier concluded Office examination of the patent (e.g., in the examination of the application for the patent)."

In this instance, the patent owner petitioner urges that the Office has previously considered (in an earlier concluded examination of the patent) the question of patentability of the '713 patent claims on which the two orders for reexamination were based, and that the previous consideration was favorable to the patent owner. Accordingly, the patent owner petitions that the '7282 and '7384 orders for reexamination of the '713 patent be vacated as *ultra vires* actions taken by the Office.

Review of the requests for reexamination

The '7282 Request for Reexamination, filed November 3, 2004, urges that Keystone Retaining Walls (Beautiful Do-It Yourself Retaining Walls! (1989)) raises a substantial new question of patentability (SNQ) with respect to claims 1-75 of the '713 patent. Specifically, the Request urges that the Keystone reference anticipates the claims and has a publication date earlier than the '713 filing date.

The '7384 Request for Reexamination, filed January 21, 2005, urges that Keystone Retaining Walls (Beautiful Do-It Yourself Retaining Walls! (1989)), Keystone Retaining Walls (Introducing the Keystone Retaining Wall System (1989)) and Johnson Block (Johnson Block Retaining Wall Systems(1989)) raise substantial new questions of patentability with respect to claims 1-75 of the '713 patent. Specifically, the Request urges that the two Keystone references each individually anticipates the claims, or renders the claims obvious in view of Johnson Block, and have publication dates earlier than the '713 filing date.

Both requests allege that the dates of the Keystone references are no later than March 1989 for one, and May 1989 for the other, the dates being established by trademark registration documents and by affidavits of Keystone sales representatives.

Review of the Patent Owner's Argument for Vacatur

Both petitions admit that the Keystone references would anticipate the indicated claims if the references were prior art. The petitions argue that the references are undated and have never had a date of publication established. The petitioner alleges that the source of the references pays substantial royalties to license the patented subject matter (of the '713 patent) and this is submitted to be evidence that the source of the references does not believe it could antedate the patent.

Further, both petitions state that "both documents are of record *and were considered* during the prosecution of Serial No. 09/497,250 ("the '250 application"), which subsequently issued as the '713 patent." The evidence proffered for this assertion is the paper entitled "Comments On Statement Of Reasons For Allowance" entered in the '250 application on March 20, 2000.

The petitions also argue, as to the impropriety of other references in the request on the grounds, that those references were listed on information disclosure statements initialed by the examiner and that all those references are secondary references for obviousness patentability issues.

Review of the order for reexamination

In the orders granting the reexamination request, the examiner stated that each of the

Keystone references are newly cited in the reexamination request and that the remaining references were cited but never applied in the '713 prosecution. As to the Keystone references, the assertion that they are newly cited is in error, given that those same references are included in the file history of the '713 patent.

Evaluation as to any prior consideration of the references:

A review of the record reveals that all of the references which the orders for reexamination cite as raising substantial new questions of patentability were cited in the '713 prosecution; however, none of them were applied, nor were they commented upon by the examiner. The petition urges that the fact that the examiner initialed the citations in the '713 prosecution evidences the examiner's consideration such that those references cannot be the basis for a new question of patentability. This is an incorrect reading of the law. 35 U.S.C. 303(a) states, in part, "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."

The petition further urges that the precise question, raised and addressed in the orders, of whether the references were prior art was considered by the examiner. Petitioner cites as evidence of this - the paper titled "Comments On Statement Of Reasons For Allowance" filed on March 20, 2000, in the '916 file, in which the applicant stated "[t]he Keystone brochure referred to in the 'Reasons for Allowance' is not the brochure which bears the copyright office date stamp of 'June 27, 1988', which is referred to in the earlier Office Action, but is the undated brochure which was attached to the 'Statutory Declaration of All Pfannestein dated August 28, 1998' filed with the Australian litigation between Keystone and Anchor Wall Systems' and "[t]he issue of the undated brochure and various related allegations of its purported author (Keystone) have previously been discussed with the Examiner in the prosecution of the parent case."

Although the Comments On Statement of Reasons For Allowance further states that '[t]hese remarks are being submitted with the consent of and at the request of Examiner Taylor," the record provides no corroborating evidence that the examiner reviewed the comments or agreed with them, much less requested them. These applicant comments are deemed to be self serving, and they were delayed until after the close of prosecution, with no further comment by the examiner. Accordingly, the comments are not deemed to be persuasive that the precise question of whether the issue of the date of the references purportedly presenting a substantial new question of patentability was ever evaluated in view of the documents suggesting a date of March 1989.

As to the issue of any oral statement the examiner might have made, and any weight to be accorded same, oral statements are open to misinterpretation. Thus, 37 CFR 1.2 clearly states:

> "All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and

> Trademark Office is unnecessary....No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt."

As to the examiner's not having commented on applicant's March 20, 2000 "Comments On Statement Of Reasons For Allowance," 37 C.F.R. 104(e) states that :

> "Failure by the examiner to respond to any statement commenting on reasons for allowance does not give rise to any implication."

As to whether the issue of the date of publication may present a substantial new question of patentability, this is readily answered by the opinion in *Heinl v Godici*, (E.D.Va. 2001), 143 F. Supp. 2d 593, which found that art cited in the original patent proceedings, but for which no findings as to their status as prior art were made in the original proceedings, could raise a substantial new question of patentability in light of evidence as to their status as prior art.

It is further to be noted that the *Heinl* opinion further states that "Courts are uniform in recognizing that the decision to grant reexaminations of a patent is preliminary, not final agency action." *Heinl*, 143 F. Supp. 2d at 597. Both the fact that the issue as to the status of the cited references as prior art has never been determined in the prior proceedings, and the fact that an order granting reexamination is not a final agency action, weigh in favor of allowing the reexamination proceedings to continue.

Finding:

In *Heinl*, 143 F.Supp.2d at 601, the Court stated, in a decision seeking termination of reexamination based on the absence of a new question of patentability:

> "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" it the Office determination that the questions of patentability raised in the January 21, 2005 and April 4, 2005 requests were not previously considered in an earlier concluded examination of the patent. The petition is thus dismissed, and the two reexamination proceedings will continue.

DISCUSSION REGARDING MERGER

Under 37 CFR 1.565(c):

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

As evidenced by the above review of facts, reexamination control No. 90/007,282 and reexamination control No. 90/007,384 are currently pending. Since the order to reexamine has been mailed in both reexamination proceedings, a decision under 37 CFR 1.565(c) is timely.

DECISION MERGING REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-noted 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

The patent owner is required to maintain identical amendments in the two 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(c).

A review of the reexamination file for the proceedings of reexamination control No. 90/007,282 and 90/007,384 shows that, in both proceedings, original patent claims 1-75 are present and no claims are added or altered by amendment. Accordingly, the claims are identical in number and are identical as to content in both proceedings.

III. Conduct of the Merged Proceeding

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

2. Any response by the 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 two requesters, who will also be sent copies of Office actions.

3. Where a paper is filed which requires payment of a fee (e.g., petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appellant brief, 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.

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

CONCLUSION

1. The petition under 37 CFR 1.181 is dismissed.

2. The '7282 and '7384 reexamination proceedings are merged into a single proceeding.

3. The reexamination file is being forwarded to the Technology Center for the issuance of a first Office action in due course.

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

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

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In re Michael E. Woolford et al.
Reexamination Proceeding
Control No.: 90/007,282
Filed: November 2, 2004
For: U.S. Patent No.: 6,142,713

In re Michael E. Woolford et al.
Reexamination Proceeding
Control No.: 90/007,384
Filed: January 21, 2005
For: U.S. Patent No.: 6,142,713

: DECISION DENYING
: PETITION TO VACATE
: REEXAMINATION ORDERS
: AND TERMINATE
: REEXAMINATIONS

This is a decision on the October 18, 2005 patent owner petition under 37 CFR 1.181, seeking supervisory review and final agency decision on the August 18, 2005 decision dismissing the petition to vacate the orders granting the two above-captioned reexamination proceedings. A requester opposition to the patent owner petition was received November 1, 2005.

The merged proceeding of reexamination Control Numbers 90/007,282 and 90/007,384, the present petition, and the present opposition are before the Office of Patent Legal Administration.

For the reasons set forth below, the petition under 37 CFR 1.181(a)(3) is denied as to the request to vacate the orders for the 90/007,278 and 90/007,386 proceedings. In addition, the petition is granted to the extent that (a) the prior decision has been fully reconsidered and (b) the instant decision is designated as a final agency decision.

The January 31, 2005 order granting reexamination in the 90/007,282 proceeding and the April 4, 2005 order granting reexamination in the 90/007,384 proceeding remain intact. Given the August 18, 2005 merger of the two proceedings, a single decision is being issued for the two proceedings.

REVIEW OF FACTS

1. U.S. Patent No. 6,142,713 (the '713 patent) issued on February 6, 2001.
2. A first request for reexamination of the '713 patent was filed by a third party requester on November 2, 2004. The first request was assigned control No. 90/007,282 (the '7282 proceeding).
3. A second request for reexamination of the '713 patent was filed by a third party requester on January 21, 2005. The second request was assigned control No. 90/007,384 (the '7384 proceeding).
4. Reexamination was ordered for the '7282 proceeding on January 31, 2005.
5. A petition under 37 CFR 1.181(a)(3) to vacate the '7282 reexamination order was received from the patent owner on March 16, 2005.
6. An opposition to the March 16, 2005 patent owner petition to vacate was received from the '7282 requester on March 24, 2005.
7. Reexamination was ordered for the '7384 proceeding on April 4, 2005.
8. A petition under 37 CFR 1.181(a)(3) to vacate the '7384 reexamination order was received from the patent owner on May 17, 2005.
9. An opposition to the May 17, 2005 patent owner petition to vacate was received from the '7384 requester on June 3, 2005.
10. On August 18, 2005, the Office mailed a decision (a) dismissing the two petitions to vacate the orders, and (b) to merge the two reexamination proceedings.
11. The present petition under 37 CFR 1.181 seeking supervisory review and final agency decision concerning the petition by patent owner to vacate order granting reexamination was received in the present merged proceeding on October 18, 2005.
12. An opposition to the October 18, 2005 petition was received from the '7282 third party requester on November 1, 2005.
13. A patent owner's statement under 37 CFR 1.530 has <u>not</u> been received in the '7282 and '7384 reexamination proceedings.

DECISION ON PETITION

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."

MPEP 2246, Part I, states, in part:

> "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 no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained. "Appropriate circumstances" under 37 CFR 1.181(a)(3) exist to vacate the order granting reexamination where, for example:
>
> ...
>
> "(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).
>
> "As to (E) above, the decision of *In re Recreative Technologies Corp.*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996) is to be noted."

MPEP 2242, Part II.A., states, in part:

> "A 'substantial new question of patentability' is not raised by prior art presented in a reexamination request if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).
>
> "In deciding whether to grant a request for reexamination of a patent, the examiner should check the patent's file history to ascertain whether any of the prior art now advanced by requester was previously cited/considered in an earlier concluded Office examination of the patent (e.g., in the examination of the application for the patent)."

In this instance, the patent owner petitioner urges that the Office has previously considered (in an earlier concluded examination of the patent) the questions of patentability of the '713 patent claims on which the two orders for reexamination are based, and that the previous consideration was favorable to the patent owner. Accordingly, the patent owner petitions that the '7282 and '7384 orders for reexamination of the '713 patent be vacated as *ultra vires* actions taken by the Office.

Review of the requests for reexamination

The '7282 Request for Reexamination, filed November 3, 2004, urges that Keystone Retaining Walls (Beautiful Do-It Yourself Retaining Walls! (1989)) raises a substantial new question of patentability (SNQ) with respect to claims 1-75 of the '713 patent. Specifically, the Request urges that the Keystone reference anticipates the claims and has a publication date earlier than the '713 filing date.

The '7384 Request for Reexamination, filed January 21, 2005, urges that Keystone Retaining Walls (Beautiful Do-It Yourself Retaining Walls! (1989)), Keystone Retaining Walls (Introducing the Keystone Retaining Wall System (1989)) and Johnson Block (Johnson Block Retaining Wall Systems(1989)) raise substantial new questions of patentability with respect to claims 1-75 of the '713 patent. Specifically, the Request urges that the two Keystone references each individually anticipates the claims, or renders the claims obvious in view of Johnson Block, and have publication dates earlier than the '713 filing date.

Both requests allege that the dates of the Keystone references are no later than March 1989 for one, and May 1989 for the other, the dates being established by trademark registration documents and by affidavits of Keystone sales representatives.

Review of the Patent Owner's Argument for Vacatur

The petition admits that the Keystone references would anticipate the indicated claims if the references were prior art. The petition argues that the references are undated and have never had a date of publication established. The petitioner alleges that the source of the references pays substantial royalties to license the patented subject matter (of the '713 patent), and this is submitted to be evidence that the source of the references does not believe it could antedate the patent.

Further, the petition state that "both documents are of record *and were considered* during the prosecution of Serial No. 09/497,250 ('the '250 application'), which subsequently issued as the '713 patent." The evidence proffered for this assertion is the paper entitled "Comments On Statement Of Reasons For Allowance" entered in the '250 application on March 20, 2000.

The petition also argues, as to the impropriety of other references in the request, on the grounds that those references were listed on information disclosure statements initialed by the examiner, and that all those references are secondary references for obviousness patentability issues.

Review of the orders for reexamination

In the orders granting the reexamination request, the examiner stated that each of the Keystone references was cited but never applied in the '713 prosecution. This appears to be correct based on a review of the '713 file.

Evaluation as to any prior consideration of the references:

A review of the record reveals that all of the references which the orders for reexamination cite as raising substantial new questions of patentability were cited in the '713 prosecution; however, none of them were applied, nor were they commented upon by the examiner. The petition urges that the fact that the examiner initialed the citations in the '713 prosecution evidences the examiner's consideration - such that those references cannot be the basis for a new question of patentability. This is an incorrect reading of the law. 35 U.S.C. 303(a) states, in part, "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."

The petition further urges that the examiner previously considered the precise question raised and addressed in the orders - of whether the Keystone references were prior art. Petitioner cites as evidence of this - the paper titled "Comments On Statement Of Reasons For Allowance" filed on March 20, 2000, in the '916 file, in which the applicant stated "[t]he Keystone brochure referred to in the 'Reasons for Allowance' is not the brochure which bears the copyright office date stamp of 'June 27, 1988', which is referred to in the earlier Office Action, but is the undated brochure which was attached to the 'Statutory Declaration of All Pfannestein dated August 28, 1998' filed with the Australian litigation between Keystone and Anchor Wall Systems" and "[t]he issue of the undated brochure and various related allegations of its purported author (Keystone) have previously been discussed with the Examiner in the prosecution of the parent case."

Although the Comments On Statement of Reasons For Allowance further states that '[t]hese remarks are being submitted with the consent of and at the request of Examiner Taylor," the record provides no corroborating evidence that the examiner reviewed the comments or agreed with them, much less requested them. These applicant comments are deemed to be self serving, and they were delayed until after the close of prosecution, with no further comment by the examiner. Accordingly, the comments are not deemed to be persuasive that the precise question of the date of the references purportedly presenting a substantial new question of patentability was ever evaluated in view of the documents suggesting a date of March 1989.

As to the issue of any oral statement the examiner might have made, and any weight to be accorded same, oral statements are open to misinterpretation. Accordingly, 37 CFR 1.2 clearly states:

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

As to the examiner's not having commented on applicant's March 20, 2000 "Comments On Statement Of Reasons For Allowance," 37 C.F.R. 104(e) states that:

> "Failure by the examiner to respond to any statement commenting on reasons for allowance does not give rise to any implication."

As to whether the issue of the date of publication may present a substantial new question of patentability, this is readily answered by the opinion in *Heinl v Godici*, (E.D.Va. 2001), 143 F. Supp. 2d 593, which found that art cited in the original patent proceedings, but for which no findings as to their status as prior art were made in the original proceedings, could raise a substantial new question of patentability in light of evidence as to their status as prior art.

It is also to be noted that the *Heinl* opinion further states that "Courts are uniform in recognizing that the decision to grant reexaminations of a patent is preliminary, not final agency action." *Heinl*, 143 F. Supp. 2d at 597. Both the fact that the issue as to the status of the cited references as prior art has never been determined in the prior proceedings, and the fact that an order granting reexamination is not a final agency action, weigh in favor of allowing the reexamination proceedings to continue.

Evaluation of the petitioner's arguments regarding the prior petition decision:

The petitioner argues that the prior decision was premised on two erroneous assumptions, i.e., (1) that the documents under consideration were not adequately considered during the course of prosecution, and (2) that the evidence relied on in finding a significant new question of patentability is being presented in a new light, as compared with the original prosecution. The petitioner argues that both of these premises are incorrect.

Petitioner's argument omits the essential aspect in these proceedings, which is that the evidence now before the Office (that was not so in the original, i.e., application, proceeding) is evidence as to the date the documents were disseminated and made accessible to the public. It is this evidence that casts the documents that are applied against the '713 patent in a new light, i.e. as being prior art rather than indeterminate art. Although the petitioner makes reference to the House Report 107-120[1] indication that the most recent revision to 35 U.S.C. 303 permits reexamination only where there is substantial evidence that the examiner did not properly understand the reference or did not consider a portion of the reference in making his decision, such is not at odds with the evidence before the examiner in this merged reexamination proceeding. Where the examiner in the original prosecution could not determine the date of a reference, and therefore could not sustain a rejection based on that reference because of the absence of a "good" date, evidence subsequently provided in the instant reexamination proceedings as to the date that antedates the date of invention can

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[1] http://thomas.loc.gov/cgi-bin/cpquery/?&dbname=cp107&sid=cp107VYubX&refer=&r_n=hr120.107&item=&sel=TOC_2687&

change the consideration of that reference from consideration of an indeterminate document to consideration of a prior art document.

As alluded to above, this set of facts is directly analogous to those in *Heinl*, 143 F.Supp.2d at 602, in which the Court stated, in a decision seeking termination of reexamination based on the absence of a new question of patentability:

> "There, plaintiff did not argue that the examiner should make a finding that the catalogs were not prior art, but rather, he argued that the evidence did not permit the examiner to make any finding regarding their status as prior art. ... Accordingly, the catalogs are not prior art that was previously relied upon to reject a claim, and therefore, their submission in the '275 Reexamination does not bar their submission and consideration in the subsequent '809 Reexamination."

In one of the parent cases to the '713 patent (to which this merged reexamination is directed), the examiner set forth that he could not determine the date of a document which was not clearly identified by the examiner. The record suggests that such unidentified document is a document different from that asserted by the petitioner, but has a similar shorthand name used for identification. Regardless as to which document the examiner referred, the examiner did not have sufficient evidence to make, and the record shows no evidence that the examiner did make, a finding as to the specific date of the document then at issue. The examiner did not even make a finding that the document was definitively not prior art.

The requester also makes reference to a petition decision in a related reexamination request by a Technology Center Director. Because this is a separate proceeding with different claims and facts, the decision in a petition in any such related proceeding is not determinative of the decision in this proceeding.

It is further pointed out that, in this instance, the patent owner's belief that a rejection based upon the Keystone references is legally impermissible in this merged proceeding (based on the alleged prior consideration of the reference date issue) does not convert the proceeding into a question of the examiner's jurisdiction to reexamine, which would create a petition right to contest the propriety of taking that action. Rather, the patent owner is free to contest such an issue before the examiner, and then the Board of Patent Appeals and Interferences ("Board"), if the claims would be rejected based upon the Keystone references. 37 CFR 1.181(a)(1) permits petitions only from matters that are not subject to appeal; in this instance, if a rejection based on the Keystone references would be made and maintained, the route to contest that rejection would be via appeal.

Finding:

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 determinations to order reexamination, and in the determinations that the questions of patentability raised in the January 21, 2005 and April 4, 2005 requests were not previously considered in an earlier concluded examination of the patent. The petition is thus denied as to the issue of the propriety of the two orders for reexamination, and the two reexamination proceedings will continue.

As to petitioner's request that the instant decision be designated a final agency decision, that request is granted since the merged proceeding is ripe for such a designation.

CONCLUSION

1. The petition under 37 CFR 1.181 is <u>denied</u> as to the request to vacate the orders for the 90/007,282 and 90/007,384 proceedings, and is <u>granted to the extent that</u> (a) the prior decision has been fully reconsidered and (b) the instant decision is designated as a final agency decision.

2. The '7282 and '7384 reexamination proceedings remain merged into a single proceeding, over which the Office properly has jurisdiction.

3. This decision is a <u>final agency action</u> within the meaning of 5 U.S.C. 704.

4. Jurisdiction over the instant merged reexamination proceeding is being forwarded to the Technology Center.

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

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

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12-28-05

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Paper No. __

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(For Patent Owner)

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(For Requester)

MAILED
AUG 18 2005
REEXAM UNIT

In re Michael E. Woolford et al.
Reexamination Proceeding
Control No.: 90/007,385
Filed: January 21, 2005
For: U.S. Patent No.: 5,827,015

: DECISION TO
: DISMISS PETITION TO
: VACATE REEXAMINATION
: ORDER AND TERMINATE
: REEXAMINATION
:

This is a decision on the May 17, 2005 patent owner petition under 37 CFR 1.181(a)(3), to vacate the order granting the above-captioned reexamination proceeding. A requester opposition to the patent owner petition was received June 3, 2005.

The proceeding, the petition, and the opposition are before the Office of Patent Legal Administration.

SUMMARY

For the reasons set forth below, the petition under 37 CFR 1.181(a)(3) is dismissed. The April 4, 2005 order granting reexamination in the 90/007,385 proceeding remains intact.

REVIEW OF FACTS

1. U.S. Patent No. 5,827,015 (the '015 patent) issued on October 27, 1998.
2. A first request for reexamination of the '015 patent was filed by a third party requester on November 2, 2004. The first request was assigned control No. 90/007,281 (the '7281 proceeding).
3. A second request for reexamination of the '015 patent was filed by a third party requester on January 21, 2005. The second request was assigned control No. 90/007,385 (the '7385 proceeding).

4. Reexamination was denied for the '7281 proceeding on January 31, 2005.
5. A petition under 37 CFR 1.515(c) to review the examiner's determination refusing *ex parte* reexamination (and to grant the '7281 reexamination) was received from the '7281 requester on February 14, 2005.
6. An opposition to the February 14, 2005 requester petition was received from the patent owner on March 24, 2005.
7. Reexamination was ordered for the '7385 proceeding on April 4, 2005.
8. A petition under 37 CFR 1.181(a)(3) to vacate the '7385 reexamination order was received from the patent owner on May 17, 2005.
9. An opposition to the May 17, 2005 patent owner petition to vacate was received from the '7385 requester on June 3, 2005.
10. A patent owner's statement under 37 CFR 1.530 has <u>not</u> been received in the '7385 reexamination proceeding.

DECISION ON PETITION

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."

MPEP 2246, Part I, states, in part:

> "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).
>
> "As to (E) above, the decision of *In re Recreative Technologies Corp.*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996) is to be noted."

MPEP 2242, Part II.A., states, in part:

> "A "substantial new question of patentability" is not raised by prior art presented in a reexamination request if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).
>
> "In deciding whether to grant a request for reexamination of a patent, the examiner should check the patent's file history to ascertain whether any of the prior art now advanced by requester was previously cited/considered in an earlier concluded Office examination of the patent (e.g., in the examination of the application for the patent)."

In this instance, the patent owner petitioner urges that the Office has previously considered (in an earlier concluded examination of the patent) the questions of patentability of the '015 patent claims on which the '7385 order for reexamination was based, and that the previous consideration was favorable to the patent owner. Accordingly, the patent owner petitions that the '7385 order for reexamination of the '015 patent be vacated as an *ultra vires* action taken by the Office.

Review of the request for reexamination

The '7385 Request for Reexamination, filed January 21, 2005, urges that Keystone Retaining Walls (Beautiful Do-It Yourself Retaining Walls! (1989)), and Keystone Retaining Walls (Introducing the Keystone Retaining Wall System (1989)) raise substantial new questions of patentability with respect to claims 1-51 of the '015 patent. Specifically, the Request urges that the two Keystone references each individually anticipates the claims, or renders the claims obvious in view of each other, and have publication dates earlier than the '015 filing date.

The request alleges that the dates of the Keystone references are no later than March 1989 for one, and May 1989 for the other, the dates being established by trademark registration documents and by affidavits of Keystone sales representatives.

Review of the Patent Owner's Argument for Vacatur

The petition admits that the Keystone references would anticipate the indicated claims if the references were prior art. The petition argues that the references are undated and have never had a date of publication established. The petitioner alleges that the source of the references pays substantial royalties to license the patented subject matter (of the '015 patent), and this is submitted to be evidence that the source of the references does not believe it could antedate the patent.

Further, the petition states that the examiner "was also squarely presented with the issue of whether the Pfannenstein Declaration established the Garden Wall I document

as a prior printed publication to the '015 patent family. He concluded that it did not." The evidence proffered for this assertion is the paper entitled "Comments On Statement Of Reasons For Allowance" entered in the subsequently filed 09/497,250 application on March 20, 2000.

The petition also argues, as to the impropriety of other references in the request, on the grounds that those references were listed on information disclosure statements initialed by the examiner, and that all those references are secondary references for obviousness patentability issues.

Review of the order for reexamination

In the order granting the reexamination request, the examiner stated that each of the Keystone references were cited but never applied in the '015 prosecution. This appears to be correct from a review of the '015 file.

Evaluation as to any prior consideration of the references:

A review of the record reveals that all of the references which the order for reexamination cites as raising substantial new questions of patentability were cited in the '015 prosecution; however, none of them were applied, nor were they commented upon by the examiner. The petition urges that the fact that the examiner initialed the citations in the '015 prosecution evidences the examiner's consideration such that those references cannot be the basis for a new question of patentability. This is an incorrect reading of the law. 35 U.S.C. 303(a) states, in part, "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."

The petition further urges that the precise question, raised and addressed in the orders, of whether the references were prior art was considered by the examiner. Petitioner cites as evidence of this - the paper titled "Comments On Statement Of Reasons For Allowance" filed on March 20, 2000, in the 09/160,916 file, in which the applicant stated "[t]he Keystone brochure referred to in the 'Reasons for Allowance' is not the brochure which bears the copyright office date stamp of 'June 27, 1988', which is referred to in the earlier Office Action, but is the undated brochure which was attached to the 'Statutory Declaration of All Pfannestein dated August 28, 1998' filed with the Australian litigation between Keystone and Anchor Wall Systems" and "[t]he issue of the undated brochure and various related allegations of its purported author (Keystone) have previously been discussed with the Examiner in the prosecution of the parent case."

Although the Comments On Statement of Reasons For Allowance further states that '[t]hese remarks are being submitted with the consent of and at the request of Examiner Taylor," the record provides no corroborating evidence that the examiner reviewed the comments or agreed with them, much less requested them. These applicant comments

are deemed to be self serving, and they were delayed until after the close of prosecution, with no further comment by the examiner. More critically, this paper was submitted in a continuation application subsequent to the instant patent's application, and therefore cannot evidence the record of the instant patent '015's history. Accordingly, the comments are not deemed to be persuasive that the precise question of whether the issue of the date of the references purportedly presenting a substantial new question of patentability was ever evaluated in view of the documents suggesting a date of March 1989.

As to the issue of any oral statement the examiner might have made, and any weight to be accorded same, oral statements are open to misinterpretation. Accordingly, 37 CFR 1.2 clearly states:

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

As to the examiner's not having commented on applicant's March 20, 2000 "Comments On Statement Of Reasons For Allowance," 37 C.F.R. 104(e) states that:

> "Failure by the examiner to respond to any statement commenting on reasons for allowance does not give rise to any implication."

As to whether the issue of the date of publication may present a substantial new question of patentability, this is readily answered by the opinion in *Heinl v Godici*, (E.D.Va. 2001), 143 F. Supp. 2d 593, which found that art cited in the original patent proceedings, but for which no findings as to their status as prior art were made in the original proceedings, could raise a substantial new question of patentability in light of evidence as to their status as prior art.

It is further to be noted that the *Heinl* opinion further states that "Courts are uniform in recognizing that the decision to grant reexaminations of a patent is preliminary, not final agency action." *Heinl*, 143 F. Supp. 2d at 597. Both the fact that the issue as to the status of the cited references as prior art has never been determined in the prior proceedings, and the fact that an order granting reexamination is not a final agency action, weigh in favor of allowing the reexamination proceedings to continue.

Finding:

In *Heinl*, 143 F.Supp.2d at 601, the Court stated, in a decision seeking termination of reexamination based on the absence of a new question of patentability:

> "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 determination that the questions of patentability raised in the April 4, 2005 requests were not previously considered in an earlier concluded examination of the patent. The petition is thus dismissed, and the '7385 reexamination proceeding will continue.

CONCLUSION

1. The petition under 37 CFR 1.181 is dismissed.
2. The reexamination file is being forwarded to the Technology Center for the issuance of a first Office action in due course.
3. Telephone inquiries related to this decision should be directed to Anton W. Fetting, Senior Legal Advisor, at (571) 272-7717, or in his absence, Kenneth Schor, Senior Legal Advisor, at (571) 272-7710.

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

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(For Patent Owner)

MAILED
OCT 29 2005
REEXAM UNIT

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(For Requester)

In re Michael E. Woolford et al.
Reexamination Proceeding
Control No.: 90/007,385
Filed: January 21, 2005
For: U.S. Patent No.: 5,827,015

: DECISION DENYING
: PETITION TO VACATE
: REEXAMINATION ORDERS
: AND TERMINATE
: REEXAMINATIONS

This is a decision on the October 18, 2005 patent owner petition under 37 CFR 1.181, seeking supervisory review and final agency decision on the August 18, 2005 decision dismissing the petition to vacate the orders granting the two above-captioned reexamination proceedings.

The proceeding of reexamination Control Number 90/007,385 and the present petition are before the Office of Patent Legal Administration.

For the reasons set forth below, the petition under 37 CFR 1.181(a)(3) is denied as to the request to vacate the order for the 90/007,385 proceedings. In addition, the petition is granted to the extent that (a) the prior decision has been fully reconsidered and (b) the instant decision is designated as a final agency decision.

The April 4, 2005 order granting reexamination in the 90/007,385 proceeding remains intact.

REVIEW OF FACTS

1. U.S. Patent No. 5,827,015 (the '015 patent) issued on October 27, 1998.
2. A first request for reexamination of the '015 patent was filed by a third party requester on November 2, 2004. The first request was assigned control No. 90/007,281 (the '7281 proceeding).
3. A second request for reexamination of the '015 patent was filed by a third party requester on January 21, 2005. The second request was assigned control No. 90/007,385 (the '7385 proceeding). The art over which this '7385 request was cited differed from the art cited in the '7281 request.

4. Reexamination was denied for the '7281 proceeding on January 31, 2005.

5. A petition under 37 CFR 1.515(c) to review the examiner's determination refusing *ex parte* reexamination (and to grant the '7281 reexamination) was received from the '7281 requester on February 14, 2005. This petition was denied in the Technology Center's decision issued August 31, 2005.

6. An opposition to the February 14, 2005 requester petition was received from the patent owner on March 24, 2005.

7. Reexamination was ordered for the '7385 proceeding on April 4, 2005.

8. A petition under 37 CFR 1.181(a)(3) to vacate the '7385 reexamination order was received from the patent owner on May 17, 2005.

9. An opposition to the May 17, 2005 patent owner petition to vacate was received from the '7385 requester on June 3, 2005.

10. A decision dismissing the petition to vacate the order was mailed by the Office on August 19, 2005.

11. The present petition under 37 CFR 1.181 seeking supervisory review and final agency decision concerning the petition by patent owner to vacate order granting reexamination was received in the proceeding on October 18, 2005.

12. A third request for reexamination of the '015 patent was filed by the same third party requester that filed the '7281 request on November 1, 2005. The third request was assigned control No. 90/007,787 (the '7787 proceeding).

13. Reexamination was denied for the '7787 proceeding on December 21, 2005. The request was denied because the art cited was the same as in the instant '7385 proceeding and therefore did not raise a new question of patentability relative to the instant proceeding.

14. A patent owner's statement under 37 CFR 1.530 has <u>not</u> been received in the '7385 reexamination proceeding.

DECISION ON PETITION

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."

MPEP 2246, Part I, states, in part:

> "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 no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained. "Appropriate circumstances" under 37 CFR 1.181(a)(3) exist to vacate the order granting reexamination where, for example:
>
> ...
>
> "(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).
>
> "As to (E) above, the decision of *In re Recreative Technologies Corp.*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996) is to be noted."

MPEP 2242, Part II.A., states, in part:

> "A 'substantial new question of patentability' is not raised by prior art presented in a reexamination request if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).
>
> "In deciding whether to grant a request for reexamination of a patent, the examiner should check the patent's file history to ascertain whether any of the prior art now advanced by requester was previously cited/considered in an earlier concluded Office examination of the patent (e.g., in the examination of the application for the patent)."

In this instance, the patent owner petitioner urges that the Office has previously considered (in an earlier concluded examination of the patent) the questions of patentability of the '015 patent claims on which the '7385 order for reexamination was based, and that the previous consideration was favorable to the patent owner. Accordingly, the patent owner petitions that the '7385 order for reexamination of the '015 patent be vacated as an *ultra vires* action taken by the Office.

Review of the requests for reexamination

The '7385 Request for Reexamination, filed January 21, 2005, urges that Keystone Retaining Walls (Beautiful Do-It Yourself Retaining Walls! (1989)), and Keystone Retaining Walls (Introducing the Keystone Retaining Wall System (1989)) raise substantial new questions of patentability with respect to claims 1-51 of the '015 patent. Specifically, the Request urges that the two Keystone references each individually anticipates the claims, or renders the claims obvious in view of the other Keystone reference, and that the Keystone references have publication dates earlier than the '015 filing date.

The request alleges that the dates of the Keystone references are no later than March 1989 for one, and May 1989 for the other, the dates being established by trademark registration documents and by affidavits of Keystone sales representatives.

Review of the Patent Owner's Argument for Vacatur

The petition admits that the Keystone references would anticipate the indicated claims if the references were prior art. The petition argues that the references are undated and have never had a date of publication established. The petitioner alleges that the source of the references pays substantial royalties to license the patented subject matter (of the '015 patent), and this is submitted to be evidence that the source of the references does not believe it could antedate the patent.

Further, the petition states that the examiner "was also squarely presented with the issue of whether the Pfannenstein Declaration established the Garden Wall I document as a prior printed publication to the '015 patent family. He concluded that it did not." The evidence proffered for this assertion is the paper entitled "Comments On Statement Of Reasons For Allowance" entered in the subsequently filed 09/497,250 application on March 20, 2000.

The petition also argues, as to the impropriety of other references in the request, on the grounds that those references were listed on information disclosure statements initialed by the examiner, and that all those references are secondary references for obviousness patentability issues.

Review of the orders for reexamination

In the order granting the reexamination request, the examiner stated that each of the Keystone references were cited but never applied in the '015 prosecution. This appears to be correct from a review of the '015 file.

Evaluation as to any prior consideration of the references:

A review of the record reveals that all of the references which the orders for reexamination cite as raising substantial new questions of patentability were cited in the '713 prosecution; however, none of them were applied, nor were they commented upon by the examiner. The petition urges that the fact that the examiner initialed the citations in the '713 prosecution evidences the examiner's consideration - such that those references cannot be the basis for a new question of patentability. This is an incorrect reading of the law. 35 U.S.C. 303(a) states, in part, "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."

The petition further urges that the examiner previously considered the precise question raised and addressed in the orders - of whether the Keystone references were prior art. Petitioner cites as evidence of this - the paper titled "Comments On Statement Of Reasons For Allowance" filed on March 20, 2000, in the '916 file, in which the applicant stated "[t]he Keystone brochure referred to in the 'Reasons for Allowance' is not the brochure which bears the copyright office date stamp of 'June 27, 1988', which is referred to in the earlier Office Action, but is the undated brochure which was attached to the 'Statutory Declaration of All Pfannestein dated August 28, 1998' filed with the Australian litigation between Keystone and Anchor Wall Systems" and "[t]he issue of the undated brochure and various related allegations of its purported author (Keystone)

have previously been discussed with the Examiner in the prosecution of the parent case."

Although the Comments On Statement of Reasons For Allowance further states that '[t]hese remarks are being submitted with the consent of and at the request of Examiner Taylor," the record provides no corroborating evidence that the examiner reviewed the comments or agreed with them, much less requested them. These applicant comments are deemed to be self serving, and they were delayed until after the close of prosecution, with no further comment by the examiner. Accordingly, the comments are not deemed to be persuasive that the precise question of the date of the references purportedly presenting a substantial new question of patentability was ever evaluated in view of the documents suggesting a date of March 1989.

As to the issue of any oral statement the examiner might have made, and any weight to be accorded same, oral statements are open to misinterpretation. Accordingly, 37 CFR 1.2 clearly states:

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

As to the examiner's not having commented on applicant's March 20, 2000 "Comments On Statement Of Reasons For Allowance," 37 C.F.R. 104(e) states that:

> "Failure by the examiner to respond to any statement commenting on reasons for allowance does not give rise to any implication."

As to whether the issue of the date of publication may present a substantial new question of patentability, this is readily answered by the opinion in *Heinl v Godici*, (E.D.Va. 2001), 143 F. Supp. 2d 593, which found that art cited in the original patent proceedings, but for which no findings as to their status as prior art were made in the original proceedings, could raise a substantial new question of patentability in light of evidence as to their status as prior art.

It is also to be noted that the *Heinl* opinion further states that "Courts are uniform in recognizing that the decision to grant reexaminations of a patent is preliminary, not final agency action." *Heinl*, 143 F. Supp. 2d at 597. Both the fact that the issue as to the status of the cited references as prior art has never been determined in the prior proceedings, and the fact that an order granting reexamination is not a final agency action, weigh in favor of allowing the reexamination proceeding to continue.

<u>Evaluation of the petitioner's arguments regarding the prior petition decision:</u>

The petitioner argues that the prior decision was premised on two erroneous assumptions, i.e., (1) that the documents under consideration were not adequately considered during the course of prosecution, and (2) that the evidence relied on in finding a significant new question of patentability is being presented in a new light, as compared with the original prosecution. The petitioner argues that both of these premises are incorrect.

Petitioner's argument omits the essential aspect in the instant proceeding, which is that the evidence now before the Office (that was not so in the original, i.e., application, proceeding) is evidence as to the date the documents were disseminated and made accessible to the public. It is this evidence that casts the documents that are applied against the '015 patent in a new light, i.e. as being prior art rather than indeterminate art. Although the petitioner makes reference to the House Report 107-120[1] indication that the most recent revision to 35 U.S.C. 303 permits reexamination only where there is substantial evidence that the examiner did not properly understand the reference or did not consider a portion of the reference in making his decision, such is not at odds with the evidence before the examiner in this reexamination proceeding. Where the examiner in the original prosecution could not determine the date of a reference, and therefore could not sustain a rejection based on that reference because of the absence of a "good" date, evidence subsequently provided in the instant reexamination proceeding as to the date that antedates the date of invention can change the consideration of that reference from consideration of an <u>indeterminate</u> document to consideration of a <u>prior art</u> document.

As alluded to above, this set of facts is directly analogous to those in *Heinl*, 143 F.Supp.2d at 602, in which the Court stated, in a decision seeking termination of reexamination based on the absence of a new question of patentability:

> "There, plaintiff did not argue that the examiner should make a finding that the catalogs were not prior art, but rather, he argued that the evidence did not permit the examiner to make any finding regarding their status as prior art. ... Accordingly, the catalogs are not prior art that was previously relied upon to reject a claim, and therefore, their submission in the '275 Reexamination does not bar their submission and consideration in the subsequent '809 Reexamination."

In one of the parent cases to the '713 patent (to which this reexamination is directed), the examiner set forth that he could not determine the date of a document which was not clearly identified by the examiner. The record suggests that such unidentified document is a document different from that asserted by the petitioner, but has a similar shorthand name used for identification. Regardless as to which document the examiner referred, the examiner did not have sufficient evidence to make, and the record shows no evidence that the examiner did make, a finding as to the specific date of the document then at issue. The examiner did not even make a finding that the document was definitively not prior art.

The requester also makes reference to a petition decision in the related '7281 reexamination proceeding by a Technology Center Director, upholding a decision not to order reexamination. Because this is a separate proceeding with different facts, the decision on the petition in the related proceeding is not determinative of the decision in this proceeding. In particular, the request for reexamination in the '7281 proceeding did not cite nor show how to apply the art that is cited in the instant proceeding's request.

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[1] <u>http://thomas.loc.gov/cgi-bin/cpquery/?&dbname=cp107&sid=cp107VYubX&refer=&r_n=hr120.107&item=&sel=TOC_2687&</u>

Although the Technology Director's decision mentions the art in the instant proceeding, it was to point out the absence of such art from the '7281 request and that there was no indication of how the art was presented in a new light in the petition arguments. The request in the instant proceeding, with its indication of how the art is presented in a new light, namely, as to the dates of publication, is not discussed in the Technology Center Director's decision.

It is further pointed out that, in this instance, the patent owner's belief that a rejection based upon the Keystone references is legally impermissible in this merged proceeding (based on the alleged prior consideration of the reference date issue) does not convert the proceeding into a question of the examiner's jurisdiction to reexamine, which would create a petition right to contest the propriety of taking that action. Rather, the patent owner is free to contest such an issue before the examiner, and then the Board of Patent Appeals and Interferences ("Board"), if the claims would be rejected based upon the Keystone references. 37 CFR 1.181(a)(1) permits petitions only from matters that are not subject to appeal; in this instance, if a rejection based on the Keystone references would be made and maintained, the route to contest that rejection would be via appeal.

Finding:

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 determination to order reexamination, and in the determinations that the questions of patentability raised in the April 4, 2005 request were not previously considered in an earlier concluded examination of the patent. The petition is thus denied as to the issue of the propriety of the order for reexamination, and the reexamination proceeding will continue.

As to petitioner's request that the instant decision be designated a final agency decision, that request is granted since the proceeding is ripe for such a designation.

CONCLUSION

1. The petition under 37 CFR 1.181 is denied as to the request to vacate the order for the 90/007,385 proceeding, and is granted to the extent that (a) the prior decision has been fully reconsidered and (b) the instant decision is designated as a final agency decision.

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

3. Jurisdiction over the instant reexamination proceeding is being forwarded to the Technology Center.

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

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

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12-28-05

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Paper No. __

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(For Patent Owner)

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REEXAM UNIT

Daniel J. Polglaze
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(For Requester)

In re Michael E. Woolford et al. Reexamination Proceeding Control No.: 90/007,278 Filed: November 2, 2004 For: U.S. Patent No.: 6,312,197	DECISION TO *SUA SPONTE* MERGE *EX PARTE* REEXAMINATION PROCEEDINGS AND
In re Michael E. Woolford et al. Reexamination Proceeding Control No.: 90/007,386 Filed: January 21, 2005 For: U.S. Patent No.: 6,312,197	DISMISS PETITION TO VACATE REEXAMINATION ORDER AND TERMINATE REEXAMINATION

This is a decision on the March 16, 2005 and May 17, 2005 patent owner petitions under 37 CFR 1.181(a)(3), to vacate the orders granting the two above-captioned reexamination proceedings. Requester oppositions to the two patent owner petitions were received March 24, 2005 and June 3, 2005, respectively.

This is also a decision to *sua sponte* merge the two above-captioned *ex parte* reexamination proceedings into a single proceeding.

The two proceedings, the two petitions, and the two oppositions are before the Office of Patent Legal Administration.

SUMMARY

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For the reasons set forth below, the two petitions under 37 CFR 1.181(a)(3) are dismissed. The January 31, 2005 order granting reexamination in the 90/007,278 proceeding and the April 4, 2005 order granting reexamination in the 90/007,386 proceeding remain intact.

Pursuant to 37 CFR 1.565(c), reexamination Control Nos. 90/007,278 and 90/007,386 are *sua sponte* merged into a single proceeding.

A single decision is being issued to address the above matters.

REVIEW OF FACTS

1. U.S. Patent No. 6,312,197 (the '197 patent) issued on February 6, 2001.
2. A first request for reexamination of the '197 patent was filed by a third party requester on November 2, 2004. The first request was assigned control No. 90/007,278 (the '7278 proceeding).
3. A second request for reexamination of the '197 patent was filed by a third party requester on January 21, 2005. The second request was assigned control No. 90/007,386 (the '7386 proceeding).
4. Reexamination was ordered for the '7278 proceeding on January 31, 2005.
5. A petition under 37 CFR 1.181(a)(3) to vacate the '7278 reexamination order was received from the patent owner on March 16, 2005.
6. An opposition to the March 16, 2005 patent owner petition to vacate was received from the '7278 requester on March 24, 2005.
7. Reexamination was ordered for the '7386 proceeding on April 4, 2005.
8. A petition under 37 CFR 1.181(a)(3) to vacate the '7386 reexamination order was received from the patent owner on May 17, 2005.
9. An opposition to the May 17, 2005 patent owner petition to vacate was received from the '7386 requester on June 3, 2005.
10. A patent owner's statement under 37 CFR 1.530 has not been received in the '7278 and '7386 reexamination proceedings.

DECISION ON PETITIONS

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

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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."

MPEP 2246, Part I, states, in part:

> "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 no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained. "Appropriate circumstances" under 37 CFR 1.181(a)(3) exist to vacate the order granting reexamination where, for example:
>
> ...
>
> "(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).
>
> "As to (E) above, the decision of *In re Recreative Technologies Corp.*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996) is to be noted."

MPEP 2242, Part II.A., states, in part:

> "A "substantial new question of patentability" is not raised by prior art presented in a reexamination request if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).
>
> "In deciding whether to grant a request for reexamination of a patent, the examiner should check the patent's file history to ascertain whether any of the prior art now advanced by requester was previously cited/considered in an earlier concluded Office examination of the patent (e.g., in the examination of the application for the patent)."

In this instance, the patent owner petitioner urges that the Office has previously considered (in an earlier concluded examination of the patent) the questions of patentability of the '197 patent claims on which the two orders for reexamination were based, and that the previous consideration was favorable to the patent owner. Accordingly, the patent owner petitions that the '7278 and '7386 orders for reexamination of the '197 patent be vacated as *ultra vires* actions taken by the Office.

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Review of the requests for reexamination

The '7278 Request for Reexamination, filed November 3, 2004, urges that Keystone Retaining Walls (Beautiful Do-It Yourself Retaining Walls! (1989)) raises a substantial new question of patentability (SNQ) with respect to claims 1-8 of the '197 patent. Specifically, the Request urges that the Keystone reference anticipates the claims and has a publication date earlier than the '197 filing date.

The '7386 Request for Reexamination, filed January 21, 2005, urges that Keystone Retaining Walls (Beautiful Do-It Yourself Retaining Walls! (1989)), Keystone Retaining Walls (Introducing the Keystone Retaining Wall System (1989)) and Johnson Block (Johnson Block Retaining Wall Systems (1989)) raise substantial new questions of patentability with respect to claims 1-8 of the '197 patent. Specifically, the Request urges that the two Keystone references each individually anticipates the claims, or renders the claims obvious in view of Johnson Block, and have publication dates earlier than the '197 filing date.

Both requests allege that the dates of the Keystone references are no later than March 1989 for one, and May 1989 for the other, the dates being established by trademark registration documents and by affidavits of Keystone sales representatives.

Review of the Patent Owner's Argument for Vacatur

Both petitions admit that the Keystone references would anticipate the indicated claims if the references were prior art. The petitions argue that the references are undated and have never had a date of publication established. The petitioner alleges that the source of the references pays substantial royalties to license the patented subject matter (of the '197 patent), and this is submitted to be evidence that the source of the references does not believe it could antedate the patent.

Further, both petitions state that "both documents are of record *and were considered* during the prosecution of Serial No. 09/497,250 ('the '250 application'), which subsequently issued as the '197 patent." The evidence proffered for this assertion is the paper entitled "Comments On Statement Of Reasons For Allowance" entered in the '250 application on March 20, 2000.

The petitions also argue, as to the impropriety of other references in the request, on the grounds that those references were listed on information disclosure statements initialed by the examiner, and that all those references are secondary references for obviousness patentability issues.

Review of the orders for reexamination

In the orders granting the reexamination request, the examiner stated that each of the Keystone references were cited but never applied in the '197 prosecution. This appears to be correct from a review of the '197 file.

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Evaluation as to any prior consideration of the references:

A review of the record reveals that all of the references which the orders for reexamination cite as raising substantial new questions of patentability were cited in the '197 prosecution; however, none of them were applied, nor were they commented upon by the examiner. The petition urges that the fact that the examiner initialed the citations in the '197 prosecution evidences the examiner's consideration such that those references cannot be the basis for a new question of patentability. This is an incorrect reading of the law. 35 U.S.C. 303(a) states, in part, "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."

The petition further urges that the precise question, raised and addressed in the orders, of whether the references were prior art was considered by the examiner. Petitioner cites as evidence of this - the paper titled "Comments On Statement Of Reasons For Allowance" filed on March 20, 2000, in the 09/160,916 file, in which the applicant stated "[t]he Keystone brochure referred to in the 'Reasons for Allowance' is not the brochure which bears the copyright office date stamp of 'June 27, 1988', which is referred to in the earlier Office Action, but is the undated brochure which was attached to the 'Statutory Declaration of All Pfannestein dated August 28, 1998' filed with the Australian litigation between Keystone and Anchor Wall Systems" and "[t]he issue of the undated brochure and various related allegations of its purported author (Keystone) have previously been discussed with the Examiner in the prosecution of the parent case."

Although the Comments On Statement of Reasons For Allowance further states that '[t]hese remarks are being submitted with the consent of and at the request of Examiner Taylor," the record provides no corroborating evidence that the examiner reviewed the comments or agreed with them, much less requested them. These applicant comments are deemed to be self serving, and they were delayed until after the close of prosecution, with no further comment by the examiner. Accordingly, the comments are not deemed to be persuasive that the precise question of whether the issue of the date of the references purportedly presenting a substantial new question of patentability was ever evaluated in view of the documents suggesting a date of March 1989.

As to the issue of any oral statement the examiner might have made, and any weight to be accorded same, oral statements are open to misinterpretation. Accordingly, 37 CFR 1.2 clearly states:

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

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As to the examiner's not having commented on applicant's March 20, 2000 "Comments On Statement Of Reasons For Allowance," 37 C.F.R. 104(e) states that:

> "Failure by the examiner to respond to any statement commenting on reasons for allowance does not give rise to any implication."

As to whether the issue of the date of publication may present a substantial new question of patentability, this is readily answered by the opinion in *Heinl v Godici*, (E.D.Va. 2001), 143 F. Supp. 2d 593, which found that art cited in the original patent proceedings, but for which no findings as to their status as prior art were made in the original proceedings, could raise a substantial new question of patentability in light of evidence as to their status as prior art.

It is further to be noted that the *Heinl* opinion further states that "Courts are uniform in recognizing that the decision to grant reexaminations of a patent is preliminary, not final agency action." *Heinl*, 143 F. Supp. 2d at 597. Both the fact that the issue as to the status of the cited references as prior art has never been determined in the prior proceedings, and the fact that an order granting reexamination is not a final agency action, weigh in favor of allowing the reexamination proceedings to continue.

Finding:

In *Heinl*, 143 F.Supp.2d at 601, the Court stated, in a decision seeking termination of reexamination based on the absence of a new question of patentability:

> "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 determination that the questions of patentability raised in the January 21, 2005 and April 4, 2005 requests were not previously considered in an earlier concluded examination of the patent. The petition is thus dismissed, and the two reexamination proceedings will continue.

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DISCUSSION REGARDING MERGER

Under 37 CFR 1.565(c):

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

As evidenced by the above review of facts, reexamination control No. 90/007,278 and reexamination control No. 90/007,386 are currently pending. Since the order to reexamine has been mailed in both reexamination proceedings, a decision under 37 CFR 1.565(c) is timely.

DECISION MERGING REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-captioned 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

The patent owner is required to maintain identical amendments in the two 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(c).

A review of the reexamination file for the proceedings of reexamination control No. 90/007,278 and 90/007,386 shows that, in both proceedings, original patent claims 1-8 are present and no claims are added or altered by amendment. Accordingly, the claims are identical in number and are identical as to content in both proceedings.

III. Conduct of the Merged Proceeding

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

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2. Any response by the 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 two requesters, who will also be sent copies of Office actions.

3. Where a paper is filed which requires payment of a fee (e.g., petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appellant brief, 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.

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

CONCLUSION

1. The petitions under 37 CFR 1.181 are dismissed.

2. The '7278 and '7386 reexamination proceedings are merged into a single proceeding.

3. The reexamination file is being forwarded to the Technology Center for the issuance of a first Office action (for the merged proceeding) in due course.

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

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

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(For Requester)

In re Michael E. Woolford et al. Reexamination Proceeding Control No.: 90/007,280 Filed: November 2, 2004 For: U.S. Patent No.: 6,183,168	DECISION TO *SUA SPONTE* MERGE *EX PARTE* REEXAMINATION PROCEEDINGS AND
In re Michael E. Woolford et al. Reexamination Proceeding Control No.: 90/007,387 Filed: January 21, 2005 For: U.S. Patent No.: 6,183,168	DISMISS PETITION TO VACATE REEXAMINATION ORDER AND TERMINATE REEXAMINATION

This is a decision on the March 16, 2005 and May 17, 2005 patent owner petitions under 37 CFR 1.181(a)(3), to vacate the orders granting the two above-captioned reexamination proceedings. Requester oppositions to the two patent owner petitions were received March 24, 2005 and June 3, 2005, respectively.

This is also a decision to *sua sponte* merge the two above-captioned *ex parte* reexamination proceedings into a single proceeding.

The two reexamination proceedings, the two petitions, and the two oppositions are before the Office of Patent Legal Administration.

SUMMARY

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For the reasons set forth below, the two petitions under 37 CFR 1.181(a)(3) are dismissed. The January 31, 2005 order granting reexamination in the 90/007,280 proceeding and the April 4, 2005 order granting reexamination in the 90/007,387 proceeding remain intact.

Pursuant to 37 CFR 1.565(c), reexamination Control Nos. 90/007,280 and 90/007,387 are *sua sponte* merged into a single proceeding.

A single decision is being issued to address the above matters.

REVIEW OF FACTS

1. U.S. Patent No. 6,183,168 (the '168 patent) issued on February 6, 2001.
2. A first request for reexamination of the '168 patent was filed by a third party requester on November 2, 2004. The first request was assigned control No. 90/007,280 (the '7280 proceeding).
3. A second request for reexamination of the '168 patent was filed by a third party requester on January 21, 2005. The second request was assigned control No. 90/007,387 (the '7387 proceeding).
4. Reexamination was ordered for the '7280 proceeding on January 31, 2005.
5. A petition under 37 CFR 1.181(a)(3) to vacate the '7280 reexamination order was received from the patent owner on March 16, 2005.
6. An opposition to the March 16, 2005 patent owner petition to vacate was received from the '7280 requester on March 24, 2005.
7. Reexamination was ordered for the '7387 proceeding on April 4, 2005.
8. A petition under 37 CFR 1.181(a)(3) to vacate the '7387 reexamination order was received from the patent owner on May 17, 2005.
9. An opposition to the May 17, 2005 patent owner petition to vacate was received from the '7387 requester on June 3, 2005.
10. A patent owner's statement under 37 CFR 1.530 has not been received in the '7280 and '7387 reexamination proceedings.

DECISION ON PETITIONS

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

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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."

MPEP 2246, Part I, states, in part:

"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 no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained. "Appropriate circumstances" under 37 CFR 1.181(a)(3) exist to vacate the order granting reexamination where, for example:

...

"(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).

"As to (E) above, the decision of *In re Recreative Technologies Corp.*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996) is to be noted."

MPEP 2242, Part II.A., states, in part:

"A "substantial new question of patentability" is not raised by prior art presented in a reexamination request if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

"In deciding whether to grant a request for reexamination of a patent, the examiner should check the patent's file history to ascertain whether any of the prior art now advanced by requester was previously cited/considered in an earlier concluded Office examination of the patent (e.g., in the examination of the application for the patent)."

In this instance, the patent owner petitioner urges that the Office has previously considered (in an earlier concluded examination of the patent) the questions of patentability of the '168 patent claims on which the two orders for reexamination were based, and that the previous consideration was favorable to the patent owner. Accordingly, the patent owner petitions that the '7280 and '7387 orders for reexamination of the '168 patent be vacated as *ultra vires* actions taken by the Office.

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Review of the requests for reexamination

The '7280 Request for Reexamination, filed November 3, 2004, urges that Keystone Retaining Walls (Beautiful Do-It Yourself Retaining Walls! (1989)) raises a substantial new question of patentability (SNQ) with respect to claims 1-14 of the '168 patent. Specifically, the Request urges that the Keystone reference anticipates the claims and has a publication date earlier than the '168 filing date.

The '7387 Request for Reexamination, filed January 21, 2005, urges that Keystone Retaining Walls (Beautiful Do-It Yourself Retaining Walls! (1989)), Keystone Retaining Walls (Introducing the Keystone Retaining Wall System (1989)) and Johnson Block (Johnson Block Retaining Wall Systems (1989)) raise substantial new questions of patentability with respect to claims 1-14 of the '168 patent. Specifically, the Request urges that the two Keystone references each individually anticipates the claims, or renders the claims obvious in view of Johnson Block, and have publication dates earlier than the '168 filing date.

Both requests allege that the dates of the Keystone references are no later than March 1989 for one, and May 1989 for the other, the dates being established by trademark registration documents and by affidavits of Keystone sales representatives.

Review of the Patent Owner's Argument for Vacatur

Both petitions admit that the Keystone references would anticipate the indicated claims if the references were prior art. The petitions argue that the references are undated and have never had a date of publication established. The petitioner alleges that the source of the references pays substantial royalties to license the patented subject matter (of the '168 patent), and this is submitted to be evidence that the source of the references does not believe it could antedate the patent.

Further, both petitions state that "both documents are of record *and were considered* during the prosecution of Serial No. 09/497,250 ('the '250 application'), which subsequently issued as the '168 patent." The evidence proffered for this assertion is the paper entitled "Comments On Statement Of Reasons For Allowance" entered in the '250 application on March 20, 2000.

The petitions also argue, as to the impropriety of other references in the request, on the grounds that those references were listed on information disclosure statements initialed by the examiner, and that all those references are secondary references for obviousness patentability issues.

Review of the orders for reexamination

In the orders granting the reexamination request, the examiner stated that each of the Keystone references were cited but never applied in the '168 prosecution. This appears to be correct from a review of the '168 file.

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Evaluation as to any prior consideration of the references:

A review of the record reveals that all of the references which the orders for reexamination cite as raising substantial new questions of patentability were cited in the '168 prosecution; however, none of them were applied, nor were they commented upon by the examiner. The petition urges that the fact that the examiner initialed the citations in the '168 prosecution evidences the examiner's consideration such that those references cannot be the basis for a new question of patentability. This is an incorrect reading of the law. 35 U.S.C. 303(a) states, in part, "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."

The petition further urges that the precise question, raised and addressed in the orders, of whether the references were prior art was considered by the examiner. Petitioner cites as evidence of this - the paper titled "Comments On Statement Of Reasons For Allowance" filed on March 20, 2000, in the 09/160,916 file, in which the applicant stated "[t]he Keystone brochure referred to in the 'Reasons for Allowance' is not the brochure which bears the copyright office date stamp of 'June 27, 1988', which is referred to in the earlier Office Action, but is the undated brochure which was attached to the 'Statutory Declaration of All Pfannestein dated August 28, 1998' filed with the Australian litigation between Keystone and Anchor Wall Systems" and "[t]he issue of the undated brochure and various related allegations of its purported author (Keystone) have previously been discussed with the Examiner in the prosecution of the parent case."

Although the Comments On Statement of Reasons For Allowance further states that '[t]hese remarks are being submitted with the consent of and at the request of Examiner Taylor," the record provides no corroborating evidence that the examiner reviewed the comments or agreed with them, much less requested them. These applicant comments are deemed to be self serving, and they were delayed until after the close of prosecution, with no further comment by the examiner. Accordingly, the comments are not deemed to be persuasive that the precise question of whether the issue of the date of the references purportedly presenting a substantial new question of patentability was ever evaluated in view of the documents suggesting a date of March 1989.

As to the issue of any oral statement the examiner might have made, and any weight to be accorded same, oral statements are open to misinterpretation. Accordingly, 37 CFR 1.2 clearly states:

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

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As to the examiner's not having commented on applicant's March 20, 2000 "Comments On Statement Of Reasons For Allowance," 37 C.F.R. 104(e) states that:

> "Failure by the examiner to respond to any statement commenting on reasons for allowance does not give rise to any implication."

As to whether the issue of the date of publication may present a substantial new question of patentability, this is readily answered by the opinion in *Heinl v Godici*, (E.D.Va. 2001), 143 F. Supp. 2d 593, which found that art cited in the original patent proceedings, but for which no findings as to their status as prior art were made in the original proceedings, could raise a substantial new question of patentability in light of evidence as to their status as prior art.

It is further to be noted that the *Heinl* opinion further states that "Courts are uniform in recognizing that the decision to grant reexaminations of a patent is preliminary, not final agency action." *Heinl*, 143 F. Supp. 2d at 597. Both the fact that the issue as to the status of the cited references as prior art has never been determined in the prior proceedings, and the fact that an order granting reexamination is not a final agency action, weigh in favor of allowing the reexamination proceedings to continue.

Finding:

In *Heinl*, 143 F.Supp.2d at 601, the Court stated, in a decision seeking termination of reexamination based on the absence of a new question of patentability:

> "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 determination that the questions of patentability raised in the January 21, 2005 and April 4, 2005 requests were not previously considered in an earlier concluded examination of the patent. The petition is thus dismissed, and the two reexamination proceedings will continue.

DISCUSSION REGARDING MERGER

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Under 37 CFR 1.565(c):

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

As evidenced by the above review of facts, reexamination control No. 90/007,280 and reexamination control No. 90/007,387 are currently pending. Since the order to reexamine has been mailed in both reexamination proceedings, a decision under 37 CFR 1.565(c) is timely.

DECISION MERGING REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-captioned 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

The patent owner is required to maintain identical amendments in the two 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(c).

A review of the reexamination file for the proceedings of reexamination control No. 90/007,280 and 90/007,387 shows that, in both proceedings, original patent claims 1-14 are present and no claims are added or altered by amendment. Accordingly, the claims are identical in number and are identical as to content in both proceedings.

III. Conduct of the Merged Proceeding

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

2. Any response by the 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

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signature. Any such responses must be served on the two requesters, who will also be sent copies of Office actions.

3. Where a paper is filed which requires payment of a fee (e.g., petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appellant brief, 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.

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

CONCLUSION

1. The petitions under 37 CFR 1.181 are dismissed.

2. The '7280 and '7387 reexamination proceedings are merged into a single proceeding.

3. The reexamination file is being forwarded to the Technology Center for the issuance of a first Office action (for the merged proceeding) in due course.

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

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

8-1-05
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MAILED

JAN 18 2006

REEXAM UNIT

In re Michael E. Woolford et al.
Reexamination Proceeding
Control No.: 90/007,280
Filed: November 2, 2004
For: U.S. Patent No.: 6,183,168

In re Michael E. Woolford et al.
Reexamination Proceeding
Control No.: 90/007,387
Filed: January 21, 2005
For: U.S. Patent No.: 6,183,168

: DECISION DENYING
: PETITION TO VACATE
: REEXAMINATION ORDERS
: AND TERMINATE
: REEXAMINATIONS

This is a decision on the October 18, 2005 patent owner petition under 37 CFR 1.181(a)(3), seeking supervisory review and final agency decision on the August 18, 2005 decision dismissing the petition to vacate the orders granting the two above-captioned reexamination proceedings. A requester opposition to the patent owner petition was received November 1, 2005.

The merged proceeding of reexamination Control Numbers 90/007,280 and 90/007,387, the present petition, and the present opposition are before the Office of Patent Legal Administration.

For the reasons set forth below, the petition under 37 CFR 1.181(a)(3) is denied as to the request to vacate the orders for the 90/007,278 and 90/007,387 proceedings. In addition, the petition is granted to the extent that (a) the prior decision has been fully reconsidered and (b) the instant decision is designated as a final agency decision.

The January 31, 2005 order granting reexamination in the 90/007,280 proceeding and the April 4, 2005 order granting reexamination in the 90/007,387 proceeding remain intact. Given the August 18, 2005 merger of the two proceedings, a single decision is being issued for the two proceedings.

REVIEW OF FACTS

1. U.S. Patent No. 6,183,168 (the '168 patent) issued on February 6, 2001.
2. A first request for reexamination of the '168 patent was filed by a third party requester on November 2, 2004. The first request was assigned control No. 90/007,280 (the '7280 proceeding).
3. A second request for reexamination of the '168 patent was filed by a third party requester on January 21, 2005. The second request was assigned control No. 90/007,387 (the '7387 proceeding).
4. Reexamination was ordered for the '7280 proceeding on January 31, 2005.
5. A petition under 37 CFR 1.181 to vacate the '7280 reexamination order was received from the patent owner on March 16, 2005.
6. An opposition to the March 16, 2005 patent owner petition to vacate was received from the '7280 requester on March 24, 2005.
7. Reexamination was ordered for the '7387 proceeding on April 4, 2005.
8. A petition under 37 CFR 1.181 to vacate the '7387 reexamination order was received from the patent owner on May 17, 2005.
9. An opposition to the May 17, 2005 patent owner petition to vacate was received from the '7387 requester on June 3, 2005.
10. On August 18, 2005, the Office mailed a decision (a) dismissing the two petitions to vacate the orders, and (b) merging the two reexamination proceedings.
11. The present petition under 37 CFR 1.181(a)(3) seeking supervisory review and a final agency decision concerning the petition by patent owner to vacate the order granting reexamination was received in the present merged proceeding on October 18, 2005.
12. An opposition to the October 18, 2005 petition was received from the '7280 third party requester on November 1, 2005.
13. A patent owner's statement under 37 CFR 1.530 has <u>not</u> been received in either of the '7280 and '7387 reexamination proceedings.

DECISION ON PETITION

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."

MPEP 2246, Part I, states, in part:

> "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 no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained. "Appropriate circumstances" under 37 CFR 1.181(a)(3) exist to vacate the order granting reexamination where, for example:
>
> ...
>
> "(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).
>
> "As to (E) above, the decision of *In re Recreative Technologies Corp.*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996) is to be noted."

MPEP 2242, Part II.A., states, in part:

> "A 'substantial new question of patentability' is not raised by prior art presented in a reexamination request if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).
>
> "In deciding whether to grant a request for reexamination of a patent, the examiner should check the patent's file history to ascertain whether any of the prior art now advanced by requester was previously cited/considered in an earlier concluded Office examination of the patent (e.g., in the examination of the application for the patent)."

In this instance, the patent owner petitioner urges that the Office has previously considered (in an earlier concluded examination of the patent) the questions of patentability of the '168 patent claims on which the two orders for reexamination are based, and that the previous consideration was favorable to the patent owner. Accordingly, the patent owner petitions that the '7280 and '7387 orders for reexamination of the '168 patent be vacated as *ultra vires* actions taken by the Office.

Review of the requests for reexamination

The '7280 Request for Reexamination, filed November 3, 2004, urges that Keystone Retaining Walls (Beautiful Do-It Yourself Retaining Walls! (1989)) raises a substantial new question of patentability (SNQ) with respect to claims 1-14 of the '168 patent. Specifically, the Request urges that the Keystone reference anticipates the claims and has a publication date earlier than the '168 filing date.

The '7387 Request for Reexamination, filed January 21, 2005, urges that Keystone Retaining Walls (Beautiful Do-It Yourself Retaining Walls! (1989)), Keystone Retaining Walls (Introducing the Keystone Retaining Wall System (1989)) and Johnson Block (Johnson Block Retaining Wall Systems(1989)) raise substantial new questions of patentability with respect to claims 1-14 of the '168 patent. Specifically, the Request urges that the two Keystone references each individually anticipates the claims, or renders the claims obvious in view of Johnson Block, and have publication dates earlier than the '168 filing date.

Both requests allege that the dates of the Keystone references are no later than March 1989 for one, and May 1989 for the other, the dates being established by trademark registration documents and by affidavits of Keystone sales representatives.

Review of the Patent Owner's Argument for Vacatur

The petition admits that the Keystone references would anticipate the indicated claims if the references were prior art. The petition argues that the references are undated and have never had a date of publication established. The petitioner alleges that the source of the references pays substantial royalties to license the patented subject matter (of the '168 patent), and this is submitted to be evidence that the source of the references does not believe it could antedate the patent.

Further, the petition states that "both documents are of record *and were considered* during the prosecution of Serial No. 09/497,250 ('the '250 application'), which subsequently issued as the '168 patent." The evidence proffered for this assertion is the paper entitled "Comments On Statement Of Reasons For Allowance" entered in the '250 application on March 20, 2000.

The petition also argues the impropriety of applying other references in the request on the grounds that those references were listed on information disclosure statements initialed by the examiner, and that all those references are secondary references for obviousness patentability issues.

Review of the orders for reexamination

In the orders granting the reexamination request, the examiner stated that each of the Keystone references was cited but never applied in the '168 prosecution. This appears to be correct based on a review of the '168 file.

Evaluation as to any prior consideration of the references:

A review of the record reveals that all of the references which the orders for reexamination cite as raising substantial new questions of patentability were cited in the '168 prosecution; however, none of them were applied, nor were they commented upon by the examiner. The petition urges that the fact that the examiner initialed the citations in the '168 prosecution evidences the examiner's consideration - such that those references cannot be the basis for a new question of patentability. This is an incorrect reading of the law. 35 U.S.C. 303(a) states, in part, "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."

The petition further urges that the examiner previously considered the precise question raised and addressed in the orders - of whether the Keystone references were prior art. Petitioner cites as evidence of this - the paper titled "Comments On Statement Of Reasons For Allowance" filed on March 20, 2000, in the '916 file, in which the applicant stated "[t]he Keystone brochure referred to in the 'Reasons for Allowance' is not the brochure which bears the copyright office date stamp of 'June 27, 1988', which is referred to in the earlier Office Action, but is the undated brochure which was attached to the 'Statutory Declaration of All Pfannestein dated August 28, 1998' filed with the Australian litigation between Keystone and Anchor Wall Systems," and "[t]he issue of the undated brochure and various related allegations of its purported author (Keystone) have previously been discussed with the Examiner in the prosecution of the parent case."

Although the Comments On Statement of Reasons For Allowance further state that "[t]hese remarks are being submitted with the consent of and at the request of Examiner Taylor," the record provides no corroborating evidence that the examiner reviewed the comments or agreed with them, much less requested them. These applicant comments are deemed to be self serving, and they were delayed until after the close of prosecution, with no further comment by the examiner. Accordingly, the comments are not deemed to be persuasive that the precise question of the date of the references purportedly presenting a substantial new question of patentability was ever evaluated in view of the documents suggesting a date of March 1989.

As to the issue of any oral statement the examiner might have made, and any weight to be accorded same, oral statements are open to misinterpretation. Accordingly, 37 CFR 1.2 clearly states:

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

As to the examiner's not having commented on applicant's March 20, 2000 "Comments On Statement Of Reasons For Allowance," 37 C.F.R. 104(e) states that:

> "Failure by the examiner to respond to any statement commenting on reasons for allowance does not give rise to any implication."

As to whether the issue of the date of publication may present a substantial new question of patentability, this is readily answered by the opinion in *Heinl v Godici*, (E.D.Va. 2001), 143 F. Supp. 2d 593, which found that art cited in the original patent proceedings, but for which no findings as to their status as prior art were made in the original proceedings, could raise a substantial new question of patentability in light of evidence as to their status as prior art.

It is also to be noted that the *Heinl* opinion further states that "Courts are uniform in recognizing that the decision to grant reexaminations of a patent is preliminary, not final agency action." *Heinl*, 143 F. Supp. 2d at 597. Both the fact that the issue as to the status of the cited references as prior art has never been determined in the prior proceedings, and the fact that an order granting reexamination is not a final agency action, weigh in favor of allowing the reexamination proceedings to continue.

Evaluation of the petitioner's arguments regarding the prior petition decision:

The petitioner argues that the prior decision was premised on two erroneous assumptions, i.e., (1) that the documents under consideration were not adequately considered during the course of prosecution, and (2) that the evidence relied on in finding a significant new question of patentability is being presented in a new light, as compared with the original prosecution. The petitioner argues that both of these premises are incorrect.

Petitioner's argument omits the essential aspect in these proceedings, which is that the evidence now before the Office (that was not so in the original, i.e., application, proceeding) is evidence as to the date the documents were disseminated and made accessible to the public. It is this evidence that casts the documents that are applied against the '168 patent in a new light, i.e. as being prior art rather than indeterminate art. Although the petitioner makes reference to the House Report 107-120[1] indication that the most recent revision to 35 U.S.C. 303 permits reexamination only where there is substantial evidence that the examiner did not properly understand the reference or did not consider a portion of the reference in making his decision, such is not at odds with the evidence before the examiner in this merged reexamination proceeding. Where the examiner in the original prosecution could not determine the date of a reference, and therefore could not sustain a rejection based on that reference because of the absence of a "good" date, evidence subsequently provided in the instant reexamination proceedings as to the date that antedates the date of invention can

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[1] http://thomas.loc.gov/cgi-bin/cpquery/?&dbname=cp107&sid=cp107VYubX&refer=&r_n=hr120.107&item=&sel=TOC_2687&

change the consideration of that reference from consideration of an indeterminate document to consideration of a prior art document.

As alluded to above, this set of facts is directly analogous to those in *Heinl*, 143 F.Supp.2d at 602, in which the court stated, in a decision seeking termination of reexamination based on the absence of a new question of patentability:

> "There, plaintiff did not argue that the examiner should make a finding that the catalogs were not prior art, but rather, he argued that the evidence did not permit the examiner to make any finding regarding their status as prior art. ... Accordingly, the catalogs are not prior art that was previously relied upon to reject a claim, and therefore, their submission in the '275 Reexamination does not bar their submission and consideration in the subsequent '809 Reexamination."

In one of the parent cases to the '168 patent (to which this merged reexamination is directed), the examiner set forth that he could not determine the date of a document which was not clearly identified by the examiner. The record suggests that such unidentified document is a document different from that asserted by the petitioner, but has a similar shorthand name used for identification. Regardless as to which document the examiner referred, the examiner did not have sufficient evidence to make, and the record shows no evidence that the examiner did make, a finding as to the specific date of the document then at issue. The examiner did not even make a finding that the document was definitively not prior art.

The requester also makes reference to a petition decision in a related reexamination request by a Technology Center Director. Because this is a separate proceeding with different claims and facts, the decision in a petition in any such related proceeding is not determinative of the decision in this proceeding.

It is further pointed out that, in this instance, the patent owner's belief that a rejection based upon the Keystone references is legally impermissible in this merged proceeding (based on the alleged prior consideration of the reference date issue) does not convert the proceeding into a question of the examiner's jurisdiction to reexamine, which would create a petition right to contest the propriety of taking that action. Rather, the patent owner is free to contest such an issue before the examiner, and then the Board of Patent Appeals and Interferences ("Board"), if the claims would be rejected based upon the Keystone references. 37 CFR 1.181(a)(1) permits petitions only from matters that are not subject to appeal; in this instance, if a rejection based on the Keystone references would be made and maintained, the route to contest that rejection would be via appeal.

Finding:

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 determinations to order reexamination, and in the determinations that the questions of patentability raised in the January 21, 2005 and April 4, 2005 requests were not previously considered in an earlier concluded examination of the patent. The petition is thus denied as to the issue of the propriety of the two orders for reexamination, and the two reexamination proceedings will continue.

As to petitioner's request that the instant decision be designated a final agency decision, that request is granted since the merged proceeding is ripe for such a designation.

CONCLUSION

1. The petition under 37 CFR 1.181 is <u>denied</u> as to the request to vacate the orders for the 90/007,280 and 90/007,387 proceedings, and is <u>granted to the extent that</u> (a) the prior decision has been fully reconsidered and (b) the instant decision is designated as a final agency decision.

2. The '7280 and '7387 reexamination proceedings remain merged into a single proceeding, over which the Office properly has jurisdiction.

3. This decision is a <u>final agency action</u> within the meaning of 5 U.S.C. 704.

4. Jurisdiction over the instant merged reexamination proceeding is being forwarded to the Technology Center.

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

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

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1-16-06

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,393	01/26/2005	6086441	1305-004	8954

7590 10/11/2007

WENDEROTH LIND AND PONACK
2033 K Street NW
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Washington, DC 20006

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/11/2007

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

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10/11/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Peter Korytnyk

650A South 15th Street

Arlington, VA 22202

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007393

PATENT NO. 6,086,441

ART UNIT 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a 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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Suite 800
Washington, DC 20006

Peter Korytnyk (For Requester)
650A South 15th Street
Arlington, VA 22202

In re Akiguchi et al. :
Reexamination Proceeding : DECISION ON
Control No. 90/007,393 : PETITION
For: U.S. Patent No. 6,086,441 :

This is a decision on petitioner's request filed September 18, 2007 requesting issuance of a new office action restarting the period for response based on failure to receive office action mailed February 2, 2007 at the correspondence address of record. The petition is considered pursuant to 37 CFR 1.181 and no fee is required.

The petition is granted.

REVIEW OF THE RELEVANT FACTS

1. U.S. Patent No. 6,086,441 (hereinafter, the '441 patent) issued to Akiguchi et al. on July 11, 2000.

2. On January 26, 2005, a third party deposited a request for ex parte reexamination of claims 2-6, 8, 9, and 11-17 of the '441 patent. The reexamination proceeding was assigned Control No. 90/007,393 (hereinafter, the '7393 proceeding).

3. The request for *ex parte* reexamination for the '7393 proceeding was granted on April 11, 2005.

4. A non-final rejection was mailed on October 16, 2006.

5. Patent Owner timely replied on December 18, 2006.

6. A final office action was mailed on February 2, 2007.

7. No timely reply was received by the office and a Notice of Intent to Issue *Ex Parte* Reexamination Certificate was mailed on September 5, 2007.

8. On September 18, 2007, petitioner filed the present petition alleging non-receipt of the office action mailed February 2, 2007.

DECISION

The record indicates that a final rejection was mailed on February 2, 2007 to the address of record. No response was timely filed. In accordance with 37 CFR 1.550(d), the proceeding was terminated and a Notice of Intent to Issue a Reexamination Certificate was mailed on September 5, 2007. On September 18, 2007, the instant petition was filed alleging non-receipt of the office action of February 2, 2007.

The showing required to establish non-receipt of an Office communication must include: (1) 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; and (2) a copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. The instant petition contains both requirements.

Accordingly, the petition is granted.

CONCLUSION

1. The Notice of Intent to Issue *Ex Parte* Reexamination Certificate mailed September 5, 2007 is hereby withdrawn.

2. The final rejection of February 2, 2007 will be remailed. The period for response will run from the mail date of the final rejection.

3. Any response to this decision should be directed to:

By Mail: Mail Stop *Ex Parte* Reexam"
Attn: Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

By hand: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

4. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929 or Mark Reinhart, at (571) 272-1611.

Eric Keasel For

Lissi Mojica Marquis
Director, Central Reexamination Unit

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20081114

DATE : November 14, 2008

TO SPE OF : ART UNIT 3992

SUBJECT : Request for Certificate of Correction on Patent No.: 6086441C1

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

Please complete this form and return with file, within **7** days to:
Certificates of Correction Branch - PK 3-910
Palm location **7590** - Tel. No. 305-8201

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

Thank You For Your Assistance **Certificates of Correction Branch**

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

☒ **Approved** All changes apply.

☐ **Approved in Part** Specify below which changes **do not** apply.

☐ **Denied** State the reasons for denial below.

Comments:

Office mistake in Ex Parte Reexamination Certificate (6484th) US 6,086,441 C1

Eric Keasel

SPE: Eric Keasel **Art Unit** 3992

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For Patent Owner

MAILED
APR 19 2006
REEXAM UNIT

Richard A. Sharpe
PEARNE & GORDON LLP
1801 East 9th Street, Suite 1200
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For Requester

Ex Parte Reexamination Proceeding
Control No. 90/007,396
Filed: January 27, 2005
For: US Patent No. 5,770,231

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

This is a decision on the petition filed March 23, 2006 to request a one-month extension of time pursuant to 37 CFR 1.550 for responding to the Office action dated January 23, 2005.

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 January 23, 2005, which set a two month date for filing a response thereto. The Office action is a 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 Patentee was preparing declarations that would establish secondary considerations of non-obviousness based on commercial success. The petition asserts Patentee has been collecting information on product sales and product benefits, and the patent owner responsible for marketing is located in Belgium. Patent Owner has attempted to collect all necessary information and complete the declarations within the two-month time period but has been unable to do so. Further, while in the process of preparing the declarations, the Federal Circuit issued the *In re Kahn* decision that

extensively addresses the legal requirements for establishing a *prima facie* case of obviousness. One month additional time is requested to complete the declaration and provide a response to the Final Office Action that is consistent with the Kahn decision.

Analysis and Findings

On balance, it is considered that the petition explains the "sufficient cause" for an extension of time. It is clear that consultation with the other patent owner who is located in Belgium and collection of sufficient data for establishing commercial success is required in order to provide a fair and complete response to the final office action. Patent Owner should note, however, that evaluation of pending court decisions is not part of the current Reexamination proceeding and, given the time allotted for response in reexamination proceedings, one should reasonably anticipate the time needed for collection of information and data and for consultation with appropriate persons. An extension of time of one month is considered sufficient to compile the information and complete the response.

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 January 23, 2005 is **granted**.

2. The Patent Owner's response is due April 23, 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.

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.
90/007,397	01/27/2005	6567266	10003620-4	1424

7590 09/23/2008

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/23/2008

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

Hewlett-Packard Company
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

(For Patent Owner)

MAILED

SEP 23 2008

CENTRAL REEXAMINATION UNIT

In re Ives et al
Ex Parte Reexamination Proceeding
Control No. 90/007,397
Filed: January 27, 2005
For: U.S. Patent No. 6,567,266

: **DECISION**
: **DISMISSING**
: **PETITION**

This is a decision on the September 11, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding ("the September 11, 2008 patent owner petition to revive".)

The September 11, 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 charged to the patent owner's deposit account no. 50-3766.

SUMMARY

The September 11, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **dismissed**.

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.

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 1.113 provides, in pertinent part:

(a) 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.

*

*

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

37 CFR 1.116 provides, in pertinent part:

(b) After a final rejection or other final action (§ 1.113) 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 . . . 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 . . . or the reexamination prosecution from termination under § 1.550(d) or § 1.957(b) or limitation of further prosecution under § 1.957(c).

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 1.530 provides, in pertinent part:

(e) *Status of claims and support for claim changes.* Whenever there is an amendment to the claims pursuant to paragraph (d) of this section, there must also be supplied, on pages separate from the pages containing the changes, the status (i.e., pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes to the claims made by the amendment paper.

(f) *Changes shown by markings* . Any changes relative to the patent being reexamined which are made to the specification, including the claims, must include the following markings:

(1) The matter to be omitted by the reexamination proceeding must be enclosed in brackets; and
(2) The matter to be added by the reexamination proceeding must be underlined.

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).

MPEP 711.03(c) II A 2 (b) provides, in pertinent part:

Abandonment for Failure To Reply to a Final Action

A reply under 37 CFR 1.113 to a final action must include . . . cancellation of, or appeal from the rejection of, each claim so rejected. Accordingly, . . . the reply required for consideration of a petition to revive must be:

(A) a Notice of Appeal and appeal fee;

(B) an amendment under 37 CFR 1.116 that cancels all the rejected claims or otherwise *prima facie* places the application in condition for allowance . . .

When a notice of appeal is the reply filed pursuant to 37 CFR 1.137(a)(1) or 1.137(b)(1), the time period under 37 CFR 41.37 for filing the appeal brief will be set by the Director of the USPTO in the decision granting the petition.

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).

III. RENEWED PETITION

Reconsideration may be requested of a decision dismissing or denying a petition under 37 CFR 1.137(a) or (b) to revive a terminated reexamination prosecution. The request for reconsideration must be submitted within

one (1) month from the mail date of the decision for which reconsideration is requested. An extension of time may be requested only under 37 CFR 1.550(c); extensions of time under 37 CFR 1.136 are not available in reexamination proceedings. Any reconsideration request which is submitted should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)" (for a petition based on unavoidable delay) or "Renewed Petition under 37 CFR 1.137(b)" (for a petition based on unintentional delay).

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

See also MPEP § 711.03(c), subsection III, 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[1] 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 and a proper statement under 37 CFR 1.137(b)(3) have been submitted with the September 11, 2008 patent owner petition to revive, which satisfy items (2) and (3), respectively. The patent owner has not, however, satisfied item (1), because the patent owner has not provided a proper response to the outstanding Office action.

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 a proper response, within the meaning of 37 CFR 1.113, to the final Office action of May 2, 2008.[2] The response required by item (1) must be a notice of appeal (and the appeal fee required by 37 CFR 41.20(b)(1)), or an amendment that *prima facie* places the application in condition for allowance.[3] The patent owner has not, however, satisfied item (1),[4] because the September 11, 2008 patent owner amendment after final rejection[5], which accompanies the present petition, is not a proper response to the May 2, 2008 final office action. A brief review of the September 11, 2008 amendment reveals that the amendment fails to comply with 37 CFR 1.530(e) and 37 CFR 1.530(f)(1). For example, the September 11, 2008 amendment fails to include an explanation of the support in the disclosure of the patent for the changes made by the amendment paper, on pages separate from the pages containing the changes, pursuant to 37 CFR 1.530(e). Furthermore, the amendment strikes out matter to be deleted. Matter to be omitted by the reexamination proceeding, however, must be enclosed in brackets pursuant to 37 CFR 1.530(f)(1). See, for example, the word "and" in line 4 of claims 1 and 11, and the phrase "The

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[1] In *ex parte* reexamination proceedings, the word "reply" is replaced by "response" to avoid confusion with the "reply" that may be filed by a third party requester under 37 CFR 1.535. See, for example, 37 CFR 1.550, subsections (b), (d), and (e).

[2] In all *ex parte* reexamination proceedings, examination is conducted in accordance with 37 CFR 1.104 through 37 CFR 1.116.

[3] See MPEP 711.03(c) II A 2 (b). Note that the Request for Continued Reexamination (RCE) practice established by 37 CFR 1.114 does not apply to a patent under reexamination. See 37 CFR 1.114(e)(5). RCE practice does not apply in reexamination because a reexamination proceeding is not an "application" under 37 CFR 1.53.

[4] A notice of appeal and the appeal fee required by 37 CFR 41.20(b)(1) have not been submitted.

[5] The September 11, 2008 amendment after final rejection is a copy of the untimely filed August 4, 2008 amendment after final rejection, which has not been entered.

disk drive enclosure system of claim 1 further comprising" in line 6 of claim 10. The entire amendment should be reviewed for compliance with 37 CFR 1.530.

Accordingly, the September 11, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **dismissed**.

CONCLUSION

- The September 11, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **dismissed**.

- Any grantable renewed petition under 37 CFR 1.137(b), that is filed in response to this decision, must be accompanied by either a proper response to the May 2, 2008 final Office action or by a notice of appeal and the appeal fee required by 37 CFR 41.20(b)(1). If the patent owner desires to submit a proper response to the final Office action, the response should be included in a cover letter entitled **"Renewed Petition under 37 CFR 1.137(b)."**

- 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 1.550(c); extensions of time under 37 CFR 1.136 are not available in reexamination proceedings.

- Jurisdiction over this reexamination proceeding is being retained by the Office of Patent Legal Administration pending a response to this decision, or the expiration of time to respond to this decision.

- All correspondence relating to this petition in this *ex parte* reexamination proceeding should be directed to:

By Mail: Mail Stop "*Ex Parte* Reexam"
ATTN: Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

By FAX: (571) 273-9900
Central Reexamination Unit

By hand: Customer Service Window
ATTN: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

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
Senior Legal Advisor
Office of Patent Legal Administration

cn

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,399; 90/007,401	01/27/2005	6174420	LIFE-0125	1205

7590 06/28/2005

Woodcock Washburn LLP
One Liberty Place 46th Floor
Philadelphia, PA 19103

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/28/2005

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

CST

Woodcock Washburn LLP One Liberty Place, 46th Floor Philadelphia, PA 19103	:	(for Patent Owner)
D. Michael Young Roche Diagnostics Operations, Inc. 9115 Hague Road Indianapolis, IN 46250-0457	:	(for Third Party)
In re Hodges et al Reexamination Proceeding Control No. 90/007,399 Filed: January 27, 2005 For: U.S. Patent 6,174,420	:	**DECISION MERGING REEXAMINATION PROCEEDINGS**
In re Hodges et al Reexamination Proceeding Control No. 90/007,401 Filed: January 28, 2005 For: U.S. Patent 6,174,420	:	

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 6,174,420, issued January 16, 2001, is the subject of Reexamination Control Nos. 90/007,399 and 90/007,401.

2. A first request for reexamination, assigned Reexamination Control No. 90/007,399 ('7399), was filed January 27, 2005 by Wendy Choi of Woodcock Washburn LLP. The request urged that a substantial new question of patentability was raised by the teachings of (a) U.S. patent 4,654,197 to Lilja et al and (b) U.S. patent 5,120,420 to Nankai et al.

3. Reexamination was ordered for '7399 on April 1, 2005.

4. A second request for reexamination, assigned Reexamination Control No. 90/007,401 ('7401), was filed January 28, 2005 by D. Michael Young. The request urged that a substantial new question of patentability was raised by the teachings of U.S. patent 4,654,197 to Lilja et al, either alone or in combination with U.S. patent 5,312,590 to Gunasingham or U.S. patent 5,520,787 to Hanagan et al.

5. Reexamination was ordered for '7401 on April 1, 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 90/007,399 and 90/007,401 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

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

III. CONDUCT OF MERGED PROCEEDING

The reexamination files shall be forwarded to the examiner for consideration of the Request for Reexamination in the '7399 reexamination proceeding, as well as consideration of the Request for Reexamination in the '7401 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 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. 90/007,399 and 90/007,401 as:

Woodcock Washburn LLP
One Liberty Place, 46th Floor
Philadelphia, PA 19103

CONCLUSION

Reexamination Control Nos. 90/007,399 and 90/007,401 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

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.
90/007,399; 90/007,401	01/27/2005	6174420	LIFE-0125	1205

7390 06/28/2005

Woodcock Washburn LLP
One Liberty Place 46th Floor
Philadelphia, PA 19103

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/28/2005

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
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CST

Woodcock Washburn LLP One Liberty Place, 46th Floor Philadelphia, PA 19103	:	(for Patent Owner)
D. Michael Young Roche Diagnostics Operations, Inc. 9115 Hague Road Indianapolis, IN 46250-0457	:	(for Third Party)
In re Hodges et al Reexamination Proceeding Control No. 90/007,399 Filed: January 27, 2005 For: U.S. Patent 6,174,420	:	**DECISION MERGING REEXAMINATION PROCEEDINGS**
In re Hodges et al Reexamination Proceeding Control No. 90/007,401 Filed: January 28, 2005 For: U.S. Patent 6,174,420	:	

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 6,174,420, issued January 16, 2001, is the subject of Reexamination Control Nos. 90/007,399 and 90/007,401.

2. A first request for reexamination, assigned Reexamination Control No. 90/007,399 ('7399), was filed January 27, 2005 by Wendy Choi of Woodcock Washburn LLP. The request urged that a substantial new question of patentability was raised by the teachings of (a) U.S. patent 4,654,197 to Lilja et al and (b) U.S. patent 5,120,420 to Nankai et al.

3. Reexamination was ordered for '7399 on April 1, 2005.

4. A second request for reexamination, assigned Reexamination Control No. 90/007,401 ('7401), was filed January 28, 2005 by D. Michael Young. The request urged that a substantial new question of patentability was raised by the teachings of U.S. patent 4,654,197 to Lilja et al, either alone or in combination with U.S. patent 5,312,590 to Gunasingham or U.S. patent 5,520,787 to Hanagan et al.

5. Reexamination was ordered for '7401 on April 1, 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 90/007,399 and 90/007,401 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

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

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The reexamination files shall be forwarded to the examiner for consideration of the Request for Reexamination in the '7399 reexamination proceeding, as well as consideration of the Request for Reexamination in the '7401 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 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. 90/007,399 and 90/007,401 as:

Woodcock Washburn LLP
One Liberty Place, 46th Floor
Philadelphia, PA 19103

CONCLUSION

Reexamination Control Nos. 90/007,399 and 90/007,401 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

6/19/06

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

ALBERT S. PENILA

MARTINE PENILLA & GENCARELLA LLP

710 LAKEWAY DRIVE, SUITE 200

SUNNYVALE, CA 94085

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007402

PATENT NO. 5,191,573

ART UNI 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a replly has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,402	01/31/2005	5191573	NAPS001	2998

23973 7590 06/19/2006

DRINKER BIDDLE & REATH
ATTN: INTELLECTUAL PROPERTY GROUP
ONE LOGAN SQUARE
18TH AND CHERRY STREETS
PHILADELPHIA, PA 19103-6996

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/19/2006

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
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

DRINKER, BIDDLE & REATH, LLP (For Patent Owner)
Attn: Intellectual Property Group
One Logan Square
18th and Cherry Streets
Philadelphia Pa 19103-6996

Albert S. Penilla (For Third Party Requester)
Martine, Penilla & Gencarcella, LLP
710 Lakeway Drive, Suite 200
Sunnyvale, CA 94085

MAILED
JUN 19 2006
CENTRAL REEXAMINATION UNIT

In re Reexamination Proceeding	:
Arthur R. Hair	:
Control No. 90/007,402	: DECISION GRANTING PETITION
Filed: January 31, 2005	:
U.S. Patent No. 5,191,573	:
Attorney Docket No. NAPSP001	:

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on May 24, 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."

§ 1.560 Interviews in ex parte reexamination proceedings.

> (a) Interviews in ex parte reexamination proceedings pending before the Office between examiners and the owners of such patents or their attorneys or agents of record must be conducted in the Office at such times, within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Director. Interviews for the discussion of the patentability of claims in patents involved in ex parte reexamination proceedings will not be conducted prior to the first official

> action. Interviews should be arranged in advance. Requests that reexamination requesters participate in interviews with examiners will not be granted.
>
> (b) In every instance of an interview with an examiner in an ex parte reexamination proceeding, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner. An interview does not remove the necessity for response to Office actions as specified in § 1.111. Patent owner's response to an outstanding Office action after the interview does not remove the necessity for filing the written statement. The written statement must be filed as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.

The present petition under 37 CFR 1.137(b) includes the requisite response (written statement)(item 1), a $1500.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3).

The petition for entry of the late papers is granted.

Jurisdiction over the reexamination proceeding is being returned to Technology Center Art Unit 3992 for further examination and consideration of the written statement filed May 24, 2006, along with the present petition, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Roland Foster, in Technology Center Art Unit 3992, who can be reached at 571-272-7538.

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,404 90/007,505	01/31/2005	4823685	A1064/314432	9320

23370 7590 12/20/2005

JOHN S. PRATT, ESQ
KILPATRICK STOCKTON, LLP
1100 PEACHTREE STREET
ATLANTA, GA 30309

EXAMINER
BOMBERG, K.

ART UNIT	PAPER NUMBER
3993	

DATE MAILED: 12/20/2005 AK

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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~~12/19/2005~~

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

A. James Isbester

Isbester & Associates

3160 College Avenue, Suite 203

Berkeley, CA 94705

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007404 & 90/007,505

PATENT NO. 4,832,685

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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Alexandria, VA 22313-1450
www.uspto.gov

John S. Pratt, Esq.
Kilpatrick Stockton, LLP
1100 Peachtree Street
Atlanta, GA 30309

(For Patent Owner)

DEC 20 2005

A. James Isbester
Isbester & Associates
3160 College Avenue, Suite 203
Berkeley, CA 94705

(For 3rd Party Requester)

Reexam Control No.: 90/007,404
Filed : January 31, 2005
For U.S. Patent No. : 4,832,685

Reexam Control No.: 90/007,505
Filed : April 8, 2005
For U.S. Patent No. : 4,832,685

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination proceedings are before the Director of the Central Reexamination Unit for consideration of merger as provided for in 37 CFR 1.565(c).

Reexamination in application control No. 90/007,404 was ordered in a decision mailed March 23, 2005. No patent owner's statement has been filed in the instant proceeding, nor has an Office action been issued.

Reexamination in application control No. 90/007,505 was ordered in a decision mailed June 21, 2005. No patent owner's statement has been filed in the instant proceeding, nor has an Office action been issued.

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.

Requirement for Same Claims, Drawings, and Specification in Both Proceedings

The patent owner is required to maintain identical claims, specifications, and drawings in both files. In view of the fact that both proceedings are identical, no amendment is necessary at this time.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. All papers mailed by the Office will take the form of a single action, which applies to both proceedings. All papers issued by the Office or as filed by the patent owner will contain the

identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office.

Conclusion

Reexamination Control Nos. 90/007,404 and 90/007,505 are hereby merged. Upon mailing of this decision, both files will be forwarded to the examiner for issuance of an Office action on the merits.

Any inquiry concerning this decision should be directed to Andres Kashnikow, Special Programs Examiner, at telephone No. (571) 272-4361.

Lissi Mojica Marquis, Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,405 E 901007,506	01/31/2005	4935005	A1064/311433	9576

23370 7590 12/20/2005

JOHN S. PRATT, ESQ
KILPATRICK STOCKTON, LLP
1100 PEACHTREE STREET
ATLANTA, GA 30309

EXAMINER
BOMBERG, K

ART UNIT	PAPER NUMBER
3993	

DATE MAILED: 12/20/2005 JK

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
Alexandria, VA 22313-1450
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~~12/19/2005~~

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

A. James Isbester

Isbester & Associates

3160 College Avenue, Suite 203

Berkeley, CA 94705

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007405 & 90(007,506)

PATENT NO. 4,935,005

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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John S. Pratt, Esq.
Kilpatrick Stockton, LLP
1100 Peachtree Street
Atlanta, GA 30309

(For Patent Owner)

DEC 20 2005

A. James Isbester
Isbester & Associates
3160 College Avenue, Suite 203
Berkeley, CA 94705

(For 3rd Party Requester)

Reexam Control No.: 90/007,405
Filed : January 31, 2005
For U.S. Patent No. : 4,935,005

Reexam Control No.: 90/007,506
Filed : April 8, 2005
For U.S. Patent No. : 4,935,005

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination proceedings are before the Director of the Central Reexamination Unit for consideration of merger as provided for in 37 CFR 1.565(c).

Reexamination in application control No. 90/007,405 was ordered in a decision mailed March 23, 2005. No patent owner's statement has been filed in the instant proceeding, nor has an Office action been issued.

Reexamination in application control No. 90/007,506 was ordered in a decision mailed June 21, 2005. No patent owner's statement has been filed in the instant proceeding, nor has an Office action been issued.

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.

Requirement for Same Claims, Drawings, and Specification in Both Proceedings

The patent owner is required to maintain identical claims, specifications, and drawings in both files. In view of the fact that both proceedings are identical, no amendment is necessary at this time.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. All papers mailed by the Office will take the form of a single action, which applies to both proceedings. All papers issued by the Office or as filed by the patent owner will contain the

identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office.

Conclusion

Reexamination Control Nos. 90/007,405 and 90/007,506 are hereby merged. Upon mailing of this decision, both files will be forwarded to the examiner for issuance of an Office action on the merits.

Any inquiry concerning this decision should be directed to Andres Kashnikow, Special Programs Examiner, at telephone No. (571) 272-4361.

Lissi Mojica Marquis, Director
Central Reexamination Unit

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6/19/06

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

ALBERT S. PENILA

MARTINE PENILLA & GENCARELLA LLP

710 LAKEWAY DRIVE, SUITE 200

SUNNYVALE, CA 94085

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007407

PATENT NO. 5,966,440

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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,407	01/31/2005	5966440	NAPSP003	4782

23973 7590 06/19/2006

DRINKER BIDDLE & REATH
ATTN: INTELLECTUAL PROPERTY GROUP
ONE LOGAN SQUARE
18TH AND CHERRY STREETS
PHILADELPHIA, PA 19103-6996

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/19/2006

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
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

DRINKER, BIDDLE & REATH, LLP (For Patent Owner)
Attn: Intellectual Property Group
One Logan Square
18th and Cherry Streets
Philadelphia Pa 19103-6996

MAILED

JUN 19 2006

CENTRAL REEXAMINATION UNIT

Albert S. Penilla (For Third Party Requester)
Martine, Penilla & Gencarcella, LLP
710 Lakeway Drive, Suite 200
Sunnyvale, CA 94085

In re Reexamination Proceeding	:
Arthur R. Hair	:
Control No. 90/007,407	: DECISION GRANTING PETITION
Filed: January 31, 2005	:
U.S. Patent No. 5,966,440	:
Attorney Docket No. NAPSP003	:

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on May 24, 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."

§ 1.560 Interviews in ex parte reexamination proceedings.

> (a) Interviews in ex parte reexamination proceedings pending before the Office between examiners and the owners of such patents or their attorneys or agents of record must be conducted in the Office at such times, within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Director. Interviews for the discussion of the patentability of claims in patents involved in ex parte reexamination proceedings will not be conducted prior to the first official

action. Interviews should be arranged in advance. Requests that reexamination requesters participate in interviews with examiners will not be granted.

(b) In every instance of an interview with an examiner in an ex parte reexamination proceeding, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner. An interview does not remove the necessity for response to Office actions as specified in § 1.111. Patent owner's response to an outstanding Office action after the interview does not remove the necessity for filing the written statement. The written statement must be filed as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.

The present petition under 37 CFR 1.137(b) includes the requisite response (written statement)(item 1), a $1500.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3).

The petition for entry of the late papers is granted.

Jurisdiction over the reexamination proceeding is being returned to Technology Center Art Unit 3992 for further examination and consideration of the written statement filed May 24, 2006, along with the present petition, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Roland Foster, in Technology Center Art Unit 3992, who can be reached at 571-272-7538.

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

Fred A. Silverberg

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

Kenneth M. Schor

Conferee: Kenneth M. Schor

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Kurt M. Pankratz
BAKER BOTTS L.L.P.
2001 Ross Avenue, Suite 600
Dallas, Texas 75201

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/007,408 AND 90/007,213

PATENT NO. KRAWEZ.

ART UNIT 2839.

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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01312005

SILICON VALLEY PATENT AGENCY
7394 WILDFLOWER WAY
CUPERTINO, CA 95014

(For Patent Owner)

Kurt M. Pankratz
BAKER BOTTS L.L.P.
2001 Ross Avenue, Suite 600
Dallas, Texas 75201

(For Third Party Requester)

In re Krawez et al
Reexamination Proceeding
Control No. 90/007,213
Filed: September 16, 2004
For U.S. Patent No. 6,012,951

In re Krawez et al
Reexamination Proceeding
Control No. 90/007,408
Filed: February 1, 2005
For U.S. Patent No. 6,012,951

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. 6,012,951 issued on January 11, 2000.

2. A first request for reexamination, Control No. 90/007,213, was filed by the patent owner on September 16, 2004.

3. Reexamination was ordered for the '7213 reexamination proceeding on November 23, 2004.

4. A second request for reexamination, Control No. 90/007,408, was filed by the third party requester on February 1, 2005.

5. Reexamination was ordered for the '7408 reexamination proceeding on April 25, 2005.

6. A first Office action was issued on August 4, 2005 in the '7408 reexamination proceeding, wherein claims 1-10 were rejected as being unpatentable.

7. An amendment was filed on October 4, 2005 in the '7408 reexamination proceeding, however, it was held to be informal/nonresponsive. Subject matter deleted from the patent was not in the proper format and a certificate of service on the third party was not provided.

8. A Notice of Informal/Nonresponsive Amendment was mailed November 3, 2005 in the '7408 reexamination proceeding setting a one-month period for reply.

9. A Supplemental response was filed November 21, 2005 in the '7408 reexamination proceeding, amending claims 1-10 and adding new claims 11-19.

10. A Supplemental response was filed December 14, 2005 in the '7408 reexamination proceeding, amending claims 1-10 and adding new claims 11-19.

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 '7213 and '7408 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Three Proceedings.

As noted above, the claims have been amended in the '7408 reexamination proceedings. The claims in the '7408 reexamination proceeding are not the same as the claims in the '7213 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. '7213 and '7408 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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,410	02/04/2005	5329619	286142000430	8873

26694 7590 11/10/2008

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/10/2008

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

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

Venable LLP
P.O. Box 34385
Washington, D.C. 20043-9998

(For Patent Owner)

MAILED

NOV 10 2008

CENTRAL REEXAMINATION UNIT

Scott W. Doyle
Morrison & Foerster LLP
1650 Tysons Boulevard, Suite 300
McLean, VA 22102

(For Requester)

In re Peter Pagé, *et al.*
Ex Parte Reexamination Proceeding
Control No. 90/007,410
Filed: February 4, 2005
For: U.S. Patent No. 5,329,619

: **DECISION**
: **GRANTING**
: **PETITION UNDER**
: **37 CFR 1.137(b)**

This is a decision on the October 6, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding ("the October 6, 2008 patent owner petition to revive").

The October 6, 2008 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The petition fee of $1,620.00 set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b) has been paid.

SUMMARY

The October 6, 2008 patent owner petition to revive is **granted**.

The September 23, 2008 Notice of Intent to Issue a Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely respond is **withdrawn**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 41(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.

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 1.560(b) provides:

In every instance of an interview with an examiner in an *ex parte* reexamination proceeding, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner. An interview does not remove the necessity for response to Office actions as specified in § 1.111. Patent owner's response to an outstanding Office action after the interview does not remove the necessity for filing the written statement. The written statement must be filed as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.

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< III, for a detailed discussion of the requirements of petitions filed under 37 CFR 1.137(a) and (b).

DECISION

The Petition Under 37 CFR 1.137(b) is Granted

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 and a proper statement under 37 CFR 1.137(b)(3) have

been submitted with the October 6, 2008 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Regarding item (1), this reexamination proceeding was technically terminated due to the failure to timely submit a statement of the substance of the July 9, 2008 interview pursuant to 37 CFR 1.560(b). 37 CFR 1.560(b) requires the submission of the statement as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview. A statement under 37 CFR 1.560(b) was not filed until September 5, 2008, which was untimely. However, for the purpose of evaluating whether the October 6, 2008 patent owner petition to revive is a grantable petition, the submission of the statement under 37 CFR 1.560(b) on September 5, 2008, satisfies item (1).

Accordingly, the October 6, 2008 patent owner petition to revive is **granted**.

The September 23, 2008 Notice of Intent to Issue a Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely respond is **withdrawn**.

CONCLUSION

1. The October 6, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.

2. The September 23, 2008 Notice of Intent to Issue a Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely respond is **withdrawn**.

3. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit, Art Unit 3992, for issuance of a new Office action to replace the withdrawn September 23, 2008 NIRC.

4. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Joseph Pokrzywa, of CRU Art Unit 3992, at (571) 272-7410.

5. Any inquiry concerning this decision should be directed to Raul Tamayo, Legal Advisor, at (571) 272-7728, or in his absence, to the undersigned at (571) 272-7710.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,412	02/04/2005	6030790	532212801000	1455

30542 7590 09/12/2006
FOLEY & LARDNER LLP
P.O. BOX 80278
SAN DIEGO, CA 92138-0278

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/12/2006

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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9/12/06

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Peng Chen

MORRISON & FOERSTER LLP

3811 Valley Centre Drive, Suite 500

San Diego, CA 92130

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007412

PATENT NO. 6,030,790

ART UNI 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a 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

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United States Patent and Trademark Office
P.O. Box 1450
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Richard J. Warburg
Foley & Lardner LLP
P.O. Box 80278
San Diego, CA 92138

For Patent Owner

MAILED

SEP 12 2006

CENTRAL REEXAMINATION UNIT

Peng Chen
Morrison & Foerster LLP
3811 Valley Centre Drive, Suite 500
San Diego, CA 92130-2332

For Requester

Ex Parte Reexamination Proceeding
Control No. 90/007,412
Filed: February 4, 2005
For: US Patent No. 6,030,790

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

This is a decision on the petition filed September 7, 2006 to request a second one-month extension of time pursuant to 37 CFR 1.550 for responding to the Office action dated May 11, 2006.

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

The petition is granted for the reasons set forth below.

Decision

The Patent Owner requests a second extension of time in which to file a response to the Office action dated May 11, 2006 which set a two-month date for filing a response thereto. The Office action is a 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 a response after final was timely filed on August 16, 2006; however, there has been no action to date from the Patent Office. A notice of appeal or an extension of time is due on Monday, September 11, 2006. Patent Owner received a telephone message from Examiner Celsa indicating the amendment will be entered and an Advisory action will be completed next week. An extension of time for one (1) month is requested.

Analysis and Findings

A Final rejection was mailed on May 11, 2006 to which a response was received on July 10, 2006. The Examiner subsequently mailed an Advisory action on August 3, 2006 in which the period for response was set for three (3) months from the date of the Final Office action. An extension of time for one additional month was granted. A reply was therefore due on or before September 11, 2006. An amendment after final was received August 16, 2006. A reply from the Examiner will not be completed until after the period for response.
On balance, it is considered that the petition explains the "sufficient cause" for why an extension of time should be granted. It is clear Patentee will not have sufficient time to consider the Advisory and additional time is necessary to provide a fair opportunity to prepare a complete response. An extension of time for one month is granted.

Conclusion

1. The patent owner's petition for extension of time is **granted**.

2. The Patent Owner's response will be due October 11, 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

Commissioner for Patents
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P.O. Box 1450
Alexandria, VA 22313-1450
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SEP 12 2006

CENTRAL REEXAMINATION UNIT

Richard J. Warburg
Foley & Lardner LLP
P.O. Box 80278
San Diego, CA 92138

For Patent Owner

Peng Chen
Morrison & Foerster LLP
3811 Valley Centre Drive, Suite 500
San Diego, CA 92130-2332

For Requester

Ex Parte Reexamination Proceeding
Control No. 90/007,412
Filed: February 4, 2005
For: US Patent No. 6,030,790

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

This is a decision on the petition filed August 8, 2006 to request a two-month extension of time pursuant to 37 CFR 1.550 for responding to the Office action dated May 11, 2006.

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

The petition is granted 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 May 11, 2006 which set a two-month date for filing a response thereto. The Office action is a 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 the response after the Final rejection was mailed on July 10, 2006 but the Advisory action issued on August 3, 2006. Further, the Advisory action was available only on the PTO website and has not yet reached Patentee. Patent owner contends the Advisory action failed to grant an extension of time for at least one month which is "automatic" as set forth in MPEP 2272. Therefore, Patentee does not have sufficient time to consider the

Advisory action and prepare and submit a complete response or to file a notice of appeal. Patentee has also requested an interview to address the Examiner's concerns and to simplify issues for appeal. An extension of time until September 11, 2006 to facilitate the completion of the reply is requested.

Analysis and Findings

A Final rejection was mailed on May 11, 2006 to which a response was received on July 10, 2006. The Examiner subsequently mailed an Advisory action on August 3, 2006 in which the period for response was set for three (3) months from the date of the Final Office action. A reply was therefore due on August 11, 2006. On balance, it is considered that the petition explains the "sufficient cause" for why an extension of time should be granted. The Advisory action was received without enough time to review and respond. Patent Owner should note, however, that the Advisory action included a period for response of three (3) months from the date of the Final Office action that implicitly includes an "automatic" one-month extension of time, which time period ends August 11, 2006. This request is considered to include that month. Even so, it is clear Patentee does not have sufficient time to consider the Advisory and additional time is necessary to provide a fair opportunity to prepare a complete response.

Conclusion

1. The patent owner's petition for extension of time in which to file a response to the Office action dated September 11, 2006 is **granted**.

2. The Patent Owner's response is due September 11, 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

Lissi M. Marquis,
Director,
Central Reexamination Unit

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FEB 19 2008

CENTRAL REEXAMINATION UNIT

RICHARD J. WARBURG
FOLEY & LARDNER LLP
P.O. BOX 80278
SAN DIEGO CA 92138-0278

In re Application of

ADERMANN et al.
Control No. 90/007,412 (U.S. Patent 6,030,790)
Filed: February 4, 2005
Attorney Docket No. 532212801000

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 February 13, 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 Richard J. Warburg on behalf of all attorneys of record who are associated with Customer No. 30542. All attorneys/agents associated with the Customer No. 30542 have been withdrawn.

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

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

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

Telephone inquiries concerning this decision should be directed to Patricia Volpe at 571-272-6825.

Patricia Volpe for

Deborah D. Jones
Supervisory Patent Examiner
CRU 3991

cc: **KNUT ADERMANN**
Schleidenstr. 5
30177 Hannover
Germany

cc: **PHARIS BIOTECH GmbH**
Feodor-Lynen-Str. 31
30625 Hannover
Germany

cc: **MORRISON & FOERSTER LLP** (Third Party Requester)
ATTN: Peng Chen
12531 High Bluff Drive, Suite 100
San Diego, CA 92130-3014

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,416	02/09/2005	6127155	36692	5076

22829 7590 03/27/2007

ROCHE MOLECULAR SYSTEMS INC
PATENT LAW DEPARTMENT
1145 ATLANTIC AVENUE
ALAMEDA, CA 94501

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/27/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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MAR 27 2007

CENTRAL REEXAMINATION UNIT

Roche Molecular Systems, Inc.)
Patent Law Department)
1145 Atlantic Avenue) **FOR PATENT OWNER**
Alameda, California 94501)

In re: David H. Gelfand et al.)
Reexamination) **DECISION DISMISSING PETITION**
Control No. 90/007,416) **TO SUSPEND REEXAMINATION**
Filed: February 9, 2005) **PROCEEDINGS**
For: U.S. Patent No. 6,127,155)

This is a decision on the paper titled "Petition for Suspension of Action" filed March 9, 2007. The paper is taken as a petition under 37 CFR 1.182.

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. 50-0812, in accordance with petitioner's authorization on page 3 of the petition.

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

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

RELEVANT BACKGROUND

1. Patent No. 6,127,155 (the '155 patent) issued on October 3, 2000.

2. A request for reexamination, assigned Control No. 90/007,416 (the '7416 proceeding), was filed by patent owner on February 9, 2005.

3. Reexamination was ordered in the '7416 reexamination proceeding on March 25, 2005.

4. Prosecution in the '7416 reexamination proceeding eventuated in the issuance of a Notice of Intent to Issue a Reexamination Certificate (NIRC) mailed on December 7, 2006. The NIRC confirmed original patent claim 18, determined claims 1-17 to be patentable as amended, and found 93 (of 114) additional claims added during the reexamination proceeding to be patentable.

5. On March 9, 2007, the patent owner filed the petition under consideration, requesting that the '7416 proceeding be suspended before the issuance of a reexamination certificate.

DECISION

Patent owner petitions for action to be suspended in the '7416 reexamination period for 6 months or the close of expert testimony in the ongoing litigation, [1] whichever is shorter. Petitioner requests that the suspension be under 37 CFR 1.103(a) or, in the alternative, under 37 CFR 1.182.

The relevant portions of the rules applicable to this petition are reproduced below with emphasis added as appropriate.

37 CFR 1.103 Suspension of action by the Office.

> (a) **Suspension for cause** . On request of the ***applicant***, the Office may grant a suspension of action by the Office under this paragraph for good and sufficient cause. The Office will not suspend action if a reply by ***applicant*** to an Office action is outstanding. Any petition for suspension of action under this paragraph must specify a period of suspension not exceeding six months. ...
>
> (1) A showing of ***good and sufficient cause*** for suspension of action; and ...

[Emphasis added]

37 CFR 1.550 Conduct of *ex parte* reexamination proceedings.

> (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]

35 U.S.C. 305 states in relevant part:

> 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.

---

[1] *Molecular Diagnostics Laboratories v. Hoffman-LaRoche Inc., Case No. 1:04CV01649*

37 CFR 1.565 (b) states in relevant part:

> If a patent in the process of *ex parte* reexamination is or becomes involved in litigation, the Director shall determine whether or not to suspend the reexamination.

I. Request for suspension under 37 CFR 1.103(a)

From the regulations cited above it is evident that suspension for cause under 37 CFR 1.103 is not available in reexamination proceedings. First of all, 37 CFR 1.103(a) refers throughout to "applicant" not "patent owner." This indicates that the rule is applicable in original prosecution of an application and by implication is not applicable to reexamination proceedings. Furthermore, 37 CFR 1.550 (a) which governs the conduct of *ex parte* reexamination proceedings states that "the examination will be conducted in accordance with §§ 1.104 through 1.116". Thus, in implementing the regulations for the conduct of *ex parte* reexamination proceedings, specific sections of the regulations were specifically incorporated to the exclusion of other sections. 37 CFR 1.103 is not included among the sections governing examination of *ex parte* reexaminations, despite the fact that the regulations that directly follows it are so included. This must be construed such that, in drafting and implementing the regulations regarding the conduct of reexamination, a decision was made not to allow for suspension of action under 37 CFR 1.103.

The clear implication of these regulations read in context is that rule 103 is not applicable in reexamination proceedings.

II. Petition for Suspension of Action under 37 CFR 1.182 (Question not specifically provided for)

A. While there is no mechanism for requesting a suspension of action in a reexamination proceeding, 37 CFR 1.103 provides such a mechanism for requesting a suspension of action in an application. Accordingly, the requirements for a suspension in a reexamination proceeding will be applied analogously to the requirements of 37 CFR 1.103(a).

37 CFR 1.103(a)(1) requires that "a showing of good and sufficient cause for suspension of action" must be provided for the grant of a petition to suspend. Petitioner requests that the Director suspend the reexamination proceedings because "ongoing expert discovery may lead to information that Patent Owner would like to provide for the Examiner's consideration in this reexamination." (Petition at page 2.)

Petitioner gives no indication of what information might be anticipated from the discovery and how such information would be material to examination. The Office will not suspend on the basis of speculation that some evidence relevant to examination might be forthcoming. Thus, no showing of "good and sufficient cause" has been alleged, much less shown, and applying a standard analogous to 37 CFR 1.103, no basis for granting the requested stay has been established.

B. In *Ethicon v. Quigg*[2] the Federal Circuit addressed the propriety of the Office suspending reexamination proceedings. The court considered whether the Commissioner had " authority to stay reexamination pending the outcome of district court litigation." [3]

The Federal circuit held that an indefinite suspension, granted under the authority of 37 CFR 1.565(b) was not consistent with the statutory requirement of 35 U.S.C. 305 of conducting reexamination proceedings in the Office with special dispatch.

> "Special dispatch" is not defined in the statute. However, "a fundamental canon of statutory construction is that, unless otherwise defined, words will be interpreted as taking their ordinary, contemporary, common meaning." *Perrin v. United States, 444 U.S. 37, 42, 62 L. Ed. 2d 199, 100 S. Ct. 311 (1979); see LSI Computer Systems, Inc. v. United States Int'l Trade Comm'n, 832 F.2d 588, 590, 4 USPQ2d 1705, 1707 (Fed.Cir. 1987).* According to Webster's New World Dictionary, special means distinctive, unique, exceptional, or extraordinary, and dispatch means to finish quickly or promptly. Consequently, the ordinary, contemporary, and common meaning of special dispatch envisions some type of unique, extraordinary, or accelerated movement. In fact, the PTO itself has interpreted special dispatch to require that "reexamination proceedings will be 'special' throughout their pendency" in the office, and provides for an accelerated schedule. MPEP § 2261. ***Whatever else special dispatch means, it does not admit of an indefinite suspension of reexamination proceedings pending conclusion of litigation.*** If it did, one would expect to find some intimation to that effect in the statute, for it would suggest the opposite of the ordinary meaning. But there is none. [Emphasis added] *(Ethicon, at 1426.)*

The court did not issue a blanket condemnation of suspensions in reexamination proceedings. Instead, the court indicated that the Office may be able to temporarily retard the progress of a particular proceeding in order to coordinate ***Office*** activity. [4] However, *Ethicon* makes it clear that a suspension in the face of the statutory mandate for special dispatch should not be undertaken lightly. The *Ethicon* decision contemplates suspension only for the Commissioner to effectively run the Office or in situations where special considerations of equity come into play.

---

[2] *Ethicon v. Quigg, 849 F.2d 1422 (Fed. Cir. 1988)*

[3] *Id. at 1425*

[4] "..nothing we say here prevents the Commissioner from conducting orderly proceedings within his office so long as he does not violate the statute. Special dispatch in the posited circumstances may call for coordinated activity to resolve issues seriatim, which would not necessarily violate congressional instructions so long as the reexamination was handled with special priority and progressed as quickly as possible. *See* MPEP § § 2283-2285. We hesitate to say more without a case before us." *Ethicon at 1428*

In this instance, patent owner, is not requesting an indefinite stay[5]. However, in light of the guidance provided in the *Ethicon* decision a stay is not appropriate.

The '7416 proceeding was filed over 2 years ago, in February of 2005, and has already undergone significant prosecution. [6] As of December 7, 2006, the proceeding in the Office has been terminated by the issuance of the NIRC and is merely awaiting the administrative act of publication of the reexamination certificate to conclude the proceeding entirely. Petitioner has not provided sufficient cause for the Commissioner further delay the conclusion of this proceeding pending some further submission by the patent owner. It has not been established that it would be equitable to delay the publication of the reexamination certificate. Note that if information developed during the course of the ongoing litigation raises a substantial new question of patentability, then patent owner is free to consider the filing of a new request for reexamination predicated on any such newly developed information.

Accordingly, the petition to suspend the '7416 reexamination proceeding is dismissed.

Jurisdiction over the proceeding is returned to the publication process to await publication of a Reexamination Certificate in due course.

Telephone inquiries related to the present decision should be directed to Pinchus M. Laufer, Legal Advisor, at 571-272-7726, or, in his absence, to the undersigned at 571-272-7710.

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

---

[5] The requested period would not exceed 6 months, and although the reason set forth for the stay may still exist at the expiration of that period, there are no grounds for the Office to believe that a further stay would be requested.

[6] Patent owner submitted a statement, including an amendment, in response to the order granting reexamination, held 3 interviews on the record with the examiner, filed 3 additional responses including amendments, submitted 5 additional Information disclosure statements, and the Office mailed 4 Office actions in this time span of approximately 20 months.

March 26, 2007
C:\kiva\7416_limited-suspend_after_NIRC.wpd

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,417	02/11/2005	4870519	H6875.0000	2274

7590 04/26/2007

Bruce Riter
Law Office of Bruce D. Riter
101 First St, PMB 208
Los Altos, CA 94022

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/26/2007

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

4/26/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

CHARLES E. MILLER
DICKSTEIN SHAPIRO MORIN & OSHINKSKY LLP
1177 AVENUE OF AMERICAS
NEW YORK, NY 10036

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007417
PATENT NO. 4,870,519
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

Bruce Riter LAW OFFICE OF BRUCE D. RITER 101 First St, PMB 208 Los Altos, CA 94022	:	For Patent Owner
Charles E. Miller DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP 1177 Avenue of the Americas New York, NY 10036	:	For Requester
	:	DECISION GRANTING PETITION FOR EXTENSION OF TIME [37 CFR 1.550(c)]
In re: White *Ex Parte* Reexamination Proceeding Control No. 90/007,417 Filed: February 11, 2005 For: US Patent No. 4,870,519	:	

MAILED

APR 26 2007

CENTRAL REEXAMINATION UNIT

This is a decision on the April 23, 2007, patent owner "Petition for Extension of Time Under 37 CFR 1.550 (c)," requesting that the time for responding to the Office action dated April 6, 2007, be extended by two weeks.

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

The petition is granted 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 April 6, 2007, which set a one month date for filing a response thereto. The request for extension is the first request for an extension of time with respect to the outstanding Office action. The petition for extension of time was timely filed on April 23, 2007, together with credit card authorization for the $200.00 petition fee 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 late arrival to the law office of the patent council representing the patent owner of the Office action and the limited time for response justifies the request for a two week extension of time.

Analysis and Findings

On balance, it is considered that the petition explains the "sufficient cause" for why the extension of time should be granted, when considered with the implications of extensive Office action.

Conclusion

1. The patent owner's petition for two-week extension of time in which to file a response to the Office action dated April 6, 2007 is **granted**.

2. The Patent Owner's response is due May 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 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

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

APR 15 2005

S.C. JOHNSON & SON, INC.
1525 HOWE STREET
RACINE WI 53403-2236

In re Wdowik	:
Reexamination Proceeding	:
Control No.: 90/007,418	: PETITION DECISION
Filed: February 11, 2005	:
Patent No.: 5,756,081	:

This is a response to the petition under 37 CFR 1.515(c), filed March 23, 2005, requesting that the Order Denying Reexamination be withdrawn and an Order Granting Reexamination be mailed in the above identified Reexamination Request.

BACKGROUND

Third party Requester filed a first Reexamination Request, Control Number 90/006,845, filed November 6, 2003, which was ordered on February 2, 2004. A first Office action was issued in the reexamination on November 17, 2004, and a reply was filed on January 13, 2005, which amended the claims. One significant amendment was to incorporate the limitations of claim 12 into claim 1. The examiner has not yet responded to Patent Owner's amendment and arguments.

Third party Requester in view of the amendments filed a second reexamination request, Control Number 90/007,418 on February 11, 2005. On March 17, 2005, the examiner denied the second request for reexamination for three general reasons (noted below) each of which third party Requester argues in the petition.

DISCUSSION

M.P.E.P. 2214 states, *inter alia*, as follows:

> If the request is filed by a person other than the patent owner, a certification that a copy of the request papers has been served on the patent owner must be included. **The request should be as complete as possible,** since there is no guarantee that the examiner will consider other prior art when making the decision on the request. Also, if no statement is filed by the patent owner, no later reply or other submission may be filed by the requester in the *ex parte* reexamination proceeding. See also MPEP § 2220.

In the first reexamination request a number of references were brought to the examiner's attention and were found to raise a substantial new question of patentability. At least four different references were applied against claim 1 and claim 12 in the first Office action. Patent Owner replied by amending the claims and arguing the rejection. The amendment specifically incorporated the limitation of claim 12 into claim 1 so as to more narrowly define the particles of the shaving composition as fibers having a length and diameter.

Third party Requester's second reexamination request identifies a new reference, Yu, which teaches incorporation of fibers into a shaving composition. Third party Requester states that the new reference raises a substantial new ground of patentability not addressed in the first request.

The examiner denied the reexamination request on three grounds: 1) the arguments presented are directed to the amended claims in the earlier reexamination request rather than the unamended claims of the patent; 2) Yu alone or in combination does not raise a substantial new question of patentability not already under consideration; and 3) the second reexamination request appeared to be an attempt to participate in the prosecution of the reexamination by third party requester.

Third party requester argues that the new reexamination request was, in essence, directed to the original claims and referenced amended claim 1 only for convenience. While this is true, third party Requester states that Patent Owner argues that this is a limitation that defines over the prior art. This directly occasioned the filing of the second reexamination request according to third party Requester. This is, in effect, a response to Patent Owner's reply to the Office action and thus a participation in the reexamination process by third party Requester which is impermissible. Further, the examiner has had no opportunity to respond to Patent Owner's arguments and amendments or to reassess patentability in view thereof.

The examiner's assessment of the Yu reference is not inappropriate. In view of the examiner's rejection of claim 12 in the initial Office action in the first reexamination, and Patent Owner's amending of claim 1 to incorporate the limitations of claim 12 therein, it is reasonable to assume that the amended claim may still be rejected over the same prior art for the same reasons as before. Should Patent Owner's arguments be persuasive, the examiner is under obligation to further evaluate the cited prior art and conduct further searching, if necessary, to determine whether the claim, as amended, is patentable. However, at the present time the examiner's statement that Yu is not important (i.e. – not necessary for rejection of the claims), is correct. Although the examiner offered no specific reason, it must be presumed that the reference was considered no more than cumulative to the prior art already of record. That a reference may have a more specific teaching of a particular limitation does not mean that it is necessary for determination of patentability or that it is more than cumulative prior art.

M.P.E.P. 2240 has recently been revised to indicate that second requests for reexamination are to be carefully scrutinized to determine whether a truly new substantial question of patentability is being put forth.

> II. SECOND OR SUBSEQUENT REQUEST FILED DURING REEXAMINATION
> If a second or subsequent request for ex parte reexamination is filed (by any party) while a first ex parte reexamination is pending, the presence of a substantial new question of patentability depends on the prior art (patents and printed publications) cited by the second or subsequent requester. If the requester includes in the second or subsequent request prior art which raised a substantial new question in the pending reexamination, **reexamination should be ordered only if the prior art cited raises a substantial new question of patentability which is different than that raised in the pending reexamination proceeding**. If the prior art cited raises the same substantial new question of patentability as that raised in the pending reexamination proceedings, the second or subsequent request should be denied.

This is being generally interpreted to mean a new reference or combination of new references which alone, or in combination with art already of record, raises a new question of patentability which is different than that set forth in a pending reexamination. As noted above, the Yu reference, although addressing more specifically a particular limitation, is not much more than cumulative prior art and is directed to basically the same question of patentability already raised. Requester's footnote at page 6 of the request clearly states that the Yu reference is not being used to supply a missing element from the primary reference, Fowler, but to clarify the teachings thereof. Note also M.P.E.P. 2214, cited above, states that reexamination requests should be as complete as possible in all aspects and with respect to all claims for which a new patentability determination is requested when first filed. It must be presumed that third party Requester know of the Yu reference prior to filing the first reexamination request. As such it should have been cited at that time. Third party Requester gives no reasonable explanation as to why it was not cited then.

The petition to is **DENIED** for the reasons set forth above.

This decision is final and nonappealable. 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

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
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.
90/007,419	02/11/2005	6015917	H-5104/Reexam	2028

25559 7590 12/03/2008

ATMI, INC.
7 COMMERCE DRIVE
DANBURY, CT 06810

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/03/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ATMI, Inc.
7 Commerce Drive
Danbury, CT 06810

(For Patent Owner)

Paul A. Fattibene
2480 Post Road
Southport, CT 06890

(For Requester)

MAILED

DEC 03 2008

CENTRAL REEXAMINATION UNIT

Intellectual Property/Technology Law
P.O. Box 14329
Research Triangle Park, NC 27709

(Courtesy Copy)

In re Bhandari et al
Ex Parte Reexamination Proceeding
Control No. 90/007,419
Filed: February 11, 2005
For: U.S. Patent No. 6,015,917

: **DECISION DISMISSING**
: **PETITION**

This is a decision on the August 4, 2008 patent owner petition under 37 CFR 1.183, "to waive the rules" and to permit entry of "arguments and supporting documents not presented before filing of the Appeal Brief," which is taken as a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 41.33(d) ("the August 4, 2008 patent owner petition").

This decision also addresses the September 28, 2007 patent owner change of correspondence address.

The August 4, 2008 patent owner petition, the September 28, 2007 patent owner change of correspondence address, and the record as a whole are before the Office of Patent Legal Administration for consideration.

The August 4, 2008 patent owner petition under 37 CFR 1.183 is accompanied by the appropriate petition fee of $400 under 37 CFR 1.17(f).

SUMMARY

The prosecution of this reexamination proceeding appears to have been legally terminated as of April 19, 2007. Accordingly, the August 4, 2008 patent owner petition under 37 CFR 1.183 to waive the provisions of 37 CFR 41.33(d) is **dismissed as moot**.

The September 28, 2007 patent owner change of correspondence address is **ineffective**.

BACKGROUND

- On January 18, 2000, U.S. Patent 6,015,917 ("the '917 patent") issued to Bhandari et al.

- On February 11, 2005, a request for *ex parte* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/007,419 ("the '7419 proceeding").

- On April 6, 2005, an order granting the reexamination request was mailed.

- On September 7, 2005, a first Office action on the merits was mailed.

- Prosecution progressed until, on October 18, 2006, a final Office action was mailed.

- On December 18, 2006, the patent owner filed an amendment after final Office action. On page 2 of the cover letter to the December 18, 2006 amendment, the patent owner states that a notice of appeal "is concurrently being filed under separate cover." **Office records fail to reveal, however, that a notice of appeal and appropriate fee were received by the Office on December 18, 2006.**

- On January 12, 2007, an advisory action was mailed, informing the patent owner that the December 18, 2006 amendment fails to comply with 37 CFR 1.530, and that, unless a timely appeal is filed, the '7419 proceeding will be terminated. The advisory action set the period for response to expire four (4) months from the mail date of the October 18, 2006 final rejection.

- On February 20, 2007, the patent owner filed an amendment after final Office action (February 18, 2007 was a Sunday and February 19, 2007 was a federal holiday). On page 2 of the cover letter to the February 20, 2007 amendment, the patent owner states that an appeal brief "is concurrently being filed to perfect the appeal." **Office records fail to reveal, however, that an appeal brief was received by the Office on February 20, 2007.**[1]

- On March 14, 2007, an advisory action was mailed, notifying the patent owner that the February 20, 2007 amendment does not place the application in condition for allowance, and that, unless a timely appeal is filed, the '7419 proceeding will be terminated.[2] The

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[1] The Office's Revenue and Accounting Management database (RAM) does indicate, however, that a $500 fee for an appeal brief was received on February 20, 2007. Office records fail to reveal, however, that an appeal brief was received on February 20, 2007.

[2] The amendment filed on February 20, 2007 fails to comply with 37 CFR 1.530. While the first page of the advisory appears to state that the proposed "compliant" amendment "will be" entered, a careful reading of the entire advisory reveals that the examiner determined that the February 20, 2007 amendment was noncompliant, and that a compliant amendment, **if later filed**, would be entered for the purposes of appeal. The examiner states, on the March 14, 2007 completed form PTOL-467, that for purposes of appeal, the proposed "compliant" amendment (the word "compliant" is penned in) will be entered. The status of the claims, i.e., at the time of entry of a "compliant" amendment, is provided. On page 2 of the advisory action, i.e., the first page of the attachment to the advisory

advisory action set the period for response to expire six (6) months from the mail date of the October 18, 2006 final rejection.

- On April 6, 2007, the patent owner filed an amendment after final Office action. On page 2 of the cover letter to the April 6, 2007 amendment, the patent owner states that a notice of appeal was filed on December 18, 2006, and that an appeal brief was filed on February 20, 2007. However, as pointed out above, **Office records fail to reveal that a notice of appeal was received by the Office on December 18, 2006, or that an appeal brief was received by the Office on February 20, 2007.**

- Also on April 6, 2007, the patent owner filed a "revised" appeal brief.

- On June 4, 2007, an examiner's answer was mailed "in response to the appeal brief filed 4/6/2007."[3]

- Subsequently, prosecution progressed until September 24, 2007, when a final Office action, which reopened prosecution, was mailed.

- On September 28, 2007, the patent owner filed a change of correspondence address in the '7419 proceeding. **Office records fail to reveal, however, that proof of service of the September 28, 2007 change of correspondence address on the third party requester was received by the Office. Office records also fail to reveal that a change of correspondence address was received in the patent file, application no. 09/012,679.**

- On November 26, 2007, the patent owner filed a notice of appeal and appropriate fee, as well as an amendment and response to the September 24, 2007 final Office action (November 24, 2007 was a Saturday).

- On December 21, 2007, an advisory action was mailed.

- On January 28, 2008, the patent owner filed an appeal brief and appropriate fee (January 26, 2008 was a Saturday).

- On April 16, 2008, a notice of non-compliant appeal brief was mailed.

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action, however, the examiner states that the status identifiers for new claims 5-15, as filed in the February 20, 2007 amendment, are incorrect. The examiner further states that "**this non-compliant amendment filed on 2/20/07 would not be entered for purposes of appeal unless the status identifiers were corrected**" (emphasis added). (The Office also notes that the presentation of new claims 5-15 in the February 20, 2007 amendment fails to comply with 37 CFR 1.530(f) due to the failure to underline new claims 5-15). The patent owner subsequently made the appropriate corrections to new claims 5-15 in the April 6, 2007 amendment after final, which was filed in response to the March 14, 2007 advisory. On page 2 of the June 4, 2007 examiner's answer, the examiner states that "the amendment filed with the appeal brief on 4/6/07 is compliant and has been entered." The March 14, 2007 advisory, therefore, indicated that the February 20, 2007 amendment was noncompliant, but a later-filed compliant amendment would be entered if the appropriate corrections were made.

[3] See the sentence appearing at the bottom of the first page of the June 4, 2007 examiner's answer.

- On May 15, 2008, the patent owner filed an appeal brief in response to the April 16, 2008 notice of non-compliant appeal brief, including the arguments and supporting documents not presented before the May 15, 2008 filing of the appeal brief, as well as a petition under 37 CFR 1.183 (and supporting arguments) embedded in the May 15, 2008 appellant brief. A revised appeal brief was also received, from which the arguments and supporting documents not presented before the May 15, 2008 filing of the appeal brief, as well as the 37 CFR 1.183 petition (and supporting arguments), have been redacted.

- On July 7, 2008, a notice of non-compliant appeal brief was mailed, notifying the patent owner that the petition under 37 CFR 1.183, embedded in the May 15, 2008 patent owner appeal brief, must be submitted as a separate paper pursuant to 37 CFR 1.4(c).

- On August 4, 2008, the patent owner filed the present petition under 37 CFR 1.183 "to waive the rules" and to permit entry of "arguments and supporting documents not presented before filing of the Appeal Brief," which is taken as a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 41.33(d) ("the August 4, 2008 patent owner petition").

- Also on August 4, 2008, the patent owner filed an appeal brief, which **again** includes a petition under 37 CFR 1.183 (and supporting arguments) embedded in the August 4, 2008 appeal brief, as well as the arguments and supporting documents not presented before the May 15, 2008 filing of the appeal brief. A revised appeal brief was also received, from which the arguments and supporting documents not presented before the May 15, 2008 filing of the appeal brief, as well as the 37 CFR 1.183 petition (and supporting arguments) have been redacted.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 134(b) provides:

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. 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. . . 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.

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 1.8(b) provides:

In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the U.S. Patent and Trademark Office after . . . the prosecution of a reexamination proceeding is terminated pursuant to § 1.550(d) . . . the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;
(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and
(3) **Includes a statement that attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing, transmission or submission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement. If the correspondence was transmitted via the Office electronic filing system, a copy of an acknowledgment receipt generated by the Office electronic filing system confirming submission may be used to support this statement.**

37 CFR 1.10 provides, in pertinent part:

(e) Any person mailing correspondence addressed as set out in § 1.1(a) to the Office with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS but not received by the Office, may petition the Director to consider such correspondence filed in the Office on the USPS deposit date, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has no evidence of receipt of the correspondence;

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

(3) The petition includes a copy of the originally deposited paper(s) or fee(s) that constitute the correspondence showing the number of the "Express Mail" mailing label thereon, a copy of any returned postcard receipt, a copy of the "Express Mail" mailing label showing the "date-in," a copy of any other official notation by the USPS relied upon to show the date of deposit, and, if the requested filing date is a date other than the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS, a showing pursuant to paragraph (d)(3) of this section that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day; and

(4) The petition includes a statement which establishes, to the satisfaction of the Director, the original deposit of the correspondence and that the copies of the correspondence, the copy of the "Express Mail" mailing label, the copy of any returned postcard receipt, and any official notation entered by the USPS are true copies of the originally mailed correspondence, original "Express Mail" mailing label, returned postcard receipt, and official notation entered by the USPS.

(f) The Office may require additional evidence to determine if the correspondence was deposited as "Express Mail" with the USPS on the date in question.

37 CFR 1.134 provides:

An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.

37 CFR 1.183 provides, in pertinent part:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed.

37 CFR 1.550 provides:

(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.

(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.

(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).

(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,

(1) The delay in filing such response may be excused if it is shown to the satisfaction of the Director that the delay was unavoidable; a petition to accept an unavoidably delayed response must be filed in compliance with § 1.137(a); or

(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).

(f) The reexamination requester will be sent copies of Office actions issued during the *ex parte* reexamination proceeding. 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.

37 CFR 41.31 provides, in pertinent part:

(a) *Who may appeal and how to file an appeal.*

*

*

(3) 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.

*

*

(c) An appeal, when taken, must be taken from the rejection of all claims under rejection which the applicant or owner proposes to contest. Questions relating to matters not affecting the merits of the invention may be required to be settled before an appeal can be considered.

37 CFR 41.37 provides:

(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 503 provides, in pertinent part:

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. The identifying data on the postcard should be so complete as to clearly identify the item for which a receipt is requested. For example, the postcard should identify the applicant's name, application number (if known), confirmation number (if known), filing date, interference number, title of the invention, etc. The postcard should also identify the type of paper being filed, e.g., new application, affidavit, amendment, notice of appeal, appeal brief, drawings, fees, motions, supplemental oath or declaration, petition, etc., and the number of pages being submitted . . .

The postcard receipt will not serve as prima facie evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard "a complete application" or "patent application" will not serve as a proper receipt for each of the required components of an application (e.g., specification (including claims), drawings (if necessary), oath or declaration and the application filing fee) or missing portions . . . if one of the components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as prima facie evidence of receipt of those items.

MPEP 512 IV provides:

IV. ORIGINAL MAILED PAPER NOT DELIVERED

Paragraphs (b) and (c) of 37 CFR 1.8 concern the situation where a paper containing a Certificate was timely deposited in the U.S. mail or transmitted by facsimile, but never received by the U.S. Patent and Trademark Office. In the TCs, all submissions under these paragraphs should be considered and the sufficiency thereof determined by the TC Director. The statement required by 37 CFR 1.8(b)(3) is no longer required to be verified.

37 CFR 1.8(b) permits a party to notify the Office of a previous mailing, or transmitting, of correspondence when a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence. In the event that correspondence may be considered timely filed because it was mailed or transmitted in accordance with 37 CFR 1.8(a), but was not received in the Office after a reasonable amount of time has elapsed, (e.g., more than one month from the time the correspondence was mailed), applicant is not required to wait until the end of the maximum extendable period for reply set in a prior Office action (for the Office to hold the application abandoned) before informing the Office of the previously submitted correspondence. Applicant may notify the Office of the previous mailing or transmission and supply a duplicate copy of the previously mailed or transmitted correspondence and **a statement attesting on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the person signing the statement did not sign the certificate of mailing, then the person signing the statement should explain how they have firsthand knowledge of the previous timely mailing or transmission.** Such a statement should be filed promptly after the person becomes aware that the Office has not received the correspondence. Before notifying the Office of a previously submitted correspondence that appears not to have been received by the Office, applicants are encouraged to check the private Patent Application Information Retrieval (PAIR) System to see if the correspondence has been entered into the application file.

MPEP 513 VII provides, in pertinent part:

PETITION FOR CORRESPONDENCE NEVER RECEIVED

37 CFR 1.10(e) sets forth procedures for filing a petition to the Director to accord a filing date as of the date of deposit with the USPS, where correspondence deposited as "Express Mail" is never received by the Office. Such a petition should:

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

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

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

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

MPEP 2265 provides, in pertinent part (emphasis added):

An extension of time in an *ex parte* reexamination proceeding is requested pursuant to 37 CFR 1.550(c). 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). . .

Ex parte prosecution will be conducted by initially setting either a 1-month or a 2-month shortened period for response, see MPEP § 2263. . . **Any request for an extension of time in a reexamination proceeding to file a notice of appeal to the Board of Patent Appeals and Interferences, a brief or reply brief, or a request for reconsideration or rehearing will be considered under the provisions of 37 CFR 1.550(c)** . . .

Normally, examiners will complete a response to an amendment after final rejection within 5 days after receipt thereof. In those situations where the advisory action cannot be mailed in sufficient time for the patent owner to consider the examiner's position with respect to the amendment after final rejection (or other patent owner paper) and act on it before termination of the prosecution of the proceeding, the granting of additional time to complete the response to the final rejection or to take other appropriate action would be appropriate. See *Theodore Groz & Sohne & Ernst Bechert Nadelfabrik KG v.Quigg*, 10 USPQ2d 1787 (D.D.C. 1988). The additional time should be granted by the examiner, and the time granted should be set forth in the advisory Office action . . . In no case can the period for reply to the final rejection be extended to exceed 6 months from the mailing date of the final rejection. **An appropriate response (e.g., a second or subsequent amendment or a notice of appeal) must be filed within the extended period for response. If patent owner elects to file a second or subsequent amendment, it must place the reexamination in condition for allowance. If the amendment does not place the reexamination in condition for allowance, the prosecution of the reexamination proceeding will stand terminated under 37 CFR 1.550(d) unless an appropriate notice of appeal was filed before the expiration of the response period.**

MPEP 2272 I provides, in pertinent part:

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. . . . It should be noted that the filing of any timely first response to a final rejection (even an informal response or even a response that is not signed) will automatically result in the extension of the shortened statutory period for an additional month. Note further that the patent owner is entitled to know the examiner's ruling on a timely response filed after final rejection before being required to file a notice of appeal. Notification of the examiner's ruling should reach the patent owner with sufficient time for the patent owner to consider the ruling

and act on it. Accordingly, the period for response to the final rejection should be appropriately extended in the examiner's advisory action. See *Theodore Groz & Sohne & Ernst Bechert Nadelfabrik KG v. Quigg,* 10 USPQ2d 1787 (D.D.C. 1988). The period for response may not, however, be extended to run past 6 months from the date of the final rejection.

MPEP 2273 provides, in pertinent part:

The period for filing the notice of appeal is the period set for response in the last Office action which is normally 2 months. The timely filing of a first response to a final rejection having a shortened statutory period for response is construed as including a request to extend the period for response an additional month, even if an extension has been previously granted, as long as the period for response does not exceed 6 months from the date of the final rejection. 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. . . If the patent owner does not timely file a notice of appeal and/or does not timely file the appropriate appeal fee . . . The reexamination prosecution is then terminated, and a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) will subsequently be issued indicating the status of the claims at the time of final rejection (or after the second rejection of the claims, where an appeal was taken from that action without waiting for a final rejection). See MPEP §2287.

MPEP 2274 provides, in pertinent part:

II. TIME FOR FILING APPEAL BRIEF
The time for filing the appeal brief is 2 months from the date of the appeal.

III. EXTENSION OF TIME FOR FILING APPEAL BRIEF
In the event that the patent owner finds that he or she is unable to file a brief within the time allowed by the rules, he or she may file a petition with the appropriate extension of time fee, to the Central Reexamination Unit (CRU) or Technology Center (TC), requesting additional time (usually 1 month), and give reasons for the request. The petition should contain the address to which the response is to be sent. If **sufficient** cause is shown and the petition is filed prior to the expiration of the period sought to be extended (37 CFR 1.550(c)), the CRU or TC Director is authorized to grant the extension for up to 1 month. Requests for extensions of time for more than 1 month will also be decided by the CRU or TC Director, but will not be granted unless extraordinary circumstances are involved; e.g., death or incapacitation of the patent owner. The time extended is added to the last calendar day of the original period, as opposed to being added to the day it would have been due when said last day is a Saturday, Sunday, or Federal holiday.

IV. FAILURE TO TIMELY FILE APPEAL BRIEF
Failure to file the brief and/or the appeal brief fee within the permissible time will result in dismissal of the appeal. Form PTOL-468 is used to notify the patent owner that the appeal is dismissed. The reexamination prosecution is then terminated, and a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) (see MPEP § 2287) will subsequently be issued indicating the status of the claims at the time of appeal.

DECISION

The August 4, 2008 Patent Owner Petition under 37 CFR 1.183 is Moot

The prosecution of the '7419 *ex parte* reexamination proceeding appears to have been legally terminated as of April 19, 2007, for failure to timely file a proper response to the October 18, 2006 final Office action, as discussed in detail below. The Office cannot consider granting relief in a proceeding which is not pending.

Accordingly, the August 4, 2008 patent owner petition is **dismissed as moot**.

The '7419 Proceeding Appears To Have Been Legally Terminated As Of April 19, 2007

The October 18, 2006 final Office action, which finally rejected the claims, set a two-month shortened statutory period for response. This period for response was automatically extended by one month (if no notice of appeal had been filed),[4] because the patent owner timely filed a first amendment after final rejection on December 18, 2006.[5] This period for response was further set to expire four months after the mail date of the final Office action by a first advisory action.[6] Subsequently, the patent owner timely filed a second amendment after final on February 20, 2007.[7] The time period for response was again set to expire six months after the mail date of the final Office action by a second advisory action.[8]

To maintain pendency and avoid termination, the patent owner was required to file,[9] on or before the six-month statutory due date of April 18, 2007, either a proper response to the October 18, 2006 final Office action that places the patent in a condition where all of the pending claims are patentable, or a notice of appeal and appropriate fee.[10] Office records fail to reveal, however, that such a response, or a notice of appeal and appropriate fee, were received on or before April 18, 2007.

The patent owner states that a notice of appeal "is concurrently being filed under separate cover" on page 2 of the cover letter to the December 18, 2006 after final amendment. Office records fail to reveal, however, that a notice of appeal was received by the Office on December 18, 2006. Furthermore, the certificate of service received on December 18, 2006 fails to specifically certify that a notice of appeal was served on the third party requester.[11]

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[4] Office records fail to reveal that a notice of appeal and appropriate fee were timely received in response to the October 18, 2006 final Office action, as discussed *infra*.

[5] If a response to a final rejection is timely filed, the time period for response to a final rejection is automatically extended by one month, if the response is a first response after final rejection, and if a notice of appeal has not yet been filed. See MPEP 2272 I.

[6] See the January 12, 2007 (first) advisory action, which responded to the December 18, 2006 patent owner amendment.

[7] The time period for response to the January 12, 2007 advisory action expired on or after February 21, 2007, since February 18, 2007 was a Sunday and February 19, 2007 was a federal holiday.

[8] See the March 14, 2007 (second) advisory action, which responded to the February 20, 2007 patent owner amendment.

[9] See 37 CFR 1.550(d) and 37 CFR 41.31(a)(3).

[10] See also MPEP 2265 I, which states, in pertinent part: "If the [second or subsequent amendment after final action] does not place the reexamination in condition for allowance, the prosecution of the reexamination proceeding will stand terminated under 37 CFR 1.550(d) unless an appropriate notice of appeal was filed before the expiration of the response period.

[11] The December 18, 2006 certificate of service separately lists, as "enclosures" after the signature block, a "Response to the October 18, 2006 Office Action," a "Notice of Appeal," and an "Information Disclosure Statement." The body of the certificate of service, however, specifically certifies only that only one of the three enclosures, i.e., the "Response to the October 18, 2006 Office Action," was served on the third party requester. Furthermore, Office records fail to reveal that either a notice of appeal, or an information disclosure statement, were received on December 18, 2006.

The patent owner further states that "[a]n [a]ppeal [b]rief is concurrently being filed to perfect the appeal" on page 2 of the cover letter to the February 20, 2007 after final amendment. [12] Office records fail to reveal, however, that an appeal brief was received by the Office on February 20, 2007. Furthermore, the certificate of service received on February 20, 2007 fails to certify that an appeal brief was served on the third party requester, and also fails to identify an appeal brief in the list of enclosures.

For the reasons given above, pendency does not appear to have been maintained after April 18, 2007.

Accordingly, the prosecution of the '7419 *ex parte* reexamination proceeding appears to have been legally terminated on April 19, 2007. To avoid termination, any response to this decision filed by the patent owner must include:

A. A petition under 37 CFR 1.137(a) or (b)[13] to revive an unavoidably or unintentionally terminated reexamination proceeding, and the appropriate petition fee, accompanied by either a notice of appeal and appropriate fee, or an amendment that places the patent in a condition where all pending claims are patentable,[14] and proof of service of these documents on the third party requester pursuant to 37 CFR 1.550(f) or 37 CFR 1.248,[15] **or**

B. Evidence of the timely Office receipt, on or before April 18, 2007, of:

1. A proper amendment to the final October 18, 2006 Office action, which places the patent in a condition where all pending claims are patentable, and proof of service of this amendment on the third party requester pursuant to 37 CFR 1.550(f) and 37 CFR 1.248, **or**

2. A notice of appeal and appropriate fee pursuant to 37 CFR 41.31(a)(3), and proof of service of this notice of appeal on the third party requester pursuant to 37 CFR 1.550(f) and 37 CFR 1.248, **and**

a) Evidence of the timely Office receipt, within two months after the filing of the notice of appeal pursuant to paragraph B(2) above, of:

i) An appeal brief and appropriate fee pursuant to 37 CFR 41.37, and proof of service of this appeal brief on the third party requester pursuant to 37 CFR 1.550(f) and 37 CFR 1.248, **or**

ii) A petition for extension of time to file an appeal brief and appropriate petition fee pursuant to 37 CFR 1.550(c), and of proof of service of this

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[12] In addition, the patent owner again stated that a notice of appeal and appeal brief were filed on December 18, 2006 and February 20, 2007, respectively, on, for example, page 2 of the April 6, 2007 amendment and page 2 of the April 6, 2007 appeal brief.
[13] See 37 CFR 1.550(e).
[14] See 711.03(c) II A 2 (b)
[15] See also MPEP 2266.03.

petition on the third party requester pursuant to 37 CFR 1.550(f) and 37 CFR 1.248.

Evidence of the timely filing of the above-described documents is required to show that pendency was maintained after April 18, 2007. For example, to maintain pendency, if the patent owner presents evidence that the Office received a notice of appeal and appropriate fee on December 18, 2006, then the patent owner must also present evidence that either an appeal brief, or a petition under 37 CFR 1.550(c) for an extension of time to file an appeal brief, and appropriate fee(s) were timely filed on or before February 20, 2007.[16]

If the patent owner does not timely file appropriate evidence of the timely Office receipt of the above-described documents in response to this decision, i.e., if the patent owner timely files a petition under 37 CFR 1.137(a) or (b) in response to this decision, or if no response to this decision is timely received, all Office actions mailed after April 18, 2007 will be vacated.[17] In addition, if no response to this decision is timely received, the prosecution of the '7419 proceeding will be terminated, and a notice of intent to issue a reexamination certificate (NIRC) in accordance with the October 18, 2006 final Office action will be mailed in due course.

Any evidence of Office receipt should be submitted pursuant to 37 CFR 1.8(b), if the papers were filed with a certificate of mailing, or pursuant to 37 CFR 1.10(e), if the papers were filed by United States Postal Service (USPS) Express Mail. Any evidence of Office receipt should also include, if available, a postcard receipt stamped by the Office.[18] If the papers were filed with a certificate of mailing or transmission pursuant to 37 CFR 1.8,[19] the patent owner is reminded to include a statement pursuant to 37 CFR 1.8(b)(3) in any response to this decision. See MPEP 512 IV. [20] If the papers were filed by USPS Express Mail, then any response to this decision may include a petition under 37 CFR 1.10(e). As expressly stated in MPEP 513 VII, any petition under 37 CFR 1.10(e) should:

> "(A) Be filed promptly after the person becomes aware that the Office has no evidence of receipt of the correspondence;
>
> "(B) Include a showing that the number of the "Express Mail" mailing label was placed on each piece of correspondence prior to the original mailing;

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[16] See 37 CFR 41.37(a) and (b).

[17] For example, the June 4, 2007 examiner's answer, the September 24, 2007 final Office action, the December 21, 2007 advisory action, the April 16, 2008 notice of non-compliant appeal brief, and the July 7, 2008 notice of non-compliant appeal brief, would be vacated.

[18] See MPEP 503.

[19] Regarding express mail certificates, "first class mail" within the meaning of 37 CFR 1.8(a)(1)(i)(A), is interpreted as including "Express Mail" and "Priority Mail" deposited with the USPS. See MPEP 512 I (F). If the papers were filed with a certificate of mailing by USPS Express Mail, i.e., an Express Mail Certificate, the patent owner is also reminded to include a statement pursuant to 37 CFR 1.8(b)(3) in any response to this decision.

[20] MPEP 512 IV provides, in pertinent part: "**a statement attesting on a personal knowledge basis . . . to the previous timely mailing or transmission** [should be supplied]. **If the person signing the statement did not sign the certificate of mailing, then the person signing the statement should explain how they have firsthand knowledge of the previous timely mailing or transmission.**"

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

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

Additional Discussion

The Office notes that the patent owner fails to specifically identify, in the present petition under 37 CFR 1.183 to waive the provisions of 37 CFR 41.33(d), which documents the patent owner wishes the Office to enter. Furthermore, the Office notes that the patent owner fails to provide a showing of good and sufficient reasons why this evidence is necessary and was not earlier presented.[21] If termination of the prosecution of this proceeding is avoided by the filing of appropriate evidence of the timely Office receipt of the above-described documents pursuant to this decision, the patent owner is reminded that any future petition under 37 CFR 1.183 to waive the provisions of 37 CFR 41.33(d), filed in this proceeding, must specifically identify any documents that patent owner wishes the Office to enter, and must provide a showing of good and sufficient reasons why this evidence is necessary and was not earlier presented.

Furthermore, if termination of the prosecution of this proceeding is avoided by the filing of appropriate evidence of the timely Office receipt of the above-described documents pursuant to this decision, the patent owner is reminded that an appeal brief must not include a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 41.33(d) embedded within it. Different matters may be considered by different branches or sections of the Office, and any petitionable matter is

[21] See, for example, 37 CFR 41.33(d)(1). It appears, from what can be understood of the present petition, that the patent owner essentially urges that the STA plots and Alen dissertation, which were filed with the "revised appeal brief" (which apparently refers to the May 15, 2008 appeal brief) were not earlier presented, because the deficiency of the December 18, 2006 Chongying Xu declaration under 37 CFR 1.132, which this evidence is presented to rebut, was not discussed by the examiner until after a point in the prosecution where the rules do not permit the entry of additional arguments and supporting evidence. The December 18, 2006 Chongying Xu declaration, however, was specifically addressed in the advisory action of January 12, 2007. After the mailing of the January 12, 2007 advisory action and prior to the filing of the January 28, 2008 appeal brief, the patent owner has submitted no less than four responses after final Office action in 2007, i.e., on February 20, April 6, August 2, and November 26, respectively, in addition to an appeal brief on April 6, 2007, and a notice of appeal on November 26, 2007. The patent owner fails to explain why the STA plots and Alen dissertation were not presented with any of the earlier filed responses after final Office action, in addition to the April 6, 2007 appeal brief, or the November 26, 2007 notice of appeal. In particular, the patent owner clearly had numerous opportunities to file the STA plots and the Alen dissertation with the April 6, 2007 appeal brief, with the November 26, 2007 notice of appeal, and especially with the August 2, 2007 amendment after final Office action, in which the patent owner requested the Office to reopen prosecution (and in response to which prosecution was reopened). The patent owner has provided no explanation for the failure to submit the STA plots and the Alen dissertation with any of these earlier-filed papers.

generally not appealable. Such a petition must be filed as a separate paper pursuant to 37 CFR 1.4(c).[22]

The September 28, 2007 Change of Correspondence Address is Ineffective

On September 28, 2007, the patent owner filed a change of correspondence address in the '7419 proceeding. The official correspondence address of record for the patent owner in a reexamination proceeding, however, is the correspondence address as recorded in the patent file.[23] Office records fail to reveal that a change of correspondence address was received in the patent file, application no. 09/012,679. In the present case, the official correspondence address of record for the patent owner, as recorded in the patent file, application no. 09/012, 679, is ATMI, Inc., 7 Commerce Drive, Danbury, CT 06810. In addition, Office records fail to reveal that a proof of service on the third party requester of the September 28, 2007 patent owner change of correspondence address, pursuant to 37 CFR 1.550(f) and 37 CFR 1.248, was received by the Office.

A courtesy copy of this decision will be mailed to the correspondence address indicated on the September 28, 2007 patent owner change of correspondence address. **In the absence of a proper submission of a change of correspondence address for the patent owner in the patent file, application no. 09/012,679, however, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence addresses of record for the patent owner and for the third party requester.**

CONCLUSION

- The August 4, 2008 patent owner petition under 37 CFR 1.183 to waive the provisions of 37 CFR 41.33(d) is **dismissed as moot**.

- Any response pursuant to this decision must be filed within **one (1) month** of the mail date of this decision, and must be accompanied by proof of service of this response on the third party requester pursuant to 37 CFR 1.550(f) and 37 CFR 1.248.

- If the patent owner does not timely file appropriate evidence of the timely Office receipt of the documents described in this decision, i.e., if the patent owner timely files a petition under 37 CFR 1.137(a) or (b) in response to this decision, or if no response to this decision is timely received, all Office actions mailed after April 18, 2007 will be **vacated**. In addition, if no response to this decision is timely received, prosecution of this reexamination proceeding will be **terminated** as of April 19, 2007, and a notice of

[22] The Office notes that the patent owner filed an appeal brief that contained BOTH new evidence (and supporting arguments) AND a petition embedded within it, and an appeal brief from which BOTH the new evidence (and supporting arguments) AND the embedded petition were redacted. For future reference, any grantable petition under 37 CFR 1.183 to waive the provisions of 37 CFR 41.33(d), and to enter evidence newly presented on appeal, must be accompanied by an appeal brief that includes the new evidence (and supporting arguments), but does NOT include an embedded petition. In this instance, however, a grantable petition has not been received (see footnote 21).

[23] See 37 CFR 1.33(c) and MPEP 2222.

intent to issue a reexamination certificate (NIRC) in accordance with the October 18, 2006 final Office action will be mailed in due course.

- The September 28, 2007 change of correspondence address filed in this reexamination proceeding is **ineffective**. A courtesy copy of this decision will be mailed to the correspondence address indicated on the September 28, 2007 patent owner change of correspondence address. In the absence of a proper submission of a change of correspondence address for the patent owner in the patent file, application no. 09/012,679, however, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence addresses of record for the patent owner and for the third party requester.

- Jurisdiction over this proceeding is being retained by the Office of Patent Legal Administration, pending a response to the decision, or the expiration of time for response to this decision.

- All correspondence relating to this petition in this *ex parte* reexamination proceeding should be directed to:

By EFS: Registered users may submit via the electronic filing system EFS-Web, at https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html.

By Mail To: Mail Stop "*Ex Parte* Reexam"
ATTN: 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

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 communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,419	02/11/2005	6015917	H-5104/Reexam	2028

23448 7590 09/29/2009

INTELLECTUAL PROPERTY / TECHNOLOGY LAW
PO BOX 14329
RESEARCH TRIANGLE PARK, NC 27709

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/29/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
PAUL A. FATTIBENE, ESQ., FATTIBENE & FATTIBENE
2480 POST ROAD
SOUTHPORT, CT 06890

Date: MAILED
SEP 2 9 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007419
PATENT NO. : 6015917
ART UNIT : 3900

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ATMI, Inc.
7 Commerce Drive
Danbury, CT 06810

(For Patent Owner)

MAILED

SEP 29 2009

CENTRAL REEXAMINATION UNIT

Paul A. Fattibene
2480 Post Road
Southport, CT 06890

(For Requester)

Intellectual Property/Technology Law
P.O. Box 14329
Research Triangle Park, NC 27709

(Courtesy Copy)

In re Bhandari et al
Ex Parte Reexamination Proceeding
Control No. 90/007,419
Filed: February 11, 2005
For: U.S. Patent No. 6,015,917

: **DECISION**
: **GRANTING**
: **PETITION**

This is a decision on the January 2, 2009 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding ("the January 2, 2009 patent owner petition to revive").

This decision also addresses:

- the amendment and other evidence filed on January 2, 2009,
- the August 4, 2008 appeal brief, and
- the June 17, 2009 patent owner power of attorney and change of correspondence address.

The January 2, 2009 patent owner petition, the amendment and other evidence filed on January 2, 2009, the August 4, 2008 appeal brief, the June 17, 2009 patent owner power of attorney and change of correspondence address, and the record as a whole are before the Office of Patent Legal Administration for consideration.

The petition fee of $1620 set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b) has been received.

SUMMARY

The January 2, 2009 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.

The amendment and other evidence filed on January 2, 2009 **will not be entered**. The August 4, 2008 appeal brief is **defective**. The June 17, 2009 patent owner power of attorney and change of correspondence address is **ineffective**. The June 22, 2009 "Notice of Acceptance of Power of Attorney" and a "Notice Regarding Change of Power of Attorney" are **vacated**.

BACKGROUND

- On January 18, 2000, U.S. Patent 6,015,917 ("the '917 patent") issued to Bhandari et al.
- On February 11, 2005, a request for *ex parte* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/007,419 ("the '7419 proceeding").
- On April 6, 2005, an order granting the reexamination request was mailed.
- On September 7, 2005, a first Office action on the merits was mailed.
- Prosecution progressed until, on October 18, 2006, a final Office action was mailed.
- On December 18, 2006, the patent owner filed an amendment after final Office action. On page 2 of the cover letter to the December 18, 2006 amendment, the patent owner states that a notice of appeal "is concurrently being filed under separate cover." Office records fail to reveal, however, that a notice of appeal and appropriate fee were received by the Office on December 18, 2006.
- On January 12, 2007, an advisory action was mailed, setting the period for response to expire four (4) months from the mail date of the October 18, 2006 final rejection.
- On February 20, 2007, the patent owner filed an amendment after final Office action (February 18, 2007 was a Sunday and February 19, 2007 was a federal holiday). On page 2 of the cover letter to the February 20, 2007 amendment, the patent owner states that an appeal brief "is concurrently being filed to perfect the appeal." Office records fail to reveal, however, that an appeal brief was received by the Office on February 20, 2007.
- Subsequently, prosecution progressed until September 24, 2007, when a final Office action, which reopened prosecution, was mailed.
- On November 26, 2007, the patent owner filed a notice of appeal and appropriate fee, as well as an amendment and response to the September 24, 2007 final Office action (November 24, 2007 was a Saturday).
- On December 21, 2007, an advisory action was mailed.
- On January 28, 2008, the patent owner filed an appeal brief (January 26, 2008 was a Saturday).
- On April 16, 2008, a notice of non-compliant appeal brief was mailed.
- On May 15, 2008, the patent owner filed an appeal brief.

- On July 7, 2008, a notice of non-compliant appeal brief was mailed.

- On August 4, 2008, the patent owner filed a petition under 37 CFR 1.183 "to waive the rules" and to permit entry of "arguments and supporting documents not presented before filing of the Appeal Brief," which is taken as a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 41.33(d) ("the August 4, 2008 patent owner petition").

- Also on August 4, 2008, the patent owner filed an appeal brief.

- On December 3, 2008, a decision dismissing the August 4, 2008 patent owner petition was mailed.

- On January 2, 2009, the patent owner filed the present petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding ("the January 2, 2009 patent owner petition to revive"). The January 2, 2009 patent owner petition to revive is accompanied by a notice of appeal, as well as an amendment, a declaration under 37 CFR 1.132 of Mr. Chongying Xu, a two-page document containing graphs ("the STA plots") and an excerpt (page 24) from a document by Petra Alen entitled "Atomic Layer Deposition of TaN, NbN, and MoN Films for Cu Metallizations" ("the Alen dissertation").

- On June 17, 2009, the patent owner filed a power of attorney and change of correspondence address.

- On June 22, 2009, a "Notice of Acceptance of Power of Attorney" and a "Notice Regarding Change of Power of Attorney" were mailed by the Office.

DECISION

The January 2, 2009 Patent Owner Petition Under 37 CFR 1.137(b) Is Granted

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) a response[1] 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 and a proper statement under 37 CFR 1.137(b)(3) have been submitted with the January 2, 2009 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Regarding item (1), the previous decision, mailed on December 3, 2008, stated that if a petition under 37 CFR 1.137(a) or (b) was filed in response to the December 3, 2008 decision, the petition must be accompanied by either a notice of appeal and appropriate fee, or an amendment that places the patent in condition in which all pending claims are patentable. The decision also

[1] In *ex parte* reexamination proceedings, the word "reply" is replaced by "response" to avoid confusion with the "reply" that may be filed by a third party requester under 37 CFR 1.535. See, for example, 37 CFR 1.550, subsections (b), (d), and (e).

stated that if a petition under 37 CFR 1.137(a) or (b) was filed, all Office actions mailed in this proceeding after April 18, 2007 would be vacated.[2] Upon reconsideration, however, no Office actions previously mailed in this proceeding will be vacated as a result of the termination of this proceeding. Because the present proceeding is revived, all papers that would have been proper but for the unintentional termination of the proceeding on April 19, 2007, are deemed to be proper. For this reason, the notice of appeal and appropriate fee filed on November 26, 2007 satisfy item (1) above, i.e., the response requirement of 37 CFR 1.137(b),[3] and the January 2, 2009 notice of appeal is moot.

Accordingly, the January 2, 2009 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.

The Amendment and Other Evidence Submitted on January 2, 2009 Will Not Be Entered

Regarding the amendment,[4] the excerpt (page 24) from the Petra Alen dissertation, and the documents containing graphs, which are designated as the "STA plots", these papers will not be entered as discussed in the attached advisory action by the examiner. The patent owner is also cautioned that if a petition under 37 CFR 1.183 is later filed to waive the provisions of 37 CFR 41.33(d) and to request entry of the STA plots and the excerpt from the Alen dissertation, the patent owner must provide a showing of the extraordinary circumstances such that justice requires the entry of these documents.[5]

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[2] See pages 11-12 and 14 of the December 3, 2008 decision dismissing the August 4, 2008 patent owner petition.

[3] See MPEP 2268 IV and MPEP 711.03(c) II A 2 (b).

[4] On page 15 of the remarks which accompany the January 2, 2009 amendment, the patent owner states that "it has evidence, in the form of fax cover sheets . . . that the December 18, 2006 Notice of Appeal was received by the U.S. Patent and Trademark Office, that the February 20, 2007 Appeal Brief was received by the U.S. Patent and Trademark Office . . ." The patent owner also states that "there appears to be ample evidence the documents lost at the U.S.. Patent and Trademark Office were timely and properly submitted." The patent owner, however, has not provided the evidence described.

[5] See, for example, 37 CFR 41.33(d)(1). As stated in the December 3, 2008 decision, it appears, from what can be understood of the August 4, 2008 petition, that the patent owner essentially urges that the STA plots and Alen dissertation, which were filed with the "revised appeal brief" (which apparently refers to the May 15, 2008 appeal brief) were not earlier presented, because the deficiency of the December 18, 2006 Chongying Xu declaration under 37 CFR 1.132, which this evidence is presented to rebut, was not discussed by the examiner until after a point in the prosecution where the rules do not permit the entry of additional arguments and supporting evidence. The December 18, 2006 Chongying Xu declaration, however, was specifically addressed in the advisory action of January 12, 2007. After the mailing of the January 12, 2007 advisory action and prior to the filing of the January 28, 2008 appeal brief, the patent owner has submitted no less than four responses after final Office action in 2007, i.e., on February 20, April 6, August 2, and November 26, respectively, in addition to an appeal brief on April 6, 2007, and a notice of appeal on November 26, 2007. The patent owner fails to explain why the STA plots and Alen dissertation were not presented with any of the earlier filed responses after final Office action, in addition to the April 6, 2007 appeal brief, or the November 26, 2007 notice of appeal. In particular, the patent owner clearly had numerous opportunities to file the STA plots and the Alen dissertation with the April 6, 2007 appeal brief, with the November 26, 2007 notice of appeal, and especially with the August 2, 2007 amendment after final Office action, in which the patent owner requested the Office to reopen prosecution (and in response to which prosecution was reopened). The patent owner has provided no explanation for the failure to submit the STA plots and the Alen dissertation with any of these earlier-filed papers.

The August 4, 2008 Appeal Brief Is Defective

The appeal brief filed on August 4, 2008 is defective. Specifically, the appeal brief filed on August 4, 2008 contains arguments and supporting documents not presented before the filing of the May 15, 2008 original version of the appeal brief. Reference to this unentered evidence is not permitted in the brief. See MPEP 1205.02 (ix).

The August 4, 2008 appeal brief also contains a petition under 37 CFR 1.183 embedded in the brief. Different matters may be considered by different branches or sections of the Office, however,and any petitionable matter is generally not appealable. Such a petition must be filed as a separate paper pursuant to 37 CFR 1.4(c).

In addition, the August 4, 2008 appeal brief includes, *as an appendix*, an appeal brief from which the arguments and supporting documents not presented before the May 15, 2008 filing of the appeal brief, as well as the 37 CFR 1.183 petition (and supporting arguments), have been redacted. Because this redacted appeal brief is filed *as an appendix,* however, it is not clear whether this paper is meant to be separately filed. An appeal brief must be filed as a separate paper.

For the reasons given above, the August 4, 2008 appeal brief is **defective**.

If the patent owner files an amended brief in response to this decision which does not overcome all of the reasons for non-compliance stated in this decision, the appeal will stand dismissed. See 37 CFR 41.37(d).

The June 17, 2009 Patent Owner Power of Attorney and Change of Correspondence Address Is Ineffective

On June 17, 2009, the patent owner filed a power of attorney and change of correspondence address in the '7419 proceeding.[6] As expressly stated in the previous decision mailed December 3, 2008,[7] however, the official correspondence address of record for the patent owner in this reexamination proceeding is the correspondence address as recorded in the patent file, application no. 09/012,679.[8] The patent owner has filed the power of attorney and change of correspondence address in the reexamination proceeding, but has not filed this paper in the patent file, application no. 09/012,679, as required by the rules. In the present case, the official correspondence address of record for the patent owner, as recorded in the patent file, application no. 09/012, 679, is ATMI, Inc., 7 Commerce Drive, Danbury, CT 06810. The attorney of

[6] The patent owner is cautioned that a power of attorney (37 CFR 1.32(b)(4)) to a patent practitioner to prosecute a patent application executed by the applicant or the assignee of the entire interest does not make that practitioner an official of an assignee or empower the practitioner to sign the submission under 37 CFR 3.73(b) on behalf of the assignee. See MPEP 324. Therefore, while the rules permit a patent practitioner to sign the submission under 37 CFR 3.73(b) if the statement under 37 CFR 3.73(b) states that the person signing is authorized (or empowered) to act on behalf of the assignee, the patent practitioner is reminded that this statement refers to a practitioner who, in addition to a power of attorney, also has apparent authority to sign on behalf of the organization.

[7] See the statement in bold on page 14, and the first full bullet on page 15, of the December 3, 2008 decision.

[8] See 37 CFR 1.33(c) and MPEP 2222.

record for the patent owner, as recorded in the patent file, are the attorneys listed under customer no. 25559, for ATMI, Inc.

A "Notice of Acceptance of Power of Attorney" and a "Notice Regarding Change of Power of Attorney" were inadvertently mailed on June 22, 2009 in response to the June 17, 2009 power of attorney. These notices are hereby **vacated** as erroneous. Any inconvenience is regretted.

A courtesy copy of this decision will be mailed to the correspondence address indicated on the June 17, 2009 patent owner change of correspondence address. In the absence of a proper submission of a change of correspondence address for the patent owner in the patent file, application no. 09/012,679, however, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence addresses of record for the patent owner and for the third party requester.

CONCLUSION

- The January 2, 2009 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.

- The amendment and other evidence, including the papers designated as "STA plots" and the excerpt (page 24) of the Alen dissertation, **will not be entered** as discussed in the attached advisory action.

- The August 4, 2008 appeal brief is **defective**.

- The time period for filing an amended appeal brief is set to run **one (1) month, or thirty days, whichever is longer,** from the mail date of this decision. If an amended brief is not timely submitted, the **appeal will be dismissed** as of the expiration of the period for reply to this decision. Extensions of this time period may only be obtained under 37 CFR 1.550(c).

- If the amended brief does not overcome all of the reasons for non-compliance stated in this decision, the **appeal will stand dismissed** pursuant to 37 CFR 41.37(d).

- The June 17, 2009 change of correspondence address filed in this reexamination proceeding is **ineffective**. The June 22, 2009 notice of acceptance of power of attorney and the notice regarding change of power of attorney are **vacated**. A courtesy copy of this decision will be mailed to the correspondence address indicated on the June 17, 2009 patent owner change of correspondence address. In the absence of a proper submission of a change of correspondence address for the patent owner in the patent file, application no. 09/012,679, however, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence addresses of record for the patent owner and for the third party requester.

- Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit to await the Office receipt of any amended brief filed in response to this decision.

- All correspondence relating to this petition in this *ex parte* reexamination proceeding should be directed to:

By Mail: Mail Stop "*Ex Parte* Reexam"
ATTN: Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

By hand: Customer Service Window
ATTN: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

- Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Evelyn Huang, at (571) 272-0686.

- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724.

Kenneth M. Schor

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

Attachment: Advisory Action

Ex Parte Reexamination Advisory Action *Before the Filing of an Appeal Brief*	**Control No.** 90/007,419	**Patent Under Reexamination** 6015917	
	Examiner EVELYN HUANG	**Art Unit** 3991	

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

THE PROPOSED RESPONSE FILED *02 January 2009* FAILS TO OVERCOME ALL OF THE REJECTIONS IN THE FINAL REJECTION MAILED *24 September 2007*.

1. ☐ Unless a timely appeal is filed, or other appropriate action by the patent owner is taken to overcome all of the outstanding rejection(s), this prosecution of the present *ex parte* reexamination proceeding WILL BE TERMINATED and a Notice of Intent to Issue *Ex Parte* Reexamination Certificate will be mailed in due course. Any finally rejected claims, or claims objected to, will be CANCELLED.

   THE PERIOD FOR RESPONSE IS EXTENDED TO RUN _____ MONTHS FROM THE MAILING DATE OF THE FINAL REJECTION. Extensions of time are governed by 37 CFR 1.550(c).

NOTICE OF APPEAL

2. ☒ An Appeal Brief is due two months from the date of the Notice of Appeal filed on *1/2/09* to avoid dismissal of the appeal. See 37 CFR 41.37(a). Extensions of time are governed by 37 CFR 1.550(c). See 37 CFR 41.37(e).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final action, but prior to the date of filing a brief, will not be entered because:
   (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☒ They are not deemed to place the proceeding in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.
   NOTE: *see attachment* (See 37 CFR 1.116 and 41.33(a)).
4. ☐ Patent owner's proposed response filed _____ has overcome the following rejection(s):_____
5. ☐ The proposed new or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☒ For purposes of appeal, the proposed amendment(s) a)☒ will not be entered, or b)☐ will be entered and an explanation of how the new or amended claim(s) would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) patentable and/or confirmed: _____
   Claim(s) objected to: *9,10 and 15*
   Claim(s) rejected: *1-10 and 15*
   Claim(s) not subject to reexamination: *11-14*

AFFIDAVIT OR OTHER EVIDENCE

7. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because patent owner failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
8. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence fails to overcome all rejections under appeal and/or appellant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
9. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

10. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
11. ☐ Note the attached Information Disclosure Statement(s), PTO/SB/08, Paper No(s) _____.
12. ☒ Other: *see attachment.*

EVELYN M. HUANG PRIMARY EXAMINER CRU - AU 3991	PADMASHRI PONNALURI PRIMARY EXAMINER CRU - AU 3991	SPE, Art Unit 3991

cc: Requester (if third party requester)

Attachment to Advisory Action

1. The amendment filed on 1/2/2009 will not be entered for the following reasons:

   a. The new limitation introduced in claim 5 would require further consideration and may raise new issues.

   b. The amendment fails to place the proceeding in better form for appeal by reducing or simplifying the issues for appeal.

   c. The amendment presents 4 additional new claims without cancelling a corresponding number of finally rejected claims.

2. 2. The affidavit or other evidence (the STA plots and page 24 of the Petra Alen Academic Dissertation) filed after a final action, but on the date of filing a Notice of Appeal will not be entered because Patent Owner fails to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented, particularly when the Dissertation was published in 2005. Further, the STA plots are not presented in the form of a Declaration and are thus have no probative value. Even if the plots were presented in the form of a Declaration, they still would be insufficient to overcome the rejections. Particularly, there is no description of how the plots were obtained and no explanation of the data, which apparently was obtained by different operators four years apart, and under different conditions.

3. The amendment fails to overcome the following rejections, which would be maintained for reasons of record.

a. The rejection for claim 1 under 35 U.S.C. 103(a) over Jain (paragraph 8 of the 9/24/07 final rejection).

b. The rejection for claims 1 and 5 under 35 U.S.C. 103(a) over Sun (paragraph 10 of the 9/24/07 final rejection).

c. The rejection for claims 2-4, under 35 U.S.C. 103(a) over Jain as applied for claim 1, or for claims 2-4, 6-10, 15 over Sun as applied for claims 1 and 5, and further in view of Gardiner (paragraph 8, 10, 12 of the 9/24/07 final rejection).

d. The rejection for claim 1 under 35 U.S.C. 103(a) over Jun (paragraph 14 of the 9/24/07 final rejection).

e. The rejection for claims 2-4 under 35 U.S.C. 103(a) over Jun in view of Gardiner (paragraphs 14, 16 of the 9/24/07 final rejection).

f. Claims 9-10, 15 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 6-8. See MPEP § 706.03(k).

4. The repeated arguments of the Patent Owner have been considered but deemed unpersuasive for reasons of record.

5. Since claims 11-14 are not under reexamination and would not be under appeal, an amendment cancelling claims 11-14 would be appropriate.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,419	02/11/2005	6015917	2771-221-REEXAM	2028

23448 7590 01/12/2010

INTELLECTUAL PROPERTY / TECHNOLOGY LAW
PO BOX 14329
RESEARCH TRIANGLE PARK, NC 27709

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/12/2010

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MAILED
Date: JAN 12 2010
CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
PAUL A. FATTIBENE, ESQ., FATTIBENE & FATTIBENE
2480 POST ROAD
SOUTHPORT, CT 06890

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007419
PATENT NO. : 6015917
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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Intellectual Property/Technology Law
P.O. Box 14329
Research Triangle Park, NC 27709

(For Patent Owner)

MAILED

JAN 12 2010

CENTRAL REEXAMINATION UNIT

Paul A. Fattibene
2480 Post Road
Southport, CT 06890

(For Requester)

In re Bhandari et al
Ex Parte Reexamination Proceeding
Control No. 90/007,419
Filed: February 11, 2005
For: U.S. Patent No. 6,015,917

: **DECISION**
: **GRANTING**
: **PETITION**

This is a decision on the November 27, 2009 patent owner petition under 37 CFR 1.183 to waive the provisions of 37 CFR 41.33(b) so that the patent owner petition under 37 CFR 1.181, also filed on November 27, 2009, to enter an amendment filed after the date of filing of an appeal brief, may be considered by the Central Reexamination Unit (CRU). The petition will be referred to as "the November 27, 2009 patent owner petition under 37 CFR 1.183".

This decision also addresses the December 16, 2009 patent owner power of attorney.

The November 27, 2009 patent owner petition under 37 CFR 1.183, the December 16, 2009 patent owner power of attorney, and the record as a whole are before the Office of Patent Legal Administration for consideration.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.183 has been received.

Based on the present facts and circumstances, the November 27, 2009 patent owner petition under 37 CFR 1.183 is **granted to the extent that** that waiver is needed, and the patent owner petition under 37 CFR 1.181, filed on November 27, 2009, may be considered by the Central Reexamination Unit.

The December 16, 2009 power of attorney, which was filed in the present reexamination proceeding and in the patent file, 09/012679, is effective to grant power of attorney to practitioners associated with customer number 23448. The December 16, 2009 power of attorney is ineffective, however, to grant power of attorney to the practitioners additionally listed

on the form, i.e., Mr. Shofi, Maggie Chappuis and Chih-Sheng Lin.[1] See MPEP 403, subsection I, which states:

> Where an applicant appoints all of the practitioners associated with a Customer Number as well as a list of individually named practitioners, **such action would be treated as only an appointment of all of the practitioners associated with a Customer Number** due to the potential for confusion and data entry errors in entering registration numbers from plural sources. Furthermore, Office computer systems do not allow for entry of both a power of attorney to a list of practitioners associated with a Customer Number and a list of practitioners.

Furthermore, the December 16, 2009 power of attorney is not in compliance with 37 CFR 1.4(d)(3), because it appears to be a modified version of the Office's form PTO/SB/80 (the word "OR" appearing above the list of practitioners has been replaced with the word "AND"), and because the Office's identification of form PTO/SB/80 (04-05) remains at the top of the form. Any future forms submitted by the patent owner must comply with 37 CFR 1.4(d)(3), which provides, in pertinent part (emphasis in bold added):

> *Forms*. The Office provides forms to the public to use in certain situations to assist in the filing of correspondence for a certain purpose and to meet certain requirements for patent applications and proceedings. Use of the forms for purposes for which they were not designed is prohibited. No changes to certification statements on the Office forms (e.g., oath or declaration forms, terminal disclaimer forms, petition forms, and nonpublication request form) may be made. **The existing text of a form, other than a certification statement, may be modified, deleted, or added to, if all text identifying the form as an Office form is removed. The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any Office form** with text identifying the form as an Office form by a party, whether a practitioner or non-practitioner, **constitutes a certification under § 11.18(b) of this chapter that the existing text and any certification statements on the form have not been altered** other than permitted by EFS-Web customization.

Finally, the statement under 37 CFR 3.73(b), which accompanied the December 16, 2009 power of attorney, is signed by Mr. David Bradin, an attorney of record. The December 16, 2009 statement under 37 CFR 3.73(b) is effective because it includes the statement that "the undersigned is authorized to act on behalf of the assignee". Mr. Bradin is reminded, however, that a power of attorney (37 CFR 1.32(b)(4)) to a patent practitioner to prosecute a patent application executed by the applicant or the assignee of the entire interest, alone, does not make that practitioner an official of an assignee or empower the practitioner to sign the submission on behalf of the assignee. The practitioner must also have authority to sign on behalf of the

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[1] It is not necessary for one who is authorized to act on behalf of the assignee to grant power of attorney to himself, when acting *pro se* as the assignee. However, Mr. Shofi has given power of attorney to the practitioners assigned to customer number 23448 and has also attempted to grant power of attorney to himself. While Mr. Shofi may do so via an appropriate procedure, such as, for example, the inclusion of Mr. Shofi in the list of practitioners assigned to customer number 23448, an appropriate procedure was not followed here, as explained above. See 37 CFR 1.33(a), which provides, in pertinent part:

> . . . The Office will not engage in double correspondence with an applicant and a patent practitioner, or with more than one patent practitioner except as deemed necessary by the Director. If more than one correspondence address is specified in a single document, the Office will select one of the specified addresses for use as the correspondence address and, if given, will select the address associated with a Customer Number over a typed correspondence address. . .

organization, i.e., the practitioner must also be empowered to bind the corporation. See MPEP 324, subsection V. The Office presumes that Mr. Bradin has such authorization to bind the corporation by virtue of the statement made in the statement under 37 CFR 3.73(b), and also by virtue of Mr. Bradin's signature pursuant to 37 CFR 1.4(d)(4), which incorporates 37 CFR 11.18(b).

CONCLUSION

- The November 27, 2009 patent owner petition under 37 CFR 1.183 is **granted to the extent that** the patent owner petition under 37 CFR 1.181, filed on November 27, 2009, may be considered by the Central Reexamination Unit.

- The December 16, 2009 power of attorney is ineffective to grant power of attorney to Mr. Shofi, Maggie Chappuis and Chih-Sheng Lin.

- Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit for consideration of the November 27, 2009 patent owner petition under 37 CFR 1.181.

- Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Evelyn Huang, at (571) 272-0686.

- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724.

Kenneth M. Schor

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

Kenpetlog7/
KenAtty/
1-11-10

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,419	02/11/2005	6015917	2771-221-REEXAM	2028

23448 7590 03/02/2010

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RESEARCH TRIANGLE PARK, NC 27709

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/02/2010

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Date: MAR 0 2 2010

CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
PAUL A. FATTIBENE, ESQ., FATTIBENE & FATTIBENE
2480 POST ROAD
SOUTHPORT, CT 06890

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007419
PATENT NO. : 6015917
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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CENTRAL REEXAMINATION UNIT

INTELLECTUAL PROPERTY / TECHNOLOGY LAW PO BOX 14329 RESEARCH TRIANGLE PARK, NC 27709	FOR PATENT OWNER
Paul A. Fattibene, Esq. Fattibene & Fattibene 2480 Post Road Southport, Connecticut 06890	FOR THIRD PARTY REQUESTER
In re Bhandari et al. Reexamination Proceeding Control No. : 90/007,419 Filed : February 11, 2005 Patent No. 6,015,917	DECISION ON PATENT OWNER'S PETITION UNDER 37 CFR 1.181

This is a decision addressing Patent Owner's petition under 37 CFR 1.181 for entry of a response after final rejection, filed November 27, 2009. The petition is before the Director of the Central Reexamination Unit for decision.

Patent Owner submitted a response on January 21, 2010 expressly withdrawing the petition under 37 CFR 1.181 (response, p. 20).

Accordingly, Patent Owner's petition is DISMISSED as moot.

Telephone inquiries related to this decision should be directed to Deborah Jones, Supervisory Patent Examiner, at (571) 272-1535, or in her absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director
Central Reexamination Unit

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.
90/007,420 95/006,789	02/14/2005	4918645	QNTA.002XX0

James H. Hsue
PARSONS HSUE & DERUNTZ, LLP
655 Montgomery Street, Suite 1800
San Francisco, California 94111

EXAMINER
Bragdon, Reginald

ART UNIT	PAPER
2188	

DATE MAILED: 04/05/2005

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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
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,420	02/14/2005	4918645	QNTA.002XX0	2031

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
www.uspto.gov

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
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
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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.
90/008,391	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

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	24286-40160	8644

33694 7590 02/13/2009

SIDLEY AUSTIN LLP
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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 1.565(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

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

Robert D. Becker
MANATT PHELPS AND PHILLIPS
1001 Page Mill Road, Building 2
Palo Alto, CA 94304

(For Patent Owner)

MAILED

JUL 25 2006

CENTRAL REEXAMINATION UNIT

VIOLA T. KUNG, PHD
2941 Fairview Park Drive
Suite 200
Falls Church, VA 22042

(For Third Party Requester)

BURNS DOANE SWECKER AND MATHIS LLP
333 Twin Dolphin Dr., Ste 700
Redwood City, CA 94065

(For Third Party Requester)

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

In re: Mandez *et alia*
Reexamination Proceeding
Control No. 90/007,933
Filed: February 10, 2006
For U.S. Patent No. 6,023,708

In re: Mandez *et alia*
Reexamination Proceeding
Control No. 90/007,421
Filed: February 15, 2005
For U.S. Patent No. 6,023,708

The above-identified reexamination files are before the Director of the Central Reexam Unit 3999, for consideration of merger of reexamination control number 90/007,933 (the '933 proceeding) and the reexamination control number 90/007,421 (the '421 proceeding) pursuant to 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 6,023,708 issued on February 8, 2000.

2. The 90/007,421 reexamination proceeding was filed on February 15, 2005 by a third party requester.

3. The '421 proceeding Order granting reexamination was mailed on April 8, 2005.

4. A non-final Office action in the '421 proceeding was mailed on November 1, 2005.

5. A response and amendment to the claims from the Patent Owner was received by the Office March 16, 2006.

6. The 90/007,933 reexamination proceeding was filed February 10, 2006 by a third party requester.

7. The '933 proceeding Order granting reexamination was mailed on March 30, 2006.

8. There are no amendments to the '933 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 90/007,421 and 90/007/933 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 90/007,421 and 90/007/933 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 90/007,421 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. 90/007,421 and 90/007/933 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.

2. The status of the merged proceedings 90/007,421 and 90/007/933 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.

All correspondence regarding these proceedings should be submitted as follows:

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

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

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

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

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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.
90/007,421	02/15/2005	6023708	035754-000012	5362

64971 7590 04/10/2007
PAMELA S. MERKADEAU
1001 PAGE MILL ROAD
BUILDING #2
PALO ALTO, CA 94304

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/10/2007

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

PAMELA S. MERKADEAU
MANATT PHELPS AND PHILLIPS
1001 PAGE MILL ROAD
BUILDING 2
PALO ALTO, CA 94304

In re Application of	:	
Daniel J. **MENDEZ**	:	
Control No. 90/007,421 (U.S. Patent 6,023,708)	:	DECISION ON PETITION
Filed: February 2, 2005	:	TO WITHDRAW
Attorney Docket No. 25587-033-006RE1	:	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 March 26, 2007.

The request is **NOT 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 Office cannot approve the request at this time since the reasons provided do not meet any of the conditions under the mandatory or permissive categories enumerated in 37 CFR 10.40. Section 10.40 of Title 37 of the Code of Federal Regulation states, "[a] practitioner shall not withdraw from employment in a proceeding before the Office without permission from the Office[.]" More specifically, 37 CFR 10.40 states, "[i]f paragraph (b) of this section is not applicable, a practitioner may not request permission to withdraw in matter pending before the Office unless such request or such withdrawal is" for one the permissive reasons listed in 37 CFR 10.40(c). While the reasons may be provided by referencing a specific portion of 37 CFR 10.40, the reasons must deal with actions by the client. The reasons set forth in the request, "Attorneys are no longer representing Applicant" are not appropriate since it is not clear that the client initiated the transfer, or that the client knowingly or freely assents to the transfer to new counsel.

All future communications from the Office will continue to be directed to the above-listed address until otherwise notified by applicant.

Telephone inquiries concerning this decision should be directed to Manuel Saldana at 571-272-7740.

Manuel Saldana
For

Mark Reinhart
Supervisory Patent Examiner
CRU 3992

cc: **SCOTT MCKEOWN**
OBLON, SPIVAK, MCCLELLAND, MAIER
& NEUSTADT, P.C.
1940 Duke Street
Alexandria, VA 22314-3412

cc: **ROBERT E. KREBS** (Third Party Requester)
P.O. BOX 64040
San Jose, CA 95164

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on March 26, 2007. There is no indication it was served on 3rd Party Requester.

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

KENYON & KENYON
One Broadway
New York, NY 10004

For Patent Owner

BRENDA POMERANCE, ESQ.
Law Office of Brenda Pomerance
260 West 52 Street
Suite 27B
New York, NY 10019

For Requester

MAILED
FEB 10 2006
REEXAM UNIT

H. JAY SPIEGEL
H. Jay Spiegel & Associates
P. O. Box 11
Mount Vernon, VA 22121

For Requester

In re: Henry V. Cohorn
Ex Parte Reexamination Proceeding
Control No. 90/007,139
Filed: July 28, 2004
For: US Patent No. 5,508,731

In re: Henry V. Cohorn
Ex Parte Reexamination Proceeding
Control No. 90/007,428
Filed: February 18, 2005
For: US Patent No. 5,508,731

DECISION, *SUA SPONTE*
MERGING
REEXAMINATION
PROCEEDINGS

The above-identified reexamination files are before the Director of the Central Reexam Unit, Art Unit 3992, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 5,508,731 issued on April 16, 1996.

2. *Ex Parte* Reexamination Proceeding, control no. 90/007,139 was requested by a third party requester filed on July 28, 2004.

3. The Reexamination Order was granted in proceeding, control no. 90/007,139 on September 20, 2004.

4. A non-final Office action was mailed in proceeding, control number 90/007,139 on December 16, 2005.

5. There are currently no amendments proceeding control number 90/007,139.

6. *Ex Parte* Reexamination Proceeding, control no. 90/007,428 was requested by a third party requester filed on February 18, 2005.

7. The Reexamination Order was granted in proceeding, control no. 90/007,716 on May 6, 2005.

8. Proceeding control number 90/007,428 awaits the first Office action on the merits from the assigned examiner.

9. There are currently no amendments proceeding control number 90/007,428.

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 90/007,139 and 90/007,428 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

Patent owner is required to maintain the same claims and specification in all files.

III. Conduct of Merged Proceeding.

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

CONCLUSION

Reexamination Control Nos. 90/007,139 and 90/007,428 are merged. The reexamination files are being forwarded to the examiner for issuing a first Office action.

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

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

MReinhart 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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,428 90/007,139	02/18/2005	5508731	VTB/AI/REEXAM	3949

26646 7590 11/26/2007

KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/26/2007

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

Kenyon & Kenyon LLP
One Broadway
New York, NY 10004

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NOV 26 2007

CENTRAL REEXAMINATION UNIT

(For Patent Owner)

Brenda Pomerance, Esq.
Law Office of Brenda Pomerance
260 West 52nd Street Ste. 27B
New York, NY 10019

(For Requester)

H. Jay Spiegel
H. Jay Spiegel & Associates
P.O. Box 11
Mount Vernon, VA 22121

(For Requester)

In re Von Kohorn Reexamination Proceeding Control No. 90/007,139 For: U.S. Patent No. 5,508,731	DECISION *SUA SPONTE* RETURNING UNTIMELY FILED PAPERS
In re Von Kohorn Reexamination Proceeding Control No. 90/007,428 For: U.S. Patent No. 5,508,731	

The *ex parte* reexamination is before the Director of the Central Reexamination Unit for consideration of papers filed September 12, 2007 and October 15, 2007.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,508,731 (hereinafter, the '731 patent), issued to Von Kohorn on April 16, 1996.

2. On July 28, 2004, a third party deposited a corrected request for *ex parte* reexamination of the '731 patent. The reexamination proceeding was assigned Control No. 90/007,139 (hereinafter, the '7139 proceeding).

3. On September 20, 2004, an order granting the request for reexamination was mailed.

4. On February 18, 2005, a third party deposited a corrected request for *ex parte* reexamination of the '731 patent. The reexamination proceeding was assigned Control No. 90/007,428 (hereinafter, the '7428 proceeding).

5. On May 6, 2005, an order granting the request for reexamination was mailed.

6. On February 10, 2006, the '7139 and the '7428 proceedings were merged.

7. On February 16, 2007, a "Notice of Intent to Issue *Ex parte* Reexamination Certificate" (NIRC) was mailed for the merged '7139 and '7428 proceedings.

8. On September 12, 2007 and October 15, 2007, Information Disclosure Statements (IDS) were filed in the merged '7139 and '7428 proceedings.

DECISION

37 CFR 1.555(a) states, in 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.

MPEP 2287 states, in part:

A NIRC informs the patent owner and any third party requester that the reexamination prosecution 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.

MPEP 2267 states, in part:

The applicable regulations (37 CFR 1.501(a), 1.550(e)) provide that certain types of correspondence will not be considered or acknowledged unless timely received. Whenever reexamination correspondence is received, a decision is required of the Office as to the action to be taken on the correspondence based on what type of paper it is and whether it is timely. The return of inappropriate submissions complies with the regulations that certain papers will not be considered... Any papers returned to the sender from the Central Reexamination Unit (CRU) or a Technology Center (TC) must be accompanied by a letter indicating signature and approval of the CRU or TC Director.

The IDSs filed on September 12, 2007 and October 15, 2007 are untimely submissions and were not accompanied by a petition under 37 CFR 1.182. Since the merged proceedings are not paper files, the papers submitted on September 12, 2007 and October 15, 2007 are being "closed" from public view on November 26, 2007 (while MPEP 2267 permits for the return of inappropriate or untimely submissions, this may not be possible in an Image File Wrapper (IFW) proceeding where a paper is inadvertently entered into the record. Instead, such a paper would be marked "closed" and "not public").

CONCLUSION

1. The untimely papers filed September 12, 2007 and October 15, 2007 are hereby expunged from the record of merged reexamination proceedings '7139 and '7428 by retaining them as "closed" from public view.

2. The reexamination proceeding is being forwarded to the Office of Publications for issuance of the Reexamination Certificate in due course.

3. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929 or Mark Reinhart, at (571) 272-1611.

Eric Keasel 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.
90/007,434	02/25/2005	6163486	OKI.057DREX	7457

7590 01/31/2007

Adam C. Volentine
Volentine Francos & Whitt P. L. L. C.
11951 Freedom Drive Suite 1260
Reston, VA 20190

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/31/2007

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

Adam C. Volentine
Volentine Francos & Whitt, P.L.L.C.
11951 Freedom Drive Suite 1260
Reston, VA 20190

For Patent Owner

MAILED

JAN 3 1 2007

CENTRAL REEXAMINATION UNIT

In re: Naoki Miura
Ex Parte Reexamination Proceeding
Control No. 90/007,434
Filed: February 25, 2005
For: US Patent No. 6,163,486

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

This is a decision on the January 25, 2007, Patent Owner "Request for One-Month Extension of Time Under 37 CFR 1.550" requesting that the time for filing the response to the Office action of November 25, 2006 be extended by one month.

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

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

Decision

The Patent Owner requests an extension of time in which to file its response to the action of November 25, 2006, which set a two month time limit for filing the a reply. The present petition for extension of time was timely filed on January 15, 2006, together with the $200.00 petition fee 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. ...
>
> The reasons stated in the request will be evaluated by the TC Director, and the requests will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response within the statutory time period.

The present request is incomplete in that it fails to include a complete statement of "sufficient cause" as to why the requested extension is needed and warranted. The request does not include (a) a statement of what action the patent 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 one month is needed.

As its reason for requesting an extension of time, Patent Owner notes only that the action included multiple objections and rejections under a variety of grounds. However, the outstanding Office action is neither unusually long nor complicated. Further, the petition does not include *any* accounting of actions taken thus far, nor explain why additional time is needed in spite of those actions. Thus no sufficient cause is seen for any extension of time to respond to the November 25, 2006 action.

In order to complete the present petition for extension, the patent owner must renew the petition and provide sufficient reasons and information to enable the Director of the Central Reexamination Unit to determine whether there is "sufficient cause" to grant the patent owner's request for an extension.

Conclusion

1. The Patent Owner's petition for extension of time filed on January 25, 2007 is <u>dismissed</u> as incomplete.

2. The Patent Owner is invited to file a renewed petition for extension of time, without additional fee, addressing the matters raised above. The renewed petition would be directed to the following:

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

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

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

3. 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

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

Adam C. Volentine
Volentine Francos & Whitt P. L. L. C.
11951 Freedom Drive Suite 1260
Reston VA 20190

(For Patent Owner)

MAILED

APR 30 2007

CENTRAL REEXAMINATION UNIT

In re Reexamination Proceeding
Naoki Miura
Control No. 90/007,434
Filed: February 25, 2005
U.S. Patent No. 6,163,486
Attorney Docket No. OK1.057DREX

DECISION GRANTING PETITION

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on April 4, 2007, by facsimile transmission, for entry of late papers based upon unintentional delay.

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

37 CFR 1.137(b) states:

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

The present petition under 37 CFR 1.137(b) includes, inter alia, the requisite response (Patent Owner's Amendment In Ex Parte Reexamination - item 1), an authorization to charge counsel's deposit account for the $1,500.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3).

The petition for entry of the late papers is granted.

$1,500.00 has been charged to counsel's deposit account no. 50-0238 in accordance with the present petition.

Jurisdiction over the reexamination proceeding is being returned to Central Reexamination Unit (CRU) Art Unit 3992 for further examination and consideration of the response filed April 4, 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, Erik Kielin, in CRU Art Unit 3992, who can be reached at 571-272-1693.

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
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.
90/007,435	02/28/2005	6379748	H-5104/Reexam '748	7211

7590 07/28/2005

ATMI, Inc.
7 Commerce Drive
Danbury, CT 06810

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/28/2005

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

CST

ATMI, Inc. 7 Commerce Drive Danbury, CT 06810	:	(for Patent Owner)
Paul A. Fattibene Fattibene & Fattibene 2480 Post Road Southport, CT 06890	:	(for Third Party Requester)
In re Bhandari et al Reexamination Proceeding Control No. 90/007,435 Filed: February 28, 2005 For: U.S. Patent 6,379,748	:	**DECISION ON PETITION FOR RECONSIDERATION OF DENIAL OF *EX PARTE* REEXAM REQUEST**

This is a decision on the PETITION FOR RECONSIDERATION OF DENIAL OF *EX PARTE* REEXAMINATION REQUEST, filed May 19, 2005. Petitioner requests that that the examiner's decision denying the request for reexamination of U.S. Patent 6,379,748 be reversed.

Background

1. On February 28, 2005, a third party REQUEST FOR REEXAMINATION of U.S. Patent No. 6,379,748 was filed by Paul A. Fattibene of Fattibene & Fattibene. The request cites U.S. Patent 5,668,054 to Sun et al, as raising a substantial new question of patentability with regard to claim 1 of U.S. Patent 6,379,748.

2. On April 20, 2005, the examiner denied the request for reexamination on the grounds that the teachings of the Sun et al patent do not raise a substantial new question of patentability with regard to claim 1 because the same question of patentability had already been decided in a previous examination by the Office.

3. On May 19, 2005, the present petition was filed.

Decision

A petition filed under 37 CFR 1.515(c), requesting that the examiner's decision denying the request for reexamination be reversed, is decided by the TC Director. The Manual of Patent Examining Procedure 2248 further states that the TC Director's review will be *de novo.*

The requester petitions for reversal of the Order Denying Request for Reexamination on the grounds that U.S. Patent 5,668,054 to Sun et al raises a substantial new question of patentability with regard to claim 1. Specifically, petitioner argues that 35 USC 303(a) was amended on November 2, 2002 to add that "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". Petitioner goes on to argue that while the Sun et al patent was used to reject the claims of the application which matured to US Patent 6,379,748, the requester has presented the material new argument that there is a lack of evidence to support the examiner's conclusion in the patent prosecution as to the range of homologues that would be obvious over US patent 5,668,054 to Sun et al.

A review of the file history of US patent 6,379,748 shows that on August 3, 2001, claims 5, 6 and 12-15 were rejected under 35 USC 102(e) as being clearly anticipated by US patent 5,668,054 to Sun et al. Subsequent to this rejection, the examiner conducted an interview, the substance of the interview being "Discussed what range of homologues would be sufficiently analogous to the compound disclosed in Sun et al, to be obvious for purposes of the claimed depositions, & agreed on an amendment to remove those ligand combinations" (Interview Summary dated Dec. 16 & 17, 2001), amended original claim 5 (patent claim 1) to include the proviso that $R_1 \neq C_3$- C_5 alkyl group when $R_2 = R_3$ = Et, and stated in the reasons for allowance that the amendment to add the proviso removes adjacent homologues of the substitutional ligands disclosed in Sun et al which would have been obvious as being expected to have similar stearic size effects and homologous chemistry. Thus, the prosecution history of the '748 patent clearly indicates that the examiner considered the question of what homologues of the tantalum precursor recited in group (viii) of the '748 patent would have been expected to have similar properties to the precursor disclosed in the Sun et al patent. The requester has not provided any evidence to demonstrate that that those homologues indicated as allowable by the examiner over the Sun et al patent are indeed obvious variants of the compounds disclosed by Sun et al.

Summary

No substantial new question of patentability affecting at least one claim of U.S. patent 6,379,748 to Bhandari et al is raised by US patent 5,668,054 to Sun et al for the reasons set forth above.

The petition is **DENIED**. This decision is final and non-appealable, pursuant to 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

KINNEY & LANGE, P.A.
THE KINNEY & LANGE BUILDING
312 SOUTH THIRD STREET
MINNEAPOLIS MN 55415-1002

(For Patent Owner)

MAILED

MAY 17 2007

CENTRAL REEXAMINATION UNIT

Bradley J. Thorson
PATTERSON, THUENTE, SKAAR &
CHRISTENSEN, PA
4800 IDS Center
80 South 8th Street
Minneapolis, MN 55402

(For Requester)

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

In re: Braun *et alia* :
Ex Parte Reexamination Proceeding :
Control No. 90/008,067 :
Filed: June 27, 2006 :
For U.S. Patent No. 5,811,681 :

In re: Braun *et alia* :
Ex Parte Reexamination Proceeding :
Control No. 90/007,439 :
Filed: March 1, 2005 :
For U.S. Patent No. 5,811,681 :

The above-identified reexamination files are before the Director of the Central Reexam Unit 3999, for consideration of merger of reexamination control number

90/008,067 (the '067 proceeding) and the reexamination control number 90/007,439 (the '439 proceeding) pursuant to 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 5,811,681 issued on Sept 22, 1998.

2. The 90/007,439 reexamination proceeding was filed on March 1, 2005 by a third party requester.

3. The '439 proceeding Order granting reexamination was mailed on May 8, 2005.

4. A non-final Office action in the '439 proceeding was mailed on October 11, 2005.

5. Amendments to the claims in the '439 proceeding from the Patent Owner was received by the Office on May 5, 2006, December 12, 2006 and August 21, 2006 respectively.

6. The '439 proceeding is currently awaiting examiner's action.

7. The 90/008,067 reexamination proceeding was filed June 27, 2006 by a third party requester.

8. The '067 proceeding Order granting reexamination was mailed on August 28, 2006.

9. There are no amendments to the '067 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 90/007,439 and 90/008,067 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 have been amended in the 90/007,439 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. 90/007,439 and 90/008,067 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.

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

MRuh for

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

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Alexandria, VA 22313-1450
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THE KINNEY & LANGE BUILDING
312 SOUTH THIRD STREET
MINNEAPOLIS MN 55415-1002

(For Patent Owner)

MAILED

MAY 17 2007

CENTRAL REEXAMINATION UNIT

Bradley J. Thorson
PATTERSON, THUENTE, SKAAR &
CHRISTENSEN, PA
4800 IDS Center
80 South 8th Street
Minneapolis, MN 55402

(For Requester)

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

In re: Braun *et alia* :
Ex Parte Reexamination Proceeding :
Control No. 90/008,066 :
Filed: June 27, 2006 :
For U.S. Patent No. 6,416,482 :

In re: Braun *et alia* :
Ex Parte Reexamination Proceeding :
Control No. 90/007,440 :
Filed: 440March 1, 2005 :
For U.S. Patent No. 6,416,482 :

The above-identified reexamination files are before the Director of the Central Reexam Unit 3999, for consideration of merger of reexamination control number

90/008,066 (the '066 proceeding) and the reexamination control number 90/007,440 (the '440 proceeding) pursuant to 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 6,416,482 issued on July 9, 2002.

2. The 90/007,440 reexamination proceeding was filed on March 1, 2005 by a third party requester.

3. The '440 proceeding Order granting reexamination was mailed on May 8, 2005.

4. A non-final Office action in the '440 proceeding was mailed on October 11, 2005.

5. Amendments to the claims in the '440 proceeding from the Patent Owner was received by the Office on May 5, 2006 and December 12, 2006 respectively.

6. The '440 proceeding is currently under non-final status

7. The 90/008,066 reexamination proceeding was filed June 27, 2006 by a third party requester.

8. The '066 proceeding Order granting reexamination was mailed on August 25, 2006.

9. There are no amendments to the '066 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 90/007,440 and 90/008,066 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 have been amended in the 90/007,440 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. 90/007,440 and 90/008,066 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

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

for

Lissi Mojica. Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
www.uspto.gov

Jacobson Holman
Professional Limited Liability Company
400 Seventh Street, NW
Washington, DC 20004

(For Patent Owner)

FEB 12 2007

Matthew S. Graham
Frederickson & Byron, PA
200 South Sixth Street, Suite 4000
Minneapolis, MN 55402

(For 3rd Party Requester)

Enclosure: Copy of Patent Owner's petition under 37 CFR 1.181 filed August 21, 2006[1]

In re	: Kato et al	
Reexamination Proceeding		DECISION ON PETITION
Control No.	: 90/007,441	UNDER 37 CFR 1.181
Filed	: March 1, 2005	
For U.S. Patent No.	: 6,739,457	

This is a decision on petitioner's request filed August 21, 2006 to restart the response date of the January 24, 2006 Office action issued in the above-identified reexamination proceeding based on the assertion that petitioner did not receive the Office action in question. There is no fee for this petition.

In order to overcome the presumption of delivery of an Office action, a practitioner must submit the following: (1) a statement from the practitioner stating that the Office action was not received by practitioner; (2) a statement attesting to the fact that a search of the file jacket and docket record indicates that the Office action was not received; and (3) a copy of the docket record where the non-received Office action would have been entered had it been received and docketed. See 1156 O.G. 53.

The request filed August 21, 2006 includes all the above elements. The request is therefore GRANTED.

Upon the mailing of this decision, the proceeding will be forwarded to the Legal Instruments Examiner of the Central Reexamination Unit for the remailing of the Office action of January 24, 2006; the remailing of the Office action will establish a new statutory period for response.

[1] The petition under 37 CFR 1.181 filed by patent owner on August 21, 2006 did not include an indication that it had been served on third party requester as required by 37 CFR 1.550(f). Accordingly, a copy of the petition is being sent to the third party requester.

Any inquiry concerning this decision should be directed to Andres Kashnikow, Special Programs Examiner, at telephone No. (571) 272-4361.

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

AUG 2 1 2006
PATENT & TRADEMARK OFFICE

Reexam

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent No. 6,739,457

KATO et al

Reexam. Appln. No.: 90/007,441 Conf. No.: 6307

Filed: March 1, 2005

For: DEFLECTOR FOR CENTRIFUGAL PELLET DRYER SCREEN

PETITION UNDER 37 CFR §1.181

Mail Stop "Ex Parte Reexam"
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

We are submitting this Petition under 37 CFR §1.181 to restart the response date of the January 24, 2006 Office Action issued in connection with the above-captioned reexamination proceeding.

This Petition should be treated as a request to restart a response period for failure to receive an Office Action. No Petition fee is required.

A showing required to establish failure to receive an Office Action requires submission of a) the practitioner statement that an Office Action was not received by the practitioner, b) a statement attesting to the fact that a search of the file jacket and docket records indicate that the Office Action was not received, and c) a copy of the docket record where the non-received Office Action would have been entered had it been received.

In support of the present Petition, the undersigned practitioner hereby declares that, to the best of his knowledge and belief, the Office Action mailed January 24, 2006 was not received in this office and that a search of the file jacket and docket records support this fact.

Upon receiving a telephone call from Sarah Clarke on August 21, 2006 advising that an office action had been issued, undersigned counsel went to the PAIR website and obtained a copy of the January 24, 2006 Office Action.

In further support of the present Petition, a hard copy of the page from the electronic computer docketing system for our office is submitted herewith as Attachment A.

As can be seen from attached copy of the docket sheet for this application, the Office Action was not received in our office. In this regard, see the entry for "Office Action Recd?-Final" to indicate that an office action is expected. Had an office action been received at the time of printing this report, the field identified as "Action Taken" would have included the date of receipt of an office action. Additionally, as will be noted from the second page of Attachment A, the last date the docket for this application was updated was "30-May-2005". Had an office action been received in January 2006, the "Last Update" would have reflected a January 2006 date.

For the foregoing reasons, this Petition under 37 CFR §1.181 should be granted and a replacement office action should be issued with a new mailing date in order to restart the response period. Favorable action commensurate with the above is requested.

Should it be found necessary, please charge undersigned counsel's Deposit Account No. 06-1358 for any fees in connection with this Petition. A duplicate of this paper is attached.

Respectfully submitted,

JACOBSON HOLMAN PLLC

By: [signature] Reg # 26921 gd

HARVEY B. JACOBSON, JR.
Reg. No. 20,851

400 Seventh Street, N.W.
Washington, D.C. 20004-2201
202/638-6666
Atty. Dkt. No.: P66814US1
Dated: August 21, 2006

ATTACHMENT A

Country Application

Monday, August 21, 2006 Page: 1

Case Number:	P66814US1	**Country:** US	**SubCase:**
Client:	GALA INDUSTRIES, INC.	United States of America	
Case Type:	REX	**Application Status:**	PENDING
Application Number:	90/007,441	**Filing Date:**	01-Mar-2005
Publication Number:		**Publication Date:**	
Patent Number:		**Issue Date:**	
Parent/PCT Number:		**Parent/PCT Date :**	17-Aug-2001
Parent Issue Number:		**Parent Issue Date :**	
Tax Schedule:	SE	**Expiration Date:**	17-Aug-2021
Confirmation #:		**Patent Term Adjustment:**	0
Owner:			
Agent:		**Agent Reference #:**	

App.Title: DEFLECTOR FOR CENTRIFUGAL PELLET DRYER SCREEN

Family Reference:

Inventors:

HUMPHRIES II, Toney R.
WOODSON, William Douglas

List Of Actions

Action(s) Due	Due Date		Action Taken
FILING RECPT RECD ?	01-Jun-2005	Due Date	14-Mar-2005
REQ REEXAM ACCPT?	01-Jun-2005	Due Date	14-Mar-2005
FILING RECPT RECD ?-FINAL	01-Sep-2005	Final	14-Mar-2005
Information Disclosure Stmnt-F	01-Sep-2006	Final	
OFFICE ACTION RECD?-FINAL	01-Sep-2006	Final	

Created By:	DJC
User ID:	sa
Date Created:	11-Mar-2005
Last Update:	30-May-2005

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.
90/007,444	03/03/2005	6630192	017900.0097	2881

30542 7590 07/05/2006

FOLEY & LARDNER LLP
P.O. BOX 80278
SAN DIEGO, CA 92138-0278

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/05/2006

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

7/5/06

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

KIMBERLY A. CHASTEEN

WILLIAMS MULLEN

FOUNTAIN PLAZA THREE, 721 LAKEFRONT COMMONS

NEWPORT NEWS, VA 23606

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007444

PATENT NO. 6,630,192

ART UNI 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a 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

Foley & Lardner LLP
P.O. Box 80278
San Diego, California 92138-0278

(For Patent Owner)

MAILED

JUL 05 2006

CENTRAL REEXAMINATION UNIT

Kimberly A. Chasteen
Williams Mullen
Fountain Plaza Three
721 Lakefront Commons
Newport News, Virginia 23606

(For Requester)

In re Kalyana Sundram et al.
Reexamination Proceeding
Control No.: 90/007,444
Filed: March 3, 2005
For: U.S. Patent No.: 6,630,192

: **DECISION**
: **DISMISSING**
: **PETITION**

This is a decision on the June 14, 2006 patent owner petition titled PETITION UNDER 37 C.F.R. §1.182, which requests entry and consideration of an Information Disclosure Statement concurrently submitted.

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

The petition is dismissed for the reasons set forth below.

REVIEW OF FACTS

1. Patent number 6,630,192 (the '192 patent) issued October 7, 2003.

2. On March 3, 2005, a third party request for reexamination of the '192 patent was filed. The resulting proceeding was assigned control No. 90/007,444 (the '7444 proceeding).

3. On May 2, 2005, the Office issued an order granting the request for reexamination in the '7444 reexamination proceeding.

4. The proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed on March 17, 2006.

5. On June 14, 2006, the patent owner filed the present petition under 37 CFR §1.182 for consideration of an Information Disclosure Statement filed with the petition.

6. The reexamination proceeding is in the final phase of being prepared for printing of the reexamination certificate (it is in the "printing cycle").

DECISION DISMISSING THE PETITION TO CONSIDER THE INFORMATION DISCLOSURE STATEMENT

There is no issue fee in reexamination, and the present reexamination proceeding has entered the final phase of the publication process (the "printing cycle"). In a reexamination proceeding, there is no withdrawal under 37 CFR 1.313 of the proceeding from the publication process for consideration of an Information Disclosure Statement (IDS), because 37 CFR 1.313(a) applies to applications and not to reexamination proceedings. Accordingly, in this instance the petition for withdrawal of the proceeding from the publication process for consideration of the accompanying IDS has been filed under 37 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 provides such a mechanism for an application. Accordingly, the requirements of 37 CFR 1.313 for withdrawal of an application from the printing cycle (after the issue fee has been paid) will be applied analogously to the requirements for withdrawal of the present reexamination proceeding from the printing cycle.

37 CFR §1.313 states (emphasis added):

> (a) **Applications** may be withdrawn from issue for further action at the initiative of the Office or upon petition by the **applicant**. To request that the Office withdraw an application from issue, applicant must file a petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why withdrawal of the application from issue is necessary....
>
> (b) Once the issue fee has been paid, **the Office will not withdraw the application from issue at its own initiative for any reason except:**
>
> (1) A mistake on the part of the Office;
>
> (2) A violation of § 1.56 or illegality in the application;
>
> (3) Unpatentability of one or more claims; or
>
> (4) For interference.
>
> (c) Once the issue fee has been paid, **the application will not be withdrawn from issue upon petition by the applicant for any reason except:**
>
> (1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;
>
> (2) Consideration of a request for continued examination in compliance with § 1.114; or
>
> (3) Express abandonment of the application. Such express abandonment may be in favor of a continuing application.

In the present instance, the fact situation fails to satisfy any grounds that would be analogous to those of 37 CFR 1.313(b) or (c). The instant petition was filed very late in the examination of the reexamination, and it fails to provide a statement as to why the submitted IDS items of information (art citations) make at least one claim unpatentable. The entire statement provided is that "Patent Owners first became aware of the information cited in the enclosed IDS within the previous two weeks." Patent owner does not provide any discussion of the substance of any of the items of information submitted, and has not applied the teachings of the same to the claim limitations in the present reexamination proceeding.

For reexamination, there is a statutory requirement pursuant to 35 U.S.C. §305 that all *ex parte* reexamination proceedings "will be conducted with special dispatch within the Office." If it is required that the withdrawal criteria of 37 CFR 1.313(b) or (c) be complied with for an application, in which there is no statutory requirement for special dispatch, then, at a minimum, such criteria must certainly be complied with for a reexamination proceeding where a statutory requirement for special dispatch applies.

Accordingly, the present proceeding will not be withdrawn from the publication process for consideration of the IDS submitted with the petition, and the petition must be dismissed.

If, however, the patent owner believes that one or more of the submitted information items (art citations) raises a substantial question of patentability as to at least one claim of the '192 patent which is different than the questions of patentability raised and considered thus far, then the patent owner can file a new request for reexamination for consideration of such information item(s).

The following is provided for advisory purposes:

As to any IDS that is submitted after a Notice of Intent to Issue a Reexamination Certificate (NIRC) has been mailed, even where the reexamination proceeding has not entered the printing cycle, consideration of an IDS would run contrary to the statutory requirement of 35 U.S.C. §305 that "[a]ll reexamination proceedings under this section...will be conducted with special dispatch within the Office." This statutory provision is grounded on the need for certainty and finality as to the question of patentability raised by the request for reexamination. Accordingly, once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. The granting of a petition to consider an IDS filed after the NIRC would require withdrawal of the reexamination proceeding from the publication process, evaluation of the citations, and issuance of another action. This clearly would not carry out the special dispatch mandated by the statute. In order to justify a withdrawal from the publication process to consider an IDS, in the face of the mandate for special dispatch, there is a need for the patent owner (submitting the IDS) to assert that the information submitted raises a question of patentability as to the claims, and to apply the information to the claims' limitations - to facilitate consideration and to further the statutory mandate for special dispatch. If the patent owner fails to do so, it is not appropriate that the reexamination proceeding should be reopened at this late point in the proceeding for consideration of the information. Instead, the patent owner can file a new request for reexamination for consideration of the information, where the patent owner believes that the submitted information raises a substantial question of patentability (as to at least one claim of the patent) that is different than those already raised and considered.

CONCLUSION

1. The patent owner petition to consider the Information Disclosure Statement filed with the petition is dismissed.

2. The Information Disclosure Statement is however entered into the file for the present reexamination proceeding.

3. The present proceeding will continue in the publication process, toward issuance of a reexamination certificate.

3. The requisite petition fee of $400 (as per 37 CFR 1.17(f)) necessary for consideration of the petition under 37 C.F.R. §1.182 has been charged to Deposit Account No. 50-0872 as authorized by Patent Owner.

4. Telephone inquiries related to this decision should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726

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

July 5, 2006
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,445	03/04/2005	5778187	40255250	3036

24341 7590 05/20/2005

MORGAN, LEWIS & BOCKIUS, LLP.
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PALO ALTO, CA 94306

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/20/2005

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Washington, DC 20005-3500

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/007,445*.

PATENT NO. *5,778,187*.

ART UNIT *2143*.

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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Morgan, Lewis & Bockius, LLP 2 Palo Alto Square 3000 El Camino Real Palo Alto, California 94306	))))	**FOR PATENT OWNER**
John F. Hayden, Esq. Fish & Richardson, P.C. 1425 K Street, N.W. - 11th Floor Washington, DC 20005-3500	))))	**FOR THIRD PARTY REQUESTER**
In re Antonio M. Monteiro et al. Reexamination Proceeding Control No. 90/007,054 Filed: May 28, 2004 For: U.S. Patent No. 5,778,187	)))))	**DECISION *SUA SPONTE*, MERGING REEXAMINATION PROCEEDINGS**
In re Antonio M. Monteiro et al. Reexamination Proceeding Control No. 90/007,445 Filed: March 4, 2005 For: U.S. Patent No. 5,778,187	)))))	

The above noted reexamination proceedings are before the Director of Technology Center 2100 for consideration of merger of the proceedings under 37 CFR § 1.565(c).

BACKGROUND

1. Patent No. 5,778,187 issued on July 7, 1998.

'7054 Proceeding

2. A first request for reexamination, Control No. 90/007,054 ('7054) was filed by the Third Party Requester on May 28, 2004.

3. A revocation and appointment of attorneys was filed on June 22, 2004.

4. Reexamination was ordered in the '7054 reexamination proceeding on June 23, 2004.

5. An Information Disclosure Statement was filed September 9, 2004.

6. A Supplemental Information Disclosure Statement was filed September 24, 2004.

7. A first Office action was mailed on December 8, 2004.

8. A Petition under 37 §CFR 1.550(c) for an Extension of Time to respond to the Office action was filed December 17, 2004.

9. A Decision granting Patent Owner until February 8, 2005 to file a the Response was mailed December 21, 2004.

10. An Information Disclosure Statement was filed December 29, 2004.

11. A Supplemental Information Disclosure Statement was filed January 18, 2005.

12. A Second Supplemental Information Disclosure Statement was filed February 2, 2005.

13. An Interview Summary was mailed on February 9, 2005 recording the substance of an interview which was held on January 26, 2005.

14. Patent Owner filed a Response to the Office action on February 8, 2005. The response includes Remarks, Patent Owner's Statement of substance of the Interview (of January 26), and Affidavits under 37 CFR §1.131 by Antonio M. Monteiro and James F. Butterworth accompanied by supporting Exhibits.

15. An Information Disclosure Statement was filed March 16, 2005.

'7445 Proceeding

16. A second request for reexamination, Control No. 90/007,445 ('7445) was filed by Third Party Requester on March 4, 2005.

17. A Notification of concurrent proceedings under 37 CFR §1.565 was filed by Requestor on March 23, 2005.

18. Reexamination was ordered in the '7445 reexamination proceeding on April 19, 2005.

19. A Letter informing the Office that Patent Owner will not be filing a Statement under 37 CFR 1.530 was filed on May 11, 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 '7054 and '7445 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in all Proceedings

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

III. Conduct of Merged Proceeding

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

sent copies of all papers mailed by the Office.

Since the files currently maintain the same claimsand specification, no "housekeeping" amendment is required. Therefore, the reexamination files are being forwarded to the examiner for action commensurate with this decision.

Any inquiries with respect to this decision may be directed to Pinchus M. Laufer at the number listed below.

Pinchus M. Laufer

Pinchus M. Laufer
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security
(571) 272-3599

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,446	03/04/2005	6434622	40255276	3171

24341 7590 05/20/2005

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/20/2005

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1425 K Street,, N.W. - 11th Floor
Washington, DC 20005-3500

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/007,446*.

PATENT NO. *6,434,622*.

ART UNIT *2143*.

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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Morgan, Lewis & Bockius, LLP 2 Palo Alto Square 3000 El Camino Real Palo Alto, California 94306	))))	**FOR PATENT OWNER**
John F. Hayden, Esq. Fish & Richardson, P.C. 1425 K Street, N.W. - 11th Floor Washington, DC 20005-3500	))))	**FOR THIRD PARTY REQUESTER**
In re Antonio M. Monteiro et al. Reexamination Proceeding Control No. 90/007,056 Filed: May 28, 2004 For: U.S. Patent No. 6,434,622	)))))	**DECISION *SUA SPONTE*, MERGING REEXAMINATION PROCEEDINGS**
In re Antonio M. Monteiro et al. Reexamination Proceeding Control No. 90/007,446 Filed: March 4, 2005 For: U.S. Patent No. 6,434,622	)))))	

The above noted reexamination proceedings are before the Director of Technology Center 2100 for consideration of merger of the proceedings under 37 CFR § 1.565(c).

BACKGROUND

1. Patent No. 6,434,622 issued on August 13, 2002.

'7056 Proceeding

2. A first request for reexamination, Control No. 90/007,056 ('7056) was filed by the Third Party Requester on May 28, 2004.

3. A revocation and appointment of attorneys was filed on June 22, 2004.

4. Reexamination was ordered in the '7055 reexamination proceeding on June 24, 2004.

5. An Information Disclosure Statement was filed September 9, 2004.

6. A Supplemental Information Disclosure Statement was filed September 24, 2004.

7. A first Office action was mailed on December 8, 2004.

8. A Petition under 37 §CFR 1.550(c) for an Extension of Time to respond to the Office action was filed December 17, 2004.

9. A Decision granting Patent Owner until February 8, 2005 to file a the Response was mailed December 21, 2004.

10. An Information Disclosure Statement was filed December 29, 2004.

11. A Supplemental Information Disclosure Statement was filed January 18, 2005.

12. A Second Supplemental Information Disclosure Statement was filed February 2, 2005.

13. An Interview Summary was mailed on February 9, 2005 recording the substance of an interview which was held on January 26, 2005.

14. Patent Owner filed a Response to the Office action on February 18, 2005. The response includes Remarks, Patent Owner's Statement of substance of the Interview (of January 26), and Affidavits under 37 CFR §1.131 by Antonio M. Monteiro and James F. Butterworth accompanied by supporting Exhibits.

15. Patent Owner filed a Supplemental Response to the Office action on March 15, 2005.

16. An Information Disclosure Statement was filed March 18, 2005.

'7446 Proceeding

17. A second request for reexamination, Control No. 90/007,446 ('7446) was filed by Third Party Requester on March 4, 2005.

18. A Notification of concurrent proceedings under 37 CFR §1.565 was filed by Requestor on March 23, 2005.

19. Reexamination was ordered in the '7446 reexamination proceeding on April 19, 2005.

20. A Letter informing the Office that Patent Owner will not be filing a Statement under 37 CFR 1.530 was filed on May 11, 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 '7055 and '7447 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in all Proceedings

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

Since the files do not currently maintain the same claims and specification, a "housekeeping" amendment is required. Applicant is required to file a proper housekeeping amendment, to make the claims the same in each file, within **ONE MONTH** of the mail date of this decision.

III. Conduct of Merged Proceeding

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

Any inquiries with respect to this decision may be directed to Pinchus M. Laufer at the number listed below

Pinchus M. Laufer
Special Programs Examiner
Technology Center 2100
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(571) 272-3599

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,447	03/04/2005	5983005	40255276	3178

24341 7590 05/20/2005

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ART UNIT	PAPER NUMBER

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/007,447*.

PATENT NO. *5983005*.

ART UNIT *2143*.

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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Morgan, Lewis & Bockius, LLP 2 Palo Alto Square 3000 El Camino Real Palo Alto, California 94306	))))	**FOR PATENT OWNER**
John F. Hayden, Esq. Fish & Richardson, P.C. 1425 K Street, N.W. - 11th Floor Washington, DC 20005-3500	))))	**FOR THIRD PARTY REQUESTER**
In re Antonio M. Monteiro et al. Reexamination Proceeding Control No. 90/007,055 Filed: May 28, 2004 For: U.S. Patent No. 5,983,005	)))))	**DECISION *SUA SPONTE*, MERGING REEXAMINATION PROCEEDINGS**
In re Antonio M. Monteiro et al. Reexamination Proceeding Control No. 90/007,447 Filed: March 4, 2005 For: U.S. Patent No. 5,983,005	)))))	

The above noted reexamination proceedings are before the Director of Technology Center 2100 for consideration of merger of the proceedings under 37 CFR § 1.565(c).

BACKGROUND

1. Patent No. 5,983,005 issued on November 9, 1999.

'7055 Proceeding

2. A first request for reexamination, Control No. 90/007,055 ('7055) was filed by the Third Party Requester on May 28, 2004.

3. A revocation and appointment of attorneys was filed on June 22, 2004.

4. Reexamination was ordered in the '7055 reexamination proceeding on June 23, 2004.

5. An Information Disclosure Statement was filed September 9, 2004.

6. A Supplemental Information Disclosure Statement was filed September 24, 2004.

7. A first Office action was mailed on December 7, 2004.

8. An Information Disclosure Statement was filed December 29, 2004.

9. A Letter remailing the previous Office action and restarting the period for response was mailed January 12, 2005.

10. A Supplemental Information Disclosure Statement was filed January 18, 2005.

11. A Second Supplemental Information Disclosure Statement was filed February 2, 2005.

12. An Interview Summary was mailed on February 9, 2005 recording the substance of an interview which was held on January 26, 2005.

13. Patent Owner filed a Response to the Office action on February 18, 2005. The response includes Remarks, Patent Owner's Statement of substance of the Interview (of January 26), and Affidavits under 37 CFR §1.131 by Antonio M. Monteiro and James F. Butterworth accompanied by supporting Exhibits.

14. An Information Disclosure Statement was filed March 16, 2005.

'7447 Proceeding

15. A second request for reexamination, Control No. 90/007,447 ('7447) was filed by Third Party Requester on March 4, 2005.

16. A Notification of concurrent proceedings under 37 CFR §1.565 was filed by Requestor on March 23, 2005.

17. Reexamination was ordered in the '7445 reexamination proceeding on April 19, 2005.

18. A Letter informing the Office that Patent Owner will not be filing a Statement under 37 CFR 1.530 was filed on May 11, 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 '7055 and '7447 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

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Since the files currently maintain thesame claims and specification, no "housekeeping" amendment

is required. Therefore, the reexamination files are being forwarded to the examiner for action commensurate with this decision.

Any inquiries with respect to this decision may be directed to Pinchus M. Laufer at the number listed below.

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Special Programs Examiner
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,449	03/04/2005	6734022	016866-001508	9362

7590 07/08/2006

TOWNSEND AND TOWNSEND AND CREW LLP
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/08/2006

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Eugenia Garrett-Wackowski
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For Patent Owner

Ex Parte Reexamination Proceeding
Control No. 90/007,449
Filed: March 4, 2005
For: US Patent No. 56,734,022

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

This is a decision on the petition filed June 14, 2006 and supplemental statement of facts filed June 29, 2006 to request a one-month extension of time pursuant to 37 CFR 1.550 for responding to the Office action dated May 11, 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 May 11, 2006, which set a two-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, upon receiving the Office action, counsel met with Dr. Yip, one of the inventors and with the licensee to discuss the response. Based on the discussions, it became clear that a personal interview with the examiner would clarify some of the issues and the subsequent response would be complete and expeditious. Counsel began immediately to arrange the interview; however, there have been significant scheduling conflicts due to vacations and holidays. An interview has been scheduled for July 26, 2006 but this is beyond the response due date of July 11, 2006. An extension of time for one month is requested.

Analysis and Findings

On balance, it is considered that the petition explains the "sufficient cause" for the request of an extension of time. It is noted this request is made well in advance of the response due date in view of impending schedule conflicts. Patent Owner has been diligent in analyzing the rejections and it is clear that further input from the examiner will facilitate the formulation of a complete response to the outstanding Office action. In view of the availability of the parties involved in the requested interview, the extension of time for one month is reasonable and necessary to provide Patent Owner with a fair opportunity to respond.

Accordingly, the time for filing a reply to the outstanding Office action is extended for one (1) month and is therefor due on August 11, 2006. Patent Owner may expect that any further extensions of time to respond to the Office action will be granted only in an extraordinary situation. See MPEP 2665.

Conclusion

1. The patent owner's petition for extension of time of one (1) month in which to file a response to the Office action dated May 11, 2006 is **granted**.

2. The Patent Owner's response is due August 11, 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.

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

Tim Klima
Harbin King & Klima
509 9th Street, S.E.
Washington, DC 20003[1]

(For Patent Owner)

APR 14 2006

William A. Munck
& Daniel E. Venglarik
P.O. Drawer 800889
Dallas, TX 75380

(For 3rd Party Requester)

Reexam Control No.: 90/007,450
Filed : March 9, 2005
For U.S. Patent No. : 6,384,402

Reexam Control No.: 90/007,454
Filed : March 7, 2005
For U.S. Patent No. : 6,384,402

Reexam Control No.: 90/007,461
Filed : March 12, 2005
For U.S. Patent No. : 6,384,402

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination proceedings are before the Director of the Central Reexamination Unit for consideration of merger as provided for in 37 CFR 1.565(c).

Reexamination in application control No. 90/007,450 was ordered in a decision mailed May 25, 2005. No patent owner's statement has been filed in the instant proceeding, nor has an Office action been issued.

Reexamination in application control No. 90/007,454 was ordered in a decision mailed May 25, 2005. A timely patent owner's statement was received July 25, 2005. A timely requester's reply to patent owner's statement was received September 29, 2005. No Office action has been issued.

Reexamination in application control No. 90/007,461 was ordered in a decision mailed May 25, 2005. A timely patent owner's statement was received July 25, 2005. A timely requester's reply to patent owner's statement was received September 29, 2005. No Office action has been issued.

[1] It is noted that a change of correspondence address has been received from patent owner's representative in reexamination proceedings 90/007,454 and 90/007,461 but not for reexamination proceeding 90/007,450. A change of correspondence address should also be filed for reexamination proceeding 90/007,450.

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.

Requirement for Same Claims, Drawings, and Specification in Both Proceedings

The patent owner is required to maintain identical claims, specifications, and drawings in both files. In view of the fact that both proceedings are identical, no amendment is necessary at this time.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. All papers mailed by the Office will take the form of a single action, which applies to all proceedings. All papers issued by the Office or as filed by the patent owner will contain the identifying data for all of the files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in triplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office.

Conclusion

Reexamination Control Nos. 90/007,450, 90/007,454 and 90/007,461 are hereby merged. Upon mailing of this decision, all files will be forwarded to the examiner for issuance of an Office action on the merits.

Any inquiry concerning this decision should be directed to Andres Kashnikow, Special Programs Examiner, at telephone No. (571) 272-4361.

Lissi Mojica Marquis, Director
Central Reexamination Unit

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

Tim Klima
Harbin King & Klima
509 9th Street, S.E.
Washington, DC 20003

(For Patent Owner)

APR 13 2006

William A. Munck
& Daniel E. Venglarik
P.O. Drawer 800889
Dallas, TX 75380

(For 3rd Party Requester)

Reexam Control No.: 90/007,451
Filed : March 9, 2005
For U.S. Patent No. : 6,794,634

Reexam Control No.: 90/007,453
Filed : March 7, 2005
For U.S. Patent No. : 6,794,634

Reexam Control No.: 90/007,462
Filed : March 12, 2005
For U.S. Patent No. : 6,794,634

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination proceedings are before the Director of the Central Reexamination Unit for consideration of merger as provided for in 37 CFR 1.565(c).

Reexamination in application control No. 90/007,451 was ordered in a decision mailed May 25, 2005. A timely patent owner's statement was received July 25, 2005. A timely requester's reply to patent owner's statement was received September 29, 2005. No Office action has been issued.

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Reexamination in application control No. 90/007,462 was ordered in a decision mailed May 25, 2005. A timely patent owner's statement was received July 25, 2005. A timely requester's reply to patent owner's statement was received September 29, 2005. No Office action has been issued.

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.

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Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. All papers mailed by the Office will take the form of a single action, which applies to all proceedings. All papers issued by the Office or as filed by the patent owner will contain the identifying data for all of the files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in triplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office.

Conclusion

Reexamination Control Nos. 90/007,451, 90/007,453 and 90/007,462 are hereby merged. Upon mailing of this decision, all files will be forwarded to the examiner for issuance of an Office action on the merits.

Any inquiry concerning this decision should be directed to Andres Kashnikow, Special Programs Examiner, at telephone No. (571) 272-4361.

Lissi Mojica Marquis, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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(For Patent Owner)

APR 13 2006

William A. Munck
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Dallas, TX 75380

(For 3rd Party Requester)

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For U.S. Patent No. : 6,794,634

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Filed : March 7, 2005
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Filed : March 12, 2005
For U.S. Patent No. : 6,794,634

DECISION MERGING
REEXAMINATION
PROCEEDINGS

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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.

<u>Requirement for Same Claims, Drawings, and Specification in Both Proceedings</u>

The patent owner is required to maintain identical claims, specifications, and drawings in both files. In view of the fact that both proceedings are identical, no amendment is necessary at this time.

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Conclusion

Reexamination Control Nos. 90/007,451, 90/007,453 and 90/007,462 are hereby merged. Upon mailing of this decision, all files will be forwarded to the examiner for issuance of an Office action on the merits.

Any inquiry concerning this decision should be directed to Andres Kashnikow, Special Programs Examiner, at telephone No. (571) 272-4361.

Lissi Mojica Marquis, Director
Central Reexamination Unit

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APR 14 2006

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Filed : March 9, 2005
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Filed : March 7, 2005
For U.S. Patent No. : 6,384,402

Reexam Control No.: 90/007,461
Filed : March 12, 2005
For U.S. Patent No. : 6,384,402

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REEXAMINATION
PROCEEDINGS

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[1] It is noted that a change of correspondence address has been received from patent owner's representative in reexamination proceedings 90/007,454 and 90/007,461 but not for reexamination proceeding 90/007,450. A change of correspondence address should also be filed for reexamination proceeding 90/007,450.

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.

Requirement for Same Claims, Drawings, and Specification in Both Proceedings

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Conclusion

Reexamination Control Nos. 90/007,450, 90/007,454 and 90/007,461 are hereby merged. Upon mailing of this decision, all files will be forwarded to the examiner for issuance of an Office action on the merits.

Any inquiry concerning this decision should be directed to Andres Kashnikow, Special Programs Examiner, at telephone No. (571) 272-4361.

Lissi Mojica Marquis, Director
Central Reexamination Unit

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.
90/007,455	03/08/2005	5028122	JSH2.001XX0	7329

23117 7590 06/29/2006

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/29/2006

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
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

6/29/06

James S. Hsue

PARSONS HSUE & DE RUNTZ LLP

655 Market Street Suite 1800

San Francisco, CA 94111

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007455

PATENT NO. 5,028,122

ART UNI 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a replly has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

UNITED STATES PATENT AND TRADEMARK OFFICE

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

BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
Falls Church, VA 22042-1248

(For Patent Owner)

MAILED

JUN 29 2006

CENTRAL REEXAMINATION UNIT

James S. Hsue
PARSONS HSUE & DE RUNTZ LLP
655 Market Street
Suite 1800
San Francisco, CA 94111

(For Requester)

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

In re: Hamada *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/007,455
Filed: March 08, 2005
For: US Patent No. 5,028,122

In re: Hamada *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/007,717
Filed: September 12, 2005
For: US Patent No. 5,028,122

The above-identified reexamination files are before the Director of the Central Reexam Unit 3992, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 5,028,122 issued on July 2, 1991.

2. *Ex Parte* Reexamination Proceeding, control no. 90/007,455, a reexamination requested by a third party requester was filed on March 08, 2005.

3. *Ex Parte* Reexamination Proceeding, control no. 90/007,717, a reexamination requested by a third party requester was filed on September 12, 2005.

4. *Ex Parte* Reexamination control no. 90/007,455 order was granted June 6, 2005 and awaits first office action on the merits from the examiner in charge.

5. *Ex Parte* Reexamination control no. 90/007,717 order was granted November 1, 2005 and awaits first office action on the merits from the examiner in charge.

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 90/007,455 and 90/007,717 reexamination proceedings are **merged**. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

Patent owner is required to maintain the same claims and specification in all files.

III. Conduct of Merged Proceeding.

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

CONCLUSION

1. Reexamination Control Nos. 90/007,455 and 90/007,717 are **merged**. The reexamination files are being forwarded to the examiner for issuing a first Office action.

2. 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

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

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

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
www.uspto.gov

BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
Falls Church, VA 22042-1248

(For Patent Owner)

MAILED

JUN 29 2006

CENTRAL REEXAMINATION UNIT

James S. Hsue
PARSONS HSUE & DE RUNTZ LLP
655 Market Street
Suite 1800
San Francisco, CA 94111

(For Requester)

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

In re: Hamada *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/007,455
Filed: March 08, 2005
For: US Patent No. 5,028,122

In re: Hamada *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/007,717
Filed: September 12, 2005
For: US Patent No. 5,028,122

The above-identified reexamination files are before the Director of the Central Reexam Unit 3992, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 5,028,122 issued on July 2, 1991.

2. *Ex Parte* Reexamination Proceeding, control no. 90/007,455, a reexamination requested by a third party requester was filed on March 08, 2005.

3. *Ex Parte* Reexamination Proceeding, control no. 90/007,717, a reexamination requested by a third party requester was filed on September 12, 2005.

4. *Ex Parte* Reexamination control no. 90/007,455 order was granted June 6, 2005 and awaits first office action on the merits from the examiner in charge.

5. *Ex Parte* Reexamination control no. 90/007,717 order was granted November 1, 2005 and awaits first office action on the merits from the examiner in charge.

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 90/007,455 and 90/007,717 reexamination proceedings are **merged**. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

Patent owner is required to maintain the same claims and specification in all files.

III. Conduct of Merged Proceeding.

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

CONCLUSION

1. Reexamination Control Nos. 90/007,455 and 90/007,717 are **merged**. The reexamination files are being forwarded to the examiner for issuing a first Office action.

2. 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
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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

Mark
MARK J. REINHART
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
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,458	03/10/2005	6569427	07588/024001	3835

7590 02/16/2006

PENNIE & EDMONS
1155 Avenue of the Americas
New York, NY 10036

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/16/2006

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
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Mailed :

DDJ

PENNIE & EDMONDS
1155 Avenue of the Americas
New York, NY 10036

(For Patent Owner)

Paul T. Clark
CLARK & ELBING LLP
101 Federal Street
Boston, MA 02110

(For 3rd Party Requester)

Reexam Control No.: 90/007,633
Filed : July 18, 2005
For U.S. Patent No.: 6,569,427

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexam Control No.: 90/007458
Filed: March 10, 2005
For U.S. Patent No.: 6,569,427

The above noted reexamination proceedings are before the Director of the Central Reexamination Unit for consideration of merger as provided for in 37 CFR 1.565(c).

Reexamination in application control No. 90/007,633 was ordered in a decision mailed September 13, 2005. No patent owner's statement has been filed in the instant proceeding, nor has an Office action been issued.

Reexamination in application control No. 90/007458 was ordered in a decision mailed April 27, 2005. No patent owner's statement has been filed in the instant proceeding, nor has an Office action been issued.

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.

Requirement for Same Claims, Drawings, and Specification in Both Proceedings

The patent owner is required to maintain identical claims, claim numbering, specifications, and drawings in both files. **Accordingly, patent owner is hereby 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 the third party requester and requester will be sent copies of all papers mailed by the Office. See 37 CFR 1.565(d).

Conclusion

Reexamination Control Nos. 90/007,633 and 90/007,548 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.

Any inquiry concerning this decision should be directed to Deborah Jones, Special Programs Examiner, at telephone No. (571) 272-1535.

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.
90/007,458	03/10/2005	6569427	07588/024001	3835

7590 02/16/2006

PENNIE & EDMONS
1155 Avenue of the Americas
New York, NY 10036

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/16/2006

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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PETER J. DEHLINGER
PERKINS COIE LLP
101 JEFFERSON DR.
P.O. BOX 2168
MENLO PARK CA 94026

(For Patent Owner)

MAILED

DEC 0 1 2006

CENTRAL REEXAMINATION UNIT

PAUL T. CLARK
CLARK & ELBING LLP
101 FEDERAL STREET
BOSTON, MA 02110

(For Third Party Requester)

In re Reexamination Proceeding :
Edward A. Boyse et al. :
Control No. 90/007,633 :
Filed: July 18, 2005 :
U.S. Patent No. 6,569,427 :
Attorney Docket No. 40923-8002.US00 :

In re Reexamination Proceeding :
Edward A. Boyse et al. :
Control No. 90/007,458 : DECISION GRANTING PETITION
Filed: March 10, 2005 :
U.S. Patent No. 6,569,427 :
Attorney Docket No. 40923-8002.US00 :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on November 7, 2006, by EFS-Web, 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."

12/01/2006 TMCDOUGA 00000004 502207 90007633
01 FC:1483 400.00 DA

A review of the record reveals that the above-identified reexamination proceeding petition under 37 CFR 1.137(b) papers, titled Petition to Accept an Unintentionally Delayed Response under 37 CFR §1.137(b), were submitted to the Office by EFS-Web on November 7, 2006. Reexamination proceeding papers, however, are not permitted to be submitted to the Office by EFS-Web (Note the Legal Framework for EFS-Web (http://www.uspto.gov/ebc/portal/efs/legal.htm)). Thus, the reexamination proceeding papers are not in compliance with 37 CFR 1.52. Unfortunately, due to processing delays, the Office did not promptly note and inform the patent owner of the non-compliance of the reexamination proceeding papers. In order to avoid loss of any rights and in view of processing delays by the Office, justice requires, in this instance and based on the present facts, that 37 CFR 1.52 be waived to the extent that the above-identified reexamination proceeding papers submitted by EFS-Web be considered as being properly submitted to the Office. In the present petition under 37 CFR 1.137(b), item 6 states the following: "Please charge any underpayment in fees for timely consideration of this Petition to Deposit Account No. 50-2207." As a petition and fee are necessary for a waiver of the rules to consider the present petition under 37 CFR 1.137(b), the item 6 provision of the petition is being taken as an authorization to charge deposit account No. 50-2207 the requisite $400.00 petition fee for the waiver of 37 CFR 1.52 (37 C FR 1.17(f)). In view of the above, 37 CFR 1.52 is **hereby waived** to the extent that the reexamination proceeding papers, titled Petition to Accept an Unintentionally Delayed Response under 37 CFR §1.137(b), submitted by EFS-Web on November 7, 2006, are now **accepted as being properly submitted to the Office.**

Petitioners are put on notice that further reexamination proceeding papers submitted to the Office by EFS-Web, will <u>not</u> be accepted, and such may result in loss of rights.

A further review of the record reveals that the present petition under 37 CFR 1.137(b) includes, <u>inter alia</u>, the requisite response (a mandatory statement of the substance of the interview (37 CFR 1.560(b)), herein titled Interview Under 35 U.S.C. §1.560(b) (*sic*) - 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 <u>granted</u>.

$1,900.00 ($1,500.00 for the petition fee under 1.17(m) and $400.00 for the petition fee under 37 CFR 1.17(f)) has been charged to counsel's deposit account no. 50-2207 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 including consideration of the mandatory statement of the substance of the interview (37 CFR 1.560(b)), herein titled Interview Under 35 U.S.C. §1.560(b) (*sic*), filed November 7, 2006, along with the present petition, <u>in due course</u>.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Padmashri Ponnaluri, in CRU Art Unit 3991, who can be reached at 571-272-0809.

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

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

Conferee: Kenneth M. Schor, Senior Legal Advisor

UNITED STATES PATENT AND TRADEMARK OFFICE

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Tim Klima
Harbin King & Klima
509 9th Street, S.E.
Washington, DC 20003[1]

(For Patent Owner)

APR 14 2006

William A. Munck
& Daniel E. Venglarik
P.O. Drawer 800889
Dallas, TX 75380

(For 3rd Party Requester)

Reexam Control No.: 90/007,450
Filed : March 9, 2005
For U.S. Patent No. : 6,384,402

Reexam Control No.: 90/007,454
Filed : March 7, 2005
For U.S. Patent No. : 6,384,402

Reexam Control No.: 90/007,461
Filed : March 12, 2005
For U.S. Patent No. : 6,384,402

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination proceedings are before the Director of the Central Reexamination Unit for consideration of merger as provided for in 37 CFR 1.565(c).

Reexamination in application control No. 90/007,450 was ordered in a decision mailed May 25, 2005. No patent owner's statement has been filed in the instant proceeding, nor has an Office action been issued.

Reexamination in application control No. 90/007,454 was ordered in a decision mailed May 25, 2005. A timely patent owner's statement was received July 25, 2005. A timely requester's reply to patent owner's statement was received September 29, 2005. No Office action has been issued.

Reexamination in application control No. 90/007,461 was ordered in a decision mailed May 25, 2005. A timely patent owner's statement was received July 25, 2005. A timely requester's reply to patent owner's statement was received September 29, 2005. No Office action has been issued.

[1] It is noted that a change of correspondence address has been received from patent owner's representative in reexamination proceedings 90/007,454 and 90/007,461 but not for reexamination proceeding 90/007,450. A change of correspondence address should also be filed for reexamination proceeding 90/007,450.

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.

Requirement for Same Claims, Drawings, and Specification in Both Proceedings

The patent owner is required to maintain identical claims, specifications, and drawings in both files. In view of the fact that both proceedings are identical, no amendment is necessary at this time.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. All papers mailed by the Office will take the form of a single action, which applies to all proceedings. All papers issued by the Office or as filed by the patent owner will contain the identifying data for all of the files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in triplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office.

Conclusion

Reexamination Control Nos. 90/007,450, 90/007,454 and 90/007,461 are hereby merged. Upon mailing of this decision, all files will be forwarded to the examiner for issuance of an Office action on the merits.

Any inquiry concerning this decision should be directed to Andres Kashnikow, Special Programs Examiner, at telephone No. (571) 272-4361.

Lissi Mojica Marquis, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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Tim Klima
Harbin King & Klima
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Washington, DC 20003

(For Patent Owner)

APR 13 2006

William A. Munck
& Daniel E. Venglarik
P.O. Drawer 800889
Dallas, TX 75380

(For 3rd Party Requester)

Reexam Control No.: 90/007,451
Filed : March 9, 2005
For U.S. Patent No. : 6,794,634

Reexam Control No.: 90/007,453
Filed : March 7, 2005
For U.S. Patent No. : 6,794,634

Reexam Control No.: 90/007,462
Filed : March 12, 2005
For U.S. Patent No. : 6,794,634

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination proceedings are before the Director of the Central Reexamination Unit for consideration of merger as provided for in 37 CFR 1.565(c).

Reexamination in application control No. 90/007,451 was ordered in a decision mailed May 25, 2005. A timely patent owner's statement was received July 25, 2005. A timely requester's reply to patent owner's statement was received September 29, 2005. No Office action has been issued.

Reexamination in application control No. 90/007,453 was ordered in a decision mailed May 25, 2005. A timely patent owner's statement was received July 25, 2005. A timely requester's reply to patent owner's statement was received September 29, 2005. No Office action has been issued.

Reexamination in application control No. 90/007,462 was ordered in a decision mailed May 25, 2005. A timely patent owner's statement was received July 25, 2005. A timely requester's reply to patent owner's statement was received September 29, 2005. No Office action has been issued.

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.

Requirement for Same Claims, Drawings, and Specification in Both Proceedings

The patent owner is required to maintain identical claims, specifications, and drawings in both files. In view of the fact that both proceedings are identical, no amendment is necessary at this time.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. All papers mailed by the Office will take the form of a single action, which applies to all proceedings. All papers issued by the Office or as filed by the patent owner will contain the identifying data for all of the files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in triplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office.

Conclusion

Reexamination Control Nos. 90/007,451, 90/007,453 and 90/007,462 are hereby merged. Upon mailing of this decision, all files will be forwarded to the examiner for issuance of an Office action on the merits.

Any inquiry concerning this decision should be directed to Andres Kashnikow, Special Programs Examiner, at telephone No. (571) 272-4361.

Lissi Mojica Marquis, Director
Central Reexamination Unit

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DEC 01 2006

CENTRAL REEXAMINATION UNIT

PETER J. DEHLINGER (For Patent Owner)
PERKINS COIE LLP
101 JEFFERSON DR.
P.O. BOX 2168
MENLO PARK CA 94026

PAUL T. CLARK (For Third Party Requester)
CLARK & ELBING LLP
101 FEDERAL STREET
BOSTON, MA 02110

In re Reexamination Proceeding	:
Edward A. Boyse et al.	:
Control No. 90/007,463	: DECISION GRANTING PETITION
Filed: March 14, 2005	:
U.S. Patent No. 6,461,645	:
Attorney Docket No. 40923-8003	:

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on November 7, 2006, by EFS-Web, 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."

12/01/2006 JACKOOGA 00000001 502207 90007463
01 FC:1462 400.00 DA

A review of the record reveals that the above-identified reexamination proceeding petition under 37 CFR 1.137(b) papers, titled Petition to Accept an Unintentionally Delayed Response under 37 CFR §1.137(b), were submitted to the Office by EFS-Web on November 7, 2006. Reexamination proceeding papers, however, are not permitted to be submitted to the Office by EFS-Web (Note the Legal Framework for EFS-Web

(http://www.uspto.gov/ebc/portal/efs/legal.htm)). Thus, the reexamination proceeding papers are not in compliance with 37 CFR 1.52. Unfortunately, due to processing delays, the Office did not promptly note and inform the patent owner of the non-compliance of the reexamination proceeding papers. In order to avoid loss of any rights and in view of processing delays by the Office, justice requires, in this instance and based on the present facts, that 37 CFR 1.52 be waived to the extent that the above-identified reexamination proceeding papers submitted by EFS-Web be considered as being properly submitted to the Office. In the present petition under 37 CFR 1.137(b), item 6 states the following: "Please charge any underpayment in fees for timely consideration of this Petition to Deposit Account No. 50-2207." As a petition and fee are necessary for a waiver of the rules to consider the present petition under 37 CFR 1.137(b), the item 6 provision of the petition is being taken as an authorization to charge deposit account No. 50-2207 the requisite $400.00 petition fee for the waiver of 37 CFR 1.52 (37 C FR 1.17(f)). In view of the above, 37 CFR 1.52 is **hereby waived** to the extent that the reexamination proceeding papers, titled Petition to Accept an Unintentionally Delayed Response under 37 CFR §1.137(b), submitted by EFS-Web on November 7, 2006, are **now accepted as being properly submitted to the Office**.

Petitioners are put on notice that further reexamination proceeding papers submitted to the Office by EFS-Web, will not be accepted, and such may result in loss of rights.

A further review of the record reveals that the present petition under 37 CFR 1.137(b) includes, inter alia, the requisite response (a mandatory statement of the substance of the interview (37 CFR 1.560(b)), herein titled Interview Under 35 U.S.C. §1.560(b) (*sic*) - 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.

$1,900.00 ($1,500.00 for the petition fee under 1.17(m) and $400.00 for the petition fee under 37 CFR 1.17(f)) has been charged to counsel's deposit account no. 50-2207 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 including consideration of the mandatory statement of the substance of the interview (37 CFR 1.560(b)), herein titled Interview Under 35 U.S.C. §1.560(b) (*sic*), filed November 7, 2006, along with the present petition, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Bennett Celsa, in CRU Art Unit 3991, who can be reached at 571-272-0807.

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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,468	03/17/2005	6797286	10321/52552	3216

7590 09/25/2008

EXAMINER

Ellis & Venable, PC
101 North First Ave.
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ART UNIT	PAPER NUMBER

DATE MAILED: 09/25/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
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www.uspto.gov

Michael F. Campillo
Venable, Campillo, Logan & Meaney, PC
1938 E. Osborn Rd.
Phoenix, Arizona 85016

For Patent Owner

MAILED

SEP 25 2008

CENTRAL REEXAMINATION UNIT

David W. Denenberg
Davidoff, Malito & Hutcher, LLP
605 3rd Avenue – 34th Floor
New York, NY 10158

For Requester

Ex Parte Reexamination Proceeding
Control No. 90/007,468
Filed: March 17, 2005
For: US Patent No. 6,797,286

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

This is a decision on the petition filed March 24, 2008 to request a four-month extension of time pursuant to 37 CFR 1.550(c) to respond to the Final rejection mailed September 24, 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 file a response to the Final rejection mailed September 24, 2007. The request 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. (emphasis added in italics).

Analysis and Findings

On September 24, 2007 a Final office action was mailed to the address of record in this proceeding at that time. There is no record of returned mail in the file. The time for response was two months from the mailing date of September 24, 2007. As indicated in 37 CFR 1.550(c), any request for additional time 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. The petition for extension of time was not filed until March 24, 2008, which is after the expiration of the time for response. Therefore, the petition for extension of time fails to comply with 37 CFR 1.550(c), and accordingly, is dismissed.

In regard to the failure to receive the Office action of September 24, 2007, it is incumbent on patent owner to keep the Office informed of any changes in correspondence address. The reexamination proceeding has been terminated due to failure to file a timely response. Patent owner may file a petition under 37 CFR 1.137 to revive an unavoidable or unintentionally terminated reexamination proceeding. The petition should include a response to the Final Office action as well as the appropriate petition fee. See MPEP 2268 for more information.

Conclusion

The Patent Owner's petition for extension of time of four months in which to file a response to the Final Office action of September 24, 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 Gregory A. Morse,
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.
90/007,468	03/17/2005	6797286	10321/52552	3216

26948 7590 02/13/2009

VENABLE, CAMPILLO, LOGAN & MEANEY, P.C.
1938 E. OSBORN RD
PHOENIX, AZ 85016-7234

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
DAVID W. DENENBERG
DAVIDOFF MALITO & HUTCHER LLP
605 THIRD AVENUE - 34TH FLOOR
NEW YORK, NY 10158

Date:
MAILED

FEB 13 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007468
PATENT NO. : 6797286
ART UNIT : 3900

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

UNITED STATES PATENT AND TRADEMARK OFFICE

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FEB 13 2009

CENTRAL REEXAMINATION UNIT

Michael F. Campillo (For Patent Owner)
Venable, Campillo, Logan & Meaney, PC
1938 E. Osborn Rd.
Phoenix, Arizona 85016

David W. Denenberg (For Third Party Requester)
Davidoff, Malito & Hutcher, LLP
605 3rd Avenue- 34th Floor
New York, NY 10158

In re Bobrowski :
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/007,468 : **DISMISSING**
Filed: March 17, 2005 : **PETITION**
For: U.S. Patent No. 6,797,286 :

This is a decision on the November 14, 2008 patent owner submission styled "Petition for extension of time pursuant to 37 CFR 1.137," which requests the Office to revive the reexamination based on the proceeding being unintentionally abandoned. The present petition is being treated as a petition to accept a delayed response for the instant reexamination proceeding under the "unintentional" delay standard pursuant to 37 CFR 1.137(b).

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

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

37 CFR 1.137(b) states:

> (b) *Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination 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.

A grantable petition for entry of belated papers under 37 CFR 1.137(b) must be accompanied by (1) the proposed response to the outstanding Office action, (2) the petition fee (set in 37 CFR 1.17(m)) required by law, and (3) a proper statement that the entire delay from the due date for the response to the filing of a grantable petition was unintentional. The present proceeding is a reexamination proceeding; thus, the petition does not require a terminal disclaimer (item 4). 37 CFR 1.137(d)(3).

Petitioner has supplied items (1) and (2).

Effective December 1, 1997, 37 CFR 1.137(b)(3) requires the submission of a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." [1] The present petition is incomplete as to item (3), because this required statement has not been made by patent owner.

PETITION FEE

The Office records show the patent owner to be a small entity. A small entity fee of $810.00 under 37 CFR 1.17(m) is required for a petition under 37 CFR 1.137(b). Patent owner's authorization to charge $770.00 was enclosed with the petition. The balance of $40 has been charged to petitioner's deposit account number 50-2085 as per petitioner's instructions on page 1 of the Petition Fee Transmittal Form PTO /SB/17p to charge "any deficiency of fees and credit of any overpayments."

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:**

---

[1] For reexamination proceedings, the word "reply" is to be replaced by "response."

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.

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 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.

5. **All** correspondence relating to this *ex parte* reexamination proceeding should be directed:

By EFS: Registered users may submit via the electronic filing system EFS-Web, at https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html.

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

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

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

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

6. Telephone inquiries related to the present decision should be directed to the Susy Tsang-Foster, Legal Advisor, at 571-272-7711.

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,468	03/17/2005	6797286	10321/52552	3216

26948 7590 03/30/2009

VENABLE, CAMPILLO, LOGAN & MEANEY, P.C.
1938 E. OSBORN RD
PHOENIX, AZ 85016-7234

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/30/2009

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

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605 THIRD AVENUE
NEW YORK, NY 10158

MAILED

MAR 30 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007468

PATENT NO. 6,797,286

ART UNI 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a 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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Michael F. Campillo
Venable, Campillo, Logan & Meaney, PC
1938 E. Osborn Rd.
Phoenix, Arizona 85016

(For Patent Owner)

MAILED

MAR 3 0 2009

CENTRAL REEXAMINATION U.

David W. Denenberg
Davidoff, Malito & Hutcher, LLP
605 3rd Avenue- 34th Floor
New York, NY 10158

(For Third Party Requester)

In re Bobrowski
Ex Parte Reexamination Proceeding
Control No. 90/007,468
Filed: March 17, 2005
For: U.S. Patent No. 6,797,286

: **DECISION**
: **GRANTING**
: **PETITION UNDER**
: **37 CFR 1.137(b)**

This is a decision on the March 5, 2009 patent owner renewed petition entitled "Renewed Petition under 37 CFR § 1.137(b)," as supplemented on March 24, 2009. The petition (as supplemented) is being treated as a petition under 37 CFR 1.137(b) to accept an unintentionally delayed Notice of Appeal and revive the present terminated reexamination prosecution.

The appropriate fees of $270 and $810 set forth in 37 CFR 41.20(b)(1) and 37 CFR 1.17(m), respectively, for the Notice of Appeal filed on March 24, 2009 and the present petition filed under 37 CFR 1.137(b), have been paid.

The present renewed petition under 37 CFR 1.137(b) and the 90/007,468 *ex parte* reexamination proceeding are before the Office of Patent Legal Administration for consideration.

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

RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURES

35 U.S.C. 41(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.

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 1.113 provides, in pertinent part:

(a) 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.

*

*

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

37 CFR 1.137 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).

MPEP 711.03(c)(II)(A)(2)(b) provides, in pertinent part:

A reply under 37 CFR 1.113 to a final action must include ... cancellation of, or appeal from the rejection of, each claim so rejected. Accordingly, ... the reply required for consideration of a petition to revive must be:

(A) a Notice of Appeal and appeal fee; [or]

(B) an amendment under 37 CFR 1.116 that cancels all the rejected claims or otherwise prima facie places the application in condition for allowance;

*

*

When a notice of appeal is the reply filed pursuant to 37 CFR 1.137(a)(1) or 1.137(b)(1), the time period under 37 CFR 41.37 for filing the appeal brief will be set by the Director of the USPTO in the decision granting the petition.

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 III, for a detailed discussion of the requirements of petitions filed under 37 CFR 1.137(a) and (b).

DECISION

The Petition Under 37 CFR 1.137(b) is Granted

A grantable petition under 37 CFR 1.137(b) for a reexamination proceeding 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.

Patent owner submitted a Notice of Appeal as part of the March 24, 2009 Supplemental Petition under 37 CFR 1.137(b) and paid the corresponding fee of $270.00 on March 24, 2009, thereby satisfying item (1).[1] A petition fee of $810 was submitted on November 14, 2008, thereby satisfying item (2). A proper statement under 37 CFR 1.137(b)(3) was submitted as part of the March 3, 2009 patent owner renewed petition under 37 CFR 1.137(b) to revive, thereby satisfying item (3). The present proceeding is a reexamination proceeding; thus, the petition does not require a terminal disclaimer (item 4). 37 CFR 1.137(d)(3)

Accordingly, the present petition under 37 CFR 1.137(b) to revive is **granted.**

In view of the foregoing, the prosecution in the above-noted reexamination proceeding will be resumed. Jurisdiction over the proceeding will be forwarded to the examiner for action consistent with this decision. Both the NIRC issued on March 20, 2008, and the reexamination certificate issued on January 6, 2009, are hereby **vacated**.

ERRATUM

The Reexamination Certificate No. C1 6,797,286 issued January 6, 2009, is no longer correct, and is hereby **vacated**.

Accordingly, the following erratum will be duly published in the *Official Gazette*:

> All reference to Reexamination Certificate No. C1 6,797,286 to Bobrowski of Scottsdale, AZ (US) for METHODS AND PREPARATIONS OF EXTRACTS OF UNCARIA SPECIES WITH REDUCED ALKALOID CONTENT, appearing in the *Official Gazette* of January 6, 2009 should be deleted, since the reexamination certificate has been vacated.

CONCLUSION

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

[1] See MPEP 2268(IV) and MPEP 711.03(c)(II)(A)(2)(b).

2. The termination of prosecution rendered via the March 20, 2008 NIRC, and the NIRC itself, are vacated.

3. The *Ex Parte* Reexamination Certificate issued January 6, 2009 is vacated. Jurisdiction over the '286 patent is forwarded to the Office of Patent Publication for further processing consistent with this decision.

4. Jurisdiction of the reexamination proceeding is being forwarded to the Central Reexamination Unit (CRU), Art Unit 3991, for further processing in view of the March 24, 2009 Notice of Appeal and consideration of the March 24, 2008 after-final amendment in due course.

5. The time period for filing an appeal brief is set to expire **TWO MONTHS** from the mailing date of this decision. See MPEP 711.03(c)(II)(A)(2)(b). The time period is extendable under the provisions of 37 CFR 1.550(c). See 37 CFR 41.37(e).

6. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Evelyn Huang, of CRU Art Unit 3991, at (571) 272-0686.

7. Any inquiry concerning this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

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

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OCT 05 2007

CENTRAL REEXAMINATION UNIT

Ole K. Nilssen
200 N. Harrison St., Suite 103
Algonquin IL 60102

(Patent Owner)

Virgil L. Beaston
STERNE KESSLER GOLDSTEIN & FOX PLLC
1100 New York Avenue NW
Washington, DC 20025-3934

(For Requester)

In re Nilssen
Ex parte Reexamination Proceeding Control Nos. 90/007,480 and 90/007,930
Filed: March 25, 2005 and February 13, 2006
For: U.S. Patent No.: 5,233,270

In re Nilssen
Ex parte Reexamination Proceeding Control Nos. 90/007,518 and 90/007,823
Filed: April 22, 2005 and November 23, 2005
For: U.S. Patent No.: 5,416,386

In re Nilssen
Ex parte Reexamination Proceeding Control No.: 90/007,983
Filed: March 24, 2006
For: U.S. Patent No.: 6,172,464

In re Nilssen
Ex parte Reexamination Proceeding Control No.: 90/007,470
Filed: March 18, 2005
For: U.S. Patent No.: 4,857,806

In re Nilssen
Ex parte Reexamination Proceeding Control No.: 90/007,864
Filed: January 4, 2006
For: U.S. Patent No.: 5,343,123

DECISION ON PETITION UNDER 37 CFR 1.182 REGARDING EXTENDED EXAMINER INTERVIEW

This is a decision on the September 26, 2007 patent owner petition filed in each of the above-identified proceedings to conduct an extended personal interview with the Examiner for the duration of five hours to discuss each of the above-identified proceedings.

The petition is before the Office of Patent Legal Administration for consideration of whether the request for an extended interview should be granted.

The petition is dismissed.

REVIEW OF SALIENT FACTS

1. On September 25, 2007, the patent owner contacted Examiner Escalante and requested a personal interview for the above-identified proceedings. The examiner granted the initial request and indicated that the duration of the interview would not exceed one hour.

2. The patent owner filed a petition on Sept. 26, 2007, in each of the above identified proceedings "to confirm that Owner is entitled to interview the Examiner for a duration of one hour per patent at issue, or a total of five (5) hours for the above five (5) captioned reexamination proceedings."

3. Payment of the petition fees required for each proceeding was completed on October 4, 2007, thus affecting entry of the petitions in each respective proceeding on this date.

4. The status of each proceeding is as follows:

(a) Control nos. 90/007,480 & 90/007,930 have been merged. A final office action was mailed July 3, 2007. An amendment in response to the final office action was filed Sept. 7, 2007.

(b) Control nos. 90/007,518 & 90/007,823 have been merged. A non–final office action was mailed May 30, 2007. A petition for accepting the filing of late papers was filed Sept. 14, 2007.

(c) Control no. 90/007,983 received a non-final office action mailed on May 17, 2007. An amendment in response to the non-final office action was filed July 19, 2007.

(d) Control no. 90/007,470 received a final office action mailed June 29, 2007. An amendment in response to the final office action was filed Sept. 4, 2007, and a Notice of Appeal was filed Oct. 1, 2007.

(e) Control no. 90/007,864 received a non-final office action mailed May 29, 2007. An amendment in response to the non-final office action was filed July 2, 2007.

5. Each proceeding has received at least one office action and has had a response* filed therein by patent owner awaiting action.

6. Each proceeding has claims rejected on different grounds based on different prior art references.

DISCUSSION

Interviews in *ex parte* reexamination proceedings are governed by 37 CFR 1.560, which reads:

Interviews in *Ex Parte* reexamination proceedings.

(a) Interviews in *ex parte* reexamination proceedings pending before the Office between examiners and the owners of such patents or their attorneys or agents of record must be conducted in the Office at such times, within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Director. Interviews for the discussion of the patentability of claims in patents involved in *ex parte* reexamination proceedings will not be conducted prior to the first official action. Interviews should be arranged in advance. Requests that reexamination requesters participate in interviews with examiners will not be granted.

(b) In every instance of an interview with an examiner in an *ex parte* reexamination proceeding, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner. An interview does not remove the necessity for response to Office actions as specified in § 1.111. Patent owner 's response to an outstanding Office action after the interview does not remove the necessity for filing the written statement. The written statement must be filed as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.

---

* It is noted that merged proceeding control no. 90/007,480 does not have a amendment filed therein, but has a petition awaiting decision to accept a late response.

As explained in MPEP 2281:

> In the case where the patent owner desires to initiate an interview, the patent owner should initially contact the examiner in charge of the proceeding to indicate what issues are sought to be discussed, and to determine if an interview will be granted. If the examiner agrees to grant the interview, the patent owner must file, at least three (3) working days prior to the interview, a written statement of the issues to be discussed at the interview, and a copy of any proposed claims to be discussed, unless examiner waives this requirement. This provision will provide structure to the interview so as to facilitate the statutory mandate for special dispatch.
>
> The duration of the interview will not exceed one hour, unless the patent owner files a petition under 37 CFR 1.182 showing sufficient cause where more time is needed. In a reexamination proceeding, the invention should be well defined after the patent has issued, and it is simply a matter of defining the claims over art applied, to the extent such is deemed necessary. An hour of time in a structured planned interview should be sufficient to accomplish this, and in those rare instances where it is not, a patent owner may show cause to extend the time. During the interview, the examiner is always free to extend the duration of the interview to discuss issues that the examiner deems appropriate for (further) discussion. Such an extension of the duration of the interview is permitted at the examiner's sole discretion.
>
> Only one interview may be requested after an Office action and prior to filing the response to that action, absent a showing of good cause to conduct a second interview during this period.

DECISION

Interviews are ***permitted*** during reexamination proceedings and are granted at the discretion of the examiner if they are deemed to facilitate prosecution with special dispatch. Interviews may be requested after an Office action, prior to filing a response to that action, in order to define the claims over the applied prior art. As the interview must be conducted in a structured and planned manner, one hour of time should be sufficient to accomplish this.

The patent owner has requested that five different reexamination proceedings be discussed during one personal interview and that one hour be allotted to each proceeding to result in a personal interview with a duration of five hours.

Each of the proceedings is at a different stage of prosecution. Each of the proceedings has different prior art rejections applied against the claims, with a total of at least ten (10) different prior art references being at issue. Responses have already been filed in the proceedings and are awaiting action.

An extended interview in this case, which would raise numerous different issues, involve proceedings at various stage of prosecution, and be conducted over a lengthy period of time, would not be productive and would not facilitate the handling of these cases with special dispatch. The patent owner acknowledges in the petition that there are "a multitude of issues to be discussed" and that additional issues relating to priority particular to only two of the proceedings will be raised.

The goal of conducting a targeted, planned interview to define the claims over the prior art would not be accomplished by combining five different sets of claims and over ten different prior art references along with a variety of other issues in a single discussion. Moreover, none of these proceedings are at an appropriate stage of prosecution during which interviews are normally granted. Further, such a lengthy interview would not be an efficient use of Office resources and would not serve the public interest.

It is also noted that the petition states the patent owner is entitled to an interview in each proceeding and is entitled to one hour for each interview. Interviews are *permitted* at the discretion of the examiner; interviews are not entitlements. Further, the manual states that an interview *will not exceed one hour*. Interviews are not guaranteed to last one hour and may be held for less than one hour at the discretion of the examiner in the interest of expediting prosecution in an efficient manner.

The patent owner has not provided a sufficient showing of good cause as to why additional time, especially for a time period of five hours, in which to conduct an interview should be permitted in this situation. The petition states that patent owner's request is for reasons of efficiency, to conserve resources, and to lessen the amount of travel time. Economic and time considerations for the patent owner do not give rise to an adequate showing as there are other means of communication, including the telephone, available to the patent owner to interact with the examiner.

CONCLUSION

1. The petition requesting an extended personal examiner interview conducted at one time for all of the above identified proceedings is dismissed.

2. The patent owner is required to identify which one of the above proceedings will be the subject of the personal interview and indicate what issues are sought to be discussed so that the examiner can determine if an interview will be granted.

3. If the examiner agrees to grant the interview, the patent owner must file, at least three (3) working days prior to the interview, a written statement of the issues to be discussed at the interview along with a copy of any proposed claims to be discussed unless the examiner waives this requirement.

4. The duration of the interview for an individual proceeding, if granted, will not exceed one hour.

5. The patent owner is reminded that merged proceedings require papers to be filed in each proceeding within the merged proceeding. In this case, patent owner filed a single petition in each of the merged proceedings, which is not in accordance with the guidelines set forth in the merger decision. The petition must be filed in each proceeding in the merged proceedings. In this instance, the Office has waived this procedure, but this is not to be construed as a waiver as to future filings. A paper must be filed in each proceeding within the merged proceedings going forward.

6. Telephone inquiries related to this decision should be directed to Caroline Dennison, Legal Advisor, at (571) 272-7729.

Stephen Marcus
Legal Advisor
Office of Patent Legal Administration

cdd
October 4, 2007

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JUL 25 2006

CENTRAL REEXAMINATION UNIT

Louis J. Hoffman, PC 14614 North Kierland Boulevard, Suite 300 Scottsdale, AZ 85254	: : :	For Patent Owner
In re: Edward T. Bullister *Ex Parte* Reexamination Proceeding Control No. 90/007,471 Filed: March 18, 2005 For: US Patent No. 6,172,665	: : : : :	DECISION DENYING PETITION FOR EXTENSION OF TIME [37 CFR 1.550(c)]

This is a decision on the July 13, 2006, Patent Owner "Request for Extension of Time to Respond to Reexamination Office Action" requesting that the time for responding to the Office action dated May 17, 2006 be extended by two weeks.

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 Office action dated May 17, 2006, which set a two month date for filing a response thereto. The Office action is a non-final Office action, and the request for extension is the first request for an extension of time with respect to the outstanding Office action. The present petition for extension of time was timely filed on July 13, 2006, together with authorization to charge a credit card account for the $200.00 petition fee 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. ...
>
> The reasons stated in the request will be evaluated by the TC Director, and the requests will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response within the statutory time period.

The present request fails to include a complete statement of "sufficient cause" as to why the requested extension is needed and warranted. The request does not include (a) a statement of what action the patent 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 one month is needed.

Patent Owner notes as the sole reason for the extension of time that an interview is scheduled with the examiner for July 19, 2006, 'the first convenient date for the interview.' There is nothing in the scheduling of an interview which would preclude Patent Owner from completing and submitting a complete response to the outstanding Office action, and merely scheduling an interview in no way relieves Patent Owner of the duty to timely file a response.

Moreover, the request fails to provide any factual information as to reasonably diligent behavior by all those responsible for preparing a response.

Conclusion

1. The patent owner's petition for extension of time filed on July 13, 2006 is <u>denied</u>.

2. Further correspondence can be directed to the following:

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

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

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

3. Telephone inquiries with regard to this decision should be directed to Gregory Mills, Quality Assurance Specialist in the Central Reexamination Unit, at (571) 272-1439.

Lissi Mojica Marquis,
Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,472	03/21/2005	6597688	12566/8	5862

23838 7590 12/27/2007
KENYON & KENYON LLP
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SUITE 700
WASHINGTON, DC 20005

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/27/2007

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Fort Lauderdale, FL 33301

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/007,472*.

PATENT NO. *6597688*.

ART UNIT *3992*.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

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B. Delano Jordan
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(For Patent Owner)

MAILED

DEC 27 2007

CENTRAL REEXAMINATION UNIT

Christopher & Weissburg, P.A.
200 East Las Olas Boulevard
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Fort Lauderdale, FL 33301

(For Third Party Requester)

In re Charles BoBo, II
Reexamination Proceeding
Control No.: 90/007,472
Filed: March 21, 2005
For: U.S. Patent No.: 6,597,688

: **DECISION**
: **ON PETITION**
: **UNDER 37 CFR 1.182**

This is a decision on the November 30, 2007 patent owner petition under 37 CFR 1.182 to enter, and to have the examiner consider, an information disclosure statement (IDS) filed after the termination of the prosecution in this reexamination proceeding.

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

The petition is dismissed for the reasons set forth below.

Thus, the IDS filed November 30, 2007, has not been entered for consideration by the examiner.

BACKGROUND

1. Patent number 6,597,688 issued on July 22, 2003.
2. A request for reexamination, assigned control No. 90/007,472 (the '7472 proceeding), was filed on March 21, 2005 by a third party requester.
3. On May 12, 2005 the Office issued an order granting the '7472 reexamination request.
4. The'7472 proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) issued on November 26, 2007.
5. On November 30, 2007, the instant petition was submitted with an IDS, which the patent owner requests the Office to consider.
6. The reexamination proceeding is being processed toward publication of the reexamination certificate.

RELEVANT LAW AND PROCEDURE

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

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

MPEP 2256

.....Once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by **(A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding.** This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC.

Once the reexamination has entered the Reexamination Certificate publication process, pulling the proceeding from that process provides an even greater measure of delay. 37 CFR 1.313 states for an application (emphasis added):

> "(c) Once the issue fee has been paid, the application will not be withdrawn from issue upon petition by the applicant for any reason except:
> (1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;"

The publication process for an application occurs after the payment of the issue fee (there is no issue fee in reexamination), and thus 37 CFR 1.313(c) applies during the publication cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its publication cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). Accordingly, where a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), is made while a proceeding is in its publication cycle, the patent owner must provide an unequivocal statement as to why the art submitted makes at least one claim unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable. This is in addition to the above-discussed (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier. The submission of patents and printed publications must be accompanied by a petition under 37 CFR 1.182 (with petition fee) for withdrawal of the reexamination proceeding from the publication process for entry and consideration of the information submitted by patent owner. A grantable petition must provide the requisite showing discussed in this paragraph. (Emphasis added)

DECISION

In a reexamination proceeding, there is no 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 proceeding from the publication process, for consideration of the accompanying IDS papers, has been appropriately filed under 37 CFR 1.182.

While there is no regulatory provision for withdrawal of a <u>reexamination proceeding</u> from the publication process for consideration of an IDS, the policy for withdrawal from the publication process, after the NIRC has been mailed but before the proceeding has actually entered the printing cycle, is explicitly set forth in MPEP 2256 as follows:

> ...Once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by **(A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination**

proceeding. This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC.

In the present instance, the submission fails to satisfy both items (A) and (B), because there is neither a factual accounting to explain why the information submitted could not be submitted earlier or an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. The instant petition was filed very late in the reexamination proceeding, and no attempt is made to satisfy the guidance of MPEP 2256. To the contrary, patent owner treats the IDS submission as if prosecution on the merits is still ongoing. The patent owner has not provided a discussion of the substance of the information, and has neither made a factual accounting to explain why the information is being submitted so late or explained the relevance of the same with respect to the claim limitations in the present reexamination proceeding.

In summary, there is no factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier; nor is there an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. Therefore, the present petition does not satisfy the requirements for a petition submitted for consideration of an IDS after the NIRC has been mailed.

For *ex parte* reexamination, 35 U.S.C. 305 provides that all *ex parte* reexamination proceedings "will be conducted with special dispatch within the Office." A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on February 16, 2007, and the proceeding is being prepared to enter the final stages of the publication process. The proceeding is clearly not scheduled to come up for further action on the merits. In order to provide the requested relief, the present proceeding would need to be withdrawn from the publication process, thus significantly regressing the processing of the proceeding. This would run contrary to the statutory requirement of 35 U.S.C. 305 that "[a]ll reexamination proceedings under this section...will be conducted with special dispatch within the Office." The statutory mandate of special dispatch is based upon the public interest in providing certainty and finality as to the question of patentability raised by a request for reexamination. In view of the submission of the IDS information after termination of the prosecution in this reexamination proceeding, and the failure to provide the requisite discussion (explanation) of the submitted art citations, the present reexamination proceeding will not be reopened at this late date to consider the proffered IDS papers. Accordingly the petition is dismissed as to the request for consideration of the IDS papers.

If, however, the patent owner in fact believes that any reference submitted raises a substantial question of patentability as to at least one claim of the patent *different* than raised in this proceeding, the patent owner can always file a new request for reexamination for consideration of such reference(s).

The IDS submitted by patent owner will be placed in the file, and will remain of record. However, since prosecution has been terminated for this reexamination proceeding, the IDS will not be considered by the examiner.

CONCLUSION

1. The petition is dismissed as to the request for consideration of the IDS filed on November 30, 2007.

2. The IDS papers have not been considered by the examiner. A copy of the IDS submission will, however, be placed in the electronic image file wrapper (IFW) for the proceeding.

3. The present proceeding will continue in the publication process, toward issuance of a reexamination certificate.

4. Telephone inquiries related to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759.

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

12-25-07
c:\Kiva\kenids\decisions\7472 IDS after NIRC mailed_450 status.doc

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Westerman, Hattori, Daniels & Adrian, LLP
1250 Connecticut Avenue, NW
Suite 700
Washington, DC 20036

(For Patent Owner)

MAILED

AUG 15 2007

CENTRAL REEXAMINATION UNIT

Stoel Rives LLP
900 SW Fifth Avenue
Suite 2600
Portland, OR 97204

(For 3rd Party Requester)

Reexam Control No.: 90/007,475
Filed : March 23, 2005
For U.S. Patent No. : 5,575,925

Reexam Control No.: 90/008,060
Filed : May 17, 2006
For U.S. Patent No. : 5,575,925

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination proceedings are before the Director of the Central Reexamination Unit for consideration of merger as provided for in 37 CFR § 1.565(c).

Reexamination in application control No. 90/007,475 was ordered in a decision mailed May 27, 2005. Prosecution proceeded to the mailing of a Notice of Intent to Issue an *Ex Parte* Reexamination Certificate (NIRC) on April 3, 2006. An amendment to the claims was filed on January 23, 2006. The NIRC took into consideration the amended claims. A decision vacating the NIRC was mailed August 14, 2007.

Reexamination in application control No. 90/008,060 was ordered in a decision mailed July 31, 2006. Patent Owner filed a Patent Owner's statement under the provisions of 37 CFR § 1.530 (c) and (d) on October 2, 2006 (timely as September 30th fell on a Saturday). Third Party Requester filed a reply to Patent Owner's statement under the provisions of 37 CFR §1.53. No Office action has been issued in this proceeding. There have been no amendments to the claims, specification and drawings in this reexamination proceeding.

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.

Requirement for Same Claims, Drawings, and Specification in both Proceedings

As noted above, the claims have been amended in the '475 reexamination proceeding by virtue of the amendment filed January 23, 2006. No amendments have been filed in the '060 proceeding. The patent owner is required to maintain identical claims, claim numbering, specifications, and drawings in each of the files. **Accordingly, Patent Owner is hereby**

required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in each of the two 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 Third Party Requester and requester will be sent copies of all papers mailed by the Office. Where a paper is filed which requires a fee (e.g., petition fee, excess claims fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid.

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 Office action in order to place the files in that condition.

Conclusion

Reexamination Control Nos. 90/007,475 and 90/008,060 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 each of the files.** Upon receipt of the response, an Office action will issue in due course.

Any inquiry concerning this decision should be directed to Andres Kashnikow, Special Programs Examiner, at telephone No. (571) 272-4361.

Lissi Mojica Marquis,
Director
Central Reexamination Unit

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.
90/007,478	03/23/2005	6469012	0901-001	9685

7590 08/19/2005

EXAMINER

ART UNIT	PAPER NUMBER

Gregg C. Benson Esq.
Pfizer, Inc.
Patent Department MS4159
Eastern Point Road
Groton, CT 06340

DATE MAILED: 08/19/2005

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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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	DECISION MERGING REEXAMINATION PROCEEDINGS
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	

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)

ICOS CORPORATION
ATTN: SEAN W. O'DEA, ESQ
22021 20TH AVENUE, SE
BOTHELL, WA 98021

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/007,478*.

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)).

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 0 8 2005
REEXAM UNIT

In re Ellis et al.
Reexamination Proceeding
Control No.: 90/007,614
Filed: July 05, 2005
For: U.S. Patent No. 6,469,012

In re Ellis et al.
Reexamination Proceeding
Control No.: 90/007, 478 ✓
Filed: March 23, 2005
For: U.S. Patent No. 6,469,012

In re Ellis et al.
Reexamination Proceeding
Control No.: 90/007,110
Filed: July 7, 2004
For: U.S. Patent No. 6,469,012

DECISION
DISMISSING
PETITION

In re Ellis et al.
Reexamination Proceeding
Control No.: 90/006,886
Filed: December 15, 2003
For: U.S. Patent No. 6,469,012

In re Ellis et al.
Reexamination Proceeding
Control No.: 90/006,617
Filed: September 29, 2003
For: U.S. Patent No. 6,469,012

This is a decision on the August 22, 2005 patent owner PETITION UNDER 37 C.F.R. § 1.182 FOR PRESERVATION OF *EX PARTE* REEXAMINATION PROCEDURE.

On a page titled "Authorization to Charge Fees," petitioner authorizes payment of a $130 fee "which is due in accordance with 37 C.F.R. § 1.17(h)," as well as "any additional fees that may be owed." 37 CFR 1.182 states that "[a]ny petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f)." Pursuant to 37 CFR 1.17(f), the fee for filing a petition under 37 CFR § 1.182 is $400. Accordingly, the required petition fee of $400 is being charged to petitioner's Deposit Account No. 16-1445.

The present petition 37 CFR 1.182 is before the Office of Patent Legal Administration.

The petition is dismissed for the reasons set forth below.

BACKGROUND

This decision is issued in response to the petition under 37 CFR 1.182, filed August 30, 2005, with regard to newly filed Reexamination Proceeding 90/006,714, filed July 5, 2005 as to the interface of the '6714 proceeding with the merged proceeding of reexamination Control Nos. 90/006,617, 90/006,886, and 90/007,110, for reexamination of U.S. Patent 6,469,012. It is noted that Reexamination Proceeding 90/007,478, filed March 23, 2005, has also been merged with the '6617, '6886 and '7110 proceedings.

As the patent owner points out on page 2 of the petition, the '6617 reexamination proceeding was a Director initiated proceeding, that was initiated on September 29, 2003. On December 15, 2003, Lilly Corporation filed a first third party requester request for reexamination of the '012 patent, resulting in the '6886 proceeding. On July 7, 2004, Bayer AG filed a second third party requester request for reexamination of the '012 patent, resulting in the '7110 proceeding. Both third party requester reexamination proceedings were ordered, and the three reexamination proceedings were subsequently merged. Each proceeding raised a substantial new question of patentability (SNQ) based on a number of different references. The SNQs were similar, but not identical.

Following merger of the three proceedings, a first Office action on the merits issued for the merged proceeding on February 10, 2005, setting a two month shortened statutory time period for response. The patent owner replied to the Office action on April 8, 2005, traversing the sole ground of rejection of record. Prior to the patent owner's response, ICOS Corporation filed a new (the fourth) third party requester request for reexamination of the '012 patent, resulting in the 90/007,478 proceeding, and citing several new references which raised a new and different SNQ of the pending claims. The new proceeding was ordered, and it was subsequently merged with the previously merged proceedings on August 19, 2005. It is noted that the patent owner appears to equate Lilly Corporation and ICOS Corporation as the same entity; however, persuasive evidence has not been provided to support this apparent assertion, and the correspondence addresses are different.

On July 5, 2005, Lilly Corporation filed a fifth request for reexamination of the '012 patent, the present 90/007614 proceeding, This request was determined by the Office not to cite any new and different patents or printed publications which would raise a new SNQ not already of record in the merged reexamination proceeding then pending. Accordingly, the request for reexamination was denied in the Order mailed August 18, 2005. The present petition appears to have been filed by the patent owner prior to receiving the Order denying the '7614 request.

DECISION

Patent Owner's petition requests that: (1) the evaluation of the '7614 request should be assigned to a different examiner not involved with the consideration of the merged proceeding; (2) if reexamination is ordered, the proceeding should be kept separate from the merged proceeding; (3) the IDS filed with the '7614 request should not be considered in the merged proceeding; (4) the examiner of the merged proceeding should be instructed to disregard the '7614 request or proceeding; and (5) that ICOS be directed to not file any further reexamination requests.

As to the examiner assignment of the '7614 request for determination of whether to order reexamination or not, a decision not to order reexamination was already made prior to the filing of this petition and was made by the examiner conducting the merged proceeding. Accordingly, the issue of providing this requested relief is moot.

With respect to maintaining the '7614 request separate from the merged proceedings, if granted, this request by petitioner is also moot, since the order for reexamination for the '7614 request was not granted.

As to not considering the IDS of the '7614 request in the merged proceedings and disregarding the '7614 request or proceeding, the IDS and request were already considered by the examiner in connection with the denial for reexamination, and the examiner cannot ignore any information bearing on the patentability of the claims of which the examiner is aware. It is noted, however, that the examiner found that the '7614 request failed to raise a substantial new question of patentability which was not previously raised in the prior reexamination proceedings.

As to the request that ICOS be directed not to file any other reexamination requests, this request cannot be granted because the statute confers such a right of filing on ICOS, as well as any other potential requester of reexamination. It is to be observed, however, that any further request for reexamination of the '012 patent will be evaluated to determine whether such a request raises a substantial new question of patentability which was not previously raised in the prior reexamination proceedings (in the same manner as the '7614 request was evaluated).

In view of the discussion above the patent owner's petition is dismissed.

SERVICE OF COPIES

37 CFR 1.550(f) states as follows:

> After filing of a request for *ex parte* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party in the reexamination proceeding in the manner provided by § 1.248. The document must reflect service or the document may be refused consideration by the Office.

The requisite proof of service on the third party requesters is not included with the instant petition papers, nor with its attachments. Since there is no indication that the third party requesters were provided with a copy of these papers, a copy of the present August 22, 2005 patent owner petition is being provided to the requesters with this decision.

Any future communications filed by the patent owner in this proceeding, or the '6617, '6886, '7110 and '7478 proceedings, must include proof of service on the third party requesters in accordance with 37 CFR 1.550(f).

CONCLUSION

1. The present petition under 37 CFR 1.182 is dismissed.

2. A copy of the present petition is being provided to the requester with this decision.

3. The '7614 reexamination proceeding remains in a terminated status.

4. The merged proceeding for the '6617, '6886, '7110 and '7478 proceedings will continue.

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

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

11-8-05
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Suite 103
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(For Patent Owner)

OLE K. NILSSEN
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(For Patent Owner)

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NOV 29 2006

CENTRAL REEXAMINATION UNIT

Virgil L. Beaston
STERNE KESSLER GOLDSTEIN & FOX PLLC
1100 New York Avenue, NW
Washington, DC 20005

(For Third Party Requester)

Linda E. Alcorn
STERNE KESSLER GOLDSTEIN & FOX PLLC
1100 New York Avenue, N. W.
Washington, DC 20005-3934

(For Third Party Requester)

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

In re: Nilssen
Reexamination Proceeding
Control No. 90/007,480
Filed: March 25, 2005
For U.S. Patent No. 5,233,270

In re: Nilssen
Reexamination Proceeding
Control No. 90/007,930
Filed: February 13, 2006
For U.S. Patent No. 5,233,270

The above-identified reexamination files are before the Director of the Central Reexam Unit 3992, for consideration of merger of reexamination control number 90/007,480 and the reexamination control number 90/007,930 pursuant to 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 5,233,270 issued on August 3, 1993.

2. The 90/007,480 reexamination proceeding was filed on March 25, 2005 by a third party requester.

3. The proceeding Order granting reexamination for control number 90/007,480 was mailed on May 23, 2005.

4. The 90/007,930 reexamination proceeding was filed February 13, 2006 by a third party requester.

5. The proceeding Order granting reexamination for control number 90/007,930 was mailed on April 24, 2006.

6. There are no amendments to either the control number 90/007,480 and 90/007,930 proceedings 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 90/007,480 and 90/007,930 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, there are no amendments at this time in either reexamination proceeding. Patent owner is required to maintain the same claims and specification in all merged files.

II. Conduct of Merged Proceeding.

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

CONCLUSION

Reexamination Control Nos. 90/007,480 and 90/007,930 are **merged**.

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

for

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

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OCT 05 2007

CENTRAL REEXAMINATION UNIT

Ole K. Nilssen
200 N. Harrison St., Suite 103
Algonquin IL 60102

(Patent Owner)

Virgil L. Beaston
STERNE KESSLER GOLDSTEIN & FOX PLLC
1100 New York Avenue NW
Washington, DC 20025-3934

(For Requester)

In re Nilssen
Ex parte Reexamination Proceeding Control Nos. 90/007,480 and 90/007,930
Filed: March 25, 2005 and February 13, 2006
For: U.S. Patent No.: 5,233,270

In re Nilssen
Ex parte Reexamination Proceeding Control Nos. 90/007,518 and 90/007,823
Filed: April 22, 2005 and November 23, 2005
For: U.S. Patent No.: 5,416,386

In re Nilssen
Ex parte Reexamination Proceeding Control No.: 90/007,983
Filed: March 24, 2006
For: U.S. Patent No.: 6,172,464

In re Nilssen
Ex parte Reexamination Proceeding Control No.: 90/007,470
Filed: March 18, 2005
For: U.S. Patent No.: 4,857,806

In re Nilssen
Ex parte Reexamination Proceeding Control No.: 90/007,864
Filed: January 4, 2006
For: U.S. Patent No.: 5,343,123

DECISION ON PETITION UNDER 37 CFR 1.182 REGARDING EXTENDED EXAMINER INTERVIEW

This is a decision on the September 26, 2007 patent owner petition filed in each of the above-identified proceedings to conduct an extended personal interview with the Examiner for the duration of five hours to discuss each of the above-identified proceedings.

The petition is before the Office of Patent Legal Administration for consideration of whether the request for an extended interview should be granted.

The petition is dismissed.

REVIEW OF SALIENT FACTS

1. On September 25, 2007, the patent owner contacted Examiner Escalante and requested a personal interview for the above-identified proceedings. The examiner granted the initial request and indicated that the duration of the interview would not exceed one hour.

2. The patent owner filed a petition on Sept. 26, 2007, in each of the above identified proceedings "to confirm that Owner is entitled to interview the Examiner for a duration of one hour per patent at issue, or a total of five (5) hours for the above five (5) captioned reexamination proceedings."

3. Payment of the petition fees required for each proceeding was completed on October 4, 2007, thus affecting entry of the petitions in each respective proceeding on this date.

4. The status of each proceeding is as follows:

(a) Control nos. 90/007,480 & 90/007,930 have been merged. A final office action was mailed July 3, 2007. An amendment in response to the final office action was filed Sept. 7, 2007.

(b) Control nos. 90/007,518 & 90/007,823 have been merged. A non–final office action was mailed May 30, 2007. A petition for accepting the filing of late papers was filed Sept. 14, 2007.

(c) Control no. 90/007,983 received a non-final office action mailed on May 17, 2007. An amendment in response to the non-final office action was filed July 19, 2007.

(d) Control no. 90/007,470 received a final office action mailed June 29, 2007. An amendment in response to the final office action was filed Sept. 4, 2007, and a Notice of Appeal was filed Oct. 1, 2007.

(e) Control no. 90/007,864 received a non-final office action mailed May 29, 2007. An amendment in response to the non-final office action was filed July 2, 2007.

5. Each proceeding has received at least one office action and has had a response* filed therein by patent owner awaiting action.

6. Each proceeding has claims rejected on different grounds based on different prior art references.

DISCUSSION

Interviews in *ex parte* reexamination proceedings are governed by 37 CFR 1.560, which reads:

Interviews in *Ex Parte* reexamination proceedings.

(a) Interviews in *ex parte* reexamination proceedings pending before the Office between examiners and the owners of such patents or their attorneys or agents of record must be conducted in the Office at such times, within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Director. Interviews for the discussion of the patentability of claims in patents involved in *ex parte* reexamination proceedings will not be conducted prior to the first official action. Interviews should be arranged in advance. Requests that reexamination requesters participate in interviews with examiners will not be granted.

(b) In every instance of an interview with an examiner in an *ex parte* reexamination proceeding, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner. An interview does not remove the necessity for response to Office actions as specified in § 1.111. Patent owner 's response to an outstanding Office action after the interview does not remove the necessity for filing the written statement. The written statement must be filed as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.

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* It is noted that merged proceeding control no. 90/007,480 does not have a amendment filed therein, but has a petition awaiting decision to accept a late response.

As explained in MPEP 2281:

> In the case where the patent owner desires to initiate an interview, the patent owner should initially contact the examiner in charge of the proceeding to indicate what issues are sought to be discussed, and to determine if an interview will be granted. If the examiner agrees to grant the interview, the patent owner must file, at least three (3) working days prior to the interview, a written statement of the issues to be discussed at the interview, and a copy of any proposed claims to be discussed, unless examiner waives this requirement. This provision will provide structure to the interview so as to facilitate the statutory mandate for special dispatch.
>
> The duration of the interview will not exceed one hour, unless the patent owner files a petition under 37 CFR 1.182 showing sufficient cause where more time is needed. In a reexamination proceeding, the invention should be well defined after the patent has issued, and it is simply a matter of defining the claims over art applied, to the extent such is deemed necessary. An hour of time in a structured planned interview should be sufficient to accomplish this, and in those rare instances where it is not, a patent owner may show cause to extend the time. During the interview, the examiner is always free to extend the duration of the interview to discuss issues that the examiner deems appropriate for (further) discussion. Such an extension of the duration of the interview is permitted at the examiner's sole discretion.
>
> Only one interview may be requested after an Office action and prior to filing the response to that action, absent a showing of good cause to conduct a second interview during this period.

DECISION

Interviews are ***permitted*** during reexamination proceedings and are granted at the discretion of the examiner if they are deemed to facilitate prosecution with special dispatch. Interviews may be requested after an Office action, prior to filing a response to that action, in order to define the claims over the applied prior art. As the interview must be conducted in a structured and planned manner, one hour of time should be sufficient to accomplish this.

The patent owner has requested that five different reexamination proceedings be discussed during one personal interview and that one hour be allotted to each proceeding to result in a personal interview with a duration of five hours.

Each of the proceedings is at a different stage of prosecution. Each of the proceedings has different prior art rejections applied against the claims, with a total of at least ten (10) different prior art references being at issue. Responses have already been filed in the proceedings and are awaiting action.

An extended interview in this case, which would raise numerous different issues, involve proceedings at various stage of prosecution, and be conducted over a lengthy period of time, would not be productive and would not facilitate the handling of these cases with special dispatch. The patent owner acknowledges in the petition that there are "a multitude of issues to be discussed" and that additional issues relating to priority particular to only two of the proceedings will be raised.

The goal of conducting a targeted, planned interview to define the claims over the prior art would not be accomplished by combining five different sets of claims and over ten different prior art references along with a variety of other issues in a single discussion. Moreover, none of these proceedings are at an appropriate stage of prosecution during which interviews are normally granted. Further, such a lengthy interview would not be an efficient use of Office resources and would not serve the public interest.

It is also noted that the petition states the patent owner is entitled to an interview in each proceeding and is entitled to one hour for each interview. Interviews are *permitted* at the discretion of the examiner; interviews are not entitlements. Further, the manual states that an interview *will not exceed one hour*. Interviews are not guaranteed to last one hour and may be held for less than one hour at the discretion of the examiner in the interest of expediting prosecution in an efficient manner.

The patent owner has not provided a sufficient showing of good cause as to why additional time, especially for a time period of five hours, in which to conduct an interview should be permitted in this situation. The petition states that patent owner's request is for reasons of efficiency, to conserve resources, and to lessen the amount of travel time. Economic and time considerations for the patent owner do not give rise to an adequate showing as there are other means of communication, including the telephone, available to the patent owner to interact with the examiner.

CONCLUSION

1. The petition requesting an extended personal examiner interview conducted at one time for all of the above identified proceedings is dismissed.

2. The patent owner is required to identify which one of the above proceedings will be the subject of the personal interview and indicate what issues are sought to be discussed so that the examiner can determine if an interview will be granted.

3. If the examiner agrees to grant the interview, the patent owner must file, at least three (3) working days prior to the interview, a written statement of the issues to be discussed at the interview along with a copy of any proposed claims to be discussed unless the examiner waives this requirement.

4. The duration of the interview for an individual proceeding, if granted, will not exceed one hour.

5. The patent owner is reminded that merged proceedings require papers to be filed in each proceeding within the merged proceeding. In this case, patent owner filed a single petition in each of the merged proceedings, which is not in accordance with the guidelines set forth in the merger decision. The petition must be filed in each proceeding in the merged proceedings. In this instance, the Office has waived this procedure, but this is not to be construed as a waiver as to future filings. A paper must be filed in each proceeding within the merged proceedings going forward.

6. Telephone inquiries related to this decision should be directed to Caroline Dennison, Legal Advisor, at (571) 272-7729.

Stephen Marcus
Legal Advisor
Office of Patent Legal Administration

cdd
October 4, 2007

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OCT 17 2007

CENTRAL REEXAMINATION UNIT

Virgil L. Beaston
STERNE KESSLER GOLDSTEIN & FOX PLLC
1100 New York Avenue NW
Washington, DC 20025-3934 (For Requester)

Enclosure:* Petition filed October 9, 2007

In re Nilssen
Ex parte Reexamination Proceeding
Control Nos. 90/007,480 and 90/007,930
Filed: March 25, 2005 and February 13, 2006
For: U.S. Patent No.: 5,233,270

DECISION ON PETITION UNDER 37 CFR 1.182 & 37 CFR 1.183 REGARDING THIRD PARTY PARTICIPATION IN AND TRANSCRIPTION OR VIDEOTAPING OF EXAMINER INTERVIEW

This is a decision on the October 9, 2007 petition filed by the third party requester in the above-identified proceeding to (1) permit a representative of the third party requester to observe any and all examiner interviews; and/or (2) permit any and all examiner interviews to be transcribed or videotaped and be made part of the record for the proceeding.

The fee set forth in 37 CR 1.17(f) for a petition under 37 CFR 1.182 and 1.183 is $400. The petition fee for the above proceeding is being charged to the petitioner's deposit account No. 19-0036 as authorized by the petitioner on page 3 of the petition.

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

The petition is dismissed and returned to the third party requester. As the petition is not a proper submission, it has not been made part of the record in any of the above proceedings.

* The sole copy of the petition submitted to the Office is enclosed with the Decision in Control No. 90/007,470.

REVIEW OF SALIENT FACTS

1. Control no. 90/007,480 (the '7480 proceeding) & control no. 90/007,930 (the '7930 proceeding) have been merged. A final office action was mailed July 3, 2007. An amendment in response to the final office action was filed Sept. 7, 2007, and a notice of appeal was filed Oct. 4, 2007.

2. The period for active participation of the third party reexamination requester has ended in the '7480 and '7930 merged proceeding.

3. On October 9, 2007, the third party requester filed the present petition under 37 CFR 1.182 and 1.183.

DISCUSSION

Participation by third parties in an *ex parte* reexamination proceeding is governed by 37 CFR 1.550(g) and (h), which 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).

Interviews permitted in reexamination proceedings are conducted in accordance with MPEP 2281, which states:

> "[O]nly *ex parte* interviews between the examiner and patent owner and/or the patent owner's representative are permitted. Requests by reexamination requesters to participate in or to attend interviews will not be granted."

The recordation of an interview in *ex parte* reexamination is set forth as follows, pursuant to MPEP 2281:

> "The examiner must complete an Interview Summary form PTOL-474 for each interview held where a matter of substance has been discussed (see MPEP § 713.04)....The original should be made of record in the reexamination file, and a copy should be mailed to any third party requester."
>
> "The general procedure for conducting interviews and recording same is described at MPEP § 713.01 - § 713.04...."
>
> "In every instance of an interview with the examiner, a patent owner's statement of the interview, including a complete written statement of the reasons presented at the interview as warranting favorable action, must be filed by the patent owner.... The requirement for a patent owner's statement of the interview cannot be waived by the examiner."

Pursuant to MPEP 713.04:

> "Applicant's summary of what took place at the interview should be carefully checked to determine the accuracy of any argument or statement attributed to the examiner during the interview.... If the record is complete and accurate, the examiner should place the indication "Interview record OK" on the paper recording the substance of the interview along with the date and the examiner's initials."

DECISION

1. Third party requester participation after the period permitted for active requester participation is not permitted.

The present petition of October 9, 2007, was filed after the period for active participation of the reexamination requester had ended. The present petition is not in compliance with the requirements of 37 CFR 1.510 or 1.535, nor does the present petition qualify as a prior art statement under 37 CFR 1.501. Accordingly, it is an improper submission under the above-quoted portions of 37 CFR 1.550. See *Syntex (USA) Inc. v. U.S. Patent and Trademark Office,* 11 USPQ 2d 1866, 1868-1869 (Fed. Cir. 1989).

As the present petition is not a proper submission, it will not be made of record in the reexamination file and is being returned to the third party requester. This decision will be made of record in the reexamination file. See also MPEP 2267.

2. Third party participation during interviews in *ex parte* proceedings is not permitted.

Petitioner has requested that the Office permit the third party to observe any and all examiner interviews and/or permit transcription or videotaping of any and all examiner

interviews in the above identified proceedings. Only *ex parte* interviews between the examiner and patent owner are permitted. Observation by third parties is not permitted. Pursuant to MPEP 2281, requests by reexamination requesters to participate in or to **attend** interviews will not be granted. The relief requested by petitioner with respect to transcription or videotaping would permit attendance by a third party in interviews, in addition to the examiner and the patent owner. Such attendance is not permitted.

It is also noted that the requested stenographer or videographer would be functioning as a representative of the third party requester to record the content of the interview. This third party intervention requested in the petition would not be justified, in view of the intent of the legislation and rules to make reexamination an *ex parte* proceeding. *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 11 USPQ2d 1866, 1869 (Fed. Cir. 1989) (a reexamination is conducted *ex parte* after it is instituted); *In re Opprecht*, 10 USPQ2d 1718 (Fed. Cir. 1989)(third parties do not participate before the Office). Thus, the requested relief cannot be granted.

Moreover, the substance of the interview, as made of record in the proceeding file, is available to the public. The information generated by the procedures in MPEP 2281 and 713.04 provides the entirety of the substance of the interview to be made of record.[1] That record is available to the public and any forum that has an occasion to review the patent that was reexamined.

CONCLUSION

1. The petition requesting permission for a representative of the third party requester to observe and/or to transcribe or videotape any and all examiner interviews in the '7480 & '7930 merged proceeding is dismissed.

2. The petition is being returned to the requester and will not be entered in the above proceeding file.

3. Jurisdiction over the reexamination proceedings is being returned to the Central Reexamination Unit.

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[1] Pursuant to 37 CFR 1.2, "[t]he action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt."

4. Telephone inquiries related to this decision should be directed to Caroline Dennison, Legal Advisor, at (571) 272-7729.

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

cdd

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REEXAM UNIT

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For Patent Owner

Jeffrey G. Killian
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For Requester

In re: John D. Agostino
Ex Parte Reexamination Proceeding
Control No. 90/007,481
Filed: March 28, 2005
For: US Patent No. 6,324,526

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

This is a decision on the petition filed February 17, 2006 to request a one (1) month extension of time pursuant to 37 CFR 1.550 for responding to the Office action dated February 3, 2006.

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

The petition is granted 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 3, 2006, which set a one month date for filing a response thereto. 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 a review of the Office action and attending documentation indicates that a great deal of additional analysis is necessary in order to effectively address the grounds for rejection. Patentee and counsel are in the process of outlining and drafting explanations of each and every basis for allowance of the issued patent claims. This will include some case law that must be researched in order to present a competent response. The request also contends that the brief one month time period for response is further undermined by a holiday and the reduced number of calendar days in the month of February. The additional time is requested to enable the attorneys to confer with the patentee to outline the arguments in favor of reversal of the Examiner's rejections and to finalize the response. Such consultation cannot be accomplished

by the present due date of March 3, 2006 . An extension of time until April 3, 2006 to facilitate the completion and timely filing of the Patent Owners Response is requested.

Analysis and Findings

On balance, it is considered that the petition explains the "sufficient cause" for why an extension of time should be granted. It is clear that the Office action is substantial and that counsel requires consultation with the patentee to prepare a complete response. One should note, however, given the time allotted for response in reexamination proceedings, one should reasonably anticipate the time needed for collection of information and data and for consultation with inventors. An extension of time of one month is considered sufficient to compile the information and complete the response, the number of calendar days in the month notwithstanding.

Conclusion

1. The patent owner's petition for extension of time in which to file a response to the Office action dated February 3, 2006 is **granted**.

2. The Patent Owner's response is due April 3, 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.

for Deborah Jones
Lissi M. Marquis,
Director,
Central Reexamination Unit

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OCT 27 2008

CENTRAL REEXAMINATION UNIT

PETER A. MATOS
MALLOY & MALLOY, P.A.
HISTORIC CORAL WAY
MIAMI, FL 33129

In re Application of	:	
John D'Agostino	:	
Control No. 90/007,481 (U.S. Patent 6,324,526)	:	DECISION ON PETITION
Filed: March 28, 2005	:	TO WITHDRAW
Attorney Docket No. 1.706.98	:	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 20, 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 Peter A. Matos on behalf of all attorneys of record who are associated with Customer No. 04219. All attorneys/agents associated with Customer No. 04219 have been withdrawn.

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

All future communications from the Office will be directed to the first copied address below until otherwise properly notified.

Telephone inquiries concerning this decision should be directed to Patricia Volpe at 571-272-6825.

P Volpe for

Andres Kashnikow
Supervisory Patent Examiner
CRU 3993

cc: **JOHN D'AGOSTINO**
5153 HIGHBURY CIRCLE
SARASOTA, FL 34238

cc: JEFFREY G. KILLIAN, ESQ. (Third Party Requester)
BURNS DOANE SWECKER & MATHIS LLP
P.O. BOX 1404
ALEXANDRIA, VA 22313

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on October 20, 2008. There is no indication it was served on the Requester.

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(For Patent Owner)

Martin P. Hoffman
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Arlington, VA 22202

(For Third Party Requester)

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CENTRAL REEXAMINATION UNIT

In re Reexamination Proceeding
F. Davis et al.
Control No. 90/007,482
Filed: March 28, 2005
U.S. Patent No. 6,486,982
Attorney Docket No. 22176.37

: DECISION GRANTING REQUEST
: AND
: DECISION GRANTING PETITION

This is a decision on the request filed under 37 CFR 1.8(b) that a communication, including, *inter alia*, a petition under 37 CFR 1.137(b) and a Notice of Appeal, be considered as being submitted on September 7, 2007, and on the petition under 37 CFR 1.137(b) filed by the patent owner on September 7, 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, 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 November 1, 2007, the present request including, *inter alia*, an authorization to charge counsel's deposit account for any fee due under 37 CFR 1.17(g) with this request and a Request For An Extension Of Time Under 37 CFR 1.550(c) were filed. Petitioner argues that a

communication, including, *inter alia*, a petition under 37 CFR 1.137(b) and a Notice of Appeal, was transmitted to the Office by facsimile transmission on September 7, 2007, along with a certificate of facsimile transmission. In support of the present request, a copy of an Auto-Reply Facsimile Transmission (an automatically generated return receipt confirmation) and a copy of the sending unit's report confirming transmission denoting September 7, 2007 as the date of receipt by the Office of the communication were submitted. Petitioner requests that the communication be considered as being submitted on September 7, 2007. Copies of the petition and the Notice of Appeal were also submitted.

A review of the Office records reveals that a communication filed on or about September 7, 2007, has not been located in the Image File Wrapper for this proceeding. However, the evidence is convincing that a communication, including, *inter alia*, a petition under 37 CFR 1.137(b) and a Notice of Appeal, was submitted to the Office by facsimile transmission on September 7, 2007, using the certificate of mailing procedures under 37 CFR 1.8(a).

In view of the above, the request is granted. The communication, including, *inter alia*, a petition under 37 CFR 1.137(b) and a Notice of Appeal, will be considered as submitted on September 7, 2007. Accordingly, the fees due for the petition under 37 CFR 1.137(b) and the Notice of Appeal fee will be the fees in effect on September 7, 2007. The copy of the communication filed September 7, 2007, will be used for Office purposes. No petition fee under 37 CFR 1.17(g) is due for this request.

A review of the Office financial records for this proceeding reveals that $200.00 under 37 CFR 1.17(g) was charged to counsel's deposit account for the present request. The $200.00 will be refunded.

The present petition under 37 CFR 1.137(b) includes, inter alia, the requisite response (Notice of Appeal and fee - 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 on the Third Party Requester.

The petition for entry of the late papers is granted.

$2,000.00 ($1,500.00 for the petition fee and $500.00 for the Notice of Appeal fee) has been charged to counsel's deposit account no. 50-2233 and the $200.00 previously charged to counsel's deposit account under 37 CFR 1.17(g) has been credited to counsel's deposit account no. 50-2233 in accordance with the present petition.

The time period for filing an appeal brief and the appeal brief fee in response to the Notice of Appeal filed as a response to the outstanding Office action is two (2) months from the date of this decision, MPEP 711.03(c).

Jurisdiction over the reexamination proceeding is being returned to Central Reexamination Unit (CRU) Art Unit 3993 for further examination and consideration of the Notice of Appeal filed November 27, 2007, and the response filed November 5, 2007, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, James Menefee, in CRU Art Unit 3992, who can be reached at 571-272-1944.

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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(For Patent Owner)

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In re Reexamination Proceeding	:
Sponable et al.	:
Control No. 90/007,484	: DECISION GRANTING PETITION
Filed: March 28, 2005	:
U.S. Patent No. 5,784,833	:
Attorney Docket No. HLC-141-A	:

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on March 13, 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."

The present petition under 37 CFR 1.137(b) includes the requisite response-a Notice of Appeal and Appeal Fee (item 1), a $1500.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3).

The petition for entry of the late papers is granted.

$2,000.00 ($1,500.00 for the petition fee and $500.00 for the Notice of Appeal Fee) has been charged to counsel's deposit account no. 25-0115 in accordance with the present petition.

Jurisdiction over the reexamination proceeding is being returned to Technology Center Art Unit

3993 for further examination and consideration of the Notice of Appeal and the Amendment Under 37 CFR §1.116 filed March 13, 2006, along with the present petition, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Michael Oneill, in Technology Center Art Unit 3993, who can be reached at 571-272-4442.

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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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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Sacramento, CA 95814

MAILED
JUL 19 2005
REEXAM UNIT

In re Reissue Application of Richard J. Morris et al. Application No. 10/805,686 Filed: March 19, 2004 For: U.S. Patent No. 6,357,193	:	DECISION, *SUA SPONTE*, TO MERGE REISSUE AND REEXAMINATION PROCEEDINGS
In re Richard J. Morris, et al. Reexamination Proceeding Control No. 90/007,487 Filed: March 29, 2005 For: U.S. Patent No. 6,357,193	:	

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. 6,357,193 issued on March 19, 2002, with 22 claims.

2. An application for reissue, assigned application No. 10/805,686, was filed by the patent owner on March 19, 2004.

3. The filing of the '686 reissue application was announced in the *Official Gazette* on November 23, 2004.

4. A request for reexamination was filed by a third party requester on March 29, 2005, and was assigned control No. 90/007,487 (hereinafter, the '7487 proceeding).

5. Reexamination was ordered for the '7487 reexamination proceeding on June 2, 2005.

6. An information disclosure statement under 37 CFR 1.555 was filed in the '7487 proceeding by the patent owner on June 9, 2005.[1]

7. A patent owner's statement under 37 CFR 1.530 was not received in the '7487 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. 10/805,686 and reexamination control No. 90/007,487 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.

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[1]On June 15, 2005, a certificate of service certifying that copies c all papers filed with the Office on June 9, 2005, were served on the thi party requester, was received by the Office.

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 instant reissue and reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexamination proceeding will be merged in accordance with the decision set forth below.

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

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-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 proceeding 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. 90/007,487 shows that original patent claims 1-22 are present. A review of reissue application No. 10/805,686 shows that original patent claims 4, 5, 7, 10-13 and 21 are present, patent claims 1, 14-20 and 22 are canceled, and patent claims 2, 3, 6, 8, and 9 are amended. In addition, new claims 23-25 have been added. **Accordingly, the claims are not identical in both proceedings.**

   An appropriate housekeeping amendment (in one or both cases) is required within <u>ONE (1) MONTH</u> of this decision placing the same amendments in both cases, specifically, Application No. 10/805,686 and Control Number 90/007,487. 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 reexamination/reissue proceeding are submitted in accordance with the reissue practice under 37 CFR 1.173.

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 reissue statute, rules, and case law to the merged proceeding. **However, periods for response should be set at TWO (2) months to comply with the statutory requirement for special dispatch in reexamination (35 U.S.C. 305).**

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

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

6. Pursuant to MPEP 2285:

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

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

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

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

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

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

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

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 for consideration in reexamination pursuant to 37 CFR 1.552(c).

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

CONCLUSION

1. Reissue application No. 10/805,686 and reexamination control No. 90/007,487 **are merged** into a single proceeding.

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

3. Because the reexamination request is granted and the reissue and reexamination proceedings are merged, the merged proceeding will be handled by the examiner assigned to the reexamination proceeding, pursuant to MPEP 2236. Accordingly, the reissue and reexamination proceedings are being forwarded to the examiner via the Director of Technology Center 2800. Upon receipt of same, the examiner **should not issue an Office action for the present merged proceeding of the reissue and reexamination proceedings until after the earlier of** (a) the submission of the housekeeping amendment to place the same amendments in both cases or (b) the expiration of the ONE 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 Cynthia L. Nessler, Legal Advisor, at (571) 272-7724.

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

07/13/2005

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,489	03/31/2005	5944804	42P3026R	2223

8791 7590 05/19/2005

BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/19/2005

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

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Los Angeles, CA 90025-1030

FOR PATENT OWNER

In re Reexamination of:
U.S. Patent No. 5,944,804
Reexamination Control No. 90/007,489
Filed: March 31, 2005
For: SUPER PIPELINED ARCHITECTURE FOR TRANSMIT FLOW IN A NETWORK CONTROLLER

DECISION ON PETITION UNDER 37 § CFR 1.59

This is a decision on the petition under 37 CFR § 1.59(b), filed March 31, 2005 to expunge information submitted pursuant to MPEP § 724.02.

The petition is **DISMISSED**.

Petitioner requests that a technical document relating to Intel's 82556 product, filed March 31, 2005, be expunged from the record. Petitioner states that the information is related to TRADE SECRET information. The petition fee set forth in 37 CFR § 1.17(h) has been paid.

The petition is premature because the patentability of all claims in the reexamination proceeding has not been determined. Accordingly, it is not appropriate to make a final determination of whether or not the material requested to be expunged is "material," with "materiality" being defined as any information which the examiner considers as being important to a determination of patentability of the claims. Thus, the petition to expunge must be dismissed at this time.

During prosecution on the merits, the examiner will determine whether or not the identified document is considered to be "material." Once prosecution on the merits is closed, applicant may re-submit a petition to expunge the information. No further fee is required for such a second submission of a petition under 37 CFR § 1.59 to expunge information. If the information is not considered by the examiner to be material, the information will be returned to applicant.

Vincent N. Trans
Special Programs Examiner
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(For Patent Owner)

MAILED
MAR 0 , 2006
REEXAM UNIT

DECISION GRANTING
PETITION UNDER
37 CFR 1.59 (B) TO
EXPUNGE INFORMATION

In re Vikas Aditya *et alia*
Ex parte Reexamination Proceeding
Control No. 90/007,489
Filed: March 31, 2005
For: US Patent No. 5,944,804

This is a decision on the January 20, 2006 Patent Owner requested petition titled PETITION UNDER 37 CFR 1.59 (b) TO EXPUNGE INFORMATION SUBMITTED UNDER MPEP 724.02.

This petition considers under 37 CFR 1.59 (b) a request to expunge materials submitted by the Patent Owner with the Information Disclosure Statement (IDS) filed March 31, 2005.

The petition was filed in a timely manner with the authorization for the appropriate fee pursuant to 37 CFR 1.17 (g).

REVIEW OF FACTS

1. US Patent No. 5,944,804 issued on August 31, 1999.

2. On March 31, 2005 the Patent Owner requested ex parte reexamination of US Patent No. 5,944,804 which is identified under control no. 90/007,489.

3. The Order was granted for reexamination on May 3, 2005.

4. A first Office action on the merits (non-final) was mailed on October 13, 2005 in proceeding 90/007,489.

5. An amendment to the claims was timely filed on December 13, 2005 in proceeding 90/007,489.

6. A Notice of Intent to Issue an *Ex Parte* Reexamination Certificate was mailed on January 12, 2006.

7. A petition filed under 37 CFR 1.59 (b) to expunge information was timely filed January 20, 2006 with authorization to charge the appropriate fee.

CITATION OF APPROPRIATE PROCEDURE

MPEP 724.04

Any materials submitted under MPEP § 724.02 in a reexamination file open to the public under 37 CFR 1.11(d) will be treated in the following manner:
(A) Materials submitted under MPEP § 724.02 will only be released to the public with any other papers in the reexamination file if no petition to expunge (37 CFR 1.59) was filed prior to the mailing of a Notice of Intent to Issue Reexamination Certificate (NIRC), or if a petition to expunge was filed and the petition was denied. The submitted information will be maintained separate from the reexamination file and will not be publicly available until a determination has been made as to whether or not the information is important to a reasonable examiner in deciding whether or not a claim is patentable.
(B) Prior to the mailing of a NIRC, the examiner will review the reexamination file and determine if a petition to expunge is in the reexamination file but not acted upon. The examiner, or other appropriate Office official who is responsible for considering the information, will make a determination as to whether or not any portion or all of the information submitted is important to a reasonable examiner in deciding whether or not a claim is patentable.
(C) If any portion or all of the submitted information is found important to a reasonable examiner in deciding whether or not a claim is patentable, the petition to expunge will be denied and the information will thereafter become a permanent part of the reexamination file and open to the public.
(D) If any portion or all of the submitted information is found not to be important to a reasonable examiner in deciding whether or not a claim is patentable, the petition to expunge will be granted and the information expunged.
(E) If a petition to expunge is not filed prior to the mailing of the NIRC, the materials submitted under MPEP § 724.02 will become a permanent part of the reexamination file and open to the public under 37 CFR 1.11(d).
(F) Any petition to expunge a portion or all of the submitted information under 37 CFR 1.59(b) will be treated in accordance with MPEP § 724.05.

DECISION

The petition to expunge filed under 37 CFR 1.59 (b) is **granted**.

Petitioner requests that a document entitled Intel Corporation's 82556 product, filed March 31, 2005, be expunged from the record. Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was

unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

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

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

The expunged material has been closed from the official file.

CONCLUSION

1. The petition to expunge filed under 37 CFR 1.59 (b) is **granted**.

2. The electronic file with the IDS paper in question will be closed.

FUTURE CORRESPONDENCE

Correspondence to the Central Reexamination Unit should be directed 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

MReinhart SPRE-CRU-3992 for
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.
90/007,490	03/31/2005	6122681	42P3026CR	2482

8791 7590 05/19/2005

BLAKELY SOKOLOFF TAYLOR & ZAFMAN
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SEVENTH FLOOR
LOS ANGELES, CA 90025-1030

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/19/2005

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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TAYLOR & ZAFMAN
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Los Angeles, CA 90025-1030

FOR PATENT OWNER

In re Reexamination of:
U.S. Patent No. 6,122,681
Reexamination Control No. 90/007,490
Filed: March 31, 2005
For: SUPER PIPELINED ARCHITECTURE FOR TRANSMIT FLOW IN A NETWORK CONTROLLER

DECISION ON PETITION UNDER 37 § CFR 1.59

This is a decision on the petition under 37 CFR § 1.59(b), filed March 31, 2005 to expunge information submitted pursuant to MPEP § 724.02.

The petition is **DISMISSED**.

Petitioner requests that a technical document relating to Intel's 82556 product, filed March 31, 2005, be expunged from the record. Petitioner states that the information is related to TRADE SECRET information. The petition fee set forth in 37 CFR § 1.17(h) has been paid.

The petition is premature because the patentability of all claims in the reexamination proceeding has not been determined. Accordingly, it is not appropriate to make a final determination of whether or not the material requested to be expunged is "material," with "materiality" being defined as any information which the examiner considers as being important to a determination of patentability of the claims. Thus, the petition to expunge must be dismissed at this time.

During prosecution on the merits, the examiner will determine whether or not the identified document is considered to be "material." Once prosecution on the merits is closed, applicant may re-submit a petition to expunge the information. No further fee is required for such a second submission of a petition under 37 CFR § 1.59 to expunge information. If the information is not considered by the examiner to be material, the information will be returned to applicant.

Vincent N. Trans
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
(571) 272-3613

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Los Angeles, CA 90025-1030

(For Patent Owner)

MAILED
MAR 0 9 2006
REEXAM UNIT

DECISION GRANTING
PETITION UNDER
37 CFR 1.59 (B) TO
EXPUNGE INFORMATION

In re Vikas Aditya *et alia*
Ex parte Reexamination Proceeding
Control No. 90/007,490
Filed: March 31, 2005
For: US Patent No. 6,122,681

This is a decision on the January 20, 2006 Patent Owner requested petition titled PETITION UNDER 37 CFR 1.59 (b) TO EXPUNGE INFORMATION SUBMITTED UNDER MPEP 724.02.

This petition considers under 37 CFR 1.59 (b) a request to expunge materials submitted by the Patent Owner with the Information Disclosure Statement (IDS) filed March 31, 2005.

The petition was filed in a timely manner with the authorization for the appropriate fee pursuant to 37 CFR 1.17 (g).

REVIEW OF FACTS

1. US Patent No. 6,122,681 issued on September 19, 2000.

2. On March 31, 2005 the Patent Owner requested *ex parte* reexamination of US Patent No. 6,122,681 which is identified under control no. 90/007,490.

3. The Order was granted for reexamination on May 3, 2005.

4. A first Office action on the merits (non-final) was mailed on October 25, 2005 in proceeding 90/007,490.

5. An amendment with response and terminal disclaimer were received by the USPTO on December 16, 2005.

6. A Notice of Intent to Issue an *Ex Parte* Reexamination Certificate was mailed on January 12, 2006.

7. A petition filed under 37 CFR 1.59 (b) to expunge information was timely filed January 20, 2006 with authorization to charge the appropriate fee.

CITATION OF APPROPRIATE PROCEDURE

MPEP 724.04

Any materials submitted under MPEP § 724.02 in a reexamination file open to the public under 37 CFR 1.11(d) will be treated in the following manner:
(A) Materials submitted under MPEP § 724.02 will only be released to the public with any other papers in the reexamination file if no petition to expunge (37 CFR 1.59) was filed prior to the mailing of a Notice of Intent to Issue Reexamination Certificate (NIRC), or if a petition to expunge was filed and the petition was denied. The submitted information will be maintained separate from the reexamination file and will not be publicly available until a determination has been made as to whether or not the information is important to a reasonable examiner in deciding whether or not a claim is patentable.
(B) Prior to the mailing of a NIRC, the examiner will review the reexamination file and determine if a petition to expunge is in the reexamination file but not acted upon. The examiner, or other appropriate Office official who is responsible for considering the information, will make a determination as to whether or not any portion or all of the information submitted is important to a reasonable examiner in deciding whether or not a claim is patentable.
(C) If any portion or all of the submitted information is found important to a reasonable examiner in deciding whether or not a claim is patentable, the petition to expunge will be denied and the information will thereafter become a permanent part of the reexamination file and open to the public.
(D) If any portion or all of the submitted information is found not to be important to a reasonable examiner in deciding whether or not a claim is patentable, the petition to expunge will be granted and the information expunged.
(E) If a petition to expunge is not filed prior to the mailing of the NIRC, the materials submitted under MPEP § 724.02 will become a permanent part of the reexamination file and open to the public under 37 CFR 1.11(d).
(F) Any petition to expunge a portion or all of the submitted information under 37 CFR 1.59(b) will be treated in accordance with MPEP § 724.05.

DECISION

The petition to expunge filed under 37 CFR 1.59 (b) is **granted**.

Petitioner requests that a document entitled Intel Corporation's 82556 product, filed March 31, 2005, be expunged from the record. Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to

the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

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

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

The expunged material has been closed from the official file.

CONCLUSION

1. The petition to expunge filed under 37 CFR 1.59 (b) is **granted**.

2. The electronic file with the IDS paper in question will be closed.

FUTURE CORRESPONDENCE

Correspondence to the Central Reexamination Unit should be directed as follows:

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United States Patent & Trademark Office
P. O. Box 1450
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By Fax to: (571) 273-9900
Central Reexamination Unit

By Hand: Customer Service Window
Randolph Building
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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

M Reinhart SPRE-CRU - 3992

Lissi M. Marquis,
Director,
Central Reexamination Unit

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(For Patent Owner)

MAILED

OCT 17 2007

CENTRAL REEXAMINATION UNIT

In re Lutkus
Ex Parte Reexamination Proceeding
Control No.: 90/007,492
Filed: April 1, 2005
For: U.S. Patent No.: 6,494,659

DECISION DISMISSING PETITION

This is a decision on the patent owner paper filed on September 27, 2007, entitled "PETITION TO ENTER CD INTO FILE."

The patent owner paper is before the Office of Patent Legal Administration for consideration.

For the reasons set forth below, the patent owner petition is dismissed. The CD attached to the petition will not be entered into the reexamination proceeding file, and it will be returned to the patent owner.

FEES

The patent owner petition has been filed without any indication of under which rule the petition is being filed. Further, the petition has been filed without a petition fee.

BACKGROUND

1. Patent number 6,494,659 (the '659 patent) issued on December 17, 2002.
2. The patent owner filed a request for reexamination on April 1, 2005.
3. The request was granted on May 20, 2005, and assigned control no. 90/007,492 (the '492 proceeding.)
4. A patent owner's statement was filed July 20, 2005.
5. On August 15, 2006, a first Office action was mailed.

6. A personal interview was conducted with the patent owner and the examiner on September 28, 2006, during which a video was shown.

7. On October 13, 2006, the patent owner filed a response to the August 15, 2006 Office action, including an amendment.

8. A final rejection was mailed July 27, 2007.

9. On September 27, 2007, the patent owner filed a response to the final rejection, and the present petition including one copy of a CD labeled *Nitronic 60 Helically Coiled Fastener Insert vs. 304 Stainless Steel.*

DECISION

I. Pertinent Regulations

A. Petitions filed under 37 CFR 1.182 and 37 CFR 1.183

This petition does not specify under which rule relief is requested. However, two possible provisions under which a petition of this type might have been filed are 37 CFR 1.182 and 37 CFR 1.183.

37 CFR 1.182 provides:

> All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.183 provides:

> In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

B. Electronic Documents

A CD is an electronic document. Submission of electronic documents is governed by 37 CFR 1.52(e). 37 CFR 1.52(e) provides in pertinent part:

> (e) *Electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application or reexamination proceeding.*
>
> (1) The following documents may be submitted to the Office on a compact disc in compliance with this paragraph:
>
> (i) A computer program listing (see § 1.96);

(ii) A "Sequence Listing" (submitted under § 1.821(c)); or

(iii) Any individual table (see § 1.58) if the table is more than 50 pages in length, or if the total number of pages of all of the tables in an application exceeds 100 pages in length, where a table page is a page printed on paper in conformance with paragraph (b) of this section and § 1.58(c).

(2) A compact disc as used in this part means a Compact Disc-Read Only Memory (CD-ROM) or a Compact Disc-Recordable (CD-R) in compliance with this paragraph. A CD-ROM is a "read-only" medium on which the data is pressed into the disc so that it cannot be changed or erased. A CD-R is a "write once" medium on which once the data is recorded, it is permanent and cannot be changed or erased.

(3)(i) Each compact disc must conform to the International Standards Organization (ISO) 9660 standard, and the contents of each compact disc must be in compliance with the American Standard Code for Information Interchange (ASCII). CD-R discs must be finalized so that they are closed to further writing to the CD-R.

(ii) Each compact disc must be enclosed in a hard compact disc case within an unsealed padded and protective mailing envelope and accompanied by a transmittal letter on paper in accordance with paragraph (a) of this section. The transmittal letter must list for each compact disc the machine format (e.g., IBM-PC, Macintosh), the operating system compatibility (e.g., MS-DOS, MS-Windows, Macintosh, Unix), a list of files contained on the compact disc including their names, sizes in bytes, and dates of creation, plus any other special information that is necessary to identify, maintain, and interpret (e.g., tables in landscape orientation should be identified as landscape orientation or be identified when inquired about) the information on the compact disc. Compact discs submitted to the Office will not be returned to the applicant.

(4) Any compact disc must be submitted in duplicate unless it contains only the "Sequence Listing" in computer readable form required by § 1.821(e). The compact disc and duplicate copy must be labeled "Copy 1" and "Copy 2," respectively. The transmittal letter which accompanies the compact disc must include a statement that the two compact discs are identical. In the event that the two compact discs are not identical, the Office will use the compact disc labeled "Copy 1" for further processing. Any amendment to the information on a compact disc must be by way of a replacement compact disc in compliance with this paragraph containing the substitute information, and must be accompanied by a statement that the replacement compact disc contains no new matter. The compact disc and copy must be labeled "COPY 1 REPLACEMENT MM/DD/YYYY" (with the month, day and year of creation indicated), and "COPY 2 REPLACEMENT MM/DD/YYYY," respectively.

(5) The specification must contain an incorporation-by-reference of the material on the compact disc in a separate paragraph (§ 1.77(b)(5)), identifying each compact disc by the names of the files contained on each of the compact discs, their date of creation and their sizes in bytes. The Office may require applicant to amend the specification to include in the paper portion any part of the specification previously submitted on compact disc.

(6) A compact disc must also be labeled with the following information:

(i) The name of each inventor (if known);

(ii) Title of the invention;

(iii) The docket number, or application number if known, used by the person filing the application to identify the application; and

(iv) A creation date of the compact disc.

(v) If multiple compact discs are submitted, the label shall indicate their order (e.g. "1 of X").

(vi) An indication that the disk is "Copy 1" or "Copy 2" of the submission. See paragraph (b)(4) of this section.

(7) If a file is unreadable on both copies of the disc, the unreadable file will be treated as not having been submitted. A file is unreadable if, for example, it is of a format that does not comply with the requirements of paragraph (e)(3) of this section, it is corrupted by a computer virus, or it is written onto a defective compact disc.

C. Material Information

Information submitted for consideration during a reexamination proceeding is submitted in accordance with the provisions of 37 CFR 1.555 - Information material to patentability in *ex parte* reexamination and *inter partes* reexamination proceedings. 37 CFR 1.555(a) provides in its last sentence:

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.

37 CFR 1.98 provides:

(a) Any information disclosure statement filed under § 1.97 shall include the items listed in paragraphs (a)(1), (a)(2) and (a)(3) of this section.

(1) A list of all patents, publications, applications, or other information submitted for consideration by the Office. U.S. patents and U.S. patent application publications must be listed in a section separately from citations of other documents. Each page of the list must include:

(i) The application number of the application in which the information disclosure statement is being submitted;

(ii) A column that provides a space, next to each document to be considered, for the examiner's initials; and

(iii) A heading that clearly indicates that the list is an information disclosure statement.

(2) A legible copy of:

(i) Each foreign patent;

(ii) Each publication or that portion which caused it to be listed, other than U.S. patents and U.S. patent application publications unless required by the Office;

(iii) For each cited pending unpublished U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and

(iv) All other information or that portion which caused it to be listed.

(3)(i) A concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separate from applicant's specification or incorporated therein.

(ii) A copy of the translation if a written English-language translation of a non-English-language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in § 1.56(c).

(b)(1) Each U.S. patent listed in an information disclosure statement must be identified by inventor, patent number, and issue date.

(2) Each U.S. patent application publication listed in an information disclosure statement shall be identified by applicant, patent application publication number, and publication date.

(3) Each U.S. application listed in an information disclosure statement must be identified by the inventor, application number, and filing date.

(4) Each foreign patent or published foreign patent application listed in an information disclosure statement must be identified by the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application.

(5) Each publication listed in an information disclosure statement must be identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication.

(c) When the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications as specified in paragraph (a) of this section may be submitted without copies of the other patents or publications, provided that it is stated that these other patents or publications are cumulative.

(d) A copy of any patent, publication, pending U.S. application or other information, as specified in paragraph (a) of this section, listed in an information disclosure statement is required to be provided, even if the patent, publication, pending U.S. application or other information was previously submitted to, or cited by, the Office in an earlier application, unless:

(1) The earlier application is properly identified

in the information disclosure statement and is relied on for an earlier effective filing date under 35 U.S.C. 120; and

(2) The information disclosure statement submitted in the earlier application complies with paragraphs (a) through (c) of this section.

II. Findings and Analysis

A. Absence of Fee

Both rules, 37 CFR 1.182 and 37 CFR 1.183, under which the present petition could appropriately be filed require the fee set forth in 37 CFR 1.17(f). The absence of any fee in this instance requires dismissal of the petition.

B. Incorrect Form of the Electronic Document

The CD submitted with the petition does not conform to the requirements of electronic documents under 37 CFR 1.52(e). It is not a submission of the type acceptable under 1.52(e)(1). There is no indication that it is a CD-ROM or CD-R as required in 1.52(e)(3)(i). The CD was not submitted in the appropriate case accompanied with a transmittal letter as required under 1.52(e)(3)(ii). The CD was not submitted in duplicate or labeled appropriately, as required in 1.52(e)(4), (5) and (6). Since the CD does not conform to the requirements for submission of electronic documents and there has been no request for waiver of any of these rules, the CD is not proper for entry into the record. For these additional reasons, the petition is not grantable.

C. Improper Submission of Material Information

It is unclear from the petition what type of information is being submitted on the CD. If the submission is material to the patentability in accordance with 37 CFR 1.555, it must be submitted in compliance with the items listed in 37 CFR 1.98.

In particular, identifying information pertaining to the content of the CD, for example the publisher and date of publication, is to be properly presented in an Information Disclosure Statement to ensure consideration of the material. No such Information Disclosure Statement was submitted with the CD.

Moreover, it is unclear whether the CD contains a video previously viewed by the Office, or whether there is new material presented. The petition states that "[a]s the present Examiner has not had the benefit of reviewing the CD which was previously shown to Examiner Bomberg during the personal interview on September 28, 2006, Patentee believes that the subject matter contained on the CD will better illustrate for the Examiner the concept of yield strength within a tapped hole..." It is unclear from this statement whether the CD submitted with the petition contains exactly the same video demonstrated during the personal interview. Further no provenance has been established for the CD.

The material contained on the CD has not been properly presented in an Information Disclosure Statement such that the examiner could consider the information during the '492 proceeding. For this reason too, entry of the CD into the record of this proceeding is improper and, therefore, the petition is not grantable.

D. Summary

Due to the failure to submit and an appropriate fee and due to the lack of clarity as to precisely what relief patent owner is seeking in this petition, patent owner has not established any basis for relief under 37 CFR 1.182 or 37 CFR 1.183. Patent owner has not complied with the appropriate submission procedures, and moreover has not demonstrated that this is an extraordinary situation in which justice would require a waiver of the rules. The petition is not grantable under either provision, even if the petition fee were submitted.

CONCLUSION

1. The patent owner petition filed on September 27, 2007, is <u>dismissed</u>.

2. The CD submitted with the petition will <u>not</u> be entered into the record of the '492 proceeding, and it will be returned to the patent owner.

3. Jurisdiction over the '492 *ex parte* reexamination proceeding is being returned to the Central Reexamination Unit, Art Unit 3993, for appropriate action in due course on the response to the final Office action filed September 27, 2007.

4. Telephone inquiries related to this decision should be directed to Caroline Dennison, Legal Advisor, at (571) 272-7729.

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

cdd

c:\Kiva\kenids\decisions\7492 decision not to accept CD
10-15-07

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In re Reexamination Proceeding	:
C. Sales	:
Control No. 90/007,494	: DECISION GRANTING PETITION
Filed: April 4, 2005	:
U.S. Patent No. 5,159,782	:
Attorney Docket No. 108633-126209	:

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on April 7, 2006, for entry of late papers based upon unintentional delay.

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

37 CFR 1.137(b) states:

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

A review of the record reveals that the present petition under 37 CFR 1.137(b) includes the requisite response - an amendment (item 1), a $750.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3).

A further review of the record reveals that the requisite proof of service on the third party requester was not included with the present petition papers or with its attachments. In a

telephone communication on April 28, 2006, Senior Legal Advisor Fred Silverberg was informed that the third party requestor would be provided with a copy of all of the papers submitted with the petition, and that, thereafter, a certificate of service, indicating that all of the papers submitted with the petition have been served on the third party requester, will be forwarded to the Office. In response, on April 28, 2006, by facsimile transmission, a communication including the requested certificate of service was submitted. It should be noted that any future communications filed by patent owner in this proceeding (including any response to this decision) must include proof of service on the third party requester in accordance with 37 CFR 1.550(f).

The petition for entry of the late papers is granted.

A Revocation of Power of Attorney with New Power of Attorney and Correspondence Address filed April 7, 2006, along with the present petition has been entered.

Jurisdiction over the reexamination proceeding is being returned to Central Reexamination Unit (CRU), CRU Art Unit 3993 for further examination and consideration of the amendment filed April 7, 2006, along with the present petition, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Matthew Graham, in CRU Art Unit 3993, who can be reached at 571-272-7116.

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

Fred A. Silverberg

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

Kenneth M. Schor

Conferee: Kenneth M. Schor

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JUL 25 2007

CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

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(For Third Party Requester)

In re Libman
Ex Parte Reexamination Proceeding
Control No.: 90/007,498
Filed: April 6, 2005
For: U.S. Patent No.: 5,987,434

DECISION DISMISSING AND RETURNING PETITION

This is a decision on the June 27, 2006, third party requester petition entitled PETITION TO THE USPTO DIRECTOR UNDER 37 CFR 1.181(a).

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

The petition is dismissed for the reasons set forth below.

REVIEW OF SALIENT FACTS

1. Patent number 5,987,434 issued on November 16, 1999.
2. A request for reexamination was filed on April 6, 2005 by third party requester ("petitioner"), and was assigned control No. 90/007,498.
3. An Order Granting Request for *Ex Parte* Reexamination was mailed on June 22, 2005.
4. Following prosecution through final Office action, a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) was mailed on April 3, 2007.
5. The reexamination proceeding was forwarded to the Office of Patent Legal Administration for review in accordance with MPEP § 2289.
6. The present petition was filed on June 27, 2007.

DECISION

I. Relevant Statutes, Regulations and Procedure

35 U.S.C. § 304 provides:

"If, in a determination made under the provisions of subsection 303(a) of this title, the Director finds that a substantial new question of patentability affecting any claim of a patent is raised, the determination will include an order for reexamination of the patent for resolution of the question. The patent owner will be given a reasonable period, not less than two months from the date a copy of the determination is given or mailed to him, within which he may file a statement on such question, including any amendment to his patent and new claim or claims he may wish to propose, for consideration in the reexamination. **If the patent owner files such a statement, he promptly will serve a copy of it on the person who has requested reexamination under the provisions of section 302 of this title. Within a period of two months from the date of service, that person may file and have considered in the reexamination a reply to any statement filed by the patent owner.** That person promptly will serve on the patent owner a copy of any reply filed. [Emphasis added.]

35 U.S.C. § 305 provides, in part:

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

37 CFR 1.181(a) provides:

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.

37 CFR 1.510(a) provides:

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. The request must be accompanied by the fee for requesting reexamination set in § 1.20(c)(1).

37 CFR 1.535 provides:

A reply to the patent owner's statement under § 1.530 may be filed by the *ex parte* reexamination requester within two months from the date of service of the patent owner's statement. Any reply by the *ex parte* requester must be served upon the patent owner in accordance with § 1.248. **If the patent owner does not file a statement under § 1.530, no reply <u>or other submission</u> from the *ex parte* reexamination requester will be considered.** [Emphasis added.]

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.)

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, ...
>
> **II. TYPES OF PAPERS RETURNED WITH DIRECTOR OF THE USPTO OR CRU/TC DIRECTOR'S APPROVAL REQUIRED**
>
> ...
>
> **Filed by Requester**
>
> A. No Statement Filed by Owner -
>
> § 1.535 If a patent owner fails to file a statement within the prescribed limit, any reply by the requester is inappropriate and will be returned and will not be considered."

II. The Present 37 CFR 1.181(a) Third Party Requester Petition Lacks an Entry Right

Petitioner has filed a petition and additional concurrently filed papers following the mailing of a NIRC. The petition requests relief under 37 CFR 1.181(a). The relief requested is that the USPTO Director review the determination reflected in the NIRC in light of certain documents that are of record in the '498 *ex parte* reexamination proceeding, and also in light additional documents not of record in '498 *ex parte* reexamination proceeding.

However, the present petition is not a request for *ex parte* reexamination in compliance with the requirements of 37 CFR 1.510, and it is not a third party reply filed pursuant to 37 CFR 1.535 after the filing of a 37 CFR 1.530 statement by patent owner. The petition does not qualify as a prior art statement pursuant to 37 CFR 1.501, as the petition was not filed prior to the date of the order for *ex parte* reexamination and does not otherwise qualify for entry under 37 CFR 1.502. Therefore, neither the reexamination statute nor the regulations promulgated pursuant thereto provide authority for the filing by a third party requester of the present third party requester petition. 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*. [1] All of the assertions set forth by petitioner are directed to the merits of the reexamination

[1] *In re Amp*, 212 USPQ 826 (Comr. Pats. 1981)

proceeding, and addressing them would be contrary to the intent of the reexamination statute. Comments at this stage of the proceeding [2] are precluded, since the examination conducted by the examiner in an *ex parte* reexamination proceeding requested under 35 U.S.C. § 302 *et seq* is an *ex 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 June 27, 2007 is an improper submission under 37 CFR 1.550(g) and, therefore, lacks an entry right into the present '498 *ex parte* reexamination proceeding. Accordingly, it is being "returned" to the third party requester together with all of papers concurrently filed therewith. However, the '498 *ex parte* reexamination proceeding is contained in an electronic Image File Wrapper (IFW), the petition and the concurrently filed papers cannot be physically removed from the file and sent back to the third party requester. Therefore, these documents will be "returned" to the third party requester by being marked "not public" and "closed" in the IFW. None of these documents will form part of the official record of the '498 *ex parte* reexamination proceeding. This decision will be part of the official record of the '498 *ex parte* reexamination proceeding, and a copy of this decision will be publicly available content in the IFW.

ADDITIONAL DISCUSSION

The record shows that the examiner terminated prosecution on the merits in this reexamination proceeding by issuing a NIRC on April 3, 2007. The record further shows that the NIRC includes a detailed "Statement of Reasons for Patentability and/or Confirmation," in which the examiner stated why the confirmed and patentable claims were deemed to distinguish over "the prior art patent and printed publications within this reexamination proceeding." A cursory inspection of the present petition shows that petitioner argues that two specifically identified prior art references were not properly considered by the examiner. However, the record clearly shows that both documents were expressly addressed in the Order Granting Request for *Ex Parte* Reexamination dated June 22, 2005. Such documents are inarguably documents that are "within this reexamination proceeding," and so were clearly considered on the record with respect to the claims that were ultimately held by the examiner to be confirmed and the claims that were ultimately held by the examiner to be patentable. That petitioner third party requester is not content with the examiner's determination does not create a right to file papers that are clearly not provided for under the reexamination statutes, regulations and published examining procedure. It should further be noted that to the extent that petitioner has proffered additional documents in support of the petition, petitioner has the right to file a new request for reexamination to obtain consideration of such documents.

While counsel should represent a client zealously, and should seek full benefit of all of the regulations implementing the *ex parte* reexamination statutes and the examining practice promulgated with respect to those regulations, counsel is reminded of the ongoing obligation to the Office as set forth in Part 10 of Title 37 of the Code of Federal Regulations.

CONCLUSION

1. The third party requester petition under 37 CFR 1.181 to reopen the '498 *ex parte* reexamination proceeding after conducting the petitioner's requested review of the examination process and the decisions made by the examiner, is **dismissed**.

---

[2] As noted, *supra*, prosecution has been terminated; a NIRC has issued.

2. The petition and the concurrently filed papers are being **returned** to the third party requester. The "return" will take the form of closing the petition and concurrently filed documents in the IFW file of the '498 *ex parte* reexamination proceeding, and marking all of the papers filed on June 27, 2007 "not public."

3. A copy of this decision is being made of record in the IFW of the '498 *ex parte* reexamination proceeding.
4. The process of issuing and publishing the reexamination certificate resulting from the '948 *ex parte* reexamination proceeding will continue.

5. Telephone inquiries related to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743.

Lissi Mojica Marquis, Director
Central Reexamination Unit

sm
July 25, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Third Party Requester)

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

In re: Nilssen
Reexamination Proceeding
Control No. 90/007,499
Filed: April 1, 2005
For U.S. Patent No. 5,510,680

In re: Nilssen
Reexamination Proceeding
Control No. 90/007,984
Filed: March 23, 2006
For U.S. Patent No. 5,510,680

The above-identified reexamination files are before the Director of the Central Reexam Unit 3992, for consideration of merger of reexamination control number 90/007,499 and the reexamination control number 90/007,984 pursuant to 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 5,510,680 issued on April 23, 1996.

2. The 90/007,499 reexamination proceeding was filed on April 1, 2005 by a third party requester.

3. The proceeding Order granting reexamination for control number 90/007,499 was mailed on May 24, 2005.

4. A non-final Office action was mailed November 18, 2005 in proceeding 90/007,499.

5. An amendment was filed by the patent owner on January 18, 2006.

6. A non-final Office action was mailed May 19, 2006 in proceeding 90/007,499.

7. A response from the patent owner was received July 24, 2006 without further amendment to the claims.

8. The 90/007,984 reexamination proceeding was filed March 23, 2006 by a third party requester.

9. The proceeding Order granting reexamination for control number 90/007,984 was mailed on May 12, 2006.

10. There are no amendments to the 90/007,984 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 90/007,499 and 90/007/984 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 have been amended in the 90/007,499 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. 90/007,499 and 90/007/984 are **merged**. 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.

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

MR for
MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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SEP 01 2007

CENTRAL REEXAMINATION UNIT

Ole K. Nilssen 408 Caesar Drive Barrington IL 60010	:	(Patent Owner)
OLE K. NILSSEN 200 N. HARRISON STREET SUITE 103 ALGONQUIN IL 60102	:	(Patent Owner)
Virgil L. Beaston STERNE KESSLER GOLDSTEIN & FOX PLLC 1100 New York Avenue NW Washington, DC 20025-3934	:	(For Third Party Requester)
Linda E. Alcom STERNE KESSLER ET AL 1100 New York Avenue, NW Washington, DC 20005	:	(For Third Party Requester)
	:	DECISION GRANTING IN PART PETITION FOR EXTENSION OF TIME [37 CFR 1.550(c)]
In re: Nilssen *Ex Parte* Reexamination Proceeding Control No. 90/007,499 Filed: April 1, 2005 For: US Patent No. 5,510,680	:	
In re: Nilssen *Ex Parte* Reexamination Proceeding Control No. 90/007,984 Filed: March 23, 2005 For: US Patent No. 5,510,680	:	

This is a decision on the August 9, 2007, petition for "Petition for Extension of Time Pursuant to 37 CFR 1.550 (c)," requesting that the time for responding to the Office action mailed June 14, 2007, be extended by one months.

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

The petition is granted in part 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 mailed June 14, 2007, which set a one month date for filing a response thereto. The Office action is a non-final Office action. The petition for extension of time was timely filed on August 9, 2007, together with authorization to debit a deposit account for the $200.00 petition fee 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. ...

Analysis and Findings

On balance, the Patent Owner's showing of "sufficient cause" is met by reasoning regarding the extensive time required to adequately respond to the outstanding Office action. The patent owner notes the large number of rejections and other proceedings whose time for response is very close to the instant proceeding for which a response is required. A sufficient cause in the patent owner's petition is shown to justify a one-month extension of time.

The petition request is **Granted**

Conclusion

1. The patent owner's petition for extension of one-month time in which to file a response to the Office action dated June 14, 2007 is **granted .**

2. The Patent Owner's response is due **September 14, 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 Mark Reinhart, Supervisory Patent 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
3999

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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CENTRAL REEXAMINATION UNIT

Ole K. Nilssen 408 Caesar Drive Barrington IL 60010	:	(Patent Owner)
Linda E. Alcorn STERNE KESSLER ET AL 1100 New York Avenue, NW Washington, DC 20005	:	(For Third Party Requester)
	:	DECISION GRANTING PETITION FOR EXTENSION OF TIME [37 CFR 1.550(c)]
In re: Nilssen *Ex Parte* Reexamination Proceeding Control No. 90/007,501 Filed: April 8, 2005 For: US Patent No. 5,510,681	:	

This is a decision on the July 6, 2007, petition for "Petition for Extension of Time Pursuant to 37 CFR 1.550 (c)," requesting that the time for responding to the Office action mailed May 17, 2007, be extended by one month.

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

The petition is granted 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 mailed May 17, 2007, which set a two month date for filing a response thereto. The Office action is a non-final Office action. The petition for extension of time was timely filed on July 6, 2007, together with authorization to debit a deposit account for the $200.00 petition fee 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. ...

Analysis and Findings

On balance, the Patent Owner's showing of "sufficient cause" is met by reasoning regarding the extensive time required to adequately respond to the outstanding Office action. The patent owner notes the large number of rejections and other proceedings whose time for response is very close to the instant proceeding for which a response is required.

The petition request is **granted**.

Conclusion

1. The patent owner's petition for extension of one-month time in which to file a response to the Office action dated May 17, 2007 is **granted**.

2. The Patent Owner's response is due **August 17, 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 Mark Reinhart, Supervisory Patent 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
3999

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

OLE K. NILSSEN
408 Caesar Drive
Barrington IL 60010

(For Patent Owner)

Linda A. Alcom
STERNE KESSLER GOLDSTEIN & FOX PLLC
1100 New York Avenue, NW
Washington, DC 20005

(For Third Party Requester)

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CENTRAL REEXAMINATION UNIT

DECISION,
SUA SPONTE,
VACATING
REEXAMINATION
PROCEEDINGS
PURSUANT TO
US COURT OF
APPEALS DECISION

In re: Nilssen
Ex Parte Reexamination Proceeding
Control No. 90/007,501
Deposited: 8 April 2005
For U.S. Patent No. 5,510,681

The above-identified reexamination files are before the director of the Central Reexam Unit 3992, for action following a U.S. Court of Appeals for the Federal Circuit decision on enforceability of US Patent 5,510,681. Since the Federal Circuit decision has held U.S. Patent No. 5,510,681, the patent underlying reexamination of control number 90/007,501, to be unenforceable, the proceeding is hereby vacated.

RELEVANT REGULATION AND MPEP PROVISIONS

Under 37 C.F.R. § 1.565(a):

> (a) In an ex parte reexamination proceeding before the Office, the patent owner must inform the Office of any prior or concurrent proceedings in which the patent is or was involved such as interferences, reissues, ex parte reexaminations, inter partes reexaminations, or litigation and the results of such proceedings. See § 1.985 for notification of prior or concurrent proceedings in an inter partes reexamination proceedings.

MPEP 2286 IV

> **IV. FEDERAL COURT DECISION ISSUES AFTER EX PARTE REEXAMINATION ORDERED** (in-part)
>
> Pursuant to 37 CFR 1.565(a), the patent owner in an ex parte reexamination proceeding must promptly notify the Office of any Federal court decision involving the patent. Where the reexamination proceeding is currently pending and the court decision issues, or the Office becomes aware of a court decision relating to a pending reexamination proceeding, the order to reexamine is reviewed to see if a substantial new question of patentability is still present. If no substantial new question of patentability is still present, the order to reexamine is vacated by the CRU or TC Director and reexamination is concluded.
>
> ...
>
> On the other hand, a final Federal Court holding of invalidity or unenforceability (after all appeals), is binding on the Office. Upon the issuance of a final holding of invalidity or unenforceability, the claims being examined which are held invalid or unenforceable will be withdrawn from consideration in the reexamination. The reexamination will continue as to any remaining claims being examined. Thus, the reexamination will continue if any original, new, or amended claim being examined that was not found invalid or unenforceable by the Court. If all of the claims being examined in the reexamination proceeding are finally held invalid or unenforceable, the reexamination will be vacated by the CRU or TC Director as no longer containing a substantial new question of patentability and the reexamination will be concluded. If not all claims being examined were held invalid (or unenforceable), a substantial new question of patentability may still exist as to the remaining claims. In such a situation, the remaining claims would be examined; and, as to the claims held invalid/unenforceable, form paragraph 22.20 should be used at the beginning of the Office action.

DECISION

On 10 October 2007, the U.S. Court of Appeals for the Federal Circuit affirmed a district court holding of unenforceability of certain patents in *Nilssen v. Osram Sylvania, Inc,* 504 F.3d 1223, 84 USPQ 2d 1811 (Fed. Cir. 2007), which included U.S. patent 5,510,681 (the '681 patent), the patent underlying reexamination of present control number 90/007,501. A petition for a *writ of certiorari* was denied by the U.S. Supreme Court on June 16, 2008, *Ole K. Nilssen, et al.,v. Osram Sylvania, Inc., et al,* 128 S. Ct. 2938; 2008 U.S. LEXIS 4944; 76 U.S.L.W. 3654. The entirety of the '681 patent and 14 other patents are accordingly unenforceable. Pursuant to MPEP 2286, Part IV, "[i]f all of the claims being examined in the reexamination proceeding are finally held invalid or unenforceable, the reexamination will be vacated by the CRU or TC Director as no longer containing a substantial new question of patentability and the reexamination will be concluded." (Underlining omitted.) Accordingly, the present reexamination proceeding is hereby vacated.

Jurisdiction over the present reexamination proceeding is being forwarded to the support staff of the Central Reexamination Unit (CRU) for conclusion of the proceedings. The CRU will mail the present decision, and process the reexamination file to update the Image File Wrapper (IFW) records for the proceedings. The file will be assigned a 422 status (reexamination vacated). A copy of the PALM "Application Number Information" screen and the "Contents" screen will be printed, the printed copy will be annotated by adding the comment "PROCEEDING CONCLUDED," and the annotated copy will then scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.

CONCLUSION

1. U.S. Patent No. 5,510,681 has been held unenforceable in a final decision of the Federal Circuit.

2. Reexamination Control No. 90/007,501 is hereby **vacated**. All prosecution of the proceeding is hereby terminated, and the proceeding will be concluded.

3. Jurisdiction over the present reexamination proceeding is being forwarded to the support staff of Central Reexamination Unit for further processing to conclude the proceeding, as provided in this decision.

4. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611; or Eric Keasel at (571) 272-4929; Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992.

/Mark Reinhart/
for

_____
Gregory Morse,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MICHAEL BEST & FRIEDRICH LLP
Two Prudential Plaza
180 North Stetson Avenue, Suite 2000
CHICAGO, IL 60601

In re Application of	:	
Scott **HAUGH**	:	
Control No. 90/007,502 (U.S. Patent 5,765,502)	:	DECISION ON PETITION
Filed: April 08, 2005	:	TO WITHDRAW
Attorney Docket No. 201300-0112	:	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 November 09, 2006.

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 Larry L. Saret on behalf of all attorneys of record who are associated with Customer No. 01131. All attorneys/agents associated with the Customer No. 01331 have been withdrawn.

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

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

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

Telephone inquiries concerning this decision should be directed to Patricia Volpe at 571-272-6825.

for Patricia Volpe
Andres Kashnikow
Supervisory Patent Examiner
CRU 3993

cc: **SCOTT HAUGH**
829 South Street
Lockport, IL 60441

cc: **SACHNOFF & WEAVER, LTD.**
10 South Wacker Drive
Chicago, IL 60606-7507

cc: **LOCKE LIDDELL & SAPP LTD.** (Third Party Requester)
ATTN: M. Scott Fuller
2200 Ross Avenue, Suite 2200
Dallas, TX 75201-6776

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on November 09, 2006. There is no indication it was served on 3rd Party Requester.

PTO/SB/83 (01-06)
Approved for use through 12/31/2008. OMB 0651-0035
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT AND CHANGE OF CORRESPONDENCE ADDRESS

Application Number	90/007,502
Filing Date	April 8, 2005
First Named Inv ntor	Scott Haugh
Art Unit	3993
Examiner Name	Aaron J. Lewis
Attorney Docket Number	201300-0112

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

Please withdraw me as attorney or agent for the above identified patent application, and

☐ all the attorneys/agents of record.

☐ the attorneys/agents (with registration numbers) listed on the attached paper(s), or

☑ the attorneys/agents associated with Customer Number 01131

NOTE: This box can only be checked when the power of attorney of record in the application is to all the practitioners associated with a customer number.

The reasons for this request are: The client refuses to communicate with the practitioner and has failed to pay one or more bills rendered by the practitioner for an unreasonable period of time.

CORRESPONDENCE ADDRESS

1. ☐ The correspondence address is NOT affected by this withdrawal.
2. ☑ Change the correspondence address and direct all future correspondence to:

☐ The address associated with Customer Number:

OR

☑ Firm *or* Individual Name	Sachnoff & Weaver, Ltd.				
Address	10 South Wacker Drive				
City	Chicago	State	IL	Zip	60606-7507
Country	US				
Telephone	312-207-1000	Email			
Signature	Larry L. Saret				
Name	Larry L. Saret	Registration No.	27,674		
Date	November 9, 2006	Telephone No.	312-222-0800		

NOTE: Withdrawal is effective when approved rather than when received. Unless there are at least 30 days between approval of withdrawal and the expiration date of a time period for response or possible extension period, the request to withdraw is normally disapproved.

This collection of information is required by 37 CFR 1.36. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: **Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

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.
90/007,503	04/04/2005	6410516	74753/JPW/GJG	5583

23432 7590 10/06/2005

COOPER & DUNHAM, LLP
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/06/2005

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

10/6/05

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Grantland G. Drutchas

MCDONNELL BOEHNEN HULBERT & BERGHOFF

300 S. Wacker Drive, Suite 3100

Chicago, IL 60606

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007503

PATENT NO. 6,410,516

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)).

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

John P. White
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, NY 10036

(For Patent Owner)

Enclosure: Patentees' Reply to Third Party Requester's Opposition to Patentees' Request for Stay of Reexamination

Grantland G. Drutchas
McDonnell Boehnen Hulbert & Berghoff
300 S. Wacker Drive
Suite 3100
Chicago, IL 60606

(For Requester)

MAILED
OCT 0 6 2005
REEXAM UNIT

In re The President and Fellows of
Harvard University *et al*
Reexamination Proceeding
Control No.: 90/007,503
Filed: April 4, 2005
For: U.S. Patent No. 6,410,516 B1

: DECISION ON PETITION TO
: VACATE ORDER
: GRANTING REEXAMINATION
: AND ON PETITION
: TO STAY REEXAMINATION

This is a decision on the August 8, 2005 patent owner petition under 37 CFR 1.181(a)(3) to vacate the order granting the above-captioned reexamination proceeding. This is also a decision on the concurrently filed patent owner request to stay the above-captioned reexamination proceeding. [1] A requester opposition to the petition to vacate and to the petition to stay reexamination was filed as a single paper and was received on August 18, 2005. A patent owner reply to the requester's opposition to the request for stay was received on September 6, 2005.

The proceeding, the patent owner petition and request, the third party requester opposition, and the patent owner reply are before the Office of Patent Legal Administration.

SUMMARY

A. The petition to vacate is dismissed for the reasons set forth below.

B. The petition to stay the reexamination proceeding is granted to the extent that there has been no action in the reexamination proceeding prior to the promulgation of the instant decision.

[1] Although captioned as a Request for Stay of Reexamination, the request is being treated as a petition and will be referred to as a petition to stay the reexamination proceeding throughout this decision.

C. Patent owner's reply to the requester's opposition to the petition to stay is being returned to owner for reasons discussed below.

D. The June 8, 2005 order granting reexamination in the 90/007,305 proceeding remains intact.

REVIEW OF FACTS

1. U. S. Patent No. 6,410,516 (the '516 patent) issued on June 25, 2002.

2. The '516 patent is the subject of litigation that commenced on June 25, 2002.

3 A request for reexamination of the '516 patent was filed on April 4, 2005.

4 Reexamination was ordered for the '7503 proceeding on June 8, 2005 and is hereinafter referred to as the '7503 reexamination proceeding.

5. On August 8, 2005, the patent owner filed a petition under 37 CFR 1.181(a)(3) to vacate the '7503 proceeding.

6. Also on August 8, 2005, the patent owner filed a petition to stay the '7503 reexamination proceeding until the authority of the Office to proceed with the reexamination is finally decided.

7. On August 10, 2005, the patent owner filed an information disclosure statement.

8. On August 18, 2005, the third party requester filed an opposition to the petition to vacate and to the petition to stay the reexamination proceeding. This was filed in the form of a single paper.

9. On September 6, 2005, the patent owner filed a reply to the third party requester's opposition.

10. A patent owner's statement under 37 CFR 1.530 has not been received in the '7503 reexamination proceeding.

DECISION ON PETITION TO VACATE THE JUNE 8, 2005 ORDER GRANTING REEXAMINATION

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."

MPEP § 2246, Part I, states, in part:

> "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 no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained. "Appropriate circumstances" under 37 CFR 1.181(a)(3) exist to vacate the order granting reexamination where, for example:
>
> "(A) the reexamination order is not based wholly on prior art patents or printed publications;"

In the instant petition to vacate the reexamination order, the patent owner urges that the order for reexamination was not based wholly on prior art patents and printed publication, but was instead based on issues under 35 U.S.C. §§ 112 and 132. The patent owner further argues that the order for reexamination was based upon prior public use, and not upon prior art patents and printed publications. Accordingly, patent owner seeks relief in the form of a decision vacating the June 8, 2005 order for reexamination as an *ultra vires* action taken by the Office.

Review of the Request for Reexamination

The Request for Reexamination, filed on April 4, 2005, cited numerous publications. Requester asserted that certain of these publications constituted prior art publications because the effective filing date of the claims of the '516 patent was no earlier than November 13, 1991, the date when grandparent application No. 07/791,898 (hereinafter the '898 application) was filed. Requester took the position that although the '898 application claimed benefit under 35 U.S.C. § 120 as a continuation-in-part (C-I-P) of three different prior patent applications, the claims of the '516 patent were entitled only to the effective date of the '898 application. [2] Requester then asserted that certain of the prior art publications cited in the request qualified as prior art to the '516 patent claims. [3] Requester further asserted that certain of the publications constituted prior art as to the '516 patent claims even assuming that the effective filing date of the '516 patent claims was earlier than November 13, 1991. [4]

Review of the Order Granting Reexamination

The examiner's order granting reexamination held that the request for reexamination established several substantial new questions of patentability with respect to the some of the claims of the '516 patent, found no new question of patentability with respect to some of the claims, and determined that all claims of the '516 patent would be reexamined. [5,6] A substantial new question of patentability was found to exist based upon prior art publications have a date earlier than November 13, 1991, but later that the earliest filing date recited in the '516 patent's 35 U.S.C. §120 benefit claim. [7] Another substantial new question of patentability was found to exist based upon prior art publications having a date earlier than the earliest date in the '516 patent's benefit claim.[8] The examiner did not refer to prior public use as establishing any substantial new question of patentability for any of the '516 patent claims.

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[2] Request for Reexamination, pages 6-7 and discussion beginning at page 15.
[3] Request for Reexamination, discussion beginning at page 20.
[4] Request for Reexamination, discussion beginning at page 24.
[5] Order granting reexamination, page 11
[6] MPEP § 2216
[7] See the Order granting reexamination, page 3, second full paragraph, for one example.
[8] See the order granting reexamination, page 6, first full paragraph, for one example.

Review of Patent Owner's Argument for Vacatur

Argument that The Order Granting Reexamination Improperly Relies Upon 35 U.S.C. §§ 112 or 132

Patent owner's argument is grounded in the language of 35 U.S.C. § 302. Pursuant to this statute, the Director has authority to conduct *ex parte* reexamination proceedings of issued United States patents based upon "patents or printed publications." Patent owner argues that any determination based upon requester's argument that certain subject matter claimed in the '516 patent is not supported by the disclosures of the C-I-P applications having filing dates earlier than November 13, 1991 violates the "patents or printed publications" requirement of 35 U.S.C. § 302. Patent owner reaches this conclusion by arguing that the '516 patent claims and specification can not be "reexamined" to determine whether they contain "new matter" under 35 USC § 132 with respect any of the prior patent applications or patents for which benefit under 35 U.S.C. § 120 is claimed, because such "reexamination" would involve the application of 35 U.S.C. § 112, first paragraph, and § 132, and not the application of patents and printed publications under 35 U.S.C. § 102 and 103. Patent owner relies upon the decisions in *Patlex Corporation v. Quigg,* 680 F.Supp. 33, 37 (D.D.C. 1988) and *Ex parte Hyatt,* Appeal No. 98-1912, Reexamination Control No. 90/001,896 (Bd. Pat. Appl. & Inter. 1999, unpublished) as supporting this argument. In owner's view, these decisions stand for the proposition that the Office lacks jurisdiction to "reexamine" the sufficiency of the specification of a parent application (to support patent claims) during the reexamination of a patent that claimed 35 U.S.C. § 120 benefit of that parent application.

With respect to the issue of the propriety of whether the examiner and the Office may properly revisit the 35 USC § 120 benefit claim of the '516 patent during reexamination of the '516 patent, patent owner also argues that because the examiner's order granting reexamination does not specifically include an analysis indicating why the claims of the '516 patent are not supported by parent applications filed earlier than November 13, 1991, the order lacks the discussion required by MPEP § 2246 and is, therefore, facially improper. [9] Owner further argues that requester's analysis of whether the '516 patent is entitled to a date earlier than November 13, 1991 is incomplete and unauthorized by statute, and is, therefore, flawed, so that even if the examiner's order is read to implicitly incorporate the information in the request, or to expressly incorporate that information, the requirement of MPEP § 2246 is not satisfied by the order.

In addition to arguing that reexamination of the review of the 35 U.S.C. § 120 benefit claim renders the reexamination order *ultra vires* under 35 U.S.C. § 302, the patent owner also argues that the order granting reexamination is *ultra vires* on the additional ground that the order is not based upon patents or printed publications as required by 35 U.S.C. § 302. Patent owner argues that the printed publications cited by the requester which have been relied upon by the examiner (to support the holding that the request raises a substantial new question of patentability) do not actually describe the claimed subject matter of the '516 patent. Patent owner argues that the '516 patent claims are directed to certain methods, and the publications cited by requester do not describe these methods expressly, but are merely alleged by requester to describe methods not claimed in the '516 patent that will, when performed, also inherently perform the methods claimed in the '516 patent; thus, the request for reexamination and the examiner's order granting reexamination based on that request for reexamination are actually

[9] MPEP § 2246 states that "[W]here the question is raised, or where it is not clear that a patent or printed publication pre-dates the patent claim claims, a discussion should be provided as to why the patent or printed publication is deemed to be available against the patent claims."

premised upon prior public use, *i.e.*, the actual practice of the inventions disclosed in the various publications. Patent owner cites *Schering Corporation v. Geneva et al*, 339 F.3d 1373 (Fed. Cir. 2003), *Cruciferous Sprout Litigation*, 301 F.3d 1343 (Fed. Cir. 2002) and *MEHL/BIOPHILE International Corp. v. Milgraum*, 192 F.3d 1362 (Fed. Cir. 1999) as cases standing for the proposition that subject matter which is inherently described in a patent or printed publication is applicable to anticipate a claimed invention only as a prior public use of the inherently disclosed subject matter, and not as an anticipation by the patent or printed publication. Patent owner quotes MPEP § 2217 as indicative of the proposition that "a prior art patent or printed publication cannot be properly applied as a ground for reexamination if it is merely used as evidence of prior public use ... ."

Findings

I. Consideration of a Benefit Claim in a Patent Being Reexamined is Not Necessarily Precluded by 35 U.S.C. § 302 and Does Not Render the June 8, 2005 Order Granting Reexamination *Ultra Vires*

A review of MPEP § 2246, relied upon by patent owner as noted in footnote 9, *supra*, shows that the Office practice clearly recognizes the propriety (in the context of a reexamination proceeding) of determining whether or not a given patent or printed publication qualifies (*i.e.*, is available) as prior art against one or more claims of a patent, such that the patent or printed publication is available to raise a substantial new question of patentability under 35 U.S.C. § 302. That this practice is legally sound, at least with respect to the facts present in the instant proceeding, is clear from a consideration of the same authorities cited and relied upon by patent owner to demonstrate the contrary position. Specifically, both the patent under consideration in the *Patlex* decision, and the application under consideration in the *Ex parte Hyatt* decision, involved 35 USC § 120 benefit claims including **only** continuation and/or divisional applications. A continuation application is a second application for the *same* invention claimed in a prior nonprovisional application and, as such, must contain a disclosure that is the same as the disclosure in the original (i.e., "parent") application. [10] A divisional application is a later application for an independent or distinct invention claiming only subject matter that is disclosed in the parent application.[11] Where a child application is found by an examiner to be a proper continuation or divisional application of its parent and the child is allowed to issue as a patent, this will imply, in absence of a strong showing to the contrary, that the examiner found sufficient written description and enablement to support the claims of the child patent (that derive the benefit of the parent application). On the other hand, where a child application is found by an examiner to be a proper continuation-in-part (C-I-P) application of its parent and the child issues as a patent, this cannot imply that the examiner found sufficient written description and enablement in the parent to support [12] the claims of the child patent, since the claims of the child C-I-P application can be supported by disclosure that would be new matter in the parent.

Where the Office "reexamines" the 35 U.S.C. § 112, first paragraph, support for the claims of a child patent, upon which to base the 35 U.S.C. § 120 benefit of the parent application, the Office may do so in order to make an intervening reference (one with a date prior to the child patent date but after the parent date) available against the child patent claims. This is permitted by the

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[10] See the discussion in MPEP § 201.07.

[11] See the discussion in MPEP § 201.06.

[12] Here, and throughout the discussion that follows, unless otherwise expressly stated, the term "support" is used in the sense of describing and enabling the claiming the manner required by 35 U.S.C. § 112, first paragraph.

reexamination statute, to provide a substantial new question of patentability using the intervening reference (i.e., this is an application of a patent or printed publication to the patent claims). However, the Office is precluded from doing this where the 35 U.S.C. § 112, first paragraph, support analysis was already done in the prosecution of the child patent.

Accordingly, in a proceeding to reexamine a continuation or divisional patent, the Office is generally precluded from reexamining the 35 U.S.C. § 112, first paragraph, claim support for the 35 U.S.C. § 120 benefit of the parent application, because there is a presumption (in absence of a strong showing to the contrary) that the Office already determined (in the examination of the child application that became the patent) that the child's claims were supported by the disclosure of the parent and the child is a proper continuation or divisional. If the child's claims were not supported by the disclosure of the parent, the Office would presumably have rejected those claims under 35 U.S.C. § 112, first paragraph. Since the Office has presumably already considered the issue and determined that any patent or publication not having a date prior to the effective filing date of the parent is unavailable against the child patent's claims, it may not reconsider the issue in a reexamination proceeding. Thus, criticism of the specification of the parent application as not supporting the child patent claims would generally [13] be precluded for the case of a continuation or divisional child patent. That is the scenario of the *Patlex* and *Hyatt* decisions relied upon by the patent owner.

On the other hand, in a proceeding to reexamine a C-I-P patent, the Office is not generally precluded from carrying out the 35 U.S.C. § 112, first paragraph, support analysis for the 35 U.S.C. § 120 claim benefit of the parent application date. As pointed out above, the finding that a child application is a proper C-I-P application of its parent does not imply that the examiner found sufficient written description and enablement *in the parent* to support the claims of the child patent, since the claims of the child C-I-P application can be supported by disclosure of the child that would be new matter in the parent. Thus, the Office is presumed to be permitted to make the "112" support analysis in a C-I-P scenario, unless there is evidence that the analysis was carried out in the child patent. The present fact situation is a C-I-P scenario; thus, the issue is squarely whether there is evidence that the "112" support analysis was carried out in the prosecution of the child patent. In the present instance, no evidence has been presented by the petition, nor in the record as a whole, that the "112" support analysis upon which the order for reexamination is based was previously carried out in the prosecution of the child '516 patent. This will be discussed further below.

The record in this reexamination proceeding shows that the 35 U.S.C. § 120 benefit claim in the '516 patent recites seven different prior patent applications that are asserted as being C-I-P applications with respect to their immediate parent applications. A C-I-P application is an application filed during the lifetime of an earlier nonprovisional application, repeating some portion of, or all of, the earlier nonprovisional application and adding subject matter not disclosed in said earlier nonprovisional application. [14] The record further shows that, in the instant proceeding, the reexamination requester has cited publications which were not of record during the examination of the '516 patent, and has argued that the claims of the '516 patent are not entitled to an effective filing date earlier than November 13, 1991. The requester's argument

[13] As the record in this reexamination proceeding is based upon facts differing from those in the *Patlex* and *Hyatt* decisions, no inference should be drawn that the reexamination of a 35 U.S.C. § 120 benefit claim would in any or all circumstances necessarily be precluded when a benefit claim in a patent undergoing reexamination includes only continuation and/or divisional applications.

[14] See the discussion in MPEP § 201.08 and *In re Klein*, 1930 C.D. 2, 393 O.G. 519 (Comm'r Pat. 1930), cited therein.

is based on requester's position that (a) application number 07/791,898, filed November 13, 1991, sets forth a claim for 35 U.S.C. § 120 benefit as a C-I-P of several different prior patent applications, and (b) **those C-I-P application specifications do not support the claims of the '516 patent**. To the extent that the *Patlex* and *Hyatt* decisions may stand for the proposition that the specification of a prior application providing the basis for a 35 U.S.C. § 120 benefit claim in a patent cannot be reexamined based upon 35 U.S.C. § 112, first paragraph or 35 U.S.C. § 132, those decisions do not apply to the facts of instant reexamination proceeding. In the present instance the patent claims would need to be fully supported by the parent, of which the patent is a C-I-P. This support analysis has not been shown to have been carried out in the prosecution of the patent. The support consideration of whether any of the prior C-I-P applications (for which 35 U.S.C. § 120 benefit is claimed in the '516 patent) describes and enables the subject matter claimed in the '516 patent does not require an examination of **the specification of the '516 patent** to determine whether **the specification of the '516 patent** describes and enables the invention recited by the '516 claims (or claims prohibited "new matter"). The '516 patent claims may very well be fully supported (described and enabled) by the specification of the '516 patent, while those claims are not entitled to the effective date of the parent cases. On the current record, consideration of the effective filing date for the claims of the '516 patent only relates to the question of whether the benefit applications themselves describe and enable the '516 claims so as to entitle the claims to an early effective filing date based upon the filing date of one or more of the benefit applications. Such consideration can in no way be construed as a reexamination of the sufficiency of the specification of the '516 patent in terms of compliance with 35 U.S.C. § 112, first paragraph, and § 132. Therefore, the *Patlex* and *Hyatt* decisions relied upon by patent owner are distinguished on the facts, and those decisions do **not** preclude the examination carried out in the present instance on the question of whether the effective filing date for a claim or claims of the '516 patent is other than the filing date of the earliest application for which 35 U.S.C. § 120 benefit is claimed. The issue of whether a given publication or patent qualifies as prior art against the '516 patent is proper in this reexamination. This follows because a finding that the specification of a given parent C-I-P application does not describe and enable the invention claimed in the patent being reexamined in no way expressly or inherently compels a conclusion that the specification of the '516 patent is itself defective under 35 U.S.C § 112, first paragraph and/or 35 U.S.C. § 132.

The instant request for reexamination is based upon newly cited prior art not of record in the examination of the '516 patent, and it invokes reexamination of the benefit claim with respect to claimed subject matter differing from the claims **originally examined** during the prosecution of the '516 patent. The record of the original examination of the '516 patent shows that the examiner did in fact make a determination regarding the effective filing date of original application claim 57, the only claim to which prior art was applied, and therefore the only claim for which the effective filing date of the application was relevant; however, claim 57, was ultimately canceled. [15] Nothing in the record shows or implies that the claims which issued in the '516 patent were ever analyzed on the record with respect to the effective filing date of those claims. The requester has done so in the request, has provided argument that the patent claims are not entitled to an effective date prior to publications newly cited (that were not of record during the original examination of the '516 patent) in the request, and argued that the newly cited publications render the claims unpatentable. This substantial new question of patentability, that takes into account a determination of the effective filing date for the '516 claims, was properly be raised in the instant request for reexamination, and it was accepted by the examiner in ordering reexamination.

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[15] See the file history of U>S> patent No. 6,410,516 B1, Office actions dated January 7, 1997 and October 27, 1997, and Notice of Allowability dated October 26, 2001.

Patent owner's arguments with respect to the allegedly incomplete nature of the examiner's order granting reexamination (on the grounds that the order fails to include a discussion of the benefit claim analysis) are not persuasive. Initially, it is pointed out that MPEP § 2246 indicates that the examiner's order **should** include a discussion of the reasons why a particular patent or printed publication is considered to be prior art as to a given patent claim.[16] MPEP § 2246 does not command that the order must include such discussion. In the absence of such discussion, it is clearly implicit that the examiner relied upon the discussion the reexamination request. In addition, arguments directed at the completeness of the examiner's order and/or the accuracy of requester's analysis of the 35 U.S.C. § 120 benefit claim in the request are not directed to the question of whether the order granting reexamination is, or is not, *ultra vires*. Rather, an *ultra vires* question is a question of whether the reexamination order is based upon matters that are not proper for consideration in a reexamination proceeding, *i.e.*, a question of whether the Office had jurisdiction to reexamine such matters. *Patlex*, at 37. The issue of the completeness and/or accuracy of the examiner's order, or of requester's request for reexamination on which the order was based, goes to the merits, (*i.e.*, accuracy), of the examiner's determination that a substantial new question of patentability was properly established by the request for reexamination, and not to the Office's jurisdiction to issue an order containing that determination. Unlike the issue of jurisdiction (*ultra vires* order), the issue of the completeness and/or correctness of the order is not petitionable. Rather, that issue is resolved during the examination and prosecution of the proceeding. MPEP § 2246(1).

II. The June 8, 2005 Order Granting the Request for Reexamination is Not Based Upon Prior Public Use

Although the request for reexamination cites and relies upon numerous printed publications which are stated by the requester to raise substantial new questions of patentability as to one or more of the '516 patent claims under 35 U.S.C. § 102, the patent owner argues that the reexamination request is based not upon those publications, but rather upon prior public use of the subject matter described in those publications. According to patent owner, the publications do not expressly teach the subject matter of any of the 203 claims of the '516 patent, all of which are method claims. The patent owner argues that to the extent that the requester is correct in alleging that the method expressly taught in any of the publications inherently teaches the method of one or more of the '516 patent claims, reliance upon the inherent teaching of a method in the publications is a reliance upon the performance of the method expressly taught in the reference, *i.e.*, a reliance upon a public use of that expressly taught method. In support of this proposition, patent owner has relied upon the decisions in the *Schering Corporation, Cruciferous Sprout Litigation, MEHL/BIOPHILE International Corp.* cases cited above. Patent owner additionally argues that the Court of Appeals for the Federal Circuit has held that a <u>method</u> is inherently anticipated <u>only</u> by the actual public use of the method (which may or may not have been described in a printed publication). [17] An analysis of the cases shows that they do not in fact support owner's position.

In *MEHL/BIOPHILE*, the issue presented included, *inter alia*, the question of whether a certain article referred to as the "Polla article" clearly anticipated the method claims of United States Patent No. 5,059,192, notwithstanding that the Polla article failed to expressly teach one of the claimed method steps. In *MEHL/BIOPHILE*, the Court of Appeals for the Federal Circuit stated

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[16] See footnote 9, **supra**.

[17] Petition to vacate, at page 11.

the general law with respect to inherent anticipation:

> "Thus, **a prior art reference** may anticipate when the claim limitation or limitations not expressly found in that reference are nonetheless inherent **in it.** (Citations omitted.) Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates. (Citations omitted.) Inherency is not necessarily conterminous with the knowledge of those of ordinary skill in the art. Artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art."

(192 F.3d at page 1365) (Emphasis added, citations omitted.)

Then, in discussing the teachings in the Polla article, the court went on to state that:

> "[V]iewed as a whole, this disclosure shows, in the words of *In re Oelrich, 666 F.2d at 581,* that the 'natural result flowing from the operation **as taught** would result in' alignment of the laser light over a hair follicle, as claimed."

(192 F.3d at page 1365) (Emphasis added.)

The court then concluded by stating:

> "Thus, **the Polla article** anticipates claim 1 of the '192 patent."

(*see Id.*) (Emphasis added.)

Although the court did discuss the aligning step of the Polla article in terms of what researchers studying the epilated backs of guinea pigs would necessarily do, it is impossible to read the quoted portions of the *MEHL/BIOPHILE* decision as stating other than it is the prior art reference itself (not the public use of the reference teachings) that may anticipate claimed method limitations when the claimed limitations are inherent in that prior art reference. Also, it is impossible to reach a conclusion other than that the court held **the Polla article** to anticipate the claimed patented method, notwithstanding that the patented method was merely inherent in, and not expressly taught by, the Polla article. The court nowhere stated that the public use of the method taught by the Polla article constituted the anticipation of the patented claims. The *MEHL/BIOPHILE* decision does not support patent owner's position that the publications cited in the present request for reexamination fail to qualify as prior art publications and are prior art (if at all) only as prior public uses.

A similar analysis can be applied to the *Cruciferous Sprout* case, which (301 F.3d at 1349) cites the *MEHL/BIOPHILE* decision approvingly. As set forth at page 1345 of the court's opinion, the patented claims were directed to methods of growing and eating certain sprouts to reduce the level of carcinogens in animals. The claimed method had been held to be anticipated by certain prior art references that disclosed the growing and eating of sprouts, but did not teach that doing so would constitute a method to reduce the level of carcinogens in animals. It is true that the court did allude to the fact that certain specifically claimed cultivars not taught in the publications were in the public domain, and that therefore, the patentee could not credibly argue that no person had grown or eaten such cultivars. However, the Federal Circuit clearly held that "**[t]he Munroe reference** therefore **discloses** each and every limitation of these claims of the patents." (*Cruciferous Sprout,* 301 F.3d at 1352)(emphasis added). It is clear that in *Cruciferous Sprout,* the Federal Circuit did not hold that inherent anticipation of a method claim

is solely grounded upon prior use of a different, non-anticipatory method disclosed in a publication, but instead held that when a publication expressly discloses a method which inherently anticipates a claimed method, it is the publication that anticipates the claimed method as a publication. Thus, the *Cruciferous Sprout* case also does not support patent owner's position on the matter.

Patent owner relies upon the *Schering Corporation* case for the proposition that while a claimed compound could inherently be anticipated by a prior art patent disclosing a method of treating a patient (by administering a different compound) when the treatment method would, when performed, inherently produce the claimed compound, the court also held that claims for **the method of treatment** would not be inherently anticipated by such disclosure. [18] However, the *Schering Corporation* case does not support patent owner's position.

In *Schering Corporation,* claims in United States Patent No. 4,659,716 (the '716 patent) to a metabolite of loratadine were held to have been inherently anticipated by prior U. S. Patent No. 4,282,233 (the '233 patent) which disclosed and enabled a treatment method by which loratadine was administered to a patient. The method of administering loratadine to the patient inherently resulted in the formation (inside the patient's body) of a metabolite of loratadine called DCL, which metabolite fell within the scope of the patented claims. The Federal Circuit clearly made the point that it was the patent reference that constituted the anticipation of the claimed metabolite when the court stated:

> "An anticipatory reference need only enable subject matter that falls within the scope of the claims at issue, nothing more. To qualify as an enabled reference, the '233 patent need not describe how to make DCL in its isolated form. The '233 patent need only describe how to make DCL in any form encompassed by a compound covering DCL, e.g., DCL as a metabolite in a patient's body. The '233 patent discloses administering loratadine to a patient. A person of ordinary skill in the art could practice the '233 patent without undue experimentation. The inherent result of administering loratadine to a patient is the formation of DCL. **The '233 patent thus provides an enabling disclosure for making DCL.** "
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> (339 F.3d 1381.) (Emphasis supplied.)

Thus, the Federal Circuit did **not** state that it was the **prior public use** of the method described in the '233 patent which constituted an inherent anticipation. The court clearly stated that it was the '233 patent that anticipated as a prior art patent.

Moreover, the *Schering Corporation* case did not hold or state that the express disclosure of a treatment method could not anticipate **the** method of treatment claims in the '716 patent, because it does not appear that any method of treatment claims in the patent were at issue in the case. [19] The court's statement at page 1381 to the effect that **a** method of administering a metabolite could avoid inherent anticipation by the method taught in the '233 patent was merely part of a discussion by the court for the purpose of illustrating that the result reached by

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[18] The method of treatment discussed by the court was the method disclosed in U.S. Patent No. 4,292,233 (the '233 patent), a patent that was applied as an inherently anticipatory patent against the claims of U.S. patent No. 4,659,716 (the '716 patent).

[19] The treatment methods claimed in the '716 patent were for the administration of a metabolite while the '233 patent relied upon as being an anticipatory patent disclosed the method of treating a patient with loratadine, which is not itself one of the claimed metabolites. However, the '716 methods were not in issue; the case involved an alleged infringement of the metabolite compounds claimed in the '716 patent.

the court (a patent teaching a method of administering a compound to a patient inherently anticipated a claim for a metabolite when the method inherently resulted in the production of the claimed metabolite) did not, in theory, preclude all patent protection for the metabolite. [20] The court opined that a claim for the metabolite in isolated form or as a pharmaceutical composition (e.g., with a pharmaceutically acceptable carrier), or a claim for a method of administering the metabolite in isolated form or as a pharmaceutical composition, would not be anticipated by the '233 patent which only taught a method administering loratadine, which in turn resulted only in the production of DCL as a metabolite *that was neither isolated nor a pharmaceutical compound.* This illustration of a theoretical viewpoint by the court is interesting, but is not relevant to the issue presented in the instant petition. Accordingly, the *Schering Corporation* case does not support patent owner's position on this matter.

Attention is also invited to *Smithkline Beecham Corporation et al v. Apotex Corporation et al,* 403 F.3d 1331 (Fed. Cir. 2005). This decision cites the *Schering Corporation, Cruciferous Sprout* and *MEHL/BIOPHILE* cases approvingly. The *Schering* court stated:

> "The *'196 patent* discloses a method of manufacturing PHC anhydrate that naturally results in the production of PHC hemihydrate. Consequently, applying the facts as found by the district court to the correct standard, this court holds that claim 1 of the *'723 patent* is invalid for anticipation by the *'196 patent.*"
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> (403 F.3d at 1344) (Emphasis in the original.)

The court then went on to state:

> "Because the record contains clear and convincing evidence that production of PHC anhydrate in accordance with the *'196 patent* inherently results in at least trace amounts of PHC hemihydrate, this courts holds that the *'196 patent* inherently results in at least trace amounts of PHC hemihydrate, this court holds that the '196 patent inherently anticipates claim 1 of the *'723 patent* under 35 U.S.C. 102(b)."
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> (403 F.3d at 1344) (Emphasis in the original.)

It is clear from a consideration of the *Smithkline Beecham* decision, as well as from a consideration of the precedential case law cited by patent owner, that a prior art patent or publication containing an enabling express disclosure that inherently anticipates a claimed invention which was not expressly known or appreciated by the prior art at the time that the patent or publication was published is to be regarded as an anticipatory prior art patent or printed publication. That the inherent anticipation exists by reason of the fact that the claimed invention would be produced by following the teachings of the patent or printed publication does not mean that the teachings of the patent or printed publication had to have been, or have to be, publicly performed prior to an applicant's invention. Nor does it mean that the anticipation is the result of a prior public use, rather than by reason of the patent or printed publication being anticipatory as a prior art patent or printed publication. This follows from the principle that it is not necessary that an invention disclosed in a patent or printed publication shall actually have been made or practiced, provided that the disclosure in the publication is

[20] The court's discussion was *dicta*, having nothing to do with the method claims of the '716 patent since those method claims were not before the court for consideration.

described so as to have placed the public in possession of it. [21] This further follows from the uniform pronouncement in the case law "that inherent anticipation does not require that a person of ordinary skill in the art recognize the inherent disclosure in the prior art at the time the prior art is created." *Schering Corporation,* 403 F.3d at 1343. Thus, so long as a patent or printed publication enables the practice of a method that would inherently anticipate a different method not expressly disclosed in the patent or printed publication, the patent or printed publication is considered to be an anticipatory disclosure of the inherently disclosed method, **as a patent or printed publication,** even if at the time of publication or issuance of the patent, the expressly disclosed invention had not been practiced and a person of ordinary skill in the art would not necessarily have recognized the inherently disclosed method. The patent or printed publication is **not** regarded as being a prior art prior public use of the inherently disclosed method, because the cases do not require that the inherently disclosed method had been publicly performed at the time of patenting or publication.

As a final point, the issue of whether the references can be applied as prior art using the inherency argument is not a petitionable issue; rather it is a matter to be resolved in examination of the claims by the examiner, or possibly on appeal. The request for reexamination has raised the issue of the inherency based on the prior art cited in the request, and the examiner has determined the request to have provided a substantial new question of patentability as to the patent claims with respect to applying the prior art based on the inherency discussed above. It is not the function of the petition process to resolve this matter of applying the prior art. As pointed out in *Heinl v. Godici,* 143 F. Supp. 2d 593 (E.D. Va. 2001), "[c]ourts are uniform in recognizing that the decision to grant reexaminations of a patent is preliminary, not final agency action." *Heinl,* 143 F. Supp. 2d at 597. Both (a) the fact that the issue as to the status of the cited references as prior art based on the position of inherency has never been determined in the prior proceedings, and (b) the fact that an order granting reexamination is not a final agency action, weigh in favor of allowing the reexamination proceedings to continue.

In summary:

In *Heinl,* 143 F.Supp.2d at 601, the court stated, in a decision seeking termination of reexamination based on the absence of a new question of patentability:

> "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 underlying proceedings."

After a review of the record, and based upon the above discussion, it is found that patent owner has not shown that the Office "clearly exceeded its statutory authority," nor acted "in brazen defiance of its statutory authorization," in the Office determination that the questions of

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[21] *Elan Pharmaceuticals, Inc., et al v. Mayo Foundation for Medical Education and Research,* 346 F.3d 1051 at 1055 (Fed. Cir. 2003), citing *In re Donohue,* 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985)

patentability raised in the April 4, 2005 reexamination request properly raised a substantial new question of patentability.

DECISION ON PATENT OWNER'S PETITION TO STAY REEXAMINATION

The patent owner petition to stay this reexamination proceeding was filed on August 8, 2005, concurrently with the filing of the petition to vacate the reexamination order of June 8, 2005. The patent owner has requested that the Office stay the instant reexamination proceeding until the authority of the Office to proceed with the reexamination is finally decided.

It is initially noted that no patent owner statement was filed on or before the due date of August 8, 2005, thereby bringing the proceeding up for the first *ex parte* examination on the merits of the claims *at that point in time.* [22] Nevertheless, the patent owner's petition to stay has been granted to the extent that action on the proceeding was delayed pending a consideration of the concurrently filed petition to vacate the reexamination order. At this point in time, however, the proceeding is ripe for action on the merits. A review of the petition to stay, and the record as a whole, fails to reveal any compelling legal or factual basis to support the grant of a stay of the reexamination proceeding, when it has now been determined by the Office that jurisdiction to order reexamination was not lacking. Although the decision in *Ethicon v. Quigg,* 849 F.2d 1422; (Fed. Cir. 1988) held that a stay of reexamination was not appropriate merely due to the existence of concurrent litigation involving the patent for which reexamination in the Office was sought, while the stay in the instant reexamination proceeding involves the alleged *ultra vires* nature of the reexamination request, much of the rationale of the *Ethicon* decision is applicable to the instant petition.

In *Ethicon,* the court gave considerable, indeed dispositive, weight to the language of 35 U.S.C. § 305 that requires reexamination proceedings in the Office to be conducted with special dispatch, notwithstanding the existence of concurrent court litigation. The court further noted that "litigation and reexamination are distinct proceedings, distinct purposes, procedures and outcomes." *Id,* at 1154. In the instant reexamination proceeding, concurrent litigation exists with respect to the '516 patent, and, therefore, the benefits discussed in *Ethicon* at page 1157 with respect to conducting reexamination in the Office even when the involved patent is in litigation are present in the instant reexamination proceeding. Further, although patent owner states that the stay being sought is for a defined period time, [23] in fact the stay is being sought until there has been a final decision on the issue of whether the order granting reexamination was an *ultra vires* act. Final determination is stated by patent owner to include court review if necessary to decide the question, [24] and that in turn means that the stay requested amounts to a stay of the instant reexamination proceeding for an indeterminate amount of time. This clearly runs counter to the statutory requirement for special dispatch.

Note is taken of the fact that in drafting the reexamination statute, it was Congress' intent that patent owners be protected from harassment. *Patlex Corporation* v. *Mossinghoff,* 771 F.2d 480 (Fed. Cir. 1985). However, patent owner nowhere offers a convincing rationale explaining why the filing of the request for reexamination in this instance, and its resolution, would constitute harassment of patent owner nor that the filing of the request was an action taken with intent to

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[22] See 37 CFR 1.530 and 1.550; see also MPEP § 2254.
[23] Petition to stay, page 4.
[24] Petition to stay, page 3.

harass. Patent owner does not offer any evidence that requester is "improperly seeking reexamination." [25]Patent owner only relies upon the assumption that patent owner's position (that the reexamination request is predicated upon public use, not upon prior patents or printed publications) is correct. It is noted that patent owner does not offer any explanation of the conclusory statement that continuing with this reexamination would prejudice patent owner at trial. Even if patent owner were correct that the reexamination request is improperly based on prior public use, the court would nevertheless be in a position to examine any alleged prior public use independently of any finding by the Office and to accord it such effect as the court deems warranted.

Given the rationale discussed in *Ethicon* against staying a reexamination proceeding, and weighing the allegations of potential prejudice to patent owner in conducting the instant reexamination proceeding against the fact that any such stay would be for an indeterminate amount of time (so as to make the conducting of this proceeding with special dispatch problematic), this reexamination proceeding will not be further stayed.

DISPOSITION OF PATENT OWNER'S REPLY TO REQUESTER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR STAY

MPEP § 2246(I) discusses the filing of a patent owner petition under to vacate an order granting reexamination. There is no right to judicial review of an Office determination that a request for reexamination has raised a substantial new question of patentability, except in the limited case of an allegation that the order for reexamination was an *ultra vires* action on the part of the Office. Accordingly, MPEP § 2246(I) provides for a petition under 37 CFR 1.181 to vacate an *ultra vires* reexamination order. The filing of such a petition, however, is limited therein to a single submission, even if an opposition to the petition is filed by third party requester." [26] Thus, the patent owner reply to requester's opposition to the patent own filed on September 6, 2005 does not have an entry right in this reexamination proceeding, and it is therefore being returned to patent owner pursuant to MPEP § 2267.

[25] Petition to stay, page 2.
[26] MPEP § 2246(I), Rev. 2, May 2004, at page 220-54.

CONCLUSION

1. The petition under 37 CFR 1.181 to vacate the reexamination order dated June 8, 2005 as being a *ultra vires* action on the part of the Office is dismissed.

2. The petition to stay the reexamination proceeding pending a final determination on the question of whether the June 8, 2005 reexamination order is an *ultra vires* act has been granted only to the extent that no examination of the patentability of the claims has been undertaken pending the issuance of this decision in the 37 CFR 1.181 petition to vacate, but is dismissed with respect to staying the proceedings subsequent to the mailing date of this decision.

3. The September 6, 2005 patent owner reply to third party requester's opposition to the patent owner's petition to stay the reexamination proceeding is a non-enterable paper, and is therefore being returned to patent owner with this decision.

4. The reexamination file is being forwarded to the Technology Center for the issuance of a first Office action under 37 CFR 1.550(a) in due course.

5. 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

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(For Requester)

In re The President and Fellows of
Harvard University *et al*
Reexamination Proceeding
Control No.: 90/007,503
Filed: April 4, 2005
For: U.S. Patent No. 6,410,516 B1

: DECISION ON REQUEST
: FOR RECONSIDERATION

This is a decision on the November 25, 2005 patent owner request for reconsideration of the October 6, 2005 decision on petition dismissing the August 4, 2005 patent owner petition under 37 CFR 1.181(a)(3). In the August 4, 2005 petition, patent owner sought to vacate the order granting the above-captioned reexamination proceeding, and also sought to stay the reexamination proceeding. The request for reconsideration is confined to the refusal to vacate the reexamination proceeding and does not seek reconsideration of the refusal to stay the reexamination proceeding. An opposition to the request for reconsideration was filed by requester on December 6, 2005.

The reexamination proceeding, the patent owner request for reconsideration and the third party requester opposition to the request for reconsideration are before the Office of Patent Legal Administration.

The request for reconsideration is granted to the extent that the October 6, 2005 Decision on Petition has been reconsidered, but the relief requested by patent owner is denied for the reasons set forth below.

REVIEW OF SALIENT FACTS

1. U. S. Patent No. 6,410,516 (the '516 patent) issued on June 25, 2002.

2. The '516 patent is the subject of litigation that commenced on June 25, 2002.

3. A request for *ex parte* reexamination of the '516 patent was filed on April 4, 2005 and assigned control number 90/007,503 (hereinafter the '7503 reexamination proceeding).

4. Reexamination was ordered for '7,503 proceeding on June 8, 2005.

5. On August 8, 2005, the patent owner filed a petition under 37 CFR 1.181(a)(3) to vacate the '7503 proceeding.

6. Also on August 8, 2005, the patent owner filed a petition to stay the '7503 reexamination proceeding until the authority of the Office to proceed with the reexamination is finally decided.

7. On August 18, 2005, the third party requester filed an opposition to the petition to vacate and to the petition to stay the reexamination proceeding. This was filed in the form of a single paper.

9. On September 6, 2005, the patent owner filed a reply to the third party requester's opposition.

10. On October 6, 2005, a decision was mailed dismissing the patent owner's petition to vacate, granting in part the petition to stay,[1] and returning to patent owner the September 6, 2005 reply to the requester's opposition.

11. Patent owner filed a supplemental Information Disclosure Statement on October 18, 2005.

12. On November 25, 2005, patent owner filed the instant request for reconsideration of the October 6, 2005 decision dismissing the original petition.

13. On December 6, 2005, the requester filed an opposition to the patent owner's request for reconsideration.

14. A patent owner statement under 37 CFR 1.530 has not been received in the '7503 proceeding.

RELEVANT STATUTORY PROVISIONS AND PRACTICE

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."

MPEP § 2246, second paragraph, states, in part:

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[1] The petition to stay was granted only to the extent that no examination of the patentability of the claims was undertaken pending the issuance of the decision in the August 8, 2005 petition to vacate, but was dismissed with respect to staying the proceedings subsequent to the mailing date of that decision.

"In the examiner's decision, [2] 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. The examiner should indicate, insofar as possible, his or her initial position on all the issues identified in the request or by the requester (without rejecting claims so that comment thereon may be received in the patent owner's statement and in the requester's reply."

MPEP § 2246(I), states, in part:

"Where the examiner determines that a date of a reference is early enough such that the reference constitutes prior art, that determination is not petitionable (with respect to vacating the examiner's finding of a substantial new question). Where the examiner determines that a reference is a printed publication (i.e., that the criteria for publication has been satisfied), that determination is also not petitionable. These matters cannot be questioned with respect to vacating the order granting reexamination until a final agency decision on the reexamination proceeding has issued. Rather, these matters can be argued by the patent owner and appealed during the examination phase of the reexamination."

"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 no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained. "Appropriate circumstances" under 37 CFR 1.181(a)(3) exist to vacate the order granting reexamination where, for example:

"(A) the reexamination order is not based wholly on prior art patents or printed publications;"

DECISION

A. Basis for Patent Owner's Request for Reconsideration

Patent owner alleges that the October 6, 2005 decision dismissing the original petition contained two significant errors. Patent owner asserts that:

1) The October 6, 2005 decision "fails to address the improper reliance by the examiner in the June 8, 2005 Order on non-prior art printed publications supporting the findings of Substantial New Questions of Patentability III through VIII involving alleged inherency." It is patent owner's position that the statutory prohibition against consideration of evidence other than "prior art consisting of patents or printed publications" was, violated, thereby rendering the order granting reexamination an *ultra vires* action.

2) In supporting the finding of Substantial New Question of Patentability I and II, the October 6, 2005 decision on petition improperly held that the term "should" in MPEP § 2246 is not obligatory, and that the examiner's failure to expressly state the examiner's rationale for limiting the effective date of the '516 patent to a date later than the earliest date in the benefit claim therefore rendered the order granting reexamination an *ultra vires* action.

[2] The context here is a decision on whether reexamination should, or should not, be ordered.

B. Analysis and Findings

1. A review of the October 6, 2005 decision shows that the decision did in fact address each and every argument presented by patent owner in the August 8, 2005 petition.

(a) At pages 5-8, the decision analyzed patent owner's position that the Office was not entitled to analyze the 35 U.S.C. § 120 benefit claim of the '516 patent. The decision explained why the Office could properly analyze a Section 120 benefit claim when the claim in the patent being reexamined was for benefit as a continuation-in-part of one or more parent patents or patent applications. The decision distinguished the precedents relied on by patent owner because in those cases, the patent being reexamined recited only continuation or divisional 35 U.S.C. § 120 benefit claims.

(b) At pages 8-13, the decision thoroughly considered patent owner's position that the references relied upon by the examiner were being relied upon as prior public uses, and not as patents or printed publications.

(c) In the first paragraph on page 8 of the decision, it was explained why the use of the word "should" in MPEP § 2246 was not the language of command. It was also explained that the issue of alleged incompleteness of the examiner's decision ordering reexamination, or the accuracy of that order, do not divest the Office of jurisdiction to order reexamination pursuant to 35 U.S.C. § 303. It was pointed out that pursuant to MPEP § 2246(I), questions of the completeness and accuracy of a reexamination order are not petitionable, as long as at least one substantial new question is presented, upon which to base the order for reexamination.

2. Petitioner's request for reconsideration of the October 6, 2005 decision by the Office not to vacate the proceeding is not persuasive as to making a modification of that decision:

At page 3 of the request for reconsideration, patent owner states that the October 6, 2005 decision does not dispute that non-prior art references were relied upon by the examiner as evidence upon which reexamination was ordered. This argument does not accurately characterize the holding of the October 6, 2005 decision on petition, or the analysis therein that supports the holding in the petition. The October 6, 2005 decision did not take a position on the issue of whether any given document relied upon by the examiner was, or was not, prior art to the '516 patent. The decision merely pointed out why it was proper for the examiner to have analyzed the '516 patent's 35 U.S.C. § 120 claim for benefit of the dates of certain parent patents. The decision also pointed out why it was proper for the examiner to order reexamination based on such patents and publications as the examiner determined to be prior art against the '516 patent on the grounds that the '516 patent was not entitled to the benefit of the filing dates of these prior patents. [3] The October 6, 2005 decision took no position *vis-à-vis* the accuracy of the examiner's analysis, because as pointed out at page 8 of the October 6, 2004 decision, the accuracy of the examiner's determination that a substantial new question of patentability exists is not petitionable. [4] In fact, the question of whether any document is or is not a printed publication, as well as the question of whether any patent or printed publication applied by the examiner is prior art, are generally appealable issues.

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[3] See Decision on Petition, October 6, 2005, pages 5-8.

[4] See MPEP § 2246 and note the discussion comparing determinations that prior art patents or printed publications establish a new question of patentability with determinations based on other than prior art patents or printed publications.

The October 6, 2005 decision on petition considered two precedents cited by patent owner in support of patent owner's proposition that when reexamination is requested for a patent in which there is a 35 U.S.C. 120 benefit claim, the patent may not be analyzed to determine whether that 120 benefit claim provides an effective filing date to predate certain applied patents/printed documents. [5] The October 6, 2005 decision distinguished those precedents with respect to the facts present in the instant reexamination proceeding, and explained that the precedents did not apply to benefit claims when the benefit being claimed is that of the patent being reexamined being a continuation-in-part. [6] The distinction was stated to be that, with respect to a continuation-in-part patent, it is the disclosure of the *parent application*, for which benefit is claimed, that is examined for 35 U.S.C. § 112 support, not the disclosure of the patent which is itself the subject of the reexamination proceeding. That is different than the case of a continuation patent, where it has already been determined, in the examination of the application, that the claims and disclosure of the patent (being reexamined) are supported by the parent's disclosure, since no new matter or 35 U.S.C. 112, paragraph 1, rejection was made in the application; thus, it can only be the disclosure of the patent itself which would be examined for support of the patent claims in the reexamination proceeding (and such is not proper for reexamination).

It is now further noted that both of these decisions (relied upon as precedent by petitioner) involved patentability **appeals** in a reexamination proceeding, not jurisdictional challenges in which a patent owner had sought relief by way of a petition on the grounds that the order granting reexamination was an *ultra vires* action. It is reiterated that the accuracy of the examiner's determination that a printed document is prior art is reviewable on appeal, and not by way of petition. [7]

Further, it was pointed out in the October 6, 2005 decision on petition that, in the instant reexamination proceeding, the examiner clearly found at least one substantial new question of patentability based upon publications not of record and not considered during the examination of the '516 patent, **which publications are clearly prior art to the '516 patent because they predate the earliest date recited in the 516 patent's Section 120 benefit claim.** [8,9] On the basis of at least one substantial new question of patentability based upon prior art antedating the earliest benefit date claimed, the Office clearly established its jurisdiction to order reexamination pursuant to 35 U.S.C. § 303, even if patent owner would be correct regarding its position that a patent undergoing reexamination cannot be examined as to its entitlement to an early effective date based upon a 35 U.S.C. § 120 benefit claim made for continuation-in-part status with respect to a parent. [10] Since the Office has established its jurisdiction to order

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[5] *Patlex Corporation v. Quigg*, 680 F. Supp. 377 (D.D.C. 1988) and *Ex parte Hyatt*, Appeal No. 98-1912, Reexamination Control No. 90/001,896 (Bd. Pat. Appl. & Inter. 1999, unpublished)

[6] See pages 5 and 6 of the October 6, 2005 decision.

[7] See MPEP § 2246(I), quoted at page 4 of the instant decision.

[8] See the Order granting reexamination, page 6, first full paragraph as **one** example of a substantial new question of patentability based upon printed publications that are unquestionably prior art to the '516 patent, even assuming that the '516 patent were entitled to the earliest effective filing date recited in its Section 120 benefit claim.

[9] See pages 5 and 6 of the October 6, 2005 decision

[10] Patent owner's request for reconsideration does not challenge the statement at page 12 of the October 6, 2005 that precedent, exemplified *Schering Corporation v. Geneva et al*, 339 F.3d 1373 (Fed. Cir. 2003) that inherent anticipation by a prior art document may be established by reference to a document that is not prior art, because "inherent anticipation does not require that a person of ordinary skill in the recognize the inherent disclosure in the prior art at the time the prior art is created." *Schering Corporation*, at page 1343. Thus, so long the order granting reexamination found a substantial new question of patentability based upon a prior art document, it is immaterial that the prior art document may have required interpretation by reference to non-prior art documents.

reexamination of the '516 patent (based to the existence of a substantial new question of patentability provided by references antedating the earliest § 120 claim date to thus qualify as prior art), the propriety of any rejection that is subsequently asserted against a patent claim during this reexamination proceeding presents an issue that is **appealable**. An allegation that the examiner has promulgated a rejection based upon an erroneous determination of the effective date of a reference would stand on no different footing than an allegation that a rejection was erroneous because an applied reference failed to teach the claimed invention, or failed to qualify as a printed publication. [11]

Finally, note is taken of the patent owner's argument regarding the word "should," that it requires specific content of an order for reexamination. There can be no dispute that the word "shall" is the language of command, unless clearly indicated otherwise. Patent owner goes further and concludes, unsupported by citation of authority, that because in ordinary English usage, the word "should" can be the past tense of the word "shall," the word "should" is to be taken as a requirement in the same manner that "shall" is so taken. This argument does not, however, establish that the word "should" when used in any context, and especially as MPEP § 2246(I) uses it, is to be construed to mean "shall." In fact, depending upon the context, it is clear that the word "should" quite often is used as other than the language of command. Patent owner is referred to *Colburn v. Trustees of Indiana University*, 739 F. Supp. 1268, 1294-1295 (D. Ind. 1990), citing *Black's Law Dictionary* (5th ed. 1979) which states that "[a]lthough the word 'should' is the preterite tense of 'shall,' it does not express the same imperative or mandatory meaning as 'shall'." Indeed, although the word 'should' ordinarily implies 'duty or obligation,' it is usually no more than an obligation of propriety or expediency, and it 'does not ordinarily express certainty as 'will' sometimes does."

Moreover, even if patent owner were correct in concluding that in the context of determining the existence of a substantial new question of patentability, "should" means "shall" in order to "provide a safeguard to the patent holder" so as to carry out the intent of Congress in reexamination proceedings of protecting a patent owner from "unjustified" reexaminations, the patent owner has failed to demonstrate why that Congressional intent was not honored in the instant reexamination proceeding. Stated differently, assuming *arguendo* that the word "should" was intended as the language of command in the portion of MPEP § 2246 reproduced, *supra*, patent owner has not explained why the examiner's order granting reexamination in this proceeding does not comply with MPEP § 2246. The order granting reexamination clearly indicates by reason of specific reference and citation to various parts of the request for reexamination that the examiner has read and understood the request for reexamination. Beginning at page 15 of the request and running through page 20, requester presents a detailed argument that the '516 patent is not entitled to an effective filing date earlier than November 13, 1991. The examiner has expressed agreement with proposed substantial new questions of patentability based upon printed publications that are dated earlier than November 13, 1991, but later than the filing dates of certain patents listed in the '516 patent 35 U.S.C. § 120 benefit claim. It is perfectly clear that the examiner has adopted the third party requester's position, as expressed at pages 15-20 of the request for reexamination, on the question of the date to which the '516 patent claims are entitled as the examiner's own. And although patent owner argues that the examiner cannot adopt requester's position, patent owner has provided no explanation or authority to explain why the examiner's adoption of requester's position does not reflect an independent assessment by the examiner that requester's position is correct. Patent owner fails to provide any legal or logical reason why, if a reexamination requester asserts a position, an examiner is not free to adopt it, providing that it can be understood from the reexamination

[11] See 35 U.S.C. § 306; 37 CFR 1.550(a); MPEP § 2273 regarding appeals in *ex parte* reexamination proceedings.

order that the examiner has done so. Nor does there appear to be any legal or logical reason why, in so doing, the examiner would fail to satisfy the Congressional mandate that reexamination proceedings not be "automatically" granted.

Again, it must be noted that the examiner's order granting reexamination has set forth at least one substantial new question of patentability based upon printed publications predating the earliest effective 35 U.S.C. § 120 benefit claim asserted in the '516 patent. Therefore, even assuming, *arguendo*, that patent owner were correct that the examiner's adoption of the third party requester analysis of the 35 U.S.C. 120 benefit claim is not "independent" action by the examiner, the Office has, nevertheless, established jurisdiction to order reexamination in this proceeding.

In summary:

1. The examiner's action in determining that the effective filing date of the '516 patent was not earlier than November 13, 1991 (i.e., the applications recited in the § 120 benefit claim that were filed earlier than November 13, 1991 did not support the subject matter claimed in the '516 patent) was not an improper examination of the sufficiency of the '516 patent's disclosure under 35 U.S.C. §§ 112 and 132. As such, the action did not render the order granting reexamination an *ultra vires* action on the part of the Office.

2. Even if it the examiner's action in examining the 35 U.S.C. § 120 benefit claim of the '516 patent would have been an improper action, the order granting reexamination is not an *ultra vires* action because it relies on at least one substantial new question of patentability based upon prior art having effective dates earlier than the *earliest* date recited in the benefit claim.

3. Patent owner has not established that the word "should" as used in MPEP § 2246 is the language of command requiring that the examiner's order granting reexamination must expressly contain analysis of the '516 patent's benefit claim, or that the absence of such analysis would render the order granting reexamination an *ultra vires* action.

4. Even if MPEP § 2246 required that the order include a textual analysis of the '516 patent's benefit claim in the reexamination order, patent owner has not established that the examiner was not entitled to rely upon the analysis of the requester as expressed in the request for reexamination, and that the examiner's order fails to reflect acceptance of, and reliance upon, the analysis of the benefit claim supplied by the requester.

5. Even if the examiner's order were devoid of any indication of why the '516 patent's benefit claim is not sufficient to entitle the '516 patent to the earliest date recited in the benefit claim, the order granting reexamination would not be an *ultra vires* action because the order granting reexamination relies upon at least one substantial new question of patentability based upon prior art having effective dates earlier than the earliest date recited in the '516 patent's benefit claim.

In *Heinl v. Godici*, 143 F. Supp. 2d 593, 601 (E.D. Va. 2001), the court stated, in a decision seeking termination of reexamination based on the absence of a new question of patentability:

> "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 underlying proceedings."

After a review of the record, and based upon the above discussion, it is found that patent owner has still not established that the Office "clearly exceeded its statutory authority," nor acted "in brazen defiance of its statutory authorization," in the Office's determination that the April 4, 2005 reexamination request properly raised a substantial new question of patentability.

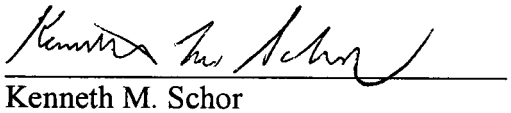
CONCLUSION

1. The request for reconsideration is granted to the extent that the October 6, 2005 Decision on Petition has been reconsidered, but is denied as to the relief requested.

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

3. Jurisdiction over the reexamination proceeding is being forwarded to the Central Reexamination Unit.

4. 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.



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In re Baltimore et al
Reexamination Proceeding
Control No.: 90/007,503
Filed: April 4, 2005
For: U.S. Patent 6,410,516

Dr. Raj Bawa
BAWA BIOTECHNOLOGY CONSULTING LLP
21005 Starflower Way
Ashburn VA 20147

(for Third Party Requester)

In re Baltimore et al
Reexamination Proceeding
Control No.: 90/007,828
Filed: December 2, 2005
For: U.S. Patent 6,410,516

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination files are before the Director of the Central Reexamination Unit for consideration of the proceedings under 37 C.F.R. 1.565(c).

BACKGROUND

1. United States Patent 6,410,516, issued June 25, 2002, is the subject of Reexamination Control Nos. 90/007,503 and 90/007,828.

2. A first request for reexamination, assigned Reexamination Control No. 90/007,503, was filed April 4, 2005 by Grantland G. Drutchas of McDonnell Boehnen Hulbert & Berghoff LLP in Chicago, IL 60606. The request urged that a substantial new question of patentability was raised by the newly cited references which either inherently or expressly disclose the use of a variety of prior art compounds as reducing NF-κB activity and resulting gene expression.

3. Reexamination was ordered for 90/007,503 on April 4, 2005.

4. A second request for re-examination, assigned Reexamination Control No. 90,007,828, was filed December 2, 2005 by Dr. Raj Bawa of Bawa Biotechnology Consulting LLP in Ashburn VA 20147. The request urged that a substantial new question of patentability was raised by the newly cited references which are directed to the use of oligonucleotides having a NF-κB binding cite for reduction of NF-κB activity.

5. Reexamination was ordered for 90/007,828 on December 2, 2005.

6. No Office action has been issued in either reexamination.

7. A petition was filed on April 4, 2006 by Patent Owner to merge the above-identified re-examination proceedings 90/007,503 and 90/007,828.

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 para 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. 1.5659 (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 question raised.

DECISION

I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. 1.565(c), the 90/007,503 and 90/007,828 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

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 of filed by the patent owner will contain the identifying data for <u>all</u> files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, **filed in duplicate**, each bearing a signature and identifying data for **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. 90/007,503 and 90/007,828 as:

John P. White
COOPER & DUNLAP LLP
1185 Avenue of the Americas
New York, New York 10036

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control No. 90/007,503 as:

Grantland G. Drutchas
MCDONNELL BOEHNEN HULBERT
& BERGHOFF LLP
300 S. Wacker Drive, Suite 3100
Chicago, IL 60606

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control No. 90/007,828 as:

Dr. Raj Bawa
BAWA BIOTECHNOLOGY CONSULTING LLP
21005 Starflower Way
Ashburn VA 20147

CONCLUSION

Reexamination Control Nos. 90/007,503 and 90/007,828 are merged. The merged reexamination files are being forwarded to the examiner for preparation of an Office action, to be issued in due course

Any inquiry concerning this decision should be directed to Deborah Jones, Special Programs Examiner, at telephone No. (571) 272-1535.

for Lissi M. Marquis, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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.
90/007,503	04/04/2005	6410516	74753/JPW/GJG	5583

23432 7590 08/15/2006

COOPER & DUNHAM, LLP
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/15/2006

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
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

8/16/06

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Grantland G. Drutchas

McDonnell Boehnen Hulbert & Berghoff

300 S. Wacker Drive, Suite 3100

Chicago, IL 60606

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007503

PATENT NO. 6,410,516

ART UNI 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a 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

Cooper & Dunham, LLP
1185 Avenue of the Americas
New York, NY 10036

(For Patent Owner)

MAILED

AUG 16 2006

CENTRAL REEXAMINATION UNIT

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(For Requester)

Bawa Biotechnology Consulting LLP
21005 Starflower Way
Ashburn, VA 20147

(For Requester)

In re The President and Fellows of
Harvard University *et al*
Reexamination Proceeding
Control No.: 90/007,503
Filed: April 4, 2005
For: U.S. Patent No. 6,410,516 B1

In re The President and Fellows of
Harvard University *et al*
Reexamination Proceeding
Control No.: 90/007,828
Filed: December 2, 2005
For: U.S. Patent No. 6,410,516 B1

: DECISION ON REQUEST
: FOR RECONSIDERATION
: OF DECISION DISMISSING
: PETITION TO VACATE ORDER
: GRANTING REEXAMINATION

This is a decision on the June 13, 2006 patent owner petition entitled "REQUEST FOR RECONSIDERATION OF MARCH 27, 2006 DECISION DISMISSING PATENTEES' PETITION." [1] The petition was filed in the 90/0007,828 reexamination proceeding. [2]

The patent owner's request for reconsideration is before the Office of Patent Legal Administration.

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[1] The March 27, 2006 Decision treated the patent owner petition filed on February 16, 2006 requesting vacatur of *ex parte* reexamination proceeding 90/007,828 and the February 17, 2006 patent owner petition requesting stay of *ex parte* reexamination proceeding 90/007,828. It appears that present patent owner request for reconsideration is confined to requesting reconsideration of the refusal to grant vacatur, and is not addressed to the Office's refusal to stay the proceeding beyond March 27, 2006.

[2] A decision merging reexam *ex parte* reexamination proceeding control number 90/007,503 and *ex parte* reexamination proceeding control number 90/007,828 was mailed on May 4, 2006, and this decision is captioned accordingly.

SUMMARY

A. The request for reconsideration is dismissed for the reasons set forth below.

B. The December 12, 2005 order granting reexamination in the 90/007,828 proceeding remains intact. Therefore, the merger of the 90/007,828 and 90/007,503 proceedings remains intact.

REVIEW OF FACTS

1. U. S. Patent No. 6,410,516 (the '516 patent) issued on June 25, 2002.

2. The '516 patent is the subject of litigation that commenced on June 25, 2002, the same day that the '516 patent issued.

3. A request for reexamination of the '516 patent was filed on April 4, 2005 by a first third party requester and was assigned control number 90/007,503 (the '503 reexamination proceeding).

4 On June 8, 2005, reexamination was ordered for the '503 reexamination proceeding.

5. On August 8, 2005, the patent owner filed a petition under 37 CFR 1.181(a)(3) to vacate the '503 proceeding on the grounds that the '503 reexamination order was an *ultra vires* act on the part of the Office.

6. Also on August 8, 2005, the patent owner filed a request which was taken as a petition to stay the '503 reexamination proceeding until the authority of the Office to proceed with the '503 reexamination was finally decided.

7. On October 6, 2005, both August 8, 2005 patent owner petitions were dismissed by the Office in a single combined decision on petition.

8. On November 25, 2005, patent owner filed a request for reconsideration directed solely to the issue of vacating the '503 order for reexamination.

8. On February 8, 2006, the Office denied the requested relief to vacate the reexamination order in the '503 reexamination proceeding.

9. On December 2, 2005, a second request for reexamination of the '516 patent was filed by a second third party requester, and was assigned control number 90/007,828 (the '828 reexamination proceeding).

9. On December 12, 2005, reexamination was ordered for the '828 reexamination proceeding.

10. On February 16, 2006, patent owner filed a petition to vacate the '828 reexamination proceeding on the grounds that the '828 reexamination order was an *ultra vires* act on the part of the Office.

11. On February 17, 2006, patent owner filed a paper, which was taken as a petition to stay the '828 proceeding.

12. On March 27, 2006, the Office, in a single combined decision, dismissed the patent owner petitions to vacate the '828 reexamination proceeding and to stay the '828 reexamination proceeding.

13. On April 4, 2006, patent owner filed a petition to merge the '503 and '828 reexamination proceedings. The Office mailed a decision merging the '503 and '828 reexamination proceedings on May 5, 2006.

14. On June 13, 2006, the present patent owner request for reconsideration of the March 27, 2006 decision was filed. The request for reconsideration included a 37 CFR 1.8 certificate of mailing dated June 8, 2006, as well as a 37 CFR 1.550(f) certificate of service on both third party requesters, also dated June 8, 2006. [3]

15. A patent owner's statement under 37 CFR 1.530 has not been received in the either the '503 *ex parte* examination proceeding or the '828 *ex parte* reexamination proceeding.

16. An initial Office action on the merits of patentability of the claims was mailed in the merged reexamination proceeding on August 2, 2006.

DECISION ON REQUEST FOR RECONSIDERATION

37 CFR 1.8(a) provides in pertinent part:

> "Except in the situations enumerated in paragraph (a)(2) of this section or as otherwise expressly excluded in this chapter, correspondence required to be filed in the U.S. Patent and Trademark Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.
> (1) Correspondence will be considered as being timely filed if:
> (i) The correspondence is mailed or transmitted prior to expiration of the set period of time by being:
> (A) Addressed as set out in § 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail; or
> (B) Transmitted by facsimile to the Patent and Trademark Office in accordance with §1.6(d); and
> (ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated."

37 CFR 1.181(f) provides:

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

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[3] A copy of the request for reconsideration was received for the '828 reexamination proceeding, but was not received for '503 reexamination proceeding. As these proceedings have been merged, a copy of the present request for reexamination has been placed in the Image File Wrapper (IFW). All future patent owner papers are to be filed in duplicate, with a copy directed to each reexamination file, and are to further comply with the requirements set forth in the Decision Merging Reexamination Proceedings dated May 5, 2006.

MPEP § 2246, Part I, states, in part:

> "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 no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained. "Appropriate circumstances" under 37 CFR 1.181(a)(3) exist to vacate the order granting reexamination where, for example:
>
> "(A) the reexamination order is not based wholly on prior art patents or printed publications;"

Preliminary Matter

The present patent owner request for reconsideration does not request reconsideration of the Office's holding in the March 27, 2006 Decision that the February 17, 2006 petition for a stay was dismissed.

Analysis and Finding

Inspection of the record reveals as follows. The patent owner has requested reconsideration of the Office's March 27, 2006 Decision dismissing the February 16, 2006 patent owner petition to vacate; yet, the request for reconsideration was not filed until June 13, 2006. The request for reconsideration included a 37 CFR 1.8 certificate of mailing that was dated June 8, 2006.

As provided by MPEP § 2246 Part I, a patent owner petition to vacate a decision granting reexamination is a petition under 37 CFR 1.181 for the exercise of supervisory authority. 37 CFR 1.181(f) establishes a two month period for filing a petition under Part 1 of Title 37 of the Code of Federal Regulations. It is noted that the present request for reconsideration was filed on June 13, 2006, more than two months subsequent to the March 27, 2006 decision dismissing patent owner's February 16, 2006 petition. The certificate of mailing date of June 8, 2006 provided for the request for reconsideration is also more than two months subsequent to the March 27, 2006 decision date. Accordingly, the request for reconsideration was not timely filed, and is, therefore, dismissed without consideration of its merits.

CONCLUSION

1. Patent owner's request for reconsideration is dismissed, as not being timely filed.

2. The reexamination proceeding is being returned to the jurisdiction of the Central Reexamination Unit to await the filing of a patent owner response to the August 2, 2006 initial Office action on the patentability of the '516 patent claims.

3. 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

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August 8, 2006

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Gary J. Gershik
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, New York 10036

(for Patent Owner)

MAILED

SEP 29

CENTRAL REEXAMINATION

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300 S. Wacker Drive
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(for Requester)

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Bawa Biotechnology Consulting LLP
21005 Starflower Way
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SEP 29 2006

CENTRAL REEXAMINATION UNIT

In re Baltimore et al
Reexamination Proceeding
Control No.: 90/007,503
Filed: April 4, 2005
For: U.S. Patent 6,410,516 B1

In re Baltimore et al
Reexamination Proceeding
Control No.: 90/007,828
Filed: December 2, 2005
For: U.S. Patent 6,410,516 B1

DECISION GRANTING PETITION
FOR EXTENSION OF TIME
(37 CFR 1.550(c))

This is a decision on the petition filed September 7, 2006 to request one-month extension of time pursuant to 37 CFR 1.550 for responding to the Office action dated May 11, 2006.

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

The petition is granted 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 August 2, 2006 which set a two-month date for filing a response thereto. The Office action is a 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 Office action was mailed on August 2, 2006. Since receiving the Office action, Patentees, counsel, and a technical expert have been studying the grounds of rejection of 160 claims of the patent on multiple grounds, based on 53 different references and a declaration. The number and complexity of issues presented in the Office action is substantial. An interview with the examiner has been scheduled for September 26, 2006; however, it is anticipated that consultation with the technical expert, the inventors, the licensee, and counsel after the interview will be necessary before finalizing and filing a response. The current deadline of October 2, 2006 is insufficient to provide patentees with time to consult with the technical expert about the issues discussed in the interview and to prepare the declaration. Further, coordinating with a technical expert in California, co-owners in Massachusetts, thirteen inventors, and counsel involved in litigation in both Massachusetts and Delaware regarding the 281-page Office action and 53 references will take additional time. Lastly, the sheer length and complexity of the Office action warrants granting this petition. The material incorporated by reference into the Office action totals 218 pages. An extension of time for one (1) month is requested to provide a fair opportunity for response.

Analysis and Findings

On balance it is considered that the petition explains the "sufficient cause" for an extension of time. The office action is extensive and it is clear that the patent owner has been diligent in reviewing the file and preparing a response. The request has been made in anticipation of the additional time needed to consult with experts, conduct a personal interview with the examiner and prepare a coordinated response. In the interest of providing the patent owner with a fair opportunity to present an argument against the rejections of record and the requirement of 35 USC 305 that the proceedings be conducted with special dispatch, as extension of time for one (1) month is granted.

Conclusion

1. The patent owner's petition for extension of time in which to file a response to the Office action dated August 2, 2006 is **granted**.

2. The Patent Owner's response is due November 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 3992, at (571) 272-1535.

Deborah Jones

for 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
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NOV 17 2006

CENTRAL REEXAMINATION UNIT

Gary J. Gershik
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, New York 10036 (for Patent Owner)

Grantland G. Drutchas
Mcdonnell Boehren Hulbert & Berghoff
300 S. Wacker Drive
Suite 3100
Chicago, IL 60606 (for Requester)

Bawa Biotechnology Consulting LLP
21005 Starflower Way
Ashburn, VA 20147 (for Requester)

In re Baltimore et al
Reexamination Proceeding
Control No.: 90/007,503
Filed: April 4, 2005
For: U.S. Patent 6,410,516 B1

In re Baltimore et al
Reexamination Proceeding
Control No.: 90/007,828
Filed: December 2, 2005
For: U.S. Patent 6,410,516 B1

DECISION GRANTING PETITION
FOR EXTENSION OF TIME
(37 CFR 1.550(c))

This is a decision on the petition filed October 31, 2006 to request a one-week extension of time pursuant to 37 CFR 1.550 in addition to the extension of time granted September 29, 2006 for responding to the Office action dated August 2, 2006.

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

The petition is granted for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in addition to the extension of time for one month granted September 29, 2006 in which to file a response to the Office action dated August 2, 2006 which set a two-month date for filing a response thereto. The Office action is a 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 Office action was mailed on August 2, 2006. Since receiving the Office action, Patentees, counsel, and a technical expert have been studying the grounds of rejection of 160 claims of the patent on multiple grounds, based on 53 different references and a declaration. The number and complexity of issues presented in the Office action is substantial. An interview with the examiner was held October 13, 2006 and, as was anticipated, consultation with the technical expert, the inventors, the licensee, and counsel after the interview was necessary before finalizing and filing a response. The final document is substantial and includes a declaration which is over 70 pages long not counting numerous supporting documents. An extension of time for one (1) week is requested to provide all parties with a fair opportunity to review the final document.

Analysis and Findings

On balance it is considered that the petition explains the "sufficient cause" for an extension of time. The office action was extensive and it is clear that the patent owner has been diligent in reviewing the file and preparing a response. The request has been made in anticipation of the additional time needed to provide an opportunity for all parties to review the final document. In the interest of providing the patent owner with a fair opportunity to present an argument against the rejections of record and the requirement of 35 USC 305 that the proceedings be conducted with special dispatch, as extension of time for one (1) week is granted. Patent Owner is advised that subsequent requests for extensions of time will be granted only in extraordinary situations.

Conclusion

1. The patent owner's petition for extension of time in which to file a response to the Office action dated August 2, 2006 is **granted**.

2. The Patent Owner's response is due November 9, 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.

for Lissi M. Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Baltimore et al
Reexamination Proceeding
Control No.: 90/007,828
Filed: December 2, 2005
For: U.S. Patent 6,410,516 B1

DECISION GRANTING PETITION
FOR EXTENSION OF TIME
(37 CFR 1.550(c))

This is a decision on the petition filed October 2, 2007 to request a two-week extension of time pursuant to 37 CFR 1.550(c) for responding to the Office action dated July 6, 2007.

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

The petition is granted for the reasons set forth below.

Decision

The Patent Owner requests an additional extension of time for two weeks in which to file a response to the Office action dated July 6, 2007 which set a two-month date for filing a response thereto. The Office action is a 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.
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> 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 Final Office action was mailed on July 6, 2007. Since receiving the Office action, Patentees, counsel, and a technical expert have been studying the grounds of rejection of 150 claims of the patent on multiple grounds, based on 37 different references and a declaration. The number and complexity of issues presented in the Office action is substantial. An interview with the examiner was held on August 22, 2007 and, as was anticipated, consultation with the technical expert, the inventors, the licensee, and counsel after the interview was necessary before finalizing and filing a response. The final document is substantial. An extension of time for one (1) month was requested on August 24, 2007 and granted. An additional two weeks is requested to provide all parties with a fair opportunity to review the final documents.

Analysis and Findings

On balance it is considered that the petition explains the "sufficient cause" for an extension of time. The office action was extensive and it is clear that the patent owner has been diligent in reviewing the file and preparing a response. The request has been made in anticipation of the additional time needed to provide an opportunity for all parties to review the final document. In the interest of providing the patent owner with a fair opportunity to present an argument against the rejections of record and the requirement of 35 USC 305 that the proceedings be conducted with special dispatch, as extension of time for two weeks is granted. Patent Owner is advised that subsequent requests for extensions of time will be granted only in extraordinary situations.

Conclusion

1. The patent owner's petition for extension of time in which to file a response to the Office action dated July 6, 2007 is **granted**.

2. The Patent Owner's response is due October 20, 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 Dulaney 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.

Deborah Jones

for Lissi M. Marquis,
Director,
Central Reexamination Unit

COOPER & DUNHAM LLP

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1185 AVENUE OF THE AMERICAS, NEW YORK, NEW YORK 10036

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FACSIMILE TRANSMISSION

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TO : Deborah Jones, SPRE

COMPANY/FIRM : **U.S. PATENT AND TRADEMARK OFFICE**

FACSIMILE NO.: 571-273-1535

FROM : John P. White/Gary J. Gershik

TOTAL NUMBER OF PAGES, INCLUDING COVER PAGE: 6

DATE : October 2, 2007 TIME: _____

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MESSAGE: **Please Deliver to Deborah Jones**

Merged Reexam: 90/007,503 and 90/007,828

Transmitted is a courtesy copy of: Petition For Extension Of Time Under 37 C.F.R. §1.550(c) For Responding To July 6, 2007 Final Office Action. Please review as soon as possible.

==========

THE INFORMATION CONTAINED IN THIS FACSIMILE TRANSMISSION IS INTENDED SOLELY FOR THE PERSONAL AND CONFIDENTIAL USE OF THE DESIGNATED RECIPIENT(S) NAMED ABOVE. THIS TRANSMISSION MAY BE AN ATTORNEY-CLIENT COMMUNICATION CONTAINING INFORMATION THAT IS PRIVILEGED AND CONFIDENTIAL. IF THE READER OF THIS MESSAGE IS NOT A DESIGNATED RECIPIENT OR AN AGENT RESPONSIBLE FOR DELIVERING IT TO A DESIGNATED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT YOU HAVE RECEIVED THIS DOCUMENT IN ERROR, AND THAT ANY REVIEW, DISTRIBUTION, OR COPYING OF THIS MESSAGE IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS COMMUNICATION IN ERROR, OR IF UPON READING THIS DOCUMENT YOU HAVE REASON TO BELIEVE THAT THE DOCUMENT WAS INADVERTENTLY SENT TO YOU, PLEASE NOTIFY US IMMEDIATELY BY COLLECT TELEPHONE CALL AND RETURN THE ORIGINAL MESSAGE TO US BY MAIL. THANK YOU.

--URGENT ACTION REQUESTED--
Ex Parte REEXAMINATION

Docket No. 74753/JPW/GJG

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

A Merged Proceeding of *Ex Parte* Reexamination Control Nos:

90/007,503	and	90/007,828
Filed April 4, 2005		Filed December 2, 2005

Merged Pursuant to May 4, 2006 Merger Decision
Group Art Unit: 3991 Examiner: B.M. Celsa

Patentees: David Baltimore, Ranjan Sen, Phillip A. Sharp, Harinder Singh, Louis Staudt, Jonathan H. Lebowitz, Albert S. Baldwin Jr., Roger G. Clerc, Lynn M. Corcoran, Patrick A. Baeuerle, Michael J. Lenardo, Chen-Ming Fan, and Thomas P. Maniatis

Patent No.: 6,410,516 B1 Serial No: 08/464,364

Issue Date: June 25, 2002 Filed: June 5, 1995

For : NUCLEAR FACTORS ASSOCIATED WITH TRANSCRIPTIONAL REGULATION

1185 Avenue of the Americas
New York, New York 10036
October 1, 2007

BY FACSIMILE 571-273-9900
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn. Director, Central Reexamination Unit

PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. § 1.550(c)
FOR RESPONDING TO JULY 6, 2007 FINAL OFFICE ACTION

A Final Office Action issued July 6, 2007 in connection with the above-identified merged *ex parte* reexamination. The July 6, 2007 Final Office Action set a two (2) month period for filing a response, i.e. by due September 6, 2007. On August 27, 2007 Patentees submitted a petition, and the U.S. Patent Office granted Patentees' petition, for a one (1) month extension of time such that a response to the July 6, 2007 Final Office Action

is now due October 6, 2007. Patentees hereby petition for a two (2) week extension of time so that a response to the July 6, 2007 Final Office Action will be due October 20, 2007. Patentees hereby authorize the Commissioner to charge the $200.00 fee under 37 C.F.R. § 1.17(g) for filing this Petition to Deposit Account No. 03-3125.

Reasons for Granting Petition

Extensions of time in an *ex parte* reexamination are governed by 37 C.F.R. § 1.550(c), which provides, in relevant part:

> (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).

Section 2265 of the M.P.E.P. provides that:

> 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.

Patentees respectfully submit that sufficient cause exists in the instant case for extending the deadline for responding to the July 6, 2007 Final Office Action by two weeks, i.e. until October 20, 2007.

The number and complexity of issues presented in the July 6, 2007 Final Office Action (which consists of 119 pages) is substantial. Since receiving the July 6, 2007 Final Office Action Patentees, their attorneys and their technical expert have been diligently studying the multiple grounds of rejection of claims of the

patent set forth. Multiple meetings and conferences, both by telephone and in person, have taken place to review and discuss the July 6, 2007 Final Office Action. Patentees have spent more than 60 hours consulting with their technical expert, Professor Inder Verma of the Salk Institute in San Diego, California. Patentees' have also interviewed the Examiner on August 22, 2007. However, Patentees' attorneys still need time to:

1) Finalize an expert Declaration, the finalization of which is complicated by Dr. Verma's absence from the United States between September 28, 2007 and October 13, 2007. During this period of time, Dr. Verma will be fulfilling prior obligations to give a lecture at the EFS Stem Cell Workshop in Milan, Italy and to serve as a Kennedy Visiting Professor at the Kennedy Institute of Rheumatology in London, England.

2) Allow a) the exclusive licensee located in Cambridge, Massachusetts, b) the three co-owners of the Patent, also located in Cambridge, Massachusetts, c) trial counsel involved in litigation in Massachusetts, and d) trial counsel involved in litigation in Delaware, to review and comment on a lengthy expert Declaration and a lengthy response to the July 6, 2007 Final Office Action.

In view of the preceding, there is sufficient cause to extend the period for reply by <u>two (2) weeks</u> to provide Patentees a fair opportunity to finalize an expert declaration by Dr. Verma and their response to the lengthy and complex attack on their patent set forth in the July 6, 2007 Final Office Action. Accordingly, Patentees respectfully submit that a <u>two week</u> extension of time should be granted.

Pursuant to the May 4, 2006 Merger Decision, this Petition is being filed in duplicate, each original bearing an original signature and identifying data for both reexamination files. As set forth above, the undersigned authorizes the Commissioner to charge any fee required in connection with the filing of this Petition to Deposit Account No. 03-3125.

Respectfully submitted,

Gary J. Gershik

John P. White
Registration No. 28,678
Gary J. Gershik
Registration No. 39,992
Attorneys for Patent Owners
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, New York 10036
(212) 278-0400

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing **PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. § 1.550(c) FOR RESPONDING TO THE JULY 6, 2007 FINAL OFFICE ACTION** and any enclosure has been sent to:

McDonnell Boehnen Hulbert & Berghoff, 300 South Wacker Drive, Suite 3200, Chicago, Illinois 60606, Attn: Grantland G. Drutchas, Esq.,

and

Bawa Biotechnology Consulting, LLC, 21005 Starflower Way, Ashburn, VA 20147, Attn: Dr. Raj Bawa,

each by U.S. Postal Service, first class mail service, with sufficient postage, on this 1st day of October, 2007.

Gary J. Gershik

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

OCT 26 2007

CENTRAL REEXAMINATION UNIT

John P. White
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, New York 10036

(For Patent Owner)

Grantland G. Drutchas
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300 S. Wacker Drive
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Chicago, IL 60606

(For Third Party Requester)

Bawa Biotechnology Consulting LLP
21005 Starflower Way
Ashburn, VA 20147

(For Third Party Requester)

In re Baltimore et al.
Merged Reexamination Proceedings
Control No.: 90/007,503 and 90/007,828
Filed: April 4, 2005 and December 2, 2005
For: U.S. Patent 6,410,516 B1

: **DECISION ON PETITION**
: **TO CONTINUE**
: ***EX PARTE***
: **REEXAMINATION**
: **PROCEEDINGS**

This is a decision on the October 22, 2007 patent owner Petition Under 37 CFR 1.182 and Request for Continued Reexamination.

The petition is before the Office of Patent Legal Administration.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182 has been charged to Deposit account No. 03-3125, pursuant to petitioner's instructions.

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

REVIEW OF FACTS

1) U.S. Patent No. 6,410,516 B1 (the '516 patent) issued on June 25, 2002.

2) A first request for *ex parte* reexamination of the '516 patent was filed by a first third party requester on April 4, 2005, and assigned control number 90/007,503 (the '503 proceeding).

3) An Order granting reexamination in the '503 proceeding was mailed on June 8, 2005.

4) A second request for *ex parte* reexamination of the '516 patent was filed by a second third party requester on December 2, 2005, and assigned control number 90/007,828 (the '828 proceeding.)

5) An Order granting reexamination in the '828 proceeding was mailed on December 12, 2005.

6) A decision merging the '503 and '828 proceedings was issued May 4, 2006.

7) The '516 patent is the subject of two court proceedings: (i) *Ariad Pharmaceuticals, Inc. et al. v. Eli Lilly & Co.*, Civil Action No. 02-11280-RWZ in the U.S. District Court, District of Massachusetts (the Eli Lilly litigation); and, (ii) *Amgen Inc. et al. v. Ariad Pharmaceuticals, Inc.*, Civil Action No. 06-CV-00259-KAJ in the U.S. District Court for the District of Delaware (the Amgen litigation.)

8) On June 9, 2006, patent owner filed a complaint in U.S. District Court in the Eastern District of Virginia (the Eastern District court) against the Office, requesting that defendant be enjoined and constrained from continuing with the merged reexamination '503 and '828 proceedings.

9) A non-final Office action was mailed in the merged '503 and '828 proceedings on August 2, 2006, rejecting claims on various prior art grounds.

10) On October 3, 2006, the Eastern District court granted a motion by defendant to dismiss the complaint filed by patent owner on June 9, 2006, because the court found that Plaintiffs suffered no harm or imminent harm from the Office's decisions to reexamine the '516 patent and that the plaintiff did not have standing to bring suit.

11) An examiner interview was conducted with patent owner on October 13, 2006.

12) Patent owner then responded to the non-final Office action on November 17, 2006, with an amendment cancelling claims, and presenting arguments in response to the rejections of record, as well as multiple exhibits.

13) The decision of the Eastern District court was appealed to the Court of Appeals of the Federal Circuit, which dismissed the court proceeding on November 22, 2006.

14) On July 6, 2007, a final rejection was mailed in the merged '503 and '828 proceeding. The final rejection vacated some of the prior art rejections, repeated most of the remaining prior art rejections, and changed several rejections based on newly added prior art. In particular, at least the rejections issued under the headings GLUCOCORTICOIDS and ANTIBIOTICS were newly added by the

examiner.

15) A petition to withdraw the finality of the July 6, 2007 Office action was filed on July 25, 2007. The petition is awaiting decision.

16) An Information Disclosure Statement (the fifth in the case) was filed after the final rejection listing materials from the concurrent Amgen litigation.

17) A second personal examiner interview was conducted on August 22, 2007.

18) A further Information Disclosure Statement was filed after the interview, listing additional materials from the concurrent Amgen litigation.

19) Patent owner filed a petition requesting an extension of time on August 27, 2007, which was granted October 5, 2007, thereby extending the period for response to October 20, 2007.

20) On October 22, 2007,[1] patent owner filed the present petition requesting continued re-examination, pointing out numerous grounds of rejection appearing in the final Office action for the first time. Patent owner asserts that a concurrently filed response addresses the new rejections and reduces the issues in the merged proceedings by cancelling more than 90 claims, adding new claims to clearly distinguish over all of applied prior art, and addressing the new rejections and newly applied prior art references. A second declaration is also concurrently submitted to address issues raised for the first time in the final Office action.

DECISION ON PETITION UNDER 37 CFR 1.182

In the present petition, it is requested that the Office continue the prosecution of the instant reexamination proceeding to provide consideration of the October 22, 2007 response. [2]

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."[3] Notice was provided therein that a second (or subsequent) reexamination would no longer be ordered on the basis of a "substantial new question of patentability" (SNQ) that is the same as a SNQ raised in an earlier pending reexamination. Notice was also provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution

---

[1] The petition is timely, as it was filed on a Monday, while October 20, 2007 was a Saturday. It is to be noted that in this case, the petition is being granted; thus, pendency is continued. **However,** if the petition were dismissed, the prosecution of the present proceeding would have been terminated.

[2] Item 20 in the Review of Facts.

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

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, since this is a key factor in reducing pendency of a reexamination proceeding. Stated another way, the § 1.182 petition practice includes a requirement that the filing of the § 1.182 petition be accompanied by a submission that provides a *bona fide* effort to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate.

In this instance, the patent owner was not aware of the newly entered grounds for rejection and newly cited prior art applied, for the first time in the final Office action, and therefore, was unable to address the new rejections or comprehend the new issues prior to the final Office action. Based on the facts and circumstances of the present situation, it is found that petitioner patent owner's presentation of an amendment and further evidence 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 U.S.C. 305 to conduct reexamination proceedings "with special dispatch within the Office."

In view of the above and the fact situation presented by the record, the petition is granted, and the prosecution in the above-noted reexamination proceeding is hereby continued. Prosecution is reopened for consideration of the fifth and sixth Information Disclosure Statement submissions, the October 22, 2007 Amendment and the newly submitted declaration. 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 in conjunction therewith. The Examiner will then issue an Office action treating these papers as patent owner responses received **after** a first Office action.

CONCLUSION

1) The petition under 37 CFR 1.182 is granted.

2) The prosecution of the present merged '7503 and '7828 *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 July 6, 2007, final Office action is withdrawn, and prosecution of the proceeding is reopened.

4) The October 22, 2007 response will be entered [4] by the Central Examination Unit, and will then be considered by the examiner. These papers will be treated as a response by patent owner received **after** a first Office action.

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

6) Telephone inquiries related to this decision should be directed to Caroline D. Dennison, Legal Advisor, at (571) 272-7729.

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

October 24, 2007
C:\Kiva\Kenpet6\RCR\7503_RCR-grant_last-day-filing.doc

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

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.
90/007,503	04/04/2005	6410516	74753/JPW/GJG	5583

23432 7590 12/27/2007

COOPER & DUNHAM, LLP
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

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.
90/007,828	12/02/2005	6410516		4525

23432 7590 12/27/2007

COOPER & DUNHAM, LLP
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/27/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

John P. White (For Patent Owner)
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, New York 10036

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DEC 27 2007

CENTRAL REEXAMINATION UNIT

Grantland G. Drutchas (For Third Party)
McDonnell Boehnen Hulbert & Berghoff
300 S. Wacker Drive
Suite 3200
Chicago, IL 60606

Bawa Biotechnology Consulting LLP (For Third Party)
21005 Starflower Way
Ashburn, VA 20147

In re Baltimore et al.	:	
Merged Reexamination Proceeding	:	**DECISION**
Control Nos. 90/007,503 and 90/007,828	:	**ON**
Filed: April 4, 2005 and December 2, 2005	:	**PETITION**
For: U.S. Patent 6,410,516 B1	:	

This is a decision on the petition of July 25, 2007 by Patent Owner entitled, "Petition under 37 C.F.R. §1.181 to Withdraw the Finality of the July 6, 2007 Final Office Action."

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

The petition fee of $400.00 set forth in 37 CFR §1.17(f) for the present petition under 37 CFR §1.181 has been charged to Deposit account No. 3-3125, pursuant to petitioner's instructions.

SUMMARY

For the reasons set forth below, the petition under 37 CFR §1.181 is **DISMISSED**.

REVIEW OF THE FACTS

1) U.S. Patent No. 6,410,516 B1 (the '516 patent) issued on June 25, 2002.

2) A first request for ex parte reexamination of the '516 patent was filed by a first third party requester on April 4, 2005, and assigned control number 90/007,503 (the '503 proceeding).

3) An Order granting reexamination in the '503 proceeding was mailed on June 8, 2005.

4) A second request for ex parte reexamination of the '516 patent was filed by a second third party requester on December 2, 2005, and assigned control number 90/007,828 (the '828 proceeding).

5) An Order granting reexamination in the '828 proceeding was mailed on December 12, 2005.

6) A decision merging the '503 and '828 proceedings was issued May 4, 2006.

7) The '516 patent is the subject of two court proceedings: (i) *Ariad Pharmaceuticals, Inc. v. Eli Lilly & Co.*, Civil Action No. 02-11280-RWZ in the U.S. District Court, District of Massachusetts (the Eli Lilly litigation); and , (ii) *Amgen Inc. et al. v. Ariad Pharmaceuticals, Inc.*, Civil Action No. 06-CV-00259-KAJ in the U.S. District Court for the District of Delaware (the Amgen litigation).

8) On June 9, 2006, Patent Owner filed a complaint in the U.S. District Court in the Eastern District of Virginia (the Eastern District court) against the Office, requesting that defendant be enjoined and constrained from continuing with the merged reexamination '503 and '828 proceedings.

9) A non-final Office action was mailed in the merged '503 and '828 proceedings on August 2, 2006, rejecting claims on various prior art grounds.

10) On October 3, 2006, the Eastern District Court granted a motion by defendant to dismiss the complaint filed by Patent Owner on June 9, 2006, because the court found that Plaintiffs suffered no harm or imminent harm from the Office's decisions to reexamine the '516 patent and that the plaintiff did not have standing to bring suit.

11) An examiner interview was conducted with Patent Owner on October 13, 2006.

12) Patent Owner then responded to the non-final Office action on November 17, 2006, with an amendment cancelling claims, and presenting arguments in response to the rejections of record, as well as multiple exhibits.

13) The decision of the Eastern District court was appealed to the Court of Appeals of the Federal Circuit, which dismissed the court proceeding on November 22, 2006.

14) On July 6, 2007, a final rejection was mailed in the merged '503 and '828 proceeding. The final rejection vacated some of the prior art rejections, repeated most of the remaining prior art rejections, and changed several rejections based on newly added prior art. In particular, at least the rejections issued under the headings, "GLUCOCORTICOIDS AND ANTIBIOTICS" were newly added by the examiner.

15) On July 25, 2007 the Patent Owner filed the present petition requesting withdrawal of the finality of the Office action of July 6, 2007.

16) An Information Disclosure Statement (the fifth in the case) was filed after the final rejection listing materials from the concurrent Amgen litigation.

17) A second personal examiner interview was conducted on August 22, 2007.

18) A further Information Disclosure Statement was filed after the interview, listing additional materials from the concurrent Amgen litigation.

19) Patent Owner filed a petition requesting an extension of time on August 27, 2007, which was granted October 5, 2007, thereby extending the period for response to October 20, 2007.

20) On October 22, 2007, Patent Owner filed a petition requesting continued re-examination, pointing out numerous grounds of rejection appearing in the final Office action for the first time. Patent Owner asserts that a concurrently filed response addresses the new rejections and reduces the issues in the merged proceedings by cancelling more than 90 claims, adding new claims to clearly distinguish over all of the applied prior art, and addressing the new rejections and newly applied prior art references. A second declaration is also concurrently submitted to address issues raised for the first time in the final Office action.

21) On October 26, 2007, a decision on the petition under 37 CFR §1.182 of October 22, 2007 was mailed in which the petition for continued re-examination was **granted**, re-opening prosecution and entering the Patent Owner response of October 22, 2007.

LEGAL BASIS

M.P.E.P. §2271

> 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.

M.P.E.P. 706.07(a)

> [A] second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final. If it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set in 37 CFR 1.18(p), of any claim not amended by applicant or Patent Owner in spite of the fact that other claims may have been amended to require newly cited art.

FACT SITUATION

The final Office action of 6 July 2007, as described by the Patent Owner, contained new grounds of rejection and new arguments in support of rejections including new references cited and applied by the examiner for the first time. The examiner cited seven references on a PTO-892 form, six of these references were neither previously cited by the Examiner nor submitted by the Patent Owners. In this instance, the Patent Owner was not aware of the newly entered grounds for rejection, and newly cited prior art applied, for the first time in the final Office action, and therefore, was unable to address the new rejections or comprehend the new issues prior to final Office action.

DECISION ON PETITION UNDER 37 CFR §1.181

The Patent Owner's petition under CFR §1.182 filed 25 July 2007 Requesting Continued Prosecution was granted on 26 October 2007. This decision ordered the withdrawal of the finality of the Office action of 6 July 2007 and entry of the response by the Patent Owner on 22 October 2007 and treatment as a response by the Patent Owner received after a first Office action. In view of this separate decision on petition mailed 26 October 2007, the instant petition requesting withdrawal of the finality of the Office action mailed 6 July 2007 is rendered moot, and therefore is **DISMISSED**.

CONCLUSION

1) The petition under 37 CFR §1.181 is **dismissed** as moot.

2) The directives provided in the "Conclusion" of the Decision on Petition under 37 CFR §1.181 filed 22 October 2007 is controlling.

3) Telephone inquiries related to this decision should be directed to Lissi Marquis, Director, Central Reexamination Unit (CRU), at 571-272-1596.

for Lissi Marquis
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,503	04/04/2005	6410516	74753/JPW/GJG	5583

23432 7590 04/15/2008

COOPER & DUNHAM, LLP
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/15/2008

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Grantland G. Drutchas

MCDONNELL BOEHNEN HULBERT & BERGHOFF

300 S. Wacker Drive, Suite 3100

Chicago, IL 60606

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/007,503*.

PATENT NO. *6410516*.

ART UNIT *3991*.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

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(for First Third Party Requester)

Bawa Biotechnology Consulting LLP
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Ashburn, VA 20147

(for Second Third Party Requester)

In re Baltimore et al.
Reexamination Proceeding
Control No. 90/007,503
Filed: April 4, 2005
For: U.S. Patent No. 6,410,516 B1

In re Baltimore et al.
Reexamination Proceeding
Control No. 90/007,828
Filed: December 2, 2005
For: U.S. Patent No.: 6,410,516 B1

DECISION
ON
PETITION

This is a decision addressing (1) patent owner "PETITION UNDER 37 C.F.R. § 1.183" to Waive the Service Rule, and (2) the patent owner "PETITION UNDER 37 C.F.R. §§ 1.59(b) and 1.182 TO EXPUNGE INFORMATION SUBMITTED UNDER MPEP 724.02," submitted on February 25, 2008.

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

SUMMARY

The petition to waive the service requirement of 37 CFR 1.550(f) is **granted**.

The petition to expunge information under MPEP 724.02 and 37 CFR 1.59(b) is granted to the extent that the information is **provisionally sealed**, but is otherwise held in abeyance. The proceeding is **forwarded** to the Central Reexamination Unit for consideration.

BACKGROUND

1. U.S. Patent No. 6,410,516 to Baltimore et al. (the '516 patent) issued on June 25, 2002.

2. On April 4, 2005, a first third party requester filed a request for *ex parte* reexamination, which was assigned reexamination control number 90/007,503 (the '7503 proceeding).

3. On June 8, 2005, the Office granted the '7503 reexamination request and ordered reexamination.

4. On December 2, 2005, a second third party requester filed a second request for *ex parte* reexamination, which was assigned reexamination control number 90/007,828 (the '7859 proceeding).

5. On December 12, 2005, the Office granted the '7828 reexamination request and ordered reexamination.

6. On May 4, 2006, the Office issued a decision merging the '7503 and '7828 *ex parte* proceedings into a single merged proceeding.

7. On February 25, 2008, the patent owner filed a supplemental Information Disclosure Statement (IDS) in the now merged reexamination proceeding. The IDS was filed under seal and concurrently with a petition under MPEP 724.06 and 37 CFR 1.59 for expungement upon issuance of a Notice of Intent to Issue a Reexamination Certificate (NIRC). Concurrently, the patent owner filed a petition under 37 CFR 1.183 to waive the service requirement by 37 CFR 1.550(f).

8. The '516 patent is the subject of two Federal District Court proceedings: (i) *Ariad Pharmaceuticals, Inc. v. Eli Lilly & Co.*, Civil Action No. 02-11280-RWZ in the U.S. District Court, District of Massachusetts; and (ii) *Amgen, Inc. et al. v. Ariad Pharmaceuticals, Inc.*, Civil Action No. 06-CV-00259-KAJ in the U.S. District Court, District of Delaware.

DECISION

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.

37 CFR 1.183 provides:

> In an extraordinary situation, when justice re-quires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in§ 1.17(f).

37 CFR 1.59 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.

Waiver of Service under 37 CFR 1.550(f)

Information submitted for entry into the reexamination file is, by rule, made available to the public. In this instance, confidential litigation/proprietary materials (protected materials) have been submitted under MPEP 724 *et seq*. These materials have not been served on the reexamination requesters. Petitioner requests that the service of copy requirement of 37 CFR 1.550(f) be waived pursuant to 37 CFR 1.183 for these protected materials.

Under MPEP 724 *et seq.*, confidential protected information may be submitted for consideration by the examiner during the examination on the merits. Pursuant to MPEP 724 *et seq.*, only such information found to be important to a reasonable examiner in deciding whether or not a claim is patentable, i.e., information that is material to patentability, [1] is opened to the public in the

[1] Note MPEP 724.06 (emphasis added):

reexamination file. Requiring service of a copy of confidential protected information submitted under MPEP 724 *et seq*. would defeat the intent and purpose of submitting such confidential protected information. Furthermore, service of copy would thwart the intent and the purpose of any protective order issued by the federal court, in the related patent litigation, as well as undermine protective order procedure/mechanisms in general. It is only when information is found to be important to a reasonable examiner in deciding whether or not a claim is patentable, that the public interest in apprising the public as to the basis for patentability determination requires that the information be opened to the public. Such has not been found to be the case, at this point. Accordingly, an extraordinary situation is present where justice requires that the provisions of 37 CFR 1 .550(f) be waived to the extent that service on the third party requesters of the materials previously submitted and identified as "confidential"' is not required. Thus, the petition is **granted.**

It is to be noted that if any portion of the "confidential" information is subsequently found to be important to a reasonable examiner in deciding whether or not a claim is patentable, that portion would be made a part of the public record in the proceeding under the guidelines of MPEP 724.04(c), part (C), and it would accordingly become available to the public (and to the requesters).

Petition to Expunge under 37 CFR 1.59(b)

The information submitted with the petition under MPEP 724.02 appears to be appropriately submitted. Accordingly, the materials are **provisionally sealed**. As the materials are scanned into the Image File Wrapper (IFW) file, the provisional sealing of the materials will take the form of maintaining the papers electronically closed from the public and marking them as non-public.

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 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," i.e. whether the information is material to patentability. Upon a review of the file history, it does not appear that the requisite determination has been made. Therefore, a decision on the petition to expunge at this time is premature, because any information submitted in confidence but found to

---

37 CFR 1.59 provides that information, other than the original disclosure of the application, may be expunged from the file wrapper provided a petition to expunge under 37 CFR 1.59(b) and the required fee set forth in 37 CFR 1.17(g) are filed, and further that petitioner has established to the satisfaction of the Director that the return of the information is appropriate. Expungement of information that was originally submitted to the Office under MPEP § 724.02, or that should have been submitted in a sealed envelope as discussed in MPEP § 724.02, is appropriate when the petitioner complies with items (A)-(E) set forth in MPEP § 724.05, paragraph I, and the examiner or other appropriate Office official who is responsible for considering the information has determined that the **information is not important to a reasonable examiner in deciding whether to allow the application (i.e., the information is not material to patentability)**. Expungement of information that was inadvertently submitted to the Office is appropriate provided that items (A)-(F) set forth in MPEP § 724.05, paragraph II, are satisfied. See also MPEP § 724.

be "important to a reasonable examiner in deciding whether or not a claim is patentable" must not be expunged. Accordingly, it is not appropriate at this time to make a determination on whether to expunge. Rather, the proceeding is forwarded to the examiner for examination, and a determination in due course 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." Pursuant to MPEP 724.04(c), the examiner may issue a determination on the issue of importance of the provisionally 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.

After a determination on the issue of importance of the provisionally sealed information is made of record (as discussed above), the issue of expungment will be ripe for a decision by the Central Reexamination Unit, at which point the petition to expunge may be renewed. **Patent owner is cautioned that a timely renewal of the petition to expunge prior to the point at which the file is forwarded for issuance of the reexamination certificate is necessary, to prevent the provisionally sealed material being unsealed and made of record in the reexamination file and thus becoming open to the public.**

CONCLUSION

1. The petition under 37 CFR 1.183 to waive the service requirement of 37 CFR 1.550(f) is **granted**.

2. The petition to expunge information submitted under MPEP 724.02 and 37 CFR 1.59(b) is granted to the extent that the submitted information is **provisionally sealed**, but is **otherwise held in abeyance**. The petition is subject to renewal at a later point in the proceeding, pursuant to the guidelines set forth above.

3. 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**.

4. Jurisdiction over the present merged reexamination proceeding is being returned to the Central Reexamination Unit for further processing consistent with this decision Jurisdiction will then be forwarded to the examiner of record for examination, and, in due course, a determination as to whether or not any portion or all of the information submitted as protected information is "important to a reasonable examiner in deciding whether or not a claim is patentable." Pursuant to MPEP 724.04(c), the examiner is to issue such a determination no later than the close of prosecution.

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,503	04/04/2005	6410516	74753/JPW/GJG	5583

23432 7590 03/10/2009

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NEW YORK, NY 10112

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/10/2009

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Date:

MAILED

MAR 10 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007503
PATENT NO. : 6410516
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)).

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,828	12/02/2005	6410516		4525

23432 7590 03/10/2009

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/10/2009

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Date MAILED
MAR 10 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007828
PATENT NO. : 6410516
ART UNIT : 3900

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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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In re Reexamination Proceeding of
Baltimore et al.
Control No.: 90/007,503
Filed: April 4, 2005
For: U.S. Patent No. 6,410,516 B1

In re Reexamination Proceeding of
Baltimore et al.
Control No.: 90/007,828
Filed: December 2, 2005
For: U.S. Patent No. 6,410,516 B1

DECISION DIMISSING PETITION TO CONTINUE *EX PARTE* REEXAMINATION PROCEEDINGS

This is a decision on the petition under 37 CFR 1.182 filed by the patent owner on January 30, 2009, requesting continued reexamination in the merged *ex parte* reexamination proceeding of reexamination proceedings control Nos. 90/007,503 and 90/007,828.

The petition under 37 CFR 1.182 is before the Office of Patent Legal Administration.

The authorization to charge the petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition to Deposit Account No. 03-3125 has been provided with the present petition.

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

REVIEW OF FACTS

1. On June 25, 2002, U.S. Patent No. 6,410,516 (the '516 patent) issued to David Baltimore et al.

2. On April 4, 2005, a first request for *ex parte* reexamination of the '516 patent was filed by a first third party requester, Grantland G. Drutchas of DcDonnell Boehnen Hulbert & Berghoff LLP, and was assigned control number 90/007,503 (the '7503 proceeding).

3. On June 8, 2005, the Office granted the reexamination request and ordered reexamination for the '7503 proceeding.

4. On December 2, 2005, a second request for *ex parte* reexamination of the '516 patent was filed by a second third party requester, Dr. Raj Bawa of Bawa Biotechnology Consulting LLP, and was assigned control number 90/007,828 (the '7828 proceeding).

5. On December 12, 2005, the Office granted the second reexamination request and ordered reexamination for the '7828 proceeding.

6. On May 4, 2006, the Office entered a decision merging the '7503 and '7828 proceedings into a singled merged *ex parte* reexamination proceeding.

7. On May 15, 2006, patent owner filed a notice of two concurrent court proceedings: (1) *Ariad Pharmaceuticals, Inc. et al. v. Eli Lilly & Co.*, Civil Action No. 02-11280-RWZ in the U.S. District Court, District of Massachusetts (the Eli Lilly litigation); and (2) *Amgen Inc. et al. v. Ariad Pharmaceuticals, Inc.*, Civil Action No. 06-CV-00259-KAJ in the U.S. District Court for the District of Delaware (the Amgen litigation).

8. On June 9, 2006, patent owner filed a compliant in U.S. District Court in Eastern District of Virginia (the Eastern District court), naming the Office as the defendant and requesting the Office be enjoined and constrained from continuing with the merged '7503 and '7828 reexamination proceedings.

9. On August 2, 2006, a first non-final Office action on the merits was mailed in the merged '7503 and '7828 reexamination proceeding.

10. On October 3, 2006, the Eastern District court granted a motion by the Office to dismiss the complaint filed by patent owner on June 9, 2006, because the court found that the plaintiffs suffered no harm, or imminent harm, from the Office's decisions to reexamine the '516 patent, and that the plaintiffs did not have standing to bring suit. Patent owner appealed the Eastern District court's decision to the Court of Appeals of the Federal Circuit.

11. On October 13, 2006, an examiner interview was conducted with patent owner.

12. On November 17, 2006, a response to the first non-final Office action was filed,

accompanied by an amendment canceling claims, and presenting arguments in response to the rejections of record, as well as multiple exhibits.

13. On November 22, 2006, the Court of Appeals of the Federal Circuit dismissed the patent owner's appeal of the October 3, 2006 decision of the Eastern District court.

14. On July 6, 2007, a final Office action was mailed in the merged '7503 and '7828 reexamination proceeding.

15. On July 25, 2007, patent owner filed a petition under 37 CFR 1.181 to withdraw the finality of the final Office action.

16. On August 22, 2007, a second examiner interview was conducted with patent owner.

17. Patent owner filed a petition pursuant to 37 CFR 1.550(c) on August 27, 2007, requesting a one-month extension of time, which was granted on September 29, 2007, and a petition on October 2, 2007, requesting a two-week extension of time, which was granted on October 5, 2007, thereby extending the time period for response to October 20, 2007.

18. On October 22, 2007, the patent owner filed a first request for continued reexamination accompanied by a petition under 37 CFR 1.182.

19. On October 25, 2007, the patent owner filed a response to the final Office action, accompanied by a certificate of mailing dated October 22, 2007.[1]

20. On October 26, 2007, the Office granted the first request for continued reexamination and the petition under 37 CFR 1.182, and withdrew the finality of the Office action mailed on July 6, 2007. The decision granting the first request for continued reexamination clearly stated that "[n]o further continuation of the present reexamination proceeding will be granted absent a showing of extraordinary circumstances."

21. On December 27, 2007, the Office dismissed the petition under 37 CFR 1.181 as moot in view of the decision mailed on October 26, 2007, granting the first request for continued reexamination and the petition under 37 CFR 1.182.

22. On June 10, 2008, the Office mailed a notice of defective paper in *ex parte* reexamination, notifying the patent owner that the amendment filed on October 25, 2007 does not comply with 37 CFR 1.53(d)-(j) and requiring corrections.

23. On July 11, 2008, the patent owner filed a corrected amendment in response to the notice of defective paper in *ex parte* reexamination.

24. On October 16, 2008, a final Office action was mailed. The final Office action indicated

[1] The response was considered timely filed on October 25, 2007, because the time period for response expired on October 20, 2007, which was a Saturday, and the response was accompanied by a certificate of mailing dated October 22, 2007, which was a Monday.

that: (1) the prosecution was reopened after the decision mailed on October 26, 2007, granting the request for continued reexamination; (2) the compliant amendment filed on July 11, 2008, including an amendment of the claims and an amendment of the specification, and the second Verma declaration, were entered and considered. The Office action also addressed the patent owner's arguments and explained why the declaration was found unpersuasive.

25. On December 2, 2008, a third examiner interview was conducted with patent owner.

26. On December 8, 2008, patent owner filed a petition for a one-month extension of time under 37 CFR 1.550(c), which was granted on December 22, 2008, thereby extending the time period for response to January 16, 2009.

27. On January, 13, 2009, the patent owner filed a petition for a ten-day extension of time under 37 CFR 1.550(c), which was granted on January 21, 2009, thereby extending the time period for response to January 26, 2009.

28. On January, 30, 2009, the patent owner filed a second request for continued reexamination accompanied by a petition under 37 CFR 1.182 (the present petition), and an after-final response including proposed amendments to the claims, accompanied by a certificate of mailing dated January 26, 2009.

29. On February 14, 2009, *Ex Parte* Reexamination Advisory Action Before the Filing of an Appeal Brief was mailed, notifying the patent owner that the after-final response fails to overcome all of the rejections in the final Office action mailed on October 16, 2008, and the proposed amendment will not be entered.

DECISION ON PETITION UNDER 37 CFR 1.182

In the present petition, it is requested that the Office continue the prosecution of the instant merged reexamination proceeding to provide consideration of the after-final response filed on January 30, 2009.

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."[2] 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. Accordingly, relief in the form of a continuation of the reexamination prosecution (after a final Office action

[2] *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).

or action closing prosecution) was made available by the Office via a petition under 37 CFR 1.182, in appropriate circumstances. However, this relief is restricted in nature, as the statutory mandate for special dispatch in resolving reexamination proceedings is still paramount. Specifically, 35 U.S.C. 305 mandates that *ex parte* reexamination proceedings must be conducted "with special dispatch within the Office."

In this instance, a request for continued reexamination was previously granted, already delaying the conclusion of the merged reexamination proceeding of '7503 and '7828. The October 26, 2007 decision granting the first request for continued reexamination and the accompanied petition under 37 CFR 1.182, clearly stated that "[n]o further continuation of the present reexamination proceeding will be granted absent a showing of extraordinary circumstances" [emphasis in original]. A review of the records of the instant merged *ex parte* reexamination proceeding reveals that there is no showing of extraordinary circumstances that would justify granting a second request for continued reexamination. After the decision granting the first request for continued reexamination, the finality of the final Office action mailed on July 6, 2007 was withdrawn, and the response filed on July 11, 2008 was entered and considered by the examiner. A second final Office action was mailed on October 16, 2008 and the examiner conducted a third interview with the patent owner on December 2, 2008. Patent owner also had the opportunity to appeal to the Board of Patent Appeals and Interferences for review of the examiner's final rejection by filing a notice of appeal under 37 CFR 41.31 and an appeal brief under 37 CFR 41.37. *See* 35 U.S.C. 134 and 306. Therefore, patent owner had sufficient opportunity to prosecute in the reexamination proceeding. Furthermore, arguments regarding the propriety of the examiner's action in closing prosecution and/or non-entry of various papers are matters within the jurisdiction of the Central Reexamination Unit (CRU), and are subject to petition under 37 CFR 1.181 to the CRU. Such arguments do not present an extraordinary circumstance to justify the second continued reexamination in the instant merged reexamination proceeding requested in the present petition.

Since patent owner's petition does not establish extraordinary circumstances, the petition is dismissed.

CONCLUSION

1) The petition under 37 CFR 1.182 is dismissed.

2) Jurisdiction over this reexamination proceeding is being forwarded to the Central Reexamination Unit (CRU) for further processing not inconsistent with this decision.

3) The CRU is directed to consider that it appears that the '7503 and '7828 reexaminations are terminated, because a proper response was not time filed within the time period for response set forth in the final Office action mailed on October 16, 2008, which has expired on January 26, 2009. The examiner denied entry of the proposed response filed on January 30, 2009, and patent owner did not timely file a notice of appeal.

4) Telephone inquiries related to this decision should be directed to Joni Y. Chang, Senior Legal Advisor, at (571) 272-7720.

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

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~~12/19/2005~~

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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Isbester & Associates

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007404 & 90/007,505

PATENT NO. 4,832,685

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)).

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,404 90/007,505	01/31/2005	4823685	A1064/314432	9320

23370 7590 12/20/2005

JOHN S. PRATT, ESQ
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ATLANTA, GA 30309

EXAMINER
BOMBERG, K.

ART UNIT	PAPER NUMBER
3993	

DATE MAILED: 12/20/2005 AK

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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John S. Pratt, Esq.
Kilpatrick Stockton, LLP
1100 Peachtree Street
Atlanta, GA 30309

(For Patent Owner)

DEC 20 2005

A. James Isbester
Isbester & Associates
3160 College Avenue, Suite 203
Berkeley, CA 94705

(For 3rd Party Requester)

Reexam Control No.: 90/007,404
Filed : January 31, 2005
For U.S. Patent No. : 4,832,685

Reexam Control No.: 90/007,505
Filed : April 8, 2005
For U.S. Patent No. : 4,832,685

DECISION MERGING REEXAMINATION PROCEEDINGS

The above noted reexamination proceedings are before the Director of the Central Reexamination Unit for consideration of merger as provided for in 37 CFR 1.565(c).

Reexamination in application control No. 90/007,404 was ordered in a decision mailed March 23, 2005. No patent owner's statement has been filed in the instant proceeding, nor has an Office action been issued.

Reexamination in application control No. 90/007,505 was ordered in a decision mailed June 21, 2005. No patent owner's statement has been filed in the instant proceeding, nor has an Office action been issued.

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.

Requirement for Same Claims, Drawings, and Specification in Both Proceedings

The patent owner is required to maintain identical claims, specifications, and drawings in both files. In view of the fact that both proceedings are identical, no amendment is necessary at this time.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. All papers mailed by the Office will take the form of a single action, which applies to both proceedings. All papers issued by the Office or as filed by the patent owner will contain the

identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office.

Conclusion

Reexamination Control Nos. 90/007,404 and 90/007,505 are hereby merged. Upon mailing of this decision, both files will be forwarded to the examiner for issuance of an Office action on the merits.

Any inquiry concerning this decision should be directed to Andres Kashnikow, Special Programs Examiner, at telephone No. (571) 272-4361.

Lissi Mojica Marquis, Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,405 ~~2~~ 901007,506	01/31/2005	4935005	A1064/311433	9576

23370 7590 12/20/2005

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EXAMINER
BOMBERG, K

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~~12/19/2005~~

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

A. James Isbester

Isbester & Associates

3160 College Avenue, Suite 203

Berkeley, CA 94705

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007405 & 90(007,506)

PATENT NO. 4,935,005

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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John S. Pratt, Esq.
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Atlanta, GA 30309

(For Patent Owner)

DEC 20 2005

A. James Isbester
Isbester & Associates
3160 College Avenue, Suite 203
Berkeley, CA 94705

(For 3rd Party Requester)

Reexam Control No.: 90/007,405
Filed : January 31, 2005
For U.S. Patent No. : 4,935,005

Reexam Control No.: 90/007,506
Filed : April 8, 2005
For U.S. Patent No. : 4,935,005

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination proceedings are before the Director of the Central Reexamination Unit for consideration of merger as provided for in 37 CFR 1.565(c).

Reexamination in application control No. 90/007,405 was ordered in a decision mailed March 23, 2005. No patent owner's statement has been filed in the instant proceeding, nor has an Office action been issued.

Reexamination in application control No. 90/007,506 was ordered in a decision mailed June 21, 2005. No patent owner's statement has been filed in the instant proceeding, nor has an Office action been issued.

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.

Requirement for Same Claims, Drawings, and Specification in Both Proceedings

The patent owner is required to maintain identical claims, specifications, and drawings in both files. In view of the fact that both proceedings are identical, no amendment is necessary at this time.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. All papers mailed by the Office will take the form of a single action, which applies to both proceedings. All papers issued by the Office or as filed by the patent owner will contain the

identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office.

Conclusion

Reexamination Control Nos. 90/007,405 and 90/007,506 are hereby merged. Upon mailing of this decision, both files will be forwarded to the examiner for issuance of an Office action on the merits.

Any inquiry concerning this decision should be directed to Andres Kashnikow, Special Programs Examiner, at telephone No. (571) 272-4361.

Lissi Mojica Marquis, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450

Date Mailed : August 27,2009
Serial No. :90/007508
Patent No. :6,481,189 B2
Patent Issued :November 19, 2002
Title :SADDLES

Re: Request for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent under the provisions of Rule 1.322.

Respecting the alleged errors noted in your report, the change you requested cannot be made since insertion of the word "the" would be incorrect, it appears before packing already.

In view of the foregoing, your request is hereby denied.

Magdalene Talley
For Mary F. Diggs, Supervisor
Decisions and Certificate
Of Correction Branch
(703)756-1540
FAX 571-270-9942

Knobbe, Martens, Olson & Bear LLP
2040 Main Street, 14th Fl.
Irvine, CA 92614

MD/mt

UNITED STATES PATENT AND TRADEMARK OFFICE

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Mailed: December 14, 2005

YOUNG & THOMPSON 745 SOUTH 23RD STREET 2ND FLOOR ARLINGTON VA 22202	FOR PATENT OWNER
ALANA M. FUIERER, ESQ HESLIN ROTHENBERG FARLEY & MESITI, PC 8 COLUMBUS CIRCLE ALBANY, NY 12203	FOR THIRD PARTY REQUESTER
In re Mallo et al Reexamination Proceeding Control No.: 90/007,509 Filed: April 15, 2005 For: U.S.Patent No. 6,197,287 In re Ekins Reexamination Proceeding Control No.: 90/007,636 Filed: July 20, 2005 For: U.S.Patent No. 6,197,287	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. 6,197,287 issued March 6, 2001.

2. A first request for reexamination, Control No. 90/007,509, was filed by patent owner on April 15, 2005.

3. Reexamination was ordered in the '509 reexamination proceeding on May 18, 2005.

4.A second request for reexamination, Control No. 90/007,636, was filed by third party Requester on July 20, 2005.

5. Reexamination was ordered in the '636 reexamination proceeding on September 6, 2005.

6. Patent Owner did not file a Patent Owner statement in the '636 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 '509 and '636 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. 90/007,509 and 90/007,636 are merged.

The Office action which issued in the '509 proceeding on November 15, 2005, is withdrawn as having been issued in error and the Office action which issued in the '636 proceeding on November 30, 2005, is also withdrawn as having been issued in error.

The files will be forwarded to the examiner for preparation of a new Office action applicable to both proceedings.

Bruce M. Kisliuk
Director, Technology Center 1600

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FEB 2 0 2009

CENTRAL REEXAMINATION UNIT

PAUL, HASTINGS, JANOFSKY & WALKER LLP
875 15th Street, NW
Washington DC 20005

In re Application of	:	
MUHAMMAD et al.	:	
Control No. 90/007,510 (US PAT 6,398,548)	:	DECISION ON PETITION
Filed: February 4, 2008	:	TO WITHDRAW
Attorney Docket No. 71784.04505.REX1	:	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 January 30, 2009.

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. The Office requires the practitioner(s) requesting withdrawal to certify that he, she, or they have: (1) given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any responses that may be due and the time frame within which the client must respond, pursuant 37 CFR 10.40(c).

The request was signed by Martin R. Bader on behalf of all attorneys of record who are associated with customer No. 36183. All attorneys/agents associated with the Customer Number 36183 have been withdrawn.

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

The correspondence address of record has been changed and the new correspondence address is the address indicated below.

Telephone inquiries concerning this decision should be directed to Patricia Volpe at 571-272-6825.

Volpe for

Andres Kashnikow
Supervisory Patent Examiner
CRU 3993

cc: ALIGN TECHNOLOGY, INC.
881 MARTIN AVENUE
SANTA CLARA, CA 95050

cc: CHARLES D. HOLLAND (Third Party Requester)
MORRISON & FOERSTER, LLP
755 PAGE MILL ROAD
PALO ALTO, CA 94304

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.
90/007,512	04/19/2005	4739762	ERSEK500-225	6996

7590 03/19/2008

EXAMINER

Ben D. Tobor
MCGLINCHEY STAFFORD LANG
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2727 Allen Parkway, Suite 1900
Houston, TX 77019

ART UNIT	PAPER NUMBER

DATE MAILED: 03/19/2008

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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Ben D. Tobor
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(For Patent Owner)

MAILED

MAR 19 2008

CENTRAL REEXAMINATION UNIT

J. Nevin Shaffer, Jr.
913 Gulf Breeze Parkway
Suite 43
Gulf Breeze, FL 32561

(For Requester)

In re *Palmaz*
Reexamination Proceeding
Control No. 90/0007,512
Filed: April 19, 2005
For: U.S. Patent No. 4,739,762

: DECISION ON
: PETITION UNDER
: 37 CFR 1.181

The paper filed by requester on August 18, 2005, styled as "Petition For Review Under 37 CFR § 1.181," is before the Director of the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks review of the Order Denying Request for *Ex Parte* Reexamination dated July 15, 2005. Specifically, petitioner requests that the CRU Director find that a substantial new question of patentability exists based upon the references cited.

The petition is denied for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 4,739,762 (hereinafter, the '762 patent) issued on April 26, 1988.

2. On October 6, 1997, a request for *ex parte* reexamination was made for the claims of the '762 patent based on U.S. Patent 3,657,744 to Ersek (hereinafter "the Ersek Patent"), and the resulting reexamination proceeding was assigned Control No. 90/004,785 (hereinafter, the '4785 proceeding). The reexamination proceeding applied the Ersek Patent in a rejection of the claims during the proceeding. A Notice of Intent to Issue a Reexamination Certificate was mailed on August 25, 1998 after amendments to the claims. On October 27, 1998, a reexamination certificate issued.

3. On April 19, 2005, a third party requester, the owner of the Ersek Patent, deposited a new request for *ex parte* reexamination for claims 1-12, 14-16, 18, 20-23, 26-31, 33-39, 42-46, 48-53, 55, and 57-59 of the '762 patent, and the resulting reexamination proceeding was assigned Control No. 90/07,512 (hereinafter, the '7512 proceeding).

5. A Notice of Reexamination Request Filing Date was issued on April 25, 2005.

6. An order denying the request for reexamination was issued on July 15, 2005.

6. On August 18, 2005, the third party requester timely filed the above-mentioned petition under 37 CFR § 1.181.

<u>Petitioner's Grounds in Support of the Requested Relief</u>

Petitioner (the third party requester) alleges that the examiner erred in not finding that substantial new question of patentability exists. The petitioner states that the request established a substantial new question of patentability based upon the Ersek Patent because of evidence that allegedly shows that the affidavit by Dr. Andros, filed on July 14, 1998, in the '4785 proceeding contained false statements.

In support of their showing under the above-mentioned first ground, the petitioner enclosed the following two documents:

1. The affidavit by Dr. Andros, dated July 14, 1998 (hereinafter "the Andros Affidavit").
2. Excerpts from the transcript of a video desposition of Dr. Andros on March 11, 2005, which was not submitted in the original request for reexamination on April 19, 2005.

Petitioner's arguments hinge on establishing that (1) there were false statements in the Andros Affidavit, and (2) that such allegedly false statements bring a "new light" to the Ersek Patent.

DECISION

I. Standard of Review

37 CFR 1.515(c) and 1.181 provide for the filing of a petition to review an examiner's determination refusing to order *ex parte* reexamination. The CRU Director's review of the reexamination request on petition is *de novo*. Therefore, the review will determine whether the examiner's refusal to order reexamination for the claims of the '762 patent, for which reexamination was requested, was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of the request to order reexamination. As will be discussed in further detail in section III.B. below, consideration is limited as to whether the Ersek Patent raises a substantial new question of patentability (SNQ) to patent claim. The review will not consider evidence not of record at the time of the request for reexamination (e.g., evidence made of record for the first time in the petition).

II. The Legal Standard for Ordering Reexamination

A review of 35 USC §§ 302 and 37 CFR 1.510 shows that *ex parte* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. In particular, 35 USC § 302 requires that a request for *ex parte* reexamination be based upon prior art as set forth in 35 USC § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.510(b)(1) requires that a request for *ex parte* reexamination include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final holding of invalidity after all appeals, or by the Office in a previous examination or in a reexamination of a patent. If a substantial new question of patentability is found, an order for *ex parte* reexamination of the patent is issued.

An SNQ is not raised by the old prior art if the Office has previously considered (in an earlier examination of the patent) the <u>same</u> question of patentability as to the patent and has decided that question in favor of the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

Looking to the legislative history for the original reexamination statute,[1] Congress stated:

---

[1] Public Law 96-517, enacted on December 12, 1980.

> "Section I provides for a system of administrative reexamination of patents within the patent office. This new procedure will permit any party to petition the patent office to review the efficacy of a patent, subsequent to its issuance, on the basis of **new information about preexisting technology which may have escaped review at the time of the initial examination of the patent application**. H.R. Rep. No. 96-1307, 96th Cong., 2d Sess. 3 (1980), reprinted in 1980 U.S.C.C.A.N. 6460, 6461, 6462." [Emphasis added]

Reexamination is limited to review of **new information** about preexisting **technology** that may have escaped review at the time of the initial examination of the patent application. It was not designed for harassment of a patent owner by review of old information about preexisting technology, even if a third party feels the Office's conclusion based on that old information was erroneous.

In accordance with this legislative history, MPEP 2242, part II.A. was drafted to require, in order to raise a SNQ for old art, that the old art must be "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." <u>This new light must be in terms of how to interpret the state of the "pre-existing technology," as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment</u>. For example, a reference may be read in a "new light" if the requester draws attention to a portion of the reference that was not relied upon, or otherwise addressed, in a rejection during the earlier concluded examination of the patent for which reexamination is requested. Similarly, a reference may be interpreted in a new light, or in a different way, by defining a term of art used in the reference, where the definition of the term of art had not been previously presented in the earlier concluded examination of the patent.

If a substantial new question of patentability is not found, an order denying for *ex parte* reexamination of the patent is issued. MPEP 2247 states that:

> No substantial new question of patentability is raised by the request for reexamination and prior art cited therein for the reasons set forth below.
>
> The decision denying the request will then indicate, for each patent and printed publication cited in the request, why the citation is:
>
> (A) Cumulative to the teachings of the art cited in the earlier concluded examination of the patent;
>
> (B) Not available against the claims (e.g., the reference is not available as prior art because of its date or the reference is not a publication);
>
> (C) Not important to a reasonable examiner in deciding whether any claim of the patent for which reexamination is requested is patentable, even though the citation is not cumulative and the citation is available against the claim; or

(D) One which was cited in the record of the patent and is barred by the guidelines set forth in MPEP § 2242 subsection II. A.

The examiner should also, in the decision respond to the substance of each argument raised by the requester which is based on patents or printed publications.

III. Analysis of the Request for Reexamination

In response to the petition filed on August 18, 2005, a *de novo* review of the request was made. It is determined that the request fails to raise a substantial new question of patentability regarding the Ersek Patent that is different from patentability issues raised in the reexamination proceeding '4785.

The request for reexamination, dated April 19, 2005, stated that the following substantial new question of patentability (SNQ) existed:

1. Claims 1, 23, 34, 35, 37, 44, and 51 of the '762 patent are anticipated by the Ersek Patent under 35 U.S.C. § 102.
2. Dependent Claims, except for claims 17, 19, 25, 40, 41, 47, 54, and 56, are also fully anticipated by the Ersek Patent.

As previously mentioned, the Ersek Patent was part of the basis for an order granting reexamination of the '762 patent in the '4785 proceeding. Moreover, the Ersek Patent was applied in a rejection of (at least) claims 1, 23, 34, 35, and 37 of the '762 patent. Therefore, since the Ersek Patent was previously considered in the previous examination of the '762 patent, the request must present the Ersek Patent "in a new light" in order to raise a substantial ***new*** question of patentability and allow the granting of a new request for reexamination.

The evidence and explanation, as set forth in the request dated April 19, 2005, simply does not support ordering a request for reexamination. The request does not present sufficient evidence to present the Ersek Patent in a new light. There is little doubt that the teachings of the Ersek were extensively considered in a previous examination. As stated in the Order denying reexamination, dated July 15, 2005, the request fails to present the Ersek Patent in a new light because the request did not clearly established (1) that Dr. Andros made any false statements in the Andros Affidavit filed in the '4785 proceedings, and (2) even if Dr. Andros did make such false statements as alleged, that this evidence presents the Ersek Patent in a new light. In accordance with the legislative history of legislation concerning reexamination, MPEP 2242, part II.A. was drafted to require, in order to raise a SNQ for old art, that the old art must be "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." <u>This new light must be in terms of how to interpret the state of the "pre-existing technology," as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment</u>. Simply alleging that the secondary evidence regarding the Ersek Patent submitted in the prior proceeding contained false information does not automatically present the

Ersek Patent in a new light. There must be a clear explanation for how the teachings in the Ersek Patent are viewed in a new light and how this new light creates a substantial new question of patentability to the claims of the '762 patent for which reexamination is requested. Accordingly, since the Ersek Patent was already consider in a prior proceeding and the request of April 19, 2005, does not present the Ersek Patent in a new light, a reasonable examiner would not consider these teachings important in light of the entire record of the previous examination.

Furthermore, a review of the request and consideration of the examiner's Order denying the request for reexamination shows that it was not based on the excerpts from the deposition that accompanied the petition dated August 18, 2005. Therefore, those excerpts have not been reviewed in detail. As explained above, the review of the record of the present proceeding, and of the prior proceeding, fails to establish that the examiner's statement explaining why the reexamination request of April 19, 2005, was denied is in error.

Petitioner can still avail themselves of the *ex parte* reexamination proceeding, if petitioner can formulate a request that brings forth some new technological information that was not consider in a previous examination, and filed a request in compliance with 37 CFR 1.510. However, petitioner should carefully consider the evidence required to present the Ersek Patent in a new light and the additional discussion below prior to filing a new request.

As explained in the order denying reexamination, in accordance with MPEP 2242, "substantial new question of patentability" is <u>not</u> raised by prior art presented in a reexamination request if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications.

REQUESTER'S RECOURSE

In the event that the third party requester desires to initiate an *ex parte* reexamination of the '762 patent, requester may wish to consider filing a <u>new</u> and complete request for *ex parte* reexamination (which new request includes the missing information identified above). The third party requester should file all evidence, with a new and complete request for reexamination, which supports the third party requester's position that the Ersek Patent is considered in a new light. This decision is <u>without prejudice</u> to the right of the requester to file a new request for reexamination to address the issues noted. The request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the previous examination or in any other currently pending reexamination proceeding.

The requester can file a new request for *ex parte* reexamination and provide an explanation of the manner and pertinence of applying each cited document to the patent claims for which reexamination is requested, as required by 37 CFR 1.510. Each substantial new question of patentability or proposed ground of rejection ("SNQ/proposed rejection") must be identified

separately. The patent claims applying to each identified SNQ/proposed rejection must be listed. Then, for each identified SNQ/proposed rejection, the request must explain how the cited documents identified for that SNQ/proposed rejection are applied to meet/teach the claim limitations for each listed claim, to thus establish the identified SNQ/proposed rejection. Where references are applied in combination, each combination must be individually identified, and the basis for forming the identified combination of references must be supplied.

Additional Discussion:

It is noted that a cursory review of the testimony shows that it does not support an important allegation made in the petition. In the petition, it is alleged that affiant, Dr. Andros, "had admitted that he did not review ...US patent 3,657,744 before he filed an affidavit in a prior re-examination." See page 1 of the petition. However, affiant states on page 1729 that "Well, I have read the Ersek patent, I'm sure it's safe to say, ten times. I have looked at the pictures. I have taken pieces of paper on several occasions and made slits in them as he describe he did with metal."

It is also noted that the presented testimony is incomplete, skipping a number of pages that are not presented, and interrupts Dr. Andros' answer regarding the issue of having read the Ersek patent in mid-answer. Seven pages of deposition (1731-1736) are missing. It is questionable that selective presentation of deposition material (on a given issue) can be considered to be probative

CONCLUSION

1. Given the facts involved in this proceeding, the request for *ex parte* reexamination of the claims of the '762 patent was properly denied by the examiner.

2. Accordingly, the PETITION is DENIED.

3. This decision is final and nonappealable. 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.

4. Telephone inquiries related to this decision should be directed to the to Jeanne Clark, at (571) 272-7714, or Andres Kashnikow, Special Program Examiner, at (571) 272-4361, or in their absence to the undersigned at (571) 272-1596.

Lissi Mojica Marquis, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,514	04/22/2005	6372252	050254	1932

7590 08/16/2005

EXAMINER

Rodger L. Tate
Hunton & Williams
1900 K Street NW
Suite 1200
Washington, DC 20006-1109

ART UNIT	PAPER NUMBER

DATE MAILED: 08/16/2005

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

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RODGER L. TATE
HUNTON & WILLIAMS
1900 K STREET NW
SUITE 1200
WASHINGTON DC 20006-1109

In re Blume et al	:
Reexamination Proceeding	:
Control No.: 90/007,514	: PETITION DECISION
Filed: April 22, 2005	:
Patent No.: 6,372,252	:

This is a response to the petition under 37 CFR 1.515(c), filed July 22, 2005, by the third party Requester requesting that the Order Denying Reexamination be withdrawn and an Order Granting Reexamination be mailed in the above identified Reexamination Request.

BACKGROUND

Third party Requester filed Reexamination Request, Control Number 90/007,514, on April 22, 2005. The Request was denied by Examiner Venkat on June 21, 2005, for reasons set forth in the denial. Third part Requester petitions that denial on various bases and requests that the Director order reexamination.

DISCUSSION

M.P.E.P. 2248 states, *inter alia*, as follows:

> If a petition seeking review of the examiner's determination refusing reexamination is filed, it is forwarded to the office of the TC Director for decision. Where a petition is filed, the TC Director will review the examiner's determination that a substantial new question of patentability has not been raised. The TC Director's review will be *de novo*.

Third party Requester requested reexamination of US Patent 6,372,252 on the basis of two references, Guley et al (4,309,405) alone or in combination with Hayashida et al (5,593,694). Requester gave a detailed explanation of the references and how they applied to the independent and selected dependent claims.

Patent Owner's claims are directed to a sustained release tablet containing the drug guaifenesin providing both an immediate release of the drug as well as sustained release over a 12 hour period. The examiner characterized Guley et al as teaching a sustained release tablet of somewhat similar composition, but not the drug of the patent. Hayashida et al was characterized similarly, but having a different tablet structure although the claimed drug was suggested as one of a large number of drugs which could be used in the tablet. The examiner found that one would have to pick or choose from such a large list and that no direction for such choice was suggested. The examiner also found no suggestion to combine the references such that the claimed tablet would be taught.

A thorough review of the references has been made. Guley et al teaches a multiple layer tablet. Patent Owner claims a two portion or component tablet in which the first component may abut the second component or may be provided as a coating. The first component provides immediate release of the drug while the second component provides slow sustained release. Guley et al specifically teach a core component which provides slow release of a drug covered by a seal layer and then coated with a second layer, the second layer containing the same (or different) drug which becomes immediately available to the patient. Guley et al teach the same core components encapsulating the drug which provide slow release as does Patent Owner and which are generally well known in the art. Both Patent Owner and Guley et al also include optional binders, excipients, etc., common to drug formulations. Guley et al teach as a drug of choice for the formulation propanolol hydrochloride, but suggest a number of other drugs could be substituted, primarily those having a short half-life (rapid dissolution and absorption into the system -see column 4, line 28-end). Guley et al do not specifically teach guaifenesin.

Hayashida et al teach a water swellable slow release tablet containing a core of a water swellable polymer encapsulating a drug surrounded by a thin membrane which is slightly permeable to water and allows slow expansion of the water swellable polymer and thus slow release of the drug. The coating membrane does not appear to contain any drug formulation, thus immediate and sustained release is directly dependent on water penetration of the membrane causing swelling and release of the drug. Hayashida et al specifically list over 160 drugs (and could have listed many more) as useful in the core including propanolol hydrochloride and guaifenesin (see column 6, line 24+). While this "laundry list" of drugs is not exhaustive, it does demonstrate the wide applicability and acceptability of sustained release tablet formulations to most drugs.

In summary, Guley et al teach a tablet structure similar or identical to that of Patent Owner, but do not specifically disclose the drug Patent Owner employs, but does suggest the applicability of the structure to a wide variety of drugs (listing various categories). Hayashida et al teach a different structure providing similar results and teach the drugs enumerated by Guley et al as well as many others, including guaifenesin, as useful in a sustained release formulation. The combination of references is found to raise a substantial new question of patentability not previously addressed during the prosecution of the patent.

The petition to is **GRANTED.**

This decision is final and nonappealable. 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

IN VIEW OF THIS DECISION RESPONSE TIMES ARE SET AS FOLLOWS:

For PATENT OWNER'S statement (Optional): **TWO MONTHS** from the mailing date of this decision. Extensions of time are governed by 37 CFR 1.550(c).

For Requester's reply (Optional): **TWO MONTHS** from the date of service of any timely filed Patent Owner's Statement. No extension of this time period is permitted. (If Patent Owner does not file a timely statement, no reply by requester is permitted.)

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number 571-273-8300.

Bruce M. Kisliuk
Director, Technology Center 1600

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

DONALD W. HANSON
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WASHINGTON, DC 20008

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/007,514*.

PATENT NO. *6372252*.

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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(For Patent Owner) – '7518

OLE K. NILSSEN
408 Caesar Drive
Barrington, IL 60010

(For Patent Owner) – '7823

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CENTRAL REEXAMINATION UNIT

Virgil L. Beaston
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Washington, DC 20005-3934

(For Third Party – '7518 Requester)

Mark J. Patterson
WADDEY & PATTERSON
1600 Division Street Suite 500
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(For Third Party – '7823 Requester)

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

In re: Nilssen
Reexamination Proceeding
Control No. 90/007,518
Filed: April 22, 2005
For U.S. Patent No. 5,416,386

In re: Nilssen
Reexamination Proceeding
Control No. 90/007,823
Filed: November 23, 2005
For U.S. Patent No. 5,416,386

The above-identified reexamination files are before the Director of the Central Reexam Unit 3992, for consideration of merger of reexamination control number 90/007,518 and the reexamination control number 90/007,823 pursuant to 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 5,416,386 issued on May 16 1995.

2. The 90/007,518 reexamination proceeding was filed on April 22, 2005 by a third party requester.

3. The proceeding Order granting reexamination for control number 90/007,518 was mailed on July 6, 2005.

4. The 90/007,823 reexamination proceeding was filed November 23, 2005 by a third party requester.

5. The proceeding Order granting reexamination for control number 90/007,823 was mailed on January 25, 2006.

6. There are no amendments to either the control number 90/007,518 and 90/007,823 proceedings 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 90/007,518 and 90/007,823 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, there are no amendments at this time in either reexamination proceeding. Patent owner is required to maintain the same claims and specification in all merged files.

II. Conduct of Merged Proceeding.

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

CONCLUSION

Reexamination Control Nos. 90/007,518 and 90/007,823 are **merged**.

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

ML
MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT
for

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

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CENTRAL REEXAMINATION UNIT

Ole K. Nilssen 408 Caesar Drive Barrington IL 60010	:	(Patent Owner)
Virgil L. Beaston STERNE KESSLER GOLDSTEIN & FOX PLLC 1100 New York Avenue NW Washington, DC 20025-3934	:	(For Third Party Requester)
Mark J Patterson WADDEY & PATTERSON 1600 Division Street, Suite 500 Nashville TN 37203	:	(for Third Party Requester)
	:	DECISION GRANTING IN PART PETITION FOR EXTENSION OF TIME [37 CFR 1.550(c)]
In re: Nilssen *Ex Parte* Reexamination Proceeding Control No. 90/007,518 Filed: April 22, 2005 For: US Patent No. 5,416,386	:	
In re: Nilssen *Ex Parte* Reexamination Proceeding Control No. 90/007,823 Filed: November 23, 2005 For: US Patent No. 5,416,386	:	

This is a decision on the July 6, 2007, petition for "Petition for Extension of Time Pursuant to 37 CFR 1.550 (c)," requesting that the time for responding to the Office action mailed May 30, 2007, be extended by two months.

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

The petition is granted in part 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 mailed May 30, 2007, which set a two month date for filing a response thereto. The Office action is a non-final Office action. The petition for extension of time was timely filed on July 6, 2007, together with authorization to debit a deposit account for the $200.00 petition fee 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. ...

Analysis and Findings

On balance, the Patent Owner's showing of "sufficient cause" is met by reasoning regarding the extensive time required to adequately respond to the outstanding Office action. The patent owner notes the large number of rejections and other proceedings whose time for response is very close to the instant proceeding for which a response is required. A sufficient cause in the patent owner's petition is shown to justify a one-month extension of time.

The petition request is **Granted in Part**.

Conclusion

1. The patent owner's petition for extension of one-month time in which to file a response to the Office action dated May 30, 2007 is **granted in part**.

2. The Patent Owner's response is due **August 30, 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 Mark Reinhart, Supervisory Patent 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
3999

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CENTRAL REEXAMINATION UNIT

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200 N. Harrison St., Suite 103
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(Patent Owner)

Virgil L. Beaston
STERNE KESSLER GOLDSTEIN & FOX PLLC
1100 New York Avenue NW
Washington, DC 20025-3934

(For Requester)

In re Nilssen
Ex parte Reexamination Proceeding Control Nos. 90/007,480 and 90/007,930
Filed: March 25, 2005 and February 13, 2006
For: U.S. Patent No.: 5,233,270

In re Nilssen
Ex parte Reexamination Proceeding Control Nos. 90/007,518 and 90/007,823
Filed: April 22, 2005 and November 23, 2005
For: U.S. Patent No.: 5,416,386

In re Nilssen
Ex parte Reexamination Proceeding Control No.: 90/007,983
Filed: March 24, 2006
For: U.S. Patent No.: 6,172,464

In re Nilssen
Ex parte Reexamination Proceeding Control No.: 90/007,470
Filed: March 18, 2005
For: U.S. Patent No.: 4,857,806

In re Nilssen
Ex parte Reexamination Proceeding Control No.: 90/007,864
Filed: January 4, 2006
For: U.S. Patent No.: 5,343,123

**: DECISION
: ON PETITION
: UNDER
: 37 CFR 1.182
: REGARDING
: EXTENDED
: EXAMINER
: INTERVIEW**

This is a decision on the September 26, 2007 patent owner petition filed in each of the above-identified proceedings to conduct an extended personal interview with the Examiner for the duration of five hours to discuss each of the above-identified proceedings.

The petition is before the Office of Patent Legal Administration for consideration of whether the request for an extended interview should be granted.

The petition is dismissed.

REVIEW OF SALIENT FACTS

1. On September 25, 2007, the patent owner contacted Examiner Escalante and requested a personal interview for the above-identified proceedings. The examiner granted the initial request and indicated that the duration of the interview would not exceed one hour.

2. The patent owner filed a petition on Sept. 26, 2007, in each of the above identified proceedings "to confirm that Owner is entitled to interview the Examiner for a duration of one hour per patent at issue, or a total of five (5) hours for the above five (5) captioned reexamination proceedings."

3. Payment of the petition fees required for each proceeding was completed on October 4, 2007, thus affecting entry of the petitions in each respective proceeding on this date.

4. The status of each proceeding is as follows:

(a) Control nos. 90/007,480 & 90/007,930 have been merged. A final office action was mailed July 3, 2007. An amendment in response to the final office action was filed Sept. 7, 2007.

(b) Control nos. 90/007,518 & 90/007,823 have been merged. A non–final office action was mailed May 30, 2007. A petition for accepting the filing of late papers was filed Sept. 14, 2007.

(c) Control no. 90/007,983 received a non-final office action mailed on May 17, 2007. An amendment in response to the non-final office action was filed July 19, 2007.

(d) Control no. 90/007,470 received a final office action mailed June 29, 2007. An amendment in response to the final office action was filed Sept. 4, 2007, and a Notice of Appeal was filed Oct. 1, 2007.

(e) Control no. 90/007,864 received a non-final office action mailed May 29, 2007. An amendment in response to the non-final office action was filed July 2, 2007.

5. Each proceeding has received at least one office action and has had a response* filed therein by patent owner awaiting action.

6. Each proceeding has claims rejected on different grounds based on different prior art references.

DISCUSSION

Interviews in *ex parte* reexamination proceedings are governed by 37 CFR 1.560, which reads:

Interviews in *Ex Parte* reexamination proceedings.

(a) Interviews in *ex parte* reexamination proceedings pending before the Office between examiners and the owners of such patents or their attorneys or agents of record must be conducted in the Office at such times, within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Director. Interviews for the discussion of the patentability of claims in patents involved in *ex parte* reexamination proceedings will not be conducted prior to the first official action. Interviews should be arranged in advance. Requests that reexamination requesters participate in interviews with examiners will not be granted.

(b) In every instance of an interview with an examiner in an *ex parte* reexamination proceeding, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner. An interview does not remove the necessity for response to Office actions as specified in § 1.111. Patent owner 's response to an outstanding Office action after the interview does not remove the necessity for filing the written statement. The written statement must be filed as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.

---

* It is noted that merged proceeding control no. 90/007,480 does not have a amendment filed therein, but has a petition awaiting decision to accept a late response.

As explained in MPEP 2281:

> In the case where the patent owner desires to initiate an interview, the patent owner should initially contact the examiner in charge of the proceeding to indicate what issues are sought to be discussed, and to determine if an interview will be granted. If the examiner agrees to grant the interview, the patent owner must file, at least three (3) working days prior to the interview, a written statement of the issues to be discussed at the interview, and a copy of any proposed claims to be discussed, unless examiner waives this requirement. This provision will provide structure to the interview so as to facilitate the statutory mandate for special dispatch.
>
> The duration of the interview will not exceed one hour, unless the patent owner files a petition under 37 CFR 1.182 showing sufficient cause where more time is needed. In a reexamination proceeding, the invention should be well defined after the patent has issued, and it is simply a matter of defining the claims over art applied, to the extent such is deemed necessary. An hour of time in a structured planned interview should be sufficient to accomplish this, and in those rare instances where it is not, a patent owner may show cause to extend the time. During the interview, the examiner is always free to extend the duration of the interview to discuss issues that the examiner deems appropriate for (further) discussion. Such an extension of the duration of the interview is permitted at the examiner's sole discretion.
>
> Only one interview may be requested after an Office action and prior to filing the response to that action, absent a showing of good cause to conduct a second interview during this period.

DECISION

Interviews are ***permitted*** during reexamination proceedings and are granted at the discretion of the examiner if they are deemed to facilitate prosecution with special dispatch. Interviews may be requested after an Office action, prior to filing a response to that action, in order to define the claims over the applied prior art. As the interview must be conducted in a structured and planned manner, one hour of time should be sufficient to accomplish this.

The patent owner has requested that five different reexamination proceedings be discussed during one personal interview and that one hour be allotted to each proceeding to result in a personal interview with a duration of five hours.

Each of the proceedings is at a different stage of prosecution. Each of the proceedings has different prior art rejections applied against the claims, with a total of at least ten (10) different prior art references being at issue. Responses have already been filed in the proceedings and are awaiting action.

An extended interview in this case, which would raise numerous different issues, involve proceedings at various stage of prosecution, and be conducted over a lengthy period of time, would not be productive and would not facilitate the handling of these cases with special dispatch. The patent owner acknowledges in the petition that there are "a multitude of issues to be discussed" and that additional issues relating to priority particular to only two of the proceedings will be raised.

The goal of conducting a targeted, planned interview to define the claims over the prior art would not be accomplished by combining five different sets of claims and over ten different prior art references along with a variety of other issues in a single discussion. Moreover, none of these proceedings are at an appropriate stage of prosecution during which interviews are normally granted. Further, such a lengthy interview would not be an efficient use of Office resources and would not serve the public interest.

It is also noted that the petition states the patent owner is entitled to an interview in each proceeding and is entitled to one hour for each interview. Interviews are *permitted* at the discretion of the examiner; interviews are not entitlements. Further, the manual states that an interview *will not exceed one hour*. Interviews are not guaranteed to last one hour and may be held for less than one hour at the discretion of the examiner in the interest of expediting prosecution in an efficient manner.

The patent owner has not provided a sufficient showing of good cause as to why additional time, especially for a time period of five hours, in which to conduct an interview should be permitted in this situation. The petition states that patent owner's request is for reasons of efficiency, to conserve resources, and to lessen the amount of travel time. Economic and time considerations for the patent owner do not give rise to an adequate showing as there are other means of communication, including the telephone, available to the patent owner to interact with the examiner.

CONCLUSION

1. The petition requesting an extended personal examiner interview conducted at one time for all of the above identified proceedings is dismissed.

2. The patent owner is required to identify which one of the above proceedings will be the subject of the personal interview and indicate what issues are sought to be discussed so that the examiner can determine if an interview will be granted.

3. If the examiner agrees to grant the interview, the patent owner must file, at least three (3) working days prior to the interview, a written statement of the issues to be discussed at the interview along with a copy of any proposed claims to be discussed unless the examiner waives this requirement.

4. The duration of the interview for an individual proceeding, if granted, will not exceed one hour.

5. The patent owner is reminded that merged proceedings require papers to be filed in each proceeding within the merged proceeding. In this case, patent owner filed a single petition in each of the merged proceedings, which is not in accordance with the guidelines set forth in the merger decision. The petition must be filed in each proceeding in the merged proceedings. In this instance, the Office has waived this procedure, but this is not to be construed as a waiver as to future filings. A paper must be filed in each proceeding within the merged proceedings going forward.

6. Telephone inquiries related to this decision should be directed to Caroline Dennison, Legal Advisor, at (571) 272-7729.

Stephen Marcus
Legal Advisor
Office of Patent Legal Administration

cdd
October 4, 2007

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CENTRAL REEXAMINATION UNIT

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Algonquin, IL 60102

Virgil L. Bealson (For Third Party Requester)
STERNE, KESSLER, GOLDSTEIN & FOX LLC
1100 New York Avenue
Washington, DC 20005

Mark J. Patterson (For Third Party Requester)
Waddey & Patterson
1600 Division Street
Suite 500
Nashville, TN 37203

In re Reexamination Proceeding :
Control No. 90/007,518 :
Filed: April 22, 2005 : DECISION GRANTING PETITION
U.S. Patent No. 5,416,386 : TO ACCEPT LATE PAPERS
: PROCEEDINGS BASED ON
: UNINTENTIONAL DELAY

In Re Reexamination Proceeding :
Control No. 90/007,823 :
Filed: November 23, 2005
U.S. Patent No. 5,416,386

This is a decision on the petition for entry of late papers based upon unintentional delay under 37 CFR § 1.137(b) filed by the patent owner on September 14, 2007.

The petition and the merged 90/007,518 - 90/007,823 *ex parte* reexamination proceeding (hereinafter "the merged proceeding") are before the Office of Patent Legal Administration (OPLA) for decision.

A review of the record shows that a non-final Office action was mailed in the merged proceeding on May 30, 2007, and a two-month shortened statutory period was set for filing a response thereto. A request for a two-month extension of time, together with the fee for the extension, was filed on July 6, 2007. The request for extension of time was granted on September 1, 2007, but for one month only. Accordingly, the merged proceeding was technically terminated for failure to file a timely response to the May 30, 2007 Office action. See 37 CFR 1.550(d).

37 CFR 1.137 provides, in part:

> (b) *Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(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; 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 for entry of late papers was accompanied by, *inter alia*, the requisite response (filed on September 18, 2007, but including a 37 CFR 1.8 showing that the response was mailed on September 14, 2007, the same day that the present petition was filed by facsimile transmission), a $1,500.00 petition fee under 37 CFR 1.17(m), and a statement by patent owner 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 CFR 1.137(b) was unintentional. It is noted that a terminal disclaimer is not required. It is also noted that the petition was accompanied by a certificate of service on the each of the third party requesters.

The fee of $1,500 has been charged to counsel's credit card as requested in the present petition.

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 3992 for further examination and consideration of the response filed on September 14, 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, Ovidio Escalante, in CRU (Technology Center) Art Unit 3992, who can be reached at (571)272-7537 or Mark Reinhart, Supervisory Patent Examiner for Art Unit 3992, who can be reached at (571) 272-1611.

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-7743.

Stephen Marcus
Legal Advisor
Office of Patent Legal Administration

mn
October 15, 2007

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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Ole K. Nilssen
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MAILED

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CENTRAL REEXAMINATION UNIT

Enclosure:* Petition filed October 9, 2007

In re Nilssen
Ex parte Reexamination Proceeding
Control Nos. 90/007,518 and 90/007,823
Filed: April 22, 2005 and November 23, 2005
For: U.S. Patent No.: 5,416,386

DECISION ON PETITION UNDER 37 CFR 1.182 & 37 CFR 1.183 REGARDING THIRD PARTY PARTICIPATION IN AND TRANSCRIPTION OR VIDEOTAPING OF EXAMINER INTERVIEW

This is a decision on the October 9, 2007 petition filed by the third party requester in the above-identified proceeding to (1) permit a representative of the third party requester to observe any and all examiner interviews; and/or (2) permit any and all examiner interviews to be transcribed or videotaped and be made part of the record for the proceeding.

The fee set forth in 37 CR 1.17(f) for a petition under 37 CFR 1.182 and 1.183 is $400. The petition fee for the above proceeding is being charged to the petitioner's deposit account No. 19-0036 as authorized by the petitioner on page 3 of the petition.

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

The petition is dismissed and returned to the third party requester. As the petition is not a proper submission, it has not been made part of the record in any of the above proceedings.

* The sole copy of the petition submitted to the Office is enclosed with the Decision in Control No. 90/007,470.

REVIEW OF SALIENT FACTS

1. Control no. 90/007,518 (the '7518 proceeding) & control no. 90/007,823 (the '7823 proceeding) have been merged. A non–final office action was mailed May 30, 2007. A petition for accepting the filing of late papers was filed Sept. 14, 2007.

2. The period for active participation of the third party reexamination requester has ended in the '7518 & '7823 merged proceeding.

3. On October 9, 2007, the third party requester filed the present petition under 37 CFR 1.182 and 1.183.

DISCUSSION

Participation by third parties in an *ex parte* reexamination proceeding is governed by 37 CFR 1.550(g) and (h), which 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.
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> (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).

Interviews permitted in reexamination proceedings are conducted in accordance with MPEP 2281, which states:

> "[O]nly *ex parte* interviews between the examiner and patent owner and/or the patent owner's representative are permitted. Requests by reexamination requesters to participate in or to attend interviews will not be granted."

The recordation of an interview in *ex parte* reexamination is set forth as follows, pursuant to MPEP 2281:

> "The examiner must complete an Interview Summary form PTOL-474 for each interview held where a matter of substance has been discussed (see MPEP § 713.04)....The original should be made of record in the reexamination file, and a copy should be mailed to any third party requester."
>
> "The general procedure for conducting interviews and recording same is described at MPEP § 713.01 - § 713.04...."
>
> "In every instance of an interview with the examiner, a patent owner's statement of the interview, including a complete written statement of the reasons presented at the interview as warranting favorable action, must be filed by the patent owner.... The requirement for a patent owner's statement of the interview cannot be waived by the examiner."

Pursuant to MPEP 713.04:

> "Applicant's summary of what took place at the interview should be carefully checked to determine the accuracy of any argument or statement attributed to the examiner during the interview.... If the record is complete and accurate, the examiner should place the indication "Interview record OK" on the paper recording the substance of the interview along with the date and the examiner's initials."

DECISION

1. Third party requester participation after the period permitted for active requester participation is not permitted.

The present petition of October 9, 2007, was filed after the period for active participation of the reexamination requester had ended. The present petition is not in compliance with the requirements of 37 CFR 1.510 or 1.535, nor does the present petition qualify as a prior art statement under 37 CFR 1.501. Accordingly, it is an improper submission under the above-quoted portions of 37 CFR 1.550. See *Syntex (USA) Inc. v. U.S. Patent and Trademark Office,* 11 USPQ 2d 1866, 1868-1869 (Fed. Cir. 1989).

As the present petition is not a proper submission, it will not be made of record in the reexamination file and is being <u>returned</u> to the third party requester. This decision will be made of record in the reexamination file. See also MPEP 2267.

2. Third party participation during interviews in *ex parte* proceedings is not permitted.

Petitioner has requested that the Office permit the third party to observe any and all examiner interviews and/or permit transcription or videotaping of any and all examiner

interviews in the above identified proceedings. Only *ex parte* interviews between the examiner and patent owner are permitted. Observation by third parties is not permitted. Pursuant to MPEP 2281, requests by reexamination requesters to participate in or to **attend** interviews will not be granted. The relief requested by petitioner with respect to transcription or videotaping would permit attendance by a third party in interviews, in addition to the examiner and the patent owner. Such attendance is not permitted.

It is also noted that the requested stenographer or videographer would be functioning as a representative of the third party requester to record the content of the interview. This third party intervention requested in the petition would not be justified, in view of the intent of the legislation and rules to make reexamination an *ex parte* proceeding. *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 11 USPQ2d 1866, 1869 (Fed. Cir. 1989) (a reexamination is conducted *ex parte* after it is instituted); *In re Opprecht*, 10 USPQ2d 1718 (Fed. Cir. 1989)(third parties do not participate before the Office). Thus, the requested relief cannot be granted.

Moreover, the substance of the interview, as made of record in the proceeding file, is available to the public. The information generated by the procedures in MPEP 2281 and 713.04 provides the entirety of the substance of the interview to be made of record.[1] That record is available to the public and any forum that has an occasion to review the patent that was reexamined.

CONCLUSION

1. The petition requesting permission for a representative of the third party requester to observe and/or to transcribe or videotape any and all examiner interviews in the '7518 & '7823 merged proceeding is dismissed.

2. The petition is being returned to the requester and will not be entered in the above proceeding file.

3. Jurisdiction over the reexamination proceedings is being returned to the Central Reexamination Unit.

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[1] Pursuant to 37 CFR 1.2, "[t]he action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt."

4. Telephone inquiries related to this decision should be directed to Caroline Dennison, Legal Advisor, at (571) 272-7729.

Kenneth M. Schor
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Office of Patent Legal Administration

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