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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,524	04/27/2005	5225925	A-2782	6888

5642 7590 03/20/2008

SCIENTIFIC-ATLANTA, INC.
INTELLECTUAL PROPERTY DEPARTMENT
5030 SUGARLOAF PARKWAY
LAWRENCEVILLE, GA 30044

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/20/2008

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

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Alexandria, VA 22313-1450

Scientific-Atlanta, Inc.
Intellectual Property Department
5030 Sugarloaf Parkway
Lawrenceville, GA 30044

(For Patent Owner)

MAILED

MAR 20 2008

CENTRAL REEXAMINATION UNIT

In re: Grubb et al.
Ex Parte Reexamination Proceeding
Control Number: 90/007,524
Filed: April 27, 2005
For: U.S. Patent 5,225,925

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

This is a decision on the petition of April 19, 2007 requesting a fifteen-day extension of time pursuant to 37 CFR §1.550(c) for responding to the non-final Office action dated March 19, 2007. The Office action of March 19, 2007 set forth a one-month period for reply.

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

The petition for a one-month extension of time is **dismissed.**

DECISION

The Patent Owner requests an extension of time in which to file a response to the non-final Office action dated March 19, 2007, which set a two-month period 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 accom-

panied 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 proceeding 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 Patent Owner believes that an interview will facilitate allowance of the application and would like to arrange a personal interview with the three examiners assigned to the reexamination application. The Patent Owner submits that 15 days (until May 4, 2007) should be sufficient time to participate in an interview and provide a response. The Patent Owner plans to file a response as early as possible after participating in an interview with the examiners.

Analysis and Findings

On balance, it is considered that the petition fails to provide an explanation of "sufficient cause" for an extension of time. A request for a personal interview does not meet the requirements of "sufficient cause." Consequently, the petition for an extension of time is **dismissed**.

Conclusion

1. The Patent Owner's petition for extension of time in which to file a response to the non-final Office action dated March 19, 2007 is **dismissed**.

2. Response may be submitted as follows:

By mail to: 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 Unit
Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

for Lissi 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.
90/007,528	04/29/2005	5037453	00217USREX	3418

56122 7590 09/12/2006

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.
530 VIRGINIA ROAD
P.O. BOX 9133
CONCORD, MA 01742-9133

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

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

9/12/06

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Daniel D. Biesterveld

3M INNOVATIVE PROPERTIES COMPANY

P.O. BOX 33247

St. Paul, MN 55133

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007528

PATENT NO. 5,037,453

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
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CENTRAL REEXAMINATION UNIT

N. Scott Pierce
Hamilton, Brook, Smith & Reynolds, P.C.
530 Virginia Road
P.O.Box 9133
Concord MA 01742-9133

For Patent Owner

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

For Requester

Ex Parte Reexamination Proceeding
Control No. 90/007,528
Filed: April 29, 2005
For: US Patent No. 5,037,453

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

This is a decision on the petition filed August 18, 2006 to request a three-month extension of time pursuant to 37 CFR 1.550 for responding to the Office action dated June 28, 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 June 28, 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, prior to receiving the Office action, inside counsel assigned to the reexamination proceeding, Mary Porter, resigned. Other inside counsel has now been assigned to this proceeding and, additionally, outside counsel has recently been assigned to assist. Work on the reply is proceeding diligently; however, Ms. Porter was not working with other counsel on this matter and an extensive amount of information must now be reassembled

in her absence. Patent Owner requests an extension of time for three months to fully prepare a reply to the outstanding Office action.

Analysis and Findings

The request for reexamination was filed on April 29, 2005 with service to the patent Owner. The order for reexamination was granted on June 24, 2005. While no Patent Owner statement was received, Patent Owner was fully aware of the issues with regards to the proceeding. In view of the requirement for expeditious handling of reexamination proceedings, Patent Owner should be prepared to respond to the outstanding Office action, personnel issues notwithstanding. The resignation of counsel is not seen to constitute extraordinary circumstances under which a three-month extension would be warranted. An extension of time for one month is considered ample to allow all counsel to review the record and provide rebuttal to the issues developed in the office action of June 28, 2006. An extension of time until September 28, 2006 to facilitate the completion of the reply is granted.

Conclusion

1. The patent owner's petition for extension of time in which to file a response to the Office action dated Junes 28, 2006 is **granted**.

2. The Patent Owner's response is due September 28, 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

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
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N. Scott Pierce (Patent Owner)
Hamilton, Brook, Smith & Reynolds, P.C.
530 Virginia Road
P.O. Box 9133
Concord, MA 01742-9133

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JUL 05 2007

CENTRAL REEXAMINATION UNIT

Daniel D. Biesterveld (Third Party)
3M Innovative Properties Company
P.O. Box 33427
St. Paul, MN 55133-3427

In re Narayanan et al.
Reexamination Proceeding
Control No.: 90/007,528
Filed: April 29, 2005
For: U.S. Patent No.: 5,037,453

DECISION ON PETITION UNDER 37 CFR 1.182

This is a decision on the June 7, 2007 patent owner petition under 37 CFR 1.182 to enter, and to have the examiner consider, an information disclosure statement (IDS) filed after the termination of the prosecution in this reexamination proceeding.

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

The petition is dismissed for the reasons set forth below.

Thus, the IDS filed June 7, 2007, has not been entered for consideration by the examiner.

BACKGROUND

1. Patent number 5,037,453 issued on August 6, 1991.
2. A request for reexamination, assigned control No. 90/007,528 (the '528 proceeding), was filed on April 29, 2005 by a third party.
3. An order granting the '528 reexamination request was mailed June 21, 2005.
4. The '528 proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed on May 22, 2007.
5. The instant petition was filed on June 7, 2007, and is accompanied by a new IDS, which the patent owner requests the Office to consider.

6. The reexamination proceeding is being processed for printing 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 2656 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.
>
> [Emphasis added.]

In the present instance, the submission fails to satisfy item (B), since there is no explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. The instant petition was filed very late in the examination of the reexamination, and it fails to provide a statement as to why the submitted IDS item of information (the art citation) is relevant to the claim limitations in the present reexamination proceeding. To the contrary, patent owner merely states that the relevance of the information is "only by the fact that it was listed in an IDS submitted with [another] third party request for reexamination filed on May 18, 2007" for the same patent under reexamination as in this proceeding. The patent owner does not provide a discussion of the substance of the reference, and has not explained the relevance of the same with respect to <u>the claim limitations in the present reexamination proceeding.</u>

In summary, there is a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier; however, there is no explanation of the relevance of the information submitted with respect to the claimed invention in the present 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 May 22, 2007, and the proceeding is being prepared to enter the final stages of the publication process. The proceeding is clearly not scheduled to come up for further action on the merits. In order to provide the requested relief, the present proceeding would need to be withdrawn from the publication process, thus significantly regressing the processing of the proceeding. This would run contrary to the statutory requirement of 35 U.S.C. 305 that "[a]ll reexamination proceedings under this section...will be conducted with special dispatch within the Office." The statutory mandate of special dispatch is based upon the public interest in providing certainty and finality as to the question of patentability raised by a request for reexamination. In view of the submission of the IDS information after termination of the prosecution in this reexamination proceeding, and the failure to provide the requisite discussion (explanation) of the submitted art citations, the present reexamination proceeding will <u>not</u> 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.

<u>If, however</u>, the patent owner in fact believes that the 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 June 7, 2007.

2. The IDS papers have not been entered for consideration by the examiner. A copy of the IDS submission will, however, be placed in the electronic image file wrapper (IFW) for the proceeding.

3. The present proceeding will continue in the publication process, toward issuance of a reexamination certificate.

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

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

kmh
06/25/07

07-2-07
c:\Kiva\kenids\decisions\7528 IDS after NIRC mailed_450 status.doc

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,529	04/29/2005	5110322	00218USREX	5741

56122 7590 09/12/2006

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.
530 VIRGINIA ROAD
P.O. BOX 9133
CONCORD, MA 01742-9133

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/12/2006

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UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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9/12/06

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Daniel D. Biesterveld

3M INNOVATIVE PROPERTIES COMPANY

P.O. BOX 33427

St.Paul, MN 55133

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007529

PATENT NO. 5,110,322

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
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CENTRAL REEXAMINATION UNIT

N. Scott Pierce
Hamilton, Brook, Smith & Reynolds, P.C.
530 Virginia Road
P.O.Box 9133
Concord MA 01742-9133

For Patent Owner

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

For Requester

Ex Parte Reexamination Proceeding
Control No. 90/007,529
Filed: April 29, 2005
For: US Patent No. 5,110,322

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

This is a decision on the petition filed August 18, 2006 to request a three-month extension of time pursuant to 37 CFR 1.550 for responding to the Office action dated June 28, 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 June 28, 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, prior to receiving the Office action, inside counsel assigned to the reexamination proceeding, Mary Porter, resigned. Other inside counsel has now been assigned to this proceeding and, additionally, outside counsel has recently been assigned to assist. Work on the reply is proceeding diligently; however, Ms. Porter was not working with other counsel on this matter and an extensive amount of information must now be reassembled

in her absence. Patent Owner requests an extension of time for three months to fully prepare a reply to the outstanding Office action.

Analysis and Findings

The request for reexamination was filed on April 29, 2005 with service to the patent Owner. The order for reexamination was granted on June 21, 2005. While no Patent Owner statement was received, Patent Owner was fully aware of the issues with regards to the proceeding. In view of the requirement for expeditious handling of reexamination proceedings, Patent Owner should be prepared to respond to the outstanding Office action, personnel issues notwithstanding. The resignation of counsel is not seen to constitute extraordinary circumstances under which a three-month extension would be warranted. An extension of time for one month is considered ample to allow all counsel to review the record and provide rebuttal to the issues developed in the office action of June 28, 2006. An extension of time until September 28, 2006 to facilitate the completion of the reply is granted.

Conclusion

1. The patent owner's petition for extension of time in which to file a response to the Office action dated Junes 28, 2006 is **granted**.

2. The Patent Owner's response is due September 28, 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

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 05 2007

CENTRAL REEXAMINATION UNIT

N. Scott Pierce
Hamilton, Brook, Smith & Reynolds, P.C.
530 Virginia Road
P.O. Box 9133
Concord, MA 01742-9133

(Patent Owner)

Daniel D. Biesterveld
3M Innovative Properties Company
P.O. Box 33427
St. Paul, MN 55133-3427

(Third Party)

In re Narayanan et al.
Reexamination Proceeding
Control No.: 90/007,529
Filed: April 29, 2005
For: U.S. Patent No.: 5,110,322

DECISION ON PETITION UNDER 37 CFR 1.182

This is a decision on the June 7, 2007 patent owner petition under 37 CFR 1.182 to enter, and to have the examiner consider, an information disclosure statement (IDS) filed after the termination of the prosecution in this reexamination proceeding.

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

The petition is dismissed for the reasons set forth below.

Thus, the IDS filed June 7, 2007, has not been entered for consideration by the examiner.

BACKGROUND

1. Patent number 5,110,322 issued on May 5, 1992
2. A request for reexamination, assigned control No. 90/007,529 (the '529 proceeding), was filed on April 29, 2005 by a third party.
3. An order granting the '529 reexamination request was mailed June 21, 2005.
4. The '529 proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed on May 22, 2007.
5. The instant petition was filed on June 7, 2007, and is accompanied by a new IDS, which the patent owner requests the Office to consider.

6. The reexamination proceeding is being processed for printing 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 2656 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.
>
> [Emphasis added.]

In the present instance, the submission fails to satisfy item (B), since there is no explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. The instant petition was filed very late in the examination of the reexamination, and it fails to provide a statement as to why the submitted IDS item of information (the art citation) is relevant to the claim limitations in the present reexamination proceeding. To the contrary, patent owner merely states that the relevance of the information is "only by the fact that it was listed in an IDS submitted with [another] third party request for reexamination filed on May 18, 2007" for the same patent under reexamination as in this proceeding. The patent owner does not provide a discussion of the substance of the reference, and has not explained the relevance of the same with respect to <u>the claim limitations in the present reexamination proceeding.</u>

In summary, there is a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier; however, there is no explanation of the relevance of the information submitted with respect to the claimed invention in the present 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 May 22, 2007, and the proceeding is being prepared to enter the final stages of the publication process. The proceeding is clearly not scheduled to come up for further action on the merits. In order to provide the requested relief, the present proceeding would need to be withdrawn from the publication process, thus significantly regressing the processing of the proceeding. This would run contrary to the statutory requirement of 35 U.S.C. 305 that "[a]ll reexamination proceedings under this section...will be conducted with special dispatch within the Office." The statutory mandate of special dispatch is based upon the public interest in providing certainty and finality as to the question of patentability raised by a request for reexamination. In view of the submission of the IDS information after termination of the prosecution in this reexamination proceeding, and the failure to provide the requisite discussion (explanation) of the submitted art citations, the present reexamination proceeding will <u>not</u> 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.

<u>If, however</u>, the patent owner in fact believes that the 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 June 7, 2007.

2. The IDS papers have not been entered for consideration by the examiner. A copy of the IDS submission will, however, be placed in the electronic image file wrapper (IFW) for the proceeding.

3. The present proceeding will continue in the publication process, toward issuance of a reexamination certificate.

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

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

kmh
06/25/07

07-3-07
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MAILED

JUN 26 2006

CENTRAL REEXAMINATION UNIT

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(For Requester)

In re Robert M. Hardy et al.
Reexamination Proceeding
Control No.: 90/007,533
Filed: May 5, 2005
For: U.S. Patent No.: 5,287,270

DECISION ON PETITION UNDER 37 CFR 1.182

This is a decision on the May 16, 2006 patent owner petition under 37 CFR 1.182 to enter a Notice of Prior and Concurrent Litigation and to have the Examiner consider an information disclosure statement (IDS) filed after the termination of the prosecution in this reexamination proceeding. The petition requests that the Office consider the complete IDS (consisting of 30 patents and 114 other documents), or failing that, to grant the petition to the extent of consideration of "the prior art documents for which the pertinency is specifically discussed".

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

The petition is granted-in-part for the reasons set forth below.

REVIEW OF FACTS

1. Patent number 5,287,270 issued February 15, 1994 with 85 claims.
2. A request for reexamination, assigned control No. 90/007,533, was filed on May 5, 2005.
3. An order granting the reexamination request was mailed June 25, 2005.
4. A Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the '533 proceeding on May 8, 2006.
5. The instant petition was filed on May 16, 2006.
6. The reexamination proceeding is in the final phase of being prepared for printing of the reexamination certificate.

RELAVANT LAW OND 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.

37 CFR 1.565. Concurrent office proceedings which include an ex parte reexamination proceeding.

(a) In an *ex parte* reexamination proceeding before the Office, the patent owner must inform the Office of any prior or concurrent proceedings in which the patent is or was involved such as interferences, reissues, *ex parte* reexaminations, *inter partes* reexaminations, or litigation and the results of such proceedings. See § 1.985 for notification of prior or concurrent proceedings in an *inter partes* reexamination proceeding

MPEP 2282 states in relevant part:

Any proper submission pursuant to 37 CFR 1.565(a) will be promptly entered into the record of the reexamination file, and will be considered by the examiner as to its content, ***when the proceeding comes up for action on the merits***. Thus, for example, if the patent owner properly files in a reexamination proceeding, pursuant to 37 CFR 1.565(a), an Information Disclosure Statement (IDS) that was submitted by a third party in the discovery stage of litigation of the patent being reexamined, the IDS would be entered into the reexamination file and ***considered by the examiner, the next time the proceeding comes up for action on the merits***. **(Emphasis added)**

DECISION

1. Counsel indicates that several telephone conferences were held with PTO personnel to notify the Examiner that material was being prepared for filing and that Patent Owner was unaware that examination was going forward. Patent Owner explains that the difficulty in supplying the IDS arises from a protective order that required the destruction of all documents in its possession at the close of the prior litigations. The Notice of Prior and Concurrent Litigation lists 16 instances of litigation and explains that the submitted IDS derives from the first listed litigation (which closed in February 2002). Note, that the latest event recorded in the Notice dates to December 19, 2005, almost 5 months prior to the filing of this petition. The petition does not detail the efforts which the patent owner made in obtaining and providing the materials to the Office, and why such efforts were not successful until the present petition with the Office.

In addition, 37 CFR 1.2 clearly states:

"All business with the Patent and Trademark Office should be transacted in writing....No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt."

In this instance, there is no communication/paper of record as to indicating or addressing patent owner's intent to submit prior art for the Office's review. Absent a written communication from the Office indicating that examination would be held in abeyance, patent owner had no basis for an expectation that examination would await the filing of additional materials.

2. Aside from the above, a review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on May 8, 2006, and has now entered the publication process. The proceeding is not scheduled to come up for further action on the merits. In this instance, the present proceeding would need to be withdrawn from the publication process, thus regressing the processing of the proceeding. This would run contrary to the statutory requirement of 35 U.S.C. 305 that "[a]ll reexamination proceedings under this section...will be conducted with special dispatch within the Office."

The instant petition was filed very late in the processing of the reexamination, and fails to provide a statement as to why the art submitted makes at least one claim unpatentable. To the contrary, patent owner merely states (page 3 of the Notice under 565(a)) that the references "include material which was alleged to invalidate the '270 patent by Defendants" in response to interrogatories but that none of the "parties filed any motions for summary judgment or otherwise attacked the validity of the patents based on the cited prior art." Furthermore, patent owner has indicated that the references are only material to patentability insofar as defendants in the litigation contended that they invalidate the claims of the '270 patent. This is not a statement that patent owner has reviewed the references and found them to be relevant.

In addition, patent owner has requested consideration of 144 items, has provided a minimal characterization - generally 5 or fewer words describing the reference, followed by 5-10 words stating what the reference does not disclose - of only 3 of the 30 patents[1] and 6 of the 114 other identified items,[2] and has provided no discussion of the other 135 items.

Even with respect to the 9 references for which for which the "pertinency is specifically discussed," the discussions are, as noted above, minimal and provide no detail nor any indication as to how they would raise a substantial new question of patentability for at least one claim.

The statutory mandate of special dispatch is based upon the public interest in providing certainty and finality as to the question of patentability raised by the request for reexamination. In view of the fact that the information submitted was submitted after termination of the prosecution in this reexamination proceeding, is not asserted as raising a question of patentability of the claims, and it is not in any way discussed in detail, it is deemed that the reexamination proceeding should not be reopened at this late date. Accordingly the petition is dismissed as to the requests for (1) consideration of the entire IDS, and (2) consideration of the limited subset of documents.

If, however, the patent owner in fact believes that one or more references submitted raises a substantial question of patentability as to at least one claim of the patent different than raised in this proceeding, the patent owner can always file a new request for reexamination for consideration of the references.

3. Consistent with 35 USC 565(a) and MPEP 2282, the Notice and IDS submitted by patent owner will be placed in the file, and will remain of record. However, since prosecution has been terminated in this reexamination proceeding, the IDS will not be considered by the Examiner[3] as the proceeding will not be coming up for action on the merits.

---

[1] US Pat. Nos. 4,656,656; 4,788,718; and 5,007,084.

[2] Documents 108-110 (discussed as one) and documents 111-113.

[3] In the event that prosecution on the merits is reopened or any further post-patent proceeding is initiated as to the patent, the IDS and Notice of prior and concurrent litigation will be in front of the Examiner for consideration. If

The petition is granted to the extent that the IDS and Notice of Prior and Concurrent litigation are entered into the file.

CONCLUSION

1. The petition is dismissed as to the requests for (1) consideration of the entire IDS filed on May 16, 2006, and (2) consideration of the limited subset of documents

2. The petition is granted to the extent that the IDS and Notice of Prior and Concurrent litigation are entered into the file.

3. The present proceeding will continue in the publication process, toward issuance of a reexamination certificate.

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

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

6-16-06
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such occurs, then preliminary to substantive consideration, the Examiner would review the submission for compliance with 37 CFR 1.98.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,533	05/05/2005	5287270		1995

EXAMINER

ART UNIT	PAPER NUMBER

2779 7590 06/29/2006

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DATE MAILED: 06/29/2006

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

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6/29/06

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007533

PATENT NO. 5,287,270

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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JUN 29 2006

CENTRAL REEXAMINATION UNIT

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(For Requester)

In re Robert M. Hardy et al.
Reexamination Proceeding
Control No.: 90/007,533
Filed: May 5, 2005
For: U.S. Patent No.: 5,287,270

SUPPLEMENTAL DECISION ON PETITION UNDER 37 CFR 1.182

This is a decision as to the May 24, 2006 patent owner paper which is taken as a supplement to the May 16, 2006 patent owner petition under 37 CFR 1.182 to enter a Notice of Prior and Concurrent Litigation and to have the Examiner consider an information disclosure statement (IDS) filed after the termination of the prosecution in this reexamination proceeding.

The petition, as it applies to the May 24, 2006 patent owner paper, is granted-in-part.

REVIEW OF RELEVANT FACTS

1. A petition was filed On May 16, 2006 requesting consideration of a concurrently filed Information Disclosure Statement (IDS).

2. A supplemental IDS was filed May 24, 2006. The IDS cover letter requested that if a petition was required for entry of the supplemental IDS, then "Patent Owner hereby requests that the petition filed May 16, 2006 operate as that petition".

3. A decision on the May 16th petition was mailed on June 26, 2006. The decision granted entry into the record of, but refused consideration of, the papers submitted on May 16, 2006. Due to late matching of the present May 24, 2006 paper to the file, the decision did not address the supplemental IDS of May 24, 2006.

DECISION

The petition is granted to the extent that the IDS filed May 24, 2006, is being entered into the file, for the reasons set forth in the Office decision mailed June 26, 2006.

CONCLUSION

1. The petition is dismissed as to the request for consideration of the IDS filed on May 24, 2006.
2. The petition is granted to the extent that the IDS filed May 24, 2006 is entered into the file.
3. The present proceeding will continue in the publication process, toward issuance of a reexamination certificate.
4. Telephone inquiries related to this decision should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726.

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

6-29-06
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(For Requester)

In re Robert M. Hardy et al.
Reexamination Proceeding
Control No.: 90/007,533
Filed: May 5, 2005
For: U.S. Patent No.: 5,287,270

: **DECISION**
: **ON PETITION**
: **UNDER 37 CFR 1.182**

This is a decision on the July 10, 2006 patent owner petition under 37 CFR 1.182 to enter a concurrently filed information disclosure statement (IDS) and to have the examiner consider an information disclosure statement filed after the termination of the prosecution in this reexamination proceeding. The petition further requests reconsideration of the decisions mailed June 26 and June 29, 2006, respectively, refusing consideration of the documents submitted May 16 and May 24, 2006, respectively. Finally, the petition requests an interview under 1.181(e) in connection with the renewed petition.

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

The petition is granted-in-part for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. Patent number 5,287,270 (the '270 patent) issued February 15, 1994 with 85 claims.
2. A request for *ex parte* reexamination of the '270 patent, assigned control No. 90/007,533 (the '533 proceeding), was filed on May 5, 2005, by a third party requester.
3. An order granting the reexamination request was mailed June 25, 2005.
4. The '533 proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the proceeding on May 8, 2006.

5. A patent owner petition was filed on May 16, 2006, requesting consideration of a concurrently filed Information Disclosure Statement (IDS).
6. A supplemental IDS was filed May 24, 2006 by patent owner. The IDS cover letter requested that if a petition was required for entry of the supplemental IDS, then "Patent Owner hereby requests that the petition filed May 16, 2006 operate as that petition."
7. A decision on the May 16th petition was mailed by the Office on June 26, 2006. The decision granted entry into the record of, but refused consideration of, the papers submitted on May 16, 2006. Due to late matching of the May 24, 2006 paper to the file, the decision did not address the supplemental IDS of May 24, 2006.
8. A supplemental decision was mailed by the Office on June 29, 2006. The decision granted entry into the record of, but refused consideration of, the papers submitted on May 24, 2006.
9. The present petition was filed by patent owner on July 10, 2006. The petition requests consideration of a concurrently filed IDS (denominated "Second Supplemental Information Disclosure Statement") and requests reconsideration of the June 26 and 29 Office decisions refusing consideration of the May 16 and May 24 Information Disclosure Statements. The petition also requests an interview under 37 CFR 1.181(e) in connection with the renewed petition.

DECISION

The prior decisions granting entry of the documents, while dismissing the request to have them considered by the examiner, were predicated on the reexamination proceeding being in the final phase of being prepared for publication of a reexamination certificate.

Since the mailing of the decision on June 29, 2006, the present '533 proceeding has been withdrawn from the publication process, and referred to the Central Reexamination Unit, as a result of the MPEP 2289 screening process performed in the Office of Patent Legal Administration. In this situation where the proceeding was indeed withdrawn from the publication process, consideration of the submitted documents no longer conflicts with the statutory requirement for conducting reexamination proceedings with special dispatch. Accordingly, the petition is granted and the Information Disclosure Statements submitted May 24, May 26, and July 10, 2006 will be considered by the Examiner.

The request for an interview is dismissed as moot, because no issue remains for which the patent owner has not been accorded relief.

CONCLUSION

1. The petition is granted as to the request for consideration by the Office of the IDS submissions filed on May 16, May 24, and July 10, 2006.

2. The request for an interview is dismissed as moot.

3. 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

7-18-06
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,533	05/05/2005	5287270	-	1995

2779 7590 07/11/2007

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/11/2007

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7/12/07

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007533

PATENT NO. 5,287,270

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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(For Patent Owner)

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JUL 11 2007

CENTRAL REEXAMINATION UNIT

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(For Requester)

In re Robert M. Hardy et al.
Reexamination Proceeding
Control No.: 90/007,533
Filed: May 5, 2005
For: U.S. Patent No.: 5,287,270

: **DECISION**
: **ON PETITION**
: **UNDER 37 CFR 1.182**

This is a decision on the June 25, 2007 patent owner petition under 37 CFR 1.182, for consideration of a concurrently filed "Seventh Supplemental IDS Statement."

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

The petition is granted to the extent that the "Seventh Supplemental IDS Statement" is compliant with 37 CFR 1.98(a).

REVIEW OF RELEVANT FACTS

1. U.S. Patent 5,287,270 (the '270 patent) issued February 15, 1994 with 85 claims.
2. A request for *ex parte* reexamination of the '270 patent, assigned control No. 90/007,533 (the '533 proceeding), was filed on May 5, 2005, by a third party requester.
3. An order granting the reexamination request was mailed June 25, 2005.
4. The '533 proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the proceeding on May 8, 2006.
5. A patent owner petition was filed on May 16, 2006, requesting consideration of a concurrently filed Information Disclosure Statement (IDS).

6. A supplemental IDS was filed May 24, 2006 by the patent owner. The IDS cover letter requested that if a petition was required for entry of the supplemental IDS, then "Patent Owner hereby requests that the petition filed May 16, 2006 operate as that petition."

7. On June 26, 2006, a decision on the May 16, 2006 petition was mailed by the Office. The decision granted entry into the record of, but refused consideration of, the papers submitted on May 16, 2006. Due to late matching of the May 24, 2006 paper to the file, the decision did not address the supplemental IDS of May 24, 2006.

8. On June 29, 2006, a supplemental decision was mailed by the Office. The supplemental decision granted entry into the record of, but refused consideration of, the papers submitted on May 24, 2006.

9. On July 10, 2006, a patent owner petition was filed, requesting consideration of a concurrently filed IDS, and further requesting reconsideration of the June 26th and 29th Office decisions refusing consideration of the May 16 and May 24 Information Disclosure Statements. The petition also requested an interview under 37 CFR 1.181(e) in connection with the renewed petition.

10. The present '533 proceeding was withdrawn from the publication process, for referral to the Central Reexamination Unit (CRU), as a result of the MPEP 2289 screening process performed in the Office of Patent Legal Administration. Accordingly, a July 20, 2006 decision on the July 10, 2006 petition was issued, granting consideration by the Office of the IDS submissions filed on May 16, May 24, and July 10, 2006. The request for an interview was dismissed as moot. Also on July 20, 2006, the present '533 proceeding was forwarded to the CRU for further handling.

11. On June 25, 2007, the present patent owner petition was filed, requesting consideration of a concurrently filed "Seventh Supplemental IDS Statement," identified as "item (11)," and patent owner's submissions "items (1) – (10)" which preceded the "Seventh Supplemental IDS Statement." Items (4) – (11) have been filed since the Office issued its previous decision on petition.

12. Also on June 25, 2007, the patent owner filed petition pursuant to 37 CFR 1.59(b) and MPEP 724, to expunge the "Seventh Supplemental IDS Statement" and the accompanying prior art documents.

DECISION

As pointed out above, the present '533 proceeding was withdrawn from the publication process, and, on July 20, 2006, forwarded to the CRU for further handling. Thus, consideration of the submitted documents does not conflict with the statutory requirement for conducting reexamination proceedings with special dispatch, despite the issuance of the NIRC.

For reexamination proceedings, 37 CFR 1.555 requires that an IDS be compliant with 37 CFR 1.98(a). Accordingly, "items (1) – (11)," as identified by the present petition, will be considered by the examiner to determine compliance with 37 CFR 1.98(a). To the extent that such compliance is found to be present, the examiner will then consider the IDS citations on the merits.

CONCLUSION

1. The petition under 37 CFR 1.182 is granted as to the request for consideration by the Office of "items (1) – (11)," as identified by the present petition, to the extent that the information disclosure statement is compliant with 37 CFR 1.98(a).

2. The proceeding is now forwarded to the Central Reexamination Unit (CRU) for decision on the June 25, 2007 patent owner petition to expunge, pursuant to 37 CFR 1.59(b) and MPEP 724, after which the proceeding will be forwarded within the CRU for handling as appropriate.

3. Telephone inquiries with respect to this decision should be directed to the undersigned at (571) 272-7710.

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

7-10-07
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,533	05/05/2005	5287270		1995

2779 7590 09/20/2007

BLANK ROME LLP
THE WATERGATE BUILDING
600 NEW HAMPSHIRE AVENUE, NW
WASHINGTON, DC 20037

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/20/2007

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

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Michael C. Greenbaum
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600 New Hampshire Avenue, N.W.
Washington , DC 20037

(For Patent Owner)

Gregory D. Caldwell
Blakely Sokoloff Taylor & Zafman
12400 Wilshire Boulevard, 7th Floor
Los Angeles, California 90025

(For Requester)

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SEP 2 0 2007

CENTRAL REEXAMINATION UNIT

In re Robert M. Hardy et al.
Reexamination Proceeding
Control No.: 90/007,533
Filed: May 5, 2005
For: U.S. Patent No.: 5,287,270

DECISION ON PETITION UNDER 37 CFR 1.182

This is a decision on the July 27, 2007 patent owner petition under 37 CFR 1.182, for consideration of a concurrently filed "Eighth Supplemental IDS Statement."

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

The petition is granted to the extent that the "Eighth Supplemental IDS Statement" is compliant with 37 CFR 1.98(a).

BACKGROUND

1. U.S. Patent 5,287,270 (the '270 patent) issued February 15, 1994 with 85 claims.
2. A request for *ex parte* reexamination of the '270 patent, assigned control No. 90/007,533 (the '533 proceeding), was filed on May 5, 2005, by a third party requester.
3. An order granting the reexamination request was mailed June 25, 2005.
4. The '533 proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the proceeding on May 8, 2006.
5. A patent owner petition was filed on May 16, 2006, requesting consideration of a concurrently filed Information Disclosure Statement (IDS).

6. A supplemental IDS was filed May 24, 2006, by the patent owner. The IDS cover letter requested that if a petition was required for entry of the supplemental IDS, then "Patent Owner hereby requests that the petition filed May 16, 2006 operate as that petition."

7. On June 26, 2006, a decision on the May 16, 2006 petition was mailed by the Office. The decision granted entry into the record of, but refused consideration of, the papers submitted on May 16, 2006. Due to late matching of the May 24, 2006 paper to the file, the decision did not address the supplemental IDS of May 24, 2006.

8. On June 29, 2006, a supplemental decision was mailed by the Office. The supplemental decision granted entry into the record of, but refused consideration of, the papers submitted on May 24, 2006.

9. On July 10, 2006, a patent owner petition was filed, requesting consideration of a concurrently filed IDS, and further requesting reconsideration of the June 26th and 29th Office decisions refusing consideration of the May 16 and May 24, 2006 IDS submissions.

10. The present '533 proceeding was withdrawn from the publication process, for referral to the Central Reexamination Unit (CRU), as a result of the MPEP 2289 screening process performed in the Office of Patent Legal Administration. Accordingly, a July 20, 2006 decision on the July 10, 2006 petition was issued, granting consideration by the Office of the IDS submissions filed on May 16, May 24, and July 10, 2006. Also on July 20, 2006, the present '533 proceeding was forwarded to the CRU for further handling.

11. On June 25, 2007, a patent owner petition was filed, requesting consideration of a concurrently filed "Seventh Supplemental IDS Statement," identified as "item (11)," and patent owner's submissions "items (1) – (10)" which preceded the "Seventh Supplemental IDS Statement." Items (4) – (11) had been filed since the Office issued its July 20, 2006 decision on petition.

12. Also on June 25, 2007, the patent owner filed a petition pursuant to 37 CFR 1.59(b) and MPEP 724, to expunge the "Seventh Supplemental IDS Statement" and the accompanying prior art documents.

13. On July 11, 2007, a decision on the petition under 37 CFR 1.182 was mailed, granting the request for consideration by the Office of "items (1) - (11)," as identified, to the extent that the information disclosure statement is compliant with 37 CFR 1.98(a).

14. On July 27, 2007, the present patent owner petition was filed, requesting consideration of a concurrently filed "Eighth Supplemental IDS Statement," identified as "item (12)," filed on July 27, 2007.

15. Also on July 27, 2007, the patent owner filed a petition pursuant to 37 CFR 1.59(b) and MPEP 724, to expunge the "Eighth Supplemental IDS Statement" and the accompanying prior art document.

DECISION

As pointed out above, the present '533 proceeding was withdrawn from the publication process, and, on July 20, 2006, forwarded to the CRU for further handling. Thus, consideration of the submitted documents does not conflict with the statutory requirement for conducting reexamination proceedings with special dispatch, despite the issuance of the NIRC for the present proceeding.

For reexamination proceedings, 37 CFR 1.555 requires that an IDS be compliant with 37 CFR 1.98(a). Accordingly, "items (1) – (11)," as identified by the present petition, will be considered by the examiner to determine compliance with 37 CFR 1.98(a). To the extent that such compliance is found to be present, the examiner will then consider the IDS citations on the merits.

CONCLUSION

1. The petition under 37 CFR 1.182 is granted as to the request for consideration by the Office of "item (12)," as identified by the present petition, to the extent that the information disclosure statement is compliant with 37 CFR 1.98(a).

2. Jurisdiction over the proceeding is now forwarded to the Central Reexamination Unit (CRU) for decision on the June 25, 2007 and July 27, 2007 patent owner petitions to expunge, pursuant to 37 CFR 1.59(b) and MPEP 724, after which the proceeding will be forwarded within the CRU for handling as appropriate.

3. Telephone inquiries with respect to this decision should be directed to the undersigned at (571) 272-7710.

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

9-18-07
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CENTRAL REEXAMINATION UNIT

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(For Requester)

In re Robert M. Hardy et al.
Reexamination Proceeding
Control No.: 90/007,533
Filed: May 5, 2005
For: U.S. Patent No.: 5,287,270

DECISION ON PETITION UNDER 37 CFR 1.182

This is a decision on the July 9, 2008 patent owner petition under 37 CFR 1.182, for consideration of a concurrently filed "Ninth Supplemental IDS Statement."

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

The petition is granted to the extent that the "Ninth Supplemental IDS Statement" will reviewed by the examiner, and considered if compliant with 37 CFR 1.98(a).

BACKGROUND

1. U.S. Patent 5,287,270 (the '270 patent) issued February 15, 1994 with 85 claims.

2. A request for *ex parte* reexamination of the '270 patent, assigned control No. 90/007,533 (the '533 proceeding), was filed on May 5, 2005, by a third party requester.

3. An order granting the reexamination request was mailed June 25, 2005.

4. The '533 proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the proceeding on May 8, 2006.

5. A patent owner petition was filed on May 16, 2006, requesting consideration of a concurrently filed Information Disclosure Statement (IDS).

6. A supplemental IDS was filed May 24, 2006, by the patent owner. The IDS cover letter requested that if a petition was required for entry of the supplemental IDS, then "Patent Owner hereby requests that the petition filed May 16, 2006 operate as that petition."

7. On June 26, 2006, a decision on the May 16, 2006 petition was mailed by the Office. The decision granted entry into the record of, but refused consideration of, the papers submitted on May 16, 2006. Due to late matching of the May 24, 2006 paper to the file, the decision did not address the supplemental IDS of May 24, 2006.

8. On June 29, 2006, a supplemental decision was mailed by the Office. The supplemental decision granted entry into the record of, but refused consideration of, the papers submitted on May 24, 2006.

9. On July 10, 2006, a patent owner petition was filed, requesting consideration of a concurrently filed IDS, and further requesting reconsideration of the June 26th and 29th Office decisions refusing consideration of the May 16 and May 24, 2006 IDS submissions.

10. The present '533 proceeding was withdrawn from the publication process, for referral to the Central Reexamination Unit (CRU), as a result of the MPEP 2289 screening process performed in the Office of Patent Legal Administration. Accordingly, a July 20, 2006 decision on the July 10, 2006 petition was issued, granting consideration by the Office of the IDS submissions filed on May 16, May 24, and July 10, 2006. Also on July 20, 2006, the present '533 proceeding was forwarded to the CRU for further handling.

11. On June 25, 2007, a patent owner petition was filed, requesting consideration of a concurrently filed "Seventh Supplemental IDS Statement," identified as "item (11)," as well as patent owner's submissions "items (1) – (10)" which preceded the "Seventh Supplemental IDS Statement." Items (4) – (11) had been filed after the Office issued its July 20, 2006 decision on petition.

12. Also on June 25, 2007, the patent owner filed a petition pursuant to 37 CFR 1.59(b) and MPEP 724, to expunge the "Seventh Supplemental IDS Statement" and the accompanying prior art documents.

13. On July 11, 2007, a decision on the petition under 37 CFR 1.182 was mailed, granting the request for consideration by the Office of "items (1) - (11)," as identified, to the extent that these information disclosure statements comply with 37 CFR 1.98(a).

14. On July 27, 2007, a patent owner petition was filed, requesting consideration of a concurrently filed "Eighth Supplemental IDS Statement," identified as "item (12)," filed on July 27, 2007.

15. Also on July 27, 2007, the patent owner filed a petition pursuant to 37 CFR 1.59(b) and MPEP 724, to expunge the "Eighth Supplemental IDS Statement" and the accompanying prior art document.

16. On September 20, 2007, a decision on the petition under 37 CFR 1.182 was mailed, granting the request for consideration of "Eighth Supplemental IDS Statement," identified as "item (12)," to the extent that the information disclosure statement complies with 37 CFR 1.98(a).

17. On July 9, 2008, the present patent owner petition was filed, requesting consideration of a concurrently filed "Ninth Supplemental IDS Statement," identified as "item (13)," filed on July 9, 2008

18. Also on July 9, 2008, the patent owner filed a petition pursuant to 37 CFR 1.59(b) and MPEP 724, to expunge the "Ninth Supplemental IDS Statement" and the accompanying prior art document.

DECISION

As pointed out above, the present '533 proceeding was withdrawn from the publication process, and, on July 20, 2006, forwarded to the CRU for further handling. Thus, consideration of the submitted documents does not conflict with the statutory requirement for conducting reexamination proceedings with special dispatch, despite the issuance of the NIRC for the present proceeding.

For reexamination proceedings, 37 CFR 1.555 requires that an IDS be compliant with 37 CFR 1.98(a). Accordingly, "item (13)," as identified by the present petition, will be reviewed by the examiner to determine compliance with 37 CFR 1.98(a). To the extent that such compliance is found to be present, the examiner will then consider the IDS citation on the merits.

CONCLUSION

1. The petition is granted to the extent that the "Ninth Supplemental IDS Statement" ("item (13)," as identified by the present petition) will reviewed by the examiner, and considered if compliant with 37 CFR 1.98(a).

2. Jurisdiction over the proceeding is forwarded to the Central Reexamination Unit (CRU) for decision on the June 25, 2007, July 27, 2007 and July 9, 2008 patent owner petitions to expunge, pursuant to 37 CFR 1.59(b) and MPEP 724, after which the proceeding will be forwarded within the CRU for handling as appropriate.

3. Telephone inquiries with respect to this decision should be directed to the undersigned at (571) 272-7710.

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

7-24-08
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CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

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Los Angeles, California 90025

(For Requester)

In re Robert M. Hardy et al.
Reexamination Proceeding
Control No.: 90/007,533
Filed: May 5, 2005
For: U.S. Patent No.: 5,287,270

DECISION ON PETITION UNDER 37 CFR 1.182

This is a decision on the July 25, 2008 patent owner petition under 37 CFR 1.182, for consideration of a concurrently filed "Eleventh Supplemental IDS Statement."

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

The petition is granted to the extent that the "Eleventh Supplemental IDS Statement" will reviewed by the examiner, and considered if compliant with 37 CFR 1.98(a).

BACKGROUND

1. U.S. Patent 5,287,270 (the '270 patent) issued February 15, 1994 with 85 claims.
2. A request for *ex parte* reexamination of the '270 patent, assigned control No. 90/007,533 (the '533 proceeding), was filed on May 5, 2005, by a third party requester.
3. An order granting the reexamination request was mailed June 25, 2005.

4. The '533 proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the proceeding on May 8, 2006.

5. A patent owner petition was filed on May 16, 2006, requesting consideration of a concurrently filed Information Disclosure Statement (IDS).

6. A supplemental IDS was filed May 24, 2006, by the patent owner. The IDS cover letter requested that if a petition was required for entry of the supplemental IDS, then "Patent Owner hereby requests that the petition filed May 16, 2006 operate as that petition."

7. On June 26, 2006, a decision on the May 16, 2006 petition was mailed by the Office. The decision granted entry into the record of, but refused consideration of, the papers submitted on May 16, 2006. Due to late matching of the May 24, 2006 paper to the file, the decision did not address the supplemental IDS of May 24, 2006.

8. On June 29, 2006, a supplemental decision was mailed by the Office. The supplemental decision granted entry into the record of, but refused consideration of, the papers submitted on May 24, 2006.

9. On July 10, 2006, a patent owner petition was filed, requesting consideration of a concurrently filed IDS, and further requesting reconsideration of the June 26th and 29th Office decisions refusing consideration of the May 16 and May 24, 2006 IDS submissions.

10. The present '533 proceeding was withdrawn from the publication process, for referral to the Central Reexamination Unit (CRU), as a result of the MPEP 2289 screening process performed in the Office of Patent Legal Administration. Accordingly, a July 20, 2006 decision on the July 10, 2006 petition was issued, granting consideration by the Office of the IDS submissions filed on May 16, May 24, and July 10, 2006. Also on July 20, 2006, the present '533 proceeding was forwarded to the CRU for further handling.

11. On June 25, 2007, a patent owner petition was filed, requesting consideration of a concurrently filed "Seventh Supplemental IDS Statement," identified as "item (11)," as well as patent owner's submissions "items (1) – (10)" which preceded the "Seventh Supplemental IDS Statement." Items (4) – (11) had been filed after the Office issued its July 20, 2006 decision on petition.

12. Also on June 25, 2007, the patent owner filed a petition pursuant to 37 CFR 1.59(b) and MPEP 724, to expunge the "Seventh Supplemental IDS Statement" and the accompanying prior art documents.

13. On July 11, 2007, a decision on the petition under 37 CFR 1.182 was mailed, granting the request for consideration by the Office of "items (1) - (11)," as identified, to the extent that these information disclosure statements comply with 37 CFR 1.98(a).

14. On July 27, 2007, a patent owner petition was filed, requesting consideration of a concurrently filed "Eighth Supplemental IDS Statement," identified as "item (12)," filed on July 27, 2007.

15. Also on July 27, 2007, the patent owner filed a petition pursuant to 37 CFR 1.59(b) and MPEP 724, to expunge the "Eighth Supplemental IDS Statement" and the accompanying prior art document.

16. On September 20, 2007, a decision on the petition under 37 CFR 1.182 was mailed, granting the request for consideration of "Eighth Supplemental IDS Statement," identified as "item (12)," to the extent that the information disclosure statement complies with 37 CFR 1.98(a).

17. On July 9, 2008, the present patent owner petition was filed, requesting consideration of a concurrently filed "Ninth Supplemental IDS Statement," identified as "item (13)," filed on July 9, 2008

18. Also on July 9, 2008, the patent owner filed a petition pursuant to 37 CFR 1.59(b) and MPEP 724, to expunge the "Ninth Supplemental IDS Statement" and the accompanying prior art document.

19. On July 24, 2008, a decision on the petition under 37 CFR 1.182 was mailed, granting the request for consideration of "Ninth Supplemental IDS Statement," identified as "item (13)," to the extent that the information disclosure statement complies with 37 CFR 1.98(a).

20. On July 25, 2008, the present patent owner petition was filed, requesting consideration of a concurrently filed "Eleventh Supplemental IDS Statement," identified as "item (15)," filed on July 25, 2008

21. Also on July 25, 2008, the patent owner filed a petition pursuant to 37 CFR 1.59(b) and MPEP 724, to expunge the "Twelfth Supplemental IDS Statement" and the accompanying prior art document.

DECISION

As pointed out above, the present '533 proceeding was withdrawn from the publication process, and, on July 20, 2006, forwarded to the CRU for further handling. Thus, consideration of the submitted documents does not conflict with the statutory requirement for conducting reexamination proceedings with special dispatch, despite the issuance of the NIRC for the present proceeding.

For reexamination proceedings, 37 CFR 1.555 requires that an IDS be compliant with 37 CFR 1.98(a). Accordingly, "item (13)," as identified by the present petition, will be reviewed by the examiner to determine compliance with 37 CFR 1.98(a). To the extent that such compliance is found to be present, the examiner will then consider the IDS citation on the merits.

CONCLUSION

1. The petition is granted to the extent that the "Eleventh Supplemental IDS Statement" ("item (15)," as identified by the present petition) will be reviewed by the examiner, and considered if compliant with 37 CFR 1.98(a).

2. Jurisdiction over the proceeding is forwarded to the Central Reexamination Unit (CRU) for decision on the June 25, 2007, July 27, 2007, July 9, 2008, and July 25, 2008 patent owner petitions to expunge, pursuant to 37 CFR 1.59(b) and MPEP 724, after which the proceeding will be forwarded within the CRU for handling as appropriate.

3. Telephone inquiries with respect to this decision should be directed to the undersigned at (571) 272-7710.

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

8-6-08
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,533	05/05/2005	5287270	117629.00141	1995

2779 7590 09/24/2009

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600 NEW HAMPSHIRE AVENUE, NW
WASHINGTON, DC 20037

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/24/2009

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UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

Gregory D. Caldwell
Blakeley Sokoloff Taylor & Zafman
12400 Wilshire Boulevard, Seventh Floor
Los Angeles, CA 90025

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007533
PATENT NO: : 5287270
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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United States Patent and Trademark Office
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In re Application of 5287270
Appl. No.: 90/007,533
Filed: May 05, 2005
For: Billing System

DECISION ON PETITION UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b), filed July 3, 2008, to expunge information from the above identified application.

The petition is granted.

Petitioner requests that a document entitled "Qwest Communications Corporation's Tenth Supplemental Responses to Plaintiff's First Set of Interrogatories to Defendant Qwest Communications Corporation", filed July 3, 2008, 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 examiner in charge of the instant proceeding and 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, SPE
CRU 3993
(571) 272-4361

Enclosure: Document titled "Qwest Communications Corporation's Tenth Supplemental Responses to Plaintiff's First Set of Interrogatories to Defendant Qwest Communications Corporation"

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.
90/007,533	05/05/2005	5287270	117629.00141	1995

2779 7590 09/24/2009

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/24/2009

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

Gregory D. Caldwell
Blakeley Sokoloff Taylor & Zafman
12400 Wilshire Boulevard, Seventh Floor
Los Angeles, CA 90025

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007533
PATENT NO. : 5287270
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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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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In re Application of 5287270
Appl. No.: 90/007,533
Filed: May 05, 2005
For: Billing System

DECISION ON PETITION UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b), filed July 27, 2007, to expunge information from the above identified application.

The petition is granted.

Petitioner requests that a document entitled "Payback, A Lexis Billing Information Service", filed July 27, 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) 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 examiner in charge of the proceeding and 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, SPE
CRU 3993
(571) 272-4361

Enclosure: Document titled "Payback, A Lexis Billing Information Service"

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.
90/007,533	05/05/2005	5287270	117629.00141	1995

2779 7590 09/24/2009

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WASHINGTON, DC 20037

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/24/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

Gregory D. Caldwell
Blakeley Sokoloff Taylor & Zafman
12400 Wilshire Boulevard, Seventh Floor
Los Angeles, CA 90025

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007533
PATENT NO. : 5287270
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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P.O. Box 1450
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In re Application of 5287270
Appl. No.: 90/007,533
Filed: May 05, 2005
For: Billing System

DECISION ON PETITION UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b), filed June 25, 2007, to expunge information from the above identified application.

The petition is granted.

Petitioner requests that documents listed as citations 185-335 in Form PTO/SB/08b included with a submission titled "Transmittal Letter for Envelopes Containing Material Subject to a Protective Order Submitted for Consideration Under 37 CFR 1.59(b) and MPEP 724" (6 envelopes), filed June 25, 2007, be expunged from the record. Petitioner states that either (A) the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

The information in question has been determined by the examiner in charge of the application and 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, SPE
CRU 3993
(571)272-4361

Enclosure: 6 Envelopes labeled as " Material Subject to Protective Order-Not Open to Public"
13 sheets of form PTO/SB/08b

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.
90/007,533	05/05/2005	5287270	117629.00141	1995

2779 7590 09/25/2009

BLANK ROME LLP
THE WATERGATE BUILDING
600 NEW HAMPSHIRE AVENUE, NW
WASHINGTON, DC 20037

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/25/2009

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

Date:

Gregory D. Caldwell
Blakeley Sokoloff Taylor & Zafman
12400 Wilshire Boulevard, Seventh Floor
Los Angeles, CA 90025

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007533
PATENT NO. : 5287270
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

In re Application of 5287270
Appl. No.: 90/007,533
Filed: May 05, 2005
For: Billing System

DECISION ON PETITION UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b), filed July 25, 2008, to expunge information from the above identified application.

The petition is granted.

Petitioner requests that documents identified as "Citation Nos. 363-385" produced under discovery in civil action Case No.: 1:04-CV-00073-LJM-WTL in the U.S. States District Court for the Southern District of Indiana, filed July 25, 2008, be expunged from the record. Petitioner states that either (A) the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) 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 examiner in charge of this proceeding and 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, SPE
CRU 3993
(571) 272-4361

Enclosure: Documents identified as "Citations" 363-385.

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.
90/007,533	05/05/2005	5287270	117629.00141	1995

2779 7590 09/25/2009

BLANK ROME LLP
THE WATERGATE BUILDING
600 NEW HAMPSHIRE AVENUE, NW
WASHINGTON, DC 20037

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/25/2009

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

Date:

Gregory D. Caldwell
Blakeley Sokoloff Taylor & Zafman
12400 Wilshire Boulevard, Seventh Floor
Los Angeles, CA 90025

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007533
PATENT NO. : 5287270
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

In re Application of 5287270
Appl. No.: 90/007,533
Filed: May 05, 2005
For: Billing System

DECISION ON PETITION UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b), filed January 16, 2009, to expunge information from the above identified application.

The petition is granted.

Petitioner requests that documents identified as "Citation Nos. 407-408" produced under discovery in civil action Case No.: 1:04-CV-00073-LJM-WTL in the U.S. States District Court for the Southern District of Indiana, filed January 16, 2009, be expunged from the record. Petitioner states that either (A) the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) 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 examiner in charge of this proceeding and 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, SPE
CRU 3993
(571) 272-4361

Enclosure: Documents identified as "Citations 407-408".

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.
90/007,533	05/05/2005	5287270	117629.00141	1995

2779 7590 09/25/2009

BLANK ROME LLP
THE WATERGATE BUILDING
600 NEW HAMPSHIRE AVENUE, NW
WASHINGTON, DC 20037

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/25/2009

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

Date:

Gregory D. Caldwell
Blakeley Sokoloff Taylor & Zafman
12400 Wilshire Boulevard, Seventh Floor
Los Angeles, CA 90025

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007533
PATENT NO. : 5287270
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

In re Application of 5287270
Appl. No.: 90/007,533
Filed: May 05, 2005
For: Billing System

DECISION ON PETITION UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b), filed December 11, 2008, to expunge information from the above identified application.

The petition is granted.

Petitioner requests that documents identified as "Citation Nos. 391-397" produced under discovery in civil action Case No.: 1:04-CV-00073-LJM-WTL in the U.S. States District Court for the Southern District of Indiana, filed December 11, 2008, be expunged from the record. Petitioner states that either (A) the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) 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 examiner in charge of this proceeding and 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, SPE
CRU 3993
(571) 272-4361

Enclosure: Documents identified as "Citations 391-397" (including 2 diskettes).

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.
90/007,533	05/05/2005	5287270	117629.00141	1995

2779 7590 09/24/2009

BLANK ROME LLP
THE WATERGATE BUILDING
600 NEW HAMPSHIRE AVENUE, NW
WASHINGTON, DC 20037

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/24/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Gregory D. Caldwell
Blakeley Sokoloff Taylor & Zafman
12400 Wilshire Boulevard, Seventh Floor
Los Angeles, CA 90025

Date:

MAILED

SEP 24 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007533
PATENT NO. : 5287270
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

In re Application of 5287270
Appl. No.: 90/007,533
Filed: May 05, 2005
For: Billing System

DECISION ON PETITION UNDER 37 CFR 1.59

MAILED

SEP 24 2009

CENTRAL REEXAMINATION UNIT

This is a decision on the petition under 37 CFR 1.59(b), filed June 25, 2007, to expunge information from the above identified application.

The petition is granted.

Petitioner requests that documents listed as citations 185-335 in Form PTO/SB/08b included with a submission titled "Transmittal Letter for Envelopes Containing Material Subject to a Protective Order Submitted for Consideration Under 37 CFR 1.59(b) and MPEP 724" (6 envelopes), filed June 25, 2007, be expunged from the record. Petitioner states that either (A) the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

The information in question has been determined by the examiner in charge of the application and 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, SPE
CRU 3993
(571)272-4361

Enclosure: 6 Envelopes labeled as " Material Subject to Protective Order-Not Open to Public"
13 sheets of form PTO/SB/08b

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

MARTIN R. BADER
P.O. BOX 919092
SAN DIEGO, CA 92191

In re Application of	:	
Phan et al.	:	
Control No. 90/007,534 (U.S. Patent 6,309,215)	:	DECISION ON PETITION
Filed: January 30, 2009	:	TO WITHDRAW
Attorney Docket No. 71784.04601.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 August 11, 2008.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a).

The request was signed by Martin R. Bader 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 assignee 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.

cc: **Align Technology, Inc.**
881 Martin Avenue
Santa Clara, CA 95050

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.
90/007,534	05/06/2005	6309215	71784.04601.REX	7071

36183 7590 02/19/2008
PAUL, HASTINGS, JANOFSKY & WALKER LLP
875 15th Street, NW
Washington, DC 20005

EXAMINER
ONEILL, MICHAEL W

ART UNIT	PAPER NUMBER
3993	

MAIL DATE	DELIVERY MODE
02/19/2008	PAPER

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

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

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

Elmore Patent Law Group, PC 209 Main Street N. Chelmsford, MA 01863	:	For Patent Owner
Kirkpatrick & Lockhart Nicholson Graham LLP Henry Oliver Bldg. 535 Smithfield Street Pittsburgh, PA 15222-2312	:	For Requester
In re: Haddleton *Ex Parte* Reexamination Proceeding Control No. 90/007,535 Filed: May 12, 2005 For: US Patent No. 6,310,149	:	DECISION DISMISSING PETITION

MAILED

MAY 25 2007

CENTRAL REEXAMINATION UNIT

This is a decision on the February 20, 2007, Patent Owner "Petition to under 37 CFR 1.181" requesting that the finality of the Office action dated October 19, 2006 be withdrawn and the after-final amendments and evidence be entered.

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

A Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC) was mailed April 18, 2007, based upon patent owner's communications of February 6 and February 12, 2007. Accordingly, the instant petition is **dismissed** as moot.

Telephone inquiries with regard to this decision should be directed to Gregory Mills, Quality Assurance Specialist in the Central Reexamination Unit, at (571) 272-1439.

Lissi Mojica Marquis,
Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Elmore Patent Law Group, PC 209 Main Street N. Chelmsford, MA 01863	:	For Patent Owner
Kirkpatrick & Lockhart Nicholson Graham LLP Henry Oliver Bldg. 535 Smithfield Street Pittsburgh, PA 15222-2312	:	For Requester
In re: Haddleton *Ex Parte* Reexamination Proceeding Control No. 90/007,535 Filed: May 12, 2005 For: US Patent No. 6,310,149	:	DECISION DISMISSING PETITION FOR EXTENSION OF TIME [37 CFR 1.550(c)]

MAILED

MAY 25 2007

CENTRAL REEXAMINATION UNIT

This is a decision on the February 20, 2007, Patent Owner "Request for Extension of Time" requesting that the time for responding to the Office action dated October 19, 2006 be extended by an additional month.

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

A Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC) was mailed April 18, 2007, based upon patent owner's communications of February 6 and February 12, 2007. Accordingly, the instant petition is **dismissed** as moot.

Telephone inquiries with regard to this decision should be directed to Gregory Mills, Quality Assurance Specialist in the Central Reexamination Unit, at (571) 272-1439.

Lissi Mojica Marquis,
Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Janice L. Dowdall (For Patent Owner)
3M Office of Intel Property Counsel
P.O. Box 33427
St. Paul, MN 55133

Gerald Levy, Esq. (For Third Party Requester)
Pitney Hardin LLP
7 Times Square
20th Floor
New York, NY 10033-7311

MAILED
OCT 04 2006
CENTRAL REEXAMINATION UNIT

In re Reexamination Proceeding :
M. Mazurek :
Control No. 90/007,538 : DECISION GRANTING PETITION
Filed: May 11, 2005 :
U.S. Patent No. 5,650,215 :
Attorney Docket No. 3094-73 :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on September 14, 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, inter alia, the requisite response (*Reply To Action Of March 2, 2006* - item 1), a $1500.00 petition fee under 37 CFR 1.17(m) (item 2), the requisite statement (item 3) and a Certificate of Service.

The petition for entry of the late papers is granted.

Jurisdiction over the reexamination proceeding is being returned to CRU Art Unit 3991 for further examination and consideration of the *Reply To Action Of March 2, 2006* filed September 14, 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, Jerry Johnson, in CRU Art Unit 3991, who can be reached at 571-272-1448.

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

Fred A. Silverberg

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

Kenneth M. Schor

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.
90/007,539	05/11/2005	6350066	12566-9	7590

23838 7590 02/28/2007

KENYON & KENYON LLP
1500 K STREET N.W.
SUITE 700
WASHINGTON, DC 20005

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/28/2007

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

3/1/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

ALAN M. WEISBERG

CHRISTOPHER & WEISBERG PA

200 EAST LAS OLAS BLVD., SUITE 2040

FORT LAUDERDALE, FL 33301

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007539

PATENT NO. 6,350,066

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

MAILED

FEB 28 2007

CENTRAL REEXAMINATION UNIT

Kenyon & Kenyon LLP 1500 K Street N.W. Suite 700 Washington, DC 2005	:	For Patent Owner
Alan M. Weisberg Christopher & Weisberg PA 200 East Las Olas Blvd., Suite 2040 Fort Lauderdale, FL 33301	:	For Requester
In re Charles R. Bobo, II *Ex Parte* Reexamination Proceeding Control No. 90/007,539 Filed: May 11, 2005 For: US Patent No. 6,350,066	:	DECISION GRANTING PETITION FOR EXTENSION OF TIME [37 CFR 1.550(c)]

This is a decision on the February 21, 2007, "Request for One-Month Extension of Time Pursuant to 37 CFR 1.550(c)" requesting that the time for responding to the Office action dated February 2, 2007 be extended by one month.

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

The petition is granted for two weeks for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action dated February 2, 2007, which set a one month period for filing a response thereto. The Office action is a 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 February 21, 2007, together with authorization to charge 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. ...
>
> 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.

Patent Owners Showing of Sufficient Cause to Grant an Extension of Time

The petition notes that the final rejection was 99 pages and rejected all 167 claims, and was received on February 7 (five days into the one month response period). The petition further notes that an interview is scheduled for March 6, 2007.

Analysis and Findings

While the scheduling of an interview is generally not sufficient cause of an extension of time, in this case it is clear Patent Owner requires some additional time beyond the one month originally given to prepare a complete response to the outstanding action, given its length and the number of claims involved. However, given the need for special dispatch, an extension of time of two weeks is considered sufficient to complete the response.

Accordingly, the time for filing a reply to the outstanding Office action is extended for two weeks and therefor the reply is due on March 16, 2007. 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 filed on February 21, 2007 is granted for two weeks.

2. The Patent Owner's response is due March 16, 2007.

3. The response may be submitted as follows:

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
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By Fax to: (571) 273-9900
Central Reexamination Unit

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401 Dulany Street
Alexandria, VA 22314

4. Telephone inquiries with regard to this decision should be directed to Gregory Mills, Quality Assurance Specialist in the Central Reexamination Unit, at (571) 272-1439.

Lissi Mojica Marquis,
Director
Central Reexamination Unit

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JUL 02 2007

CENTRAL REEXAMINATION UNIT

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Suite 700
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(For Patent Owner)

Steven M. Greenberg, Esq.
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(For Third Party Requester)

In re Charles R. Bobo II.	:	
Ex Parte Reexamination Proceeding	:	DECISION
Control No.: 90/007,539	:	GRANTING
Filed: May 11, 2005	:	PETITION
For: U.S. Patent No. 6,350,066	:	

This is a decision on the June 4, 2007 patent owner petition entitled "Petition Under 37 CFR 1.182." In the petition, patent owner seeks relief equivalent to the relief discussed in 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, and the 90/007,539 *ex parte* reexamination proceeding, are before the Office of Patent Legal Administration for decision.

The petition is granted.

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 6,350,066 (the '066 patent) issued on February 26, 2002.

2. A request for *ex parte* reexamination was filed by a third party requester on May 11, 2005, was assigned control No. 90/007,539, and is hereinafter referred to as the '539 reexamination proceeding.

3. Reexamination was ordered in the '539 reexamination proceeding on June 8, 2005.

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

4. The '066 patent is involved in multiple litigations, at least one of which has been stayed.

5. Prosecution was conducted in the '539 *ex parte* reexamination proceeding, and ultimately resulted a final Office action being mailed on February 2, 2007.

6. The February 2, 2007 final Office action set a shortened statutory period for filing a response thereto of one (1) month, or thirty (30) days in the event that the one-month period was less than thirty days. [2]

7. A Petition for Extension of Time was filed on February 21, 2007, in which patent owner requested a one-month extension of time to file a response to the final rejection.

8. A Decision Granting the February 28, 2007 petition for extension of time was issued; it granted an extension to the extent that the period for filing a response to the final rejection was extended for two weeks, thereby extending the period for response to expire on March 19, 2007. [3]

9. On March 12, 2007, patent owner conducted an interview with the examiner.

10. On March 14, 2007, patent owner conducted a second interview with the examiner.

11. On March 16, 2007, patent owner filed a <u>first</u> response to the final Office action, which included proposed claim amendments.

12. On April 13, 2007, the examiner issued an advisory action refusing to enter the proposed amendments contained in the March 16, 2007 patent owner response. The *Ex Parte* Reexamination Advisory Action Before the Filing of an Appeal Brief Form PTOL-467 ("Form PTOL-467") stated that "[T]he period for response is extended to run 1.5 months from the mailing date of the final rejection."

13. The April 13, 2007 advisory action was accompanied by *Ex Parte* Reexamination Communication Form PTOL-473 ("Form PTOL-473") that stated: "A shortened statutory period for response to this action is set to expire 1 month from the mailing date of this letter."

14. On April 17, 2007, a Monday, patent owner filed a supplemental (second) response to the final Office Action, again presenting the claim amendments previously presented on March 12, 2007, and additionally presenting a declaration under 37 CFR 1.131 executed by the inventor for the purpose of antedating certain documents relied upon by the examiner to reject the claims.

---

[2] A one-month period for response beginning on February 2, 2007 would have expired on March 2, 2007, a date which was only twenty-eight (28) days later than February 2, 2007. Therefore, the expiration date for filing a response to the final rejection was March 5, 2007, the first business day after Sunday, March 4, 2007, the date that was thirty days later than February 2, 2007.

[3] March 19, 2007 is the date that was two weeks later than March 5, 2007.

15. On May 14, 2007, a Monday, patent owner filed a Notice of Appeal and the requisite appeal fee .

16. On May 21, 2007, the examiner issued an advisory action refusing to enter the proposed amendments and the 37 CFR 1.131 declaration filed by patent owner on April 14, 2007.

17. Patent owner filed the present petition on June 4, 2007.

DECISION

I. Relevant Examining Procedure

MPEP § 2263 provides, in part:

> "Where the reexamination results from a court order or litigation is stayed for purposes of reexamination, the shortened statutory period will be set at 1 month. In addition, if (A) there is litigation concurrent with an *ex parte* reexamination proceeding and (B) the reexamination proceeding has been pending for more than one year, the Director or Deputy Director of the Office of Patent Legal Administration (OPLA), Director of the Central Reexamination Unit (CRU), Director of the Technology Center (TC) in which the reexamination is being conducted, or a Senior Legal Advisor of the OPLA, may approve Office actions in such reexamination proceeding setting a one-month or thirty days, whichever is longer, shortened statutory period for response rather than the two months usually set in reexamination proceedings."

MPEP § 2265(I) provides, in part:

"The filing of a timely first response to a final rejection having a shortened statutory period for response is construed as including a request to extend the shortened statutory period for an additional month, which will be granted even if previous extensions have been granted, but in no case may the period for response exceed 6 months from the date of the final action. Even if previous extensions have been granted, the examiner is authorized to grant the request for extension of time which is implicit in the filing of a timely first response to a final rejection." ...

> 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)."

II. Preliminary Discussion

A review of the facts reveals that there is some confusion in the record with respect to the appropriate time period for response to the final Office action dated February 2, 2007. The examiner set a shortened statutory period of one month, or thirty days in the event that one month was less than thirty days. This period was properly set in accordance with the practice discussed in MPEP § 2263 involving the time to be set for filing a response to an Office action when the patent that is the subject of an *ex parte* reexamination proceeding is also the subject of concurrent litigation.

As noted in Facts 6 and 8, *supra*, the period set in the final Office action was extended for an additional period of two weeks, and would have expired on March 19, 2007. However, as is apparent from facts 12 and 13, *supra*, the examiner's April 13, 2007 advisory action contained an ambiguity with respect to the period for filing a response to the final Office action. The April 13th Advisory action Form PTOL-467 states that the period for filing a response to the final Office action "is extended to run 1.5 months from the mailing date of the final rejection" (*i.e.*, the final Office action). However, the period for response to the final Office action had already been set to expire at the longer of one month or thirty days from the date of the final Office action, plus an additional two weeks, by reason of the response period set in the final Office action taken together with the February 28, 2007 decision that had granted a two-week extension of time period set in the final Office action. Further, in conflict with the statement on the face of Form PTOL-467, the April 13, 2007 advisory action was accompanied by Form PTOL-473 that purported to set a new shortened statutory period of time of the longer of one month or thirty days <u>from the mailing date of the advisory action</u> for filing a response to the February 2, 2007 final Office action. The two periods for response set in the April 13, 2007 advisory action expired on different dates.

It is clear that the April 13, 2007 advisory action could not "extend" the period for response to the final Office action to run "1.5 months" from the date of the final Office action, because that period (actually a slightly longer period) had already been set by the final Office action itself taken with the February 28, 2007 decision that granted a two-week extension of the period for response that had been set in the final Office action. The period for response set on the Form PTOL-467 was *clearly set in error*.

On the other hand, the practice set forth in MPEP §§ 2265 and 2272 with respect to the period for response to a final Office action in *ex parte* reexamination proceedings, as well as the general advisory action practice set forth in MPEP § 706.07(f), makes it clear that the Office cannot simply start a *new* shortened statutory period for filing a response to a final Office action unless the finality of the outstanding Office action is withdrawn, a response to the Office action is entered, and a new Office action is issued. The record does not show that the finality of the February 2, 2007 Office action was withdrawn, that any patent owner response thereto was entered, and that a new Office action was promulgated. Thus, the period set on the Form PTOL-473 was also technically set in error.

The appropriate procedure in *ex parte* reexamination practice with respect to the time for filing a response to a final Office action, and the treatment of a first patent owner response to the final Office action, is as set forth in MPEP § 2265(I). [4] The advisory action dated April 13, 2007, should have extended the period for filing a response thereto for an additional amount of time that would have permitted patent owner "to complete the response to the final rejection or to take other appropriate action (*sic*, as) would be appropriate." The response addressed by the April 13, 2007 advisory had been timely filed on March 16, 2007, but was not entered and therefore did not toll the period for filing a proper (*prima facie* enterable) response to the final Office action. The last day for taking action to file a proper (*prima facie* enterable) response to the final Office action (*e.g.* a notice of appeal) was March 19, 2007, but the advisory action was not mailed until April 13, 2007. Therefore, the advisory action should have simply extended the time for filing a response to the final Office action to run four months from the date of the final

[4] MPEP § 2272 reiterates much of what is set forth in MPEP § 2265(I).

Office action from the date of the final Office action (since an extension of only three months would have provided patent owner with less than three additional weeks, at most, even if the advisory action reached patent owner on the next business day following April 13, 2007). Completion of the Form PTOL-467 by inserting the number "4" in the appropriate space thereon have would been appropriate in order "to provide the patent owner with sufficient time "to complete the response to the final rejection or to take other appropriate action" as required by MPEP § 2265(1) in accordance with the decision in *Groz et al v. Quigg*, 10 USPQ2d 1787 (D.D.C. 1988).

It appears from the record that patent owner filed a notice of appeal on May 14, 2007. It further appears that both patent owner and the examiner treated the notice of appeal as having been timely filed, evidently relying on that portion of the April 13, 2007 advisory action that purported to establish a (new) shortened statutory period of one month or thirty days running from the date that the April 13, 2007 advisory action was mailed. [5] In order to avoid any ambiguity in the record, the period for filing a response to the final Office action dated February 2, 2007 is hereby re-set, *nunc pro tunc*, to run <u>four months</u> from the date of the final Office action.

<u>III. Request to Reopen Prosecution</u>

In the present petition, it is requested that the Office reopen and continue the prosecution of the '539 *ex parte* reexamination proceeding to provide consideration of the supplemental amendment and 37 CFR 1.131 declaration filed on April 17, 2007.

As pointed out above, 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." (See 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.) 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."

As with a Request for Continued Examination (RCE) in an application, the § 1.182 petition must be filed to further the prosecution of the reexamination proceeding, rather than to delay it, and must provide a submission toward that end. The patent owner must make a *bona fide* effort to define the issues for appeal, or the issuance of a reexamination certificate, when filing the § 1.182 petition, since this is a key factor in reducing pendency of a reexamination proceeding.

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[5] May 13, 2007, the date that was one month later than April 13, 2007, was a Sunday.

Stated another way, the practice requires that the § 1.182 petition be accompanied by a submission which provides a *bona fide* effort to advance the prosecution toward appeal, or the issuance of a reexamination certificate.

To support the present petition, patent owner has pointed out that a proposed amendment after final action has been filed, but was not entered and considered by the examiner. Further, a 37 CFR 1.131 declaration executed by Charles R. Bobo, II was also filed on April 17, 2007, but was also not entered and considered by the examiner. The 37 CFR 1.131 declaration is being relied on by patent owner to antedate certain prior art references that are applied against the claims in the final Office action. Patent owner believes that the April 17, 2007 "response" will further the prosecution of the reexamination proceeding rather than delay it, if the papers in the response are entered and considered by the examiner. The April 17, 2007 papers are acceptable as papers submitted to satisfy the requirements of the § 1.182 petition provided for in the Office's March 2005 notice.

Based on the present facts and circumstances, the petition is granted, and the prosecution in the '539 *ex parte* reexamination proceeding is hereby continued. The finality of the February 2, 2007 Office action is hereby withdrawn, and the prosecution is reopened for entry into the record, and consideration of, the amendment filed on April 17, 2007 and the accompanying 37 CFR 1.131 declaration executed by Charles R. Bobo, II. Entry of these papers will entitle the patent owner to full consideration of patent owner's position with respect to the papers, and an Office action on the merits thereof.

The proceeding will be forwarded to the examiner for such consideration. The examiner will then issue an Office action treating the April 17, 2007 amendment and accompanying 37 CFR 1.131 declaration as a response received after a first Office action. In the event that the patent owner again appeals from any new final rejection, if such is issued, patent owner would be required to submit a new notice of appeal. The fee for filing a notice of appeal has already been paid. Therefore, the appeal fee would not have to be paid again. However, patent owner would be required to pay the difference between the appeal fee that has been paid and any increased fee at the time of any such a second appeal. [6]

CONCLUSION

1. The petition under 37 CFR 1.182 is granted.

2. The prosecution of the present '539 *ex parte* reexamination proceeding is continued.

3. The finality of the February 2, 2007 Office action is withdrawn, and prosecution of the proceeding is reopened to the extent that the response submitted on April 17, 2007 will be addressed and treated as a response received after a first, non-final Office action.

4. The '539 *ex parte* reexamination is returned to the jurisdiction of the Central Reexamination Unit. The April 17, 2007 response, including the declaration of Charles R. Bobo, II under 37 CFR 1.131, will be entered by the Central Reexamination Unit, and then considered by the examiner.

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[6] See MPEP § 1207.04

5. Any further relief via a request for continued reexamination is barred, absent a showing of an extraordinary situation where justice would require such further relief.

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

Kenneth Schor,
Senior Legal Advisor
Office of Patent Legal Administration

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June 22, 2007

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In re Reexamination Proceeding	:
M. Mazurek	:
Control No. 90/007,540	: DECISION GRANTING PETITION
Filed: May 11, 2005	:
U.S. Patent No. 6,440,880	:
Attorney Docket No. 3094-72	:

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on September 14, 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, inter alia, the requisite response (*Amendment In Reply To Action Of March 2, 2006* - item 1), a $1500.00 petition fee under 37 CFR 1.17(m) (item 2), the requisite statement (item 3) and a Certificate of Service.

The petition for entry of the late papers is granted.

Jurisdiction over the reexamination proceeding is being returned to CRU Art Unit 3991 for further examination and consideration of the *Amendment In Reply To Action Of March 2, 2006* filed September 14, 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, Jerry Johnson, in CRU Art Unit 3991, who can be reached at 571-272-1448.

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

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

Conferee: Kenneth M. Schor, Senior Legal Advisor

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Gerald Levy, Esq.
PITNEY HARDIN LLP
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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/007,540*.

PATENT NO. *6440880*.

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

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Paper No.

Lisa Griffith, Esq.
3M OFFICE OF INTELLECTUAL PROPERTY
COUNSEL
P.O. BOX 33427
St. Paul, MN 55133-3427

In re Application of:
3M INNOVATIVE PROPERTIES COMPANY
Application No. 90/007,540
Filed: May 11, 2005
For: PRESSURE-SENSITIVE ADHESIVES HAVING MICROSTRUCTURED SURFACES

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request To Withdraw from Representation filed March 26, 2007.

A grantable request to withdraw as attorney of record should indicate thereon the present mailing addresses of the attorney(s) who is/are withdrawing from the record and of the applicant. **The request for withdrawal must be signed by every attorney 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 effective date of withdrawal being the date of decision and not the date of request. See M.P.E.P. ∋ 402.06. 37 C.F.R. ∋ 1.36 **further requires that the applicant or patent owner be notified of the withdrawal of the attorney or agent**.

The request is signed by Lindsay S. Adams alone and does not contain a clear indication that Ms. Adams is authorized to sign on behalf of the other attorneys of record and is signing on behalf of the other attorneys of record. Furthermore, there is no indication that Applicant has been notified of the request for withdrawal.

Accordingly, the request is **DENIED**.

All future communications from the United States Patent and Trademark Office (Office) will continue to be directed to the above-listed address until otherwise notified by applicant. Applicant is reminded of the obligation to promptly notify the Office of any change in correspondence address to ensure receipt of all communications from the Office.

James R. Matthews

JM Deborah D. Jones
Central Reexamination Unit (SPRE)
Art Unit 3991
(571) 272-1535

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Phoenix, AZ 85004

For Patent Owner

MAILED

AUG 11 2006

CENTRAL REEXAMINATION UNIT

In re: Thompson et al.
Ex Parte Reexamination Proceeding
Control No. 90/007,541
Filed: May 12, 2005
For: US Patent No. 6,494,349

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

This is a decision on the July 11, 2006, Patent Owner "Petition for Extension of Time under 37 CFR 1.550(c)" requesting that the time for responding to the Office action dated May 17, 2006 be extended by two months.

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

The petition is dismissed as moot and 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 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 11, 2006, together with appropriate payment of 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.

Patent Owner notes that the instant patent was recently purchased by The Dial Corporation, and requests up to two months to allow for transfer of the matter to new counsel and preparation of the reply.

However, the request fails to provide any factual information as to reasonably diligent behavior by all those responsible for preparing a response.

Moreover, on July 17, 2006 Patent Owner timely filed a reply to the Office action of May 17, 2006, making the instant petition for extension of time moot in any event.

Conclusion

1. The patent owner's petition for extension of time filed on June 27, 2006 and June 28, 2006 is <u>dismissed</u> as moot and incomplete.

2. Further correspondence may be submitted as follows:

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
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By Fax to: (571) 273-9900
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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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(For Patent Owner)

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NOV 28 2007

CENTRAL REEXAMINATION UNIT

In re Reexamination Proceeding :
H. Thompson et al. :
Control No. 90/007,541 : DECISION GRANTING PETITION
Filed: May 12, 2005 :
U.S. Patent No. 6,494,349 :
Attorney Docket No. 49930.8600 :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on November 5, 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 27, 2007, in response to a telephone communication between Counsel, Bradford Donovan and Senior Legal Advisor, Fred Silverberg; a Notice of Appeal along with an authorization to charge counsel's deposit account for the requisite Notice of Appeal fee was filed by facsimile transmission.

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

The petition for entry of the late papers is granted.

$2,050.00 ($1,540.00 for the petition fee and $510.00 for the Notice of Appeal fee) has been charged to counsel's deposit account no. 19-2814 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, 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

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MAILED

JUN 0 6 2006

REEXAM UNIT

In re Cabilly et al
Reexamination Proceeding
Control No.: 90/007,542
Filed: May 13, 2005
For: U.S. Patent 6,331,415

DECISION MERGING
REEXAMINATION
PROCEEDINGS

In re Cabilly et al
Reexamination Proceeding
Control No.: 90/007,859
Filed: December 23, 2005
For: U.S. Patent 6,331,415

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 6,331,415, issued December 18, 2001, is the subject of Reexamination Control Nos. 90/007,542 and 90/007,859.

2. A first request for reexamination, assigned Reexamination Control No. 90/007,542, was filed May 13, 2005 by Lisa V. Mueller, of Wood, Phillips in Chicago IL. The request urged that a substantial new question of patentability was raised by the teachings of USPN 4,816,567.

3. Reexamination was ordered for 90/007,542 on May 13, 2005.

4. A first Office action for 90/007,542 was mailed September 13, 2005.

5. A Patent Owner response was submitted on November 25, 2005.

6. A second request for re-examination, assigned Reexamination Control No. 90,007,859, was filed December 23, 2005 by Elliot M. Olstein of Carella, Byrne in Roseland New Jersey. The request urged that a substantial new question of patentability was raised by USPN 4,816,567 alone or in combination with several NPL documents.

7. Reexamination was ordered for 90/007,859 on December 23, 2005. There has been no Patent Owner response.

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 90/007,542 and 90/007,859 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 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. 90/007,542 and 90/007,859 as:

Wendy M. Lee
Genentech, Inc.
1 DNA Way
South San Francisco, CA 94080-4990

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control No. 90/007,542 as:

Lisa V. Mueller
Wood, Phillips, Katz, Clark & Mortimer
3800 West Madison Street, Suite 3800
Chicago, IL 60661

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control No. 90/007,542 as:

Elliot M. Olstein
Carella, Byrne, Bain, Gilfillan, Cecchi, Stewart & Olstein
5 Becker Farm Road, 2nd Floor
Roseland, New Jersey 07068

CONCLUSION

Reexamination Control Nos. 90/007,158 and 90/007,712 are merged. The re-examination files shall be forwarded to the examiner for action 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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,542	05/13/2005	6331415	22338-10230	7585

47554 7590 03/21/2007

SIDLEY AUSTIN LLP
ATTN: DC PATENT DOCKETING
1501 K STREET, NW
WASHINGTON, DC 20005

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/21/2007

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

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MAILED

MAR 21 2007

CENTRAL REEXAMINATION UNIT

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In re Cabilly et al. *Ex Parte* Reexamination Proceeding Control No.: 90/007,542 Filed: May 13, 2005 For: U.S. Patent No. 6,331,415	**DECISION DISMISSING PETITION**
In re Cabilly et al. *Ex Parte* Reexamination Proceeding Control No.: 90/007,859 Filed: December 23, 2005 For: U.S. Patent No. 6,331,415	

This is a decision on the March 6, 2007 patent owner petition titled "PETITION UNDER 35 U.S.C. § 304 AND 37 C.F.R. §§ 1.181 AND 1.182 FOR A DIRECTOR-ORDERED REEXAMINATION OR TO WITHDRAW FINALITY OF OFFICE ACTION." This decision also addresses the request for extension of time filed March 6, 2007.

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

The petition is dismissed; however, an avenue for petitioner to obtain the relief requested is set forth below.

FEES

Petitioner patent owner has authorized a charge against Deposit Account No. 18-1260 for the $400.00 petition fee under 37 CFR 1.17(f) for filing the present 37 CFR 1.182 petition, and such has been carried out.

BACKGROUND

1. U.S Patent number 6,331,415, ("the '415 patent") issued to Cabilly et al on December 18, 2001.

2. A first request for reexamination of the '415 patent, assigned Reexamination Control No. 90/007,542 ("the '7542 proceeding"), was filed May 13, 2005, by Lisa V. Mueller, of Wood, Phillips et al of Chicago IL.

3. Reexamination was ordered for the '7542 proceeding on May 13, 2005.

4. A first Office action was mailed for the '7542 proceeding on September 13, 2005.

5. A patent owner response was submitted on November 25, 2005.

6. A second request for reexamination of the '415 patent, assigned Reexamination Control No. 90,007,859 ("the '7859 proceeding"), was filed December 23, 2005 by Elliot M. Olstein of Carella, Byrne et al of Roseland New Jersey.

7. Reexamination was ordered for the '7859 proceeding on December 23, 2005.

8. On June 6, 2006, the Central Reexamination Unit (CRU) Director issued a decision *sua sponte* merging the '7542 reexamination proceeding and the '7859 reexamination proceeding into a single consolidated reexamination proceeding.

9. The merged proceeding has advanced to the point where a final rejection was mailed on February 16, 2007.

10. On March 6, 2007, petitioner patent owner filed the present petition under 37 CFR 1.181 and 37 CFR 1.182.

DECISION

A. Dismissal of petition:

Petitioner has filed the present petition under both 37 CFR 1.181 and 37 CFR 1.182, and makes the following requests for relief:

> 1) Primary request for relief: "[T]hat the Director vacate the outstanding Office action; order reexamination based on the '545 and/or '334 patents; provide Owners the opportunity prescribed by law to respond; and, if reexamination is still found to be justified, merge the new reexamination with the present proceedings according to established Office practice." [1]
>
> 2) Alternative request for relief: "[T]hat the finality of the 16 February 2007 Office Action be withdrawn." [2]

37 CFR 1.4(c) provides:

> "Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects."

Pursuant to 37 CFR 1.4(c), different matters raised in a given proceeding must be raised in separate papers. As pointed out above, the present petition includes two requests. (1) The request for a Director initiated reexamination under 37 CFR 1.182 is addressed in the Office of Patent Legal Administration (OPLA) by a Senior Legal Advisor or an OPLA manager. (2) The request under 37 CFR 1.181 that the finality of the 16 February 2007 Office action be withdrawn is addressed in the CRU by the CRU Director.

Accordingly, it would be required that the two requests for relief be made by two separate petitions, and the present combined petition is dismissed.

B. Avenue for petitioner to obtain relief requested:

In the interest of facilitating this reexamination proceeding, the substance of the petition has been reviewed to a limited extent. The ground of relief targeted by petitioner is that patent owner not be procedurally disadvantaged with respect to responding to the final rejection containing a new ground of rejection, and as to not receiving another Office action after the patent owner's response. [3] Such relief is available as follows:

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[1] Petition at page 4, first complete paragraph, last sentence.
[2] Petition at page 4, last complete paragraph, second sentence.
[3] Of course, an advisory Office action would be issued, but it is assumed petitioner is referring to a non-advisory Office action.

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." [4] 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....
>
> "Until these new rules become effective, however, patent owners are advised to use ...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. This will be referred to herein as "the § 1.182 petition."

As with a Request for Continued Examination (RCE) in an application, the § 1.182 petition must be filed to further the prosecution of the reexamination proceeding, rather than to delay it, and must provide a submission toward that end. In this instance, a response on the merits addressing the Moore 5,840,545 patent (newly applied in the final Office action mailed February 16 2007) would clearly further the prosecution. Thus, a renewed petition under 37 CFR 1.182 can be filed for continued reexamination, if it is accompanied by an appropriate response on the merits addressing the Moore 5,840,545 patent, in order to obtain the relief requested by patent owner. If such a petition is filed and granted, the prosecution would then be reopened for entry into the record of the response, the proceeding would be forwarded to the examiner for consideration of the response, and the examiner would issue an Office action treating the response as a response received after a first Office action. No further continuation of the reexamination proceeding would be granted under 37 CFR 1.182, absent a showing of extraordinary circumstances; however, the relief *presently requested* by patent owner (one further iteration to address the 5,840,545 patent) would be provided.

It is to be noted that there is no basis, nor any reason, for initiating the new reexamination proceeding requested. There is already a merged proceeding in existence (the present proceeding) in which the 5,840,545 patent can be addressed, and it would be a waste of resources to initiate a new one and then to merge it with the present merged proceeding. Patent owner urges that it is entitled to a chance to address the 5,840,545 patent; a continuation of the reexamination prosecution, taking the Office's application of the 5,840,545 patent as a first

---

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

Office action (which can be responded to by patent owner, without any "after-final" limitation on the response) *will give the patent owner what it is requesting.*

C. Time for response to this decision:

Pursuant to 37 CFR 1.181 (f):

> "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."

Accordingly, petitioner is provided with a period of two months from the mail date of this decision to file a renewed petition. Should any renewed petition under 37 CFR 1.182 be filed for continued reexamination be filed, no fee is needed, as the fee for a 37 CFR 1.182 petition to provide the requested relief has already been paid with the present petition.

The 37 CFR 1.181(f) provision that the "two-month period is not extendable" is hereby waived to the extent that an extension of time to file a renewed petition may be requested under 37 CFR 1.550(c). It is to be noted that MPEP 2265 provides:

> "Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period." [Emphasis added.]

D. Time for response to February 16, 2007 final Office action:

The patent owner requested a two month extension of time (filed March 6, 2007) to respond to the February 16, 2007 final Office action. Petitioner patent owner is now being provided with two months from the date of this petition to file a renewed petition. Accordingly, and to avoid confusion, the time to respond to the February 16, 2007 final Office action is hereby extended to run TWO (2) MONTHS of the mail date of this decision.

It is to be noted that the periods for response to both this decision and the Office action are coextensive. However, the filing of a petition for continued reexamination together with the response will not stop/suspend the period for response to the Office action. Patent owner is cautioned that, pursuant to 37 CFR 1.181 (f), "[t]he 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." Thus, even after the filing of any petition for continued reexamination together with a response (as discussed above), patent owner is cautioned to take steps to keep the present proceeding pending (e.g., by filing a further request for extension of time).

E. Address clarification:

It is to be noted that the street address for Lisa V. Mueller is given in the record as "3800 West Madison Street, " while that of the register of patent attorneys and agents

maintained by the Office of Enrollment and Discipline (OED) pursuant to 37 CFR §§ 11.5 and 11.11 is "500 West Madison Street." Both the service of the petition and this decision are being mailed to the "500 West Madison" street address; however, requester may wish to clarify this matter.

CONCLUSION

1. The petition is dismissed.

2. Any renewed petition or request for reconsideration must be filed within TWO (2) MONTHS of the mail date of this decision. An extension of time to file a renewed petition may be requested under 37 CFR 1.1550(c); extensions of time under 37 CFR 1.136 are not available in reexamination proceedings.

3. Any renewed petition, should be directed to:

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

4. The Office of Patent Legal Administration is retaining jurisdiction over the instant reexamination proceeding. If no renewed petition is received within two months of the mailing date of this decision (or within the time as extended, if any extension of time under 37 CFR 1.550(c) should be granted), then the proceeding will be returned to the CRU.

5. The time to respond to the February 16, 2007 final Office action is hereby extended to run TWO (2) MONTHS of the mail date of this decision

6. Telephone inquiries with regard 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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(For Patent Owner)

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JUN 01 2007

CENTRAL REEXAMINATION UNIT

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Suite 3800 Chicago, IL 60661

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Roseland, New Jersey 07068

(For Second Third Party Requester)

In re Cabilly et al.
Ex Parte Reexamination Proceeding
Control No.: 90/007,542
Filed: May 13, 2005
For: U.S. Patent No. 6,331,415

In re Cabilly et al.
Ex Parte Reexamination Proceeding
Control No.: 90/007,859
Filed: December 23, 2005
For: U.S. Patent No. 6,331,415

DECISION DISMISSING PETITION

This is a decision on the May 21, 2007 patent owner petition titled:

RENEWED PETITION UNDER 37 C.F.R. § 1.182
REQUEST FOR CONTINUED REEXAMINATION

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

The renewed petition is granted.

BACKGROUND

1. U.S Patent number 6,331,415, ("the '415 patent") issued to Cabilly et al on December 18, 2001.

2. A first request for reexamination of the '415 patent, assigned Reexamination Control No. 90/007,542 ("the '7542 proceeding"), was filed May 13, 2005, by Lisa V. Mueller, of Wood, Phillips et al of Chicago IL.

3. Reexamination was ordered for the '7542 proceeding on May 13, 2005.

4. A first Office action was mailed for the '7542 proceeding on September 13, 2005.

5. A patent owner response was submitted on November 25, 2005.

6. A second request for reexamination of the '415 patent, assigned Reexamination Control No. 90,007,859 ("the '7859 proceeding"), was filed December 23, 2005 by Elliot M. Olstein of Carella, Byrne et al of Roseland New Jersey.

7. Reexamination was ordered for the '7859 proceeding on December 23, 2005.

8. On June 6, 2006, the Central Reexamination Unit (CRU) Director issued a decision *sua sponte* merging the '7542 reexamination proceeding and the '7859 reexamination proceeding into a single consolidated reexamination proceeding.

9. The merged proceeding advanced to the point where a final rejection was mailed on February 16, 2007.

10. On March 6, 2007, the patent owner filed (a) a petition titled "PETITION UNDER 35 U.S.C. § 304 AND 37 C.F.R. §§ 1.181 AND 1.182 FOR A DIRECTOR-ORDERED REEXAMINATION OR TO WITHDRAW FINALITY OF OFFICE ACTION," and (b) a request for extension of time.

11. On March 21, 2007, the Office issued a decision (a) dismissing the petition under 37 CFR 1.181 and 37 CFR 1.182, and (b) extending the time for further action in the proceeding to expire two months the mail date of the March 21, 2007 decision.

12. On May 21, 2007, patent owner filed (a) a renewed petition titled ""RENEWED PETITION UNDER 37 C.F.R. § 1.182, REQUEST FOR CONTINUED REEXAMINATION," and (b) a response on the merits including declaration evidence.

DECISION

In the present petition, it is requested that the Office continue the prosecution of the instant reexamination proceeding to provide consideration of the response to the final Office action which accompanied the present petition.

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending." [1] Notice was provided therein that a second (or subsequent) reexamination would no longer be ordered on the basis of a "substantial new question of patentability" (SNQ) that is the same as a SNQ raised in an earlier pending reexamination. Notice was also provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding. By filing such a petition, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the 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."

As with a Request for Continued Examination (RCE) in an application, the § 1.182 petition must be filed to further the prosecution of the reexamination proceeding, rather than to delay it, and must provide a submission toward that end. The patent owner must make a *bona fide* effort to define the issues for appeal, or the issuance of a reexamination certificate, when filing the § 1.182 petition, since this is a key factor in reducing pendency of a reexamination proceeding. Stated another way, the practice requires that the § 1.182 petition be accompanied by a submission which provides a *bona fide* effort to advance the prosecution toward appeal, or the issuance of a reexamination certificate. In this instance, the response on the merits filed with the present petition addresses the Moore 5,840,545 patent (newly applied in the final Office action mailed February 16 2007) to further the prosecution, as is required.

Accordingly, the petition is granted, and the prosecution in the above-captioned reexamination proceeding is hereby continued. The finality of the February 16, 2007 Office action is withdrawn, and the prosecution is reopened for consideration of the response to the final Office action received May 21, 2007, with the present petition. This

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

response to the final Office action will be entered in the reexamination proceeding, and the proceeding will be forwarded to the examiner for action consistent with this decision. The examiner will consider the response, and then issue an Office action treating the papers as a response received after a first Office action.

CONCLUSION

1. The renewed petition under 37 CFR 1.182 is granted.

2. The prosecution of the present merged reexamination proceeding is continued. *No further continuation of the proceeding will be granted under 37 CFR 1.182, absent a showing of extraordinary circumstances.*

3. The finality of the February 16, 2007 Office action is withdrawn, and the prosecution of the proceeding is reopened.

4. The May 21, 2007 response (accompanying the present petition) will be entered by the Central Reexamination Unit (CRU), and then will be considered by the examiner. The response papers will be addressed and treated as a response 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 with regard to this decision should be directed to the undersigned at (571) 272-7710.

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

5/31/07
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,859	12/23/2005	6331415	22338-10231	6447

47554 7590 10/09/2007

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/09/2007

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

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UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,542	05/13/2005	6331415	22338-10230	7585

47554 7590 10/09/2007

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10/10/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

ALAN J. GRANT
CARELLA BYRNE BAIN GILFILLAN ET AL
5 BECKER FARM ROAD, 2ND FLOOR
ROSELAND, NJ 07068

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007859
PATENT NO. 6,331,415
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 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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10/10/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

LISA V. MUELLER
WOOD PHILLIPS KATZ CLARK & MORTIMER
3800 WEST MADISON STREET, SUITE 3800
CHICAGO, IL 60661

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007542
PATENT NO. 6,331,415
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 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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(Patent Owner)

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In re Cabilly et al. Reexamination Proceeding Control No. 90/007,542 Filed: May 13, 2005 For: U.S. Patent No. 6,331,415 B1	:	DECISION ON PETITIONS
In re Cabilly et al. Reexamination Proceeding Control No. 90/007,859 Filed: December 23, 2005 For: U.S. Patent No.: 6,331,415 B1	:	

This is a decision addressing (1) the 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 724.06," both submitted on September 13, 2007.

The petitions are 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 724.06 and 37 CFR 1.59 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. 6,331,415 to Cabilly et al. (the '415 patent) issued on December 18, 2001.

2. On May 13, 2005, a first third party requester filed a request for *ex parte* reexamination, which was assigned reexamination control number 90/007,542 (the '7542 proceeding).

3. On July 7, 2005 the Office granted the '7542 reexamination request, and ordered reexamination.

4. On December 23, 2005, a second third party requester filed a second request for *ex parte* reexamination, which was assigned reexamination control number 90/007,859 (the '7859 proceeding).

5. On January 23, 2006 the Office granted the '7859 reexamination request, and ordered reexamination.

6. On June 6, 2006 the Office issued a decision merging the '7542 and '7859 *ex parte* proceedings into a single merged proceeding.

7. On September 13, 2007, 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). The information submitted with the petition was provisionally sealed from the public.

8. Also on September 13, 2007, the patent owner filed a petition under 37 CFR 1.183 to waive the service requirement by 37 CFR 1.550(f).

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, is opened to the public in the 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 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. 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 requester).

Petition to Expunge under 37 CFR 1.59

The information submitted with the petition under MPEP 724.02, appears to be appropriately submitted. Accordingly, the materials are **provisionally sealed**.

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." 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 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 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 under the jurisdiction of 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 724.06 and 37 CFR 1.59 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. The present merged proceeding will 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. Jurisdiction over the present reexamination proceeding is being returned to the Central Reexamination Unit for further processing consistent with this decision.

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

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

10/2/07
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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,542	05/13/2005	6331415	22338-10230	7585

47554 7590 11/21/2007

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/21/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,859	12/23/2005	6331415	22338-10231	6447

47554 7590 11/21/2007

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EXAMINER

ART UNIT	PAPER NUMBER

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(for Second Third Party Requester)

In re Cabilly et al.
Reexamination Proceeding
Control No. 90/007,542
Filed: May 13, 2005
For: U.S. Patent No. 6,331,415 B1

In re Cabilly et al.
Reexamination Proceeding
Control No. 90/007,859
Filed: December 23, 2005
For: U.S. Patent No.: 6,331,415 B1

DECISION
ON
PETITIONS

This is a decision addressing (1) the 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," both submitted on October 24, 2007.

The petitions are 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. 6,331,415 to Cabilly et al. (the '415 patent) issued on December 18, 2001.

2. On May 13, 2005, a first third party requester filed a request for *ex parte* reexamination, which was assigned reexamination control number 90/007,542 (the '7542 proceeding).

3. On July 7, 2005, the Office granted the '7542 reexamination request and ordered reexamination.

4. On December 23, 2005, a second third party requester filed a second request for *ex parte* reexamination, which was assigned reexamination control number 90/007,859 (the '7859 proceeding).

5. On January 23, 2006, the Office granted the '7859 reexamination request and ordered reexamination.

6. On June 6, 2006, the Office issued a decision merging the '7542 and '7859 *ex parte* proceedings into a single merged proceeding.

7. On September 13, 2007, 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. On October 9, 2007, the Office issued a decision granting patent owner's petition requesting a waiver of service of the confidential materials and provisionally sealed the September 13, 2007 IDS submission materials.

7. On October 24, 2007, the patent owner filed a second supplemental IDS in the merged reexamination proceeding. The IDS was filed under seal and concurrently with the present petition under MPEP 724.02 and 37 CFR 1.59(b) for expungement upon issuance of a Notice of Intent to Issue a Reexamination Certificate (NIRC). The information submitted with the petition was placed in an artifact file; it was not scanned into the Image File Wrapper (IFW).

8. Also on October 24, 2007, the patent owner filed the present petition under 37 CFR 1.183 to waive the service requirement of 37 CFR 1.550(f).

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 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 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. 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 requester).

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**. The provisional sealing of the materials will take the form of keeping the materials in an artifact file and not-scanned.

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 be "important to a reasonable examiner in deciding whether or not a claim is patentable" must

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[1] Note MPEP 724.06 (emphasis added):

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.

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. The present merged proceeding will 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. Jurisdiction over the present reexamination proceeding is being returned to the Central Reexamination Unit for further processing consistent with this decision.

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

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

11/12/07
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,542	05/13/2005	6331415	22338-10230	7585

47554 7590 05/05/2009

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/05/2009

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,859	12/23/2005	6331415	22338-10231	6447

47554 7590 05/05/2009

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/05/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

ALAN J. GRANT
CARELLA BYRNE BAIN GILFILLAN ET AL
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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007859
PATENT NO. : 6331415
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 Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

LISA V. MUELLER
WOOD PHILLIPS KATZ CLARK & MORTIMER
3800 WEST MADISON STREET, SUITE 3800
CHICAGO, IL 60661

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007542
PATENT NO. : 6331415
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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Reexamination Proceeding
Control No.: 90/007,542
Filed: May 13, 2005
For: U.S. Patent 6,331,415

Reexamination Proceeding
Control No.: 90/007,859
Filed: December 23, 2005
For: U.S. Patent 6,331,415

DECISION DENYING PETITION TO EXPUNGE INFORMATION (37 CFR 1.59(b) and 1.182) AND AND PETITION TO WAIVE SERVICE RULE

This is a decision addressing (1) the patent owner "Petition Under 37 C.F.R. 1.59(b) and 1.182 to Expunge Information Submitted Under MPEP 724.02," and (2) the patent owner "Petition Under 37 C.F.R. 1.183" to waive the Service Rule, both submitted on June 6, 2008.

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

SUMMARY

The petition under 37 CFR 1.182 and 37 CFR 1.59(b) to expunge information under MPEP 724.02 is **denied**.

The petition under 37 CFR 1.183 to waive the service requirement of 37 CFR 1.550(f) is **denied**.

LEGAL BASIS

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 1.182 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 interest 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.
>
> (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 this 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 re-examination 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 re-examination 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, is opened to the public in the re-examination 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 purpose of any protective order issued by the federal court, in the related patent litigation, as well as undermine protected 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. Such has been found to be the case. The Examiner has determined that the information submitted pursuant to MPEP 724.04 is material to the patentability and/or confirmation of the instant reexamination claims as explained in the Advisory Action mailed July 19, 2008. Accordingly, no 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 required. Therefore, the petition to waive the service rule is **denied.**

Petition to Expunge under 37 CFR 1.59(b)

It has been determined that the materials previously submitted by and identified as "confidential" by the Patent Owner is important to a reasonable examiner in determining the patentability/confirmation of the claims as set forth in the Advisory Action mailed July 19, 2008. Consequently, the information submitted by the Patent Owner will not be expunged and the petition to expunge is **denied**.

CONCLUSION

1. The petition under 37 CFR 1.182 and 37 CFR 1.59(b) requesting that the submitted materials be expunged is **denied.**

2. The petition under 37 CFR 1.183 requesting waiver of the service requirement is **denied.**

3. Within 15 days from the mailing of this decision, the Patent Owner is required to serve the materials submitted as "confidential" to the third parties in the reexamination proceeding in the manner provided by 37 CFR 1.248.

4. Telephone inquires with regard to this decision should be directed to Deborah Jones, Supervisory Patent Examiner, at (571) 272 -1535.

for Deborah Jones

Gregory A. Morse, Director
Central Reexamination Unit

Interview Summary	Application No.	Applicant(s)	
	90/007,542 / 90/007,859	6331415	
	Examiner	Art Unit	
	DEBORAH JONES	3991	

All participants (applicant, applicant's representative, PTO personnel):

(1) *DEBORAH JONES*. (3)_____.

(2) *Jeffrey Kushan*. (4)_____.

Date of Interview: *30 April 2009*.

Type: a)☒ Telephonic b)☐ Video Conference
c)☐ Personal [copy given to: 1)☐ applicant 2)☐ applicant's representative]

Exhibit shown or demonstration conducted: d)☐ Yes e)☒ No.
If Yes, brief description: _____.

Claim(s) discussed: *none*.

Identification of prior art discussed: _____.

Agreement with respect to the claims f)☐ was reached. g)☐ was not reached. h)☒ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: *Mr.Kushan confirmed the petitions filed 9/13/07 and 10/24/07 to expunge will not be renewed. No further response to this interview is necessary.*.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Deborah Jones
SPE / AU 3991

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

David L. Fitzgerald
Sidley Austin LLP
1501 K Street, N.W.
Washington, D.C. 20005

(For Patent Owner)

Lisa V. Mueller
Wood, Phillips, Katz, Clark & Mortimer
500 West Madison Street, Suite 3800
Chicago, IL 60661

(For Requester)

MAILED

JUN 19 2009

CENTRAL REEXAMINATION UNIT

Elliot M. Olstein
Carella, Byrne, Bain, Gilfillan,
Cecchi, Stewart & Olstein
5 Becker Farm Road, 2nd Floor
Roseland, NJ 07068

(For Requester)

In re Cabilly et al.
Ex Parte Merged Reexamination
Control Nos. 90/007,542 & 90/007,859
Filed: May 13, 2005 & Dec. 23, 2005
For: U.S. Patent 6,331,415

DECISION DISMISSING PETITION

This is a decision on the patent owner petition, filed May 15, 2009, denominated "Request for Reconsideration and/or Petition Under 37 CFR § 1.183" requesting reconsideration of the May 5, 2009 decision denying a petition to expunge and to waive the service requirement and requesting the Director to suspend the rule to replace a document in the record.

The proceeding and the petition are before the Office of Patent Legal Administration for decision.

The petition fee required under 37 CFR 1.17(f) has been received.

The request for reconsideration and the petition under 37 CFR 1.183 are **dismissed**, because the Office lacks jurisdiction over U.S. Patent 6,331,415, since reexamination proceeding Control Nos. 90/007,542 and 90/007,859 have now been concluded by the issuance and publication of a reexamination certificate.

REVIEW OF FACTS

1. U.S. Patent No. 6,331,415 (the '415 patent) issued with 36 claims on December 18, 2001, from application No. 07/205,419 to Cabilly et al.
2. On May 13, 2005, a first request for *ex parte* reexamination was filed by a third party and was assigned control No. 90/007542 (the '7542 proceeding).

3. On July 7, 2005, reexamination was ordered in the '7542 proceeding for claims 1-36 of the '415 patent.

4. On December 23, 2005, a second request for *ex parte* reexamination was filed by a different third party and was assigned control No. 90/007859 (the '7859 proceeding).

5. On January 23, 2006, reexamination was ordered in the '7859 proceeding for claims 1-36 of the '415 patent.

6. On June 6, 2006, a decision was issued to merge the '7542 proceeding with the '7859 proceeding.

7. The merged proceedings progressed to the issuance of a Notice of Intent to Issue a Reexamination Certificate on February 23, 2009, to confirm claims 1-20 and 33-36 and allow amended claims 21-32.

8. On May 5, 2009, a decision was issued denying a petition that was filed June 6, 2008 requesting that certain information be expunged and that the service rule be waived. A telephone interview summary was attached thereto noting that the petitions filed September 13, 2007, and October 24, 2007, requesting that materials be expunged would not be renewed.

9. On Friday, May 15, 2009, at 5:10 pm, the present petition was filed requesting reconsideration of the May 5, 2009 decision, specifically to expunge other material that had been inadvertently submitted in the proceedings, and in the alternative to suspend the rules to permit submission of a substitute document in the record.

10. On Tuesday, May 19, 2009, the *Ex Parte* Reexamination Certificate, U.S. 6,331,415 C1, issued.

DECISION

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

MPEP 1305 states in part:

> Once a patent has been granted, the U.S. Patent and Trademark Office can take no action concerning it, except as provided in 35 U.S.C. 135, 35 U.S.C. 251 through 256, 35 U.S.C. 302 through 307 and 35 U.S.C. 311 through 316.

§ 1.181 Petition to the Director.

> (a) Petition may be taken to the Director:
>
> (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
>
> (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and
>
> (3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § **41.3** of this title.
>
> (b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be

embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

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

(d) Where a fee is required for a petition to the Director the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.

(e) Oral hearing will not be granted except when considered necessary by the Director.

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

(g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

§ 1.182 Questions not specifically provided for.

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).

§ 1.183 Suspension of rules.

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in **§ 1.17**(f).

ANALYSIS AND FINDINGS

Once a patent has been granted, the U.S. Patent and Trademark Office can take no action concerning it, except as provided in 35 U.S.C. 135, 35 U.S.C. 251 through 256, 35 U.S.C. 302 through 307 and 35 U.S.C. 311 through 316. See MPEP 1305. The Office does not have jurisdiction to act on a petition matter in a reexamination proceeding <u>after</u> the reexamination certificate has issued and published, because the Office lacks jurisdiction over the patent that was reexamined, once the reexamination proceeding has been concluded by the issuance and publication of a reexamination certificate.

In this case, the Notice of Intent to Issue the Reexamination Certificate was issued on February 23, 2009. <u>Almost three months after the Notice was issued</u>, the patent owner filed a petition on Friday, May 15, 2009, after business hours, which permitted only one business day to process and act on the petition before the reexamination certificate issued and published on its scheduled date for issuance and publication. Although the petition states that, upon final review of the file, the patent owner discovered a document that had been erroneously filed in the proceeding - the situation remains that the petition was not filed with sufficient time to permit the Office to process the paper and withdraw the merged proceeding from the printing process prior to

issuance and publication of the certificate. As a result, the Office now lacks jurisdiction to render a decision on the petition. Accordingly, the petition is dismissed.

CONCLUSION

1. For the reasons set forth above, the Request for Reconsideration of the decision mailed May 5, 2009 and/or Petition Under 37 CFR 1.183 to suspend the rules is **dismissed** for lack of jurisdiction.

2. The merged reexamination proceedings have concluded, and the *Ex Parte* Reexamination Certificate U.S. 6,331,415 has issued on May 19, 2009.

3. Any inquiry concerning this communication should be directed to Caroline D. Dennison, Legal Advisor, at (571) 272-7729.

Kenneth M. Schor

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

June 16, 2009
Kenpet7\expunge

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

PAUL N. WARE c/o Ware Enterprises, Inc 1090 Barker Road S W Rome, GA 30165	:	For Patent Owner
DAVID D. ZURILLA, ESQ. Schwegman, Lundberg Waessner & Kluth 1600 TCE Tower 121 South Eighth Street Minnneapolis, MN 55402	:	For Requester
LITMAN LAW OFFICES, LTD P. O. Box 15035 Crystal City Station Arlington, VA 22215	:	For Requester

In re: Paul N. Ware
Ex Parte Reexamination Proceeding
Control No. 90/007,543
Filed: May 16, 2005
For: US Patent No. 4,707,592

MAILED
JAN 30 2006
REEXAM UNIT

In re: Paul N. Ware
Ex Parte Reexamination Proceeding
Control No. 90/007,716
Filed: September 13, 2005
For: US Patent No. 4,707,592

DECISION MERGING
REEXAMINATION
PROCEEDINGS

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

BACKGROUND

1. Patent No. 4,707,592 issued on November 17, 1987.

2. *Ex Parte* Reexamination Proceeding, control no. 90/007,543 was requested by a third party requester filed on May 16, 2005.

3. The Reexamination Order was granted in proceeding, control no. 90/007,543 on August 1, 2005.

4. *Ex Parte* Reexamination Proceeding, control no. 90/007,716 was requested by a third party requester filed on September 13, 2005.

5. The Reexamination Order was granted in proceeding, control no. 90/007,716 on October 31, 2005.

6. Both proceedings await first Office actions on the merits by the examiner assigned the case.

7. There are currently no amendments in either proceeding.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

As noted 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 90/007,543 and 90/007,716 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. 90/007,543 and 90/007,716 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

Best Available Copy

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Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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AUG 03 2007

CENTRAL REEXAMINATION UNIT

BAKER BOTTS L.L.P.
2001 ROSS AVENUE
SUITE 600
DALLAS TX 75201-2980

For Patent Owner

Lawrence G. Kurland
BRYAN CAVE LLP
1290 Avenue of the Americas
New York, NY 10104

For Requester

DECISION, *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS

In re: Ozawa *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/007,546
Filed: May 18, 2005
For: US Patent No. RE 36,769

In re: Ozawa *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,071
Filed: February 18, 2005
For: US Patent No. RE 36,769

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. RE 36,769 reissued on July 11, 2000.

2. *Ex Parte* Reexamination Proceeding, control no. 90/007,546 was requested the patent owner on May 18, 2005.

3. The Reexamination Order was granted in proceeding, control no. 90/007,546 on August 1, 2004.

4. There are currently no amendments proceeding control number 90/007,546.

5. *Ex Parte* Reexamination Proceeding, control no. 90/008,071 was requested by a third party requester filed on June 28, 2006.

6. The Reexamination Order was granted in proceeding, control no. 90/008,071 on August 31, 2006.

7. There are currently no amendments proceeding control number 90/008,071.

8. Proceedings control numbers 90/007,546 and 90/008,071 awaits the first Office action on the merits from the assigned examiner.

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 90/007,546 and 90/008,071 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. 90/007,546 and 90/008,071 are **MERGED**.

2. The reexamination files are being forwarded to the examiner for issuing a first Office action.

3. All correspondence regarding these proceedings should be submitted as follows:

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

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

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

3. 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

MReinhart for
MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

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

Baker Botts LLP
2001 Ross Avenue
Suite 600
Dallas, TX 75201-2980

(For Patent Owner)

MAILED

NOV 29 2007

CENTRAL REEXAMINATION UNIT

Lawrence G. Kurland
Bryan Cave LLP
1290 Avenue of the Americas
New York, NY 10104

(For Third-Party Requester)

In re: Ozawa *et alia*
Reexamination Proceeding
Control No. 90/007,546
Request Deposited: May 18, 2005
For: U.S. Patent No. RE 36,769

In re: Ozawa *et alia*
Reexamination Proceeding
Control No. 90/008,071
Request Deposited: June 28, 2006
For: U.S. Patent No. RE 36,769

: DECISION GRANTING
: ONE MONTH PETITION
: FOR EXTENSTION OF TIME
: [37 CFR 1.550(c)]

This is a decision on the November 21, 2007, patent owner "Petition for Extension of Time Under 37 CFR 1.550(c)," requesting that the time to submit a response to the office action mailed September 29, 2007 be extended an additional month. The petition was resubmitted on November 27, 2007 and again resubmitted on November 28, 2007 with an indication that the petition was served on the third-party requester.

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

The petition is granted for a one month extension of time for the reasons set forth below.

Copied from 90008071 on 01/17/2008

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,357,091 (hereinafter, the '091 patent), issued to Ozawa *et alia*, on October 18, 1996. The '091 patent reissued as Patent Number RE 36,769 (hereinafter, the '769 patent) on July 11, 2000.

2. On May 18, 2005, patent owner deposited a Request for *Ex Parte* Reexamination of the '769 patent. The reexamination proceeding was assigned Control No. 90/007,546 (hereinafter, the '7546 proceeding).

3. The reexamination order was granted in the '7546 proceeding on August 1, 2005.

4. On June 28, 2006, a third party deposited a Request for *Ex Parte* Reexamination of the '769 patent. The reexamination proceeding was assigned Control No. 90/008,071 (hereinafter, the '8071 proceeding).

5. The reexamination order was granted in the '8071 proceeding on August 31, 2006.

6. The proceedings were merged on August 3, 2007.

7. A non-final rejection was mailed on the merged proceedings on September 29, 2007.

DECISION

The Patent Owner requests an extension of time in which to file a response to the non-final rejection mailed September 29, 2007. The request for extension is the first request for an extension of time. The present petition for extension of time was timely filed on November 28, 2007, together with authorization to charge the petition fee required by 37 CFR 1.515(c), and the indication that the petition was served on the third-party requester. It is noted the submissions of November 21 and November 27 do not appear to have been served on the third-party requester.

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.

Copied from 90008071 on 01/17/2008

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 CRU 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.

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

The patent owner notes that difficulties in scheduling an interview has forced the earliest available date for the interview to be November 29, 2007 (the date the response is due) and that filing a response on the date of the interview would not permit enough time to discuss the results of the interview with the non-US client or to implement any suggestions or respond to any concerns that may be raised during the interview.

Analysis and Findings

On balance it is considered that the petition explains the "sufficient cause" for an extension of time. It is clear Patent Owner requires some additional time to prepare a complete response. An extension of time of one month is considered sufficient.

Accordingly, the time for filing the response is extended for one month and therefor the response is due on or before December 31, 2007 (because December 29, 2007 is a Saturday).

CONCLUSION

1. Petitioner's request is granted. The period during which Patent Owner may file a response has been extended to December 31, 2007.

Copied from 90008071 on 01/17/2008

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.

Eric Keasel for

Lissi M. Marquis
Director, Center Reexamination Unit

Copied from 90008071 on 01/17/2008

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.
90/007,548	05/19/2005	6726877	MSX-101	2123

7590 02/16/2006

Stephen E. Feldman, PC
12 East 41ST Street
Suite 701
New York, NY 10017

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

MAILED
FEB 16 2006
REEXAM UNIT

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

Reexam Control No.: 90/007,548
Filed: March 10, 2005
For U.S. Patent No.: 6,569,427

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. 90/007,633 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. 90/007,548 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

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

SEP 01 2007

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 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. 90/007,559 Filed: May 27, 2005 For: US Patent No. 5,402,043	:	

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 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 June 14, 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 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.

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

for

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

Lissi Mojica Marquis,
Director,
Central Reexamination Unit
3999

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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RICHARD L. MIKESELL, ESQ.
14827 VENTURA BLVD.
SUITE 216
SHERMAN OAKS CA 91403

(For Patent Owner)

MAILED

AUG 18 2006

CENTRAL REEXAMINATION UNIT

In re George FLEMING et al.
Reexamination Proceeding
Control No.: 90/007,560
Filed: May 27, 2005
For: U.S. Patent No.: 5,468,545

: DECISION ON PETITION
: TO SUSPEND THE RULES
: UNDER 37 CFR 1.183

This is a decision on the August 16, 2006, patent owner petition titled PETITION TO SUSPEND THE RULES AND/OR FOR MATTERS NOT SPECIFICALLY PROVIDED FOR, taken as a petition under 37 CFR 1.183.

The petition is before the Office of Patent Legal Administration.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.183, has been paid by check.

The petition is dismissed for the reasons set forth below.

DECISION

37 CFR 1.550(c) states, in 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. (Emphasis added)

37 CFR 1.550(d) states:

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

In the present reexamination proceeding, the one-month time period for the patent owner to file a grantable extension of time or a response to the Office action of March 28, 2006, expired on

April 28, 2006. Patent owner did not file the required response or a grantable request for an extension of time before this expiration date. Instead, patent owner filed the present petition and a "Petition to Extend Time for Response" with the Office on August 16, 2006,[1] more than three months after the expiration of the time period set for response in the Office action. Consequently, in accordance with 37 CFR 1.550(d), the present reexamination prosecution has been terminated.

The Office cannot decide a petition under 37 CFR 1.183 in a terminated reexamination. Accordingly, the petition is dismissed as moot.

Patent owner's attention is directed to 37 CFR 1.137 regarding the revival of a terminated reexamination prosecution.

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

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

CONCLUSION

1) The petition is dismissed as moot.

2) If the petitioner chooses to file a petition to revive under either 37 CFR 1.137(a) or (b), the patent owner must comply with the requirements of those provisions, as set forth in the regulations and repeated in the body of this decision. If the petitioner desires to make the submissions required under § 1.137, the submissions should be included with a cover letter entitled "Petition under 37 CFR 1.137(a)" or "Petition under 37 CFR 1.137(b)" depending upon the avenue of requested relief chosen by petitioner.

3) Jurisdiction of this reexamination proceeding is retained in the Office of Patent Legal Administration for one month from the mailing date of this decision to permit the filing of a petition by the patent owner under 37 CFR 1.137. After the expiration of this one-month period, jurisdiction will be returned to Central Reexamination Unit for

[1] These papers include a Certificate of Mailing dated August 14, 2006.

further handling not inconsistent with this Decision, including the mailing of an *ex parte* reexamination certificate canceling the claims of the patent.

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

By U.S. Postal Service Mail:

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

By FAX:

(571) 273-9900
Central Reexamination Unit
Attention: Brian Hanlon

By hand (or delivery service):

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

5) Telephone inquiries related to this decision should be directed to Brian E. Hanlon, Legal Advisor, at (571) 272-5047, or in his absence, the undersigned at (571) 272-7710.

Brian E Hanlon

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

August 18, 2006
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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.
90/007,560	05/27/2005	5468545	Itex-47552	2255

7590 09/29/2006

RICHARD L. MIKESELL, ESQ.
14827 VENTURA BLVD.
SUITE 216
SHERMAN OAKS, CA 91403

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/29/2006

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
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RICHARD L. MIKESELL, ESQ.
14827 VENTURA BLVD.
SUITE 216
SHERMAN OAKS CA 91403

(For Patent Owner)

MAILED

SEP 29 2006

CENTRAL REEXAMINATION UNIT

In re Reexamination Proceeding	:	
Fleming et al.	:	
Control No. 90/007,560	:	DECISION GRANTING PETITION
Filed: May 27, 2005	:	
U.S. Patent No. 5,468,545	:	
Attorney Docket No. Itex-47552	:	

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on September 11, 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, inter alia, the requisite response (communication embedded in the petition (see page 9 of the petition) - item 1), a $1500.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3).

In order to avoid any further processing delays, as to the embedding of the 'response' in with the petition, 37 CFR1.4(c) is hereby waived. The 'response' embedded in with the petition is considered the requisite response.

In view of the above, the petition for entry of the late papers is granted.

Jurisdiction over the reexamination proceeding is being returned to CRU Art Unit 3991 for further examination and consideration of the communication embedded in the petition filed September 11, 2006 (see page 9 of the petition), in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Stephen Stein, in CRU Art Unit 3991, who can be reached at 571-272-1544.

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

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

Kenneth M. Schor
Conferee: Kenneth M. Schor, Senior Legal Advisor

UNITED STATES PATENT AND TRADEMARK OFFICE

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.
90/007,566	06/03/2005	6506314		5193

7590 06/15/2006

EXAMINER

Armand P. Boisselle
RENNER OTTO BOISSELLE & SKLAR LLP
1621 Euclid Avenue 19th Floor
Cleveland, OH 44115

ART UNIT	PAPER NUMBER

DATE MAILED: 06/15/2006

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

Thomas W. Adams
Renner, Otto, Boiselle & Sklar, L.L.P.
1621 Euclid Avenue, 19th Floor
Cleveland, Ohio 44114

For Patent Owner

Jennifer A. Calcagni
8 Tree Hill Road
Berlin CT 06037

For Requester

Ex Parte Reexamination Proceeding
Control No. 90/007,566
Filed: June 3, 2005
For: US Patent No. 6,506,314

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

This is a decision on the petition filed June 2, 2006 to request a two-month extension of time pursuant to 37 CFR 1.550 for responding to the Office action dated April 12, 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 April 12, 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 patentee has and continues to conduct testing on samples of copper foil and compare the resulting characteristics with those of products resulting from prior art processes. The testing is complex and time-consuming. Furthermore, due to the availability of the equipment, much of the testing must be conducted in Germany. Patentee is requesting additional time to complete the testing, coordinate the results, and prepare a suitable submission for filing. An extension of time until August 12, 2006 is requested.

Analysis and Findings

On balance, it is considered that the petition explains the "sufficient cause" as to why an extension of time should be granted. Patent Owner notes that the outstanding Office action has resulted in a need for substantial and complex testing and indicates he has been diligently conducting said testing in order to demonstrate non-obviousness of the claimed invention. According to the supplemental statement of facts, only one of the original inventors is available to complete the experiments and much of the testing must be conducted in Germany because the equipment is simply not available at the research facility in South Carolina. Additional time is needed to collate the data and prepare a sufficient response. Patent Owner has also indicated that he expects all testing, preparation and submissions to be complete within the requested two-month extension period. It is clear that these tests and experiments are essential and critical for the preparation of a fully responsive submission and necessary to enable Patent Owner a fair opportunity to present an appropriate and persuasive argument against the current rejections. An extension of time for two months is considered sufficient to compile the information and complete the response. Accordingly, the time for filing a reply to the outstanding Office action is extended for two months, and the reply is therefor due on or before August 12, 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 in which to file a response to the Office action dated April 12, 2006 is **granted**.

2. The Patent Owner's response is due August 12, 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

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 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 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. 90/007,569 Filed: June 3, 2005 For: US Patent No. 6,002,210	:	

This is a decision on the May 23, 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 March 26, 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 March 26, 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 May 23, 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 March 26, 2007 is **granted**.

2. The Patent Owner's response is due **June 26, 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

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P.O. Box 1450
Alexandria, VA 22313-1450
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Charles E. Baxley, Esquire (For Patent Owner)
HART BAXLEY DANIELS & HOLTON
59 John St., 5FL
New York NY 10038

David I. Klein (For Third Party Requester)
Rosenberg, Klein & Lee
3458 Ellicott Center Drive
Suite 101
Ellicott City, MD 21043

MAILED
APR 03 2006
REEXAM UNIT

In re Reexamination Proceeding :
Ching-Shu Wang :
Control No. 90/007,570 : DECISION DISMISSING PETITION
Filed: June 3, 2005 :
U.S. Patent No. 6,698,734 :
Attorney Docket No. 13544B :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on January 23, 2006, for entry of late papers based upon unintentional delay.

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

35 U.S.C. 304 Reexamination order by Director.

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 1.137(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." [Emphasis Added]

37 CFR 1.550 (c) and (f) state respectively:

> (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 forcommencing a civil action.
>
> (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.

The present petition under 37 CFR 1.137(b) includes a $750.00 petition fee under 37 CFR 1.17(m) (item 2), a statement (item 3), a Declaration of Inventor and Ching-Shu Wang's Response to Order Granting Request for *Ex Parte* Reexamination.

A review of the record reveals the following:

On July 21, 2005, an Order Granting/Denying Request For *Ex Parte* Reexamination was mailed granting the request for *ex parte* reexamination and setting a two month period from the mailing date of the Order for filing an optional patent owner's statement while noting that extensions of time were governed by 37 CFR 1.550(c). 35 USC 304.

No timely filed patent owner's statement has been located in the reexamination file. The filing of a patent owner's statement is optional. Therefore, the non-filing of the patent owner's statement does not cause the reexamination prosecution to become terminated. The relief provision set forth in 37 CFR 1.137(b) is remedial and is only available to reexaminations that have become terminated. As the present reexamination proceeding has not terminated, the relief provision set forth in 37 CFR 1.137(b) is unavailable to the patent owner.

It is noted that any material related to the reexamination proceeding, that is, the Declaration of Inventor and Ching-Shu Wang's Response to Order Granting Request for *Ex Parte* Reexamination may be filed during the examination stage of the present reexamination proceeding in accordance with the rules and regulations governing the reexamination proceeding.

Further, extensions of time in reexamination proceedings are provided for in 37 CFR 1.550(c). Pursuant to 37 CFR 1.550(c), any request for extension of time must be filed "on or before the day on which action by the patent owner is due," and will be granted only upon a presentation of "sufficient cause" for the extension and "for a reasonable time specified."

In view of the above, the petition is **dismissed**.

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 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 3739 for further examination in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Beverly M. Flanagan, in Technology Center Art Unit 3739, who can be reached at 571-272-4766.

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

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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MAILED

JUN 14 2006

CENTRAL REEXAMINATION UNIT

David I. Klein (For Third Party Requester)
Rosenberg, Klein & Lee
3458 Ellicott Center Drive
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Ellicott City, MD 21043

In re Reexamination Proceeding	:	
Ching-Shu Wang	:	
Control No. 90/007,570	:	DECISION DISMISSING
Filed: June 3, 2005	:	REQUEST FOR RECONSIDERATION
U.S. Patent No. 6,698,734	:	
Attorney Docket No. 13544B	:	

This is a decision on patent owner's Request For Reconsideration filed May 1, 2006, by facsimile transmission, in response to the decision mailed April 3, 2006, in the above-identified application.

Petitioner, patent owner, requests reconsideration of the decision mailed April 3, 2006, dismissing the January 3, 2006, patent owner petition. Petitioner argues that the reason that the petition was dismissed appears on page 3 of the decision in the second full paragraph, wherein it was stated that the requisite proof of service to the third party requestor was not included with the present petition or its attachments. Petitioner further argues that proof of such service was submitted to the Office on March 8, 2006, by facsimile transmission. In support of the request for reconsideration, copies of the correspondence submitted March 8, 2006, by facsimile transmission, were submitted.

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

35 U.S.C. 304 Reexamination order by Director.

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 1.137(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." [Emphasis Added]

37 CFR 1.550 (c) and (f) state respectively:

(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 forcommencing a civil action.

(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.

The decision dismissing the petition mailed April 3, 2006 noted the following:

On July 21, 2005, an Order Granting/Denying Request For *Ex Parte* Reexamination was mailed granting the request for *ex parte* reexamination and setting a two month period from the mailing date of the Order for filing an optional patent owner's statement while noting that extensions of time were governed by 37 CFR 1.550(c).

No timely filed patent owner's statement has been located in the reexamination file. The filing of a patent owner's statement is optional. Therefore, the non-filing of the patent owner's statement does not cause the reexamination prosecution to become terminated. The relief provision set forth in 37 CFR 1.137(b) is remedial and is only available to reexaminations that have become terminated. As the present reexamination proceeding has not terminated, the relief provision set forth in 37 CFR 1.137(b) is unavailable to the patent owner.

> It is noted that any material related to the reexamination proceeding, that is, the Declaration of Inventor and Ching-Shu Wang's Response to Order Granting Request for *Ex Parte* Reexamination may be filed during the examination stage of the present reexamination proceeding in accordance with the rules and regulations governing the reexamination proceeding.
>
> Further, extensions of time in reexamination proceedings are provided for in 37 CFR 1.550(c). Pursuant to 37 CFR 1.550(c), any request for extension of time must be filed "on or before the day on which action by the patent owner is due," and will be granted only upon a presentation of "sufficient cause" for the extension and "for a reasonable time specified."

Contrary to patent owner's statement in the present request for reconsideration, the petition was dismissed on April 3, 2006, as no timely patent owner's statement was located in the Image File Wrapper (IFW). The service matter was an additional item noted in the April 3, 2006, decision, but that did not provide the primary basis for the dismissal.

Accordingly, as no timely patent owner's statement has been located in the Image File Wrapper (IFW), as set forth above, the petition is again **dismissed**.

It is again emphasized that any material related to the reexamination proceeding, that is, the Declaration of Inventor and Ching-Shu Wang's Response to Order Granting Request for *Ex Parte* Reexamination may be filed during the examination stage of the present reexamination proceeding in accordance with the rules and regulations governing the reexamination proceeding.

A further review of the IFW record reveals that there is no record that the requisite certificate of service for the present petition was filed on March 8, 2006. However, the evidence is convincing that the requisite proof of such service for the present petition was submitted to the Office on March 8, 2006, by facsimile transmission and was thereafter misplaced in the USPTO. The copy of the certificate of service submitted with the present request will be inserted into the IFW.

Receipt is acknowledged on April 17, 2006, of a Change of Correspondence Address (copy enclosed). No Certificate of Service has been located among the Change of Correspondence Address papers. However, in order to expedite matters, the certificate of service for the Change of Correspondence Address will be perfected by attaching a copy of the Change of Correspondence Address communication to this decision which will be forwarded to the third party requestor. The Change of Correspondence Address will be entered in due course.

In order to avoid any problems in the future, the patent owner should make certain that any future communications filed by patent owner in this proceeding (including any response to this decision) 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 3739 for further examination in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Beverly M. Flanagan, in Technology Center Art Unit 3739, who can be reached at 571-272-4766.

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

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

Enclosure:
Change of Correspondence Address

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NOV - 2 2005

Harbin, King and Klima
500 Ninth Street, SE
Washington, DC 20003

In re Requestor : **DECISION ON PETITION**
Automated Merchandising Systems, Inc. : **TO REVIEW EXAMINER'S**
Reexamination Application No. 90/007,572 : **DETERMINATION REFUSING**
Filed: May 31, 2005 : **REEXAMINATION**
For: SYSTEM FOR ACCOMPLISHING PRODUCT DETECTION

This is in reply to requestor's Petition to Review Examiner's Determination Denying Reexamination filed under 37 CFR 1.181 and 37 CFR 1.515(c) in the United States Patent and Trademark Office on September 26, 2005.

The petition is **DISMISSED**.

A review of the file record indicates that a determination on reexamination was denied and mailed to applicant on August 18, 2005. Third party requestor Automated Merchandizing Systems, Inc. (AMS) filed a petition with a certificate of mailing dated September 26, 2005.

37 CFR 1.515 (c) states:

The requestor may seek review by a petition to the Commissioner under § 1.181 within one month of the mailing date of the examiner's determination refusing *ex parte* reexamination. Any such petition must comply with § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable.

MPEP § 2248 states:

The requestor may seek review of a *denial* of a request for reexamination only by petitioning the Commissioner under 37 CFR 1.515 (c) and 1.181 within 1 month of the mailing date of the decision denying request for reexamination. Additionally, any request for an extension of the time period to file such a petition from the denial of a request for reexamination can only be entertained by filing a petition under 37 CFR 1.183 with appropriate fee to waive the time provisions of 37 CFR 1.515.(c).

While meeting the requirements under 37 CFR 1.181, the petition fails to meet the time provisions under requirements 37 CFR 1.515 (c) and MPEP § 2248. The one month date for filing the petition was September 19, 2005, as stated above, AMS petition has a certificate of mailing dated September 26, 2005. There being no petition of record under 37 CFR 1.183 with appropriate fee to waive the time provisions of 37 CFR 1.515.(c), the petition request is properly denied and the file will be forwarded to the Office of Finance for a refund as per MPEP § 2248.

Robert J. Oberleitner, Director
Technology Center 3600
(571) 272-5350

GOC/spe: 11/01/05

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FROM DIRECTOR'S OFFICE

MAY 02 2006

TECHNOLOGY CENTER 3600

For the Patent Owner:

DOCKET CLERK
P.O. Drawer 800889
Dallas, TX 75380

For the Requester:

Timothy J. Klima
Harbin, King & Klima
500 9th Street, SE
Washington, DC 20003

DECISION ON PETITION FOR REVIEW OF DENIAL OF REQUEST FOR REEXAMINATION UNDER 37 CFR 1.515(c)

In re Reexamination proceeding 90/007,572
Filed: May 31, 2005
For: SYSTEM FOR ACCOMPLISHING PRODUCT DETECTION

This is in response to Requester's petition filed November 28, 2005 under 37 CFR 1.183 and 1.515(c) requesting review of the November 2, 2005 petition decision that Dismissed as untimely requester's petition of September 19, 2005, that requested review of the Order Denying Request For Reexamination dated August 18, 2005. This latest petition is being treated as a request for reconsideration of the earlier petition decision of November 2, 2005.

The petition is **GRANTED to the extent indicated below**.

On August 18, 2005 the examiner issued a denial of the request for reexamination. On September 19, 2005 (a Monday), the requester filed a petition requesting review of the above denial of the reexamination request. On November 2, 2005 a decision was mailed that dismissed the petition as being untimely, erroneously indicating that the petition was filed on September 26, 2005.

Because the requester's petition was filed on September 19, 2005 and not September 26, 2005, it was filed within the one month period from the date of the denial and is thus considered timely. Although a Certificate of Service on the Patent Owner was apparently missing, the document was served as evidenced by a copy of the certificate attached to the Patent Owner's submission of September 26, 2005. Although the Certificate of Service was missing initially, it's subsequent arrival in the Office outside the one month period to timely petition does not adversely impact the timeliness of the petition itself.

Thus, this petition is **GRANTED** to the extent that the original petition of September 19, 2005 was timely and the original petition will be looked at on the merits to decide if the Denial of the request for reexamination was proper. A decision on the original petition follows below.

The petition filed September 19, 2005 is **DENIED**.

Requester's petition outlines two reasons as to why it is believed that the decision to deny the request for Reexamination was in error:

1.) The Patent Owner subsequently filed a Reexamination on the same 6,732, 014 patent that is the subject of the request denied here.
2.) That the examiner neglected to appreciate the new interpretation of the previously cited prior art or the reasons why the new prior art was cited.

As to the first reason above, the petition indicates that a Reexamination request (90/007,679) was filed by the Patent Owner on the '014 patent that cited much of the same art but also cited many patents and publications not of record in the '014 patent. This Patent Owner Reexamination request was granted by an examiner different from the one denying the request in reexamination control number 90/007,572. As a result of the grant of this later request, requester feels that this is evidence of the error in denying the request in the '572 case.

This first argument is not agreed with. Initially, it should be noted that each request is decided separately based upon what is contained in the request. Although many of the references may be the same, each requester is free to provide whatever reasoning they wish to show that a Substantial New Question of Patentability (SNQ) exists. The mere fact that another request to reexamine the same patent was subsequently granted does not mean that an earlier request to reexamine which was denied was done so in error.

As to the second reason, above, the petition indicates that the examiner neglected to appreciate the new interpretation of the previously cited prior art or the reasons why the new prior art was cited. Certainly a request can use old art to show a SNQ where a request provides a clear indication that the old art is being viewed in a "new light" different from the way it was viewed in the prosecution of the patent. The examiner clearly considered whether or not the old art being discussed in the request was being viewed in a new light, and concluded that it was not. The instant petition argues that the old art was provided with a new interpretation that the examiner ignored. However, without some specifics as to the explanation of how the old art was being viewed in a "new light", this statement is nothing more than a conclusion and is not persuasive. Likewise, in the decision denying the request, the examiner considered the newly cited art and determined that it was cumulative of art used in the prosecution of the original patent. Without some specifics to the contrary, the allegation in the petition that the

examiner failed to appreciate the newly cited art is again an unsubstantiated conclusion and not persuasive.

As an aside, it should be noted, that because the Patent Owner has separately and subsequently filed a granted reexamination request of this same patent, even if requester could show that the decision denying their request for reexamination was in error, there would appear to be no benefit to the requester. If the requester's request were granted, the proceedings would be merged into a single proceeding (MPEP 2283) with the requester having no further participation in the merged proceeding. This fact has no bearing on this decision, however, and is only pointed out for the benefit of the requester.

In conclusion, the request for reexamination filed May 31, 2005 did not raise a substantial new question of patentability concerning U.S. Patent 6,732,014 and the decision to deny said request by the examiner on August 18, 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.

Inquiries related to this decision may be directed to Special Programs Examiner Steven N. Meyers at (571) 272-6611.

John Love, Director
Patent Technology Center 3600
(571) 272-5250

SM/SM: 4/30/06
SM

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The Hamilton Law Firm PC
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G21-139
Littleton, CO 80123

(For Patent Owner)

MAILED

JAN 28 2008

CENTRAL REEXAMINATION UNIT

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Abraham Hershkovitz
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(For 3rd Party requester)

Reexam Control No.: 90/007,576
Filed : June 6, 2005
For U.S. Patent No. : 5,043,736

Reexam Control No.: 90/008,655
Filed : May 18, 2007
For U.S. Patent No. : 5,043,736

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. 90/007,576 was ordered in a decision mailed August 9, 2005. A number of Office actions have been issued and a number of responses have been filed in the instant proceeding. The last paper that has been recorded is an amendment filed by patent owner on September 11, 2007, which amendment is responsive to an Office action mailed July 12, 2007. Claims have been amended and added, and the specification has been amended as well by virtue of amendments filed October 24, 2006, March 20, 2007, and the afore-mentioned amendment filed September 11, 2007.

Reexamination in application control No. 90/008,655 was ordered in a decision mailed June 20, 2007. 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 and specification have been amended in the '7,576 reexamination proceedings by virtue of the amendments filed October 24, 2006; March 20, 2007; and September 11, 2007. 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 and specification 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 that jointly applies to both reexaminations. All papers issued by the Office will contain the identifying data for both cases, and each action will be entered into both files (which will be maintained as separate files). Any paper 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. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief, brief fee, oral hearing fee, etc.), 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 multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings 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.

Dual Correspondence

Currently, patent owner appears to be represented by two different representatives. In reexamination proceeding control No. 90/007,576, patent owner is represented by the Hamilton Law Firm per the Power of Attorney papers filed September 13, 2006. In reexamination control No. 90/008,655, patent owner is represented by the law firm of Faegre & Benson, which is the representative of record in the file of the patent undergoing reexamination (i.e., serial number 07/558,651). 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. 90/007,576 and 90/008,655 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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(for Patent Owner)

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MAY 07 2007

CENTRAL REEXAMINATION UNIT

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Doublas G. Hodder
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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: Alumot *et alia* :
Ex Parte Reexamination Proceeding :
Control No. 90/007,577 :
Filed: June 3, 2005 :
For U.S. Patent No. 5,982,921 :

In re: Alumot *et alia* :
Ex Parte Reexamination Proceeding :
Control No. 90/007,691 :
Filed: August 22, 2005 :
For U.S. Patent No. 5,982,921 :

The above-identified reexamination files are before the Director of the Central Reexam Unit 3999, for consideration of merger of reexamination control number 90/007,577 (the '577 proceeding) and the reexamination control number 90/007,691 (the '691 proceeding) pursuant to 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 5,982,921 issued on November 9, 1999.

2. The 90/007,577 reexamination proceeding was filed on June 3, 2005 by a third party requester.

3. The '577 proceeding Order granting reexamination was mailed on August 17 2005.

4. A non-final Office action in the '577 proceeding was mailed on January, 10, 2007.

5. A response and amendment to the claims from the Patent Owner was received by the Office March 13, 2007.

6. The 90/007,691 reexamination proceeding was filed August 22, 2005 by a third party requester.

7. The '691 proceeding Order granting reexamination was mailed on September 30, 2005.

8. There are no amendments to the '691 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 90/007,577 and 90/007,691 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 90/007,577 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. 90/007,577 and 90/007,691 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 90/007,577 and 90/007,691 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

for
MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

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CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

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(For Third Party Requester)

Robert A. Saltzberg
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(For Third Party Requester)

In re Alumot *et alia*
Reexamination Proceeding
Control No. 90/007,577
Request Deposited: June 3, 2005
For: U.S. Patent No. 5,982,921

In re Alumot *et alia*
Reexamination Proceeding
Control No. 90/007,691
Request Deposited: August 22, 2005
For: U.S. Patent No. 5,982,921

In re Alumot *et alia*
Reexamination Proceeding
Control No. 90/008,690
Request Deposited: August 22, 2005
Corrected Request Deposited: July 20, 2007
For: U.S. Patent No. 5,982,921

: DECISION *SUA SPONTE*
: MERGING
: REEXAMINATION
: PROCEEDINGS

The above identified *ex parte* reexamination files are before the Director of the Central Reexam Unit for consideration of merger of proceedings under 37 CFR 1.565(c).

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,982,921 (hereinafter, the '921 patent), issued to Alumot *et alia*, on November 9, 1999.

2. On June 3, 2005, a third party requester deposited a Request for *Ex Parte* Reexamination of the '921 patent. The reexamination proceeding was assigned Control No. 90/007,577 (hereinafter, the '7577 proceeding).

3. The Reexamination Order was granted in the '7577 proceeding on August, 17, 2005.

4. A non-final office action was mailed on January 10, 2007 in the '7577 proceeding.

5. A response and amendment to the claims was filed by Patent Owner on March 13, 2007.

6. On August 22, 2005, a third party deposited a Request for *Ex Parte* Reexamination of the '921 patent. The reexamination proceeding was assigned Control No. 90/007,577 (hereinafter, the '7691 proceeding).

7. The Reexamination Order was granted in the '7691 proceeding on September 30, 2005.

8. The '7577 and '7691 proceedings were merged on May 7, 2007.

9. A housekeeping amendment was filed on June 4, 2007 to maintain the same claims and specification in the merged '7577 and '7691 proceedings.

10. On July 20, 2007, a third party deposited a corrected Request for *Ex Parte* Reexamination of the '921 patent. The reexamination proceeding was assigned Control No. 90/008,690 (hereinafter, the '8690 proceeding).

11. The Reexamination Order was granted in the '8690 proceeding on August 22, 2007.

12. There are currently no amendments in the '8690 proceeding.

DECISION

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.

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '7577, '7691, and '8690 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.

As noted above, the claims have been amended in the '7577 and '7691 reexamination proceedings. 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 all files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

III. Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to all 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. 90/007,577, 90/007,691, and 90/008,690 are **merged**.

2. Patent Owner has one month from the date of this decision to submit a "housekeeping" amendment. Upon receipt of the "housekeeping" amendment, an office action will be issued in due course.

3. All correspondence regarding these proceedings should be submitted as follows:

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

ERIC S. KEASEL
CRU SPE-AU 3992

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.
90/007,577	06/03/2005	5982921	586850000002	2061

26185 7590 03/04/2009
FISH & RICHARDSON P.C.
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/04/2009

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Douglas G. Hodder
Morrison & Foerster LLP
755 Page Mill Rd
Palo Alto, CA 94304-1018

MAILED

MAR 04 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/007,691. ; 90/007,577 ; 90/008,690

PATENT NO. 5,982,921.

ART UNIT 3992.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Applied Materials, Inc.
P.O. Box 450A
Santa Clara, CA 95052

(For Patent Owner)

Douglas G. Hodder
Morrison & Foerster LLP
755 Page Mill Road
Palo Alto, CA 94304-1018

(For Third Party Requester)

Robert A. Saltzberg
Morrison & Foerster LLP
425 Market Street
San Francisco, CA 94105

(For Third Party Requester)

In re Alumot *et alia*
Reexamination Proceeding
Control No. 90/007,577
Request Deposited: June 3, 2005
For: U.S. Patent No. 5,982,921

In re Alumot *et alia*
Reexamination Proceeding
Control No. 90/007,691
Request Deposited: August 22, 2005
For: U.S. Patent No. 5,982,921

In re Alumot *et alia*
Reexamination Proceeding
Control No. 90/008,690
Request Deposited: August 22, 2005
Corrected Request Deposited: July 20, 2007
For: U.S. Patent No. 5,982,921

DECISION DISMISSING PETITION TO WITHDRAW FINALITY UNDER 37 CFR 1.181

MAILED

MAR 04 2009

CENTRAL REEXAMINATION UNIT

This is a decision on the January 5, 2009, "PETITION UNDER 37 C.F.R §1.181 TO WITHDRAW FINALITY OF OFFICE ACTION".

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

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,982,921 (hereinafter, the '921 patent), issued to Alumot *et alia*, on November 9, 1999.

2. On June 3, 2005, a third party requester deposited a Request for *Ex Parte* Reexamination of the '921 patent. The reexamination proceeding was assigned Control No. 90/007,577 (hereinafter, the '7577 proceeding).

3. The Reexamination Order was granted in the '7577 proceeding on August, 17, 2005.

4. A non-final office action was mailed on January 10, 2007 in the '7577 proceeding.

5. A response and amendment to the claims was filed by Patent Owner on March 13, 2007.

6. On August 22, 2005, a third party deposited a Request for *Ex Parte* Reexamination of the '921 patent. The reexamination proceeding was assigned Control No. 90/007,577 (hereinafter, the '7691 proceeding).

7. The Reexamination Order was granted in the '7691 proceeding on September 30, 2005.

8. The '7577 and '7691 proceedings were merged on May 7, 2007.

9. A housekeeping amendment was filed on June 4, 2007 to maintain the same claims and specification in the merged '7577 and '7691 proceedings.

10. On July 20, 2007, a third party deposited a corrected Request for *Ex Parte* Reexamination of the '921 patent. The reexamination proceeding was assigned Control No. 90/008,690 (hereinafter, the '8690 proceeding).

11. The Reexamination Order was granted in the '8690 proceeding on August 22, 2007.

12. The '7577, '7691, and '8690 proceedings were merged on December 6, 2007.

13. A non-final rejection was mailed on February 7, 2008.

14. An amendment was timely filed on April 7, 2008.

15. A final rejection was mailed on August 5, 2008.

16. An after-final response was filed on August 13, 2008.

17. An advisory action was mailed on November 10, 2008.

18. A Notice of Appeal, a second after-final response, and the present petition were filed on January 5, 2009.

19. An advisory action was mailed on February 19, 2009 withdrawing 35 USC 305 rejections of claims 41-45, 47-49, 63-65 as well as other rejections.

20. On March 4, 2009, the office mailed a PTO-90C indicating that the 35 USC 305 rejections of claims 34-36, 46, and 56-58 were withdrawn.

DECISION

Patent Owner argues that the presence of a 35 USC 305 rejection of claims 34-36, 41-49, 56-58, and 63-65 in the office action mailed August 5, 2008 were not necessitated by the most current amendment. So, the office action can not properly be made final. In the advisory action mailed February 19, 2009 and the letter mailed March 4, 2009, all of the rejections in question (as well as others) have been withdrawn. It is noted that the rejection of claim 47 is withdrawn in the advisory action as indicated by claim 47 being indicated as patentable and/or confirmed in box 6 of the advisory. Since the underlying basis for the requested relief no longer exists, the petition is dismissed as moot and the office action mailed August 5, 2008 remains a final rejection.

CONCLUSION

1. Petitioner's request is **dismissed as moot**.

2. **All** correspondence relating to this *ex parte* reexamination proceeding should be directed:

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

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

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

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

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

3. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929.

Eric Keasel For

Gregory Morse
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Douglas G. Hodder
Morrison & Foerster LLP
755 Page Mill Rd
Palo Alto, CA 94304-1018

MAILED

MAR 04 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/007,691. ; 90/007,577 ; 90/008,690

PATENT NO. 5,982,921.

ART UNIT 3992.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,577	06/03/2005	5982921	586850000002	2061

26185 7590 03/04/2009
FISH & RICHARDSON P.C.
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/04/2009

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

Applied Materials, Inc.
P.O. Box 450A
Santa Clara, CA 95052

(For Patent Owner)

Douglas G. Hodder
Morrison & Foerster LLP
755 Page Mill Road
Palo Alto, CA 94304-1018

(For Third Party Requester)

Robert A. Saltzberg
Morrison & Foerster LLP
425 Market Street
San Francisco, CA 94105

(For Third Party Requester)

In re Alumot *et alia*
Reexamination Proceeding
Control No. 90/007,577
Request Deposited: June 3, 2005
For: U.S. Patent No. 5,982,921

In re Alumot *et alia*
Reexamination Proceeding
Control No. 90/007,691
Request Deposited: August 22, 2005
For: U.S. Patent No. 5,982,921

In re Alumot *et alia*
Reexamination Proceeding
Control No. 90/008,690
Request Deposited: August 22, 2005
Corrected Request Deposited: July 20, 2007
For: U.S. Patent No. 5,982,921

DECISION DISMISSING
PETITION FOR EXTENSION
OF TIME
UNDER 37 CFR 1.550

MAILED

MAR 04 2009

CENTRAL REEXAMINATION UNIT

This is a decision on the February 25, 2009, "REQUEST FOR EXTENSION OF TIME FOR RESPONSE PURSUANT TO 37 C.F.R 1.550" requesting that the time to submit a Patent Owner Appeal Brief be extended two months.

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

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,982,921 (hereinafter, the '921 patent), issued to Alumot *et alia*, on November 9, 1999.

2. On June 3, 2005, a third party requester deposited a Request for *Ex Parte* Reexamination of the '921 patent. The reexamination proceeding was assigned Control No. 90/007,577 (hereinafter, the '7577 proceeding).

3. The Reexamination Order was granted in the '7577 proceeding on August, 17, 2005.

4. A non-final office action was mailed on January 10, 2007 in the '7577 proceeding.

5. A response and amendment to the claims was filed by Patent Owner on March 13, 2007.

6. On August 22, 2005, a third party deposited a Request for *Ex Parte* Reexamination of the '921 patent. The reexamination proceeding was assigned Control No. 90/007,577 (hereinafter, the '7691 proceeding).

7. The Reexamination Order was granted in the '7691 proceeding on September 30, 2005.

8. The '7577 and '7691 proceedings were merged on May 7, 2007.

9. A housekeeping amendment was filed on June 4, 2007 to maintain the same claims and specification in the merged '7577 and '7691 proceedings.

10. On July 20, 2007, a third party deposited a corrected Request for *Ex Parte* Reexamination of the '921 patent. The reexamination proceeding was assigned Control No. 90/008,690 (hereinafter, the '8690 proceeding).

11. The Reexamination Order was granted in the '8690 proceeding on August 22, 2007.

12. The '7577, '7691, and '8690 proceedings were merged on December 6, 2007.

13. A non-final rejection was mailed on February 7, 2008.

14. An amendment was timely filed on April 7, 2008.

15. A final rejection was mailed on August 5, 2008.

16. An after-final response was filed on August 13, 2008.

17. An advisory action was mailed on November 10, 2008.

18. A Notice of Appeal, a second after-final response, and the present petition were filed on January 5, 2009.

19. An advisory action was mailed on February 19, 2009 withdrawing 35 USC 305 rejections of claims 41-45, 47-49, 63-65 as well as other rejections.

20. On February 25, 2009, the present petition was filed.

DECISION

The Patent Owner requests an extension of time in which to file a Patent Owner Appeal Brief. The present petition for extension of time was timely filed on February 25, 2009.

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 must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.

Analysis and Findings

Initially, it noted that Patent Owner states "[n]o fee is believed to be due". However, 37 CFR §1.550(c) clearly states

> Any request for such extension must be accompanied by the petition fee set forth in § 1.17(g).

An authorization to charge Deposit Account No. 06-1050 is given in the petition. Accordingly, the required fee has been applied to said Deposit Account No.

The petition lacks a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and why, in spite of the action taken thus far, the requested additional time is needed.

The present petition notes that a petition filed January 5, 2009 has not yet been decided as of the filing date of the present petition. Petitioner attention is directed to 37 CFR 1.181(f), which states, in part, "[t]he 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."

CONCLUSION

1. Petitioner's request is **dismissed**.

2. **All** correspondence relating to this *ex parte* reexamination proceeding should be directed:

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

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

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

By hand: Customer Service Window

Randolph Building
401 Dulany Street
Alexandria, VA 22314

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

3. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929.

Eric Keasel for

Gregory Morse
Director, Central Reexamination Unit

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Commissioner for Patents
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MAILED

JUL 3 1 2007

CENTRAL REEXAMINATION UNIT

DAVID M. GESHWIND
PRESIDENT, THREE DIMENSIONAL MEDIA GROUP
TWO LINCOLN SQUARE, SUITE 36-J
NEW YORK, NY 10023

In re Application of	:	
DAVID M. **GESHWIND**	:	
Control No. 90/007,578 (U.S. Patent 4,925,294)	:	DECISION ON PETITION
Filed: JUNE 09, 2005	:	TO WITHDRAW
Attorney Docket No.	:	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 July 30, 2007.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a).

The request was signed by Ognjan V. Shentov on behalf of all attorneys of record who are associated with Customer No. 20583. All attorneys/agents associated with the Customer No. 20583 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 Manuel Saldana at 571-272-7740.

Manuel Saldana
for
Mark Reinhart
Supervisory Patent Examiner
CRU 3992

cc: **DAVID M. GESHWIND**
111 FOURTH AVENUE
NEW YORK, NY 10003

cc: **WHITE & CASE LLP** (Third Party Requester)
ATTN: Heidi Keefe
3000 EL CAMINO REAL
5 PALO ALTO SQ. 10TH FL
PALO ALTO, CA 94306

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on July 30, 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
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SEP 01 2007

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 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. 90/007,581
Filed: June 10, 2005
For: US Patent No. 5,214,356

This is a decision on the May 24, 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 March 26, 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 March 26, 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 May 24, 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 March 26, 2007 is **granted**.

2. The Patent Owner's response is due **June 26, 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

CONNOLLY BOVE LODGE & HUTZ LLP
(FOR IBM RALEIGH)
P.O. BOX 2207
WILMINGTON DE 19899-2207

(For Patent Owner)

MAILED

MAY 16 2008

CENTRAL REEXAMINATION UNIT

DECISION GRANTING-IN-PART
PETITION FOR EXTENSION OF TIME
[37 CFR § 1.550(c)]

In re: Babin
Ex Parte Reexamination Proceeding
Control No. 90/007,582
Depositied: 10 June 2005
For: US Patent No. 6,411,517

This is a decision on the 12 May 2008, petition for "Extension of Time Under to 37 CFR § 1.550 (c)," requesting that the be extended by an additional month.

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

The petition is granted in part extending the time for response by seven-days for the reasons set forth below.

Background

1. The final action was mailed on 14 January 2008 setting a shortened statutory response time of two months.

2. The Notice of Appeal was filed on 13 March 2008.

Decision

The Patent Owner requests an extension of time in which to file a response to the Notice of Appeal, which set a two month date for filing a Brief thereto. The petition for extension of time was timely filed on 12 May 2008, together with the $200.00 petition fee required by 37 CFR § 1.515(c).

MPEP 2274 Appeal Brief

> ...
>
> II. TIME FOR FILING APPEAL BRIEF
>
> The time for filing the appeal brief is 2 months from the date of the appeal.

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" supports granting-in-part a brief extension of time. The Patent Owner requests one-month but has only provided support for "sufficient cause" in that the Patent Owner has not yet received the response to the after final amendment. Since an advisory action addressing the patent owner's after final

amendment was mailed on 12 May 2008, the sufficient cause requirement is on met for a very brief extension of time. The request for extension of time for a period of seven-days is hereby granted-in-part.

The petition request is **Granted-in-Part**.

Conclusion

1. The patent owner's petition for extension of one-month time in which to file an appeal brief is **granted in part**.

2. The time for response is extended by seven days.

3. The Patent Owner's appeal brief is due **20 May 2008**.

4. 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, at 571-272-1611, or Eric Keasel at 571-272-4929, Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992.

MARK J. REINHART
CRU SPE-AU 3992

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

Kenneth L. Cage
McDermott Will & Emery LLP
600 13th Street, N.W.
Washington, DC 20005-3096

FOR PATENT OWNER

MAILED

SEP 07 2007

CENTRAL REEXAMINATION UNIT

David L. McCombs
Haynes & Boone, LLP
901 Main Street, Suite 3100
Dallas, Texas 75202

FOR THIRD PARTY REQUESTER

In re Craig Hansen et al.
Reexamination Proceeding
Control No. 90/007,583
Filed: June 13, 2005
For: U.S. Patent No. 5,742,840

DECISION ON REQUEST UNDER 37 CFR § 1.550(C) FOR EXTENSION OF TIME

This is a decision on a request for an extension of time under 37 CFR § 1.550(c) filed August 31, 2007. This submission requests a one-month extension until October 9, 2007 to respond to the Office action of August 9, 2007.

Jurisdiction of this request is before the Office of Patent Legal Administration in order to expedite the treatment of the matter.

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 sets forth sufficient cause and indicates a situation beyond the ordinary in which the owner would have difficulty in responding within the period set forth in the Office action. The request also includes authorization to charge any necessary fees to Deposit Account No. 500417. The requisite fee of $200 as set forth in 37 CFR §1.17(g) has been charged to the aforementioned Deposit Account.

Accordingly, the request is **GRANTED**.

The Owner's response to the Office action of August 9, 2007 is due on or before October 9, 2007. The Owner is reminded of the requirement under 35 U.S.C. § 305 to conduct reexamination proceedings with special dispatch.

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 571-272-7735.

Robert A. Clarke

Robert A. Clarke, Director
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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P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,583	06/13/2005	5742840	33142.8	5167

20277 7590 10/29/2009

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/29/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
David L. McCombs
HAYNES AND BOONE, LLP, IP Section
2323 Victory Avenue, Suite 700
Dallas, TX 75219

Date:
MAILED
OCT 29 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007583
PATENT NO. : 5742840
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
qAlexandria, VA 22313-1450
www.uspto.gov

Eric M Shelton MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON DC 20005-3096	:	(For Patent Owner)
David L McCombs HAYNES AND BOONE, LLP IP SECTION 2323 VICTORY AVENUE SUITE 700 DALLAS, TX 75219	:	(For Third Party Requester)

MAILED

OCT 29 2009

CENTRAL REEXAMINATION UNIT

In re: Hansen *et alia* *Ex Parte* Reexamination Proceeding Control No. 90/007,583 Deposited: 13 June 2005 For: US Patent No. 5,742,840	:	DECISION GRANTED PETITION FOR EXTENSION OF TIME [37 CFR §§ 1.550(c) & 1.181]

This is a decision on the 23 October 2009, "Request for Extension of Time Under 37 CFR § 1.550(c)" requesting that the time for responding to the Final Office action mailed 24 July 2009, be extended by one (1) month extension of time. The petition was timely filed on 23 October 2009. The petition included the required petition fee pursuant to 37 CFR § 1.17(g) and certificate of service.

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

The petition is GRANTED for the reasons set forth below.

DISCUSSION

The Patent Owner requests the period of time to be extended in which to file a response to the Final Office action mailed 24 July 2009. The petition for extension of time was timely filed on 23 October 2009 with appropriate fee according to 37 CFR § 1.17(g).

The extension of time is granted.

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. ...

MPEP 2265 (in-part)

> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
>
> ...
>
> I. FINAL REJECTION — TIME FOR RESPONSE
> The statutory period for response to a final rejection in a reexamination proceeding will normally be two (2) months. If a response to the final rejection is filed, the time period set in the final rejection continues to run. The time period is automatically extended by 1 month (in accordance with the guidelines set forth in MPEP § 2265) if the response is the first response after the final rejection and a notice of appeal has not yet been filed.

Any advisory Office action using form PTOL-467, Ex Parte Reexamination Advisory Action Before the Filing of an Appeal Brief, which is issued in reply to patent owner's response after final rejection (and prior to the filing of the notice of appeal) will inform the patent owner of the automatic 1 month extension of time. It should be noted that the filing of any timely first response to a final rejection (even an informal response or even a response that is not signed) will automatically result in the extension of the shortened statutory period for an additional month. 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).

ANALYSIS AND FINDINGS

The patent owner's representative petitions to extend the period for response by adding one (1) month to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The petitioner has demonstrated "sufficient cause" for granting the extension of time. The petitioner articulates 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. There is "sufficient cause" for granting the extension of time.

Additionally, it is noted that the filing of any timely first response to a final rejection will automatically result in the extension of the shortened statutory period for an additional month.

The petition request to extend the response time is hereby granted.

CONCLUSION

1. The patent owner's petition for extension of time is hereby **granted.**

2. The time for response is extended by one (1) month.

3. The Patent Owner's response is due **24 November 2009.**

4. Response and/or submissions to the Office should be addressed 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
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401 Dulany Street
Alexandria, VA 22314

By EFS: Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

5. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, in the event that Mark Reinhart is unavailable Eric Keasel at (571)

272-4929, or Jessica Harrison at (571) 272-4449; all are Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992 may also be contacted..

/Mark Reinhart/
for

Gregory Morse
Director,
Central Reexamination Unit 3999

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.
90/007,583	06/13/2005	5742840	33142.8	5167

20277 7590 12/23/2009

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/23/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
David L. McCombs
HAYNES AND BOONE, LLP, IP Section
2323 Victory Avenue, Suite 700
Dallas, TX 75219

Date: MAILED

DEC 23 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007583
PATENT NO. : 5742840
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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Eric M Shelton MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON DC 20005-3096	:	(For Patent Owner)
David L McCombs HAYNES AND BOONE, LLP IP SECTION 2323 VICTORY AVENUE SUITE 700 DALLAS, TX 75219	:	(For Third Party Request)

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DEC 23 2009

CENTRAL REEXAMINATION UNIT

In re: Hansen *et alia* *Ex Parte* Reexamination Proceeding Control No. 90/007,583 Deposited: 13 June 2005 For: US Patent No. 5,742,840	:	DECISION GRANTED PETITION FOR EXTENSION OF TIME [37 CFR §§ 1.550(c) & 1.181]

This is a decision on the 17 December 2009, "Request for Extension of Time Under 37 CFR § 1.550(c)" requesting that the time for responding to the Final Office action mailed 24 July 2009, be further extended by one (1) month extension of time. The petition was timely filed on 17 December 2009. The petition included the required petition fee pursuant to 37 CFR § 1.17(g) and certificate of service.

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

The petition is GRANTED for the reasons set forth below.

DISCUSSION

The Patent Owner requests the period of time to be extended in which to file a response to the Final Office action mailed 24 July 2009. The petition for extension of time was timely filed on 17 December 2009 with appropriate fee according to 37 CFR § 1.17(g).

The extension of time is granted.

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. ...

MPEP 2265 (in-part)

> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
>
> ...

I. FINAL REJECTION — TIME FOR RESPONSE

The statutory period for response to a final rejection in a reexamination proceeding will normally be two (2) months. If a response to the final rejection is filed, the time period set in the final rejection continues to run. The time period is automatically extended by 1 month (in accordance with the guidelines set forth in MPEP § 2265) if the response is the first response after the final rejection and a notice of appeal has not yet been filed.

Any advisory Office action using form PTOL-467, Ex Parte Reexamination Advisory Action Before the Filing of an Appeal Brief, which is issued in reply to patent owner's response after final rejection (and prior to the filing of the notice of appeal) will inform the patent owner of the automatic 1 month extension of time. It should be noted that the filing of any timely first response to a final rejection (even an informal response or even a response that is not signed) will automatically result in the extension of the shortened statutory period for an additional month. 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).

ANALYSIS AND FINDINGS

The patent owner's representative petitions to extend the period for response by further adding one (1) month to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The petitioner has demonstrated "sufficient cause" for granting the extension of time. The petitioner articulates that the time is needed to properly prepare an amendment putting previously found patentable limitations into an independent claim. While second extensions are generally only permitted in extraordinary circumstances, the amendment submitted with the petition, which is timely, notes that there was claim language was found to be patentable in an examiner's interview, not yet of record. To preserve the rights for appeal and to allow the examiner time to consider this amendment, the period for response should be further extended by one month. There is "sufficient cause" for granting the extension of time.

The petition request to extend the response time is hereby granted.

CONCLUSION

1. The patent owner's petition for extension of time is hereby **granted.**

2. The time for response is further extended by one (1) month.

3. The Patent Owner's response is due **24 January 2010.**

4. Response and/or submissions to the Office should be addressed 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
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5. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, in the event that Mark Reinhart is unavailable Eric Keasel at (571) 272-4929, or Jessica Harrison at (571) 272-4449; all are Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992 may also be contacted..

/Mark Reinhart/

Mark Reinhart,
Supervisory Patent Examiner,
AU 3992,
Central Reexamination Unit
571-272-1611

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

Arnold & Ferrera, L.L.P.
2401 Fountain View Drive
Suite 630
Houston, TX 77057

(For Patent Owner)

DEC 23 2005

Kenneth L. Nash
P.O. Box 680106
Houston, TX 77268-0106

(For Patent Owner)

Janelle D. Waack
Howrey LLP
750 Bering Drive
Houston, TX 77057

(For 3rd Party Requester)

Reexam Control No.: 90/007,349
Filed : December 21, 2004
For U.S. Patent No. : 6,401,824

Reexam Control No.: 90/007,585
Filed : June 13, 2005
For U.S. Patent No. : 6,401,824

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. 90/007,349 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
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Arnold & Ferrera, L.L.P.
2401 Fountain View Drive
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(For Patent Owner)

DEC 2 2 2005

Kenneth L. Nash
P.O. Box 680106
Houston, TX 77268-0106

(For Patent Owner)

Janelle D. Waack
Howrey LLP
750 Bering Drive
Houston, TX 77057

(For 3rd Party Requester)

Reexam Control No.: 90/007,350
Filed : December 21, 2004
For U.S. Patent No. : 6,679,336

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexam Control No.: 90/007,586
Filed : June 13, 2005
For U.S. Patent No. : 6,679,336

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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Douglas N. Larson, Esq.
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1900 Avenue of the Stars, 7th Floor
Los Angeles, CA 90067-4308

(For Patent Owner)

Douglas S. Foote
1700 S. Patterson Boulevard
Dayton, OH 47479-0001

(For 3rd Party Requester)

In re	: Ghanshyam H. Popat
Reexamination Proceeding	
Control No.	: 90/007,590
Filed	: June 16, 2005
For U.S. Patent No.	: 5,853,837

DECISION ON PETITION

The above noted *ex parte* reexamination proceeding is before the Director of the Central Reexamination Unit for consideration of petition styled as a Petition for Entry of Supplemental Amendment and Declaration filed December 26, 2006. The petition seeks to have a supplemental amendment and 37 1.132 declaration filed December 26, 2006 entered.

The petition is hereby dismissed as being moot.

A non-final Office action was mailed March 14, 2006. A first response to the Office action was received June 14, 2006. An interview was held November 14, 2006. On December 26, 2006 the instant petition along with the amendment sought to be entered were filed.

The examiner in charge of the instant reexamination proceeding has determined that entry of the supplemental amendment is in order, has considered the amendment along with the 37 CFR 1.132 declaration that accompanied the amendment as well as the additional supplemental amendment that was filed March 19, 2007, and has issued a new Office action, which action is being concurrently mailed with the instant decision.

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

Andrea Koshumbaw

Lissi Mojica-Marquis,
Director,
Central Reexamination Unit

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MAILED
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CENTRAL REEXAMINATION UNIT

In re Reissue Application of: Popat
Application No. 11/847,259
Filed: Aug. 29, 2007
For: U.S. Patent No. 5,853,837

In re Popat
Reexamination Proceeding
Control No. 90/007,590
Filed: June 16, 2005
For: U.S. Patent No. 5,853,837

DECISION ON PETITION UNDER 37 CFR 1.182 TO MERGE REISSUE AND REEXAMINATION PROCEEDINGS

This is a decision on the Aug. 30, 2007 patent owner petition under 1.182 to (1) merge the above-captioned reissue and reexamination proceedings and to (2) waive the MPEP 1441 two month examination delay under 37 CFR 1.182.

The petition is 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. 5,853,837 (the '837 patent) issued on Dec. 29, 1998, with 49 claims.

2. A request for reexamination of the '837 patent was filed by a third party requester on June 16, 2005, and was assigned control No. 90/007,590 (the '590 proceeding).

3. Reexamination was ordered for the '590 proceeding on Aug. 18, 2005.

4. No patent owner statement was filed, and the period for filing such statement has expired.

5. Two non-final Office Actions have been issued in the '590 proceeding. The claims have been amended (i.e., the patent claims have been canceled and new claims have been added) in the '590 proceeding.

6. An application for reissue of the '837 patent, assigned application No. 11/847,259 (the '259 application), was filed by the patent owner on Aug. 29, 2007.

7. The claims have been amended (i.e., the patent claims have been canceled and new claims have been added) in the '259 application.

8. On Aug. 30, 2007, the present petition under 37 CFR 1.182 was filed by the patent owner in the '590 proceeding requesting merger of the reissue application and reexamination proceeding and requesting a waiver of the MPEP 1441 two month examination delay in the reissue application.

9. A notice of concurrent proceedings was filed by the patent owner on Aug. 30, 2007, in the '590 proceeding informing the Office of the '259 reissue application.

10. The filing of the '259 reissue application was announced in the *Official Gazette* on October 16, 2007.

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. 11/847,259 and reexamination control No. 90/007,590 are currently pending. The order to reexamine has been mailed in the reexamination proceeding, and a petition to waive the two month delay in the reissue application has been filed concurrently herewith. Accordingly, a decision under 37 CFR 1.565(d) is timely.

The general policy of the Office is that a reissue application examination and a reexamination proceeding will not be conducted separately, and at the same time, as to a particular patent. The reason for this policy is to prevent inconsistent, and possibly

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

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

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

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

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

II. Requirement for Same Amendments in Both Proceedings

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

2. A review of the file for reexamination control No. 90/007,590 shows:

   (a) Original patent claims 1-49 have been canceled.

   (b) New claims 317-658 have been entered by amendment made on June 7, 2007.

A review of reissue application No. 11/847,259 shows:

(a) Original patent claims 1-49 have been canceled.

(b) New claims 50-188 have been added by amendment on Aug. 29, 2007.

At least claims 317-658 in the reexamination proceeding are not identical to the claims in the reissue application. **Accordingly, the claims are not identical in both proceedings.**

An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision, placing the same amendments in both proceedings, specifically, Application No. 11/847,259 and Control No. 90/007,590. The response to this requirement must be limited to formally placing the same amendments in all cases, and patent owner must **not** address any issue of patentability in the housekeeping amendment. It is to be noted that, pursuant to MPEP 2285, amendments in a merged reexamination/reissue proceeding are submitted under 37 CFR 1.173, in accordance with reissue practice.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

IV. <u>Waiver of the Two Month Delay Period for the Reissue Application</u>

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

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

pertinent information is submitted in the form of a protest under 37 CFR 1.291(a)."

In the present instance, action would not be taken by the Office for the reissue application until two months from the announcement date in the *Official Gazette*, and action in the copending reexamination proceeding would be delayed accordingly. Waiver of the 2-month delay provision of MPEP 1441 is appropriate in view of the facts and circumstances in the present instance, taken with the statutory requirement that the '590 reexamination proceeding be conducted with special dispatch within the Office, pursuant to 35 U.S.C. 305, to resolve the substantial new question of patentability for the public and the parties. The two-month delay period is therefore waived under 37 CR 1.182, and the present merger decision is being issued at this time.

The present action taken by the Office does not close or remove the public's opportunity to protest the reissue application. Should a protest be filed in this application within two months from the date of the *Official Gazette* announcement, the examiner is instructed to proceed according to the provisions of 37 CFR 1.291, as well as MPEP §§ 1901.04 and 1901.06.

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

CONCLUSION

1. The petition requesting merger is granted. The petition requesting waiver of the two month examination delay in the reissue application is granted.

2. Reissue application No. 11/847,259 and reexamination control No. 90/007,590 **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 1700, in which the reissue proceeding is assigned. The examiner assigned the merged proceeding is not to be one who

was involved in any part of the examination of the '837 patent (e.g., by preparing/signing an action). See MPEP 2236.

5. The examiner should not issue an Office action for the present merged proceeding until after the earlier of:

   (A) The expiration of the one month period from the mailing of this decision for the filing of the required housekeeping amendment, or

   (B) The receipt of the required amendment paper.

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 Caroline Dennison, Legal Advisor, at (571) 272-7729.

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

cdd

November 19, 2007
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CENTRAL REEXAMINATION UNIT

STEVEN C. SEREBOFF
SoCAL IP LAW GROUP LLP
310 N. WESTLAKE BLVD. STE 120
WESTLAKE VILLAGE, CA 91362

In re Application of	:	
POPAT, GHANSHYAM H.	:	
Control No. 90/007,590 (US PAT 5,853,837)	:	DECISION ON PETITION
Filed: June 16, 2005	:	TO WITHDRAW
Attorney Docket No. A019-P08314US	:	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 28, 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 Steven C. Sereboff on behalf of all attorneys of record who are associated with customer No. 33356.

All attorneys/agents associated with the Customer Number 33356 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 first copied 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: DOUGLAS N. LARSON
24772 SADDLE PEAK ROAD
MALIBU, CA 90265-3042

cc: DOUGLAS S. FOOTE, ESQ. (Third Party Requester)
NCR CORPORATION
1700 S. PATTERSON BLVD. WHQ5E
WHO-5E
DAYTON, OH 45479

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on January 28, 2009. There is no indication it was served on the Third Party Requester.

Substitute 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 No.	90/007,590
	Filing Date	6/16/2005
	Patent/Registration No.	5,853,837
	Grant Date	12/29/1998
	Inventor/Owner	Popat
	Attorney Docket No.	A019-P08314US

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: 33356

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:

☐ 10.40(b)(1) ☐ 10.40(b)(2) ☐ 10.40(b)(3) ☒ 10.40(b)(4): The practitioner is discharged by the client.
☐ 10.40(c)(1)(i) ☐ 10.40(c)(1)(ii) ☐ 10.40(c)(1)(iii) ☐ 10.40(c)(1)(iv)
☐ 10.40(c)(1)(v) ☐ 10.40(c)(1)(vi) ☐ 10.40(c)(2) ☐ 10.40(c)(3)
☐ 10.40(c)(4) ☐ 10.40(c)(5) ☐ 10.40(c)(6)

Certifications

Check each box below that is factually correct. WARNING: If a box is left unchecked, the request will likely not be approved.

1. ☒ I/We have given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intend to withdraw from employment.

2. ☒ I/We have delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled.

3. ☒ I/We have notified the client of any responses that may be due and the time frame within which the client must respond.

Please provide an explanation, if necessary:

CORRESPONDENCE ADDRESS

1. ☐ The correspondence address is NOT affected by this withdrawal.
2. ☒ Change the correspondence and address and direct all future correspondence to:
   - ☐ The address associated with Customer Number:

OR

☒ Firm/Individual Name	Douglas N. Larson				
Address	24772 Saddle Peak Road				
City	Malibu	State	CA	Zip	90265-3042
Country	US				
Telephone	310-317-4466	Email			

I am authorized to sign on behalf of myself and all withdrawing practitioners.

Signature	/Steven C. Sereboff/		
Name	Steven C. Sereboff	Registration No.	37035
Date	January 28, 2009	Telephone No.	805-230-1350

NOTE: Withdrawal is effective when approved rather that when received. Unless there are 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.

c

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.

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Douglas N. Larson, Esq.
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1900 Avenue of the Stars, 7th Floor
Los Angeles, CA 90067-4308

(For Patent Owner)

Douglas S. Foote
1700 S. Patterson Boulevard
Dayton, OH 47479-0001

(For 3rd Party Requester)

In re	: Ghanshyam H. Popat
Reexamination Proceeding	
Control No.	: 90/007,591
Filed	: June 16, 2005
For U.S. Patent No.	: 5,993,928

DECISION ON PETITION

The above noted *ex parte* reexamination proceeding is before the Director of the Central Reexamination Unit for consideration of petition styled as a Petition for Entry of Supplemental Amendment and Declaration filed December 26, 2006. The petition seeks to have a supplemental amendment and 37 1.132 declaration filed December 26, 2006 entered.

The petition is hereby dismissed as being moot.

A non-final Office action was mailed March 7, 2006. A first response to the Office action was received June 27, 2006. An interview was held November 14, 2006. On December 26, 2006 the instant petition along with the amendment sought to be entered were filed.

The examiner in charge of the instant reexamination proceeding has determined that entry of the supplemental amendment is in order, has considered the amendment along with the 37 CFR 1.132 declaration that accompanied the amendment as well as the additional supplemental amendment that was filed March 19, 2007, and has issued a new Office action, which action is being concurrently mailed with the instant decision.

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

Andrew Koshuchow

for Lissi Mojica Marquis,
Director,
Central Reexamination Unit

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CENTRAL REEXAMINATION UNIT

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Los Angeles, CA 90067-4308 (For Patent Owner)

Douglas S. Foote, Esq.
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Dayton, OH 45479 (For Requester)

In re Reissue Application of: Popat
Application No. 11/847,264
Filed: Aug. 29, 2007
For: U.S. Patent No. 5,993,928

In re Popat
Reexamination Proceeding
Control No. 90/007,591
Filed: June 16, 2005
For: U.S. Patent No. 5,993,928

DECISION ON PETITION UNDER 37 CFR 1.182 TO MERGE REISSUE AND REEXAMINATION PROCEEDINGS

This is a decision on the Aug. 30, 2007 patent owner petition under 1.182 to (1) merge the above-captioned reissue and reexamination proceedings and to (2) waive the MPEP 1441 two month examination delay under 37 CFR 1.182.

The petition is 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. 5,993,928 (the '928 patent) issued on Nov. 30, 1999, with 34 claims.

2. A request for reexamination of the '928 patent was filed by a third party requester on June 16, 2005, and was assigned control No. 90/007,591 (the '591 proceeding).

3. Reexamination was ordered for the '591 proceeding on Aug. 18, 2005.

4. No patent owner statement was filed, and the period for filing such statement has expired.

5. Two non-final Office Actions have been issued in the '591 proceeding. The claims have been amended in the '591 proceeding.

6. An application for reissue of the '928 patent, assigned application No. 11/847,264 (the '264 application), was filed by the patent owner on Aug. 29, 2007.

7. The claims have been amended in the '264 application.

8. On Aug. 30, 2007, the present petition under 37 CFR 1.182 was filed by the patent owner in the '591 proceeding requesting merger of the reissue application and reexamination proceeding and requesting a waiver of the MPEP 1441 two month examination delay in the reissue application.

9. A notice of concurrent proceedings was filed by the patent owner on Aug. 31, 2007, in the '591 proceeding informing the Office of the '264 reissue application.

10. The filing of the '264 reissue application has not yet been announced in the *Official Gazette*.

DISCUSSION REGARDING MERGER

Under 37 CFR 1.565(d):

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

As evidenced by the above review of facts, reissue application No. 11/847,264 and reexamination control No. 90/007,591 are currently pending. The order to reexamine has been mailed in the reexamination proceeding, and a petition to waive the two month delay in the reissue application has been filed concurrently herewith. Accordingly, a decision under 37 CFR 1.565(d) is timely.

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

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

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

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

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

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

II. Requirement for Same Amendments in Both Proceedings

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

2. A review of the file for reexamination control No. 90/007,591 shows:

   (a) Original patent claims 1-34 have been canceled.

   (b) New claims 334-833 have been entered by amendment made on June 7, 2007.

   A review of reissue application No. 11/847,264 shows:

(a) Original patent claims 1-34 have been canceled.

(b) New claims 35-113 have been added by amendment on Aug. 29, 2007.

At least claims 114-833 in the reexamination proceeding are not identical to the claims in the reissue application. **Accordingly, the claims are not identical in both proceedings.**

An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision, placing the same amendments in both proceedings, specifically, Application No. 11/847,264 and Control No. 90/007,591. The response to this requirement must be limited to formally placing the same amendments in all cases, and patent owner must **not** address any issue of patentability in the housekeeping amendment. It is to be noted that, pursuant to MPEP 2285, amendments in a merged reexamination/reissue proceeding are submitted under 37 CFR 1.173, in accordance with reissue practice.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

pertinent information is submitted in the form of a protest under 37 CFR 1.291(a)."

In the present instance, once the reissue application is announced in the *Official Gazette*, action would not be taken by the Office for the reissue application until two months from the announcement date, and action in the copending reexamination proceeding would be delayed accordingly. Waiver of the 2-month delay provision of MPEP 1441 is appropriate in view of the facts and circumstances in the present instance, taken with the statutory requirement that the '591 reexamination proceeding be conducted with special dispatch within the Office, pursuant to 35 U.S.C. 305, to resolve the substantial new question of patentability for the public and the parties. The two-month delay period is therefore waived under 37 CR 1.182, and the present merger decision is being issued at this time.

The present action taken by the Office does not close or remove the public's opportunity to protest the reissue application. Should a protest be filed in this application within two months from the date of the *Official Gazette* announcement, the examiner is instructed to proceed according to the provisions of 37 CFR 1.291, as well as MPEP §§ 1901.04 and 1901.06.

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

CONCLUSION

1. The petition requesting merger is granted. The petition requesting waiver of the two month examination delay in the reissue application is granted.

2. Reissue application No. 11/847,264 and reexamination control No. 90/007,591 **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 1700, in which the reissue proceeding is

assigned. The examiner assigned the merged proceeding is not to be one who was involved in any part of the examination of the '928 patent (e.g., by preparing/signing an action). See MPEP 2236.

5. The examiner should not issue an Office action for the present merged proceeding until after the earlier of:

   (A) The expiration of the one month period from the mailing of this decision for the filing of the required housekeeping amendment, or

   (B) The receipt of the required amendment paper.

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 Caroline Dennison, Legal Advisor, at (571) 272-7729.

Kenneth M. Schor

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

cdd

October 2, 2007
C:\kiva\kenpetmerger\7591petition_grant_merge_waive-2-month-per.cdd.doc

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MAR 05 2009

CENTRAL REEXAMINATION UNIT

Steven C. Sereboff
SoCAL IP LAW GROUP LLP
310 N. WESTLAKE BLVD. STE 120
WESTLAKE VILLAGE, CA 91362

In re Application of	:	
POPAT, GHANSHYAM H.	:	
Control No. 90/007,591 (US PAT 5,993,928)	:	DECISION ON PETITION
Filed: June 16, 2005	:	TO WITHDRAW
Attorney Docket No. A019-P08317US	:	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 28, 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 Steven C. Sereboff on behalf of all attorneys of record who are associated with customer No. 33356.

All attorneys/agents associated with the Customer Number 33356 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.

PVolpe for

Andres Kashnikow
Supervisory Patent Examiner
CRU 3993

cc: DOUGLAS N. LARSON
24772 SADDLE PEAK ROAD
MALIBU, CA 90265-3042

cc: DOUGLAS S. FOOTE, ESQ. (Third Party Requester)
1700 S. PATTERSON BLVD
DAYTON, OH 45479

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on January 28, 2009. There is no indication it was served on the Third Party Requester.

Substitute 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 No.	90/007,591
	Filing Date	6/15/2005
	Patent/Registration No.	5993928
	Grant Date	
	Inventor/Owner	Popat
	Attorney Docket No.	A019-P08317US

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: 33356

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:

☐ 10.40(b)(1)	☐ 10.40(b)(2)	☐ 10.40(b)(3)	☒ 10.40(b)(4): The practitioner is discharged by the client.
☐ 10.40(c)(1)(i)	☐ 10.40(c)(1)(ii)	☐ 10.40(c)(1)(iii)	☐ 10.40(c)(1)(iv)
☐ 10.40(c)(1)(v)	☐ 10.40(c)(1)(vi)	☐ 10.40(c)(2)	☐ 10.40(c)(3)
☐ 10.40(c)(4)	☐ 10.40(c)(5)	☐ 10.40(c)(6)	

Certifications

Check each box below that is factually correct. WARNING: If a box is left unchecked, the request will likely not be approved.

1. ☒ I/We have given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intend to withdraw from employment.

2. ☒ I/We have delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled.

3. ☒ I/We have notified the client of any responses that may be due and the time frame within which the client must respond.

Please provide an explanation, if necessary:

CORRESPONDENCE ADDRESS

1. ☐ The correspondence address is NOT affected by this withdrawal.
2. ☒ Change the correspondence and address and direct all future correspondence to:
   - ☐ The address associated with Customer Number:

OR

☒ Firm/Individual Name	Douglas N. Larson				
Address	24772 Saddle Peak Road				
City	Malibu	State	CA	Zip	90265-3042
Country	US				
Telephone	310-317-4466	Email			

I am authorized to sign on behalf of myself and all withdrawing practitioners.

Signature	/Steven C. Sereboff/		
Name	Steven C. Sereboff	Registration No.	37035
Date	January 28, 2009	Telephone No.	805-230-1350

NOTE: Withdrawal is effective when approved rather that when received. Unless there are 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.

c

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.

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FEB 03 2009

CENTRAL REEXAMINATION UNIT

Steven C. Sereboff
SoCAL IP LAW GROUP LLP
310 N. WESTLAKE BLVD. STE 120
WESTLAKE VILLAGE, CA 91362

In re Application of	:	
POPAT, GHANSHYAM H.	:	
Control No. 90/007,592 (US PAT 5,997,680)	:	DECISION ON PETITION
Filed: June 16, 2005	:	TO WITHDRAW
Attorney Docket No. A019-P08048US	:	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 28, 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 Steven C. Sereboff on behalf of all attorneys of record who are associated with customer No. 33356.

All attorneys/agents associated with the Customer Number 33356 have been withdrawn.

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

The request to change the correspondence address 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 or the assignee of the entire interest at the first copied address below until otherwise properly notified by the applicant

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

PVolpe for

Andres Kashnikow
Supervisory Patent Examiner
CRU 3993

cc: GHANSHYAM H. POPAT
1365 BRISTOL
ALTA LOMA, CA 91737

cc: DOUGLAS S. FOOTE, ESQ. (Third Party Requester)
1700 S. PATTERSON BLVD
DAYTON, OH 45479

cc: DOUGLAS N. LARSON
24772 SADDLE PEAK ROAD
MALIBU, CA 90265-3042

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on January 28, 2009. There is no indication it was served on the Third Party Requester.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,594	06/17/2005	5838758	25960-023	6302

7590 05/18/2010

EXAMINER

Randy J. Pritzker, Esq.
WOLF GREENFIELD & SACKS P.C.
Federal Reserve Plaza
600 Atlantic Avenue
Boston, MA 02210

ART UNIT	PAPER NUMBER

DATE MAILED: 05/18/2010

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

C. Eric Schulman
Mintz, Levin, Cohn, Ferris, Glovsky & Popeo PC
One Financial Center
Boston, MA 02111

MAILED
MAY 18 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/007,594*.

PATENT NO. *5838758*.

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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COMMISSIONER FOR PATENTS
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Randy Pritzker, Esq.
Wolf, Greenfield & Sacks, P.C.
Federal Reserve Plaza
600 Atlantic Avenue
Boston, MA 02210

(For Patent Owner)

MAILED

MAY 18 2010

CENTRAL REEXAMINATION UNIT

C. Eric Schulman
Mintz, Levin, Cohn, Ferris, Glovsky
and Popeo P.C.
One Financial Center
Boston, MA 02111

(Third Party Requester)

In re Kristoph D. Krug et al.
Ex Parte Reexamination Proceeding
Control No. 90/007,594
Filed: June 17, 2005
For: U.S. Patent No. 5,838,758

: **DECISION**
: **GRANTING**
: **PETITION UNDER**
: **37 CFR 1.137(b)**

This is a decision on the March 31, 2010 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to final Office action and revive the present terminated reexamination[1] ("the March 31, 2010 patent owner petition to revive").

The March 31, 2010 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The March 31, 2010 patent owner petition to revive is **granted**.

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 ...

[1] 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 December 18, 2009.

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 and paid the corresponding fee of $540.00 on March 31, 2010, thereby satisfying item (1).[2]

A petition fee of $1,620.00 and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the March 31, 2010 patent owner petition to revive, which satisfy items (2) and (3), respectively.

The present proceeding is a reexamination proceeding; thus, the petition does not require a terminal disclaimer.[3]

Accordingly, the March 31, 2010 patent owner petition to revive is **granted**.

CONCLUSION

1. The March 31, 2010 patent owner petition to revive under 37 CFR 1.137(b) is **granted**.

2. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit (CRU), Art Unit 3992, for treatment of the March 31, 2010 Notice of Appeal.

3. 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).

---

[2] *See*: MPEP 2268(IV) and MPEP 711.03(c)(II)(A)(2)(b).
[3] *See*: 37 CFR 1.137(d)(3).

4. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Margaret Rubin, of CRU Art Unit 3992, at (571) 272-1756.

5. Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7728.

Raul Tamayo
Legal Advisor
Office of Patent Legal Administration

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.
90/007,605	06/27/2005	6670384	LD0284REX	6469

23914 7590 08/30/2005

STEPHEN B. DAVIS
BRISTOL-MYERS SQUIBB COMPANY
PATENT DEPARTMENT
P O BOX 4000
PRINCETON, NJ 08543-4000

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/30/2005

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

Order Granting / Denying Request For Ex Parte Reexamination	Control No. 90/007,605	Patent Under Reexamination 6670384	
	Examiner Phyllis G. Spivack	Art Unit 1614	

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

The request for *ex parte* reexamination filed 27 June 2005 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a)☐ PTO-892, b)☒ PTO-1449, c)☐ Other: _____

1. ☒ The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. ☐ The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 (c) will be made to requester:

a) ☐ by Treasury check or,

b) ☐ by credit to Deposit Account No. _____, or

c) ☐ by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

Phyllis Spivack

PHYLLIS SPIVACK
PRIMARY EXAMINER

Phyllis G. Spivack
Primary Examiner
Art Unit: 1614

cc:Requester (if third party requester)

A substantial new question of patentability affecting claims 1-29 of United States Patent Number 6,670,384 is raised by the request for reexamination filed June 27, 2005. For the reasons given below, the Examiner finds new questions of patentability affecting claims 1-29 and the request for *ex parte* reexamination pursuant to 37 CFR 1.510 is GRANTED.

Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an Applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extension of time in reexamination proceedings are provided for in 37 CFR 1.550(c)).

Claims Considered Unpatentable by Requester

The Requester considers claims 1-29 to be obvious under 35 U.S.C 103 as being unpatentable over Vite et al., U.S. Patent 6,380,395, in view of Mehta et al., U.S. Patent 4,950,432.

Decision on Request

It is agreed that consideration of Vite et al., U.S. Patent 6,380,395, in view of Mehta et al., U.S. Patent 4,950,432, raises a substantial new question of patentability. Vite teaches epothilone derivatives for treating carcinomas and a variety of human diseases and the formulation of the epothilone derivatives for oral and intravenous administration. Mehta teaches macrolide antibiotics, their encapsulation into liposomes for administration to patients and the preparation of liposome encapsulated macrolide antibiotics, including the step of lyophilization to produce a powder. A reasonable

Examiner would have considered these references in determining patentability of the claims.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Phyllis G. Spivack whose telephone number is 571-272-0585. The Examiner can normally be reached Mondays to Fridays from 10:30 AM to 7 PM.

If attempts to reach the Examiner by telephone are unsuccessful **after one business day**, the Examiner's supervisor, Chris Low, can be reached at telephone number 571-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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).

Phyllis G. Spivack
Primary Examiner
Art Unit 1614

Phyllis Spivack
PHYLLIS SPIVACK
PRIMARY EXAMINER

August 25, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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www.uspto.gov

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CENTRAL REEXAMINATION UNIT

Jason Bryon
NOVAK DRUCE & QUIGG, LLP
1000 Louisiana Ave
53rd Floor
Houston TX 77002

For Patent Owner

Ex Parte Reexamination Proceeding
Control No. 90/007,606
Filed: June 28, 2006
For: US Patent No. 6,284,917

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

This is a decision on the petition filed October 26, 2006 to request a one-month extension of time pursuant to 37 CFR 1.550(c) for submitting an Appeal Brief.

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 an Appeal Brief pursuant to the Notice of Appeal received September 1, 2006. 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, pursuant to the notice of appeal filed on September 1, 2006, the deadline for filing an appeal brief is November 1, 2006. On October 10, 2006, a timely reply and amendment in conformance with the advisory action was filed. On October 26, 2006, the examiner held a telephone interview with Patentee's counsel and indicated that further time beyond November 1, 2006 was required to adequately address and consider the amendment. Since it is very likely that the claims will be allowed, Patentee requests an extension of time for one month to provide time for the Examiner to address the proposed amendment.

Analysis and Findings

On balance, it is considered that the petition explains the "sufficient cause" for an extension of time. The advisory action was extensive and the response will require more than a cursory review. Further, in addition to the substantial amendment to claim 1, the response includes a new claim that will require additional consideration. It is clear that the examiner and counsel have been working together diligently to bring the proceeding to a close. In the interest of providing the examiner with a fair opportunity to review the response and for Patentee to make any necessary corrections, an extension of time for one month is granted.

Conclusion

1. The patent owner's petition for extension of time of one month in which to file an Appeal Brief pursuant to the Notice of Appeal received September 1, 2006 is **granted**.

2. The Patent Owner's response is due on December 1, 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.

Deborah Jones

for Lissi M. Marquis,
Director, Central Reexamination Unit

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Alexandria, VA 22313-1450
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FROM DIRECTORS OFFICE

APR 28 2006

TECHNOLOGY CENTER 3600

For the Patent Owner:

Cohen & Grigsby, P.C.
11 Stanwix Street, 15th Floor
Pittsburgh, PA 15222

For the Requester:

Carrier, Blackman, & Associates, P.C.
24101 Novi Road, Suite 100
Novi, MI 48375

DECISION ON PETITION FOR REVIEW OF DENIAL OF REQUEST FOR REEXAMINATION UNDER 37 CFR 1.515(c)

In re Reexamination proceeding 90/007,612
Filed: July 5, 2005
For: U.S. Patent No. 5.026,109

This is in response to Requester's petition filed September 6, 2005 and supplemented on February 6, 2006 under 37 CFR 1.181 and 1.515(c) requesting review of the August 3, 2005 Order Denying Request For Reexamination.

The petition is **GRANTED**.

Patent No. 5, 026,109 issued on June 25, 1991. A request for reexamination of that patent was filed on December 13, 2002 and assigned Control No. 90/006,482. In reexam '6482, the examiner applied the references of Sprung, Hall, Folkes, Cramaro, Cappella, Biancale and Myburgh in rejections based on 35 U.S.C. 102 and/or 103. The request was granted on February 11, 2003 and the Reexamination Certificate issued on February 8, 2006. A second request for reexamination of Patent No. 5,026,109 was filed by the same third party on July 5, 2005 and assigned Control No. 90/007,612. In the second request for reexamination '007,612, requestor argued that the rejections made in the first reexam should have been maintained. Other possible rejections were also proposed, including some based on prior art newly cited in the second reexam. That request was denied on August 3, 2005. The examiner denied reexamination because it was said that although Rinaldi and Bourgeois patents were not previously considered, they were deemed cumulative to the references already considered in the prosecution of the '6482 reexam. Also, the examiner maintained that the question of analogousness was previously considered and therefore does not raise a substantial new question of patentability (SNQ). Finally, the examiner held that the proposed new question of patentability regarding the use of Sprung and Rinaldi patents as a basis for rejection would not be considered to be important to a reasonable examiner as these patents describe static structures, not truck trailers and as such cannot form a basis for

a prima facie rejection A petition requesting reconsideration and withdrawal of the August 3, 2005 denial was filed September 6, 2005 and supplemented on February 6, 2006. In the petition filed September 6, 2005, petitioner argues against (a) the allowance of claims in the patent '109 based on the argument of non-analogous art and (b) the examiner's finding that the second request fails to raise a substantial new question of patentability. The supplemental petition filed February 6, 2006 cites court decisions to support petitioner's petition.

MPEP 2242 discusses the criteria for deciding requests for reexamination. It is noted that the presence or absence of a "substantial new question of patentability" (SNQ) determines whether or not reexamination is ordered. A prior patent or publication raises a SNQ where there is substantial likelihood that a reasonable examiner would consider the prior art patent or publication important in deciding whether or not the claim is patentable. If the prior art are considered important, then the examiner should find a SNQ unless the prior art is cumulative to similar prior art already considered by the Office. For a SNQ to be present, it is only necessary that (A) the prior art raise a SNQ and (B) the same question of patentability has not been decided by the Office.

The examiner is correct in his holding that questions of obviousness (i.e., whether prior art is analogous in this case) will not be reconsidered in a request for reexamination where that issue has been decided upon in a prior proceeding before the Office. The examiner's holding that Sprung and Rinaldi patents are not considered important and therefore do not support a SNQ because they would not support a basis for a prima facie rejection is an improper reason for denial. MPEP 2242 specifically states that it is not necessary that a prima facie case of unpatentability exist in order for a SNQ to be present. Finally, the examiner's holding that Rinaldi and Bourgeois patents were not previously considered and are cumulative of the references already considered in the prosecution of reexm '6482 is flawed since the patent to Rinaldi was cited in the '6482 reexam.

Petitioner's arguments against the allowance of claims in the '6482 reexam is deemed without merit since questions of patentability previously considered will not form the basis for a SNQ. However, a SNQ can be established where a new reference is cited which is not cumulative of prior art already considered or where old art is presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded reexamination, in view of the new argument or interpretation presented in the request.

The '7612 reexam includes the citation of three new references (Dunn, Lamb and Bourgeois) not previously considered. After review of the newly cited references, it is determined that a substantial new question of patentability is raised with the consideration of these new references. The test for determining a SNQ for new references is whether or not a reasonable examiner would have been considered them important in deciding whether or not a claim is patentable. Bourgeois teaches a retractable truck cover. Lamb teaches an extendable and retractable cover. Dunn teaches a flexible cover having particular connection means to its support. All these

references are pertinent to the claimed invention and are not considered cumulative to that previously considered.

Petitioner's arguments on page 10 of the petition filed September 6, 2005 raise issues not previously considered. For example, the analogousness of prior art sectional covers for static structures with regard to the use of such structures on vehicles raises a SNQ with regard to the examiner's previous determination of non-analogousness. Evidence of the loads that such sectional covers for static structures can withstand is referenced by petitioner in the patent to Sprung at column 2, lines 54-59. The consideration of such teaching in combination with the other prior art cited raises a SNQ.

Accordingly, the petition to overturn the examiner's denial of the request for reexamination of the Patent No. 5,026,109 is **GRANTED**.

Petitioner's request for a new examiner will be treated in accordance with MPEP 2248.

A two-month period for filing a statement under 37 CFR 1.530 is set from the mailing date of this decision.

Inquiries related to this decision may be directed to Special Programs Examiner Kenneth J. Dorner at (571) 272-6587.

John J. Love, Director
Patent Technology Center 3600
(571) 272-5250

kjd/kjd: 4/25/06

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Fish & Neave IP Group
Ropes & Gray LLP
One International Place
Boston, MA 02110-2624

(For Patent Owner)

JAN 12 2007

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In re	: Eilaz Babaev	
Reexamination Proceeding		DECISION ON PETITION
Control No.	: 90/007,613	UNDER 37 CFR 1.181
Filed	: July 5, 2005	
For U.S. Patent No.	: 6,569,099	

This is a decision on a petition under 37 CFR 1.181 filed December 7, 2006 requesting entry of patent owner's after-final amendment filed September 21, 2006 along with evidence submitted with said amendment.

Upon further consideration of the record in the instant reexamination proceedings, the examiner in charge of the proceedings has entered the after-final amendment filed September 21, 2006 as well as the evidence accompanying said amendment. An action, taking into consideration the September 21, 2006 communication has been prepared and mailed under separate cover.

In view of the above, the petition under 37 CFR 1.181 filed December 7, 2006 is dismissed as being moot.

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

Andres Kashnikow

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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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
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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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JAN 15 2008

CENTRAL REEXAMINATION UNIT

Robert E. Sokohl
Sterne, Kessler, Goldstein & Fox PLLC
1100 New York Ave., NW
Washington, DC 20005

(For Patent Owner)

Edward C. Kwok
MacPherson Kwok Chen & Heidi LLP
1762 Technology Dr., Suite 226
San Jose, CA 95110

(For Third Party Requester)

Ex parte LaRoy Tymes	: **DECISION ON PETITION**
Reexamination Proceeding	: **TO CONTINUE**
Control No.: 90/007,617	: ***EX PARTE***
Filed: July 6, 2005	: **REEXAMINATION**
For: U.S. Patent 5,029,183	: **PROCEEDINGS**

This is a decision on the December 19, 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 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) U.S. Patent No. 5,029,183 (the '183 patent) issued on July 2, 1991.

2) The '183 patent has been the subject of four court proceedings, which are all now closed.

3) A request for *ex parte* reexamination of the '183 patent was filed by a third party requester on July 6, 2005, and assigned control number 90/007,617 (the '7617 proceeding).

4) An Order granting reexamination in the '7617 proceeding was mailed on

September 16, 2005.

5) There have been two non-final Office actions in the '7617 proceeding. In addition, a final Office action was mailed September 21, 2007.

6) An examiner interview was conducted with patent owner on November 13, 2007.

7) Patent owner then responded to the final Office action on November 21, 2007.

8) On December 10, 2007, an advisory action was mailed indicating that the amendments to the claims filed after the final Office action would not be entered because they were directed to the merits of the patent and the patent owner failed to make a showing of good and sufficient reasons why the amendment was necessary and not earlier presented.

9) The present petition to request continued reexamination of the '183 patent was filed on December 19, 2007, along with a notice of appeal to allow sufficient time for a decision to made on this petition. The petition asserts that the amendment filed November 21, 2007, advances prosecution of the reexamination proceeding by amending the claims to explicitly recite the meaning of certain claim terms and to add new claims corresponding in scope to the claims already confirmed as to patentability in the '7617 proceeding.

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 November 21, 2007 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 rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding.

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[1] Item 7 in the Review of Facts.

[2] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

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 believed prior to the final rejection that the claim language, as interpreted in view of the specification, was adequate to overcome the rejection and that an explanation to the Office of the claim interpretation would be a persuasive response. After the final rejection, patent owner realized that claim amendments would be required to overcome the rejection. In particular, in the amendment after the final Office action, the patent owner asserted that the amendments were not made previously, because the patent owner believed that the claim terms should be limited to the definitions set forth in the specification, which is asserted to be consistent with the claim construction followed in a concurrent (now closed) litigation, and thus required no amendment. 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 to support the argued claim interpretation is deemed a *bona fide* effort to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate. As such, the granting of the present petition is consistent with the requirement of 35 U.S.C. 305 to conduct reexamination proceedings "with special dispatch within the Office."

In view of the above and the fact situation presented by the present record, the petition is granted, and the prosecution in the above-noted reexamination proceeding is hereby continued. Prosecution is reopened for consideration of the November 21, 2007 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 November 21, 2007 Amendment After Final 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 '7617 *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 September 21, 2007 final Office action is withdrawn, and prosecution of the proceeding is reopened.

4) The November 21, 2007 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) 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

January 11, 2008
C:\Kiva\Kenpet6\RCR\ 7617_RCR-grant-amdt-to-go-w-claim consrtruction.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.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,619; 90/006,824	07/07/2005	6359022	OXID/0002/HMP/12123.0024	7605

20306 7590 02/24/2006

MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP
300 S. WACKER DRIVE
32ND FLOOR
CHICAGO, IL 60606

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/24/2006

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CST

Steven J. Sarussi McDonnell Boehnen Hulbert & Berghoff LLP 300 South Wacker Drive Chicago, Illinois 60606	(for Patent Owner)
Henry M. Pogorzelski Patterson & Sheridan LLP 3040 Post Oak Blvd. Suite 1500 Houston, TX 77056	(for Third Party)
In re Hickey et al Reexamination Proceeding Control No. 90/006,824 Filed: October 20, 2003 For: U.S. Patent 6,359,022	**DECISION MERGING REEXAMINATION PROCEEDINGS**
In re Hickey et al Reexamination Proceeding Control No. 90/007,619 Filed: July 7, 2005 For: U.S. Patent 6,359,022	

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

BACKGROUND

1. United States Patent 6,359,022, issued March 19, 2002, is the subject of Reexamination Control Nos. 90/006,824 and 90/007,619.

2. A first request for reexamination, assigned Reexamination Control No. 90/006,824 ('6824), was filed October 20, 2003 by Steven Sarussi of McDonnell Boehnen Hulbert & Berghoff LLP. The request urged that a substantial new question of patentability was raised by the teachings of (a) "Improved Hydrocarbon Blown Foams for North America", Polyurethane, 1995 (Nicola), (b) "Hydrocarbon Blown

Foams for U.S. Construction Applications", 35th Annual Polyurethane Technical/Marketing Conference, October 9-12 (Nicola 1994) and (c) U.S. patent 5,916,480 to Rotermund et al.

3. Reexamination was ordered for '6824 on January 15, 2004.

4. A first Office action for '6824 was mailed on January 18, 2005 and contained the rejection of (a) claims 1-26 under 35 USC 102(b) as being anticipated by WO 96/25,443, (b) claims 1-26 under 35 USC 103 as being unpatentable over Nicola et al 1994, and (c) claims 1-26 as being unpatentable over Nicola et al 1995 alone, or in view of Nicola et al 1994.

5. Patent owner responded to the first Office action on April 21, 2005 with an amendment to the claims.

6. A second request for reexamination, assigned Reexamination Control No. 90/007,619 ('7619), was filed July 7, 2005 by Henry Pogorzelski of Patterson & Sheridan LLP. The request urged that a substantial new question of patentability was raised by the teachings of WO 96/25,433 to Blanpied, U.S. patent 5,859,078 to Chittolini and WO 97/21,764 to Singh.

7. Reexamination was ordered for '7619 on September 26, 2005.

DISCUSSION

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

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

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

> After the patent owner and second requester have been given an opportunity to file a statement and reply, respectively, the second reexamination proceeding will be merged with the first reexamination proceeding, and prosecution will then continue at the most advanced point possible for the first proceeding. It should be noted that if a final rejection has been issued in the first proceeding, prosecution will be ordinarily be

reopened where any of the new patents or printed publications presented in the second request are applied to the merged proceeding in a new ground of rejection.

DECISION

I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. 1.565(c), the 90/006,824 and 90/007,619 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. Patent Owner is given one (1) month from the date of this decision to provide a "housekeeping amendment" to make the claims the same in each file. Note that Patent Owner has submitted an amendment in Reexamination Control No. 90/006,824 on April 21, 2005. See MPEP 2283, "Merger of Reexaminations."

III. CONDUCT OF MERGED PROCEEDING

An Office action will be issued in due course (after entry of the "housekeeping amendment") which applies to Reexamination Control Nos. 90/006,824 and 90/007,619.

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for all files and will be electronically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, **filed in duplicate**, each bearing a signature and identifying data for all files, for entry into each file. All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control Nos. 90/006,824 and 90/007,619 as:

Steven Sarussi
McDonnell Boehnen Hulbert & Berghoff LLP
300 South Wacker Drive
Chicago, Illinois 60606

CONCLUSION

Reexamination Control Nos. 90/006,824 and 90/007,619 are merged. The Patent Owner is given one (1) month from the date of this decision to provide a "housekeeping amendment" to make the claims the same in each file.

JMStone

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,619	07/07/2005	6359022	OXID/0002/HMP/12123.0024	7605

23446 7590 03/31/2008

MCANDREWS HELD & MALLOY, LTD
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CHICAGO, IL 60661

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/31/2008

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

HENRY M. POGORZELSKI
PATTERSON & SHERIDAN LLP
3040 POST OAK BLVD. SUITE 1500
HOUSTON, TX 77056

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007619 + 90/006824
PATENT NO. 6,359,022
ART UNI 3993

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

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a 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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George Wheeler
McAndrews, Held & Malloy
500 West Madison Street, Suite 3400
Chicago, IL 60661

For Patent Owner
(First request)

Henry M. Pogorzelski
Patterson & Sheridan LLP
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056

For Requester

In re: Hickey et al
Ex Parte Reexamination Proceedings
Control No. 90/006,824
Filed: October 20, 2003
Merged with:
Control No. 90/007,619
Filed: July 7, 2005

For: US Patent No. 6,359,022

DECISION ON PETITION
FOR ENTRY OF
AMENDMENT

This is a decision on the Petition under 37 CFR 41.33 and 1.181, filed May 15, 2007, to request entry of amendment before filing appeal brief in an *ex parte* reexamination.

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

The petition is dismissed for the reasons set forth below.

Decision

The Patent Owner requests entry of the **Amendment Before Filing Appeal Brief**, filed May 15, 2007, such amendment filed concurrently with this petition under the provisions of 37 CFR 41.33 and 1.181. The basis for requesting relief is that the requirements of 37 CFR 1.116 and 37 CFR 41.33 for entering an amendment, when requested after filing a Notice of Appeal and before an appeal brief, have been met.

37 CFR 41.33 states in pertinent part:

> (a) Amendments filed after the date of filing an appeal pursuant to 41.31(a)(1) through (a)(3) and prior to the date a brief is filed pursuant to 41.37 may be admitted as provided in 1.116 of this title.

37 CFR 1.116 states in relevant part:

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

> (1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;
> (2) An amendment presenting rejected claims in better form for consideration on appeal may be entered; or
> (3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

Analysis and Findings

In the Advisory action mailed June 14, 2007, the amendment submitted by Patent Owner May 15, 2007 was indicated as "entered". As this amendment is entered and is part of the record under consideration in this proceeding, this petition is dismissed as moot.

Conclusion

The patent owner's petition for entry of the amendment submitted May 15, 2007 is **dismissed**.

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

Lissi M. Marquis,
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,619	07/07/2005	6359022	OXID/0002/HMP/12123.0024	7605

23446 7590 03/31/2008

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/31/2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,824	10/20/2003	6359022	97-845-C	7651

23446 7590 03/31/2008

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EXAMINER

ART UNIT	PAPER NUMBER

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MAR 31 2008

CENTRAL REEXAMINATION UNIT

George Wheeler
McAndrews, Held & Malloy
500 West Madison Street, Suite 3400
Chicago, IL 60661

For Patent Owner
(First request)

Henry M. Pogorzelski
Patterson & Sheridan LLP
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056

For Requester

In re: Hickey et al
Ex Parte Reexamination Proceedings
Control No. 90/006,824
Filed: October 20, 2003
Merged with:
Control No. 90/007,619
Filed: July 7, 2005

For: US Patent No. 6,359,022

DECISION ON PETITION
TO DESIGNATE NEW
GROUNDS OF REJECTION
(37 CFR 1.181(a))

This is a decision on the Petition under 37 CFR 1.181(a), filed September 13, 2007, to designate new grounds of rejection.

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

The petition is dismissed for the reasons set forth below.

Decision

The Patent Owner requests the Office, under 37 CFR 1.181(a), to re-designate the rejections of claims 33-51 and 53-54 under 35 USC 103(a) in the Examiner's Answer dated July 13, 2007, in this proceeding as new grounds of rejection.

MPEP 1207.03 III states in relevant part:

> There is no new ground of rejection when the basis thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See *In re Kronig* 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Where the statutory basis for the rejection remains the same and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection.

Summary of Relevant Facts

On March 16, 2007 Patent Owner filed a response to the Final rejection which included an amendment to the claims. A Notice of Appeal was filed concurrently with this response.

On April 5, 2007 an Advisory Action was mailed indicating the amendment would not be entered because it raised new issues and did not place the claims in better condition for appeal. Suggestions were made by the examiner regarding the amendments and synopsis of how the claims would be rejected was provided.

On May 15, 2007 Patent Owner submitted a petition for Entry of the Amendment before Filing Appeal Brief in an *Ex Parte* Reexamination accompanied by an amendment to the claims.

On May 18, 2007, Patent Owner filed an appeal brief.

On June 14, 2007, an Advisory Action was mailed indicating the amendment was entered and providing a synopsis of the remaining rejections.

On July 13, 2007, an Examiner's Answer was mailed responding to the claims as amended on May 15, 2007.

On September 13, 2007, Patent Owner submitted a Reply Brief that reflected the corrected summary of claimed subject matter and addressed the arguments raised pursuant thereto.

On September 13, 2007, Patent Owner submitted this petition to Designate New Grounds of Rejection.

Analysis and Findings

The Advisory Action of June 14, 2007 indicated that the amendment to the claims filed May 15, 2007 would be entered and included a discussion of all remaining rejections. The Examiner's Answer dated July 13, 2007 did not present any new references or view those of record in any new light. Since the statutory basis and supporting evidence has not changed and the discussion of the rejections remains essentially the same, no new grounds of rejection are noted.

Conclusion

The patent owner's petition designate new grounds of rejection, filed September 13, 2007 is **dismissed**.

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

Deborah Jones

for Lissi M. Marquis,
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,824	10/20/2003	6359022	97-845-C	7651

23446 7590 12/05/2008

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/05/2008

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Henry M. Pogorzelski
MOSER PATTERSON & SHERIDAN LLP
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056

Date:
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DEC 05 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90006824
PATENT NO. : 6359022
ART UNIT : 3900

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

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

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CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

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(For Third Party Requester)

In re F. Leo Hickey et al.
Reexamination Proceeding
Control Nos.: 90/006,824
Filed: October 20, 2003
For: U.S. Patent No.: 6,359,022

In re F. Leo Hickey et al.
Reexamination Proceeding
Control No.: 90/007,619
Filed: July 7, 2005
For: U.S. Patent No.: 6,359,022

DECISION TO DISMISS PETITION TO SUSPEND 37 CFR 1.114(e)(5) AND TO EXPUNGE PAPERS REQUESTING CONTINUED EXAMINATION

This is a decision on the November 6, 2008 patent owner petition entitled "PETITION UNDER 37 CFR 1.183 TO SUSPEND 37 CFR 1.114(e)(5)."

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

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.183 was charged to petitioner's account on November 7, 2008.

The petition is dismissed and the accompanying papers of the request for continued examination under 37 CFR 1.114 are being expunged as improper papers for the reasons pointed out below.

Copied from 90006824 on 01/06/2009

REVIEW OF FACTS

1. U.S. Patent No. 6,359,022 to Hickey *et al.* (the '022 patent) was issued on March 19, 2002.

2. On October 20, 2003, patent owner filed a request for *ex parte* reexamination, which was assigned reexamination control number 90/006,824 (the '6824 proceeding).

3. On September 13, 2004, patent owner filed an amendment pursuant to 37 C.F.R. § 1.530(b) in the '6824 proceeding.

4. On January 15, 2004, the Office granted the '6824 reexamination request and ordered reexamination.

5. The'6824 reexamination proceeding progressed to the point where, on April 21, 2005, patent owner filed a response to an Office action mailed January 18, 2005.

6. On July 7, 2005, a second request for reexamination was filed by a third party requester, which was assigned reexamination control number 90/007,619.

7. On August 26, 2005, the Office granted the '7619 reexamination request and ordered reexamination.

8. On February 24, 2006, the Office issued a decision merging the '6824 patent owner reexamination proceeding with the '7619 third party requester reexamination proceeding (the merged reexamination proceeding).

9. The merged proceeding progressed to the point where the Office's rejection of the claims was appealed, and, on September 24, 2008, the Board issued an order returning the application to the Central Reexamination Unit (CRU) to issue a response to a petition under 37 C.F.R. § 1.181 to reconsider a petition to designate new grounds of rejection in the examiner's answer in the merged reexamination proceeding.

10. On November 6, 2008, patent owner filed the present petition under 37 CFR 1.183 to suspend 37 CFR 1.114(e)(5), concurrently with a request for continued examination under 37 CFR1.114, including an amendment to the claims, in the merged reexamination proceeding.

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DECISION DISMISSING PETITION AND EXPUNGING PAPERS

The present November 6, 2008 petition under 37 CFR 1.183 to suspend 37 CFR 1.114(e)(5) and accept the accompanying Request for Continued Examination (RCE) is dismissed:

37 CFR 1.183 states, in pertinent part:

> In an extraordinary situation, when justice requires, any requirement of the regulations in this part which **is not a requirement of the statutes** may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. [Emphasis added]

35 U.S.C. § 132(b) states:

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

37 CFR 1.114 states, in pertinent part:

> (a) If prosecution **in an application** is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth under § 1.17(e) prior to the earliest of:
>
> (1) Payment of the issue fee, unless a petition under § 1.313 is granted;
> (2) Abandonment of the application; or
> (3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141 or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.
>
> ...
>
> **(e) The provisions of this section do not apply to:**
>
> ...
>
> **(5) A patent under reexamination.**
>
> [Emphasis added]

35 U.S.C. § 132(b) expressly limits the authority to create regulations providing for continued examination to "the continued examination of applications for patent." To implement this statutory limitation, 37 CFR 1.114(e)(5), specifically excludes reexamination proceedings from RCE practice, because reexamination of a patent is not the examination of an "application for patent." There is, accordingly, no authority for the filing, in a reexamination proceeding, of a RCE in an effort to continue prosecution of the reexamination proceeding, regardless of whether prosecution was closed, or otherwise.

Copied from 90006824 on 01/06/2009

Accordingly, the RCE filed on November 6, 2008 is not a paper that is enterable in the merged '6824 and '7619 reexamination proceeding.

37 CFR 1.183 empowers the Office to waive any requirement of the regulations "which is not a requirement of the statutes." However, since a reexamination of a patent is not the examination of an "application for patent," there exists no statutory authority to grant a continued examination of a reexamination of a patent. Therefore, 37 CFR 1.183 is inapplicable.

Furthermore, 37 CFR 1.183 is to be used only in an "extraordinary situation," and such has not been established in this instance. Petitioner's argument alleging inadequate opportunity to prosecute the currently amended claims such that justice requires reopening of prosecution is not persuasive. The record shows that petitioner has had a full and fair opportunity to prosecute the merged reexamination, including four interviews, consideration of claim amendments and affidavits, and entry of claim amendments filed three days prior to filing of an appeal brief. Petitioner's allegations of new grounds of rejections in the examiner's answer are properly addressable by way of 37 CFR 1.181, not via 37 CFR 1.183. Therefore, the record does not exhibit an "extraordinary situation" as required under 37 CFR 1.183, even were 37 CFR 1.183 applicable.

In view of the above and the fact situation presented by the record, the petition is dismissed. Further, the papers of the request for continued examination under 37 CFR 1.114 that accompanied the petition are being expunged as improper papers, not authorized by statute.

CONCLUSION

1. The petition is dismissed.

2. The accompanying papers of the request for continued examination under 37 CFR 1.114 are being expunged as improper papers. The papers are being expunged by closing them in the IFW file of the present reexamination proceeding, and marking the papers "closed" and "non-public" in the IFW.

2. The present decision is being made of part of the official record (the IFW) for the present proceeding.

3. Jurisdiction over the present *ex parte* reexamination proceeding is being returned to the Central Reexamination Unit (CRU), for appropriate action in due course, including consideration of a petition under 37 CFR 1.181, filed on May 29, 2008, requesting reconsideration of a petition to designate new grounds of rejection..

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4. Telephone inquiries related to the present decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700, or in his absence, the undersigned at 571-272-7710.

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

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12-3-08

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,619	07/07/2005	6359022	OXID/0002/HMP/12123.0024	7605

23446 7590 03/12/2009

MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO, IL 60661

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/12/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Date: MAILED
MAR 12 2009
CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
HENRY M. POGORZELSKI
PATTERSON & SHERIDAN LLP
3040 POST OAK BLVD. SUITE 1500
HOUSTON, TX 77056

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007619
PATENT NO. : 6359022
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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P.O. Box 1450
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George Wheeler
McAndrews, Held & Malloy
500 West Madison Street, Suite 3400
Chicago, IL 60661

For Patent Owner

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MAR 12 2009

CENTRAL REEXAMINATION UNIT

Henry M. Pogorzelski
Patterson & Sheridan LLP
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056

For Requester

In re: Hickey et al
Ex Parte Reexamination Proceedings
Control No. 90/006,824
Filed: October 20, 2003
Merged with:
Control No. 90/007,619
Filed: July 7, 2005

For: US Patent No. 6,359,022

DECISION ON PETITION
TO DESIGNATE NEW
GROUNDS OF REJECTION
(37 CFR 1.181(a))

This is a decision on the May 29, 2008 patent owner petition under 37 1.181(a) requesting reconsideration of the March 31, 2008 decision by the Director of the Central Reexamination Unit which was issued on patent owner's petition under 37 CFR 1.181(a) to designate new grounds of rejection.

The petition is before Irem Yucel, Director, Technology Center 1600 for reconsideration of the March 31, 2008 decision.

The petition is granted to the extent that the March 31, 2008 decision has been reconsidered, but is denied as to the underlying relief requested, for the reasons set forth below.

Background

On January 16, 2007, Patent Owner filed an Amendment after Final that included extensive amendments to the claims.

On February 2, 2007, an Advisory Action was mailed indicating that the January 16, 2007 response would not be entered because it raised new issues and did not place the proceeding in better form for appeal. The examiner offered several suggestions on how to amend the claims to over come some of these issues and at least place the proceeding in better form for appeal. The examiner explicitly indicated that, should a subsequent amendment be filed according to the suggestions, the 35 U.S.C. 102(b) rejection over Singh will become a 35 U.S.C. 103(a) rejection and the finality will be maintained. See the paragraph bridging pages 8-9 of this Advisory Action.

On March 16, 2007, Patent Owner filed a response to the Final rejection which included an amendment to the claims. A Notice of Appeal was filed concurrently with this response.

On April 5, 2007, an Advisory Action was mailed indicating the amendment would not be entered because it raised new issues and did not place the claims in better condition for appeal. Suggestions were again made by the examiner regarding the amendments, and a synopsis of how the claims would be rejected was provided.

On May 15, 2007, Patent Owner submitted a petition for Entry of the Amendment before Filing Appeal Brief in an *Ex Parte* Reexamination accompanied by an amendment to the claims.

On May 18, 2007, Patent Owner filed an appeal brief.

On June 14, 2007, an Advisory Action was mailed stating that the amendment was entered and providing a synopsis of the remaining rejections. As was stated in the Advisory Action of February 2, 2007, the 35 U.S.C. 102(b) rejection of claims 1-10, 13-16. 20, 24, 27-47, 49-51, 53-55, 57-59, 61-66, and 68 were now rejected under 35 U.S.C.103(a) over Singh.

On July 13, 2007, an Examiner's Answer was mailed responding to the claims as amended on May 15, 2007.

On September 13, 2007, Patent Owner submitted a Reply Brief that reflected the corrected summary of claimed subject matter and addressed the arguments raised pursuant thereto.

On September 13, 2007, Patent Owner submitted a petition to Designate New Grounds of Rejection, which was dismissed on March 31, 2008.

On May 29, 2008, Patent Owner filed the present Petition requesting reconsideration of the Decision of March 31, 2008.

Relevant Procedure

MPEP 1207.03 III states in relevant part:

III. SITUATIONS THAT ARE NOT CONSIDERED AS NEW GROUNDS OF REJECTION

There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See *In re Kronig,* 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. Id. At 1303, 190 USPQ at 427 (reliance upon fewer references in affirming a rejection under 35 U.S.C. 103 does not constitute a new ground of rejection).

In addition, former 37 CFR 1.193(a)(2) also provided that if:

(A) an amendment under 37 CFR 1.116 [or 41.33] proposes to add or amend one or more claims;

(B) appellant was advised (through an advisory action) that the amendment would be entered for purposes of appeal; and

(C) the advisory action indicates which individual rejection(s) set forth in the action from which appeal has been taken would be used to reject the added or amended claims, then

(1) the appeal brief must address the rejection(s) of the added or amended claim(s) and

(2) the examiner's answer may include the rejection(s) of the added or amended claims. Such rejection(s) made in the examiner's answer would not be considered as a new ground of rejection.

The filing of such an amendment represents appellant's consent to proceed with the appeal process. For example, when an amendment under 37 CFR 1.116 or 41.33 cancels a claim (the "canceled claim") and incorporates its limitations into the claim upon which it depends or rewrites the claim as a new independent claim (the "appealed claim"), the appealed claim contains the limitations of the canceled claim (i.e., the only difference between the appealed claim and the canceled claim is the claim number). In such situations, the appellant has been given a fair opportunity to react to the ground of rejection (albeit to a claim having a different claim number). Thus, such a rejection does not constitute a "new ground of rejection" within the meaning of 37 CFR 41.39.

The phrase "individual rejections" addresses situations such as the following: the action contains a rejection of claim 1 under 35 U.S.C. 102 on the basis of Reference A, a rejection of claim 2 (which depends upon claim 1) under 35 U.S.C. 103 on the basis of Reference A in view of Reference B and a rejection of claim 3 (which depends upon claim1) under 35 U.S.C. 103 on the basis of Reference A in view of Reference C. In this situation, the action contains the following "individual rejections": (1) 35 U.S.C. 102 on the basis of Reference A; (2) 35 U.S.C. 103 on the basis of Reference A in view of Reference B; and (3) 35 U.S.C. 103 on the basis of Reference A in view of Reference C. The action, however, does not contain any rejection on the basis of A in view of B and C. If an amendment under 37 CFR 1.116 or 41.33 proposes to combine the

limitations of claims 1 and 2 together into amended claim 1 and cancels claim 2, a rejection of amended claim 1 under 35 U.S.C. 103 on the basis of Reference A in view of Reference B would be appropriate and would not be considered a new ground of rejection within the meaning of 37 CFR 41.39, provided the applicant was advised that this rejection would be applied to amended claim 1 in an advisory action. Furthermore, since claim 3 (which depends upon claim 1) would include the limitations of the original claims 1, 2, and 3, a rejection of amended claim 3 (amended by the amendment to original claim 1) under 35 U.S.C. 103 on the basis of Reference A in view of Reference B and Reference C may be appropriate and would not be considered a new ground of rejection within the meaning of 37 CFR 41.39, provided applicant was advised that this rejection would be applied to amended claim 3 in the advisory action. Of course, as amended claim 3 includes the limitations of the original claims 1, 2, and 3, amended claim 3 is a newly proposed claim in the application raising a new issue (i.e., a new ground of rejection), and such an amendment under 37 CFR 1.116 or 41.33 may properly be refused entry as raising a new issue.

Decision

The Patent Owner requests the Office, under 37 CFR 1.181(a), to re-designate the rejections of claims 33-51 and 53-54 under 35 USC 103(a) in the July 13, 2007 Examiner's Answer as new grounds of rejection.

The Advisory Action of June 14, 2007 stated that the amendment to the claims filed May 15, 2007 would be entered, and it included a discussion of all remaining rejections including the change with regards to the rejection over Singh. The July 13, 2007 Examiner's Answer reflected this discussion and did not present any new references or view those of record in any new light. This is consistent with MPEP 1207.03. Claim 52 was originally rejected over Singh alone under § 103(a) with respect to the water content. This issue was clearly developed in the Final rejection (see pages 22-24). The amendment of May 15, 2007 was denied entry because is raised other substantial issues and did not put the proceeding in better form for appeal. However, Patent Owner was notified at that time that, if a subsequent after-final amendment was filed ameliorating the other issues and containing the amendment with respect to water content, the § 102(b) rejection

would be converted to a §103(a) rejection over Singh and the finality maintained because this issue had been discussed. In the amendment filed May 15, 2007, Patent Owner filed an amendment incorporating claim 52 into claim 1 as suggested by the Examiner. The Examiner then issued a subsequent Advisory action stating that the claims were rejected under §103(a) and maintaining the finality of the rejection as had been discussed. Upon entry of the May 15, 2007, the patent owner could have filed a replacement brief, addressing the Examiner's statement in the Advisory action that the claims were, at that point, rejected under §103(a). Patent Owner amended the claims under the advisement of the Examiner, was aware of the consequences and had ample time to respond and did not do so until the filing of the reply brief; accordingly the request for reconsideration to designate new grounds of rejection is denied.

Conclusion

The Patent Owner's petition for reconsideration to designate new grounds of rejection is granted to the extent that the March 31, 2008 decision has been reconsidered, but is denied as to the underlying relief requested.

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

Irem Yucel
Director, Technology Center 1600

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REEXAM UNIT

R. Joseph Trojan
TROJAN LAW OFFICES
9250 Wilshire Boulevard
Suite 325
Beverly Hills, CA 90212

(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	DECISION TO *SUA SPONTE* MERGE *EX PARTE* REEXAMINATION PROCEEDINGS AND
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	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.

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).

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

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.

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

> 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.

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:

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[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.

> "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.

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.

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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JM

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Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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REEXAM UNIT

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Science and Technology Law Group
242 Ave Vista Del Oceano
San Clemente, CA 92672

For Patent Owner

Christopher J. McDonald
Hoffman, Wasson & Gitler, P.C.
2461 South Clark Street
Crystal Center 2 – Suite 522
Arlingotn, VA 22202

For Requester

Ex Parte Reexamination Proceeding
Control No. 90/007,626
Filed: July 13, 2005
For: US Patent No. 5,916,912

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

This is a decision on the petition filed February 16, 2006 to request a two-month extension of time pursuant to 37 CFR 1.550 for responding to the Office action dated December 21, 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 21, 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 that significant input and time is required of the inventors regarding the rejections under 35 USC 102(e) and 103 and to file a 37 CFR 1.131 declaration to antedate one or more of the references. The request indicates Dr. Bruce Ames is out of the country until February 24, 2006 and Dr. Tory Hagen, co-inventor, is unavailable during the month of February. As such it will be difficult for the patent owner to fully respond to the Office action by the February 21, 2006 deadline. An extension of time until April 21, 2006 is requested to facilitate the completion of the reply.

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 the Patent Owner is relying upon consultation with the inventors to prepare the response to the Office action and that the inventors are presently unavailable; however, given the time allotted for reexamination proceedings response, one should reasonably anticipate the time needed for consultation with inventors for collection of information and data. 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 December 21, 2005 is **granted**.

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

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For Patent Owner

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CENTRAL REEXAMINATION UNIT

Christopher J. McDonald
Hoffman, Wasson & Gitler, P.C.
2461 South Clark Street
Crystal Center 2 – Suite 522
Arlington, VA 22202

For Requester

Ex Parte Reexamination Proceeding
Control No. 90/007,626
Filed: July 13, 2005
For: US Patent No. 5,916,912

: DECISION ON
: PETITION UNDER
: 37 CFR 1.181(c)

This is a decision on the petition filed November 13, 2006, to request supervisory authority under the provisions of 37 CFR 1.181(c) to overturn the examiner's withdrawal of new dependent claims 14-21, 24-27, 30-32, 35-38, 41-44, 48-51 and 55-57 added in the present reexamination proceeding.

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. Claims 16, 17, 20, 21, 26, 27, 32, 37, 38 ,43, 44, 50, 51, and 57 will be examined together with already-examined claims 1, 2, 4-13, 22, 23, 28, 29, 33, 34, 39, 40, 45-47, 52-54, 58, and 59. Claims 14, 15, 18, 19, 24, 25, 30, 31, 35, 36, 41, 42, 48, 49, 55, and 56 remain withdrawn from consideration and will be cancelled at the time the prosecution on the reexamination proceeding is terminated.

BACKGROUND

On July 13, 2005, request for reexamination was filed by a third party requester and assigned a filing date thereon.

On September 14, 2005, reexamination was ordered. No patent owner's statement was received.

On December 21, 2005, a non-final Office action was mailed that rejected all claims.

On February 13, 2006 a petition for extension of time was submitted and granted for one month on February 21, 2006.

On March 23, 2006, a response to the non-final Office action was received that included the addition of new claims 11-59.

On July 24, 2006, a final Office action was mailed indicating newly added claims 14-21, 24-27, 30-38, 41-44, 48-51, and 55-57 to be drawn to embodiments that were not presented in the original claims and were therefore outside the scope of this proceeding. The claims were withdrawn from consideration.

On August 23, 2006, a personal interview was held.

On September 11, 2006, a non-final Office action was mailed that maintained the examiner's position regarding claims 14-21, 24-27, 30-38, 41-44, 48-51, and 55-57.

On November 13, 2006, a response to the non-final Office action was received that included this petition.

DECISION

Petitioner's Position:

In the response to the first Office action dated December 21, 2005, Patent Owner added additional claims 14-59. Patent Owner asserts these claims to be narrower in scope than the broadest independent claims subject to reexamination and that the scope of the patent claims has not been enlarged.

Patent Owner petitions for supervisory authority under 37 CFR 1.181(c) to over turn the examiner's withdrawal of new dependent claims 14-21, 24-27, 30-32, 35-38, 41-44, 48-51 and 55-57 added in the present proceeding. Patent Owner asserts that all newly added dependent claims are narrower in scope than the broadest claims subject to reexamination. Patent Owner also contends no authority under the Patent Code, USPTO regulations or MPEP was cited or relied

upon by the examiner for support of the proposition that the examiner has discretion to withdraw newly added claims that are otherwise presented as in compliance with USPTO practice.

Patent Owner argues that the withdrawal of the new dependent claims is contrary to the statute, 35 U.S.C. 305, which provides that new claims may be added so long as they do not enlarge the scope of the original claims. Patent Owner further argues the withdrawal is contrary to (a) 37 CFR 1.505(sic) that provides that new claims may be added by the patent owner, and (b) the MPEP 2250 which provisions provide that new claims may be added by the patent owner (see MPEP 2250.I.B). Patent Owner contends that the USPTO is bound by the provisions of the statutes and there can be no question that the statute authorizes the consideration of new claims proposed by the patent owner. It is the Patent Owner's position that the withdrawal of the identified claims is contrary to statute, regulations, and the MPEP.

Analysis and Conclusions:

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

> In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto **in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent** (emphasis added). No proposed amended or new claim enlarging the scope of the patent will be permitted in a reexamination proceeding under this chapter.

37 CFR 1.552 (b) states:

> (a) Claims in an *ex parte* reexamination proceeding will be examined on the basis of patents or printed publications and, with respect to subject matter added or deleted in the reexamination proceeding, on the basis of the requirements of 35 U.S.C. 112.
>
> (b) Claims in an *ex parte* reexamination proceeding will not be permitted to enlarge the scope of the claims of the patent.
>
> (c) **Issues other than those indicated in paragraphs (a) and (b) of this section will not be resolved in a reexamination proceeding. If such issues are raised by the patent owner or third party requester in a reexamination proceeding, the existence of such issues will be noted by the examiner in the next Office action, in which case the patent**

owner may consider the advisability of filing a reissue application to have such issues considered and resolved.

37 CFR 1.550 states:

> 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.

As to claims 16, 17, 20, 21, 26, 27, 32, 37, 38 ,43, 44, 50, 51, and 57, it is sufficiently clear that they have been added in an effort to "distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent" as required by 35 U.S.C. 305 for an amendment in reexamination; they are deemed to be linked to the invention of the existing patent claims. Accordingly, claims 16, 17, 20, 21, 26, 27, 32, 37, 38 ,43, 44, 50, 51, and 57 will be examined together with already-examined claims 1, 2, 4-13, 22, 23, 28, 29, 33, 34, 39, 40, 45-47, 52-54, 58 and 59. The discussion which now follows is directed to the remainder of the claims added March 23, 2006, and reference to the "newly" added claims applies only to this remainder of the claims.

The reexamination statute provides that anyone, at any time, may request reexamination any claim of a patent based on prior art patents and printed publications. 35 U.S.C. §§ 301, 302. See also House Report No 66-1307, 96th Cong. 2d Sess. As stated in the legislative history of Chapter 30 of title 35, reexamination "will permit any party to petition the patent office to review the efficacy of a patent, following its issuance, on the basis of new information about pre-existing technology which may have escaped review at the time of the initial examination of the application." House Report at 3-4. The function of reexamination is to increase the reliability of patents thought to be of doubtful validity. *In re Etter*, 756 F 2d 852, The function is reflected in 35 U.S.C. 303 which requires the USPTO Director to determine that there is a substantial new question (SNQ) of patentability before a reexamination proceeding can commence. Thus, the SNQ is the focal point of every reexamination. The ability of a patentee to amend the claims or add new claims must be seen in light of the purpose of reexamination – the determination of validity in light of the substantial new question(s) of patentability. Thus, amendment of the claims during reexamination is limited to amendment in light of prior art raising a substantial new question of patentability. This is reflected in the statement of 35 U.S.C. 305 authorizing the presentation of new or amended claims "in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent." It does not appear that the newly added claims have anything to do with resolving any substantial new question of patentability of record, or resolving any decision adverse to the patentability of a claim of a patent raised by the Office during the present proceeding.

Stated another way, reexamination was enacted for resolving the patentability of the existing patent claims over prior patents and printed publications, with revision of the patent claims being carried out to affect that purpose; reexamination was **not** enacted for the purpose of increasing the number of claims in the patent and the scope/spectrum of claim protection. As pointed out by the Federal Circuit in its decision, *In re Freeman*, 30 F.3d 1459, 31 USPQ 2d 1444 (Fed. Cir. 1994):

> "[T]he ability of a patentee to amend claims during reexamination must be seen in light of the fundamental purpose of reexamination -- the determination of validity in light of a substantial new question of patentability. Thus, amendment of claims during reexamination is limited to amendment in light of prior art raising a substantial new question of patentability." [Citation omitted] [30 F.3d at 1468, 31 USPQ 2d 934, 1451].

It is also to be noted that the addition of claims toward multiple new species or embodiments dependent from generic patent claims may very well take the examiner's focus off of the patentability determination for the existing patent claims. Further, the time and effort expended in addressing the newly added claims detracts from the statutorily mandated "special dispatch" within the Office to resolve the substantial new question of patentability raised for the existing patent claims, and is thus contrary to the reexamination statute in that respect. See 35 U.S.C. 305. Aside from the administrative difficulties, the delay, and the confusion of the record resulting from the addition of claims in a reexamination proceeding, it must be appreciated that the intent of the reexamination statute is simply not for the purpose of adding claims to augment and improve the patent's package of claim protection. As stated above, the innate function of the reexamination process is to increase the reliability of the Office's action in issuing a patent by reexamination of patents thought "doubtful;"it is not to expand the scope of protection.

It is clearly <u>not</u> the intent of the reexamination statute that a reexamination proceeding be used to "round out" claim coverage (i.e., to augment and improve the patent's package of claim coverage); where such is permitted, such correction of a patent is rather accomplished via reissue, in which a number of conditions (not required in reexamination) must be met. If there is an "error" in the patent as defined by 35 USC 251, which would dictate correction of the patent by increasing the number of claims, the appropriate vehicle to increase and shape claim protection is via reissue, not reexamination. Any attempt to correct claim scope of the patent via reexamination circumvents the reissue statute, since new claims presented in a reexamination proceeding do not require support by a reissue oath/declaration, and since patent owner avoids paying the reissue fees for the filing, search, examination, and issue of new claims added, that are required in reissue. Also, unlike a reissue proceeding where a full search *de novo* is made as a

matter of procedure, the additional limitations presented via reexamination in the new claims would be considered only in light of the references of record in this proceeding, since MPEP 2254 provides that "[a] full search will not routinely be made by the examiner."

In this instance, Patent Owner has pointed to support in the original specification; however, there is no indication as to why these claims are necessary to overcome any art rejection or to place the original claims in condition of patentability, and the Office is left to guess at how Patent Owner views that the art would be applied to the new claims. Specifically, there is no showing as to why the added claims were needed to "distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent" as required by 35 U.S.C. 305 for an amendment in reexamination. Also, Patent Owner has failed to explain what substantial new question of patentability exists as to the added claims that would make them subject to reexamination. Further, Patent Owner has not set forth the pertinency and manner of applying cited prior art to every added claim. It is to be noted that there is no reason why a patent owner wishing to add multiple claims to obtain reexamination of them (i.e., to place them in a reexamination proceeding) should be in a better position than is the requester who is required to point out the substantial new question(s) of patentability and apply the art to each claim requested.

Since these claims are not being presented in response to the Office action, i.e. to distinguish the invention from the cited art or to respond to an adverse decision regarding the patentability of any of the original claims, no examination of these claims is deemed warranted. These claims are simply not properly part of the reexamination proceeding, and will be canceled at the time the reexamination proceeding is terminated.

As a final point, it has been noted that the newly added claims are drawn to embodiments that were not presented during the examination of the application which resulted in the patent currently being reexamined. Even though the claims are written in dependent form, adding claim language does not mean that scope of claims is necessarily further limited. These added claims include the addition of unlimited amounts of undefined components and are seen to represent embodiments that could have been subject to restriction in regular examination.

<u>In conclusion:</u> The requestor (1) did not submit claims 14, 15, 18, 19, 24, 25, 30, 31, 35, 36, 41, 42, 48, 49, 55, and 56 to distinguish the claims over the cited art or in response to an adverse decision as to the patentability of the patented claims, and (2) did not request reexamination of these claims, <u>accompanied by</u> an assertion of the existence of a substantial new question of patentability for such claims (see 35 USC 311(b)(2), 37 CFR 1.510(b)(1)) and application of the art of record to the new claims (37 CFR 1.510(b)(2)). Accordingly, such claims will not

be reexamined, and as pointed out above, will be cancelled at the time the prosecution on the reexamination proceeding is terminated.

Conclusion

1. The patent owner's petition for supervisory authority to overturn examiners withdrawal of newly added claims is **granted-in part**.

2. Claims 16, 17, 20, 21, 26, 27, 32, 37, 38 ,43, 44, 50, 51, and 57 will be examined together with already-examined claims 1, 2, 4-13, 22, 23, 28, 29, 33, 34, 39, 40, 45-47, 52-54, 58, and 59. Claims 14, 15, 18, 19, 24, 25, 30, 31, 35, 36, 41, 42, 48, 49, 55, and 56 remain withdrawn from consideration and will be cancelled at the time the prosecution on the reexamination proceeding is terminated.

2. Response may be submitted as follows:

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

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

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

3. Jurisdiction over the proceeding is forwarded to the examiner for action not inconsistent with this decision.

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

for Lissi M. Marquis
Director,
Central Reexamination Unit

January.3, 2008
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Commissioner for Patents
United States Patent and Trademark Office
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600 13th Street NW
Washington, DC 20005

(For Requester)

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FEB 22 2007

CENTRAL REEXAMINATION UNIT

Patentee: In re Palmaz	:
Reexamination Proceeding	: DECISION ON
Control No. 90/007,627	: PETITION
Filed: July 13, 2005	: (37 CFR §§ 1.515(c) & 1.181)
For: U.S. Patent No. 4,739,762	:

This is a decision on third party reexamination requester's October 26, 2005 petition entitled "PETITION REQUESTING RECONSIDERATION OF A DECISION DENYING *EX PARTE* REEXAMINATION OF U.S. PATENT NO. 4,739,762." Petitioner, the third party reexamination requester, seeks review under 37 CFR 1.515(c) and 37 CFR 1.181 of the examiner's Order dated September 26, 2005 denying the request for reexamination.

Pursuant to MPEP § 2248, the petition is before the Director of the Central Reexamination Unit (CRU) for decision.

The petition is **granted** as to claims 16, 23, 44, 51 and 54, and is **denied** as to claims 1-12, 14-15, 17-22, 25-43, 45-50, 52-53 and 55-59.

BACKGROUND

1. U.S. Patent No. 4,739,762 (the '762 patent) issued on April 26, 1988.

2. A third party requester filed a request for reexamination of the '762 patent on October 6, 1997, and the request papers were assigned Control No. 90/004785 (the '4785 proceeding).

3. The '4785 proceeding concluded with the issuance of reexamination certificate 3,650 on October 27, 1998. The certificated noted the cancellation of claims 13 and 24; the confirmation of claims 23 and 34; the determination of patentability as amended of claims 1, 14, 16-19, 25, 29, 31-33, 35, 37, 40 and 41; the determination of patentability of claims 2-12, 15, 20-22, 26-28, 30, 36, 38-39, 42 and 43 which depend upon an amended claim; and new claims 44-59 were found patentable.

4. A third party requester filed a request for reexamination of the '762 patent on July, 13, 2005, and the request papers were assigned Control No. 90/007627 (the '7627 proceeding).

5. On September 26, 2005, an order denying reexamination was issued, finding that a substantial new question of patentability was not raised by the request for reexamination.

6. On October 26, 2005, the third party requester timely filed the instant petition under 37 CFR 1.181, requesting reconsideration of the denial of reexamination, which found that a substantial new question of patentability was not raised by the request for reexamination.

7. On July 25, 2006, the third party requester filed a second petition under 37 CFR 1.181, requesting reconsideration of the denial of reexamination. That petition paper is being "returned" to the third party requester as not having a right of entry, in a decision of the Senior Legal Advisor of the Office of Patent Legal Administration which is being mailed on even date.

DECISION

I. Petitioner Requests for Relief

In the petition dated October 26, 2005, petitioner requests that the CRU Director:

(1) Reverse the examiner's denial of the request for *ex parte* reexamination of United States Patent No. 4,739,762 (hereinafter the '762 patent) that was filed on October 26, 2005, on the grounds that the examiner misapplied the Ersek patent (U.S. Patent 3,657,744);

(2) Reverse the examiner's denial of the request for *ex parte* reexamination of the '762 patent on the grounds that the examiner failed to consider the requester's allegation that the patent owner made false statements during the examination of the '762 patent;

(3) Reverse the examiner's denial of the request for *ex parte* reexamination of the '762 patent on the grounds that the examiner failed to properly apply the SIE submission in a substantial new question analysis;

(4) Reverse the examiner's denial of the request for *ex parte* reexamination of the '762 patent on the grounds that the examiner's reliance on the Delaware District Court [1] findings of fact and conclusions of law in related litigation proceedings was misplaced.

(5) Reverse the examiner's denial of the request for *ex parte* reexamination of the '762 patent on the grounds that the examiner misunderstood the patent owner's alleged admissions regarding Hammerslag (US 4,560,374); and

(6) Reverse the examiner's denial of the request for *ex parte* reexamination of the '762 patent on the grounds that the examiner failed to consider petitioner's submitted 35 U.S.C. § 102(g) prior art.

The original request for reexamination asserted a number of grounds in support of reexamination, and these grounds were addressed in the examiner's order denying reexamination. In the present

[1] *Cordis Corp. v. Medtronic AVE Inc.*, 194 F. Supp. 2d 323 (D. Del. 2002), *aff'd.*, 188 Fed. Appx. 984 (Fed. Cir. 2006); *See also Cordis Corp. v. Boston Scientific Corp.*, 2005 U.S. Dist. LEXIS 10795 (D. Del., June 3, 2005).

decision, however, only those grounds being challenged by the petitioner are being reviewed. The review of such grounds will be undertaken *de novo,* pursuant to MPEP 2248.

II. Petitioner's Positions in the Request for Reconsideration

Position (1):

Petitioner alleges the examiner erred in denying the request for reexamination by improperly distinguishing the allegedly anticipatory U.S. Patent 3,657,744 to Ersek (hereinafter the '744 patent) in regards to the intra-luminal delivery and smooth outer surface aspects of the '744 patent and the present '762 patent.

Position (2):

Petitioner alleges the examiner should have considered the requester's allegations that false statements were made by individuals associated with the filing and prosecution of the patent.

Position (3):

Petitioner alleges the examiner erred in denying the request for reexamination by not considering the non-cumulative aspects of the SIE submissions, i.e. the technical aspects of mesh/design features that permit endothelialized securing of the invention to vessel walls.

Position (4):

Petitioner alleges the examiner erred in denying the request for reexamination by giving overly broad deference to the Delaware Federal District Court's findings of law and fact, made in a patent infringement action involving the '762 patent.

Position (5):

Petitioner alleges the Examiner erred in denying the request for reexamination by failing to give weight to the teachings of U.S. patent 4,560,374 to Hammerslag (hereinafter referred to as the '374 patent) as explicated by the '762 patent owner's licensing activity of the '374 patent, which petitioner urges should be treated in the nature of an admission.

Position (6):

Petitioner alleges the examiner erred in denying the request for reexamination, by failing to address, and presumably failing to consider, petitioner's alleged 35 U.S.C. § 102 (g) prior art.

III. Summary of Findings

This decision finds positions 1-3, 5-6, and position 4 as it relates to the 1980 Monograph, not to be persuasive.

This decision finds position 4, as it relates to the 1983 Monograph, to be persuasive.

Accordingly, the petition is granted as to patent claims 16, 23, 44, 51, 54 based upon the 1983 Monograph, and the '762 patent will be reexamined as to those claims.

IV. 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 CRU Director's review on petition is a *de novo* review.[2] Therefore, the review will determine whether reexamination is warranted based upon the record as a whole, 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.

V. The Legal Standard for Ordering Reexamination

35 U.S.C. §§ 302-307 and 37 CFR §§ 1.510-1.570 provide that *ex* parte reexamination of a United States patent is only authorized when 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.

Issues relating to grounds of rejection other than those based on prior art patents or printed publications are **not** to be included in the request, and such issues will not be considered by the examiner if included.[3]

Where reexamination of a patent is requested, 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 do raise a "substantial" question of patentability, it is still required that the "substantial" question be a "new" question, before the reexamination request will be granted. If the same question of patentability has already been decided by a Federal Court final holding of invalidity after all appeals, or by the Office in a prior examination of the patent or in a previous or pending reexamination of a patent, then a "substantial new question of patentability" will not have been raised, and reexamination will not be granted. [4] If a substantial new question of patentability is found to be raised, then an order granting *ex parte* reexamination of the patent is issued. [5]

VI. Analysis of the Petitioner's Request for Reconsideration

A. Analysis of Request/Position (1):

Petitioner's assertion the examiner erred in denying the request for reexamination by improperly distinguishing the allegedly anticipatory '744 patent is not persuasive, and petitioner does not otherwise raise a substantial question of patentability regarding at least one claim of the '762 patent based upon the '744 patent. As pointed out above, a prior art patent or printed publication raises a substantial question of patentability where there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and/or publications would be considered important, then the examiner should find "a substantial new question of patentability" unless the same question of patentability has already been decided as to the claim in a final holding of invalidity by the Federal court system or **by the Office in a previous examination.** Conversely, the same patent or printed publication can be presented in a subsequent request for reexamination and raise a substantial question

[2] See MPEP 2248.
[3] MPEP §§ 2216 and 2217.
[4] See MPEP 2242 for a detailed discussion of the meaning of "substantial new question of patentability."
[5] 35 USC § 304(a).

of patentability if the reference is being presented in a new light or in a different way as compared to the prior proceedings. See MPEP §§ 2242, 2258.01.

The examiner's Order pointed out that the '744 patent was actively applied in the initial examination of, and a prior reexamination of, the present '762 patent. The examiner noted that the issue of smoothness and roughness of the surfaces of equivalent structural surfaces were examined and found to result in patently distinct differences. The examiner found no new issue on this technical feature raised by the third party requester's request. However, for the benefit of requester, the examiner fully vetted and explicated the reasoned basis for these patently distinct technical differences. [6] In the absence of presenting the '744 reference in a new light as compared to the prior proceedings, the requester did not, and does not, raise a substantial new question of patentability based on the '744 reference.[7] After a review of the record as a whole, the examiner's conclusion that the '744 patent does not raise a substantial new question of patentability is found to be proper. The evidence, arguments and original presentment by requester regarding a substantial new question of patentability directed to this issue is deemed insufficient to support a finding of a substantial new question of patentability.

B. Analysis of Request/Position (2):

The petition is not persuasive that the examiner's failure to consider alleged false statements by the patent owner was in error, nor does it otherwise raise a substantial question of patentability regarding at least one claim of the '762 patent based on this issue. Issues of "fraud," " inequitable conduct," or "violation of duty of disclosure" are not considered in reexamination. See MPEP § 2014. See also MPEP § 2280 for *ex parte* reexamination proceedings. Therefore, such an allegation cannot raise a cognizable substantial new question of patentability. Note further, that the examiner evaluated the record as a whole (including the full record of the prior proceedings) and found that consideration of the alleged false statements by the patent owner did not give rise to a substantial new question.

C. Analysis of Request/Position (3):

The petition (and the record, as a whole) fails to show that the SIE submission is not cumulative, or that it otherwise raises a substantial question of patentability regarding at least one claim of the '762 patent. Specifically, the petition points to the technical aspects of mesh/design features, features that ultimately permit endothelialized securing of the invention to vessel walls. Petitioner asserts these features, as disclosed by the SIE submission, were not accorded proper weight in the substantial new question analysis.[8] However, upon a review of the record the examiner considered the technical features in question.[9] The examiner found the SIE submission to be cumulative and less comprehensive than the '744 patent. The examiner found the endothelialization securing aspect of the '744 patent/SIE submission to be contrary to the invention of the '762 patent. Therefore, the technical features petitioner feels were not addressed in a substantial new question analysis were in fact addressed. After a review of the record as a whole, the evidence, arguments and original presentment by requester regarding a substantial new question of patentability directed to this issue are deemed insufficient to support a finding of a substantial new question of patentability.

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[6] Order Denying Request for Ex Parte Reexamination at p. 2-6.
[7] Petition for Reconsideration at p. 6-10.
[8] Petition for Reconsideration at p. 13-15
[9] Order Denying Request for Ex Parte Reexamination at p. 8.

D. Analysis of Request/Position (4):

1. The 1983 Monograph:

Petitioner has asserted that the examiner accorded overly broad deference to the Delaware Federal District Court's findings that the '762 patent's claims were valid, when determining the merits of the request for reexamination. The examiner's denial of reexamination based on the 1983 Monograph was grounded on that deference given. This assertion by petitioner is found to be persuasive.

The threshold for determining the existence of a substantial new question of patentability is outlined in MPEP § 2242, which states - "[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 claim is patentable; and (B) the same question of patentability as to the claim has not been decided by the Office in a previous examination or pending reexamination of the patent or in ***a final holding of invalidity by the Federal Courts*** in a decision on the merits involving the claim." [Emphasis added]

In the "Order Denying Request for *Ex Parte* Reexamination," the examiner gave blanket deference to the Delaware Federal District Court's determinations. However, the District Court found the '762 patent's claims valid; *there was no court determination of claim invalidity.* Thus, a finding of the presence of a substantial new question of patentability based on the 1983 Monograph is **not** precluded by the District Court decision. It is to be noted that MPEP § 2242 III A states:

> "When the initial question as to whether the prior art raises a substantial new question of patentability as to a patent claim is under consideration, the existence of a final court decision of claim *validity* in view of the same or different prior art *does not necessarily mean that no new question is present, because of the different standards of proof employed by the Federal District Courts and the Office.* ***While the Office may accord deference to factual findings made by the district court, the determination of whether a substantial new question of patentability exists will be made independently of the court's decision on validity, because it is not controlling on the Office.***" [Emphasis added]

After a review of the record as a whole, it is found that the request for reexamination meets the criteria for a substantial new question of patentability to be raised based upon the 1983 Monograph. Petitioner's request for reexamination urges that the 1983 Monograph anticipates the limitations of at least one claim.[10] The teaching in the 1983 Monograph regarding anticipation, which discloses an expandable stent with longitudinal fissures, is found to be sufficient for a reasonable examiner to consider same important in deciding whether or not claims 16, 23, 44, 51 and 54 are patentable. And, the same question of patentability regarding the 1983 Monograph 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.

Petitioner is correct in asserting that a substantial new question of patentability exists based upon the 1983 Monograph; accordingly, reexamination is ordered with respect to the 1983 Monograph. Requester has requested reexamination of claims 16, 23, 44, 51 and 54 based on the 1983 Monograph, and claims 16, 23, 44, 51 and 54 will be reexamined based on the 1983 Monograph. Requester has not requested reexamination of claims 1-12, 14-15, 17-22, 25-43, 45-50, 52-53 and 55-59 based on the 1983

[10] Request for *Ex Parte* Reexamination of U.S. Patent No. 4,739,762 under 35 U.S.C. §§ 302-307 and 37 C.F.R. § 1.510 at p. 49-50.

Monograph, and, accordingly, claims 1-12, 14-15, 17-22, 25-43, 45-50, 52-53 and 55-59 will be not be reexamined based on the 1983 Monograph (see MPEP § 2240); no determination has been made as to whether or not the 1983 Monograph raises a substantial new question of patentability as to claims 1-12, 14-15, 17-22, 25-43, 45-50, 52-53 and 55-59.

In determining whether or not to reject claims 16, 23, 44, 51 and 54 using the 1983 monograph, the examiner is directed to consider the threshold issue (substantial question) raised, as to whether or not the monograph is a printed publications. While appropriate deference may be given to a Federal Court's findings of facts in accordance with MPEP § 2242 III A, the court's decision is not to be taken as dispositive of the issue. Rather, the appropriate Office standards must be applied in addressing the issue.

2. The 1980 Monograph:

In regard to the 1980 Monograph, a review of the record as a whole reveals that the 1980 Monograph submitted by requester does not raise a substantial new question of patentability. The request does not provide an identification of the claim(s) for which reexamination was requested, with a detailed explanation of the pertinence and manner of applying the 1980 Monograph to such claims, as is required by statute (see MPEP § 2217; also 35 U.S.C. § 302 – "The request must set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested."). After a review of the record as a whole, the examiner's failure to favorably consider the 1980 Monograph is deemed proper. While the 1983 Monograph appears to provide for an expandable stent with longitudinal fissures, the 1980 Monograph *does not* textually provide a teaching of same, nor any other teaching not previously provided of record. The evidence, arguments and original presentment by requester regarding a substantial new question of patentability directed to this issue are deemed insufficient to support a finding of a substantial new question of patentability.

E. Analysis of Request/Position (5):

Petitioner's assertion the examiner erred in denying the request for reexamination by ignoring the teachings of the '374 patent in light of patent owner admissions is not persuasive, and petitioner does not otherwise raise a substantial new question of patentability regarding at least one claim of the '762 patent based on this issue. The Office policy on admissions in reexamination is set forth in MPEP § 2217 III. While patent owner admissions of record in the file or in a court record may be utilized in combination with a patent or printed publication, "a third party **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.**" MPEP § 2217, emphasis added. Therefore, even assuming *arguendo* the patent owner's licensing activity amounted to an admission, it would fall outside the scope of reexamination, because any such alleged admission would have been made outside the record of the file and the courts. The license agreement was executed outside the file history of the patent owner's patent prosecution files and was not a license agreement executed before a court. Therefore, it is not an admission relating to prior art "established in the record or in court" [11]. Accordingly, the '374 patent was not presented in a new light or different way because petitioner relied upon an improper admission to evidence presentment in a new light or different way. After a review of the record as a whole, the evidence, arguments and original presentment by requester regarding a substantial new question of patentability on this issue are deemed insufficient to support a finding of a substantial new question of patentability based on this issue.

[11] MPEP 2217, Part III is noted.

F. Analysis of Request/Position (6):

Petitioner's assertion the examiner erred in denying the request for reexamination, by failing to address/ consider alleged 35 U.S.C. § 102(g) prior art is not persuasive, and petitioner does not otherwise raise a substantial question of patentability regarding at least one claim of the '762 patent based on this issue. A review of the request for *ex parte* reexamination of U.S. Patent No. 4,739,762 reveals that the alleged § 102(g) prior art submitted by requester was not used as a basis for making a statement alleging that a substantial new question of patentability was raised. Nor was there an identification of the claim(s) for which reexamination was requested based on this § 102(g) art, with a detailed explanation of the pertinence and manner of applying the alleged § 102(g) art; yet, such is required by statute (again see MPEP § 2217; pursuant to 35 U.S.C. § 302, "[t]he request must set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested."). Furthermore, the alleged § 102(g) art is admitted by petitioner to be part of the SIE submission, which was found to be merely cumulative of the '762 patent. See *supra* ¶ C. Also, an independent review of the alleged 35 U.S.C. § 102(g) art finds that such art also merely cumulative relative to the '762 patent. After a review of the record as a whole, the examiner's refusal to order reexamination based upon the alleged § 102(g) art is proper. The evidence, arguments and original presentment by requester regarding a substantial new question of patentability on this issue are deemed insufficient to support a finding of a substantial new question of patentability.

VII. Holding

1. After a review of the record as a whole, and based on the facts and law involved in this proceeding, the request for *ex parte* reexamination of the request was properly found by the examiner not to raise a substantial question of patentability regarding at least one claim of the '762 patent in regards to petitioner's Positions 1-3, 5-6 and the 1980 Monograph of Position 4. Accordingly, reexamination is hereby **DENIED.**

2. Due to the use of the incorrect deferential standard for considering Federal Court determinations in evaluating the request for *ex parte* reexamination of the '762 patent, it was erroneously found that the request failed to raise a substantial question of patentability regarding at least one claim of the '762 patent with regards to petitioner Request/Position 4 as to the 1983 Monograph. The evidence presented is regarded as being of sufficient clarity and detail so as to support a finding that a substantial new question of patentability is raised by the request for *ex parte* reexamination in regards to claims 16, 23, 44, 51 and 54 for which reexamination was requested based on the 1983 Monograph. Accordingly, reexamination is hereby **GRANTED**.

VIII. Party Response

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530(b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (Optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding.

Additionally, 35 U.S.C. 305 requires that reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extension of time in reexamination proceedings are provided for in 37 CFR 1.550(c).

All correspondence relating to this *ex parte* reexamination proceeding should be directed:

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

CONCLUSION

1. The petition is **GRANTED** as to claims 16, 23, 44, 51 and 54.

2. The petition is **DENIED** as to claims 1-12, 14-15, 17-22, 25-43, 45-50, 52-53 and 55-59.

3. With respect to the denial as to claims 1-12, 14-15, 17-22, 25-43, 45-50, 52-53 and 55-59, 35 U.S.C. § 303(c) provides that "[a] determination by the Director ... that no substantial new question of patentability has been raised will be final and nonappealable."

4. This decision is, however, issued *without prejudice to the requester's ability to submit a new request based on* the issues not found to raise a substantial question of patentability regarding the '762 patent claims, by providing additional detail and clarity to view such issues in a new light in an effort to support a finding that substantial new question of patentability is raised.[12]

5. The patent owner may file a statement under 37 CFR 1.530(b) within a 2-month time period from the date of mailing of this decision. Third Party Requester may file a reply to any Patent Owner statement within a 2-month time period from the date of service of a timely filed Patent Owner's statement. No other communication(s) on this matter will be acknowledged or considered.

6. Jurisdiction over the reexamination proceeding is forwarded to the CRU Special Program Examiner (SPRE) for Art Unit 3993.

7. The CRU SPRE will assign the reexamination proceeding to a different examiner of record in accordance with MPEP § 2248.

[12] Any new request should be limited to issues within the scope of reexamination and should not provide information, which cannot be considered in a reexamination proceeding.

8. When the proceeding is ready for preparation of an office action the new examiner will examine claims 16, 23, 44, 51 and 54 based on the 1983 Monograph. The new examiner will consider the threshold issue raised as to whether or not the 1983 monograph is a printed publication as directed above.[13]

9. This decision is final and non-appealable. See 35 USC § 303(c) and 37 CFR 1.515(c).

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

11. Telephone inquiries related to this proceeding should be directed to Andres Kashnikow, Special Programs Examiner AU 3993, at 571-272-4361.

PETITION DENIED IN PART AND GRANTED IN PART.

Lissi M. Marquis, Director
Central Reexamination Unit

February 21, 2007
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[13] Again, MPEP 2286, Part II is noted.

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Wood, Phillips, Katz, Clark, Mortimer
500 W. Madison Street
Suite 3800
Chicago, IL 60661

(For Patent Owner)

MAILED

MAR 3 1 2008

CENTRAL REEXAMINATION UNIT

Kenneth L. Cage
McDermott, Will & Emery LLP
600 13th Street, N.W.
Washington, DC 20005

(For 3rd Party Requester)

Walter Steinkraus
Vidas, Arrett & Steinkraus
6640 Shady Oak Road, Suite 400
Eden Prairie, MN 55344

(For 3rd Party Requester)

Reexam Control No.: 90/007,627
Filed : July 13, 2005
For U.S. Patent No. : 4,739,762

Reexam Control No.: 90/008,780
Filed : July 26, 2007
For U.S. Patent No. : 4,739,762

Reexam Control No.: 90/008,797
Filed : August 9, 2007
For U.S. Patent No. : 4,739,762

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. 90/007,627 was ordered in a decision on petition mailed February 27, 2007. The decision ordered reexamination of claims 16, 23, 44, 51 and 54. No patent owner's statement has been filed nor has an Office action issued in this proceeding. There have been no amendments to the claims, specification and/or drawings in this reexamination proceeding.

Reexamination in application control No. 90/008,780 was ordered in a decision mailed October 22, 2007 indicating that claims 23, 51 and 54 will be reexamined. No patent owner's statement has been filed nor has an Office action issued in this proceeding. There have been no amendments to the claims, specification and/or drawings in this reexamination proceeding.

Reexamination in application control No. 90/008,797 was ordered in a decision mailed October 23, 2007 indicating that claims 1-12, 14-23 and 25-43, will be reexamined. No patent owner's statement has been filed nor has an Office action issued in this proceeding. There have been no amendments to the claims, specification and/or drawings in this reexamination proceeding.

As evidenced by the above facts, reexamination control No. 90/007,627, reexamination control No. 90/008,780 and reexamination control No. 90/008,790 are currently pending. Since the order to reexamine has been mailed in all three reexamination proceedings, a decision under 37 CFR 1.565(c) is timely. Accordingly, the above-captioned reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

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. Claims 1-12, 14-23, 25-44, 51 and 54, will be reexamined. Claims 45-50, 52, 53, and 55-59 will not be reexamined as none of the above-identified requests requested reexamination of these claims. All papers mailed by the Office will take the form of a single action that jointly applies to each of the three reexamination proceedings. All papers issued by the Office will contain the identifying data for each of the three proceedings, and each action will be entered into each of the three files (which will be maintained as separate files). Any paper 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 each of the two third party requesters and requesters will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief, brief fee, oral hearing fee, etc.), 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 multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings 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

Reexamination Control Nos. 90/007,627; 90/008,780 and 90/008,797 are hereby merged. Upon mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit 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.

Andrés Kashnikow

Lissi Mojica Marquis,
Director
Central Reexamination Unit

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Price Heneveld Cooper Dewitt & Litton, LLP
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PO Box 2567
Grand Rapids, MI 49501

For Patent Owner

MAILED

FEB 12 2007

CENTRAL REEXAMINATION UNIT

In re: Enke et al.
Ex Parte Reexamination Proceeding
Control No. 90/007,629
Filed: July 13, 2005
For: US Patent No. 5,175,430

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

This is a decision on the January 24, 2007, "Petition for Extension of Time Under 37 CFR 1.550(c)" requesting that the time for responding to the Office action dated December 8, 2006 be extended by two weeks.

The petition is before the Director of the Central Reexamination Unit (CRU) 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 8, 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 January 24, 2007, together with authorization to charge 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. ...
>
> 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.

Patent Owners Showing of Sufficient Cause to Grant an Extension of Time

The petition states that an interview with the examiner is scheduled for February 8, 2007, and that such could not be scheduled earlier due to the examiner's schedule.

Analysis and Findings

While in general the Office does not grant extensions of time solely for the purpose of conducting an interview, in the instant case, given the examiner's lack of availability and the short amount of time requested, a two week extension is both reasonable and a suitable balance between the need for special dispatch and the requirement to give Patent Owner a fair opportunity to defend the patent.

Accordingly, the time for filing a reply to the outstanding Office action is extended for two weeks and therefor the reply is due on February 22, 2007. 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 filed on January 24, 2007 is <u>granted</u>.

2. The Patent Owner's response is due February 22, 2007.

2. The response may be submitted as follows:

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

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

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

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

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.
90/007,633	07/18/2005	6569427	07588/041001	8619

7590 02/14/2006

PENNIE & EDMONDS
1155 Avenue of the Americas
New York, NY 10036

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/14/2006

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

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New York, NY 10036

(For Patent Owner)

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FEB 14 2006

REEXAM UNIT

Paul T. Clark
Clark & Elbing LLP
101 Federal Street
Boston, MA 02110

(For Requester)

In re PharmaStem Therapeutics, Inc.
Reexamination Proceeding
Control No.: 90/007,633
Filed: July 18, 2005
For: U.S. Patent No. 6,569,427 B1

: DECISION ON PETITION TO
: VACATE ORDER
: GRANTING REEXAMINATION

This is a decision on the November 14, 2005 patent owner petition entitled PETITION TO VACATE ORDER UNDER 37 CFR 1.181(a)(3) by which patent owner petitions to have the order granting the above-captioned reexamination proceeding vacated as being an *ultra vires* action by the Office. A requester opposition to the petition to vacate was filed on November 28, 2005.

This reexamination proceeding, the patent owner petition, and the third party requester opposition are before the Office of Patent Legal Administration.

SUMMARY

A. The petition to vacate is dismissed for the reasons set forth below.

B. The September 13, 2005 order granting reexamination in the 90/007,633 proceeding remains intact.

REVIEW SALIENT OF FACTS

1. U. S. Patent No. 6,569,427 (the '427 patent) issued on May 27, 2003.

2. The '427 patent claims benefit under 35 U.S.C. § 120. The recited benefit claim states that the '427 patent is a continuation of application No. 07/950,356, which in turn is a continuation of U. S. Patent No. 5,192,553, which is a continuation-in-part of U. S. Patent No. 5,004,681.

3. The '427 patent is the subject of litigation that commenced on May 27, 2003.

4. A first request for reexamination of the '427 patent was filed on March 10, 2005, and was assigned reexamination control number 90/007,458 (the '458 proceeding). Reexamination was ordered in the '458 proceeding on April 27, 2005. No further action has been taken in the '458 proceeding.

5. A second request for reexamination of the '427 patent was filed on July 18, 2005, and resulted in the present 90/007,633 reexamination proceeding (hereinafter the '633 reexamination proceeding). Reexamination was ordered for the '633 reexamination proceeding on September 13, 2005. No further action has been taken in the '633 reexamination proceeding.

6. On November 14, 2005, the patent owner filed a petition under 37 CFR 1.181(a)(3) to vacate the '633 reexamination proceeding.

7. On November 28, 2005, the third party requester filed an opposition to the petition to vacate the '633 reexamination proceeding.

8. A patent owner's statement under 37 CFR 1.530 has not been received in the '633 reexamination proceeding.

DECISION ON PETITION TO VACATE THE SEPTEMBER 13, 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."

35 U.S.C. § 304 states, in part:

> "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." (Emphasis supplied.)

35 U.S.C. § 121 states:

> "If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application."

37 CFR 1.525(a) states, in part:

> "If a substantial new question of patentability is found pursuant to § 1.515 or § 1.520, the determination will include an order for ex parte reexamination of the patent for resolution of the question. (Emphasis in bold supplied.)

37 CFR 1.181 states, in part:

> "(a) Petition may be taken to the Director:
> (1)From any action or requirement of any examiner in the ex parte prosecution of an application, or in *ex parte* or *inter* partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
>
> ...
>
> (3) To invoke the supervisory authority of the Director in appropriate circumstances. "

MPEP § 2240 states, in part:

> "It is only necessary to establish that a substantial new question of patentability exists as to any one of the patent claims in order to order reexamination. In the examination stage of the reexamination, normally all patent claims will be reexamined, even where the order has made a finding of a substantial new question for less than all of the patent claims."

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:
>
> "(A) the reexamination order is not based wholly on prior art patents or printed publications; ..."

<u>Review of the Request for Reexamination</u>

The request for reexamination alleged the existence of a substantial new question of patentability on two grounds. One of the grounds was based on U. S. Patent No. 5,004,681 (the '681 patent) which is the "great-grandparent" of the '427 patent. Third party requester alleged that the '681 raised a substantial new question of patentability for patent claims 49-56 based on obvious type double patenting, an issue not considered on the record during prosecution of the '427 patent. Third party requester further alleged that a substantial new question of patentability was raised for claims 49-56 based upon consideration of two publications referred to by requester as the Koike publication and the Douay publication. Both publications were alleged to qualify as prior art to the '427 patent.

<u>Review of the Order Granting Reexamination</u>

The examiner's order granting reexamination found that the request for reexamination established the '681 patent to raise a substantial new question of patentability with respect to claims 49-56 of the '427 patent on the grounds of double patenting, but found that no new question of patentability was raised by the Koike and Douay publications. [1] The existence of a single substantial new question of patentability with respect to claims 49-56 of the '427 patent

[1] Order granting reexamination, paragraph bridging pages 2 and 3.

will result in the reexamination proceeding being addressed in the examination stage, pursuant to MPEP § 2240.

Review of Patent Owner's Argument for Vacatur

In the petition to vacate the reexamination order, the patent owner points out that the order for reexamination was based solely on the existence of substantial new question of patentability raising an issue of obviousness type double patenting. While recognizing that reexamination may properly be ordered based on a substantial new question of patentability based upon obviousness type double patenting, [2] patent owner argues that the order for reexamination in the instant reexamination proceeding was improper because the application of obviousness type double patenting is, in this instance, statutorily precluded under 35 U.S.C. § 121.

Patent owner takes this position based on the assertion that there was an examiner's requirement for restriction requirement imposed in the '681 patent, and in that restriction requirement, the claims in the '681 patent were grouped as one invention (Group 1), while the claims of the '427 patent are "in, or consonant with," a different grouping that was designated as Group (III) in that restriction requirement. Specifically, patent owner states that Group I in the restriction requirement consisted of claims 1-9, described as being directed to "hematopoietic stem cell, a neonatal or fetal blood cell and a cryopreservative." Patent owner further states that Group III in the restriction requirement consisted of claims 14-25, described as being directed to "methods for obtaining (preserving) cells." Accordingly, patent owner seeks relief in the form of a decision vacating the September 13, 2005 order for reexamination as an *ultra vires* action taken by the Office, because the question of obvious type double patenting cannot be raised due to the language of 35 U.S.C. §121 that states:

> "A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application."

Findings

I. Obviousness Type Double Patent May Properly Raise A Substantial New Question Of Patentability So As To Confer Jurisdiction To Reexam On The Office

As noted, *supra*, patent owner recognizes that obviousness type double patenting is appropriate as a basis for finding a substantial new question of patentability on which to base reexamination of a patent. Patent owner contends only that the examiner's determination that the '681 patent raises a substantial new question of patentability for claims 49-56 is erroneous, because this determination is barred as a matter of law by 35 U.S.C. § 121 when the facts involved, *i.e.*, claims 49-56 of the '427 patent are properly analyzed and compared with the non-elected claims of the '681 patent. Patent owner's position is that restriction was required in the '681 patent, the claims elected for prosecution in the application matured into the '681 patent, and the resulting claims of the '681 patent are drawn to hematopoietic stem cells, while claims 49-56 of the '427 were in, or consonant with, a different group of claims in the restriction requirement, having claims drawn to methods of obtaining (preserving) cells.

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[2] Petition, page 5, in which patent owner cites *In re Lonardo*, 1119 F. 3d 960, 43 USPQ2d 1262 (Fed. Cir. 1997) for its holding that 35 U.S.C. § 303(a) authorizes the Office to order reexamination based upon obviousness type double patenting.

II. The Restriction Requirement In The Great-Grandparent '681 Patent Does Not Conclusively Establish That The Claims In The '427 Patent Are Immune to Double Patenting Pursuant To 37 U.S.C. § 121 So As To Render The Order Granting Reexamination *Ultra Vires*

First, a review of the 35 U.S.C. § 120 benefit claim on in the '427 patent shows that none of the patents in the benefit claim, including the '427 patent itself, are alleged to be divisional applications. 35 U.S.C. § 121, by its terms, states that "[A] patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application." [Emphasis added] Facially, it does not appear that the '427 patent issued from a divisional application based upon a patent that was subject to a restriction requirement, or that the application from which the '427 patent issued was filed before the issuance of the '681 patent. The availability of the '681 patent based upon double patenting, *i.e.*, whether it is, or is not, precluded by 35 U.S.C. § 121, is an issue to be decided on the merits, and it raises a substantial new question of patentability with respect to some or all of the claims of the '427 patent based.

Further, pages 3-4 of the Order Granting Request for *Ex Parte* Examination set forth an analysis in support of the examiner's finding of the existence of a substantial new question of patentability for claims 49-56 of the '427 patent based upon the obviousness type double patenting in view of claims 1-4 of the '681 patent. This analysis reflects detailed consideration of the matter. Moreover, application claim 14, a claim grouped within Group III in the restriction requirement made in the application [3] that matured into the '681 patent, facially lacks limitations present in claim 49 of the '427 patent, while claim 49 of the '427 patent lacks certain limitations present in application claim 14.

Analysis

As a general proposition, the issue of whether a given patent can or cannot be applied as the basis for a double patenting rejection is a matter to be resolved during the prosecution of the reexamination proceeding and examination of the claims by the examiner, and if necessary, on appeal. Therefore, resolution of this issue would not properly be the subject of a petition. [4] The request for reexamination has raised the issue of the double patenting based on the '681 patent, and the examiner has determined the request to have provided a substantial new question of patentability as to claims 49-56 of the '681 patent. For at least the reasons set forth in Section II of the Findings, *supra*, the examiner's determination has not been shown to be improper on its face, to require an exception to the general rule that it is not the function of the petition process to resolve this matter of applying the art. In other words, the issue also does not appear to fall under the "supervisory authority" provision of 37 CFR 1.181(a)(3).

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. The existence of (a) the issue as to the status of the

---

[3] Application No. 07/119746, filed on November 12, 1987

[4] Pursuant to 37 CFR 1.181(a)(1), petition may be taken to the Director "From any action or requirement of any examiner ... in *ex parte* or *inter partes* prosecution of a reexamination proceeding **which is not subject to appeal** to the Board of Patent Appeals and Interferences or to the court". [Emphasis added]

availability of the great-grandfather '681 patent under 35 U.S.C. § 121 as a basis for double patenting of claims of the '427 patent where there are no divisional applications in the '427 domestic benefit claim stretching back to the '681 patent, (b) the issue as to whether claims 49-56 of the '427 are in fact in, or consonant with, the claims in a group of non-elected claims that was set forth in the restriction requirement made in the '681 patent, and (c) the fact that an order granting reexamination is not a final agency action, all weigh in favor of allowing the reexamination proceedings to continue.

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 question of patentability based upon obviousness type double patenting asserted in the July 18, 2005 reexamination request properly raised a substantial new question of patentability.

CONCLUSION

1. The petition under 37 CFR 1.181 is <u>dismissed</u>.

2. The reexamination proceeding is being forwarded to the Central Reexamination Unit for immediate consideration of merger with *ex parte* reexamination proceeding 90/007,458 in accordance with MPEP § 2283, ultimately leading to a first Office action under 37 CFR 1.550(a) in due course.

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

SM
2/6/06

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,633	07/18/2005	6569427	07588/041001	8619

7590 02/16/2006

PENNIE & EDMONDS
1155 Avenue of the Americas
New York, NY 10036

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/16/2006

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REEXAM UNIT

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

Reexam Control No.: 90/007,548
Filed: March 10, 2005
For U.S. Patent No.: 6,569,427

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. 90/007,633 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. 90/007,548 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

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(For Patent Owner)

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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."

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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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,634	07/19/2005	5737547	043876-0173	8886

20277 7590 04/27/2007

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

EXAMINER

ART UNIT	PAPER NUMBER

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Ann. M. McCrackin

SCHWEGMAN LUNDBERG WOESSNER & KLUTH PA

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Minneapolis, MN. 55402

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007634

PATENT NO. 5,737,547

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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MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON DC 20005-3096	:	For Patent Owner
Ann M. McMrackin SCHWEGMAN LUNDBERG WOESSNER & KLUTH, PA P. O. Box 2938 Minneapolis, MN 55402	:	For Requester
In re: Zuravleff *et alia* *Ex Parte* Reexamination Proceeding Control No. 90/007,634 Filed: July 19, 2005 For: US Patent No. 5,737,547	:	DECISION DENYING PETITION UNDER 37 CFR 1.515(c) & 37 CFR 1.181

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APR 27 2007

CENTRAL REEXAMINATION UNIT

This is a decision on the August 20, 2005, "Petition To The Director For Denial Of Request For Reexamination" filed under 37 CFR 1.515(c) & 37 CFR 1.181. Petitioner, the Third Party Requester, requests that the decision denying the request for reexamination of US Patent 5,737,547 be reversed. The petition request was timely filed.

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

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

Background

1. On July 19, 2005, a third party REQUEST FOR *EX PARTE* REEXAMINATION of U.S. Patent No. 5,737,547 was filed. The third party requester considers that the claims 1-27 are unpatentable over the IEEE Standard (Exhibit PA-A).

2. On July 29, 2005, the examiner denied the request for reexamination on the grounds that the references cited by requester did not raise a substantial new question of patentability because the references did not reasonably suggest the limitations of the requested claims sufficiently to

support a substantial new question for patentability. Further, the examiner noted that in fact teaches away from the claim limitations.

3. On August 20, 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 Central Reexamination Unit (CRU) Director. The Manual of Patent Examining Procedure 2248 further states that the CRU's Director's review will be *de novo.*

Requester raises four points in the petition, those being briefly:

1. The IEEE Standard fully anticipates the '547 patent.
2. The IEEE Standard reference is analogous art and is classified in the same class and subclass as the patent for which reexamination is requested.
3. The examiner overlooked teachings in the reference.
4. The IEEE Standard raises a new question of patentability.

Reexamination is conducted on the basis of prior art which raises a substantial new question of patentability. 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). MPEP 2242(II). Also, in *ex parte* reexamination, "the active participation of the *ex parte* reexamination requester ends with the reply pursuant to §1.535" (37 CFR 1.550(g)).

In the instant case, the third party requester substantially believes that the prior art citation IEE Standard anticipates. The patent claims. The analysis performed by the examiner is reasonable with respect to the claim construction of the patent under which reexamination is requested. The third party requester believes that the examiner overlooked teachings in the reference. Given the reasonable construction of the patent claim limitations the examiner's position that no new substantial new question is raised is a reasonable one. Teachings in a reference are not always germane to the limitations to the claims for which reexamination is sought.

The third party requester further notes that the IEEE Standard is classified in the same class and subclass as the patent for which reexamination is requested. While this may be correct. Analogous art is not the standard by which a substantial new question is determined.

Conclusion

No substantial new question of patentability affecting at least one claim of U.S. patent 5,827,015 has been presented by requester for the reasons set forth above.

The petition is **DENIED**.

This decision is final and nonappealable. See 35 U.S.C. 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

for

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

Lissi Mojica Marquis, Director
Central Reexamination Unit

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ATLANTA, GA 30357-0037

In re Application of	:
D491285 ET AL.	:
Serial No.: 90007635	: PETITION DECISION
Filed: 7/19/2005	:
	:

This is a decision on the petition filed 3/23/2006 to review the 9/20/2005 denial of ex-parte Rexam request.

The request is GRANTED.

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.

Turning to the original request, B. Trent Webb, third-party requester seeks ex parte reexamination pursuant to 37 CFR 1.510 of patent number D491,285 ("'285") issued June 8, 2004.

Reexamination is requested on the single claim of the '285 design patent in view of the earlier U.S. Design Patent D487,521 ("'521"), which is not a cited reference in the '285 patent.

The claims in both patents are directed to the ornamental design for a panel used on the segments of a garage door. Each panel is framed and has what looks like a number of vertical slats separated laterally by V-shaped grooves.

Requester asserts the claim of the '285 patent is fully anticipated under 35 U.S.C. 102(e)(2) by the prior art '521 patent, because "the average observer takes the new design for a different, and a not a

modified, already-existing design." In re Bartlett, 300 F.2d 942, 133 USPQ 204 (CCPA 1962).

Requester points out differences in the number of slats and in the configuration of the frame and concludes the differences would be inconsequential to an average observer.

Requester points out that according to Polaroid Corp. v. Eastman Kodak Co. (citation omitted), "that which infringes if later, anticipates if earlier." Therefore, since the '285 design meets the two requirements for infringement: 1) The overall impression of the patents is substantially similar; and 2) The '285 design appropriates the vertical slats which requestor considers the novelty in the '521 design which distinguishes it from the prior art.

Since the prior art cited in the '521 patent shows no panels having vertical slats and the '285 design shows a major feature of the '521 design, a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable. Therefore, a substantial new question of patentability is raised.

This application is being returned to the examiner for further action according to this decision.

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

Should there be any questions with regard to this letter please contact Joel Sincavage by letter addressed to the Director, Technology Center 1700/2900, P.O. Box 1450, Alexandria, VA 22313-1450, or by telephone at (571) 272-2610.

Jacqueline M. Stone

Jacqueline M. Stone

Director, Technology Center 1700/2900

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: 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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,637	07/20/2005	6482520	2005_1160	5857

23456 7590 11/14/2006

WADDEY & PATTERSON, P.C.
1600 DIVISION STREET, SUITE 500
NASHVILLE, TN 37203

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/14/2006

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
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

11/14/06

W. DOUGLAS HAHM

WENDEROTH LIND & PONACK LLP

2033 K STREET, N.W. SUITE 800

WASHINGTON, D.C. 20006

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007637

PATENT NO. 6,482,520

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

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James R. Cartaglia
Waddey & Patterson, P.C.
1600 Division Street, Suite 500
Nashville, Tennessee 37203

(For Patent Owner)

MAILED

NOV 14 2006

CENTRAL REEXAMINATION UNIT

W. Douglas Hahm
Wendroth, Lind & Ponack, LLP
2033 K Street N.W., Suite 800
Washington, D.C. 20006

(For Requester)

In re Jing-Wen Tzeng
Ex Parte Reexamination Proceeding
Control No. 90/007,637
Filed: July 20, 2005
For: U.S. Patent No. 6,482,520

DECISION DISMISSING PETITION

This is a decision on the patent owner petition, filed October 16, 2006, denominated "Petition Pursuant to Rule 1.47." The petition is being taken as a petition under 37 CFR 1.183 to waive the requirement of 37 CFR 1.131 that the July 21, 2006 declaration under 37 CFR 1.131 of Dr. Julian Norley be signed by all of the inventors.

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

The petition was filed under 37 CFR 1.47, and it was accompanied by the $200 fee under 37 CFR 1.17(g). However, the petition is properly considered under 37 CFR 1.183 and requires a $400 fee under 37 CFR 1.17(f). The additional $200.00 necessary to complete the fee under 37 CFR 1.17(f) for consideration of a petition under 37 CFR 1.183 has been charged to deposit account no. 50-1202 as per the authorization to charge additional fees contained in the transmittal letter.

The petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.131 is **dismissed**.

REVIEW OF FACTS

- On November 19, 2002, U.S. Patent No. 6,482,520 (the '520 patent) issued to Jing-Wen Tzeng.

- On July 20, 2005, the third party requester filed a request for *ex parte* reexamination, and the resulting reexamination proceeding was assigned control number 90/007,637 (the '637 proceeding).

- On September 20, 2005, an order granting the reexamination request was mailed.

- On Monday, November 21, 2005, the patent owner filed a statement in response to the order granting reexamination, as provided for in 37 CFR 1.530.

- On January 19, 2006, the third party requester filed a reply to the patent owner's statement, as provided for in 37 CFR 1.535.

- On May 23, 2006, an Office action on the merits was mailed in which claims 1-5 and 12-15 were rejected, and claims 6-11 and 16-20 were confirmed. The Office action set a 2 month period for response.

- On July 27, 2006, the Office received a response filed by patent owner bearing a certificate of mailing dated July 24, 2006.[1] The response included an amendment which cancelled claims 6, 10, 16, and 19, amended claims 1, 3, 7, 11, 13, 17, and 20, and added new claims 21-30. A declaration under 37 CFR 1.131 by non-inventor Dr. Julian Norley, executed on July 21, 2006, accompanied the response.

- On December 23, 2005, the patent owner filed the instant (above-identified) petitions under 37 CFR 1.324, and 37 CFR 1.183. The petitions each included a certificate of mailing dated December 19, 2005.

- On September 29, 2006, a final Office action was mailed in which claims 1, 2, 11, and 21-30 were rejected, and claims 3-5, 7-9, 12-18 and 20 were confirmed. The declaration of Dr. Norley was deemed defective by the examiner, because Dr. Norley is not an inventor of the '520 patent, and "the patent owner has not demonstrated or even averred that the inventor is otherwise unavailable." The Office action set a 2-month period for response.

- On October 16, 2006, patent owner filed a response, using the electronic filing system (EFS), consisting of an amendment and a petition to have the declaration of non-inventor Dr. Julian Norley considered on the merits. The petition was filed with a payment of $200.00 to cover the petition fee.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR 1.131(a) provides, in pertinent part (emphasis added):

> When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, **the owner of the patent under reexamination**, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. [Emphasis added.]

37 CFR 1.183 provides, in pertinent part:

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[1] July 23, 2006 was a Sunday. Therefore, the submission of the response was timely.

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

MPEP 715.04 I. provides, in pertinent part (emphasis added):

The following parties may make an affidavit or declaration under 37 CFR 1.131:

(A) All the inventors of the subject matter claimed.

(B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.

(C) If a petition under 37 CFR 1.47 was granted or the application was accepted under 37 CFR 1.42 or 1.43, the affidavit or declaration may be signed by the 37 CFR 1.47 applicant or the legal representative, where appropriate.

(D) The assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor. *Ex parte Foster*, 1903 C.D. 213, 105 O.G. 261 (Comm'r Pat. 1903).

Affidavits or declarations to overcome a rejection of a claim or claims must be made by the inventor or inventors of the subject matter of the rejected claim(s), a party qualified under 37 CFR 1.42, 1.43, or 1.47, **or the assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor(s)**. Thus, where all of the named inventors of a pending application are not inventors of every claim of the application, any affidavit under 37 CFR 1.131 could be signed by only the inventor(s) of the subject matter of the rejected claims. [Emphasis added.]

Legal Framework for EFS-Web (http://www.uspto.gov/ebc/portal/efs/legal.htm) states, in part, the following:

EFS-Web
Improper Use of Web Pages
The published waiver of 37 CFR 1.52 mentioned in the Official Gazette notice (240 OG 45, 14 November 2000) is contingent on applicant's conformance to the instructions for use of EFS-Web. Use of EFS-Web in a manner significantly in violation of the instructions may result in non-entry of the submission or failure to accord a filing date (e.g. attempted submission of documents specifically proscribed by the instructions) in the event the USPTO does not fully, successfully, and officially receive all of the elements necessary to obtain a filing date for an intended submission once the applicant clicks the SUBMIT button on the Confirm and Submit screen.

. . .

Documents Policy
EFS-Web will allow registered users to file both new submissions and follow-on documents. **The following is a list of submission types that are not allowed to be filed using EFS-Web**:

. . .

3) A request for reexamination under § 1.510 or §1.913. See 37 CFR 1.6(d)(5) and **documents related to reexaminations.** *[sic.]* [Emphasis Added.]

DECISION

I. Decision sua sponte waiving 37 CFR 1.52

A review of the record reveals that the reexamination proceeding papers filed October 16, 2006, were submitted to the Office by EFS-Web. Reexamination proceeding papers, however, are not permitted to be submitted to the Office by EFS-Web (Note the Legal Framework for EFS-Web cited above). Thus, the October 16, 2006 reexamination 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 patent 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. Note that although this decision accepts the paper as properly submitted to the Office, whether the papers are entitled to entry under 37 CFR 1.116 is a determination within the Examiner's jurisdiction and is not addressed herein.

The fee of $400.00 under 37 CFR 1.17(f) for relief under 37 CFR 1.183 has been paid, as discussed above.

Parties are put on notice that any further reexamination proceeding papers that are submitted to the Office by EFS-Web, will <u>not</u> be accepted, and such may result in a loss of rights.

II. Petition Under 37 CFR 1.183 To Waive the Requirements of 37 CFR 1.131

The petitioner requests the Office to waive the requirement of 37 CFR 1.131 for the declaration to be signed by the inventor and to consider the declaration under 37 CFR 1.131 of Dr. Julian Norley who is not an inventor of any of the claims of the patent. The petition was filed under 37 CFR 1.47; however, the petition is properly treated pursuant to 37 CFR 1.183. There is no issue of joining "in an application for patent" that would be necessary to trigger 37 CFR 1.47 relief.

Addressing the substance of the petition, it is pointed out that the extraordinary relief of waiving a rule is not provided if the rules provide an alternative avenue for obtaining the relief sought - see *Cantello v. Rasmussen*, 220 USPQ 664 (Comr. 1982). In this instance, it would appear that, even if the petition is not granted, patent owner may pursue an alternative avenue that complies with the rules to obtain the requested relief.

37 CFR 1.131 specifically provides that " . . . *the owner of the patent under reexamination. . .* may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is

based" (emphasis added). The rule permits an assignee, or other party in interest, to make a declaration under 37 CFR 1.131 "when it is not possible to produce the declaration of the inventor," as is the case here. See MPEP 715.04 I. In this instance, the petitioner submitted, on October 16, 2006, a copy of papers assigning U.S. application serial number 09/513,001, which matured into the '520 patent under reexamination, to UCAR Graph-Tech, Inc. Thus, there appears to be an assignee [2] available to execute the declaration under 37 CFR 1.131 consistent with 37 CFR 1.131. [3]

The petitioner has not provided evidence of any inability to submit a declaration under 37 CFR 1.131 signed by the assignee of the entire interest in the patent under reexamination. To the contrary, it would appear that patent owner (assignee) patent owner could (1) execute a declaration under 37 CFR 1.131 and use the declaration of Dr. Norley to support the declaration under 37 CFR 1.131 or (2) legally authorize Dr. Norley to act on patent owner's (the assignee's) behalf in providing the affidavit to establish prior invention and provide a statement of such authorization. Accordingly, the petitioner has not shown the present situation to be one warranting extraordinary relief. For this reason, the petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.131 is dismissed.

CONCLUSION

1. For the reasons set forth above, the petition under 37 CFR 1.183 to waive 37 CFR 1.131 as to its requirement for signature of an oath or declaration is **dismissed**.

2. 37 CFR 1.52 is waived to the extent that the reexamination proceeding papers submitted by EFS-Web on October 16, 2006, are now accepted as being properly submitted to the Office. *No such waiver will be granted for any future papers in the reexamination proceeding.*

3. This decision does not address whether the amendment after final and the affidavit under 37 CFR 1.131 have a right to entry at this point of the proceeding. The right of entry under 37 CFR 1.116 is a determination within the jurisdiction of the Examiner of record.

4. An additional $200.00 for consideration under 37 CFR 1.183 has been charged to counsel's deposit account no. 50-1202 in accordance with the authorization to charge necessary fees contained in the transmittal letter accompanying the October 16. 2006 submission.

5. Jurisdiction over the reexamination proceeding is being returned to the Central Reexamination Unit (CRU).

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[2] Note that there are further assignments recorded for this patent. If patent owner persists in the attempt to have the declaration under 37 CFR 1.131 considered, then patent owner should establish the right to take action by filing a statement under 37 CFR 3.73(b).

[3] The assignee may make the 37 CFR 1.131 declaration for a patent under reexamination even if the inventors are available to sign a declaration.

6. **All** correspondence relating to this *ex parte* reexamination proceeding should be directed as follows:

By **U.S. Postal Service 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 to:

Customer Service Window
Randolph Building
401 Dulany St.
Alexandria, VA 22314

7. Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Stephen Stein, in Central Reexamination Art Unit 3991, who can be reached at 571-272-1544.

8. Any inquiry concerning this communication 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

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.
90/007,637	07/20/2005	6482520	2005_1160	5857

23456 7590 10/05/2007

WADDEY & PATTERSON, P.C.
1600 DIVISION STREET, SUITE 500
NASHVILLE, TN 37203

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/05/2007

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
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10/5/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

W. DOUGLAS HAHM

WENDEROTH LIND & PONACK LLP

2033 K STREET, N.W. SUITE 800

WASHINGTON, D.C. 20006

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007637

PATENT NO. 6,482,520

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
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MAILED

OCT 05 2007

CENTRAL REEXAMINATION UNIT

James R. Cartigila
Waddey & Patterson, P.C.
1600 Division Street, Suite 500
Nashville, TN 37203

For Patent Owner

W. Douglas Hahm
Wendroth, Lind & Ponack, LLP
2033 K Street N.W., Suite 800
Washington D.C. 20006

For Requester

Ex Parte Reexamination Proceeding
Control No. 90/007,637
Filed: July 20, 2005
For: US Patent No. 6,482,520

DECISION DISMISSING PETITION

This is a decision on the patent owner petition filed August 24, 2007 for relief pursuant to 37 CFR 1.181, in the form of an order instructing that the Reexamination Certificate for the above captioned patent be issued immediately.

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

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

Review of Facts

On December 2006, a Notice of Intent to Issue Ex Parte Reexamination Certificate was mailed.

On May 22, 2007, the proceeding was returned to the Art Unit for documentation corrections.

On September 12, 2007, the proceeding was sent to Publications for issuance of the certificate.

Conclusion

Since the proceeding has been forwarded to Publications for issuance of the certificate, the petition is moot and is herein dismissed.

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

for Deborah Jones

Lissi M. Marquis,
Director,
Central Reexamination Unit

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.
90/007,638	07/22/2005	6219674	61185.00010	7045

67283 7590 06/17/2010

MONTGOMERY, MCCRACKEN, WALKER & RHOADS, LLP
123 SOUTH BROAD STREET
AVENUE OF THE ARTS
PHILADELPHIA, PA 19109

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/17/2010

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

MAILED

JUN 17 2010

CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

JAMES B. MONROE
Finnegan Henderson Farabow Garrett & Dunner LL
901 New York Avenue, NW
Washington, DC 20001

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007638
PATENT NO. 6,219,674
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

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United States Patent and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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Washington, DC 20001

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007638

PATENT NO. 6,219,674

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
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Montgomery, McCracken,
Walker & Rhoads, LLP
123 South Broad Street
Avenue of the Arts
Philadelphia, PA 19109

(For patent owner)

MAILED

JUN 17 2010

CENTRAL REEXAMINATION UNIT

James B. Monroe
Finnegan Henderson Farabow
Garrett & Dunner LLP
901 New York Avenue, NW
Washington, DC 20001

(For requester)

In re John Barthelow Classen
Ex Parte Reexamination Proceeding
Control No. 90/007,638
Filed: July 22, 2005
For: U.S. Patent No. 6,219,674

DECISION GRANTING PETITION UNDER 37 CFR 1.137(b)

This is a decision on the June 7, 2010 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed Summary of Examiner's Interview and revive the present terminated reexamination prosecution ("the June 7, 2010 petition to revive").[1]

The June 7, 2010 petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The June 7, 2010 petition to revive is **granted**.

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 ...

[1] 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 the written statement of interview required under 37 CFR 1.560(b) for the interview of March 29, 2010.

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) 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. The present proceeding is a reexamination proceeding; thus, the petition does not require a terminal disclaimer.[2]

Regarding item (1), this reexamination proceeding was terminated due to the failure to timely submit a statement of the substance of the March 29, 2010 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 filed within one month from the date of the interview. A statement under 37 CFR 1.560(b) was not filed until June 7, 2010, which was untimely. However, for the purpose of evaluating whether the June 7, 2010 petition to revive is a grantable petition, the June 7, 2010 Summary of Examiner Interview satisfies item (1).

The appropriate petition fee of $810.00 set forth in 37 CFR 1.17(m) for the June 7, 2010 petition to revive has been paid, which satisfies item (2).

A proper statement under 37 CFR 1.137(b)(3) with respect to the June 7, 2010 Summary of Examiner Interview was submitted as part of the June 7, 2010 petition to revive. Item (3) has thus been satisfied.

Accordingly, the June 7, 2010 patent owner petition to revive is **granted**. Prosecution in the above-identified reexamination proceeding will be resumed.

CONCLUSION

1. The June 7, 2010 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. Jurisdiction over this reexamination proceeding is being returned to Art Unit 3992 for processing of the June 7, 2010 Summary of Examiner Interview.

3. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Majid Banankhah, of Art Unit 3992, at (571) 272-3770.

4. Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7728.

Raul Tamayo
Legal Advisor
Office of Patent Legal Administration

[2] *See*: 37 CFR 1.137(d)(3).

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,640	07/07/2005	D498187	FMC 1925 R	9845

28395 7590 09/08/2005

BROOKS KUSHMAN P.C./FGTL
1000 TOWN CENTER
22ND FLOOR
SOUTHFIELD, MI 48075-1238

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/08/2005

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

Order Granting / Denying Request For Ex Parte Reexamination	Control No. 90/007,640	Patent Under Reexamination D498187 ET AL.	
	Examiner Adir Aronovich	Art Unit 2915	

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

The request for *ex parte* reexamination filed 07 July 2005 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a)☒ PTO-892, b)☒ PTO-1449, c)☐ Other: _____

1. ☒ The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. ☐ The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 (c) will be made to requester:

a) ☐ by Treasury check or,

b) ☐ by credit to Deposit Account No. _____, or

c) ☐ by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

Adir Aronovich
Primary Examiner
Art Unit: 2915

cc:Requester (if third party requester)

A substantial new question of patentability affecting the claim of United States Patent Number D498,187 is raised by the request for *ex parte* reexamination.

The claim in the above patent is directed to a vehicle front grille. The newly cited publications (Popular Mechanics, Trailer Life & Spy Shots: 03 Ford Expedition) combined with presently cited publication (Road and Track) and previously cited reference (Patent D491,118) raise new question of patentability for the following reasons:

The publications Popular Mechanics (August 2001), Trailer Life (October 2001) and Spy Shots: 03 Ford Expedition all disclose a 2003 Ford Expedition having a front grille, which (despite poor quality of the photos) appears to be similar to the front grille, disclosed in the Patent D498,187.

The publication "Road & Track" (July 2001) discloses a 2002 Ford Explorer having a front grille with overall appearance similar to the Patent D498,187.

The 2003 Ford Expedition photo posted on the *truckworld.com* website (updated on April 16, 2002) illustrates a 2003 Ford Expedition having a front grille with overall appearance similar to the Patent D498,187.

The previously cited reference (Patent D491,118) illustrates a front grille for an automobile with a similar pattern to the grille shown in the Patent D498,187.

In view of the above, it is noted that the combination of the cited new art and the previously cited reference raises a new question of patentability.

Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that *ex parte* reexamination

proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extensions of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a), to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. D498,187 throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adir Aronovich whose telephone number is (571) 272-2615. The examiner can normally be reached on Tuesday-Friday 7:30 am-5:00 pm. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Watson can be reached on (571) 272-2647. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300.

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).

Adir Aronovich

August 31, 2005

Adir Aronovich
Primary Examiner
Art Unit 2915

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,652	07/28/2005	6861986	WNCP0021USA	6778

27765 7590 07/11/2007

NORTH AMERICA INTELLECTUAL PROPERTY CORPORATION
P.O. BOX 506
MERRIFIELD, VA 22116

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/11/2007

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JUL 11 2007

CENTRAL REEXAMINATION UNIT

North America Intellectual Property Corporation
P.O. Box 506
Merrifield, VA 22116

For Patent Owner

In re Fang et al.
Ex Parte Reexamination Proceeding
Control No. 90/007,652
Filed: July 28, 2005
For: US Patent No.6,861,986

DECISION ON PETITION

This is a decision on the June 27, 2007, "Petition Under 37 CFR 1.181 and MPEP 1002.02(c)" requesting that the finality of the action dated January 5, 2007 be withdrawn, that the amendment filed March 3, 2007 be entered, and that the affidavit filed March 3, 2007 be entered..

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

The petition is granted-in-part and denied-in-part for the reasons set forth below.

Background

A first Office action was mailed on March 17, 2006, the action including a rejection of claims 1-11 under 35 USC 102(b) as being anticipated by US Patent 5,181,044 to Matsumoto et al., and a rejection of claim 13 under 35 USC 103(c) as being obvious over Matsumoto in view of Patent Owner's admitted prior art.

Patent Owner responded on April 24, 2006, arguing, inter alia, that Matsumoto did not show a multi-frequency antenna. No amendments were included in this response. The examiner repeated the above rejections in a final rejection mailed January 4, 2007.

On March 3, 2007, Patent Owner submitted an after-final amendment which proposed amending the background section of the specification, and which further included an affidavit traversing the rejections. The examiner denied entry of both the amendment and affidavit in the advisory action of May 7, 2007. The instant petition was then timely filed on June 27, 2007.

Decision

With respect to the finality of the second action, Patent Owner argues that the examiner's reliance on inherency amounts to a new ground of rejection. Patent Owner further argues that this new ground of rejection was not necessitated by amendment, and therefore the action should not be made final.

What is and is not a new grounds of rejection is discussed in MPEP 1207.03 As stated therein:

> There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See In re Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. Id. At 1303, 190 USPQ at 427 (reliance upon fewer references in affirming a rejection under 35 U.S.C. 103 does not constitute a new ground of rejection).

Here, the basic thrust of the rejection clearly remained the same, viz., that Matsumoto met all the structural requirements of the claims. The examiner's discussion of inherency was merely made in response to Patent Owner's arguments. Examiners may rebut arguments without such rebuttal being deemed a new grounds of rejection, so long as the basic thrust of the rejection remains the same. Given the above, the second action did not in fact include any new grounds of rejection, the examiner's statement to the contrary notwithstanding.

The second action was thus properly made final. Therefore Patent Owner's request to withdraw the finality thereof is **DENIED**.

With respect to entry of the amendment, Patent Owner argues that the proposed amendment "did not touch the merit of this patent and did not change the scope of any claim" and further argues that the examiner did not adequately explain why the amendment was not entered.

Patent Owner's arguments are agreed with. The proposed amendment to the specification does not appear to raise any new issue, and if any new issues are raised by the amendment, they were not adequately explained by the examiner.

Accordingly, Patent Owner's request to enter the amendment to the specification is **GRANTED**.

With respect to entry and consideration of the affidavit, Patent Owner argues that the affidavit was necessary to rebut the examiner's inherency argument, which was first raised in the final rejection. Thus the affidavit could not presented earlier, and Patent Owner has met the 'good and sufficient' requirements of 37 CFR 1.116(e).

This argument is somewhat dubious. The response of April 24, 2006 included the argument that Matsumoto showed a single-frequency antenna, and evidence supporting this argument could have been included with that response. Nonetheless, in addressing after-final practice, MPEP 2272 makes the following points:

> 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.
>
> 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.

In the instant case, the affidavit is seen as stemming from a continuing discussion between the Patent Owner and examiner. Such discussions should not be cut off and Patent Owner's substantive rights possibly sacrificed on purely procedural grounds if it is feasible to avoid such a result. Just as it was appropriate for the examiner to make the second action final despite including new points of argument, so is it appropriate for the examiner to consider the Patent Owner's response to those new points if it all feasible. Put another way, while the Patent Owner could have presented the evidence earlier, the examiner could also have more clearly invoked inherency in the first action as well. Thus both fairness and the rule of reason require the affidavit to be entered and considered.

Accordingly, Patent Owner's request to enter the affidavit is **GRANTED**.

Conclusion

1. Patent Owner's petition is granted-in-part and denied in part as explained above.

2. Further correspondence may be submitted as follows:

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Daniel P. McCarthy
Parsons Behle & Latimer
201 South Main Street, Suite 1800
P.O. Box 45898
Salt Lake City, UT 84145[1]

(For Patent Owner)

MAILED

MAR 13 2008

CENTRAL REEXAMINATION UNIT

A. John Pate
Pate Pierce & Baird
215 South State Street, Suite 550
Salt Lake City, UT 84111

(For 3rd Party Requester)

Stoel Rives LLP-SLC
201 South Main Street
One Utah Center
Salt Lake City, UT 84111

(For 3rd Party Requester)

Reexam Control No.: 90/007,656
Filed : August 5, 2005
For U.S. Patent No. : 5,749,111

Reexam Control No.: 90/008,333
Filed : November 20, 2006
For U.S. Patent No. : 5,749,111

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. 90/007,656 was ordered in a decision mailed October 14, 2005. Prosecution proceeded to the mailing of a Notice of Intent to Issue an *Ex Parte* Reexamination Certificate (NIRC) on January 16, 2007. The NIRC indicated that claims 1-120, all of the claims in the patent, were confirmed. A decision vacating the NIRC was mailed March 12, 2008. There were no amendments made to the claims, specification and/or drawings in this proceeding.

Reexamination in application control No. 90/008,333 was ordered in a decision mailed February 6, 2007 indicating that claims 1-120 will be reexamined. No patent owner's statement has been

[1] Communications from Mr. McCarthy directed to the '7,656 proceeding and received October 15, 2006 and subsequently bear a correspondence address of P.O. Box 71550, Salt Lake City, UT 84171-0550. This address differs from the correspondence address of record. The filing of a formal request to change the correspondence address is suggested to ensure prompt receipt of all Office communications.

filed nor has an Office action issued in this proceeding. There have been no amendments to the claims, specification and/or drawings in this reexamination proceeding.

As evidenced by the above facts, reexamination control No. 90/007,656 and reexamination control No. 90/008,333 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. Accordingly, the above-captioned reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

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. Claims 1-120, all of the claims in the patent, will be reexamined. All papers mailed by the Office will take the form of a single action that jointly applies to both reexaminations. All papers issued by the Office will contain the identifying data for both cases, and each action will be entered into both files (which will be maintained as separate files). Any paper 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. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief, brief fee, oral hearing fee, etc.), 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 multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings 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

Reexamination Control Nos. 90/007,656 and 90/008,333 are hereby merged. Upon mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit 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

cc: Daniel P. McCarthy
P.O. Box 71550
Salt Lake City, UT 84171-0550

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,657	08/05/2005	5994450	3412.7.1	3274

24247 7590 11/20/2009

TRASKBRITT, P.C.
P.O. BOX 2550
SALT LAKE CITY, UT 84110

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/20/2009

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

A. JOHN PATE

PATE PIERCE & BAIRD

215 SOUTH STATE STREET SUITE 550

SALT LAKE CITY, UT 84111

MAILED

NOV 20 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/007,657*.

PATENT NO. *5994450*.

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

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TRASKBRITT, P.C. P.O. BOX 2550 SALT LAKE CITY UT 84110	: FOR PATENT OWNER
A. JOHN PATE PATE PIERCE & BAIRD 215 SOUTH STATE STREET SUITE 550 SALT LAKE CITY, UT 84111	: FOR THIRD PARTY REQUESTER

MAILED

NOV 2 0 2009

CENTRAL REEXAMINATION UNIT

In re Pearce Reexamination Proceeding Control No. : 90/007,657 Filed : August 5, 2005 Patent No. 5,994,450	: DECISION ON PATENT OWNER'S PETITION UNDER 37 CFR 1.183 AND OTHER REQUESTS

This is a decision addressing Patent Owner's submission of December 20, 2007, entitled "REQUESTS FOR RECONSIDERATION AND FOR MORE DEFINITE REPLY, PETITON FOR SUSPENSION OF THE RULES, AND REQUEST FOR EXTENSION OF TIME."

Patent Owner's submission includes a petition under 37 CFR 1.183, two requests for reconsideration, a request for a more definite reply and a request for extension of time. The petition and requests are before the Director of the Central Reexamination Unit for decision.

SUMMARY

A. The request for reconsideration of denial of entry of the amendment filed March 15, 2007 is DENIED.

B. The request for reconsideration of denial of entry of the evidence filed March 15, 2007 is DENIED.

C. The petition for suspension of the rules under 37 CFR 1.183 is DISMISSED under 37 CFR 1.4(c).

D. The request for more definite reply is DISMISSED as moot.

E. The request for extension of time is DENIED.

BACKGROUND

1. Patent No. 5,994,450 (the '450 patent) issued on November 30, 1999.

2. A request for reexamination, assigned Control No. 90/007,657 (the '657 proceeding), was filed by a third party Requester on August 5, 2005.

3. Reexamination was ordered in the '657 reexamination proceeding on September 22, 2005.

4. An Office action on the merits was mailed on June 14, 2006.

5. On August 18, 2006, Patent Owner filed a reply to the Office action by the examiner.

6. A final Office action on the merits was mailed on November 2, 2006.

7. Patent Owner filed a notice of appeal, amendment and response after final on January 8, 2007.

8. Patent owner filed a request for extension of time February 28, 2007.

9. An advisory action was mailed on March 7, 2007.

10. A decision granting a two week extension of time (to March 22, 2007) to file an appeal brief was mailed on March 9, 2007.

11. On March 15, 2007, Patent Owner filed an appeal brief together with claim amendments and affidavits from Tony M. Pearce and William G. Pitt.

12. An advisory action denying entry of the amendment and affidavits, together with a notice of non-compliant appeal brief setting a one month period for response, was mailed November 30, 2007.

13. On December 20, 2007, Patent Owner filed the requests and petition presently under consideration.

DECISION ON PATENT OWNER REQUESTS AND PETITION

A. REQUEST TO RECONSIDER DENIAL OF ENTRY OF THE AMENDMENT FILED MARCH 15, 2007

The advisory action of November 30, 2007 denied entry of the claim amendment due to non-compliance with 37 CFR 1.530. Specifically, the changes previously made in claim 12 relative to the patented claim were not marked with bracketing and underlining.

Patent Owner argues that no amendment was made to claim 12 in the paper filed March 15, 2007. This argument is not persuasive because 37 CFR 1.530(f) requires that all changes relative to the patent being reexamined must include brackets and underlining to indicate the material omitted and added, respectively. Claim 12 as presented on March 15, 2007 is changed relative to the '450 patent, but the changes are not marked as required by the regulation.

Patent Owner's Request is DENIED.

B. REQUEST FOR RECONSIDERATION OF DENIAL OF ENTRY OF THE EVIDENCE FILED MARCH 15, 2007

The advisory action of November 30, 2007 denied entry of the new evidence filed March 15, 2007 because it was not timely filed.

37 CFR 41.33(d) identifies two categories of evidence submitted after a notice of appeal has been filed: (1) an affidavit or other evidence filed after the date of filing an appeal and prior to the date of filing a brief, which may be admitted if certain requirements are met, and (2) all other affidavits or other evidence filed after the date of filing an appeal, which will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1). The evidence in question is clearly in the second category because it was not submitted prior to the date the brief was filed.

Patent Owner argues that the conditions of 41.33(d)(1) have been met. This argument is not persuasive because this section of the regulation does not apply, as noted above.

Patent Owner further argues that the request for extension of time filed February 28, 2007 disclosed that the additional time would be used to supplement the evidence of record after filing an appeal brief. This argument is not persuasive because the request did not indicate that Patent Owner intended to submit the new evidence on the same date as the appeal brief, nor did the decision granting the extension of time (mailed March 9, 2007) authorize this course of action.

Patent Owner's Request is DENIED.

C. PETITION FOR SUSPENSION OF THE RULES UNDER 37 CFR 1.183

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.

Petitions under 37 CFR 1.183 relating to reexamination proceedings are decided by the Office of the Deputy Commissioner for Patent Examination Policy. See MPEP 1002.02(b).

Patent Owner's petition is DISMISSED without prejudice.

D. REQUEST FOR MORE DEFINITE REPLY

Patent Owner argues that the brief statement in the advisory action of November 30, 2007 does not provide sufficient information to allow for evaluation of the propriety of continuing prosecution.

This argument is not persuasive. The evidence submitted March 15, 2007 can not be entered under 37 CFR 41.33. Upon receipt of the advisory action and notice of non-compliant appeal brief, Patent Owner was faced with two possible courses of action: to either submit a corrected appeal brief as detailed in the notice, or not. In either case the evidence would not be entered into the record and Patent Owner would not be able to rely upon it. Since the examiner's conclusions regarding the proffered evidence are of no significance, there is no point in requiring a more detailed explanation of the examiner's reasoning.

Patent Owner's request is DISMISSED as moot.

E. REQUEST FOR EXTENSION OF TIME

Patent Owner requests an extension of time under 37 CFR 1.550(c). Essentially Patent Owner does not wish to prepare a corrected brief until all of the requests and petitions filed December 20, 2007 have been decided.

MPEP 2265 states, in part:

> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent

behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.

Patent Owner has not provided an accounting of diligent behavior in preparing a compliant appeal brief. Patent Owner's argument that the required form of the appeal brief can only be presumed is incorrect. The notice mailed November 30, 2007 provided explicit guidance for preparation of a compliant appeal brief.

Patent Owner's request is DENIED.

CONCLUSION

1. The requests for reconsideration and request for extension of time are DENIED.

2. The petition for suspension of the rules under 37 CFR 1.183 is DISMISSED under 37 CFR 1.4(c).

3. The request for more definite reply is DISMISSED as moot.

4. This reexamination proceeding will be returned to the examiner for further action consistent with the decisions herein.

5. 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 PATENT AND TRADEMARK OFFICE

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

Daniel P. McCarthy
Parsons Behle & Latimer
201 South Main Street, Suite 1800
P.O. Box 45898
Salt Lake City, UT 84145[1]

(For Patent Owner)

MAILED

MAR 13 2008

CENTRAL REEXAMINATION UNIT

A. John Pate
Pate Pierce & Baird
215 South State Street, Suite 550
Salt Lake City, UT 84111

(For 3rd Party Requester)

Stoel Rives LLP-SLC
201 South Main Street
One Utah Center
Salt lake City, UT 84111

(For 3rd Party Requester)

Reexam Control No.: 90/007,659
Filed : August 5, 2005
For U.S. Patent No. : 6,026,527

Reexam Control No.: 90/008,509
Filed : February 27, 2007
For U.S. Patent No. : 6,026,527

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. 90/007,659 was ordered in a decision mailed October 14, 2005. Prosecution proceeded to the mailing of a Notice of Intent to Issue an *Ex Parte* Reexamination Certificate (NIRC) on January 16, 2007. The NIRC indicated that claims 1-38, all of the claims in the patent, were confirmed. A decision vacating the NIRC was mailed March 12, 2008. There were no amendments made to the claims, specification and/or drawings in this proceeding.

Reexamination in application control No. 90/008,509 was ordered in a decision mailed April 20, 2007 indicating that claims 1-38 will be reexamined. No patent owner's statement has been filed

[1] [1] Communications from Mr. McCarthy directed to the '7,656 proceeding and received October 26, 2006 and subsequently bear a correspondence address of P.O. Box 71550, Salt Lake City, UT 84171-0550. This address differs from the correspondence address of record. The filing of a formal request to change the correspondence address is suggested to ensure prompt receipt of all Office communications.

nor has an Office action issued in this proceeding. There have been no amendments to the claims, specification and/or drawings in this reexamination proceeding.

As evidenced by the above facts, reexamination control No. 90/007,659 and reexamination control No. 90/008,509 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. Accordingly, the above-captioned reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

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. Claims 1-38, all of the claims in the patent, will be reexamined. All papers mailed by the Office will take the form of a single action that jointly applies to both reexaminations. All papers issued by the Office will contain the identifying data for both cases, and each action will be entered into both files (which will be maintained as separate files). Any paper 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. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief, brief fee, oral hearing fee, etc.), 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 multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings 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

Reexamination Control Nos. 90/007,659 and 90/008,509 are hereby merged. Upon mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit 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

cc: Daniel P. McCarthy
P.O. Box 71550
Salt Lake City, UT 84171-0550

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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CENTRAL REEXAMINATION UNIT

SYNOPSYS, INC.
C/O HAYNES BEFFEL & WOLFELD LLP
P.O. BOX 366
HALF MOON BAY CA 94019

(for Patent Owner)

Gerald P. Parsons
PARSONS HSUE & DE RUNTZ LLP
655 Montgomery St., Suite 1800
San Francisco, CA 94111

(for Third Party Requester)

James S. Hsue
PARSONS HSUE & DE RUNTZ LLP
595 Market Street, Suite 1900
San Francisco, CA 94105

(for Third Party Requester)

DECISION, *SUA SPONTE* MERGING REEXAMINATION PROCEEDINGS

In re: Sheony *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/007,660
Filed: August 9, 2005
For: US Patent No. 6,378,114

In re: Sheony *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,396
Filed: December 26, 2006
For: US Patent No. 6,378,114

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. 6,378,114 issued on April 23, 2002.

2. *Ex Parte* Reexamination Proceeding, control no. 90/007,660 was requested by a third party requester on August 9, 2005.

3. The Reexamination Order was granted in proceeding, control no. 90/007,660 on September 21, 2005.

4. An amendment was filed October 3, 2006 proceeding control number 90/007,660.

5. *Ex Parte* Reexamination Proceeding, control no. 90/008,396 was requested by a third party requester filed on December 26, 2006.

6. The Reexamination Order was granted in proceeding, control no. 90/008,396 on March 13, 2006.

7. An amendment was filed March 14, 2007 in proceeding control number 90/008,396.

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 90/007,660 and 90/008,396 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. 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 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. 90/007,660 and 90/008,396 are **MERGED**.

2. 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.

3. All correspondence regarding these proceedings should be submitted as follows:

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

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

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

3. 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

MRehart for

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

Lissi M. Marquis,
Director,
Central Reexamination Unit

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Commissioner for Patents
United States Patent and Trademark Office
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Kenneth P. Glynn (For Patent Owner)
GLYNN & ASSOCIATES, PC
24 Mine Street
Flemington NJ 08822

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NOV 28 2007

CENTRAL REEXAMINATION UNIT

Mathew W. Stavish (For Third Party Requester)
Berenato, White & Tavish, LLC
6550 Rock Spring Drive, Suite 240
Bethesda, MD 20817

In re Reexamination Proceeding :
H. Eberle :
Control No. 90/007,661 : DECISION GRANTING PETITION
Filed: August 8, 2005 :
U.S. Patent No. 6,402,415 :
Attorney Docket No. 0247-3 CIP RE :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on September 17, 2007, by Express Mail, and resubmitted on October 26, 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, 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 ...."

A review of the Office records for this reexamination proceeding reveals that a petition filed September 17, 2007, has been located in the Image File Wrapper.

The present petition under 37 CFR 1.137(b) includes, inter alia, the requisite response (Supplemental Amendment - item 1), a $750.00 petition fee under 37 CFR 1.17(m) (item 2), the requisite statement (item 3) and a Certificate of Service on the Third Party Requester.

The petition for entry of the late papers is granted.

Jurisdiction over the reexamination proceeding is being returned to Central Reexamination Unit (CRU) Art Unit 3993 for further examination and consideration of the Supplemental Amendment filed September 17, 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, J. Jastrzab, in CRU Art Unit 3993, who can be reached at 571-272-4947.

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

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

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.
90/007,665	08/10/2005	6747388	SIMTEK7251	5182

25776 7590 09/30/2005

ERNEST A. BEUTLER, ATTORNEY AT LAW
10 RUE MARSEILLE
NEWPORT BEACH, CA 92660

EXAMINER
Scott Weaver

ART UNIT	PAPER NUMBER
3992	

DATE MAILED: 09/30/2005

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

Order Granting / Denying Request For Ex Parte Reexamination	Control No.	Patent Under Reexamination	
	90/007,665	6747388	
	Examiner	Art Unit	
	Scott L. Weaver	3992	

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

The request for *ex parte* reexamination filed *10 August 2005* has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a)☐ PTO-892, b)☐ PTO-1449, c)☒ Other: *Decsion*

1. ☐ The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. ☒ The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 (c) will be made to requester:

a) ☐ by Treasury check or,

b) ☐ by credit to Deposit Account No. _____, or

c) ☒ by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

cc:Requester (if third party requester)

DECISION:

1. No substantial new question of patentability is raised by the request for reexamination of Patent #6,747,388 and prior art cited therein for the reasons set forth below.

The request does not include a detailed statement identifying each substantial new question of patentability based on prior patents and printed publications included with the request as required by 37 CFR 1.510(b)(1).

The request does not include a detailed explanation of the pertinence of the cited art and manner of applying the cited art to every claim for which reexamination is requested as required under 37 CFR 1.510(b)(2). The mere citation of new patents or printed publications without an explanation does not comply with 37 CFR 1.510(b)(2). Requester must present an explanation of how the cited patents or printed publications are applied to all claims which requester considers to merit reexamination. This not only sets forth the requester's position to the Office, but also to the patent owner (where the patent owner is not the requester).

The request does not include an English language translation of all necessary and pertinent non-English language patents and/or printed publications which are included with the request. With reference to MPEP 2218, Copies of Prior Art,

It is required that a copy of each patent or printed publication relied on or referred to in the request, be filed with the request (37 CFR 1.510(b)(3)). If any of the documents are not in the English language, an English language translation of all necessary and pertinent parts is also required. An English language summary or abstract of a non-English language document is usually not sufficient.

2. With respect to the Information Disclosure Statement (IDS) filed 8/10/2005, the IDS cites documents which do not meet the prior art, printed publication, and/or pertinency requirements and have therefore not been considered. Citation of documents for which no explanation of pertinency and applicability is provided fail to meet the requirements set forth by 37 U.S.C. § 1.501 and 37 U.S.C. §1.510(b). Those references cited on the IDS which are not in compliance will be lined through by the examiner and not considered. See MPEP § 2205.

3. With respect to the Proposed amendment filed 8/10/2005, The patent claims in effect at the time of the determination will be the basis for deciding whether a substantial new question of patentability has been raised. 37 CFR 1.515(a). Amendments which (1) have been presented with the request if by the patent owner, (2) have been filed in a pending reexamination proceeding in which the certificate has not been issued, or (3) have been submitted in a reissue application on which no reissue patent has been issued, will not be considered or commented upon when deciding requests. The decision on the request for reexamination has as its object either the granting or denial of an order for reexamination. This decision is based on whether or not "a substantial new question of patentability" is found. A final determination as to unpatentability of the claims is not made in the decision; this determination will be made during the examination stage of the reexamination proceedings. Accordingly, no prima facie case of unpatentability need be found to grant an order for reexamination. If a decision to deny an order for reexamination is made, the requester may seek review by a petition under CFR 1.181. See 37 CFR 1.515(c).

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott L. Weaver whose telephone number is 571-272-7548. The examiner can normally be reached on Monday to Friday 8 AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Reinhart can be reached at 571-272-1611.

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).

Please mail any communications to:

Attn: Mail Stop "Ex Parte Reexam"
Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

Please FAX any communications to:

(571) 273-9900
Central Reexamination Unit

Please hand-deliver any communications to:

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the Reexamination Legal Advisor or Examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

Scott L. Weaver
Primary Patent Examiner
Art Unit 3992
(571) 272-7548

R.C.F.
Conferees:

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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CENTRAL REEXAMINATION UNIT

Ole K. Nilssen
200 N Harrison Street
Suite 103
Algonquin IL 60102

(Patent Owner)

Martin P. Hoffman
HOFFMAN, WASSON & GITLER, P.C.
2461 South Clark Street
Crystal Center 2, Suite 522
Arlington, VA 22202

(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. 90/007,668
Filed: August 16, 2005
For: US Patent No. 5,036,253

This is a decision on the August 16, 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 July 20, 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 July 20, 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 16, 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 July 20, 2007 is **granted**.

2. The Patent Owner's response is due **September 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 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

MRein for

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

Lissi Mojica Marquis,
Director,
Central Reexamination Unit
3999

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SEP 28 2007

CENTRAL REEXAMINATION UNIT

Ole K. Nilssen 200 N Harrison Street Suite 103 Algonquin IL 60102	:	(Patent Owner)
Martin P. Hoffman HOFFMAN, WASSON & GITLER, P.C. 2461 South Clark Street Crystal Center 2, Suite 522 Arlington, VA 22202	:	(For Third Party Requester)
	:	DECISION DISMISSING PETITION FOR EXTENSION OF TIME [37 CFR 1.550(c)]
In re: Nilssen *Ex Parte* Reexamination Proceeding Control No. 90/007,668 Filed: August 16, 2005 For: US Patent No. 5,036,253	:	

This is a decision on the August 16, 2007, petition for "(Second) Petition for Extension of Time Pursuant to 37 CFR 1.550 (c)," requesting that the time for responding to the Office action mailed July 20, 2007, be extended by a second month.

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 Office action mailed July 20, 2007, which set a one month date for filing a response thereto. The Office action is a non-final Office action. A Petition for extension of time for a first month extension was filed on August 16, 2007 and was granted. This petition for extension of time was timely filed on September 19 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 lacks a showing of "sufficient cause" to support a second extension of time. The MPEP 2265 states that "[s]econd or subsequent requests for extensions of time or requests for more than one month will be granted only in extraordinary situations." In this situation, the patent owner was fully aware with the arrival of the Office actions when the responses were due. The time frame for response could have been fully anticipated. As such the "sufficient cause" requirement has not been met.

The petition request is **dismissed**.

Conclusion

1. The patent owner's petition for extension of second-month time in which to file a response to the Office action dated July 20, 2007 is **dismissed**.

2. The Patent Owner's response is due **September 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 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

for

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
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Ole K. Nilssen
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Suite 103
Algonquin IL 60102

MAILED
SEP 01 2007
CENTRAL REEXAMINATION UNIT

(Patent Owner)

Martin P. Hoffman
HOFFMAN, WASSON & GITLER, P.C.
2461 South Clark Street
Crystal Center 2, Suite 522
Arlington, VA 22202

(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. 90/007,669
Filed: August 16, 2005
For: US Patent No. 5,144,202

This is a decision on the August 16, 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 July 19, 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 July 19, 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 16, 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 July 19, 2007 is **granted**.

2. The Patent Owner's response is due **September 19, 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
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Alexandria, VA 22313-1450
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SEP 28 2007

CENTRAL REEXAMINATION UNIT

Ole K. Nilssen 200 N Harrison Street Suite 103 Algonquin IL 60102	:	(Patent Owner)
Martin P. Hoffman HOFFMAN, WASSON & GITLER, P.C. 2461 South Clark Street Crystal Center 2, Suite 522 Arlington, VA 22202	:	(For Third Party Requester)
	:	DECISION DISMISSING PETITION FOR EXTENSION OF TIME [37 CFR 1.550(c)]
In re: Nilssen *Ex Parte* Reexamination Proceeding Control No. 90/007,669 Filed: August 16, 2005 For: US Patent No. 5,144,202	:	

This is a decision on the September 19, 2007, petition for "(Second) Petition for Extension of Time Pursuant to 37 CFR 1.550 (c)," requesting that the time for responding to the Office action mailed July 20, 2007, be extended by a second month.

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 Office action mailed July 19, 2007, which set a one month date for filing a response thereto. The Office action is a non-final Office action. A Petition for extension of time for a first month extension was filed on August 16, 2007 and was granted. This petition for extension of time was timely filed on September 19, 2007, together with 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. ...

Analysis and Findings

On balance, the Patent Owner's lacks a showing of "sufficient cause" to support a second extension of time. The MPEP 2265 states that "[s]econd or subsequent requests for extensions of time or requests for more than one month will be granted only in extraordinary situations." In this situation, the patent owner was fully aware with the arrival of the Office actions when the responses were due. The time frame for response could have been fully anticipated. As such the "sufficient cause" requirement has not been met.

The petition request is **dismissed**.

Conclusion

1. The patent owner's petition for extension of second-month time in which to file a response to the Office action dated July 19, 2007 is **dismissed**.

2. The Patent Owner's response is due **September 19, 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 for

Lissi Mojica Marquis,
Director,
Central Reexamination Unit
3999

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.
90/007,671	08/17/2005	RE36355	7047200001	4103

7590 04/25/2007

YOON JA KIM
913 Frances Parkway
Park Ridge, IL 60068

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

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

Robert A. Schroeder
BINGHAM MCCUTCHEN LLP
Three Embarcadero Center Suite 1800
San Francisco, CA 94111

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007671
PATENT NO. re36355
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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APR 25 2007

CENTRAL REEXAMINATION UNIT

YOON JA KIM
913 FRANCES PARKWAY
PARK RIDGE IL 60068

(For Patent Owner)

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

(For Third Party Requester)

In re Reexamination Proceeding	:
Yoon Ja Kim	:
Control No. 90/007,671	: DECISION GRANTING PETITION
Filed: August 17, 2005	:
U.S. Patent No. RE 36,355	:
For: Potassium Bromate Replacer Composition	:

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on April 16, 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."

§ 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 of substance of interview)(item 1), a $750.00 small entity 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.

The shortened statutory period for response to the final Office action mailed January 25, 2007, is restarted to **run TWO MONTHS from the date of this decision**.

Jurisdiction over the reexamination proceeding is being returned to Central Reexamination Unit (CRU) 3991 for further examination and consideration of the patent owner's response to the final Office action filed February 28, 2007 and the written statement of substance of interview filed April 16, 2007, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Stephen Stein, in CRU Art Unit 3991, who can be reached at 571-272-1544.

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

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

Conferee: Kenneth M. Schor, Senior Legal Advisor

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MAR 17 2008

CENTRAL REEXAMINATION UNIT

YOON JA KIM (For Patent Owner)
913 FRANCES PARKWAY
PARK RIDGE IL 60068

ROBERT A. SCHROEDER (For Third Party Requester)
BINGHAM MCCUTCHEN L.L.P.
THREE EMBARCADERO CENTER, SUITE 1800
SAN FRANCISCO, CA 94111

In re Reexamination Proceeding	:
Yoon Ja Kim	:
Control No. 90/007,671	: DECISION GRANTING PETITION
Filed: August 17, 2005	:
U.S. Patent No. RE 36,355	:
Attorney Docket No. 7047200001	:

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on March 5, 2008, for entry of late papers based upon unintentional delay.

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

37 CFR 1.137(b) states, in part:

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

The present petition under 37 CFR 1.137(b) includes, inter alia, the requisite response (Notice of Appeal and Appeal fee ($255.00) - item 1), a $770.00 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.

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 3991 for further examination and consideration of the Notice of Appeal filed March 5, 2008, 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, Stephen Stein, in CRU Art Unit 3991, who can be reached at 571-272-1544.

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)

MAILED
FEB 2 0 2006
REEXAM UNIT

Patrick M. Dwyer PC
1818 Westlake Avenue N
Suite 114
Seattle, WA 98109

(For Requester)

In re Eloise Brady *et al*
Reexamination Proceeding
Control No.: 90/007,672
Filed: August 17, 2005
For: U.S. Patent No. 4,363,350

: DECISION ON PETITION TO
: VACATE ORDER
: GRANTING REEXAMINATION

This is a decision on the November 7, 2005 patent owner petition [1] entitled PETITION TO RESCIND GRANT OF REQUEST FOR REEXAMINATION UNDER 37 CFR 1.182 [2] by which patent owner petitions to have the order granting the above-captioned reexamination proceeding vacated as being an *ultra vires* action by the Office. A requester opposition to the petition to vacate was filed on December 2, 2005. [3]

This reexamination proceeding, the patent owner petition, and the third party requester opposition are before the Office of Patent Legal Administration.

SUMMARY

A. The petition to vacate is dismissed for the reasons set forth below.

B. The September 26, 2005 order granting reexamination in the present 90/007672 proceeding remains intact.

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[1] The Image File Wrapper (IFW) contains a duplicate copy of the November 7, 2005 petition dated November 22, 2005.

[2] In accordance with MPEP § 2246(I), entitled "Petition To Vacate the Order Granting Reexamination," a petition of this nature is filed under 37 CFR 1.181. No fee is required, and the $400.00 petition fee tendered with the petition will be refunded.

[3] MPEP § 2246(I) states that a third party requester has a right to file a submission in opposition to a 37 CFR 1.181 petition to vacate a reexamination order and that the opposition must be filed within two weeks of the date of service of the petition on the third party. It is noted that neither the November 7, 2005, nor the November 22, 2005, filing of the patent owner petition, as filed, reflects service of the petition on the third party requester. The third party requester's opposition petition was filed within two weeks of the November 22, 2005 filing by patent owner, and is accepted as having been timely filed. On February 15, 2006, patent owner filed a certificate of service indicating that the patent owner petition on November 7, 2005 was incorrectly served on the wrong party, and that service has now been perfected Patent Owner and third party requester are reminded that all papers filed by either party *must* hereinafter be served on the other party, as required by 37 CFR 1.550(f). Service under 37 CFR 1.550(f) must be accomplished in the manner set forth by 37 CFR 1.248.

REVIEW SALIENT OF FACTS

1. U. S. Patent No. 4,363,350 (the '350 patent) issued on December 14, 1982.

2. The '350 patent was the subject of litigation that commenced on November 19, 1999. In the most recent decision in the litigation, [4] patent claim 1 was held to be valid and infringed. The Court of Appeals for the Federal Circuit remanded the matter to the District Court for a determination of damages.

3. The term of the '350 patent has expired.

4. A first request for reexamination of the '350 patent was filed on March 10, 2005, and was assigned reexamination control number 90/007,458 (the '458 proceeding). Reexamination was ordered for the '458 proceeding on April 27, 2005. No further action has been taken in the '458 proceeding.

5. A second request for reexamination of the '350 patent was filed on August 17, 2005, and resulted in the present 90/007,672 reexamination proceeding (hereinafter the '672 reexamination proceeding). Reexamination was ordered for the '672 reexamination proceeding on September 13, 2005. No further action has been taken in the '672 reexamination proceeding.

6. On November 14, 2005, the patent owner filed the present petition under 37 CFR 1.181(a)(3) to vacate the '672 reexamination proceeding.

7. On November 28, 2005, the third party requester filed an opposition to the petition to vacate the '672 reexamination proceeding.

8. A patent owner's statement under 37 CFR 1.530 was filed in the '672 reexamination proceeding on November 22, 2005. A third party requester reply pursuant to 37 CFR 1.535 has not been received.

DECISION ON PETITION TO VACATE THE SEPTEMBER 13, 2005 ORDER GRANTING REEXAMINATION

35 U.S.C. § 301(a) states, in part:

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

35 U.S.C. § 302 states, in part:

> "**Any person at any time may file a request for reexamination by the Office of any claim of a patent** on the basis of any prior art cited under the provisions of section 301 of this title." (Emphasis supplied.)

35 U.S.C. § 303(a) states, in part:

> "Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Director will determine whether a substantial new question of patentability affecting **any claim of the patent concerned is raised by the request**, with or

[4] *Beckson Marine, Inc., et al v NFM, Inc.*, 44 Appx. 862, U.S. App. LEXIS 15629 (Fed. Cir. 2005) (unpublished)

without consideration of other patents or printed publications. (Emphasis supplied.)

35 U.S.C. § 304 states, in part:

> 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.** (Emphasis supplied.)

Review of the Request for Reexamination

The request for reexamination alleged the existence of a substantial new question of patentability on the grounds that the claims of the '350 patent were unpatentable over either United States Patent No. 4,112,645 (the '645 patent) or United States Patent No. 4,095,640 (the '640 patent) in view of United States Patent No. 304,183 to Davis (the Davis patent). [5] A review of the file history of the '350 patent shows that, while both the '645 patent and the '640 patent were applied and discussed on the record during prosecution of the '350 patent, the Davis patent was not of record.

Review of the Order Granting Reexamination

The examiner's order granting reexamination found that the request for reexamination established the '350 patent raised a substantial new question of patentability with respect to claim 1 of the '350 patent. The examiner based this finding on the fact that during prosecution of the '350 patent, an amendment was directed to a claim limitation reciting a particular drain groove structure that was added to overcome a prior rejection of claim 1, that the '350 patent was thereafter allowed, and that the Davis patent appears to teach a drain groove having that structure. [6] The existence of a single substantial new question of patentability with respect to claim 1 of the '350 patent resulted in the examiner ordering reexamination of patent claims 1-13 in accordance with the practice set forth in MPEP § 2240.

Review of Patent Owner's Argument for Vacatur

In the *Beckson Marine* decision [7] the Federal Circuit held that claim 1 of the '350 patent is valid. Further, the Federal Circuit held that the Davis patent was properly excluded from consideration by the District Court because the defendant did not timely assert it. *Beckson Marine,* at 868. Patent owner argues that the doctrine of issue preclusion therefore bars the Office from ordering reexamination based upon the Davis patent. Patent owner states that "the right and question put in issue [in *Beckson Marine*] is whether the Davis Patent could be used as invalidating reference." Patent owner states that:

> "[T]his issue has been fully and finally litigated, and the Federal Circuit has explicitly upheld that the answer is 'NO.' The resolution of this issue was essential to the prior judgment, since the late inclusion of the reference would have required unnecessary and expensive protraction of litigation. Thus, the issue already decided by the Federal Circuit and the issue presented to the Examiner are identical."

Patent owner concludes that the doctrine of issue preclusion bars the Office from reexamining the '350 patent based upon the Davis patent. In support of this conclusion, patent owner relies

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[5] Request for reexamination, filed August 17, 2005, page 3-10.
[6] Order granting reexamination, September 26, 2005, page 3.
[7] See note 4, *supra.*

upon *In re Freeman* [8] for the proposition that the doctrine of issue preclusion applies to reexamination proceedings in the Office.

Findings and Analysis

A review of 35 U.S.C. §§ 301-304 shows that Section 302 states that "any person, at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited" under Section 301. If the prior art establishes a substantial new question of patentability, then reexamination will be ordered.

In accordance with the rights conferred by Sections 301 and 302, third party requester filed a request for reexamination of claims 1-13 of the '305 patent. The request for reexamination alleged that the prior art Davis patent raised a substantial new question of patentability. In accordance with the statutory mandate in Section 303, the request for reexamination was reviewed, and it was determined that the Davis patent in fact raised a substantial new question of patentability. As then required by Section 304, reexamination was ordered. Based on a review of the record, it is clear that reexamination was properly ordered.

Further, it is noted that with respect to a final holding of claim validity, the Federal Circuit has held that reexamination in the Office of patent claims previously held valid by the courts is perfectly proper. [9]

Although the *Freeman* decision discussed whether the doctrine of issue preclusion is applicable to reexamination proceedings, it is clear that *Freeman* is readily distinguishable from the facts presented in the instant reexamination proceeding. In *Freeman*, a reissue patent involved in litigation was subsequently subjected to reexamination. During the reexamination proceeding, the patentee amended certain of the reissue patent claims, and some of the pending claims were rejected pursuant to 35 U.S.C. § 305 as having been broadened (i.e., as impermissibly enlarging the scope of the patent claims). Patent owner argued that the rejected claims were not broadened, and that any broadening of the claims had been accomplished during the reissue. On appeal, the Board of Patent Appeals and Interferences ("BPAI") held itself to be bound, with respect to reviewing the appealed claims, by the construction that was given to those claims during the litigation. Based on that holding, the Board found that the claims proposed in the reexamination proceeding were in fact broadened with respect to the construction of those claims set forth by the courts. The Federal Circuit ultimately found that the appealed claims were in fact broadened with respect to the construction of those claims by the courts, and that the patent owner was precluded from obtaining the broadened claims in the reexamination proceeding.

In reaching the finding on the issue of claim scope, the Federal Circuit discussed four factors that are required in order to support the application of the doctrine of issue preclusion. [10] The first issue preclusion factor discussed by the court was termed "identical issue." The court stated that:

> "The general principle of [issue preclusion] ... is that a right, question or fact distinctly put in issue ... cannot be disputed in a second suit. Where an appellate court has decided a specific

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[8] 39 F.3d 1459, 31 USPQ2.d 1444, Fed. Cir. 1994)

[9] See, for example, *In re Etter*, 756 F.2d 852, 225 USPQ 1 (Fed. Cir. 1985) (the 35 U.S.C. § 282 presumption of patent validity has no application in reexamination proceedings).

[10] *Freeman*, at 1465, 1449

> question, the doctrine of issue preclusion should normally prevent relitigation of that issue. " (Parenthetical material in the original. Citations omitted.)

In this reexamination proceeding, it is clear that the question of precisely what the Davis patent teaches, whether that teaching would establish a substantial new question of patentability, and whether that teaching would render one or more of the '350 patent claims unpatentable, are all issues that were not determined during the litigation. Rather, the sole issue determined during the litigation regarding the Davis patent was a procedural determination that the Davis patent was not timely submitted during the litigation. Thus, the required element of identity of issues between the prior litigation and this reexamination proceeding clearly has not been satisfied.

The instant finding of a substantial new question of patentability based upon prior art taken in view of Davis is not a final agency decision, and the issue may be contested by patent owner inthe examination stage of this reexamination proceeding. In *Heinl v. Godici*, 143 F. Supp. 2d 593 (E.D. Va. 2001), the court pointed out that "[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. The existence of (a) a statutory mandate in the *ex parte* reexamination statutes that permits any party, at any time, file a request for *ex parte* reexamination based upon prior art patents, (b) a statutory mandate that when a substantial new question of patentability is raised by the request, *ex parte* reexamination will be ordered, (c) precedent requiring *ex parte* reexamination to be undertaken when a substantial new question of patentability has been established for one or more claims of a patent, notwithstanding a final court decision holding those patent claims valid; and (d) the fact that an order granting reexamination is not a final agency action, all weigh in favor of allowing the present reexamination proceeding to continue.

In *Heinl*, 143 F.Supp.2d at 601, the court stated, in its decision on a patent owner's action 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 August 17, 2005 reexamination request properly raised a substantial new question of patentability based upon consideration of the prior art Davis patent (a patent not considered during the examination of the '350 patent and not considered during the litigation of the '350 patent).

CONCLUSION

1. The petition under 37 CFR 1.181 is dismissed.

2. Jurisdiction over the reexamination proceeding is being forwarded to the Central Reexamination Unit for issuance of a first Office action under 37 CFR 1.550(a) in due course. The examiner should note that, in a reexamination proceeding involving claims of an expired patent (which are not subject to amendment), a policy of narrow construction of the claims is applied. [11]

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

SM
2/21/06

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[11] See MPEP § 2258(G), "Claim Interpretation and Treatment.

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CENTRAL REEXAMINATION UNIT

Dion M. Bregman
Morgan, Lewis & Bockius, LLP
2 Palo Alto Square
3000 El Camino Real
Palo Alto, California 94306

(For Patent Owner)

Kevin J. Carroll
Grossman, Tucker, Perreault
& Pfleger, PLLC
55 South Commercial Street
Manchester, New Hampshire 03101

(For Third Party Requester)

In re Reissue Application of Belgacem Haba Application No. 11/398,458 Filed: April 4, 2006 For: U.S. Patent No. 6,833,984	:	DECISION, *SUA SPONTE,* TO MERGE REISSUE AND REEXAMINATION PROCEEDINGS
In re Belgacem Haba Reexamination Proceeding Control No. 90/007,681 Filed: August 19, 2004 For: U.S. Patent No. 6,833,984	:	

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

REVIEW OF FACTS

1. U.S. patent No. 6,833,984 (the '984 patent) issued on December 21, 2004, with 23 claims.

2. A request for reexamination was filed by a third party requester on August 19, 2005, and was assigned control No. 90/007,681 (hereinafter, the '7681 proceeding).

3. Reexamination was ordered for the '7681 reexamination proceeding on October 18, 2005.

4. An *Ex Parte* Reexamination Interview Summary record was mailed December 16, 2006 recording an interview with the patent owner's representative (Dion Bregman) on that date. The summary indicated, *inter alia*, that no patent owner statement under 37 CFR 1.530 would be filed.

5. Patent Owner filed an Information disclosure statement on December 19, 2005 in the '7681 proceeding.

6. On January 4, 2006, patent owner filed, in the '7681 proceeding, a detailed summary of the December 16, 2006 interview as per 37 CFR 1.560(b).

7. On April 4, 2006, patent owner filed a Notice of Concurrent proceedings under 37 CFR 1.565 informing the Office of the filing of an application seeking reissue of the '984 patent.

8. An application for reissue, assigned application No. 11/398,458 (the '458 reissue application), was filed by the patent owner on April 4, 2006.

9. The filing of the '458 reissue application was announced in the *Official Gazette* on May 23, 2006.

10. A patent owner's statement under 37 CFR 1.530 has not been received in the '7681 proceeding, and the time for filing same has expired.

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. 11/398,458 and reexamination control No. 90/007,681 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, 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. Furthermore, in the event that a request for continued examination (RCE) is filed for the reissue application, there is no assurance that the present merger will not be dissolved.*

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

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

II. Requirement for Same Amendments in Both Proceedings

1. The patent owner is required to maintain identical amendments in the reissue application and the reexamination proceeding 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. 90/007,681 shows that original patent claims 1-23 are present. A review of reissue application No. 11/398,458 shows that original patent claims 1-5 and 7-23 are present, patent claim 6 is amended, new claims 24-266 have been added, and the Abstract has been amended. **Accordingly, both the claims and Abstract are not identical in the two proceedings.** In addition, the the amendment does not comply with 37 CFR 1.173 for the following reasons:

   a. The amendment to the Abstract and to claim 6 uses strikethrough to denote deletion. 37 CFR 1.173(d)(1) requires that "the matter to be omitted by reissue must be enclosed in brackets".

   b. Newly presented claims 24-266 should be underlined in their entirety in accordance with 37 CFR 1.173(d)(2) and 1.173(g).

An appropriate housekeeping amendment is required within <u>ONE (1) MONTH</u> of this decision (a) placing the same amendments in both cases, specifically, Application No. 11/398,458 and Control Number 90/007,681, and (b) correcting the informalities pointed out above. The response to the requirement must be limited to placing the same amendments in all cases and addressing the informalities. The patent owner must **not** address any issue of patentability in the housekeeping amendment. It is to be noted that, pursuant to MPEP 2285, amendments in a merged proceeding are submitted 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 <u>reissue</u> 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, 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 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 <u>not</u> apply to amendments in a reissue application. Accordingly, clean copies of the amended claims are not required, *and such clean copies are not to be submitted.* Instead, pursuant to 37 CFR 1.173(b)(2), amendments are to be presented via markings pursuant to 37 CFR 1.173(d), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

7. Where a paper is filed which requires payment of a fee (e.g., petition fee, excess claims fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for 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. 11/398,458 and reexamination control No. 90/007,681 **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 (a) placing the same amendments in both cases of the present merged proceeding, (b) and addressing the informalities noted above.

3. Jurisdiction over the merged reissue and reexamination proceeding is being transferred to Technology Center 2800, 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 '984 patent (e.g., by preparing/signing an action), or was so involved in the examination of the parent of the '984 patent. See MPEP 2236.

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

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

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

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

December 6, 2005
C:\kiva\kenpetmerger\7681_Merge_Reissue_Amdt-informal_cls-3PR.wpd

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.
90/007,682	08/19/2005	6695907	032301.383	6907

25461 7590 02/16/2007

SMITH, GAMBRELL & RUSSELL
SUITE 3100, PROMENADE II
1230 PEACHTREE STREET, N.E.
ATLANTA, GA 30307-3592

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/16/2007

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CENTRAL REEXAMINATION UNIT

Smith, Gambrell & Russell Suite 3100, Promenade II 1230 Peachtree Street, N.E. Atlanta, GA 30307-3592	:	For Patent Owner
In re Scharfe et al. *Ex Parte* Reexamination Proceeding Control No. 90/007,682 Filed: August 19, 2005 For: US Patent No. 6,695,907	:	DECISION DISMISSING PETITION FOR EXTENSION OF TIME [37 CFR 1.550(c)]

This is a decision on the January 29, 2007, Patent Owner "Petition for Extension of Time Under 37 CFR 1.136(a) " requesting that the time for responding to the Office action dated September 29, 2006 be extended by one month

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

Note that extensions of time in reexamination proceedings are governed by 37 CFR 1.550(c), not 37 CFR 1.136(a), and thus the advisory action mailed January 10, 2007 was in error.

The advisory action mailed February 12, 2007 extended the period for response to run *six* months from the mail date of the final rejection, and accordingly the instant petition is **dismissed** as moot.

Telephone inquiries with regard to this decision should be directed to Gregory Mills, Quality Assurance Specialist in the Central Reexamination Unit, at (571) 272-1439.

Lissi Mojica Marquis, for
Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,684	08/22/2005	6024981	15514/40037	1442

7590 04/20/2006

LERNER DAVID LITTENBERG KRUMHOLZ &
MENTLIK
600 South Avenue West
Westfield, NJ 07090

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/20/2006

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Michael H. Teschner
LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK, LLP
600 South Avenue West
Westfield NJ 07090

For Patent Owner

MAILED

APR 20 2006

REEXAM UNIT

Alan H. Norman
THOMPSON COBURN LLP
One US Bank Plaza
St. Louis, MO 63101-1611

For Requester

In re: Khankari et al
Ex Parte Reexamination Proceeding
Control No. 90/007,684
Filed: August 22, 2005
For: US Patent No. 6,024,981

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

This is a decision on the petition filed April 10, 2006 to request a two week extension of time pursuant to 37 CFR 1.550 for responding to the Office action dated February 24, 2006.

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

The petition is granted for two weeks 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 24, 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 a personal interview is scheduled with the examiner for April 18, 2006 which leaves too little time to incorporate any points raised by the examiners and memorialize arguments to address such points into the reply due only a few days later. The extension is requested so that, should the need arise as a result of the interview, patentee can address any points in any reply, thereby reducing the need for supplementation.

Analysis and Findings

On balance, it is considered that Patent Owner is being diligent in preparing and submitting a response to the outstanding Office action and is relying on an interview with the examiner to prepare a complete response and to avoid further supplemental action. Patent Owner 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 necessary consultations. Holidays and interviews with examiners will not be seen to present a compelling reason in support of an additional extension of time. An extension of time of two weeks is granted.

Conclusion

1. The patent owner's petition for extension of time in which to file a response to the Office action dated February 24, 2006 is **granted**.

2. The Patent Owner's response is due May 8, 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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,684	08/22/2005	6024981	15514/40037	1442

7590 01/08/2007

LERNER DAVID LITTENBERG KRUMHOLZ & MENTLIK
600 South Avenue West
Westfield, NJ 07090

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/08/2007

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1/8/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Alan H. Norman
THOMPSON COBURN LLP
ONE US BANK PLAZA
ST. LOUIS, MO 63101

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007684
PATENT NO. 6,024,981
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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CENTRAL REEXAMINATION UNIT

Michael H. Teschner
LERNER, DAVID, LITTENBERG,
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Wetfield, New Jersey 07090

(for Patent Owner)

Alan H. Norman
Thompson Coburn LLP
One US Bank Plaza
St. Louis, MO 63101-1611

(for Third Party Requester)

In re Khankari et al
Reexamination Proceeding
Control No.: 90/007,684
Filed: August 22, 2005
For: U.S. Patent 6,024,981

Alan H. Norman
Thompson Coburn LLP
One US Bank Plaza
St. Louis, MO 63101-1611

(for Third Party Requester)

In re Khankari et al
Reexamination Proceeding
Control No.: 90/0078,133
Filed: September 28, 2006
For: U.S. Patent 6,024,981

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 6,024,981, issued February 15, 2000, is the subject of Reexamination Control Nos. 90/007,684 and 90/008,133.

2. A first request for reexamination, assigned Reexamination Control No. 90/007,624, was filed August 22, 2005 by Alan Norman of Thompson Coburn LLP in St. Louis MO. The request urged that a substantial new question of patentability was raised by the newly cited references that either disclose the claimed dosage form comprising an active ingredient and a matrix including a non-direct compression filler and a lubricant or are so close as to establish a case of obviousness.

3. Reexamination was ordered for 90/007,684 on August 22, 2005.

4. A first non-final Office action was issued on February 24, 2006.

5. Patent Owner filed a response on April 27, 2006.

6. A subsequent request for re-examination, assigned Reexamination Control No. 90,008,133, was filed July 28, 2006 by Alan Norman of Thompson Coburn LLP in St. Louis MO. The request was deemed non-compliant and a corrected request was filed September 7, 2006. The request urged that a substantial new question of patentability was raised by the newly cited reference combinations that render obvious the claimed dosage form comprising an active ingredient and a matrix including a non-direct compression filler and a lubricant.

7. Reexamination was ordered for 90/008,133 on September 28, 2006.

8. No Office action has been issued in the later reexamination.

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 90/007,684and 90/008,133 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 all files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, **filed in duplicate**, each bearing a signature and identifying data for **all** files, for entry into each file.

All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control Nos. 90/007,684 and 90/008,133 as:

Michael H. Teschner
LERNER, DAVID, LITTENBERG,
KRUMHOLTZ & MENTLIK, LLP
600 South Avenue West
Wetfield, New Jersey 07090

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control Nos. 90/007,684 and 90/008,133 as:

Alan H. Norman
Thompson Coburn LLP
One US Bank Plaza
St. Louis, MO 63101-1611

CONCLUSION

Reexamination Control Nos. 90/007,684 and 90/008,133 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 and to name but a single representative.** Upon receipt of the response, as 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.

Deborah Jones

for Lissi M. Marquis, Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,685	08/22/2005	6689566	532212801100	3042

7590 02/16/2006

EXAMINER

Peng Chen
MORRISON & FOERSTER LLP
3811 Valley Centre Drive
Suite 500
San Diego, CA 92130

ART UNIT	PAPER NUMBER

DATE MAILED: 02/16/2006

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(For Patent Owner)

MAILED
FEB 16 2006
REEXAM UNIT

Matthew A, Newboles
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Aliso Viejo, CA 92656

(For 3rd Party Requester)

Reexam Control No.: 90/007,685
Filed : August 22, 2005
For U.S. Patent No.: 6,689,566

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexam Control No.: 90/007,732
Filed: September 28, 2005
For U.S. Patent No.: 6,689,566

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. 90/007,685 was ordered in a decision mailed September 14, 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. 90/007,732 was ordered in a decision mailed October 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. 90/007,685 and 90/007,732 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

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MAILED

APR 27 2007

CENTRAL REEXAMINATION UNIT

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Aliso Viejo, CA 92656

(for Third Party Requester)

In re Cantor et al. Reexamination Proceeding Control No. 90/007,685 Filed: August 22, 2005 For: U.S. Patent No. 6,689,566 B1	:	DECISION ON PETITIONS
In re Cantor et al. Reexamination Proceeding Control No. 90/007,732 Filed: September 28, 2005 For: U.S. Patent No.: 6,689,566 B1	:	

This is a decision on (1) the March 24, 2006 patent owner "Petition to Expunge Information Under MPEP 724.06 and 37 C.F.R. 1.59," and (2) the April 7, 2006 patent owner "Petition to Waive Service Rule Under 37 C.F.R. 1.183," both petitions were resubmitted on February 8, 2007.

The petitions are 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 724.06 and 37 CFR 1.59 is **dismissed** as premature.

The proceeding is **remanded** to the examiner for a determination as to whether or not any portion or all of the information submitted in this proceeding as protected information is "important to a reasonable examiner in deciding whether or not a claim is patentable."

BACKGROUND

1. U.S. Patent No. 6,689,566 to Cantor et al. (the '566 patent) issued on February 10, 2004.

2. On August 22, 2005, petitioner patent owner filed a first request for *ex parte* reexamination, which resulted in a reexamination proceeding assigned reexamination control number 90/007,685 (the '7685 proceeding).

3. On September 14, 2005 the Office granted the patent owner's request, and ordered reexamination.

4. On September 26, 2005, a third party requester filed a second request for *ex parte* reexamination, which resulted in a reexamination proceeding assigned reexamination control number 90/007,732 (the '7732 proceeding).

5. On October 27, 2005 the Office granted the third party requester request, and ordered reexamination.

6. On February 16, 2006 the Office issued a decision merging the '7685 and '7732 *ex parte* proceedings into a single merged proceeding.

7. On March 24, 2006 the patent owner filed a supplemental Information Disclosure Statement (IDS) in the now merged reexamination proceedings noted above. 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). The information submitted with the petition was provisionally sealed from the public.

8. On April 7, 2006 the patent owner filed a petition under 37 CFR 1.183 to waive the service requirement by 37 CFR 1.550(f).

9. On January 8, 2007 the Office issued a NIRC for the merged *ex parte* proceeding of '7685 and '7732.

10. On February 8, 2007, the patent owner resubmitted the petitions to expunge and waive service filed on March 24, 2006 and April 7, 2006 respectively.

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 as a general rule made available to the public. Confidential litigation/proprietary materials (protected materials) have been submitted under MPEP 724 *et seq*. These materials have not been served on the reexamination requester. 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, and then timely release to the public any of such information found to be important to a reasonable examiner in deciding whether or not a claim is patentable. It goes without saying, that requiring that 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 purpose of the protective order issued by the federal court, in the related patent litigation, as well as undermine protective order procedure/mechanisms in general. 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 requester of the materials previously submitted and identified as "confidential"' is not required. Accordingly, 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 requester).

Petition to Expunge under 37 CFR 1.59

The information submitted with the petition was appropriately submitted under MPEP 724.02, and it accordingly was **provisionally sealed**.

As to the petition itself, 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." Upon a review of the file history, it does not appear that the requisite determination has been made. Therefore, a decision on the petition at this time is premature, because any information submitted in confidence but found to be "important to a reasonable examiner in deciding whether or not a claim is patentable" cannot be expunged. Accordingly, it is not appropriate at this time to make a determination to expunge. Thus the petition to expunge is **dismissed**, and is held in abeyance pending the determination as to whether or not any portion or all of the information submitted is "important to a reasonable examiner in deciding whether or not a claim is patentable."

The dismissal is subject to renewal at a later point in this proceeding, when the issue becomes ripe for decision. After a determination on the issue of importance of the sealed information is made of record (as discussed above), the petition to expunge may be renewed by patent owner. 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 provisionally sealed material being unsealed and made of record in the reexamination file and thus becoming open to the public.

Remand

The proceeding is remanded to the examiner for 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." Upon receipt of jurisdiction of the proceeding, the examiner will, pursuant to MPEP 724.04(c), promptly make such a determination and issue an Office action, which may be a supplemental Notice of Intent to Issue a Reexamination Certificate, if appropriate.

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 under MPEP 724.06 and 37 CFR 1.59 is **dismissed**, subject to renewal at a later point in the proceeding. It is held in abeyance, pending renewal of it by patent owner at an appropriate time.

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. The present merged proceeding is **remanded** to the examiner of record for a prompt 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."

5. Jurisdiction over the present reexamination proceeding is being returned to the Central Reexamination Unit for further processing not inconsistent with this decision.

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

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

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.
90/007,732	09/28/2005	6689566	IMUNE-006X	9258

25225 7590 07/10/2007

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/10/2007

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

Copied from 90007732 on 11/27/2007

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7/11/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007685

PATENT NO. 6,689,566

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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JUL 10 2007

CENTRAL REEXAMINATION UNIT

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In re Cantor et al. Reexamination Proceeding Control No. 90/007,685 Filed: August 22, 2005 For: U.S. Patent No. 6,689,566 B1	:	DECISION GRANTING PETITION
In re Cantor et al. Reexamination Proceeding Control No. 90/007,732 Filed: September 28, 2005 For: U.S. Patent No.: 6,689,566 B1	:	

This is a decision on the June 7, 2007 patent owner "Request to Renew Petition to Expunge Information under MPEP 724.06 and 37 C.F.R. § 1.59".

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

The petition is **granted**, and the information under MPEP 724.06 and 37 CFR 1.59 will be expunged.

Copied from 90007732 on 11/27/2007

BACKGROUND

1. U.S. Patent No. 6,689,566 to Cantor et al. (the '566 patent) issued on February 10, 2004.

2. On August 22, 2005, petitioner patent owner filed a first request for *ex parte* reexamination, which resulted in a reexamination proceeding assigned reexamination control number 90/007,685 (the '7685 proceeding).

3. On September 14, 2005 the Office granted the patent owner's request, and ordered reexamination.

4. On September 26, 2005, a third party requester filed a second request for *ex parte* reexamination, which resulted in a reexamination proceeding assigned reexamination control number 90/007,732 (the '7732 proceeding).

5. On October 27, 2005, the Office granted the third party requester's request, and ordered reexamination.

6. On February 16, 2006, the Office issued a decision merging the '7685 and '7732 *ex parte* proceedings into a single merged proceeding (hereinafter, "the merged proceeding").

7. On March 24, 2006, the patent owner filed a supplemental Information Disclosure Statement (IDS) in the merged 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). The information submitted with the petition was provisionally sealed from the public.

8. On April 7, 2006, the patent owner filed a petition under 37 CFR 1.183 to waive the service requirement by 37 CFR 1.550(f).

9. On January 8, 2007, the Office issued a NIRC for the merged *ex parte* proceeding of '7685 and '7732.

10. On February 8, 2007, the patent owner resubmitted the petitions to expunge and waive service, which had been filed on March 24, 2006 and April 7, 2006 respectively.

11. On April 27, 2007, a Senior Legal Advisor of Office of the Patent Legal Administration issued a decision on the petitions to expunge and to waive service. The decision (1) granted patent owner's 37 CFR 1.83 petition requesting a waiver of service under 37 CFR 1.550(f) and (2) dismissed patent owner's petition to expunge under MPEP 724.06 and 37 CFR 1.59 as premature. The decision (3) remanded the proceeding to the examiner for a determination as to whether or not any portion, or all, of the information submitted as protected information was "important to a reasonable examiner in deciding whether or not a claim is patentable."

Copied from 90007732 on 11/27/2007

12. On May 23, 2007, the examiner of record issued a communication in regard to the merged proceeding, addressing the Senior Legal Advisor's remand of the merged proceeding.

13. On June 7, 2007, patent owner filed the instant petition, titled "Request to Renew Petition to Expunge Information under MPEP 724.06 and 37 C.F.R. § 1.59."

DECISION

37 CFR 1.59 provides:

> (a)(1) Information in an application will not be expunged, except as provided in paragraph (b) of this section or § 41.7(a) of this title.
> (2) Information forming part of the original disclosure (*i.e.*, written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under §§1.63 and 1.175 will not be expunged from the application file.
>
> (b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

MPEP 724.05 I provides (in part):

> Such petition must contain:
>
> (A) a clear identification of the information to be expunged without disclosure of the details thereof;
>
> (B) a clear statement that the information to be expunged is trade secret material, proprietary material, and/or subject to a protective order, and that the information has not been otherwise made public;
>
> (C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;
>
> (D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information;
>
> (E) the fee as set forth in 37 CFR 1.17(g) for a petition under 37 CFR 1.59(b).

<u>Petition to Expunge under 37 CFR 1.59</u>

The information submitted March 24, 2006, was appropriately submitted under MPEP 724.02, and it accordingly was **provisionally sealed**.

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As to the petition itself, MPEP 724.04(c) sets forth the guidelines for submitting and treatment of proprietary "Materials Submitted in Reexamination File Open to the Public Under 37 CFR 1.11(d)." A petition to expunge should accompany the submission of the information and, in any event, must be submitted in sufficient time that it can be acted on before the reexamination proceeding enters the reexamination certificate printing process.[1] When reexamination proceeding is considered on the merits, the examiner (and/or other appropriate Office personnel responsible for considering the information) reviews the sealed information, and makes a determination as to whether or not any portion or all of the information submitted is "important to a reasonable examiner in deciding whether or not a claim is patentable."

The original petition to expunge was filed concurrently with the proprietary and protective order materials on March 24, 2006, in the merged reexamination proceeding. Petitioner renewed the petition to expunge on February 8, 2007, shortly after a NIRC issued for the merged reexamination proceeding. Patent owner, in their renewed petition to expunge clearly identified the information to be expunged as the information supplied in an information disclosure statement on March 24, 2006. Patent owner clearly stated that document numbers 1-75 of the 76 documents submitted on March 24, 2006 are subject to a federal district court protective order. Patent owner also clearly stated that document number 76 submitted on March 24, 2006, contains proprietary information. Patent owner provided a commitment to retain the information for the entire patent term. The patent owner stated, on the record, that the petition was being submitted by or on behalf of the real party in interest who originally submitted the information. The petition authorized payment of the necessary fees under 37 CFR 1.17(g) for a petition under 37 CFR 1.59(b). Finally, on May 23, 2007, in a communication addressing the Senior Legal Advisor's April 27, 2007 remand of the merged proceeding, the examiner determined the references in question "were not found to be important to a reasonable examiner in deciding whether or not a claim is patentable."

Accordingly, there is compliance with all the criteria set forth in MPEP 724.05 I listed above. Thus, the petition is **granted.**

CONCLUSION

1. The petition to expunge information under MPEP 724.06 and 37 CFR 1.59 is **granted.**

2. No copy of the expunged documents will be maintained of record in the Office.

3. A copy of this decision will be made of record in the '7685 and '7732 *ex parte* reexamination files.

4. Jurisdiction over the present merged reexamination proceedings is being returned to the Central Reexamination Unit.

[1] If the reexamination is merged with a reissue application, the petition is to be submitted such that it can be acted upon prior to the application's entry into the patent publication stage or the issuance of the notice of abandonment for the reissue application.

Copied from 90007732 on 11/27/2007

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

7/5/07
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,685	08/22/2005	6689566	532212801100	3042

25225 7590 02/11/2008
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/11/2008

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Date:

MAILED
FEB 11 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007685
PATENT NO. : 6689566
ART UNIT : 2800

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

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

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CENTRAL REEXAMINATION UNIT

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In re Cantor et al.	:	
Ex Parte Reexamination Proceeding	:	**DECISION**
Control No. 90/007,685	:	**ON**
Filed: August 22, 2005	:	**PETITION**
For: U.S. Patent 6,689,566 B1	:	

In re Cantor et al.	:
Ex Parte Reexamination Proceeding	:
Control No. 90/007,732	:
Filed: September 28, 2005	:
For: U.S. Patent No.: 6,689,566 B1	:

This is a decision on the April 21, 2006 Patent Owner "Petition to Expunge Information Under MPEP §724.06 and 37 CFR §1.59."

This petition is before the Central Reexamination Unit of the United States Patent and Trademark Office.

FEES

The Patent Owner has paid the $200.00 petition fee for the petition under 37 CFR §1.17(f) as required by 37 CFR §1.59(b).

SUMMARY

This petition to expunge information under MPEP §724.06 and 37 CFR §1.59 is **GRANTED**.

BACKGROUND

1. U.S. Patent No. 6,689,566 to Cantor et al. (the '566 patent) issued on February 10, 2004.

2. On August 22, 2005, petitioner Patent Owner filed a first request for *ex parte* reexamination, which resulted in a reexamination proceeding assigned reexamination control number 90/007,685 (the '7685 proceeding).

3. On September 14, 2005 the Office granted the Patent Owner's request, and ordered reexamination.

4. On September 28, 2005, a Third Party Requester filed a second request for *ex parte* reexamination, which resulted in a reexamination proceeding assigned reexamination control number 90/007,732 (the '7732 proceeding).

5. On October 27, 2005, the Office granted the Third Party Requester's request, and ordered reexamination.

6. On February 16, 2006, the Office issued a decision merging the '7685 and '7732 *ex parte* proceedings into a single merged proceeding (hereinafter, "the merged proceeding").

7. On March 24, 2006, the Patent Owner filed a supplemental Information Disclosure Statement (IDS) in the merged 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).

8. On April 7, 2006, the Patent Owner filed a petition under 37 CFR 1.183 to waive the service requirement by 37 CFR 1.559(f).

9. On April 20, 2006 a non-final Office action was mailed.

9. On April 21, 2006, the Patent Owner filed an Information Disclosure Statement (IDS) in the merged proceeding. The IDS was filed under seal and concurrently with a petition under MPRP 724.06 and 37 CFR. 1.59 for expungement upon issuance of a Notice of Intent to Issue a Reexamination Certificate (NIRC).

10. On May 24, 2006, a non-final Office action was mailed.

11. On June 5, 2006, an telephone interview was conducted.

12. On July 10, 2006, a telephone interview was conducted.

13. On July 24, 2006, the Patent Owner filed an amendment to the claims.

14. On September 21, 2006, a final Office action was mailed.

15. On November 7, 2006, a telephone interview was conducted.

16. On November 10, 2006, the Patent Owner filed an amendment in response to the the final rejection of November 7, 2006.

17. On November 20, 2006, a telephone interview was conducted.

18. On December 1, 2006, the Patent Owner filed an amendment to the claims.

19. On December 21, 2006, the Patent Owner filed a supplemental amendment after final was filed.

20. On December 21, 2006, the Patent Owner filed a Notice of Appeal.

21. On January 8, 2007, the Office issued a NIRC for the merged ex parte proceeding of '7685 and '7732.

11. On February 8, 2007, the Patent Owner filed renewed petitions to expunge and waive service, which had been filed on 24 March 2006 and 07 April 7, 2006, respectively.

12. On April 27, 2007, a Senior Legal Advisor of Office of the Patent Legal Administration issued a decision on the petitions to expunge and to waive service. The decision (1) granted Patent Owner's 37 CFR 1.183 petition requesting a waiver of service under 37 CFR 1.550(f) and (2) dismissed Patent Owner's petition to expunge under MPEP 724.06 and 37 CFR. 1.59 as premature. The decision (3) remanded the proceeding to the examiner for a determination as to whether or not any portion, or all, of the information submitted as protected information was "important to a reasonable examiner in deciding whether or not a claim is patentable."

13. On May 23, 2007, the examiner of record issued a communication with regard to the IDS filed 24 March 2006 in the merged proceeding, addressing the Senior Legal Advisor's remand of the merged proceeding.

14. On June 7, 2007, Patent Owner filed a petition titled, "Request to Renew Petition to Expunge Information under MPEP 724.06 and 37 CFR 1.59," requesting that the information cited on the IDS of April 7, 2006 be expunged.

15. October July 2, 2007, a telephone interview was conducted.

16. On July 10, 2007 the "Request to Renew Petition to Expunge Information under MPEP 724.06 and 37 CFR 1.59" filed 07 June 2007 was granted with respect to the IDS submitted on 24 March 2006.

17. On September 7, 2007, the Board of Patent Appeals and Interferences declared an interference between U.S. Patent Application 10/641,780 to Thomas L. Cantor and U.S. Patent 6,838,264 to Zahradnik and Lavigne.

18. On November 30, 2007 the examiner of record issued a communication with regard to the Information Disclosure Statement submitted April 21, 2006.

DECISION

37 CFR §1.59 provides:

> (a)(1) Information in an application will not be expunged except as provided in paragraph (b) of this section or §41.7(a) of this title.
> (2) Information forming part of the original disclosure (i.e. written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under §§1.63 and 1.175 will not be expunged from the application file.
> (b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in §1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

MPEP 724.05 I provides (in part):

> Such petition must contain:
>
> (A) a clear identification of the information to be expunged without disclosure of the details thereof:
>
> (B) a clear statement that the information to be expunged is trade secret material, proprietary material, and/or subject to a protective order, and that the information has not been otherwise made public;
>
> (C) a commitment on the part of the petitioner to retain such information for a period of any patent with regard to which such information is submitted;
>
> (D) a statement that the petition to expunge is being submitted by, or on behalf of, the party interest who originally submitted the information;
>
> (E) the fee as set forth in 37 CFR 1.17(g) for a petition under 37 CFR 1.599(b).

Petition to Expunge under 37 CFR 1.59

The information submitted with the petition was appropriately submitted under MPEP §724.02, and it accordingly was **provisionally sealed.**

As to the petition itself, 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)." A petition to expunge should accompany the submission of the information and, in any event, must be submitted in sufficient time that it can be acted on before the reexamination proceeding enters the reexamination certificate printing process. When reexamination proceeding is considered on the merits, the examiner(and/or other appropriate Office personnel responsible for considering the information) reviews the sealed information, and makes a determination as to whether or not any portion or all of the information submitted is "important to a reasonable examiner in deciding whether or not a claim is patentable."

The original petition to expunge was filed with the proprietary and protective order materials on 21 April 2006, in the merge reexamination proceeding. (A copy of this petition to expunge was resubmitted 08 February 2007.) Patent Owner clearly identified the information to be expunged as the information supplied in an information disclosure document submitted on 17 March 2006. Patent Owner clearly stated that the document submitted on 17 March 2006 is subject to a federal district court protective order. Patent Owner provided a commitment to retain the information for the entire patent term. The Patent Owner stated, on the record, that the petition was being submitted by or on behalf of the real party of interest who originally submitted the information. The petition authorized payment of the necessary fees under 37 CFR §1.17(g) for a petition under 37 CFR 1.59(b). Finally, on 29 November 2007 the examiner determined that the reference in question "was not found to be important to a reasonable examiner in deciding whether or not a claim is patentable."

Accordingly, there is compliance with all of the criteria set forth in MPEP 724.05 I listed above. Thus, the petition is **granted**.

CONCLUSION

1. The petition to expunge under MPEP §724.06 and 37 CFR §1.59 is **granted**.

2. The present proceeding is an Image File Wrapper (IFS) proceeding and the paper was entered into the IFW record. Therefore, the paper cannot be "returned" to the Patent Owner, but the paper has been (and will remain) marked "closed" and "not public." The paper will not form part of the record, and will not be available to the public.

3. A copy of this decision will be made of record in the '7685 and '7732 *ex parte* reexamination files.

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

for Lissi M.Marquis,
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APR 03 2008

CENTRAL REEXAMINATION UNIT

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

Peng Chen (For Patent Owner)
MORRISON & FOERSTER LLP
12531 High Bluff Drive
Suite 100
San Diego, CA 92130-2040

Matthew A. Newboles (For Third Party)
STETINA, BRUNDA, GARRED & BRUCKER
75 Enterprise, Suite 250
Aliso Viejo, CA 92656

In re Cantor et al.	:	
Ex Parte Reexamination Proceeding	:	**DECISION**
Control No. 90/007,685	:	**ON**
Filed: August 22, 2005	:	**PETITION**
For: U.S. Patent No.: 6,689,566 B1	:	

In re Cantor et al.	:
Ex Parte Reexamination Proceeding	:
Control No. 90/007,732	:
Filed: September 28, 2005	:
For: U.S. Patent No.: 6,689,566 B1	:

This is a decision on two petitions to Expunge Information under MPEP §724.06 and 37 CFR §1.59 dated December 12, 2007 and February 4, 2008. Each of these petitions was filed after the NIRC which was mailed January 8, 2007. Furthermore, the information which the Patent Owner seeks to expunge was cited on Information Disclosure Statements also filed after the mailing of the NIRC. Since all of the supplemental IDS's filed after the mailing of the NIRC are being returned to the Patent Owner for failing to comply with MPEP 2256, these two petitions to Expunge Information under MPEP 724.06 and 37 CFR 1.59 are not necessary, and therefore, are **dismissed**.

A copy of the letter accompanying the returned papers will be made of record in the reexamination proceeding. However, no copy of the returned papers will be retained by the Office. If the submission of the returned papers is appropriate later in the proceedings, they will be accepted by the Office at that time. See MPEP 2256.

Please note, the present proceeding is an Image File Wrapper (IFW) proceeding and the paper was entered into the IFW record. Therefore, the papers cannot be "returned" to the Patent Owner, but the papers have been (and will remain) marked "closed" and "not public." The paper will not form part of the record, and will not be available to the public.

This decision is made of record in the reexamination proceeding.

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.

Lissi Marquis
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

mas

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

APPLIED MATERIALS, INC.
P. O. BOX 450A
SANTA CLARA CA 95052

(for Patent Owner)

MAILED

MAY 07 2007

CENTRAL REEXAMINATION UNIT

Douglas G. Hodder
MORRISON & FOERSTER LLP
755 Page Mill Road
Palo Alto, CA 95018

(For Third Party Requester)

Doublas G. Hodder
MORRISON & FOERSTER LLP
425 Market Street
San Francisco, CA 94304

(For Third Party Requester)

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

In re: Alumot *et alia* :
Ex Parte Reexamination Proceeding :
Control No. 90/007,577 :
Filed: June 3, 2005 :
For U.S. Patent No. 5,982,921 :

In re: Alumot *et alia* :
Ex Parte Reexamination Proceeding :
Control No. 90/007,691 :
Filed: August 22, 2005 :
For U.S. Patent No. 5,982,921 :

The above-identified reexamination files are before the Director of the Central Reexam Unit 3999, for consideration of merger of reexamination control number 90/007,577 (the '577 proceeding) and the reexamination control number 90/007,691 (the '691 proceeding) pursuant to 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 5,982,921 issued on November 9, 1999.

2. The 90/007,577 reexamination proceeding was filed on June 3, 2005 by a third party requester.

3. The '577 proceeding Order granting reexamination was mailed on August 17 2005.

4. A non-final Office action in the '577 proceeding was mailed on January, 10, 2007.

5. A response and amendment to the claims from the Patent Owner was received by the Office March 13, 2007.

6. The 90/007,691 reexamination proceeding was filed August 22, 2005 by a third party requester.

7. The '691 proceeding Order granting reexamination was mailed on September 30, 2005.

8. There are no amendments to the '691 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 90/007,577 and 90/007,691 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 90/007,577 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. 90/007,577 and 90/007,691 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 90/007,577 and 90/007,691 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

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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CENTRAL REEXAMINATION UNIT

Applied Materials, Inc.
P.O. Box 450A
Santa Clara, CA 95052

(For Patent Owner)

Douglas G. Hodder
Morrison & Foerster LLP
755 Page Mill Road
Palo Alto, CA 94304-1018

(For Third Party Requester)

Robert A. Saltzberg
Morrison & Foerster LLP
425 Market Street
San Francisco, CA 94105

(For Third Party Requester)

In re Alumot *et alia*
Reexamination Proceeding
Control No. 90/007,577
Request Deposited: June 3, 2005
For: U.S. Patent No. 5,982,921

In re Alumot *et alia*
Reexamination Proceeding
Control No. 90/007,691
Request Deposited: August 22, 2005
For: U.S. Patent No. 5,982,921

In re Alumot *et alia*
Reexamination Proceeding
Control No. 90/008,690
Request Deposited: August 22, 2005
Corrected Request Deposited: July 20, 2007
For: U.S. Patent No. 5,982,921

DECISION *SUA SPONTE*
MERGING
REEXAMINATION
PROCEEDINGS

The above identified *ex parte* reexamination files are before the Director of the Central Reexam Unit for consideration of merger of proceedings under 37 CFR 1.565(c).

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,982,921 (hereinafter, the '921 patent), issued to Alumot *et alia*, on November 9, 1999.

2. On June 3, 2005, a third party requester deposited a Request for *Ex Parte* Reexamination of the '921 patent. The reexamination proceeding was assigned Control No. 90/007,577 (hereinafter, the '7577 proceeding).

3. The Reexamination Order was granted in the '7577 proceeding on August, 17, 2005.

4. A non-final office action was mailed on January 10, 2007 in the '7577 proceeding.

5. A response and amendment to the claims was filed by Patent Owner on March 13, 2007.

6. On August 22, 2005, a third party deposited a Request for *Ex Parte* Reexamination of the '921 patent. The reexamination proceeding was assigned Control No. 90/007,577 (hereinafter, the '7691 proceeding).

7. The Reexamination Order was granted in the '7691 proceeding on September 30, 2005.

8. The '7577 and '7691 proceedings were merged on May 7, 2007.

9. A housekeeping amendment was filed on June 4, 2007 to maintain the same claims and specification in the merged '7577 and '7691 proceedings.

10. On July 20, 2007, a third party deposited a corrected Request for *Ex Parte* Reexamination of the '921 patent. The reexamination proceeding was assigned Control No. 90/008,690 (hereinafter, the '8690 proceeding).

11. The Reexamination Order was granted in the '8690 proceeding on August 22, 2007.

12. There are currently no amendments in the '8690 proceeding.

DECISION

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.

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '7577, '7691, and '8690 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.

As noted above, the claims have been amended in the '7577 and '7691 reexamination proceedings. 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 all files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

III. Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to all 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. 90/007,577, 90/007,691, and 90/008,690 are **merged**.

2. Patent Owner has one month from the date of this decision to submit a "housekeeping" amendment. Upon receipt of the "housekeeping" amendment, an office action will be issued in due course.

3. All correspondence regarding these proceedings should be submitted as follows:

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

ERIC S. KEASEL
CRU SPE-AU 3992

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.
90/007,691	08/22/2005	5982921	586852800100	5350

26185 7590 03/04/2009
FISH & RICHARDSON P.C.
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/04/2009

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Douglass C. Hodder

MORRISON & FOERSTER LLP

755 PAGE MILL RD

PALO ALTO, CA 94304-1018

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MAR 04 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/007,577, 90/007,691, 90/008,690

PATENT NO. 5982921.

ART UNIT 3992.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Applied Materials, Inc.
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(For Patent Owner)

Douglas G. Hodder
Morrison & Foerster LLP
755 Page Mill Road
Palo Alto, CA 94304-1018

(For Third Party Requester)

Robert A. Saltzberg
Morrison & Foerster LLP
425 Market Street
San Francisco, CA 94105

(For Third Party Requester)

In re Alumot *et alia*
Reexamination Proceeding
Control No. 90/007,577
Request Deposited: June 3, 2005
For: U.S. Patent No. 5,982,921

In re Alumot *et alia*
Reexamination Proceeding
Control No. 90/007,691
Request Deposited: August 22, 2005
For: U.S. Patent No. 5,982,921

In re Alumot *et alia*
Reexamination Proceeding
Control No. 90/008,690
Request Deposited: August 22, 2005
Corrected Request Deposited: July 20, 2007
For: U.S. Patent No. 5,982,921

DECISION DISMISSING
PETITION FOR EXTENSION
OF TIME
UNDER 37 CFR 1.550

MAILED

MAR 04 2009

CENTRAL REEXAMINATION UNIT

This is a decision on the February 25, 2009, "REQUEST FOR EXTENSION OF TIME FOR RESPONSE PURSUANT TO 37 C.F.R 1.550" requesting that the time to submit a Patent Owner Appeal Brief be extended two months.

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

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,982,921 (hereinafter, the '921 patent), issued to Alumot *et alia*, on November 9, 1999.

2. On June 3, 2005, a third party requester deposited a Request for *Ex Parte* Reexamination of the '921 patent. The reexamination proceeding was assigned Control No. 90/007,577 (hereinafter, the '7577 proceeding).

3. The Reexamination Order was granted in the '7577 proceeding on August, 17, 2005.

4. A non-final office action was mailed on January 10, 2007 in the '7577 proceeding.

5. A response and amendment to the claims was filed by Patent Owner on March 13, 2007.

6. On August 22, 2005, a third party deposited a Request for *Ex Parte* Reexamination of the '921 patent. The reexamination proceeding was assigned Control No. 90/007,577 (hereinafter, the '7691 proceeding).

7. The Reexamination Order was granted in the '7691 proceeding on September 30, 2005.

8. The '7577 and '7691 proceedings were merged on May 7, 2007.

9. A housekeeping amendment was filed on June 4, 2007 to maintain the same claims and specification in the merged '7577 and '7691 proceedings.

10. On July 20, 2007, a third party deposited a corrected Request for *Ex Parte* Reexamination of the '921 patent. The reexamination proceeding was assigned Control No. 90/008,690 (hereinafter, the '8690 proceeding).

11. The Reexamination Order was granted in the '8690 proceeding on August 22, 2007.

12. The '7577, '7691, and '8690 proceedings were merged on December 6, 2007.

13. A non-final rejection was mailed on February 7, 2008.

14. An amendment was timely filed on April 7, 2008.

15. A final rejection was mailed on August 5, 2008.

16. An after-final response was filed on August 13, 2008.

17. An advisory action was mailed on November 10, 2008.

18. A Notice of Appeal, a second after-final response, and the present petition were filed on January 5, 2009.

19. An advisory action was mailed on February 19, 2009 withdrawing 35 USC 305 rejections of claims 41-45, 47-49, 63-65 as well as other rejections.

20. On February 25, 2009, the present petition was filed.

DECISION

The Patent Owner requests an extension of time in which to file a Patent Owner Appeal Brief. The present petition for extension of time was timely filed on February 25, 2009.

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 must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.

Analysis and Findings

Initially, it noted that Patent Owner states "[n]o fee is believed to be due". However, 37 CFR §1.550(c) clearly states

> Any request for such extension must be accompanied by the petition fee set forth in § 1.17(g).

An authorization to charge Deposit Account No. 06-1050 is given in the petition. Accordingly, the required fee has been applied to said Deposit Account No.

The petition lacks a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and why, in spite of the action taken thus far, the requested additional time is needed.

The present petition notes that a petition filed January 5, 2009 has not yet been decided as of the filing date of the present petition. Petitioner attention is directed to 37 CFR 1.181(f), which states, in part, "[t]he 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."

CONCLUSION

1. Petitioner's request is **dismissed**.

2. **All** correspondence relating to this *ex parte* reexamination proceeding should be directed:

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

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

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

By hand: Customer Service Window

Randolph Building
401 Dulany Street
Alexandria, VA 22314

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

3. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929.

Eric Keasel 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
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Doublas G. Hodder

MORRISON & FOERSTER, LLP

425 Market Street

San Francisco, CA 94304

MAILED

MAR 04 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007691

PATENT NO. 5,982,921

ART UNI 3900

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,691	08/22/2005	5982921	586852800100	5350

26185 7590 03/04/2009

FISH & RICHARDSON P.C.
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/04/2009

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Applied Materials, Inc.
P.O. Box 450A
Santa Clara, CA 95052

(For Patent Owner)

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755 Page Mill Road
Palo Alto, CA 94304-1018

(For Third Party Requester)

Robert A. Saltzberg
Morrison & Foerster LLP
425 Market Street
San Francisco, CA 94105

(For Third Party Requester)

In re Alumot *et alia*
Reexamination Proceeding
Control No. 90/007,577
Request Deposited: June 3, 2005
For: U.S. Patent No. 5,982,921

In re Alumot *et alia*
Reexamination Proceeding
Control No. 90/007,691
Request Deposited: August 22, 2005
For: U.S. Patent No. 5,982,921

In re Alumot *et alia*
Reexamination Proceeding
Control No. 90/008,690
Request Deposited: August 22, 2005
Corrected Request Deposited: July 20, 2007
For: U.S. Patent No. 5,982,921

DECISION DISMISSING PETITION TO WITHDRAW FINALITY UNDER 37 CFR 1.181

MAILED

MAR 04 2009

CENTRAL REEXAMINATION UNIT

This is a decision on the January 5, 2009, "PETITION UNDER 37 C.F.R §1.181 TO WITHDRAW FINALITY OF OFFICE ACTION".

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

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,982,921 (hereinafter, the '921 patent), issued to Alumot *et alia*, on November 9, 1999.

2. On June 3, 2005, a third party requester deposited a Request for *Ex Parte* Reexamination of the '921 patent. The reexamination proceeding was assigned Control No. 90/007,577 (hereinafter, the '7577 proceeding).

3. The Reexamination Order was granted in the '7577 proceeding on August, 17, 2005.

4. A non-final office action was mailed on January 10, 2007 in the '7577 proceeding.

5. A response and amendment to the claims was filed by Patent Owner on March 13, 2007.

6. On August 22, 2005, a third party deposited a Request for *Ex Parte* Reexamination of the '921 patent. The reexamination proceeding was assigned Control No. 90/007,577 (hereinafter, the '7691 proceeding).

7. The Reexamination Order was granted in the '7691 proceeding on September 30, 2005.

8. The '7577 and '7691 proceedings were merged on May 7, 2007.

9. A housekeeping amendment was filed on June 4, 2007 to maintain the same claims and specification in the merged '7577 and '7691 proceedings.

10. On July 20, 2007, a third party deposited a corrected Request for *Ex Parte* Reexamination of the '921 patent. The reexamination proceeding was assigned Control No. 90/008,690 (hereinafter, the '8690 proceeding).

11. The Reexamination Order was granted in the '8690 proceeding on August 22, 2007.

12. The '7577, '7691, and '8690 proceedings were merged on December 6, 2007.

13. A non-final rejection was mailed on February 7, 2008.

14. An amendment was timely filed on April 7, 2008.

15. A final rejection was mailed on August 5, 2008.

16. An after-final response was filed on August 13, 2008.

17. An advisory action was mailed on November 10, 2008.

18. A Notice of Appeal, a second after-final response, and the present petition were filed on January 5, 2009.

19. An advisory action was mailed on February 19, 2009 withdrawing 35 USC 305 rejections of claims 41-45, 47-49, 63-65 as well as other rejections.

20. On March 4, 2009, the office mailed a PTO-90C indicating that the 35 USC 305 rejections of claims 34-36, 46, and 56-58 were withdrawn.

DECISION

Patent Owner argues that the presence of a 35 USC 305 rejection of claims 34-36, 41-49, 56-58, and 63-65 in the office action mailed August 5, 2008 were not necessitated by the most current amendment. So, the office action can not properly be made final. In the advisory action mailed February 19, 2009 and the letter mailed March 4, 2009, all of the rejections in question (as well as others) have been withdrawn. It is noted that the rejection of claim 47 is withdrawn in the advisory action as indicated by claim 47 being indicated as patentable and/or confirmed in box 6 of the advisory. Since the underlying basis for the requested relief no longer exists, the petition is dismissed as moot and the office action mailed August 5, 2008 remains a final rejection.

CONCLUSION

1. Petitioner's request is **dismissed as moot**.

2. **All** correspondence relating to this *ex parte* reexamination proceeding should be directed:

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

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

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

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

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

3. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929.

Eric Keasel For

Gregory Morse
Director, Central Reexamination Unit

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.
90/007,692	08/24/2005	6118124	DSR-911	5480

47501 7590 11/28/2008

JOHN S. PRATT, ESQ.
KILPATRICK STOCKTON, LLP
1100 PEACHTREET STREET, SUITE 2800
ATLANTA, GA 30309-4530

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/28/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Kenneth N. Nigon
P.O. Box 980
Valley Forge, PA 19482

Date: NOV 28 2008

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007692
PATENT NO. : 6118124
ART UNIT : 2800

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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Kilpatrick Stockton, LLP
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Atlanta, GA 30309-4530

(For Patent Owner)

Ratner Prestia
P. O. Box 980
Valley Forge, PA 19482

(For Requester)

In re Thundat et al
Ex Parte Reexamination Proceeding
Control No. 90/007,692
Filed: August 24, 2005
For: U.S. Patent No. 6,118,124

: **DECISION**
: **GRANTING**
: **PETITION**

This is a decision on the September 25, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding ("the September 25, 2008 patent owner petition to revive").

The September 25, 2008 patent owner petition to revive, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

The petition fee of $1540 set forth in 37 CFR 1.17(m) for the present petition under 37 CFR 1.137(b) has been received.

SUMMARY

The September 25, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 47(a)(7) provides, in pertinent part:

> REVIVAL FEES. — On filing each petition . . . for an unintentionally delayed response by the patent owner in any reexamination proceeding . . .

35 U.S.C. 133 provides:

> Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

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:

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).

*

*

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 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 under 37 CFR 1.137(b) was unintentional. The patent owner has submitted a notice of appeal and appeal fee on November 25, 2008, which satisfies item (1).[1] A petition fee and a proper statement under 37 CFR 1.137(b)(3) have also been submitted with the September 25, 2008 patent owner petition to revive, which satisfy items (2) and (3), respectively.

[1] See MPEP 2268 IV and MPEP 711.03(c) II A 2 (b).

Accordingly, the September 25, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding[2] is **granted**.

CONCLUSION

- The September 25, 2008 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.
- Jurisdiction over this reexamination proceeding is being returned to Central Reexamination Unit Art Unit 3992 for processing of the September 25, 2008 patent owner response (including three attached declarations under 37 CFR 1.132), to the July 17, 2008 final Office action.
- Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Kim Nguyen, of CRU Art Unit 3992, at (571) 272-4441.
- Any inquiry concerning this decision should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.

Kenneth M. Schor

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

cn

[2] 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.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,692	08/24/2005	6118124	DSR-911	5480

47501 7590 04/01/2009

JOHN S. PRATT, ESQ.
KILPATRICK STOCKTON, LLP
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ATLANTA, GA 30309-4530

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/01/2009

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Kenneth N. Nigon
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CENTRAL REEXAMI

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/007,692*.

PATENT NO. *6118124*.

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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JOHN S. PRATT, ESQ.
KILPATRICK STOCKTON, LLP
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ATLANTA, GA 30309-4530

(For Patent Owner)

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APR 01 2009

CENTRAL REEXAMINATION UNIT

Kenneth N. Nigon, Esq.
Ratner Prestia
P.O. Box 980
Valley Forge, PA 19482

(For Third Party Requester)

In re Thundat et al.
Ex Parte Reexamination Proceeding
Control No. 90/007,692
Filed: August 24, 2005
For: U.S. Patent No. 6,118,124

: **DECISION**
: **GRANTING**
: **PETITION UNDER**
: **37 CFR 1.137(b)**

This is a decision on the patent owner petition entitled "PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)" filed on March 23, 2009. The present petition is being treated as a petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to the December 22, 2008 non-final Office action and revive the present terminated reexamination prosecution. [1]

The appropriate petition fee of $1620 set forth in 37 CFR 1.17(m) for the present petition, filed under 37 CFR 1.137(b), has been paid.

The present petition under 37 CFR 1.137(b) and the 90/007,692 *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** for the reasons set forth below.

[1] 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 response under 37 CFR 1.550(b) to the December 22, 2008 Office action.

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 1.111 provides, in pertinent part:

(a)(1) If the Office action after the first examination (§ 1.104) is adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply and request reconsideration or further examination, with or without amendment. See §§ 1.135 and 1.136 for time for reply to avoid abandonment.

*

*

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

37 CFR 1.137 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:

(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..

*

(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)(a) provides, in pertinent part:

The required reply to a non-final action in a nonprovisional application abandoned for failure to prosecute may be either:

(A) an argument or an amendment under 37 CFR 1.111;

*

The grant of a petition under 37 CFR 1.137 is not a determination that any reply under 37 CFR 1.111 is complete. Where the proposed reply is to a non-final Office action, the petition may be granted if the reply appears to be *bona fide*. After revival of the application, the patent examiner may, upon more detailed review, determine that the reply is lacking in some respect. In this limited situation, the patent examiner should send out a letter giving a 1-month shortened statutory period under 37 CFR 1.135(c) for correction of the error or omission. Extensions of time under 37 CFR 1.136(a) are permitted. If applicant does not correct the omission within the time period set in the letter (including any extension), the application is again abandoned.

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).

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.

A petition fee and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the March 23, 2009 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Regarding item (1), the instant reexamination proceeding was terminated due to the failure to timely submit a response to the December 22, 2008 non-final Office action. The December 22, 2008 Office action set a two-month period for response. A response to the December 22, 2008 Office action was not filed until March 23, 2009, which was untimely. For the purpose of evaluating whether the March 23, 2009 patent owner petition to revive is a grantable petition, the submission of the March 23, 2009 response[2] to the December 22, 2008 Office action satisfies item (1).[3]

Accordingly, the March 23, 2009 patent owner petition to revive is **granted**.

---

[2] The response filed on March 23, 2009 is mislabeled as "Response to Final Office Action of December 22, 2008." The December 22, 2008 was a non-final Office action. The March 23, 2009 response is being treated as a response pursuant to 37 CFR 1.111 and appears to be *bona fide*.

[3] This decision is not directed to the persuasiveness and propriety of the arguments presented in the March 23, 2009 response as to each of the rejections set forth in the December 22, 2008 Office action; such is the examiner's province.

CONCLUSION

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

2. Jurisdiction over this reexamination proceeding is being transfered to the Central Reexamination Unit (CRU), Art Unit 3992, for further processing of the March 23, 2009 response under 37 CFR 1.111.

3. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Kim Nguyen, of CRU Art Unit 3992, at (571) 272-4441.

4. Any inquiry concerning this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

Kenneth M. Schor

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
P.O. Box 1450
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DEC 0 1 2006

CENTRAL REEXAMINATION UNIT

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BRYAN J. LEMPIA (For Third Party Requester)
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6300 SEARS TOWER
CHICAGO, IL 60606

In re Reexamination Proceeding	:
H. Focke et al	:
Control No. 90/007,702	: DECISION GRANTING PETITION
Filed: August 31, 2005	:
U.S. Patent No. 6,343,691	:
Attorney Docket No. 207,205	:

This is a decision on the petition under 37 CFR 1.10(c) filed November 22, 2006, by facsimile transmission, requesting that an amendment received September 19, 2006, be treated as being filed on September 18, 2006, the date it was deposited in Express Mail Service.

In the present petition , petitioners allege that the amendment received September 19, 2006, was deposited in Express Mail Service on September 18, 2006. In support, the petition is accompanied by, *inter alia,* an Express Mail label No. ER059676290US (the same Express Mail number found on the correspondence received September 19, 2006) showing a "Date-In" of September 18, 2006, a copy of a postcard receipt specifically itemizing that an amendment was filed and including Express Mail label No. ER059676290US thereon, and an authorization to charge counsel's deposit account for any fee which may be due for filing the present petition.

The Office considers the date that a paper or fee is shown to have been deposited as "Express Mail" to be the "Date-In" on the Express Mail label, MPEP 513. In this instance, the evidence is convincing that the amendment was deposited as "Express Mail" with the U. S. Postal Service on September 18, 2006.

In view of the above, the petition is **GRANTED**. No petition fee is required and none has been charged to counsel's deposit account.

Copied from 90007102 on 12/05/2006

The record will be corrected to show that the amendment received September 19, 2006, was deposited in Express Mail Service on September 18, 2006. The amendment will be treated as being filed on September 18, 2006.

Jurisdiction over the reexamination proceeding is being returned to CRU Art Unit 3993 for further examination and consideration of the correspondence filed February 6, 2006, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Jimmy 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

Copied from 90007102 on 12/05/2006

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,703	09/01/2005	6609764	WCMI-0045	4117

26568 7590 09/19/2007

COOK, ALEX, MCFARRON, MANZO, CUMMINGS & MEHLER LTD
SUITE 2850
200 WEST ADAMS STREET
CHICAGO, IL 60606

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/19/2007

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

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9/19/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

MARLIN R. SMITH

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660 NORTH CENTRAL EXPRESSWAY, SUITE 230

PIANO, TX 75074

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007703

PATENT NO. 6,609,764

ART UNI 3993

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

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

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SEP 19 2007

CENTRAL REEXAMINATION UNIT

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In re Reissue Application of Dudding, et al. Application No. 11/490,507 Filed: July 20, 2006 For: U.S. Patent No. 6,609,764	:	**DECISION,** ***SUA SPONTE,*** **TO MERGE REISSUE AND REEXAMINATION PROCEEDINGS**
In re Dudding et al. Reexamination Proceeding Control No. 90/007703 Filed: September 1, 2005 For: U.S. Patent No. 6,609,764	:	

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

REVIEW OF FACTS

1. U.S. Patent No. 6,609,764 (the '764 patent) issued on August 26, 2003, with 92 claims.

2. A request for reexamination of the '764 patent was filed by a third party requester on September 1, 2005, and was assigned control No. 90/007,703 (the '703 proceeding).

3. Reexamination was ordered for the '703 proceeding on November 4, 2005.

4. Notice of the filing of the request for reexamination was announced in the *Official Gazette* on November 29, 2005.

5. A patent owner's statement under 37 CFR 1.530 has not been received in the '703 proceeding, and the time for filing same has expired.

6. A non-final Office Action in the '703 proceeding was mailed on March 16, 2006.

7. The patent owner filed an amendment in the '703 proceeding on May 16, 2006.

8. An application for reissue of the '764 patent, assigned application No. 11/490,507 (the '507 application), was filed by the patent owner on July 20, 2006.

9. A paper was filed with the '507 application amending the claims in the same manner as was done in the '703 proceeding.

10. On July 20, 2006, the patent owner filed, in the '703 proceeding, a notice of concurrent proceeding under 37 CFR 1.565, informing the Office of the '507 reissue application.

11. The filing of the '507 reissue application was announced in the *Official Gazette* on September 5, 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. 11/490,507 and reexamination control No. 90/007,703 are currently pending. The order to reexamine has been mailed in the reexamination proceeding, and a 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 and the reexamination files for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the reissue and reexamination proceedings remain merged. See 37 CFR 1.565(d).

2. A review of the file for reexamination control No. 90/007,703 and the reissue application 11/490,507 shows that both contain: original claims 2-5, 7-9, 11-17, 19-24, 27-37, 39-44, 48, 50-52, 54, 59-65, 74, and 78-91; amended claims 1, 6, 10, 18, 25, 26, 38, 46, 47, 49, 53, 73, 75, and 77; canceled claims 45, 55-58, 66-72, 76, and 92; and new claims 93-101. The claims are identical in both number and text in both proceedings.

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

1. Upon receipt of the merged proceeding, the examiner should promptly prepare an Office action for the merged proceeding.

2. 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).**

3. 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).

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

5. 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 is 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 amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

6. Where a paper is filed which requires payment of a fee (e.g., petition fee, 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.

7. 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.

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

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

considered under reexamination following the dissolution would be noted by the examiner as not being proper for consideration in reexamination pursuant to 37 CFR 1.552(c).

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

CONCLUSION

1. Reissue application No. 11/490,507 and reexamination control No. 90/007,703 **are merged** into a single proceeding.

2. Jurisdiction over the merged reissue and reexamination proceeding is being transferred to Technology Center 3600, in which the reissue proceeding is assigned. The examiner assigned the merged proceeding is not to be one who was involved in any part of the examination of the '764 patent (e.g., by preparing/signing an action). See MPEP 2236.

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

4. Telephone inquiries related to this decision should be directed to Caroline Dennison, Legal Advisor, at (571) 272-7729.

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

cdd
DATE

9/18/07
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CENTRAL REEXAMINATION UNIT

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In re Reissue Application of Jerry L. Farrar, *et al.* Application No.: 11/145,502 Filed: June 3, 2005 For: U.S. Patent No. 6,688,044 In re Jerry L. Farrar, *et al.* Reexamination Proceeding Control No.: 90/007,704 Filed: September 1, 2005 For: U.S. Patent No.: 6,688,044	DECISION, *SUA SPONTE*, TO MERGE REISSUE AND REEXAMINATION PROCEEDINGS

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

REVIEW OF FACTS

1. U.S. Patent No. 6,688,044 (the '044 patent) issued on February 10, 2004.

2. An application for reissue, assigned application No. 11/145,502 (the '502 reissue application), was filed by the patent owner on June 3, 2005.

3. Notice of the filing of the reissue application was published in the *Official Gazette* on July 19, 2005.

4. A request for reexamination, assigned control No. 90/007,704 (the'7704

reexamination proceeding), was filed by a third party requester on September 1, 2005.

5. Reexamination was ordered for the '7704 reexamination proceeding on October 21, 2005.

6. A patent owner's statement under 37 CFR 1.530 has not been received in the '7704 reexamination proceeding, and the time for filing same expired.

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, the '502 reissue application and the '7704 reexamination proceeding are currently pending. Because the order to reexamine has been mailed in the '7704 reexamination proceeding, a decision under 37 CFR 1.565(d) is timely.

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

In order to provide efficient and prompt handling of all proceedings and to prevent inconsistent, and possibly conflicting, amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the 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 and reexamination files for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the proceedings remain merged. See 37 CFR 1.565(d).

2. A review of the reexamination file for the '7704 reexamination proceeding shows that original patent claims 1-18 are present and no claims are added by amendment. A review of the '502 reissue application shows that original patent claims 1-18 are present and no claims are added by amendment. Accordingly, the claims are identical in both proceedings.

3. It is noted, however, that the specification is amended in the '502 reissue application, while not so for the '7704 reexamination proceeding. In particular, the entire SUMMARY OF THE INVENTION of the '044 patent (beginning on column 2, line 25, and ending on column 3, line 57) is amended by the Preliminary Amendment for Reissue Application filed on June 3, 2005, in the '502 reissue application.

4. An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both cases, specifically, the above-captioned reissue and reexamination proceedings. The response to the requirement must be limited to placing the same amendments in all cases, and patent owner must not address any issue of patentability in the housekeeping amendment.

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

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

2. In the event that a housekeeping amendment is not timely submitted, the disclosures in both proceedings should be objected to as being inconsistent for the same underlying patent.

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

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

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

6. Pursuant to MPEP 2285:

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

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

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

7. Where a paper is filed which requires payment of a fee (e.g., petition fee, excess claim 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.

8. Upon return of the present merged proceeding to the examiner, the examiner will review the files to ascertain 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.

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 concluded as follows. The reissue application will be held abandoned, and the merger will be dissolved as to the reissue application. With respect to the reexamination proceeding, the Director will proceed to issue a reexamination certificate under 37 CFR 1.570 in accordance with the last action of the Office, unless further action is clearly needed as a result of the difference in rules relating to reexamination and reissue proceedings. Thus, any grounds of rejection that are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection that are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner upon dissolution of the merged proceeding as to the reissue application. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 CFR 1.552(c).

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

CONCLUSION

1. Reissue application No. 11/145,502 and reexamination control No. 90/007,704 are hereby merged into a single proceeding.

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

3. Jurisdiction over the merged reissue and reexamination proceeding is being transferred to Technology Center 3600, in which the reissue proceeding is assigned. The examiner assigned the merged proceeding is not to be one who was involved in any part of the examination of the '044 patent (e.g., by preparing/signing an action). See MPEP 2236. 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) set in part 2 of the "Conclusion."

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

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

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

October 24, 2007

Oct. 24, 2007
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CENTRAL REEXAMINATION UNIT

Reexam Control No.: 90/007,704
Filed : September 1, 2005
For U.S. Patent no. : 6,688,044

Reissue Application No.: 11/145,502
Filed : June 3, 2005
For U.S. Patent No. : 6,688,044

DECISION DISSOLVING MERGED REISSUE APPLICATION AND REEXAMINATION PROCEEDINGS

In a decision mailed October 26, 2007, the instant reexamination proceeding and then copending reissue application No. 11/145,502 were *sua sponte* merged. Under section III, "Conduct of the Merged Reissue Application Examination and Reexamination Proceedings", paragraph No. 11, it was stated that 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 would accept the express abandonment, dissolve the merged proceedings as to the reissue application, and continue examination as to the reexamination proceeding. Such examination would be conducted as set forth in paragraph No. 10 of that decision.

A letter expressly abandoning the reissue application No. 11/145,502 pursuant to 37 CFR 1.138 was filed by applicant on June 16, 2008. On July 3, 2008, the Office mailed out a letter accepting the express abandonment of the reissue application. Accordingly, in view of the express abandonment of the reissue application and guidelines set forth in section III of the decision merging the two, the merger is hereby deemed dissolved.

Upon the mailing of this decision, the application will be forwarded to an examiner in the Central Reexamination Unit for the issuance of an appropriate action.

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

Andres Kashnikow, SPE
Central Reexamination Unit

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CENTRAL REEXAMINATION UNIT

Reexam Control No.: 90/007,704
Filed : September 1, 2005
For U.S. Patent no. : 6,688,044

Reissue Application No.: 11/145,502
Filed : June 3, 2005
For U.S. Patent No. : 6,688,044

DECISION DISSOLVING MERGED REISSUE APPLICATION AND REEXAMINATION PROCEEDINGS

In a decision mailed October 26, 2007, the instant reexamination proceeding and then copending reissue application No. 11/145,502 were *sua sponte* merged. Under section III, "Conduct of the Merged Reissue Application Examination and Reexamination Proceedings", paragraph No. 11, it was stated that 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 would accept the express abandonment, dissolve the merged proceedings as to the reissue application, and continue examination as to the reexamination proceeding. Such examination would be conducted as set forth in paragraph No. 10 of that decision.

A letter expressly abandoning the reissue application No. 11/145,502 pursuant to 37 CFR 1.138 was filed by applicant on June 16, 2008. On July 3, 2008, the Office mailed out a letter accepting the express abandonment of the reissue application. Accordingly, in view of the express abandonment of the reissue application and guidelines set forth in section III of the decision merging the two, the merger is hereby deemed dissolved.

Upon the mailing of this decision, the application will be forwarded to an examiner in the Central Reexamination Unit for the issuance of an appropriate action.

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

Andres Kashnikow

Andres Kashnikow, SPE
Central Reexamination Unit

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(For Third Party Requester)

In re Reissue Application of
Karol Doktor
Application No.: 11/152,833
Filed: June 14, 2005
For: U.S. Patent No. 5,617,567

In re Karol Doktor
Reexamination Proceeding
Control No.: 90/007,705
Filed: September 1, 2005
For: U.S. Patent No.: 5,617,567

DECISION, *SUA SPONTE*, TO MERGE REISSUE AND REEXAMINATION PROCEEDINGS

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

REVIEW OF FACTS

1. U.S. Patent No. 5,617,567 issued on April 1, 1997.

2. An application for reissue, assigned application No. 11/152,833, was filed by the patent owner on June 14, 2005.

3. Notice of the filing of the reissue application was published in the *Official Gazette* on July 26, 2005.

4. A request for reexamination, assigned control No. 90/007,705 (the'7705 reexamination proceeding),, was filed by a third party requester on September 1, 2005.

5. Reexamination was ordered for the '7705 reexamination proceeding on

September 30, 2005.

6. A patent owner's statement under 37 CFR 1.530 has not been received in the '7705 reexamination proceeding.

DISCUSSION REGARDING MERGER

Under 37 CFR 1.565(d):

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

As evidenced by the above review of facts, reissue application No. 11/152,833 and reexamination control No. 90/007,705 are currently pending. Since the order to reexamine has been mailed in the reexamination proceeding, a decision under 37 CFR 1.565(d) is timely.

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

In order to provide efficient and prompt handling of all proceedings and to prevent inconsistent, and possibly conflicting, amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexamination proceeding will be 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 and reexamination files for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the proceedings remain merged. See 37 CFR 1.565(d).

2. A review of the reexamination file for the proceeding of reexamination control No. 90/007,705 shows that original patent claims 1-18 are present and no claims are added by amendment. A review of reissue application No. 11/152,833 shows that original patent claims 1-18 are present and no claims are added by amendment. Accordingly, the claims are identical in both proceedings.

3. It is noted, however, that the first paragraph of the specification is amended in the reissue application, while not so for the reexamination proceeding. An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both cases, specifically, the above-captioned reissue and reexamination proceedings. The response to the requirement must be limited to placing the same amendments in all cases, and patent owner must not address any issue of patentability in the housekeeping amendment.

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

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

2. In the event that a housekeeping amendment is not timely submitted, the disclosures in both proceedings should be objected to as being inconsistent for the same underlying patent.

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

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

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

6. Pursuant to MPEP 2285:

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

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

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

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

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

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

10. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be concluded as follows. The reissue application will be held abandoned, and the merger will be dissolved as to the reissue application. With respect to the reexamination proceeding, the USPTO Director will proceed to issue a reexamination certificate under 37 CFR 1.570 in accordance with the last action of the Office, unless further action is clearly needed as a result of the difference in rules relating to reexamination and reissue proceedings. Thus, any grounds of rejection that are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any

new grounds of rejection that are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner upon dissolution of the merged proceeding as to the reissue application. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 CFR 1.552(c).

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

CONCLUSION

1. Reissue application No. 11/152,833 and reexamination control No. 90/007,705 are hereby merged into a single proceeding.

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

3. Jurisdiction over the reissue and reexamination proceedings is hereby transferred to the examiner via the Director of Technology Center 2100. 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) set in part 2 of the "Conclusion."

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

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

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

December 1, 2005
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UNITED STATES PATENT AND TRADEMARK OFFICE

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ALEXANDRIA, VA 22313-1450
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(For Patent Owner)

MAILED
DEC 0 5 2006
REEXAM UNIT

Donald E. Daybell
ORRICK HERRINGTON & SUTCLIFFE LLP
4 Park Plaza, Suite 1600
Irvine, CA 92614

(For Third Party Requester)

In re Reissue Application of
Karol Doktor
Application No.: 11/152,835
Filed: June 14, 2005
For: U.S. Patent No. 5,826,259

In re Karol Doktor
Reexamination Proceeding
Control No.: 90/007,707
Filed: September 1, 2005
For: U.S. Patent No.: 5,826,259

: DECISION, *SUA SPONTE*, TO MERGE REISSUE AND REEXAMINATION PROCEEDINGS

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

REVIEW OF FACTS

1. U.S. Patent No. 5,826,259 issued on October 20, 1998.

2. An application for reissue, assigned application No. 11/152,835, was filed by the patent owner on June 14, 2005.

3. Notice of the filing of the reissue application was published in the *Official Gazette* on July 26, 2005.

4. A request for reexamination, assigned control No. 90/007,707 (the'7707

reexamination proceeding), was filed by a third party requester on September 1, 2005.

5. Reexamination was ordered for the '7707 reexamination proceeding on September 30, 2005.

A patent owner's statement under 37 CFR 1.530 has not been received in the '7707 reexamination proceeding.

DISCUSSION REGARDING MERGER

Under 37 CFR 1.565(d):

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

As evidenced by the above review of facts, reissue application No. 11/152,835 and reexamination control No. 90/007,707 are currently pending. Since the order to reexamine has been mailed in the reexamination proceeding, a decision under 37 CFR 1.565(d) is timely.

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

In order to provide efficient and prompt handling of all proceedings and to prevent inconsistent, and possibly conflicting, amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexamination proceeding will be 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 and reexamination files for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the proceedings remain merged. See 37 CFR 1.565(d).

2. A review of the reexamination file for the proceeding of reexamination control No. 90/007,707 shows that original patent claims 1-18 are present and no claims are added by amendment. A review of reissue application No. 11/152,835 shows that original patent claims 1-18 are present and no claims are added by amendment. Accordingly, the claims are identical in both proceedings.

3. It is noted, however, that the first paragraph of the specification is amended in the reissue application, while not so for the reexamination proceeding. An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both cases, specifically, the above-captioned reissue and reexamination proceedings. The response to the requirement must be limited to placing the same amendments in all cases, and patent owner must not address any issue of patentability in the housekeeping amendment.

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

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

2. In the event that a housekeeping amendment is not timely submitted, the disclosures in both proceedings should be objected to as being inconsistent for the same underlying patent.

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

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

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

a signature. Any such responses must be served on the requester, who will also be sent copies of Office actions.

6. Pursuant to MPEP 2285:

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

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

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

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

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

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

10. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be concluded as follows. The reissue application will be held abandoned, and the merger will be dissolved as to the reissue application. With respect to the reexamination proceeding, the Director will proceed to issue a reexamination certificate under 37 CFR 1.570 in accordance with the last action of the Office, unless further action is clearly

needed as a result of the difference in rules relating to reexamination and reissue proceedings. Thus, any grounds of rejection that are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection that are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner upon dissolution of the merged proceeding as to the reissue application. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 CFR 1.552(c).

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

CONCLUSION

1. Reissue application No. 11/152,835 and reexamination control No. 90/007,707 are hereby merged into a single proceeding.

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

3. Jurisdiction over the reissue and reexamination proceedings is hereby transferred to the examiner via the Director of Technology Center 2100. 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) set in part 2 of the "Conclusion."

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

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

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

December 2, 2005
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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,710	09/07/2005	5744980	13268/1	1827

23838 7590 07/15/2009

KENYON & KENYON LLP
1500 K STREET N.W.
SUITE 700
WASHINGTON, DC 20005

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/15/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Shawn O'Dowd
KENYON & KENYON LLP
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SUITE 700
WASHINGTON DC 20005

(For Patent Owner)

MAILED

JUL 15 2009

CENTRAL REEXAMINATION UNIT

DECISION
GRANTING-IN-PART
PETITION FOR EXTENSION
OF TIME
37 CFR § 1.550(c) and § 1.181

In re: McGowan *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/007,710
Deposited: 07 September 2005
For: US Patent No. 5,744,980

This is a decision on the 10 June 2009, "Request for Two-Week Extension of Time Pursuant to 37 CFR 1.550(c)" requesting that the time for responding to the Final Office action mailed 13 February 2009, be extended by two-weeks. The petition was timely filed. The petition included the required petition fee pursuant to 37 CFR § 1.17(g).

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.

SUMMARY OF RELEVANT FACTS

1. On 28 April 1998 US Patent No. 5,744,980 was granted.

2. On 07 September 2005 a request for *ex parte* reexamination was submitted patent owner identified by control number 90/007,710.

3. On 27 October 2005 the Order was granted for *ex parte* reexamination in control number 90/007,710.

4. On 10 June 2009 a second after final response was received.

5. On 10 June 2009 the instant petition was submitted.

6. On 12 June the Notice of Appeal was submitted by the patent owner.

DISCUSSION

The Patent Owner requests the period of time be extended in which to file a response to the Office action mailed 05 June 2009, which set a one (1) 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 2 July 2009.

The extension of time is granted-in-part.

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. ...

MPEP 2265 (in-part)

> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.

ANALYSIS AND FINDINGS

The patent owner's representative petition to extend the period for response by adding two (2) weeks to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The petition for extension of time and after final response were not acted upon prior to the filing of the Notice of Appeal on 12 June 2009. The examiner in charge of the proceeding is on extended leave from the Office and is currently not available to respond to the response after final in a timely manner prior to the time for the patent owner to submit the Appeal. On balance considering all the facts before the Director of the Central Reexamination Unit, it is appropriate to grant an extension of time to enable the examiner to respond to the after final submission and allow the patent owner time for which to properly evaluate the issues at Appeal .

The petition request to extend the response time is hereby granted-in-part.

The time for which to respond to the patent owner's notice of appeal is hereby extended by one (1) month.

CONCLUSION

1. The patent owner's petition for extension of time is hereby **granted-in-part.**

2. The time for submission of the Appeal by the patent owner is extended by one (1) month.

3. The Patent Owner's Appeal is due **12 September 2009.**

4. Response and/or submissions to the Office to change the correspondence address or power of attorney in the record of the patent should be addressed 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

By EFS: Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

5. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, in the event that Mark Reinhart is unavailable Eric Keasel at (571) 272-4929, or Jessica Harrison at (571) 272-4449; all are Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992 may also be contacted..

/Mark Reinhart/
for

Gregory Morse
Director,
Central Reexamination Unit 3999

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.
90/007,710	09/07/2005	5744980	13268/1	1827

23838 7590 07/01/2010

KENYON & KENYON LLP
1500 K STREET N.W.
SUITE 700
WASHINGTON, DC 20005

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/01/2010

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

UNITED STATES DEPARTMENT OF COMMERCE
U.S. Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
90007710	9/7/05	5744980	

ACTEL CORPORATION
955 EAST ARQUES AVENUE
SUNNYVALE, CA 94086

EXAMINER
JAMES R. MATTHEWS

ART UNIT	PAPER
3999	20100701A

DATE MAILED: MAILED

JUL 01 2010

CENTRAL REEXAMINATION UNIT

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

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ACTEL CORPORATION
955 EAST ARQUES AVENUE
SUNNYVALE CA 94086

(For Patent Owner-Requester)

MAILED

JUL 01 2010

KENYON & KENYON LLP
1500 K STREET N.W.
SUITE 700
WASHINGTON DC 20005

(Courtesy Copy)

CENTRAL REEXAMINATION UNIT

In re McGowan *et al.*
Ex Parte Reexamination Proceeding
Control No. 90/007,710
Filed: September 7, 2005
For: U.S. Patent No. 5,744,980

: **DECISION GRANTING**
: **PETITION FOR ENTRY**
: **OF AMENDMENT**

This is a decision on the April 28, 2010 patent owner petition entitled "PETITION UNDER 37 CFR § 1.182," seeking entry of an amendment to the claims pursuant to § 1.182, or, in the alternative, pursuant to § 1.183.

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

The petition fee of $400.00 under 37 C.F.R. § 1.17(f) has been charged.

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

DECISION

The April 28, 2010 patent owner petition is filed under 37 C.F.R. § 1.182, or in the alternative, under 37 C.F.R. § 1.183, requesting entry and consideration of an amendment submission previously denied entry. 37 C.F.R. § 1.182 provides for relief that is not currently provided by an existing rule. In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending." [1] Notice was provided therein that a patent owner could file a petition under 37 C.F.R. § 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.

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

The § 1.182 petition procedure was created to address a need for an amendment or evidence submission, the need for which did not become apparent until the issuance of the final rejection or action closing prosecution. The filing of such a § 1.182 petition is strictly controlled by the Office to further the statutory mandate of 35 U.S.C. § 305 that "[a]ll reexamination proceedings under this section . . . will be conducted with **special dispatch** within the Office" [emphasis added]. In keeping with the requirement of special dispatch, a petition under 37 C.F.R. § 1.182 for continued reexamination must show how granting the petition would further the prosecution of the reexamination proceeding. Prosecution may be furthered by reducing issues for appeal or by placing the claims in condition for the issuance of a reexamination certificate. Furthermore, patent owner should set forth reasons why the need for the submission did not become apparent until the issuance of the final rejection or action closing prosecution.

On April 28, 2010, the patent owner timely filed the instant petition, grounded alternatively under §§ 1.182 and 1.183, seeking entry of a simultaneously submitted proposed amendment to the claims. On this date, the proceedings were under appeal, with an appeal brief filed and an examiner's answer having been issued. Patent owner alleges that the petition and amendment was responsive to a footnote in the examiner's answer stating that the sole ground of rejection could have been avoided if the claims under appeal had used the exact language, in one of the claim phrases, of that in the confirmed claims.[2] The amendment is alleged to amend the claims under appeal to conform to the language in the confirmed claims, which the examiner has stated would have avoided the rejection.

The examiner has been consulted to determine if the proposed language would overcome the sole ground of rejection in the proceeding. After review of the amendment, the examiner has determined that entry of the amendment would resolve the sole issue on appeal and place the claims in condition for the issuance of a reexamination certificate. Therefore, despite the extremely late submission of the petition in this proceeding, there exist extraordinary circumstances in the proceeding such that justice requires the entry of the April 28, 2010 amendment in order to best serve the efficient resolution of the question of patentability arising from the art of record. Due to the advanced stage of the proceedings, however, an unrestricted reopening of prosecution would not be in accord with the statutory mandate requiring the Office to conduct this reexamination proceeding with special dispatch.

In view of the above, the restriction on entry of amendments after the filing of a brief in an *ex parte* reexamination as set forth at 37 C.F.R. § 41.33 is hereby waived to the extent that the proposed amendment may be entered and considered by the examiner.

The April 28, 2010 amendment will be entered by the Central Reexamination Unit, and will then be considered by the examiner. <u>This amendment will be treated as a response by patent owner received **after** a final Office action</u>. Following treatment of this amendment by the CRU, the patent owner may, if desired, reinstate the appeal should any appealable issues remain present.

---

[2] Petition at 8.

PATENT OWNER'S ADDRESS

The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c). The current correspondence address of record for the 5,744,980 patent file is that of Actel Corporation, 955 East Arques Ave, Sunnyvale, CA 94086. However, the correspondence address of record in the reexamination file is that of Kenyon and Kenyon LLP, 1500 K Street NW, Suite 700 Washington, DC 20005. As a courtesy, this decision is being mailed to both addresses.

The address of Actel Corporation, 955 East Arques Ave, Sunnyvale, CA 94086, will be the sole address used in future correspondence, until a change in correspondence address in the 5,744,980 patent file is made in accordance with 37 CFR 1.33(c).

CONCLUSION

- The petition is **granted to the extent that** the restriction on entry of amendments after the filing of a brief in an *ex parte* reexamination as set forth at 37 C.F.R. § 41.33 is waived pursuant to 37 C.F.R. § 1.183, such that the April 28, 2010 proposed amendment may be entered and considered by the examiner.

- The April 28, 2010 response will be entered by the Central Reexamination Unit, and it will then be considered by the examiner. These April 28, 2010 response will be treated as a response by patent owner received **after** a final Office action.

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

- Any inquiry concerning this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.

Kenneth M. Schor

Senior Legal Advisor
Office of Patent Legal Administration

June 23, 2010
Kenpet8/IP/RCR
Kenappeal/decisions/entry issues

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,712	09/10/2005	6703355	1001.076	5664

27810 7590 02/16/2006

EXXONMOBIL RESEARCH AND ENGINEERING COMPANY
P.O. BOX 900
1545 ROUTE 22 EAST
ANNANDALE, NJ 08801-0900

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
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Mailed :

DDJ

Mark D. Marin
For : ExxonMobile Research and
Engineering Company
P.O.Box 900
1545 Route 22 East
Annandale NJ 08801-0900

(for Patent Owner)

MAILED
FEB 16 2006
REEXAM UNIT

Andrew Brenc
Brenc Law
47 Banks Road
Simsbury Connecticut 06070-2324

(for Third Party Requester)

In re Antika et al
Reexamination Proceeding
Control No.: 90/007,158
Filed: August 05, 2004
For: U.S. Patent 6,703,355

DECISION MERGING
REEXAMINATION
PROCEEDINGS

In re Antika et al
Reexamination Proceeding
Control No.: 90/007,712
Filed: August 05, 2004
For: U.S. Patent 6,703,355

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 6,703,355, issued March 9, 2004, is the subject of Reexamination Control Nos. 90/007,158 and 90/007,712.

2. A first request for reexamination, assigned Reexamination Control No. 90/007,158, was filed August 8, 2004 by Andrew Brenc of Brenc Law in Fairfax, VA. The request urged that a substantial new question of patentability was raised by the teachings of (a) the art of record and (b) the art of record in combination with the document entitled Instruction Manual – 5.5 HP Honda Gas Power Unit.

3. Reexamination was ordered for 90/007,158 on October 13, 2004.

4. A first Office action for 90/007,158 was mailed June 27, 2005.

5. Patent owner response to the first Office action was received August 25, 2005.

6. A second request for re-examination, assigned Reexamination Control No. 90,007,712, was filed September 10, 2005 by Andrew Brenc of Brenc Law, Simsbury CT. The request urged that a substantial new question of patentability was raised by (a) USPN 2,707,176 to Gramrath et al in view of USPN 5,464,551 to Deetman or (b) USPN 2,707,176 to Gramrath et al in view of USPN 5464,551 to Deetman and a document entitled Phosphate Ester Hydraulic Fluid Performance at High Pressure by T. Wolfe.

7. Reexamination was ordered for 90/007,712 on October 13, 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 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 90/007,158 and 90/007,712 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 all files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, **filed in duplicate**, each bearing a signature and identifying data for **all** files, for entry into each file.

All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control Nos. 90/007,158 and 90/007,712 as:

Reexamination Control Ns. 90/007,158 and 90/007,712

Mark D. Marin
ExxonMobile Research and Engineering Company
P.O.Box 900
1545 Route 22 East
Annandale, NJ 08801-0900

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control No. 90/007,712 as:

Andrew Brenc
Brenc Law
47 Banks Road
Simsbury, CT 06070-2324

CONCLUSION

Reexamination Control Nos. 90/007,158 and 90/007,712 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 Deborah Jones

Lissi M. Marquis, Director
Central Reexamination Unit

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EXXONMOBIL RESEARCH & ENGINEERING COMPANY (For Patent Owner)
P.O. BOX 900
1545 ROUTE 22 EAST
ANNANDALE NJ 08801-0900

MR. ANDREW S. BRENC (For Third Party Requester)
BRENC LAW
P.O. BOX 155
ALBION, PA 16401

MAILED

FEB 22 2007

CENTRAL REEXAMINATION UNIT

In re Reexamination Proceeding :
S. Antica et al. :
Control No. 90/007,158 :
Filed: August 5, 2004 :
U.S. Patent No. 6,703,355 :
Attorney Docket No. P2000J070 US3 :

In re Reexamination Proceeding :
S. Antica et al. :
Control No. 90/007,712 ✓ : DECISION GRANTING PETITION
Filed: September 10, 2005 :
U.S. Patent No. 6,703,355 :
Attorney Docket No. P2000J070 US3 :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on January 8, 2007, for entry of late papers based upon unintentional delay.

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

37 CFR 1.137(b) states:

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

The present petition under 37 CFR 1.137(b) includes, inter alia, the requisite response (item 1), 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.

$1,500.00 has been charged to counsel's deposit account no. 05-1330 in accordance with the present petition.

Jurisdiction over the reexamination proceeding is being returned to Central Reexamination Unit (CRU) Art Unit 3991 for further examination and consideration of the response filed January 8, 2007, along with the present petition, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Jerry D. Johnson in CRU Art Unit 3991, who can be reached at 571-272-1448.

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

Fred A. Silverberg

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

Kenneth M. Schor

Conferee: Kenneth M. Schor, Senior Legal Advisor

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,713	09/07/2005	5966680	ADV1001USRE	7809

58417 7590 12/23/2009

HEINZ GRETHER PC
G2 Technology Law
P.O. Box 202858
AUSTIN, TX 78720

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/23/2009

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

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HEINZ GRETHER PC
G2 Technology Law
P.O. Box 202858
AUSTIN TX 78720

(For Patent Owner)

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DEC 23 2009

CENTRAL REEXAMINATION UNIT

In re: Butnaru
Ex Parte Reexamination Proceeding
Control No. 90/007,713
Deposited: 07 September 2005
For: US Patent No. 5,966,680

DECISION
GRANTED
PETITION FOR EXTENSION
OF TIME
[37 CFR §§ 1.550(c) & 1.181]

This is a decision on the 15 December 2009, "Request for Extension of Time Under 37 CFR § 1.550(c)" requesting that the time for responding to the non-final Office action mailed 29 October 2009, be further extended by one (1) month extension of time. The petition was timely filed on 15 December 2009. The petition included the required petition fee pursuant to 37 CFR § 1.17(g).

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

The petition is GRANTED for the reasons set forth below.

DISCUSSION

The Patent Owner requests the period of time to be extended in which to file a response to the non-final Office action mailed 29 October 2009. The petition for extension of time was timely filed on 15 December 2009 with appropriate fee according to 37 CFR § 1.17(g).

The extension of time is granted.

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. ...

MPEP 2265 (in-part)

> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
>
> ...

ANALYSIS AND FINDINGS

The patent owner petitions to extend the period for response by adding one (1) month to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The petitioner has demonstrated "sufficient cause" for granting the extension of time. The petition cites the death of the inventor as well as the great length of the Office action. On balance there is "sufficient cause" for granting the extension of time.

The petition request to extend the response time is hereby granted.

CONCLUSION

1. The patent owner's petition for extension of time is hereby **granted.**

2. The time for response is further extended by one (1) month.

3. The Patent Owner's response is due **29 January 2010.**

4. Response and/or submissions to the Office should be addressed 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

By EFS: Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

5. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, in the event that Mark Reinhart is unavailable Eric Keasel at (571) 272-4929, or Jessica Harrison at (571) 272-4449; all are Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992 may also be contacted..

/Mark Reinhart/

Mark Reinhart,
Supervisory Patent Examiner,
AU 3992,
Central Reexamination Unit
571-272-1611

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.
90/007,713	09/07/2005	5966680	ADV1001USRE	7809

58417 7590 01/27/2010

HEINZ GRETHER PC
G2 Technology Law
P.O. Box 202858
AUSTIN, TX 78720

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/27/2010

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JAN 27 2010

CENTRAL REEXAMINATION UNIT

HEINZ GRETHER PC G2 Technology Law P.O. Box 202858 AUSTIN TX 78720	:	(For Patent Owner)

In re: Butnaru *Ex Parte* Reexamination Proceeding Control No. 90/007,713 Deposited: 07 September 2005 For: US Patent No. 5,966,680	:	DECISION DISMISSED PETITION FOR EXTENSION OF TIME [37 CFR §§ 1.550(c) & 1.181]

This is a decision on the 26 January 2010, "Request for Extension of Time Under 37 CFR § 1.550(c)" requesting that the time for responding to the non-final Office action mailed 29 October 2009, be further extended by one (1) month extension of time. The petition was timely filed on 26 January 2010. The petition included the required petition fee pursuant to 37 CFR § 1.17(g).

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

The petition is dismissed for the reasons set forth below.

DISCUSSION

The Patent Owner requests the period of time to be extended in which to file a response to the non-final Office action mailed 29 October 2009. The petition for extension of time was timely filed on 26 January 2010 with appropriate fee according to 37 CFR § 1.17(g).

The extension of time is DISMISSED.

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. ...

MPEP § 2265 Extension of Time (in-part)

> ...
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period. All requests must be submitted in a separate paper which will be forwarded to the CRU or TC Director for action. A request for an extension of the time period to file a

petition from the denial of a request for reexamination can only be entertained by filing a petition under 37 CFR 1.183 with appropriate fee to waive the time provisions of 37 CFR 1.515(c). Since the reexamination examination process (for a reexamination request filed under 35 U.S.C. 302 and 37 CFR 1.510) is intended to be essentially ex parte, the party requesting reexamination can anticipate that requests for an extension of time to file a petition under 37 CFR 1.515(c) will be granted only in extraordinary situations.

...

Ex parte prosecution will be conducted by initially setting either a 1-month or a 2-month shortened period for response, see MPEP § 2263. The patent owner also will be given a 2-month period after the order for reexamination to file a statement >(by statute (35 U.S.C. § 304), this period cannot be less than 2-months, even in a proceeding where the patent is being litigated). See 37 CFR § 1.530(b). First requests for extensions of these statutory time periods will be granted for sufficient cause, and for a reasonable time specified — usually 1 month. The reasons stated in the request will be evaluated by the CRU or 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. Second or subsequent requests for extensions of time or requests for more than 1 month will be granted only in extraordinary situations.

...

ANALYSIS AND FINDINGS

The patent owner petitions to extend the period for response by adding one (1) month to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The petitioner has demonstrated "sufficient cause" for granting the extension of time. The petitioner notes the length of the action and the death of the inventor. These were the reasons given in the first request for extension of time. The petitioner further articulates health issues of relatives. While this is regrettable, the petitioner has already been granted a first extension of time. Second or subsequent requests for extensions of time or requests for more than 1 month will be granted only in extraordinary situations. The engagement of experts is useful but there is no explanation as to how in spite of the action taken thus far that there is an unexpected need which would rise to the level of extraordinary circumstances. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those

responsible for preparing a response to the outstanding Office action within the statutory time period. On balance there is not "sufficient cause" for granting the extension of time.

The petition request to extend the response time is hereby dismissed.

CONCLUSION

1. The patent owner's petition for extension of time is hereby **dismissed.**

2. The Patent Owner's response is due **29 January 2010.**

3. Response and/or submissions to the Office should be addressed 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

By EFS: Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

4. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, in the event that Mark Reinhart is unavailable Eric Keasel at (571) 272-4929, or Jessica Harrison at (571) 272-4449; all are Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992 may also be contacted..

/Mark Reinhart/

Mark Reinhart,
Supervisory Patent Examiner,
AU 3992,
Central Reexamination Unit
571-272-1611

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CENTRAL REEXAMINATION UNIT

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 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. 90/007,714 Filed: September 9, 2005 For: US Patent No. 5,047,690	:	

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 21, 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 21, 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 21, 2007 is **granted**.

2. The Patent Owner's response is due **August 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, 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

mar

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

PAUL N. WARE c/o Ware Enterprises, Inc 1090 Barker Road S W Rome, GA 30165	:	For Patent Owner
DAVID D. ZURILLA, ESQ. Schwegman, Lundberg Waessner & Kluth 1600 TCE Tower 121 South Eighth Street Minnneapolis, MN 55402	:	For Requester
LITMAN LAW OFFICES, LTD P. O. Box 15035 Crystal City Station Arlington, VA 22215	:	For Requester

In re: Paul N. Ware
Ex Parte Reexamination Proceeding
Control No. 90/007,543
Filed: May 16, 2005
For: US Patent No. 4,707,592

In re: Paul N. Ware
Ex Parte Reexamination Proceeding
Control No. 90/007,716
Filed: September 13, 2005
For: US Patent No. 4,707,592

MAILED
JAN 30 2006
REEXAM UNIT

DECISION MERGING
REEXAMINATION
PROCEEDINGS

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

BACKGROUND

1. Patent No. 4,707,592 issued on November 17, 1987.

2. *Ex Parte* Reexamination Proceeding, control no. 90/007,543 was requested by a third party requester filed on May 16, 2005.

3. The Reexamination Order was granted in proceeding, control no. 90/007,543 on August 1, 2005.

4. *Ex Parte* Reexamination Proceeding, control no. 90/007,716 was requested by a third party requester filed on September 13, 2005.

5. The Reexamination Order was granted in proceeding, control no. 90/007,716 on October 31, 2005.

6. Both proceedings await first Office actions on the merits by the examiner assigned the case.

7. There are currently no amendments in either proceeding.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

As noted 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 90/007,543 and 90/007,716 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. 90/007,543 and 90/007,716 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

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

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.

Copied from 90007455 on 11/08/2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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)).

Copied from 90007455 on 11/08/2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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).

Copied from 90007455 on 11/08/2006

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.

Copied from 90007455 on 11/08/2006

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

Copied from 90007455 on 11/08/2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

(For Patent Owner)

MAILED

AUG 23 2006

CENTRAL REEXAMINATION UNIT

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

(For Third Party Requester)

In re Campana, Jr. et al	:
Ex Parte Reexamination Proceeding	: **DECISION, *SUA SPONTE*,**
Control No.: 90/007,723	: **DISMISSING PETITION**
Filed: September 16, 2005	: **AND "RETURNING"**
For: U.S. Patent No. 5,625,670	: **IMPROPER PAPERS**
	:

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

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

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

REVIEW OF SALIENT FACTS

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

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

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

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

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

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

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

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

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

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

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

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

13. No initial Office action on the merits of the patentability of the '670 patent claims has been promulgated in the '723 reexamination proceeding.

14. There having been no initial Office action on the merits of the patentability of the '670 patent claims, patent owner could not, and did not, file a response to an Office action on the merits of the patentability of the '670 patent claims.

15. Notwithstanding Facts 9, 13 and 14, on April 28, 2006, patent owner filed a paper styled "Supplemental Amendment/Response to Office Action of December 14, 2005", which in fact responded to an initial Office action promulgated in the merged reexamination proceeding. This response included a traverse of the nonfinal rejection, copies of material obtained as a result of the FOIA request, and a number of statements in support of patent owner's traverse.

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

---

[2] The present petition is directed to all three *ex parte* reexamination proceedings for the '670 patent. However, the May 26, 2004 Technology Center Director decision merged only the '491 and '678 reexamination proceedings. The facts set forth in the present petition appear to be applicable only to that merged proceeding, but are not entirely applicable to the 90/007,723 reexamination proceeding. Therefore, a separate decision directed to the merged '491/'678 reexamination proceeding has been prepared. However, insofar as the present patent owner petition is directed to the 90/007,723 proceeding, the petition is being treated in the instant decision in order to facilitate prosecution of the 90/007,723 proceeding with "special dispatch" in accordance with 35 U.S.C. § 305

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

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

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

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

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

37 CFR 1.550(b) provides:

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

The '723 reexamination proceeding has not been merged with the merged reexamination proceeding that includes the '491 and '678 *ex parte* reexamination proceedings. No action on the merits of the patentability of the '670 patent claims has been promulgated in the presently separate '723 reexamination proceeding. The rules do not provide for the filing of a response to an action on the merits of the patentability of patent claims that are the subject of an *ex parte* reexamination proceeding unless there has been an Office action on the merits of the patentability of the patent claims. Inasmuch as the Image File Wrapper (IFW) record of the '723 reexamination proceeding does not contain include an action on the merits of the patentability of the '670 patent claims, a response or supplemental response to such action is not presently necessary, and is not permitted by the rules. Therefore, the paper filed on April 28, 2006, purportedly a supplemental response to the Office action of December 16, 2005, was clearly an improper paper. As such, the papers lacked an entry right and were properly excluded from the IFW record and returned to patent owner.

In addition, the redacted version of the April 28, 2006 "supplemental response" filed on May 22, 2005 is also an improper paper in the present '723 reexamination proceeding because this paper is also directed to an Office action on the merits of the patentability of the '670 patent claims that is not part of the record in the '723 reexamination proceeding. Therefore, the May 22, 2005 paper also lacks and entry right. However, the May 22, 2005 paper has already been scanned into the IFW file of the '723 reexamination proceeding and cannot be physically removed. Therefore, the paper will be "returned" to patent owner by being marked as "closed" and "non-public" in the IFW of the '723 reexamination proceeding.

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

Further, the patent owner has attached to the present petition the material that was refused entry and returned (by the CRU Director's May 17, 2006 decision), for entry into the record as part of patent owner's response to the December 14, 2005 Office action. These papers are improper papers because they purport to be a response to an Office action that is not of record in the '723 reexamination proceeding. As such, these papers lack an entry right in the '723 reexamination proceeding to which they are directed. As the June 23, 2006 papers are determined to lack an entry right in the present merged reexamination proceeding, they will be returned in accordance with provisions of MPEP § 2267. In this instance it would be unduly burdensome to either physically return the large bulk of papers, or expend significant Office resources scanning the documents into the record and then closing them from view. [5] Therefore, the papers are being temporarily held for "pick up" in the Central Reexamination Unit (CRU). If the patent owner desires the physical return of the papers, then patent owner should promptly make arrangements to pick up the papers from the CRU **within one month** of the mailing date of this decision. Patent owner should immediately notify Norma Amador of the CRU, at telephone number (571) 272-6474, of any arrangements that have been made to pick up the papers. If the papers are **not** picked up **within one month** of the mailing date of this decision, **the CRU will dispose of the papers**, note being taken that the patent owner presumably has the originals.

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

ADDITIONAL DISCUSSION IN THE INTEREST OF 35 U.S.C. § 303 SPECIAL DISPATCH

Patent owner's attention is directed to the decision on the June 23, 2006 petition for the merged reexamination proceeding involving the '491 and '678 *ex parte* reexamination proceedings. In particular, note the complete discussion therein as to why the present petition will be retained in the record only as a "non-public" document. Patent owner may expect that in the event that the '723 reexamination proceeding is merged with that merged proceeding, and patent owner therefore files papers to make the records in all three of the merged *ex parte* reexamination proceedings identical, that any petition directed to a "response" to the December 15, 2005 nonfinal action will be treated in the same manner as it was treated in the petition decision directed to the merged reexamination proceeding. In the event that the '723 reexamination proceeding is merged with the existing merged reexamination proceeding, then the May 22, 2006 patent owner "supplemental response" papers will be "reopened" and marked "public" so that patent owner will not have to again file the May 22, 2006 patent owner papers in order to make the records in the three reexamination proceedings identical.

CONCLUSION

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

2. The April 28, 2006 "supplemental response" is an improper paper that lacks an entry right. This paper has returned to patent owner and **will form no part of the official record of the present merged reexamination proceeding.**

3. The May 22, 2006 papers that are a redacted version of the April 28, 2006 papers are improper papers because they purport to be a "supplemental response" to an Office action

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

that does not exist in the record of the '723 reexamination proceeding. These papers will be "returned" to patent owner by being marked "closed" and "non-public" in the IFW record.

4. The papers attached to the present petition are also improper papers because they too purport to be a "supplemental response" to an Office action that does not exist in the record of the '723 reexamination proceeding. These papers will be returned to patent owner in the manner discussed in the first paragraph of page 4, *supra*.

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

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

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

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

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

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

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

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

sm
August 9, 2006

8/16/06
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,723	09/16/2005	5625670	6082.003	5019

803 7590 02/24/2007

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/24/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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2/26/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007723
PATENT NO. 5,625,670
ART UNI 3992

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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(For Patent Owner)

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

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

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

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

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

STATEMENT OF FACTS

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

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

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

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

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

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

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

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

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

As noted in the above noted facts, reexamination has been ordered in both of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is appropriate.

DECISION

In accordance with 37 C.F.R. § 1.565(c), the 90/006,491; 90/006,678 and 90007,723 reexamination proceedings are merged.

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

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

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

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the 90/006,491; 90/006,678 and 90/007,723 reexamination proceedings are **merged**. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in Both Proceedings

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

III. Conduct of Merged Proceeding.

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

CONCLUSION

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

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

3. All correspondence regarding these proceedings should be submitted as follows:

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

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

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

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

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

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(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

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

(For Third Party Requester)

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

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

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

DECISION DENYING PETITION

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

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

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

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

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

REVIEW OF SALIENT FACTS

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

DECISION

I. Relevant Statutes, Regulations and Practice

35 U.S.C. § 132 provides:

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

[5] The paper was mailed in the '491-'678 merged reexamination proceeding and separately mailed in the '723 *ex parte* reexamination proceeding.
[6] See discussion at pages 5-7, *infra*.
[7] No such pick up was scheduled, and none was made.

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

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

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

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

35 U.S.C. § 302 provides in pertinent part:

"Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title."

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

"Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications."

35 U.S.C. § 305 provides, in pertinent part:

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

35 U.S.C. § 306 provides:

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

37 CFR 1.3 provides:

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

37 CFR 1.4(c) provides:

"Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects."

37 CFR 1.111(b) provides:

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

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

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

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

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

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

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

MPEP § 2267 provides in pertinent part:

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

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

II. Basis For The August 23, 2006 Decision

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

A. Patent Owner's Position Is Fundamentally Flawed

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

CONCLUSION

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

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

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

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

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

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

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February 22, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

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MAILED
MAY 23 2006
REEXAM UNIT

Walter E. Hanley, Jr. (For Requester)
Kenyon & Kenyon LLP
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In re Tang et al
Reexamination Proceeding
Control No. 90/007,724
Filed: September 16, 2005
For: U.S. Patent No. 6,528,784

DECISION DISMISSING AND RETURNING PETITION

This is a decision on the May 02, 2006 third party requester petition under 37 CFR 1.182 entitled "PETITION BY REQUESTER TO MERGE REEXAMINATION PROCEEDING OF U.S. PATENT NO. 6,528,784 WITH CO-PENDING REISSUE PROCEEDING."

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

The petition is dismissed and returned an improper paper.

REVIEW OF FACTS

1. U.S. patent No. 6,528,784 issued on March 4, 2003, with 9 claims.

2. An application for reissue, assigned application No. 11/073,394, was filed by the patent owner on March 4, 2005.

3. The filing of the '394 reissue application was announced in the *Official Gazette* on May 31, 2005.

4. A request for reexamination was filed by a third party requester on September 16, 2005, and was assigned control No. 90/007,724 (the '724 proceeding) .

5. Reexamination was ordered for the '784 proceeding on November 4, 2005.

6. A communication was filed by the patent owner on December 9, 2005 that states that a Patent Owner's Statement will not be filed. A concurrently filed statement under 1.565 was included to inform the Examiner of the pending reissue application and litigation.

7. A patent owner's statement under 37 CFR 1.530 has not been received in the '784 proceeding, and the time for filing same has expired.

8. The present petition was filed on May 02, 2006 under 37 CFR 1.182, with service on the patent owner.

DECISION

37 CFR 1.535 provides as to third party requesters:

"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 provides as to third parties in general:

"(g) ...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)."

As noted, *supra*, the request for reexamination of the '784 patent was filed on September 16, 2005, and reexamination was ordered in the resulting '724 reexamination proceeding on November 4, 2005. The record shows that, prior to third party requester's filing of the present petition on May 02, 2006, patent owner had not filed a patent owner's statement pursuant to 37 CFR 1.530. Thus, the third party requester was not entitled to file a reply, or any other submission at the time the petition was filed. In addition, the two month period of time set in the Order Granting *Ex Parte* Reexamination in which the patent owner was permitted to file a patent owner's statement has now expired, and no patent owner statement has been filed in the '724 reexamination proceeding. Thus, 37 CFR 1.535 prohibits the consideration of the present third party requester submission. In addition, the present petition is not a request for reexamination in compliance with the requirements of 37 CFR 1.510, it is not a reply to a patent owner's statement pursuant to 37 CFR 1.535, and it does not qualify as a prior art citation under 37 CFR

1.501. Thus, 37 CFR 1.550 prohibits the consideration of the present third party requester submission 1.

Accordingly, the present petition does not have an entry right under the rules. The third party requester has not requested the waiver of any regulation precluding entry of the present petition, nor is any basis for same found to be present. Therefore, the present petition is being returned to the third party requester without consideration. The present petition *will not* be decided on the merits.

CONCLUSION

1. The third party requester petition filed February 17, 2006 is dismissed as not having an entry right.

2. The petition paper is being returned to the third party requester with this decision.

3. No copy of the petition papers will be maintained in the electronic Image File Wrapper, or elsewhere in the Office.

4. A copy of this decision will be made of record in the reexamination file.

5. Telephone inquiries related to the present decision should be directed to Karen Hastings, Legal Advisor, at 571-272-7717, or, in her absence, to the undersigned at 571-272-7710.

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

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May 23, 2006

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(For Patent Owner)

MAILED

MAY 23 2006

REEXAM UNIT

Walter E. Hanley, Jr.
Kenyon & Kenyon LLP
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(For Requester)

In re Reissue Application of
Tang et al
Application No. 11/073,394
Filed: March 4, 2005
For: U.S. Patent No. 6,528,784

In re Tang et al
Reexamination Proceeding
Control No. 90/007,724
Filed: September 16, 2005
For: U.S. Patent No. 6,528,784

DECISION, *SUA SPONTE*, TO MERGE REISSUE AND REEXAMINATION PROCEEDINGS

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

REVIEW OF FACTS

1. U.S. patent No. 6,528,784 (the '784 patent) issued on March 4, 2003, with 9 claims.

2. An application for reissue, assigned application No. 11/073,394 (the '394 application), was filed by the patent owner on March 4, 2005.

3. The filing of the '394 reissue application was announced in the *Official Gazette* on May 31, 2005.

4. A request for reexamination was filed by a third party requester on September 16, 2005, and was assigned control No. 90/007,724 (the '724 proceeding).

5. Reexamination was ordered for the '724 proceeding on November 4, 2005.

6. A communication was filed by the patent owner on December 9, 2005 that states that a Patent Owner's Statement will not be filed. A concurrently filed statement under 37 CFR 1.565 was included to inform the Examiner of the pending reissue application and litigation.

7. A patent owner's statement under 37 CFR 1.530 has not been received in the '784 proceeding, and the time for filing same has expired.

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. 11/073,394 and reexamination control No. 90/007,724 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. 90/007,724 shows the presence of the following live claims: original patent claims 1-9.

   A review of reissue application No. 11/073,394 shows:

   (a) original patent claims 1-9 are present;

   (b) new claims 10-42 have been added.

   Accordingly, the claims are not identical in both proceedings.

   An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both proceedings, specifically, Application No. 11/073,394 and Control Number 90/007,724. The response to this requirement must be limited to formally placing the same amendments in all cases, and patent owner must **not** address any issue of patentability in the housekeeping amendment. It is to be noted that, pursuant to MPEP 2285, amendments in a merged proceeding are submitted under 37 CFR 1.173, in accordance with reissue practice.

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

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

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

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

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

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

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

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

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

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

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

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

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

10. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be dissolved. The reissue application will be held abandoned. The reexamination prosecution

will be terminated, and a reexamination certificate under 37 CFR 1.570 will be issued in accordance with the last action of the Office, unless further action in the reexamination proceeding is needed as a result of the difference in the rules relating to reexamination and reissue proceedings. If further action in the reexamination proceeding is needed, any grounds of rejection 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, 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. 11/073,394 and reexamination control No. 90/007,724 **<u>are merged</u>** into a single proceeding.

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

3. Jurisdiction over the merged reissue and reexamination proceeding is being transferred to Technology Center 2800 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 '784 patent (e.g., by preparing/signing an action), or was so involved in the examination of the parent of the '784 patent. See MPEP 2236.

4. The examiner should not issue an Office action for the present merged proceeding until after the expiration of the ONE (1) MONTH period (from the mailing of this

decision) for filing the amendment.

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

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

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

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22 May 2006

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(For Third Party Requester)

In re Thomas J. Campana, Jr. *et al*
Reexamination Proceeding
Control No. 90/006,494
Filed: December 26, 2002
For U.S. Patent No.6,067,451

In re Thomas J. Campana, Jr. *et al*
Reexamination Proceeding
Control No. 90/006,681
Filed: June 24, 2003
For U.S. Patent No. 6,067,451

In re Thomas J. Campana, Jr. *et al*
Reexamination Proceeding
Control No. 90/007,726
Filed: September 22, 2005
For U.S. Patent No. 6,067,451

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

The above-identified reexamination files are before the Director of the Central Reexam Unit 3999, for consideration of merger of reexamination control number 90/007,726 (the '726 proceeding) with the previously merged reexamination control numbers 90/006,494 (the '494 proceeding) and 90/006,681 (the '681 proceeding) pursuant to 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 6,067,451 issued on May 23, 2000.

2. The '494 reexamination proceeding is a Director Ordered reexamination proceeding that was ordered on December 26, 2002.

3. The '681 reexamination proceeding, filed on June 24, 2003, is a reexamination proceeding that was requested by a third party requester.

4. An order granting reexamination in the '681 reexamination proceeding was mailed on September 3, 2003.

5. The '494 and '681 proceedings were merged to provide a single consolidated proceeding on May 26, 2004

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

7. A response to the June 21, 2005, Office action was timely filed on August 22, 2005. The response added claims 342 to 392 to the merged proceedings. However, the amendment was canceled following notification of fee deficiency in the Interview Summary mailed on November 18, 2005.

8. An amendment with proper fee was filed on November 25, 2005 in the '494 and '681 reexamination proceedings. The amendment canceled claims 342 to 392 and added claims 393 to 418.

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

10. An amendment was filed on January 30, 2005 in the '494 and '681 reexamination proceedings. The amendment added claims 419 to 437.

11. The '726 proceeding was filed on September 22, 2005 by a third party requester.

12. The third party requester's correspondence address is the same in the '681 and '726 proceedings.

13. An order granting reexamination in the '726 reexamination proceeding was mailed on September 30, 2005.

14. There are no amendments to the '726 reexamination proceeding.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

As noted , *supra*, reexamination was previously ordered in the '494 and '681 reexamination proceedings, and these proceedings have previously been merged. Reexamination has been ordered in the '726 proceeding.

As noted in the above noted facts, reexamination has been ordered in both of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is appropriate.

DECISION

In accordance with 37 C.F.R. § 1.565(c), the 90/006,494, 90/006,681 and 90/007,723 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

I. Requirements for Same Amendments in Both Proceedings

As noted above, the claims and specification have been amended in the '6,494 and '6,681 reexamination proceeding. Patent owner is required to maintain the same claims and specification in all merged files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in both files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

II. Conduct of Merged Proceeding.

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

CONCLUSION

Reexamination Control Nos. 90/006,494, 90/006,681 and 90/007,723 are merged. Patent owner has **one month** from the date of this decision to submit an appropriate "housekeeping" amendment. Upon receipt of the "housekeeping" amendment, an Office action will be issued in due course.

All correspondence regarding these proceedings should be submitted as follows:

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

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

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

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

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

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206 Sixth Avenue
Des Moines, IA 50309-4076

(For Patent Owner)

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

(For Third Party Requester)

MAILED

AUG 23 2006

CENTRAL REEXAMINATION UNIT

In re Campana, Jr. et al
Ex Parte Reexamination Proceeding
Control No.: 90/006,494
Filed: December 26, 2002
For: U.S. Patent No. 6,067,451

In re Campana, Jr. et al
Ex Parte Reexamination Proceeding
Control No. : 90/006,681
Filed: June 24, 2003
For: U.S. Patent No. 6,067,451

In re Campana, Jr. et al
Ex Parte Reexamination Proceeding
Control No.: 90/007,726
Filed: September 22, 2005
For: U.S. Patent No. 6,067,451

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

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

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

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

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

REVIEW OF SALIENT FACTS

1. U.S Patent number 6,067,451 ("the '451 patent") issued to Campana *et al* on May 23, 2000 from an application filed on September 28, 1998.

2. On December 26, 2002, a Director Initiated Order for Reexamination of the '451 patent was mailed and assigned control number 90/006,494 ("the '494 reexamination proceeding").

3. On June 24, 2003, a request for ex *parte* reexamination of the '451 patent was filed by a third party requester, and assigned control number 90/006,681 ("the '681 reexamination proceeding").

5. On September 3, 2003, the examiner's Order Granting *Ex Parte* Reexamination for the '681 reexamination proceeding was mailed.

6. On May 26, 2004, the Technology Center Director issued a decision, *sua sponte,* by which the '494 reexamination proceeding and the '681 reexamination proceeding were merged into a single combined reexamination proceeding.

7. On September 22, 2005, a third request for *ex parte* reexamination of the '451 patent, which was assigned control number 90/007,726 ("the '726 reexamination proceeding").

8. On September 30, 2005, the examiner's Order Granting *Ex Parte* Reexamination for the '726 reexamination proceeding was mailed.

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

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

11. Following prosecution on the patentability of the '451 patent claims, a final rejection Office action was issued in the merged reexamination proceeding on February 22, 2006.

12. On March 1, 2006, the Central Reexamination Unit (CRU) Director issued a decision, *sua sponte,* by which the '494 reexamination proceeding, the '681 reexamination proceeding and the '726 reexamination proceeding were merged into a single merged reexamination proceeding. [3]

13. On April 24, 2006, patent owner filed both a notice of appeal and an information disclosure statement (IDS) in the single combined reexamination proceeding.

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

[3] Jurisdiction of the merged '494 and '681 reexamination proceedings had previously been transferred from the Technology Center to the CRU.

14. Also on April 24, 2006, patent owner filed a paper styled as a response to the final rejection, which included a traverse of the final rejection, copies of material obtained as a result of the FOIA request, and a number of statements in support of patent owner's traverse.

15. On May 17, 2006, the CRU Director mailed a decision returning the April 24, 2006 patent owner response to the final rejection noted in Fact 14 above without consideration on the merits. The return was based on the grounds that the papers filed were improper because they were not limited to consideration of prior patents and printed publications and also because portions were not in compliance with the 37 CFR 1.3 requirements for decorum and courtesy. Accordingly, the returned response was not entered into the record.

16. On May 22, 2006, patent owner filed a redacted version of the April 24, 2006 response, limited to material addressing the outstanding final rejection Office action, which has been entered into the IFW record.

17. On June 23, 2006, patent owner filed the present petition requesting reconsideration of the CRU Director's May 17, 2006 decision. Patent owner has attached to the petition the material that was refused entry and returned (by the CRU Director's May 17, 2006 decision), for entry into the record as part of patent owner's response to the February 22, 2006 final Office action.

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

I. Relevant Statutes, Regulations and Practice

35 U.S.C. § 132 provides:

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

35 U.S.C. § 134(b) provides:

> "A patent owner in any reexamination proceeding may appeal from the final rejection of any claim by the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal."

35 U.S.C. § 305 provides, in part:

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

35 U.S.C. § 306 provides:

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

37 CFR 1.3 provides:

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

37 CFR 1.4(c) provides:

"Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects."

37 CFR 1.113(a) provides, in part:

"On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon ... for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. **Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181).** ..." [Emphasis added.]

37 CFR 1.116(a)-(e) provide, in part:

"(a) An amendment after final action must comply with § 1.114 or this section.

(b) After a final rejection or other final action (§ 1.113) ... in an ex parte reexamination filed under § 1.510 ... but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):

(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;
(2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or
(3) An amendment touching the merits of the ... patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

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

(d) (1) ...
(2) Notwithstanding the provisions of paragraph (b) of this section, an amendment made after a final rejection or other final action (§ 1.113) in an ex parte reexamination filed under §1.510 ... may not

cancel claims where such cancellation affects the scope of any other pending claim in the reexamination proceeding except ... as permitted by § 41.77(b)(1) of this title.

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

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

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

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

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

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

MPEP § 2267 provides in part:

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

I. DISPOSITION OF PAPERS
Where papers are filed during reexamination proceedings which are inappropriate because of some defect, such papers will either be returned to the sender or forwarded to one of three files, the "Reexamination File" (paper file or IFW file history), the "Patent File" (paper file or IFW file history), or the "Storage File" (paper file). Any papers returned to the sender from a Technology Center (TC) must be accompanied by a letter indicating signature and approval of the TC Director." [4]

II. Findings and Analysis

On April 24, 2006, patent owner filed a response to the final action dated February 22, 2006. That paper was returned to patent owner by the decision of the CRU Director dated May 17, 2006, on the grounds that the response was an improper paper. The basis of this holding was that the response included statements and documents that were improper because they were not limited to consideration of prior patents and printed publications, and also because portions were not in compliance with 37 CFR 1.3 requirements for decorum and courtesy. Patent owner was invited, in the May 17, 2006 decision returning papers, to submit a redacted response, and patent owner has in fact filed a redacted version of that response (the redacted version has been entered into the record).

Patent owner has now attached to the present petition - a set of papers to be added to the record as a part of the response to the February 22, 2006 final action, which would be available for the examiner's consideration in evaluating the patent owner's response. Patent owner

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

requests by way of the present petition that these papers be entered into the IFW record to provide a complete administrative record. [5] It is patent owner's position that:

(1) There was no legal basis for the CRU Director's return of the April 24, 2006 response papers;

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

(3) The patent owner is entitled to argue and provide documents to allege that the February 22, 2006 final action is an improper action based on allegations of misconduct and bias.

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

It is also noted that patent owner argues that the CRU Director's decision returning the April 24, 2006 response to the final action dated February 22, 2006 was inconsistent with a prior petition decision dated March 20, 2006 denying a patent owner petition filed on January 23, 2006. [7] This argument will be separately addressed, *infra.*

A. The April 24, 2006 Response Was An Improper Paper, The Response Attached To The Present Petition Is An Improper Paper, And Both Papers Lack An Entry Right In The Merged Reexamination Proceeding

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

In the present instance, a review of the papers attached to the present petition indicates that (1) the papers are essentially the same as, if not identical to, the papers that were returned by the CRU Director's May 17, 2006 decision, and (2) these papers purport to be a response to the examiner's treatment of the pending claims in light of the prior art patents and publications applied to the claims by the examiner in the final action dated February 22, 2006. Pursuant to 37 CFR 1.550(a) (the rule that implements 35 U.S.C. § 305), *ex parte* reexamination proceeding is "conducted in accordance with [37 CFR] §§ 1.104 through 1.116." Therefore, the appropriate content of a 37 CFR 1.550(b) response to a final Office action in an *ex parte* reexamination proceeding is defined by 37 CFR 1.113(a) and 37 CFR 1.116. These regulations do not (contrary to petitioner's argument) provide for "further statements" that are unrestricted as to content. Instead, 37 CFR 1.113(a) and 37 CFR 1.116 require that a response to a final action address the issue of patentability of the pending claims with respect to the outstanding rejection, which, in this instance, is the examiner's treatment of the patentability of the claims in light of prior

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

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

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

this instance, is the examiner's treatment of the patentability of the claims in light of prior patents and printed publications. In contrast, the papers attached to the present petition include material directed to issues other than the examiner's treatment of the patentability of the claims in light of prior patents and printed publications. In fact, large portions of the remarks contained in the response to the final action [8] and documents cited in support are directed to the conduct of Office employees/officials. Thus, large portions of the papers attached to the present petition, are not directed to issues of patentability of the pending claims in light of the applied prior art patents and printed publications. Therefore, these papers clearly constitute responses to the outstanding final Office action that are not proper under 37 CFR 1.550(b) and do not fall within the jurisdiction of the examiner. Accordingly, each of these papers submitted in response to the Office action lacks an entry right in the present merged reexamination proceeding for consideration by the examiner.

Further, 37 CFR 1.3 expressly precludes "complaints against examiners and other employees" submitted as part of papers directed to other matters. Thus, the patent owner's submission of documents in support of its allegations of misconduct and bias could not properly be included with papers directed to the question of patentability in view of prior art, because the clear and unequivocal language of 37 CFR 1.3 expressly requires that "employee conduct" issues are to be raised in correspondence separate from other papers. Here, patent owner improperly raises allegations of employee misconduct incorporated within papers directed to the merits of the examiner's position on the patentability of the pending claims in light of patents and printed publications as set forth in the final Office action. Therefore, the originally filed April 24, 2006 response and the response attached to the present petition are both improper for the reason that they fail to comply with the requirements of 37 CFR 1.3. Accordingly, each paper further lacks an entry right in the present merged reexamination proceeding for consideration by the examiner.

Moreover, 37 CFR 1.4(c) requires that different matters in a given proceeding appropriate for consideration by different branches within the Office must be raised in separate papers. However, patent owner's April 24, 2006 response to the final action improperly presented, in the same paper, both:

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

(2) allegations of employee misconduct and bias.

The patentability arguments are properly considered by the examiner. In contrast, allegations of employee misconduct and bias are considered by way of a petition to the appropriate Office official for the exercise of supervisory authority pursuant to 37 CFR 1.181(a), because alleged employee misconduct and bias relate to non appealable subject matter. Thus both the originally filed April 24, 2006 response and the response attached to the present petition are improper for the additional reason that they fail to comply with the requirements of 37 CFR 1.4(c).

Therefore, for the foregoing reasons, the April 24, 2006 patent owner response, and the June 23, 2006 response attached to the present patent owner petition are deemed improper and therefore these papers lack an entry right in the present merged reexamination proceeding. The disposition of improper papers will be treated as discussed in Section C., *infra*.

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

B. Further Discussion

1. While the patent owner's April 24, 2006 response to the Feb 24, 2006 final action and the response to the final action attached to the present petition each lack an entry right for consideration by the examiner as explained in Section II(A), patent owner may raise the issue of alleged employee misconduct by way of petition under 37 CFR 1.181(a). Note is taken of patent owner's statement that on March 20, 2006, the Office issued a decision in a separate proceeding, such decision denying a patent owner petition filed on January 23, 2006. [9] Patent owner correctly states that the January 23, 2006 petition was denied because it did not provide sufficient details. However, if patent owner is able to now supply those details, they must be submitted in a separate petition under 37 CFR 1.181, but cannot be submitted as part of a paper submitted for consideration by the examiner.

2. Patent owner's characterization of the May 17, 2006 decision issued by the CRU Director returning the April 24, 2006 response to the final Office action of February 22, 2006 is not wholly accurate. In actuality, the CRU Director's May 17, 2006 decision did not mean to imply that the FOIA papers would be barred from submission for any and all purposes. Rather, it properly points out that the papers were returned because they raised issues unrelated to patentability and therefore are not appropriate for consideration by the examiner. Therefore, the submitted papers did not comply with the regulations and practice regarding the submission of response papers. [10]

3. To the extent that patent owner disagrees with some or all of the rationale set forth in support of the CRU Director's decision, Section II(A) of the present decision amplifies the reasons in support of the conclusion reached in the CRU Director's May 17, 2006 decision to refuse entry and return the April 24, 2006 response with attached papers. Section II(A) of the present decision explains that the patent owner may indeed raise alleged employee misconduct and bias issues, but must do so via a separate petition under 37 CFR 1.181. Such a petition must conform to the governing regulations and practice, i.e., the petition regarding alleged employee misconduct must not be attached to papers directed to the substantive issue of claim patentability in light of the prior patents and printed publication. See 37 CFR 1.3 and 37 CFR 1.4(c).

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

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[9] See footnote 7, *supra*.

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

C. Disposition Of Papers

1. In this instance: (1) the April 24, 2006 presentation of the FOIA papers, (2) the April 24, 2006 declaration of Keith Anderson directed the FOIA papers, and (3) the remarks directed to the conduct of Office employees/officials that were included within the April 24, 2006 response to the final action have previously been found to be improper, and lacking an entry right in the present merged proceeding. These papers were previously returned, and a redacted form of these papers was entered into the record, as discussed above.

2. In addition, the patent owner has attached to the present petition the material that was refused entry and returned (by the CRU Director's May 17, 2006 decision), for entry into the record as part of patent owner's response to the February 22, 2006 Office action. These papers have now been found to be improper and therefore lack an entry right in the present merged proceeding to which they are directed. As these papers are determined to lack an entry right in the present merged reexamination proceeding, they will be returned in accordance with provisions of MPEP § 2267. In this instance it would be unduly burdensome to either physically return the large bulk of papers, or expend significant Office resources scanning the documents into the record and then closing them from view. [11] Therefore, the papers are being temporarily held for "pick up" in the Central Reexamination Unit (CRU). If the patent owner desires the physical return of the papers, then patent owner should promptly make arrangements to pick up the papers from the CRU **within one month** of the mailing date of this decision. Patent owner should immediately notify Norma Amador of the CRU, at telephone number (571) 272-6474, of any arrangements that have been made to pick up the papers. If the papers are **not** picked up **within one month** of the mailing date of this decision, **the CRU will dispose of the papers**, note being taken that the patent owner presumably has the originals.

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

CONCLUSION

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

2. The (1) the April 24, 2006 presentation of the FOIA papers, (2) the April 24, 2006 declaration of Keith Anderson directed the FOIA papers, and (3) the remarks directed to the conduct of Office employees/officials that were included within the April 24, 2006 response to the final action have been found to be improper papers lacking an entry right in the present merged proceeding to which they are directed. These papers will be marked "closed" and "non-public" **will form no part of the official record of the present merged reexamination proceeding.**

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

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

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

5. A copy of this decision is being made of record in the merged reexamination proceeding, and the decision will therefore appear in the IFW record of *ex parte* reexamination proceedings 90/006,494, 90/006,681 and 90/007,726.

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

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

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

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

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

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

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July 31, 2006

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In re Campana, Jr. et al
Ex Parte Reexamination Proceeding
Control No.: 90/006,494
Filed: December 26, 2002
For: U.S. Patent No. 6,067,451

In re Campana, Jr. et al
Ex Parte Reexamination Proceeding
Control No.: 90/006,681
Filed: June 24, 2003
For: U.S. Patent No. 6,067,451

In re Campana, Jr. et al
Ex Parte Reexamination Proceeding
Control No.: 90/007,726
Filed: September 22, 2005
For: U.S. Patent No. 6,067,451

DECISION DENYING PETITION

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

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

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

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

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

REVIEW OF SALIENT FACTS

1. U.S Patent number 6,067,451 ("the '451 patent") issued to Campana *et al* on May 23, 2000, from an application filed on September 28, 1998.

2. On December 26, 2002, a Director Initiated Order for Reexamination of the '451 patent was mailed. The resulting *ex parte* reexamination proceeding was assigned control number 90/006,494 ("the '494 reexamination proceeding").

3. On June 24, 2003, a request for a second ex *parte* reexamination of the '451 patent was filed by a third party requester, and the resulting proceeding was assigned control number 90/006,681 ("the '681 reexamination proceeding").

4. On September 3, 2003, an examiner's Order Granting *Ex Parte* Reexamination was mailed for the '681 reexamination proceeding.

5. On May 26, 2004, the Technology Center Director issued a decision, *sua sponte*, by which the '494 reexamination proceeding and the '681 reexamination proceeding were merged into a single consolidated reexamination proceeding.

6. On September 22, 2005, a request for a third *ex parte* reexamination of the '451 patent was filed. The resulting proceeding was assigned control number 90/007,726 ("the '726 reexamination proceeding").

7. On September 30, 2005, the examiner's Order Granting *Ex Parte* Reexamination was mailed for the '726 reexamination proceeding.

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

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

10. Following prosecution on the patentability of the '451 claims, a final rejection Office action was issued in the '434 - '681 merged reexamination proceeding on February 22, 2006.

11. On March 1, 2006, the Central Reexamination Unit (CRU) Director issued a decision, *sua sponte*, by which the '494 reexamination proceeding, the '681 reexamination proceeding and the '726 reexamination proceeding were merged into a single consolidated reexamination proceeding. [5]

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

[5] Jurisdiction of the merged '494 and '681 reexamination proceedings had previously been transferred from the Technology Center to the CRU.

12. On April 24, 2006, patent owner filed both a notice of appeal and an information disclosure statement (IDS) in the single combined reexamination proceeding.

13. Also on April 24, 2006, patent owner filed a paper styled as a response to the final rejection, which included a traverse of the final rejection, copies of material obtained as a result of the FOIA request, and a number of statements in support of patent owner's traverse.

14. On May 17, 2006, the CRU Director mailed a decision returning the April 24, 2006 patent owner response to the final rejection without consideration on the merits. The return was grounded on the impropriety of the papers, because they were not limited to consideration of prior patents and printed publications, and also because portions of the submission were not in compliance with the requirements of 37 CFR 1.3. Accordingly, the returned response was not entered into the record.

15. On May 22, 2006, patent owner filed a redacted version of the April 24, 2006 response, which is limited to material addressing the outstanding final rejection Office action, and which has been entered into the IFW record for the merged proceeding.

16. On June 23, 2006, patent owner filed a petition requesting reconsideration of the CRU Director's May 17, 2006 decision. Patent owner attached to the petition the material that had been refused entry and returned (by the CRU Director's May 17, 2006 decision), and requested entry of that material into the record, as part of patent owner's response to the February 22, 2006 final Office action.

17. On August 23, 2006, the June 23, 2006 patent owner petition was dismissed, [6] and was "returned" to petitioner by permitting petitioner to schedule a time to pick up the material (together with similar material from other concurrently filed related petitions). [7]

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

DECISION

I. Relevant Statutes, Regulations and Practice

35 U.S.C. § 132 provides:

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

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

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

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

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

35 U.S.C. § 302 provides in pertinent part:

"Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title."

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

"Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications."

35 U.S.C. § 305 provides, in pertinent part:

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

35 U.S.C. § 306 provides:

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

37 CFR 1.3 provides:

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

37 CFR 1.4(c) provides:

"Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects."

37 CFR 1.113(a) provides, in part:

"On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon ... for *ex parte* reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. **Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181).** ..." [Emphasis added.]

37 CFR 1.116(a)-(e) provide, in part:

"(a) An amendment after final action must comply with § 1.114 or this section.

(b) After a final rejection or other final action (§ 1.113) ... in an *ex parte* reexamination filed under § 1.510 ... but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):

(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;
(2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or
(3) An amendment touching the merits of the ... patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

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

(d) (1) ...
(2) Notwithstanding the provisions of paragraph (b) of this section, an amendment made after a final rejection or other final action (§ 1.113) in an ex parte reexamination filed under §1.510 ... may not cancel claims where such cancellation affects the scope of any other pending claim in the reexamination proceeding except ... as permitted by § 41.77(b)(1) of this title.

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

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

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

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

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

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

MPEP § 2267 provides in pertinent part:

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

I. DISPOSITION OF PAPERS
Where papers are filed during reexamination proceedings which are inappropriate because of some defect, such papers will either be returned to the sender or forwarded to one of three files, the "Reexamination File" (paper file or IFW file history), the "Patent File" (paper file or IFW file history), or the "Storage File" (paper

file). Any papers returned to the sender from a Technology Center (TC) must be accompanied by a letter indicating signature and approval of the TC Director." [8]

II. Basis For The August 23, 2006 Decision

On April 24, 2006, patent owner filed a response to an outstanding Office action dated February 22, 2006. That paper was returned to patent owner without consideration on the merits as an inappropriate submission. [9] The paper was considered to be inappropriate by the Central Reexamination Unit Director, (1) because the paper was not limited to consideration of prior patents and printed publications, [10] and (2) because portions of that paper were not in compliance with the requirements of 37 CFR 1.3. On June 23, 2006, patent owner requested reconsideration of the return of those papers by way of a petition for reconsideration. Patent owner attached to that petition for reconsideration the material that had previously been refused entry. A decision issued August 23, 2006, setting forth in detail the basis for refusing the underlying relief requested in the June 23, 2006 request for reconsideration, and for again returning the material that was not proper for entry into the record of the present merged reexamination proceeding.

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

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

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

A. The April 24, 2006 Papers Did Not Comply With 37 CFR 1.113(a) and 37 CFR 1.116

The April 24, 2006 papers purported to be a response directed to the outstanding final Office action dated February 22, 2006. Pursuant to 37 CFR 1.550(a), the present merged reexamination proceeding is to be conducted in accordance with sections 1.104 through 1.116 of Title 37 of the Code of Federal Regulations. Those regulations implement the provisions of 35 U.S.C § 132. 37 CFR 1.113(a) and 37 CFR 1.116 specifically require that a response to a final Office action address issues of patentability of the pending claims that are subject to an outstanding final rejection. The April 24, 2006 papers did contain material directed to the issue of the patentability of the claims of the patents being reexamined that are required to be resolved by appeal to the Board. However, in direct contravention of 37 CFR 1.113(a), the April 24, 2006

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

papers also contained comments and documents that were not directed to the merits of the outstanding rejection (*i.e.*, not directed to appealable matters). These additional comments and documents were instead directed to matters of alleged misconduct on the part of Office employees/officials, and requested relief that is only available by way of petition to the USPTO Director, and not by an appeal to the Board.[11] Accordingly, the April 24, 2006 papers failed to comply with 37 CFR 1.113(a) and 37 CFR 1.116.

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

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

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

B. The April 24, 2006 Papers Did Not Comply With 37 CFR 1.3

37 CFR 1.3, last sentence, prohibits the submission of "complaints against examiners and other employees" of the Office as a part of papers directed to other matters before the Office. The "returned" April 24, 2006 papers included complaints regarding the conduct of Office employees, and these complaints were submitted as part of papers directed to other matters, *i.e.*, the issues of claim patentability in this merged proceeding. Accordingly, the April 24, 2006 papers are barred by 37 CFR 1.3.

C. The April 24, 2006 Papers Did Not Comply With 37 CFR 1.4(c)

37 CFR 1.4(c) requires that, within a given proceeding, material directed to matters that will be considered by different branches within the Office be raised in separate papers. Yet, the April 24, 2006 papers included complaints regarding conduct together with material directed to the issues of claim patentability, notwithstanding that these separate issues are decided by different branches of the Office and resolved by different appellate review tribunals: (1) decision on petition to the USPTO Director and (2) consideration by the Primary Examiner which may ultimately be reviewed by the Board. Accordingly, the April 24, 2006 papers are barred by 37 CFR 1.4(c).

[11] See, for example, the arguments at page 74-92 of the supplemental response filed April 24, 2006, that was to be disposed of if not "picked up" by the patent owner in accordance with the August 23, 2006 Decision on Petition. Note that even a single instance of an argument directed to matters that are not part of a proper response to a nonfinal action within the meaning of 37 CFR 1.111(b) would suffice to preclude entry of the entire supplemental response as lacking an entry right.

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

A. Patent Owner's Position Is Fundamentally Flawed

Petitioner patent owner argues that there has been improper conduct on the part of Office employees. [12] Patent owner apparently also believes that it has evidence of bias specifically on the part of one or more examiners, [13] and that this evidence, as previously submitted on April 24, 2006, should not be barred from examiner consideration because it bears on issues of patentability. Thus, petitioner patent owner urges that 37 CFR 1.3 should not preclude presentation to the examiner of the material alleging bias (even where bias alleged on the part of the examiner is alleged), because bias bears on patentability issues. Similarly, patent owner argues that 37 CFR 1.4(c) is inapplicable, because evidence of bias addresses the same patentability issues as the remainder of patent owner's substantive reply. [14]

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

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

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[12] See pages 3-4 of the present Petition for Reconsideration.
[13] See, for example, the headings on pages 4 and 7 of the present Petition for Reconsideration.
[14] See pages 7-9 of the present Petition for Reconsideration.
[15] Non-appealable subject matter reviewed by petition under 37 CFR 1.181 is subject to judicial review under the Administrative Procedures Act.

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

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

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

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

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

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

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

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

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

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

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

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

raised, "papers directed to the merits of claim patentability in any proceeding in which the misconduct is alleged to have occurred."

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

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

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

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

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

C. 37 CFR 1.113(a) and 37 CFR 1.116 Preclude The Relief Requested By Patent Owner

37 CFR 1.113(a) and 37 CFR 1.116 provide that a response to a final Office action must, *inter alia*, specifically point out supposed errors in the examiner's action, and point out the specific distinctions believed to render the claims patentable over the prior art. The regulation does not

provide for "further statements" that address matters other than the issues of patentability raised in the outstanding Office action. The failure of the April 24, 2006 patent owner submission to comply with 37 CFR 1.113(a) and 37 CFR 1.116 was discussed at pages 6-7 of the Decision Dismissing Petition dated August 23, 2006. It was pointed out that the April 24, 2006 patent owner submission was not confined to responding to the final Office action as required by 37 CFR 1.113(a), but instead intermingled matter directed to other issues (the issues of alleged misconduct on the part of Office personnel).

In the present petition patent owner has not directly addressed this point. To the extent that patent owner's general argument that the allegations of misconduct are in fact relevant to the issues of patentability, those arguments are wholly unpersuasive for the reasons set forth in Section III (A) above. Therefore, it is again concluded that the August 23, 2006 Decision Dismissing Petition properly refused entry of the April 24, 2006 patent owner as being non-compliant with 37 CFR 1.113(a) and 37 CFR 1.116.

CONCLUSION

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

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

3. A copy of this decision is being made of IFW record for the merged reexamination proceeding, and the decision will therefore appear in the IFW record of *ex parte* reexamination proceedings 90/006,494, 90/006,681 and 90/007,726.

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

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

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

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February 22, 2007

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte Campana et al.

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

Mailed: June 24, 2008

DECISION ON PETITION

This is a decision on the "Petition Under §41.3 for Consolidating Related Appeals for Hearing and Argument," filed March 19, 2008 ("Petition"). The Petition will be treated as a petition to the Chief Administrative Patent Judge under 37 C.F.R. § 41.3(b).

FINDINGS

1. The present appeal was docketed on December 31, 2007.

2. Appellants allege that they are parties to seven other related appeals including six additional patents involved ex parte reexamination proceedings and one additional patent involved in an inter partes reexamination proceeding. Petition at 2-3. Further, Appellants allege that all of these

appeals involve the same basic technical disclosure, common legal issues, and common technical issues. *Id.* at 3-6.

3. None of the seven additional appeals has yet been docketed by the Board of Patent Appeals and Interferences ("Board"). *Id.* at 3.

4. By the Petition, Appellants seek to consolidate the oral hearings in the eight related appeals, noting significant commonality in the effect on the appealed claims in the eight related patents of decisions on common key issues.

DISCUSSION

The Board agrees that consolidation of oral hearings may be proper in appropriate circumstances. Before an appeal can be scheduled for oral hearing, however, it must be docketed at the Board. Since only one of the eight appeals here involved has been docketed at the Board, it is premature to schedule a consolidated hearing for the seven undocketed appeals

DECISION

In view of the foregoing, the Petition is DISMISSED as premature, without prejudice to being renewed after all of the involved appeals have been docketed at the Board.

Michael R. Fleming
Chief Administrative Patent Judge

Appeal No. 2008-1116
Reexamination Control Nos. 90/006,494,
90/006,681 and 90/007,726
Patent No. 6,607,451

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Date :04/20/07

Patent No. : 4779635 C1
Ser. No. : 90/007,727
Inventor(s) : LYNCH, JAMES P.
Issued : 03/20/07
Title : **COLLAPSIBLE CANOPY WITH TELESCOPING ROOF SUPPORT STRUCTURE**
Docket No. : 1228

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(s) 1.322 and/or 1.323.

Assignees' names and addresses (assignment data) printed in a patent, are based *solely* on information supplied in the appropriate space for identifying the assignment data, i.e., item 3 of the Issue Fee Transmittal Form PTOL-85B. Granting of a request under 37 CFR 3.81(b) is required to correct applicant's error providing ***incorrect or erroneous*** assignment data, *before* issuance of a Certificate of Correction, under 37 CFR 1.323 *(see Manual of Patent Examining Procedures (M.P.E.P) Chp.1400, sect. 1481).* This procedure is required *at any time after the issue fee is paid*, including after issuance of the patent.

In view of the foregoing, your request, in this mater, is hereby denied.

A request to correct the Assignee under 37 CFR 3.81(b) should include:

A. **the processing fee set forth in 37 CFR 1.117(h) (currently $130);**
B. a statement that the failure to include the correct assignee name on the PTOL-85B was inadvertent; and
C. a copy of the Notice of Recordation of Assignment Document, reflecting the reel and frame number where the assignment(s) is recorded and/or reflecting proof of *the date* the assignment was submitted for recordation.

In the Request, Applicant(s) may request that the file be forwarded to Certificates of Correction Branch, for issuance of a Certificate of Correction, if the Request is granted.

Any request under 37 CFR 3.81(b) should be directed to the following address or facsimile number:

By mail: Mail Stop PETITIONS

Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: Customer Service Window
Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By fax: (703) 872-9306
ATTN: Office of Petitions

If a fee (currently $100) was previously submitted for consideration of a Request for Certificate of Correction, under CFR 1.323, to correct assignment data, , no additional fee is required.

Lamonte M. Newsome
For Cecelia Newman
Decisions & Certificates
of Correction Branch
(703) 308-9390 #112 or (703) 308-8309

TIMOTHY J. MARTIN
9250 W. 5TH AVENUE, SUITE 200
LAKEWOOD CO 80226

LMN

md

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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 A. Oliff (For Patent Owner)
Oliff & Berridge, PLC
P.O. Box 19928
Alexandria, VA 22320

Cheryl H. Agris, Ph.D., Esq. (For Requester)
P.O. Box 806
Pelham, NY 10803

MAILED
JUN 16 2006
REEXAM UNIT

In re Reissue Application of :
Sawai et al :
Application No. 11/337,223 :
Filed: January 23, 2006 :
For: U.S. Patent No. 6,020,945 :
: DECISION GRANTING
In re Sawai et al : PETITION TO MERGE
Reexamination Proceeding : REISSUE AND
Control No. 90/007,728 : REEXAMINATION
Filed: September 24, 2005 : PROCEEDINGS
For: U.S. Patent No. 6,020,945 :

This is a decision on the January 23, 2006 patent owner petition under 37 CFR 1.182, titled Petition To Merge Reissue Application With Ex Parte Reexamination Proceedings Under 37 CFR § 1.182.

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 fee of $400.00 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182 has been paid by patent owner's check no. 175552 included with the petition.

The petition is **GRANTED**.

REVIEW OF FACTS

1. U.S. patent No. 6,020,945 (the '945 patent) issued on February 1, 2000, with 13 claims.

2. A request for reexamination was filed by a third party requester on September 24, 2005, and was assigned control No. 90/007,728 (the '7728 proceeding).

3. Reexamination was ordered for the '7728 proceeding on November 21, 2005.

4. An application for reissue of the '945 patent, assigned application No. 11/337,223 (the '223 application), was filed by the patent owner on January 23, 2006.

5. The filing of the '223 reissue application was announced in the *Official Gazette* on March 14, 2006.

6. A patent owner's statement under 37 CFR 1.530 was not received in the '7728 proceeding, and the time for filing same has expired.

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. 11/337,223 and reexamination control No. 90/007,728 are currently pending. The order to reexamine has been mailed in the reexamination proceeding, and notice of the reissue application has been published in the *Official Gazette*. Accordingly, a decision under 37 CFR 1.565(d) is timely.

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

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

It is to be noted, however, that the grant of merger of a reissue application and an *ex parte* reexamination proceeding under 37 CFR 1.565(d) **is discretionary**. *The present merger is not an assurance that, in a future similar situation, 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 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. 90/007,728 shows the presence of the following:

   Original patent claims 1-13 are present as live claims.

   A review of reissue application No. 11/337,531 shows the following:

   (a) Original patent claims 1-6 have been deleted;
   (b) Original patent claims 7-13 remain as live claims; and
   (c) New claims 14-20 have been added.

   Accordingly, the claims are not identical in both proceedings.

   An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both cases, specifically, Application No. 11/337,223 and Control Number 90/007,728. The response to this requirement must be limited to formally placing the same amendments in all cases, and patent owner must **not** address any issue of patentability in the housekeeping amendment. It is to be noted that,

pursuant to MPEP 2285, amendments in a merged proceeding are submitted under 37 CFR 1.173, in accordance with reissue practice; see the discussion below in part III.6 of this decision.

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

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

2. In the event that a housekeeping amendment is not timely submitted, any claim which does not contain identical text in both proceedings (or would be construed differently based on any difference in the specifications of 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:

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

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

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

7. Where a paper is filed which requires payment of a fee (e.g., petition fee, excess claims fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for 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. 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).

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. The petition for merger is **granted**.

2. Reissue application No. 11/337,223 and reexamination control No. 90/007,728 **are merged** into a single proceeding.

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

4. 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.

5. Jurisdiction over the merged reissue and reexamination proceeding is being transferred to Technology Center 2800 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 '945 patent (e.g., by preparing/signing an action), or was so involved in the examination of any parent of the '945 patent. See MPEP 2236.

6. 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.

7. Telephone inquiries related to this decision should be directed to Samuel Broda, Legal Advisor, at (571) 272-7711.

Kenneth M. Schor

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

ssb
31 May 2006

June 9, 2006
C:\kiva\kenpetmerger\7728_PO-Pet-to-merge_cls-diff_grant.wpd

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,730	09/26/2005	6284131	18196-020001	6929

29200 7590 01/23/2006

BAXTER HEALTHCARE CORPORATION
1 BAXTER PARKWAY
DF2-2E
DEERFIELD, IL 60015

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
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

1/23/06

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

JOHN C. PHILLIPS

FISH & RICHARDSON P.C.

P.O. BOX 1022

MINNEAPOLIS, MN 55440-1022

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007730

PATENT NO. 6,284,131

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

Robert M. Barrett
Baxter Healthcare Corporation
Baxter Parkway
DF2 – 2E
Deerfield, IL 60015

For Patent Owner

MAILED
JAN 23 2006
REEXAM UNIT

John C. Phillips
Fish & Richardson P.C.
12390 El Camino Real
San Diego, CA 92130

For Requester

In re: Robert M. Barrett
Ex Parte Reexamination Proceeding
Control No. 90/007,730
Filed: September 26, 2005
For: US Patent No. 6,284,131

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

This is a decision on the petition filed January 10, 2006 to request a two-week extension of time pursuant to 37 CFR 1.550 for responding to the Order Granting Request for *Ex Parte* Reexamination dated November 22, 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 November 22, 2005, which set a two month date for filing a response thereto. The Office action is an Order Granting Request for *Ex-Parte* Reexamination. 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 attorneys for the patent owner are currently preparing a Patent Owners Statement for filing with the USPTO; however, the patent is also currently involved in litigation pending in the U.S. District Court, Northern District of California, Case No. C03-01431 SBA (EDL). On December 22, 2005, Fresenius USA, Inc., the party that filed the Reexamination Request, served eight voluminous expert reports in connection with the litigation containing its invalidity contentions regarding the subject patent. At the present time, multiple rebuttal reports are due on February 1 and February 8, 2006. These rebuttal reports will provide the patent owner's views regarding validity of the patent here involved. Additional time is requested to

enable the attorneys for the patent owner to fully consult with the technical experts who are providing opinions and analysis regarding the subject patent as well as the prior art alleged to present a substantial new question of patentability. Such consultation cannot be accomplished by the present due date of January 22, 2006. An extension of time until February 10, 2006 to facilitate the completion and timely filing of the Patent Owners Statement 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 implications of the documents filed by Fresenius, USA, Inc., which include further explanations of the invalidity contentions provided in the Reexamination Request, appear to have necessitated the consultation with technical experts which cannot be accomplished by the present due date of January 22, 2006. It appears that the Patent Owner is relying upon this consultation to prepare both the rebuttal expert reports and the Patent Owners Statement. Patent owner is advised that litigation proceedings are separate from Reexamination proceedings and preparation of the rebuttal expert reports in connection with the litigation will **not** be considered to present a compelling reason establishing an extraordinary situation in support of the grant of a second 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 November 22, 2005 is **granted**.

2. The Patent Owner's response is due February 10, 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

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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JUL 15 2008

CENTRAL REEXAMINATION UNIT

BAXTER HEALTHCARE CORPORATION (For Patent Owner)
1 BAXTER PARKWAY
DF2-2E
DEERFIELD IL 60015

JOHN C. PHILLIPS, ESQ. (For Third Party Requester)
FISH & RICHARDSON
12390 EL CAMINO REAL
SAN DIEGO, CA 92130

In re Reexamination Proceeding	:
M. Hogard et al.	:
Control No. 90/007,730	: DECISION GRANTING PETITION
Filed: September 26, 2005	:
U.S. Patent No. 6,284,131	:
Attorney Docket No. 18196-020001	:

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on June 12, 2008, for entry of late papers based upon unintentional delay.

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

37 CFR 1.137(b) states, in part:

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

The present petition under 37 CFR 1.137(b) includes, inter alia, the requisite response (appeal brief and fee (authorization to charge counsel's deposit account for the appeal brief fee) - item 1), an authorization to charge counsel's deposit account for the $1,540.00 petition fee under 37 CFR 1.17(m) (item 2), the requisite statement (item 3) and a Certificate of Service on the Third Party Requester.

The petition for entry of the late papers is granted.

No terminal disclaimer and disclaimer fee are required for a period of termination in a reexamination proceeding.

$2,050.00 ($1,540.00 for the petition fee and $510.00 for the appeal brief fee) has been charged to counsel's deposit account no. 08-0219 in accordance with the present petition.

Jurisdiction over the reexamination proceeding is being returned to Central Reexamination Unit (CRU) Art Unit 3991 for further examination and consideration of the appeal brief filed June 12, 2008, 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, Sharon Turner, in CRU Art Unit 3991, who can be reached at 571-272-0894.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

(For Patent Owner)

MAILED
MAR 0 1 2006
REEXAM UNIT

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

(For Third Party Requester)

In re Thomas J. Campana, Jr. *et al*
Reexamination Proceeding
Control No. 90/006,533
Filed: January 30, 2003
For U.S. Patent No.5,436,960

In re Thomas J. Campana, Jr. *et al*
Reexamination Proceeding
Control No. 90/006,675
Filed: June 24, 2003
For U.S. Patent No. 5,436,960

In re Thomas J. Campana, Jr. *et al*
Reexamination Proceeding
Control No. 90/007,731
Filed: September 27, 2005
For U.S. Patent No. 5,436,960

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

The above-identified reexamination files are before the Director of the Central Reexam Unit 3999, for consideration of merger of reexamination control number 90/007,731 (the '731 proceeding) with the previously merged reexamination control numbers 90/006,533 (the '533 proceeding) and 90/006,675 (the '675 proceeding) pursuant to 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 5,436,960 issued on July 25, 1995.

2. The '533 reexamination proceeding, filed on January 30, 2003, is a reexamination proceeding that was requested by a third party requester.

3. An order granting reexamination in the '533 reexamination proceeding was mailed on April 17, 2003.

4. The '675 reexamination proceeding, filed on June 24, 2003, is a reexamination proceeding that was requested by a third party requester.

5. An order granting reexamination in the '675 reexamination proceeding was mailed on September 3, 2003.

6. The '533 and '675 proceedings were merged to provide a single consolidated proceeding on August 23, 2004.

7. A non-final Office action was mailed on April 19, 2005 in the previously merged proceedings.

8. A response to the April 19, 2005, Office action was timely filed on July 19, 2005. The response added claims 90 to 182 to the merged proceedings. However, the amendment was canceled following notification of fee deficiency in the Interview Summary mailed on November 18, 2005.

9. An amendment with proper fee was filed on November 25, 2005 in the '533 and '675 reexamination proceedings. The amendment canceled claims 90 to 182 and added claims 183 to 200.

10. A non-final Office action was mailed on December 15, 2005 in the previously merged proceedings.

11. A response to the December 15, 2005 Office action was timely filed on February 15, 2006. The response added claims 201 to 233.

12. A Final Office action was mailed on February 24, 2006 in the previously merged proceedings.

13. The '731 proceeding was filed on September 27, 2005 by a third party requester.

14. The third party requester's correspondence address is the same in each of the above mentioned proceedings.

15. An order granting reexamination in the '731 reexamination proceeding was mailed on October 14, 2005.

16. There are no amendments to the '731 reexamination proceeding.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

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

As noted , *supra*, reexamination was previously ordered in the '533 and '675 reexamination proceedings, and these proceedings have previously been merged. Reexamination has been ordered in the '731 proceeding.

As noted in the above noted facts, reexamination has been ordered in both of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is appropriate.

DECISION

In accordance with 37 C.F.R. § 1.565(c), the 90/006,533, 90/006,675 and 90/007,731 reexamination proceedings are hereby merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

I. Requirements for Same Amendments in Both Proceedings

As noted above, the claims and specification have been amended in the '6,533 and '6,675 reexamination proceeding. Patent owner is required to maintain the same claims and specification in all merged files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in both files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

II. Conduct of Merged Proceeding.

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

CONCLUSION

Reexamination Control Nos. 90/006,533, 90/006,675 and 90/007,731 are **merged**. Patent owner has **one month** from the date of this decision to submit an appropriate "housekeeping" amendment. Upon receipt of the "housekeeping" amendment, an Office action will be issued in due course.

All correspondence regarding these proceedings should be submitted as follows:

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

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

(For Patent Owner)

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

(For Third Party Requester)

MAILED

AUG 23 2006

CENTRAL REEXAMINATION UNIT

In re Campana, Jr. et al
Ex Parte Reexamination Proceeding
Control No.: 90/006,533
Filed: January 30, 2003
For: U.S. Patent No. 5,436,960

In re Campana, Jr. et al
Ex Parte Reexamination Proceeding
Control No. : 90/006,675
Filed: June 24, 2003
For: U.S. Patent No. 5,436,960

In re Campana, Jr. et al
Ex Parte Reexamination Proceeding
Control No.: 90/007,731
Filed: September 27, 2005
For: U.S. Patent No. 5,436,960

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

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

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

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

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

REVIEW OF SALIENT FACTS

1. U.S Patent number 5,436,960 ("the '960 patent") issued to Campana *et al* on July 25, 1995 from an application filed on May 20, 1991.

2. On January 30, 2003, a request for *ex parte* reexamination of the '960 patent was filed by a third party requester and assigned control number 90/006,533 ("the '533 reexamination proceeding").

3. On April 17, 2003, the examiner's Order Granting *Ex Parte* Reexamination for the '533 reexamination proceeding was mailed.

4. On June 24, 2003, a second request for ex *parte* reexamination of the '960 patent was filed by the same third party requester, and assigned control number 90/006,675 ("the '675 reexamination proceeding").

5. On September 3, 2003, the examiner's Order Granting *Ex Parte* Reexamination for the '675 reexamination proceeding was mailed.

6. On August 23, 2004, the Technology Center Director issued a decision, *sua sponte*, by which the '533 reexamination proceeding and the '675 reexamination proceeding were merged into a single combined reexamination proceeding.

7. On September 27, 2005, third party requester filed a third request for *ex parte* reexamination of the '960 patent, which was assigned control number 90/007,731 ("the '731 reexamination proceeding").

8. On October 14, 2005, the examiner's Order Granting *Ex Parte* Reexamination for the '731 reexamination proceeding was mailed.

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

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

11. Following prosecution on the patentability of the '960 patent claims, a final rejection Office action was issued in the merged reexamination proceeding on February 24, 2006.

12. On March 1, 2006, the Central Reexamination Unit (CRU) Director issued a decision, *sua sponte*, by which the '533 reexamination proceeding, the '675 reexamination proceeding and the '731 reexamination proceeding were merged into a single merged reexamination proceeding. [3]

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

[3] Jurisdiction of the merged '533 and '675 reexamination proceedings had previously been transferred from the Technology Center to the CRU.

13. On April 24, 2006, patent owner filed both a notice of appeal and an information disclosure statement (IDS) in the single combined reexamination proceeding.

14. Also on April 24, 2006, patent owner filed a paper styled as a response to the final rejection, which included a traverse of the final rejection, copies of material obtained as a result of the FOIA request, and a number of statements in support of patent owner's traverse.

15. On May 17, 2006, the CRU Director mailed a decision returning the April 24, 2006 patent owner response to the final rejection noted in Fact 14 above without consideration on the merits. The return was based on the grounds that the papers filed were improper because they were not limited to consideration of prior patents and printed publications and also because portions were not in compliance with the 37 CFR 1.3 requirements for decorum and courtesy. Accordingly, the returned response was not entered into the record.

16. On May 22, 2006, patent owner filed a redacted version of the April 24, 2006 response, limited to material addressing the outstanding final rejection Office action, which has been entered into the IFW record.

17. On June 23, 2006, patent owner filed the present petition requesting reconsideration of the CRU Director's May 17, 2006 decision. Patent owner has attached to the petition the material that was refused entry and returned (by the CRU Director's May 17, 2006 decision), for entry into the record as part of patent owner's response to the February 24, 2006 final Office action.

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

I. Relevant Statutes, Regulations and Practice

35 U.S.C. § 132 provides:

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

35 U.S.C. § 134(b) provides:

> "A patent owner in any reexamination proceeding may appeal from the final rejection of any claim by the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal."

35 U.S.C. § 305 provides, in part:

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

35 U.S.C. § 306 provides:

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

37 CFR 1.3 provides:

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

37 CFR 1.4(c) provides:

"Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects."

37 CFR 1.113(a) provides, in part:

"On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon ... for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. **Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181).** ..." [Emphasis added.]

37 CFR 1.116(a)-(e) provide, in part:

"(a) An amendment after final action must comply with § 1.114 or this section.

(b) After a final rejection or other final action (§ 1.113) ... in an ex parte reexamination filed under § 1.510 ... but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):

(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;
(2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or
(3) An amendment touching the merits of the ... patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

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

(d) (1) ...
(2) Notwithstanding the provisions of paragraph (b) of this section, an amendment made after a final rejection or other final action (§ 1.113) in an ex parte reexamination filed under §1.510 ... may not

cancel claims where such cancellation affects the scope of any other pending claim in the reexamination proceeding except ... as permitted by § 41.77(b)(1) of this title.

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

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

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

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

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

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

MPEP § 2267 provides in part:

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

I. DISPOSITION OF PAPERS
Where papers are filed during reexamination proceedings which are inappropriate because of some defect, such papers will either be returned to the sender or forwarded to one of three files, the "Reexamination File" (paper file or IFW file history), the "Patent File" (paper file or IFW file history), or the "Storage File" (paper file). Any papers returned to the sender from a Technology Center (TC) must be accompanied by a letter indicating signature and approval of the TC Director." [4]

II. Findings and Analysis

On April 24, 2006, patent owner filed a response to the final action dated February 24, 2006. That paper was returned to patent owner by the decision of the CRU Director dated May 17, 2006, on the grounds that the response was an improper paper. The basis of this holding was that the response included statements and documents that were improper because they were not limited to consideration of prior patents and printed publications, and also because portions were not in compliance with 37 CFR 1.3 requirements for decorum and courtesy. Patent owner was invited, in the May 17, 2006 decision returning papers, to submit a redacted response, and patent owner has in fact filed a redacted version of that response (the redacted version has been entered into the record).

Patent owner has now attached to the present petition - a set of papers to be added to the record as a part of the response to the February 24, 2006 final action, which would be available for the examiner's consideration in evaluating the patent owner's response. Patent owner

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

requests by way of the present petition that these papers be entered into the IFW record to provide a complete administrative record.[5] It is patent owner's position that:

(1) There was no legal basis for the CRU Director's return of the April 24, 2006 response papers;

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

(3) The patent owner is entitled to argue and provide documents to allege that the February 24, 2006 final action is an improper action based on allegations of misconduct and bias.

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

It is also noted that patent owner argues that the CRU Director's decision returning the April 24, 2006 response to the final action dated February 24, 2006 was inconsistent with a prior petition decision dated March 20, 2006 denying a patent owner petition filed on January 23, 2006. [7] This argument will be separately addressed, *infra*.

A. The April 24, 2006 Response Was An Improper Paper, The Response Attached To The Present Petition Is An Improper Paper, And Both Papers Lack An Entry Right In The Merged Reexamination Proceeding

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

In the present instance, a review of the papers attached to the present petition indicates that (1) the papers are essentially the same as, if not identical to, the papers that were returned by the CRU Director's May 17, 2006 decision, and (2) these papers purport to be a response to the examiner's treatment of the pending claims in light of the prior art patents and publications applied to the claims by the examiner in the final action dated February 24, 2006. Pursuant to 37 CFR 1.550(a) (the rule that implements 35 U.S.C. § 305), *ex parte* reexamination proceeding is "conducted in accordance with [37 CFR] §§ 1.104 through 1.116." Therefore, the appropriate content of a 37 CFR 1.550(b) response to a final Office action in an *ex parte* reexamination proceeding is defined by 37 CFR 1.113(a) and 37 CFR 1.116. These regulations do not (contrary to petitioner's argument) provide for "further statements" that are unrestricted as to content. Instead, 37 CFR 1.113(a) and 37 CFR 1.116 require that a response to a final action address the issue of patentability of the pending claims with respect to the outstanding rejection, which, in this instance, is the examiner's treatment of the patentability of the claims in light of prior

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

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

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

patents and printed publications. In contrast, the papers attached to the present petition include material directed to issues other than the examiner's treatment of the patentability of the claims in light of prior patents and printed publications. In fact, large portions of the remarks contained in the response to the final action [8] and documents cited in support are directed to the conduct of Office employees/officials. Thus, large portions of the papers attached to the present petition, are not directed to issues of patentability of the pending claims in light of the applied prior art patents and printed publications. Therefore, these papers clearly constitute responses to the outstanding final Office action that are not proper under 37 CFR 1.550(b) and do not fall within the jurisdiction of the examiner. Accordingly, each of these papers submitted in response to the Office action lacks an entry right in the present merged reexamination proceeding for consideration by the examiner.

Further, 37 CFR 1.3 expressly precludes "complaints against examiners and other employees" submitted as part of papers directed to other matters. Thus, the patent owner's submission of documents in support of its allegations of misconduct and bias could not properly be included with papers directed to the question of patentability in view of prior art, because the clear and unequivocal language of 37 CFR 1.3 expressly requires that "employee conduct" issues are to be raised in correspondence separate from other papers. Here, patent owner improperly raises allegations of employee misconduct incorporated within papers directed to the merits of the examiner's position on the patentability of the pending claims in light of patents and printed publications as set forth in the final Office action. Therefore, the originally filed April 24, 2006 response and the response attached to the present petition are both improper for the reason that they fail to comply with the requirements of 37 CFR 1.3. Accordingly, each paper further lacks an entry right in the present merged reexamination proceeding for consideration by the examiner.

Moreover, 37 CFR 1.4(c) requires that different matters in a given proceeding appropriate for consideration by different branches within the Office must be raised in separate papers. However, patent owner's April 24, 2006 response to the final action improperly presented, in the same paper, both:

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

(2) allegations of employee misconduct and bias.

The patentability arguments are properly considered by the examiner. In contrast, allegations of employee misconduct and bias are considered by way of a petition to the appropriate Office official for the exercise of supervisory authority pursuant to 37 CFR 1.181(a), because alleged employee misconduct and bias relate to non appealable subject matter. Thus both the originally filed April 24, 2006 response and the response attached to the present petition are improper for the additional reason that they fail to comply with the requirements of 37 CFR 1.4(c).

Therefore, for the foregoing reasons, the April 24, 2006 patent owner response, and the June 23, 2006 response attached to the present patent owner petition are deemed improper and therefore these papers lack an entry right in the present merged reexamination proceeding. The disposition of improper papers will be treated as discussed in Section C., *infra*.

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

B. Further Discussion

1. While the patent owner's April 24, 2006 response to the Feb 24, 2006 final action and the response to the final action attached to the present petition each lack an entry right for consideration by the examiner as explained in Section II(A), patent owner may raise the issue of alleged employee misconduct by way of petition under 37 CFR 1.181(a). Note is taken of patent owner's statement that on March 20, 2006, the Office issued a decision in a separate proceeding, such decision denying a patent owner petition filed on January 23, 2006. [9] Patent owner correctly states that the January 23, 2006 petition was denied because it did not provide sufficient details. However, if patent owner is able to now supply those details, they must be submitted in a separate petition under 37 CFR 1.181, but cannot be submitted as part of a paper submitted for consideration by the examiner.

2. Patent owner's characterization of the May 17, 2006 decision issued by the CRU Director returning the April 24, 2006 response to the final Office action of February 24, 2006 is not wholly accurate. In actuality, the CRU Director's May 17, 2006 decision did not mean to imply that the FOIA papers would be barred from submission for any and all purposes. Rather, it properly points out that the papers were returned because they raised issues unrelated to patentability and therefore are not appropriate for consideration by the examiner. Therefore, the submitted papers did not comply with the regulations and practice regarding the submission of response papers. [10]

3. To the extent that patent owner disagrees with some or all of the rationale set forth in support of the CRU Director's decision, Section II(A) of the present decision amplifies the reasons in support of the conclusion reached in the CRU Director's May 17, 2006 decision to refuse entry and return the April 24, 2006 response with attached papers. Section II(A) of the present decision explains that the patent owner may indeed raise alleged employee misconduct and bias issues, but must do so via a separate petition under 37 CFR 1.181. Such a petition must conform to the governing regulations and practice, i.e., the petition regarding alleged employee misconduct must not be attached to papers directed to the substantive issue of claim patentability in light of the prior patents and printed publication. See 37 CFR 1.3 and 37 CFR 1.4(c).

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

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[9] See footnote 7, *supra*.

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

C. Disposition Of Papers

1. In this instance: (1) the April 24, 2006 presentation of the FOIA papers, (2) the April 24, 2006 declaration of Keith Anderson directed the FOIA papers, and (3) the remarks directed to the conduct of Office employees/officials that were included within the April 24, 2006 response to the final action have previously been found to be improper, and lacking an entry right in the present merged proceeding. These papers were previously returned, and a redacted form of these papers was entered into the record, as discussed above.

2. In addition, the patent owner has attached to the present petition the material that was refused entry and returned (by the CRU Director's May 17, 2006 decision), for entry into the record as part of patent owner's response to the February 24, 2006 Office action. These papers have now been found to be improper and therefore lack an entry right in the present merged proceeding to which they are directed. As these papers are determined to lack an entry right in the present merged reexamination proceeding, they will be returned in accordance with provisions of MPEP § 2267. In this instance it would be unduly burdensome to either physically return the large bulk of papers, or expend significant Office resources scanning the documents into the record and then closing them from view. [11] Therefore, the papers are being temporarily held for "pick up" in the Central Reexamination Unit (CRU). If the patent owner desires the physical return of the papers, then patent owner should promptly make arrangements to pick up the papers from the CRU **within one month** of the mailing date of this decision. Patent owner should immediately notify Norma Amador of the CRU, at telephone number (571) 272-6474, of any arrangements that have been made to pick up the papers. If the papers are **not** picked up **within one month** of the mailing date of this decision, **the CRU will dispose of the papers**, note being taken that the patent owner presumably has the originals.

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

CONCLUSION

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

2. The (1) the April 24, 2006 presentation of the FOIA papers, (2) the April 24, 2006 declaration of Keith Anderson directed the FOIA papers, and (3) the remarks directed to the conduct of Office employees/officials that were included within the April 24, 2006 response to the final action have been found to be improper papers lacking an entry right in the present merged proceeding to which they are directed. These papers were properly returned to patent owner.

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

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

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

5. A copy of this decision is being made of record in the merged reexamination proceeding, and the decision will therefore appear in the IFW record of *ex parte* reexamination proceedings 90/006,533, 90/006,675 and 90/007,731.

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

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

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

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

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

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

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July 31, 2006

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(For Third Party Requester)

In re Campana, Jr. et al *Ex Parte* Reexamination Proceeding Control No.: 90/006,533 Filed: January 30, 2003 For: U.S. Patent No. 5,436,960	**DECISION DENYING PETITION**
In re Campana, Jr. et al *Ex Parte* Reexamination Proceeding Control No.: 90/006,675 Filed: June 24, 2003 For: U.S. Patent No. 5,436,960	
In re Campana, Jr. et al *Ex Parte* Reexamination Proceeding Control No.: 90/007,731 Filed: September 27, 2005 For: U.S. Patent No. 5,436,960	

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

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

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

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

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

REVIEW OF SALIENT FACTS

1. U.S Patent number 5,436,960 ("the '960 patent") issued to Campana *et al* on July 25, 1995 from an application filed on May 20, 1991.

2. On January 30, 2003, a request for *ex parte* reexamination of the '960 patent was filed by a third party requester. The resulting *ex parte* reexamination proceeding was assigned control number 90/006,533 ("the '533 reexamination proceeding").

3. On April 17, 2003, the examiner's Order Granting *Ex Parte* Reexamination for the '533 reexamination proceeding was mailed.

4. On June 24, 2003, a request for a second ex *parte* reexamination of the '960 patent was filed by the same third party requester, and the resulting proceeding was assigned control number 90/006,675 ("the '675 reexamination proceeding").

5. On September 3, 2003, the examiner's Order Granting *Ex Parte* Reexamination was mailed for the '675 reexamination proceeding.

6. On August 23, 2004, the Technology Center Director issued a decision, *sua sponte*, by which the '533 reexamination proceeding and the '675 reexamination proceeding were merged into a single consolidated reexamination proceeding.

7. On September 27, 2005, third party requester filed a third request for *ex parte* reexamination of the '960 patent, which was assigned control number 90/007,731 ("the '731 reexamination proceeding").

8. On October 14, 2005, the examiner's Order Granting *Ex Parte* Reexamination for the '731 reexamination proceeding was mailed.

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

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

11. Following prosecution on the patentability of the '960 claims, a final rejection Office action was issued in the merged '533 - '675 reexamination proceeding on February 24, 2006.

12. On March 1, 2006, the Central Reexamination Unit (CRU) Director issued a decision, *sua sponte*, by which the '533 reexamination proceeding, the '675 reexamination proceeding and the '731 reexamination proceeding were merged into a single consolidated reexamination

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

proceeding. [5]

13. On April 24, 2006, patent owner filed both a notice of appeal and an information disclosure statement (IDS) in the single combined reexamination proceeding.

14. Also on April 24, 2006, patent owner filed a paper styled as a response to the final rejection, which included a traverse of the final rejection, copies of material obtained as a result of the FOIA request, and a number of statements in support of patent owner's traverse.

15. On May 17, 2006, the CRU Director mailed a decision returning the April 24, 2006 patent owner response to the final rejection without consideration on the merits. The return was grounded on the impropriety of the papers, because they were not limited to consideration of prior patents and printed publications, and also because portions of the submission were not in compliance with the requirements of 37 CFR 1.3. Accordingly, the returned supplemental response was not entered into the record.

15. On May 22, 2006, patent owner filed a redacted version of the April 24, 2006 supplemental amendment/response, which is limited to material addressing the outstanding nonfinal rejection Office action, and which has been entered into the IFW record for the merged proceeding.

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

17. On August 23, 2006, the June 23, 2006 patent owner petition was dismissed, [6] and was "returned" to petitioner by permitting petitioner to schedule a time to pick up the material (together with similar material from other concurrently filed related petitions). [7]

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

DECISION

I. Relevant Statutes, Regulations and Practice

35 U.S.C. § 132 provides:

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

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[5] Jurisdiction of the merged '533 and '675 reexamination proceedings had previously been transferred from the Technology Center to the CRU.

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

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

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

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

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

35 U.S.C. § 302 provides in pertinent part:

"Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title."

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

"Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications."

35 U.S.C. § 305 provides, in pertinent part:

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

35 U.S.C. § 306 provides:

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

37 CFR 1.3 provides:

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

37 CFR 1.4(c) provides:

"Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects."

37 CFR 1.113(a) provides, in part:

"On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon ... for *ex parte* reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. **Petition may be taken to the Direct r in the case of objections or requirements not inv lved in the rejection of any claim (§ 1.181).** ..." [Emphasis added.]

37 CFR 1.116(a)-(e) provide, in part:

"(a) An amendment after final action must comply with § 1.114 or this section.

(b) After a final rejection or other final action (§ 1.113) ... in an *ex parte* reexamination filed under § 1.510 ... but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):

(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;
(2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or
(3) An amendment touching the merits of the ... patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

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

(d) (1) ...
(2) Notwithstanding the provisions of paragraph (b) of this section, an amendment made after a final rejection or other final action (§ 1.113) in an ex parte reexamination filed under §1.510 ... may not cancel claims where such cancellation affects the scope of any other pending claim in the reexamination proceeding except ... as permitted by § 41.77(b)(1) of this title.

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

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

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

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

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

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

MPEP § 2267 provides in pertinent part:

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

I. DISPOSITION OF PAPERS
Where papers are filed during reexamination proceedings which are inappropriate because of some defect, such papers will either be returned to the sender or forwarded to one of three files, the "Reexamination File" (paper file or IFW file history), the "Patent File" (paper file or IFW file history), or the "Storage File" (paper

file). Any papers returned to the sender from a Technology Center (TC) must be accompanied by a letter indicating signature and approval of the TC Director." [8]

II. Basis For The August 23, 2006 Decision

On April 24, 2006, patent owner filed a response to an outstanding final Office action dated February 24, 2006. That paper was returned to patent owner without consideration on the merits as an inappropriate submission. [9] The paper was considered to be inappropriate by the Central Reexamination Unit Director, (1) because the paper was not limited to consideration of prior patents and printed publications, [10] and (2) because portions of that paper were not in compliance with the requirements of 37 CFR 1.3. On June 23, 2006, patent owner requested reconsideration of the return of those papers by way of a petition for reconsideration. Patent owner attached to that petition for reconsideration the material that had previously been refused entry. A decision issued August 23, 2006, setting forth in detail the basis for refusing the underlying relief requested in the June 23, 2006 request for reconsideration, and for again returning the material that was not proper for entry into the record of the present merged reexamination proceeding.

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

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

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

A. The April 24, 2006 Papers Did Not Comply With 37 CFR 1.113(a) and 37 CFR 1.116

The April 24, 2006 papers purported to be a response directed to the outstanding final Office action dated February 24, 2006. Pursuant to 37 CFR 1.550(a), the present merged reexamination proceeding is to be conducted in accordance with sections 1.104 through 1.116 of Title 37 of the Code of Federal Regulations. Those regulations implement the provisions of 35 U.S.C § 132. 37 CFR 1.113(a) and 37 CFR 1.116 specifically require that a response to a final Office action address issues of patentability of the pending claims that are subject to an outstanding final rejection. The April 24, 2006 papers did contain material directed to the issue of the patentability of the claims of the patents being reexamined that are required to be resolved by appeal to the Board. However, in direct contravention of 37 CFR 1.113(a), the April 24, 2006

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

[9] See MPEP § 2267.

[10] See 35 U.S.C. §§ 301-303.

papers also contained comments and documents that were not directed to the merits of the outstanding rejection (*i.e.*, not directed to appealable matters). These additional comments and documents were instead directed to matters of alleged misconduct on the part of Office employees/officials, and requested relief that is only available by way of petition to the USPTO Director, and not by an appeal to the Board.[11] Accordingly, the April 24, 2006 papers failed to comply with 37 CFR 1.113(a) and 37 CFR 1.116.

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

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

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

B. The April 24, 2006 Papers Did Not Comply With 37 CFR 1.3

37 CFR 1.3, last sentence, prohibits the submission of "complaints against examiners and other employees" of the Office as a part of papers directed to other matters before the Office. The "returned" April 24, 2006 papers included complaints regarding the conduct of Office employees, and these complaints were submitted as part of papers directed to other matters, *i.e.*, the issues of claim patentability in this merged proceeding. Accordingly, the April 24, 2006 papers are barred by 37 CFR 1.3.

C. The April 24, 2006 Papers Did Not Comply With 37 CFR 1.4(c)

37 CFR 1.4(c) requires that, within a given proceeding, material directed to matters that will be considered by different branches within the Office be raised in separate papers. Yet, the April 24, 2006 papers included complaints regarding conduct together with material directed to the issues of claim patentability, notwithstanding that these separate issues are decided by different branches of the Office and resolved by different appellate review tribunals: (1) decision on petition to the USPTO Director and (2) consideration by the Primary Examiner which may ultimately be reviewed by the Board. Accordingly, the April 24, 2006 papers are barred by 37 CFR 1.4(c).

[11] See, for example, the arguments at page 74-92 of the supplemental response filed April 24, 2006, that was to be disposed of if not "picked up" by the patent owner in accordance with the August 23, 2006 Decision on Petition. Note that even a single instance of an argument directed to matters that are not part of a proper response to a nonfinal action within the meaning of 37 CFR 1.111(b) would suffice to preclude entry of the entire supplemental response as lacking an entry right.

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

A. Patent Owner's Position Is Fundamentally Flawed

Petitioner patent owner argues that there has been improper conduct on the part of Office employees. [12] Patent owner apparently also believes that it has evidence of bias specifically on the part of one or more examiners, [13] and that this evidence, as previously submitted on April 24, 2006, should not be barred from examiner consideration because it bears on issues of patentability. Thus, petitioner patent owner urges that 37 CFR 1.3 should not preclude presentation to the examiner of the material alleging bias (even where bias alleged on the part of the examiner is alleged), because bias bears on patentability issues. Similarly, patent owner argues that 37 CFR 1.4(c) is inapplicable, because evidence of bias addresses the same patentability issues as the remainder of patent owner's substantive reply. [14]

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

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

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[12] See pages 3-4 of the present Petition for Reconsideration.
[13] See, for example, the headings on pages 4 and 7 of the present Petition for Reconsideration.
[14] See pages 7-9 of the present Petition for Reconsideration.
[15] Non-appealable subject matter reviewed by petition under 37 CFR 1.181 is subject to judicial review under the Administrative Procedures Act.

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

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

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

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

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

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

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

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

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

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

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

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

raised, "papers directed to the merits of claim patentability in any proceeding in which the misconduct is alleged to have occurred."

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

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

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

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

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

C. 37 CFR 1.113(a) and 37 CFR 1.116 Preclude The Relief Requested By Patent Owner

37 CFR 1.111(a) and 37 CFR 1.116 provide that a response to a final Office action must, *inter alia*, specifically point out supposed errors in the examiner's action, and point out the specific distinctions believed to render the claims patentable over the prior art. The regulation does not

provide for "further statements" that address matters other than the issues of patentability raised in the outstanding Office action. The failure of the April 24, 2006 patent owner submission to comply with 37 CFR 1.113(a) and 37 CFR 1.116 was discussed at pages 6-7 of the Decision Dismissing Petition dated August 23, 2006. It was pointed out that the April 24, 2006 patent owner submission was not confined to responding to the nonfinal Office action as required by 37 CFR 1.111(b), but instead intermingled matter directed to other issues (the issues of alleged misconduct on the part of Office personnel).

In the present petition patent owner has not directly addressed this point. To the extent that patent owner's general argument that the allegations of misconduct are in fact relevant to the issues of patentability, those arguments are wholly unpersuasive for the reasons set forth in Section III (A) above. Therefore, it is again concluded that the August 23, 2006 Decision Dismissing Petition properly refused entry of the April 24, 2006 patent owner as being non-compliant with 37 CFR 1.113(a) and 37 CFR 1.116.

CONCLUSION

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

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

3. A copy of this decision is being made of IFW record for the merged reexamination proceeding, and the decision will therefore appear in the IFW record of *ex parte* reexamination proceedings 90/006,533, 90/006,675 and 90/007,731.

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

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

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

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February 22, 2007

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,732	09/28/2005	6689566	IMUNE-006X	9258

7590 02/16/2006

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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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REEXAM UNIT

REEXAM UNIT

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(For 3rd Party Requester)

Reexam Control No.: 90/007,685
Filed : August 22, 2005
For U.S. Patent No.: 6,689,566

Reexam Control No.: 90/007,732
Filed: September 28, 2005
For U.S. Patent No.: 6,689,566

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. 90/007,685 was ordered in a decision mailed September 14, 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. 90/007,732 was ordered in a decision mailed October 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. 90/007,685 and 90/007,732 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

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MAILED

APR 27 2007

CENTRAL REEXAMINATION UNIT

Matthew A. Newboles
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(for Third Party Requester)

In re Cantor et al. Reexamination Proceeding Control No. 90/007,685 Filed: August 22, 2005 For: U.S. Patent No. 6,689,566 B1	:	DECISION ON PETITIONS
In re Cantor et al. Reexamination Proceeding Control No. 90/007,732 Filed: September 28, 2005 For: U.S. Patent No.: 6,689,566 B1	:	

This is a decision on (1) the March 24, 2006 patent owner "Petition to Expunge Information Under MPEP 724.06 and 37 C.F.R. 1.59," and (2) the April 7, 2006 patent owner "Petition to Waive Service Rule Under 37 C.F.R. 1.183," both petitions were resubmitted on February 8, 2007.

The petitions are 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 724.06 and 37 CFR 1.59 is **dismissed** as premature.

The proceeding is **remanded** to the examiner for a determination as to whether or not any portion or all of the information submitted in this proceeding as protected information is "important to a reasonable examiner in deciding whether or not a claim is patentable."

BACKGROUND

1. U.S. Patent No. 6,689,566 to Cantor et al. (the '566 patent) issued on February 10, 2004.

2. On August 22, 2005, petitioner patent owner filed a first request for *ex parte* reexamination, which resulted in a reexamination proceeding assigned reexamination control number 90/007,685 (the '7685 proceeding).

3. On September 14, 2005 the Office granted the patent owner's request, and ordered reexamination.

4. On September 26, 2005, a third party requester filed a second request for *ex parte* reexamination, which resulted in a reexamination proceeding assigned reexamination control number 90/007,732 (the '7732 proceeding).

5. On October 27, 2005 the Office granted the third party requester request, and ordered reexamination.

6. On February 16, 2006 the Office issued a decision merging the '7685 and '7732 *ex parte* proceedings into a single merged proceeding.

7. On March 24, 2006 the patent owner filed a supplemental Information Disclosure Statement (IDS) in the now merged reexamination proceedings noted above. 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). The information submitted with the petition was provisionally sealed from the public.

8. On April 7, 2006 the patent owner filed a petition under 37 CFR 1.183 to waive the service requirement by 37 CFR 1.550(f).

9. On January 8, 2007 the Office issued a NIRC for the merged *ex parte* proceeding of '7685 and '7732.

10. On February 8, 2007, the patent owner resubmitted the petitions to expunge and waive service filed on March 24, 2006 and April 7, 2006 respectively.

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 as a general rule made available to the public. Confidential litigation/proprietary materials (protected materials) have been submitted under MPEP 724 *et seq*. These materials have not been served on the reexamination requester. 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, and then timely release to the public any of such information found to be important to a reasonable examiner in deciding whether or not a claim is patentable. It goes without saying, that requiring that 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 purpose of the protective order issued by the federal court, in the related patent litigation, as well as undermine protective order procedure/mechanisms in general. 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 requester of the materials previously submitted and identified as "confidential"' is not required. Accordingly, 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 requester).

Petition to Expunge under 37 CFR 1.59

The information submitted with the petition was appropriately submitted under MPEP 724.02, and it accordingly was **provisionally sealed**.

As to the petition itself, 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." Upon a review of the file history, it does not appear that the requisite determination has been made. Therefore, a decision on the petition at this time is premature, because any information submitted in confidence but found to be "important to a reasonable examiner in deciding whether or not a claim is patentable" cannot be expunged. Accordingly, it is not appropriate at this time to make a determination to expunge. Thus the petition to expunge is **dismissed**, and is held in abeyance pending the determination as to whether or not any portion or all of the information submitted is "important to a reasonable examiner in deciding whether or not a claim is patentable."

The dismissal is subject to renewal at a later point in this proceeding, when the issue becomes ripe for decision. After a determination on the issue of importance of the sealed information is made of record (as discussed above), the petition to expunge may be renewed by patent owner. 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 provisionally sealed material being unsealed and made of record in the reexamination file and thus becoming open to the public.

Remand

The proceeding is remanded to the examiner for 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." Upon receipt of jurisdiction of the proceeding, the examiner will, pursuant to MPEP 724.04(c), promptly make such a determination and issue an Office action, which may be a supplemental Notice of Intent to Issue a Reexamination Certificate, if appropriate.

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 under MPEP 724.06 and 37 CFR 1.59 is **dismissed**, subject to renewal at a later point in the proceeding. It is held in abeyance, pending renewal of it by patent owner at an appropriate time.

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. The present merged proceeding is **remanded** to the examiner of record for a prompt 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."

5. Jurisdiction over the present reexamination proceeding is being returned to the Central Reexamination Unit for further processing not inconsistent with this decision.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,732	09/28/2005	6689566	IMUNE-006X	9258

25225 7590 07/10/2007

MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/10/2007

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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7/11/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Matthew A. Newboles

STETINA BRUNDA GARRED & BRUCKER

75 Enterprise, Suite 250

Aliso Viego, CA 92656

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007685

PATENT NO. 6,689,566

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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ALEXANDRIA, VA 22313-1450
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JUL 10 2007

CENTRAL REEXAMINATION UNIT

Peng Chen (Patent Owner)
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Matthew A. Newboles (for Third Party Requester)
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75 Enterprise, Suite 250
Aliso Viejo, CA 92656

In re Cantor et al. Reexamination Proceeding Control No. 90/007,685 Filed: August 22, 2005 For: U.S. Patent No. 6,689,566 B1	:	DECISION GRANTING PETITION
In re Cantor et al. Reexamination Proceeding Control No. 90/007,732 Filed: September 28, 2005 For: U.S. Patent No.: 6,689,566 B1	:	

This is a decision on the June 7, 2007 patent owner "Request to Renew Petition to Expunge Information under MPEP 724.06 and 37 C.F.R. § 1.59".

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

The petition is **granted**, and the information under MPEP 724.06 and 37 CFR 1.59 will be expunged.

BACKGROUND

1. U.S. Patent No. 6,689,566 to Cantor et al. (the '566 patent) issued on February 10, 2004.

2. On August 22, 2005, petitioner patent owner filed a first request for *ex parte* reexamination, which resulted in a reexamination proceeding assigned reexamination control number 90/007,685 (the '7685 proceeding).

3. On September 14, 2005 the Office granted the patent owner's request, and ordered reexamination.

4. On September 26, 2005, a third party requester filed a second request for *ex parte* reexamination, which resulted in a reexamination proceeding assigned reexamination control number 90/007,732 (the '7732 proceeding).

5. On October 27, 2005, the Office granted the third party requester's request, and ordered reexamination.

6. On February 16, 2006, the Office issued a decision merging the '7685 and '7732 *ex parte* proceedings into a single merged proceeding (hereinafter, "the merged proceeding").

7. On March 24, 2006, the patent owner filed a supplemental Information Disclosure Statement (IDS) in the merged 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). The information submitted with the petition was provisionally sealed from the public.

8. On April 7, 2006, the patent owner filed a petition under 37 CFR 1.183 to waive the service requirement by 37 CFR 1.550(f).

9. On January 8, 2007, the Office issued a NIRC for the merged *ex parte* proceeding of '7685 and '7732.

10. On February 8, 2007, the patent owner resubmitted the petitions to expunge and waive service, which had been filed on March 24, 2006 and April 7, 2006 respectively.

11. On April 27, 2007, a Senior Legal Advisor of Office of the Patent Legal Administration issued a decision on the petitions to expunge and to waive service. The decision (1) granted patent owner's 37 CFR 1.83 petition requesting a waiver of service under 37 CFR 1.550(f) and (2) dismissed patent owner's petition to expunge under MPEP 724.06 and 37 CFR 1.59 as premature. The decision (3) remanded the proceeding to the examiner for a determination as to whether or not any portion, or all, of the information submitted as protected information was "important to a reasonable examiner in deciding whether or not a claim is patentable."

12. On May 23, 2007, the examiner of record issued a communication in regard to the merged proceeding, addressing the Senior Legal Advisor's remand of the merged proceeding.

13. On June 7, 2007, patent owner filed the instant petition, titled "Request to Renew Petition to Expunge Information under MPEP 724.06 and 37 C.F.R. § 1.59."

DECISION

37 CFR 1.59 provides:

> (a)(1) Information in an application will not be expunged, except as provided in paragraph (b) of this section or § 41.7(a) of this title.
> (2) Information forming part of the original disclosure (*i.e.*, written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under §§1.63 and 1.175 will not be expunged from the application file.
>
> (b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

MPEP 724.05 I provides (in part):

> Such petition must contain:
>
> (A) a clear identification of the information to be expunged without disclosure of the details thereof;
>
> (B) a clear statement that the information to be expunged is trade secret material, proprietary material, and/or subject to a protective order, and that the information has not been otherwise made public;
>
> (C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;
>
> (D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information;
>
> (E) the fee as set forth in 37 CFR 1.17(g) for a petition under 37 CFR 1.59(b).

<u>Petition to Expunge under 37 CFR 1.59</u>

The information submitted March 24, 2006, was appropriately submitted under MPEP 724.02, and it accordingly was **provisionally sealed**.

As to the petition itself, MPEP 724.04(c) sets forth the guidelines for submitting and treatment of proprietary "Materials Submitted in Reexamination File Open to the Public Under 37 CFR 1.11(d)." A petition to expunge should accompany the submission of the information and, in any event, must be submitted in sufficient time that it can be acted on before the reexamination proceeding enters the reexamination certificate printing process.[1] When reexamination proceeding is considered on the merits, the examiner (and/or other appropriate Office personnel responsible for considering the information) reviews the sealed information, and makes a determination as to whether or not any portion or all of the information submitted is "important to a reasonable examiner in deciding whether or not a claim is patentable."

The original petition to expunge was filed concurrently with the proprietary and protective order materials on March 24, 2006, in the merged reexamination proceeding. Petitioner renewed the petition to expunge on February 8, 2007, shortly after a NIRC issued for the merged reexamination proceeding. Patent owner, in their renewed petition to expunge clearly identified the information to be expunged as the information supplied in an information disclosure statement on March 24, 2006. Patent owner clearly stated that document numbers 1-75 of the 76 documents submitted on March 24, 2006 are subject to a federal district court protective order. Patent owner also clearly stated that document number 76 submitted on March 24, 2006, contains proprietary information. Patent owner provided a commitment to retain the information for the entire patent term. The patent owner stated, on the record, that the petition was being submitted by or on behalf of the real party in interest who originally submitted the information. The petition authorized payment of the necessary fees under 37 CFR 1.17(g) for a petition under 37 CFR 1.59(b). Finally, on May 23, 2007, in a communication addressing the Senior Legal Advisor's April 27, 2007 remand of the merged proceeding, the examiner determined the references in question "were not found to be important to a reasonable examiner in deciding whether or not a claim is patentable."

Accordingly, there is compliance with all the criteria set forth in MPEP 724.05 I listed above. Thus, the petition is **granted.**

CONCLUSION

1. The petition to expunge information under MPEP 724.06 and 37 CFR 1.59 is **granted.**

2. No copy of the expunged documents will be maintained of record in the Office.

3. A copy of this decision will be made of record in the '7685 and '7732 *ex parte* reexamination files.

4. Jurisdiction over the present merged reexamination proceedings is being returned to the Central Reexamination Unit.

---

[1] If the reexamination is merged with a reissue application, the petition is to be submitted such that it can be acted upon prior to the application's entry into the patent publication stage or the issuance of the notice of abandonment for the reissue application.

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

7/5/07
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,685	08/22/2005	6689566	532212801100	3042

25225 7590 02/11/2008

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SAN DIEGO, CA 92130-2040

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/11/2008

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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Date:

MAILED
FEB 11 2008
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007685
PATENT NO. : 6689566
ART UNIT : 2800

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

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

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Commissioner for Patents
United States Patent and Trademark Office
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CENTRAL REEXAMINATION UNIT

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In re Cantor et al.	:	
Ex Parte Reexamination Proceeding	:	**DECISION**
Control No. 90/007,685	:	**ON**
Filed: August 22, 2005	:	**PETITION**
For: U.S. Patent 6,689,566 B1	:	

In re Cantor et al.	:
Ex Parte Reexamination Proceeding	:
Control No. 90/007,732	:
Filed: September 28, 2005	:
For: U.S. Patent No.: 6,689,566 B1	:

This is a decision on the April 21, 2006 Patent Owner "Petition to Expunge Information Under MPEP §724.06 and 37 CFR §1.59."

This petition is before the Central Reexamination Unit of the United States Patent and Trademark Office.

FEES

The Patent Owner has paid the $200.00 petition fee for the petition under 37 CFR §1.17(f) as required by 37 CFR §1.59(b).

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SUMMARY

This petition to expunge information under MPEP §724.06 and 37 CFR §1.59 is **GRANTED**.

BACKGROUND

1. U.S. Patent No. 6,689,566 to Cantor et al. (the '566 patent) issued on February 10, 2004.

2. On August 22, 2005, petitioner Patent Owner filed a first request for *ex parte* reexamination, which resulted in a reexamination proceeding assigned reexamination control number 90/007,685 (the '7685 proceeding).

3. On September 14, 2005 the Office granted the Patent Owner's request, and ordered reexamination.

4. On September 28, 2005, a Third Party Requester filed a second request for *ex parte* reexamination, which resulted in a reexamination proceeding assigned reexamination control number 90/007,732 (the '7732 proceeding).

5. On October 27, 2005, the Office granted the Third Party Requester's request, and ordered reexamination.

6. On February 16, 2006, the Office issued a decision merging the '7685 and '7732 *ex parte* proceedings into a single merged proceeding (hereinafter, "the merged proceeding").

7. On March 24, 2006, the Patent Owner filed a supplemental Information Disclosure Statement (IDS) in the merged 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).

8. On April 7, 2006, the Patent Owner filed a petition under 37 CFR 1.183 to waive the service requirement by 37 CFR 1.559(f).

9. On April 20, 2006 a non-final Office action was mailed.

9. On April 21, 2006, the Patent Owner filed an Information Disclosure Statement (IDS) in the merged proceeding. The IDS was filed under seal and concurrently with a petition under MPRP 724.06 and 37 CFR. 1.59 for expungement upon issuance of a Notice of Intent to Issue a Reexamination Certificate (NIRC).

10. On May 24, 2006, a non-final Office action was mailed.

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11. On June 5, 2006, an telephone interview was conducted.

12. On July 10, 2006, a telephone interview was conducted.

13. On July 24, 2006, the Patent Owner filed an amendment to the claims.

14. On September 21, 2006, a final Office action was mailed.

15. On November 7, 2006, a telephone interview was conducted.

16. On November 10, 2006, the Patent Owner filed an amendment in response to the the final rejection of November 7, 2006.

17. On November 20, 2006, a telephone interview was conducted.

18. On December 1, 2006, the Patent Owner filed an amendment to the claims.

19. On December 21, 2006, the Patent Owner filed a supplemental amendment after final was filed.

20. On December 21, 2006, the Patent Owner filed a Notice of Appeal.

21. On January 8, 2007, the Office issued a NIRC for the merged ex parte proceeding of '7685 and '7732.

11. On February 8, 2007, the Patent Owner filed renewed petitions to expunge and waive service, which had been filed on 24 March 2006 and 07 April 7, 2006, respectively.

12. On April 27, 2007, a Senior Legal Advisor of Office of the Patent Legal Administration issued a decision on the petitions to expunge and to waive service. The decision (1) granted Patent Owner's 37 CFR 1.183 petition requesting a waiver of service under 37 CFR 1.550(f) and (2) dismissed Patent Owner's petition to expunge under MPEP 724.06 and 37 CFR. 1.59 as premature. The decision (3) remanded the proceeding to the examiner for a determination as to whether or not any portion, or all, of the information submitted as protected information was "important to a reasonable examiner in deciding whether or not a claim is patentable."

13. On May 23, 2007, the examiner of record issued a communication with regard to the IDS filed 24 March 2006 in the merged proceeding, addressing the Senior Legal Advisor's remand of the merged proceeding.

14. On June 7, 2007, Patent Owner filed a petition titled, "Request to Renew Petition to Expunge Information under MPEP 724.06 and 37 CFR 1.59," requesting that the information cited on the IDS of April 7, 2006 be expunged.

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15. October July 2, 2007, a telephone interview was conducted.

16. On July 10, 2007 the "Request to Renew Petition to Expunge Information under MPEP 724.06 and 37 CFR 1.59" filed 07 June 2007 was granted with respect to the IDS submitted on 24 March 2006.

17. On September 7, 2007, the Board of Patent Appeals and Interferences declared an interference between U.S. Patent Application 10/641,780 to Thomas L. Cantor and U.S. Patent 6,838,264 to Zahradnik and Lavigne.

18. On November 30, 2007 the examiner of record issued a communication with regard to the Information Disclosure Statement submitted April 21, 2006.

DECISION

37 CFR §1.59 provides:

> (a)(1) Information in an application will not be expunged except as provided in paragraph (b) of this section or §41.7(a) of this title.
> (2) Information forming part of the original disclosure (i.e. written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under §§1.63 and 1.175 will not be expunged from the application file.
> (b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in §1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

MPEP 724.05 I provides (in part):

> Such petition must contain:
>
> (A) a clear identification of the information to be expunged without disclosure of the details thereof:
>
> (B) a clear statement that the information to be expunged is trade secret material, proprietary material, and/or subject to a protective order, and that the information has not been otherwise made public;
>
> (C) a commitment on the part of the petitioner to retain such information for a period of any patent with regard to which such information is submitted;
>
> (D) a statement that the petition to expunge is being submitted by, or on behalf of, the party interest who originally submitted the information;
>
> (E) the fee as set forth in 37 CFR 1.17(g) for a petition under 37 CFR 1.599(b).

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Petition to Expunge under 37 CFR 1.59

The information submitted with the petition was appropriately submitted under MPEP §724.02, and it accordingly was **provisionally sealed.**

As to the petition itself, 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)." A petition to expunge should accompany the submission of the information and, in any event, must be submitted in sufficient time that it can be acted on before the reexamination proceeding enters the reexamination certificate printing process. When reexamination proceeding is considered on the merits, the examiner(and/or other appropriate Office personnel responsible for considering the information) reviews the sealed information, and makes a determination as to whether or not any portion or all of the information submitted is "important to a reasonable examiner in deciding whether or not a claim is patentable."

The original petition to expunge was filed with the proprietary and protective order materials on 21 April 2006, in the merge reexamination proceeding. (A copy of this petition to expunge was resubmitted 08 February 2007.) Patent Owner clearly identified the information to be expunged as the information supplied in an information disclosure document submitted on 17 March 2006. Patent Owner clearly stated that the document submitted on 17 March 2006 is subject to a federal district court protective order. Patent Owner provided a commitment to retain the information for the entire patent term. The Patent Owner stated, on the record, that the petition was being submitted by or on behalf of the real party of interest who originally submitted the information. The petition authorized payment of the necessary fees under 37 CFR §1.17(g) for a petition under 37 CFR 1.59(b). Finally, on 29 November 2007 the examiner determined that the reference in question "was not found to be important to a reasonable examiner in deciding whether or not a claim is patentable."

Accordingly, there is compliance with all of the criteria set forth in MPEP 724.05 I listed above. Thus, the petition is **granted**.

CONCLUSION

1. The petition to expunge under MPEP §724.06 and 37 CFR §1.59 is **granted**.

2. The present proceeding is an Image File Wrapper (IFS) proceeding and the paper was entered into the IFW record. Therefore, the paper cannot be "returned" to the Patent Owner, but the paper has been (and will remain) marked "closed" and "not public." The paper will not form part of the record, and will not be available to the public.

3. A copy of this decision will be made of record in the '7685 and '7732 *ex parte* reexamination files.

Copied from 90007685 on 02/14/2008

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

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APR 03 2008

CENTRAL REEXAMINATION UNIT

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Peng Chen (For Patent Owner)
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Suite 100
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Matthew A. Newboles (For Third Party)
STETINA, BRUNDA, GARRED & BRUCKER
75 Enterprise, Suite 250
Aliso Viejo, CA 92656

In re Cantor et al. *Ex Parte* Reexamination Proceeding Control No. 90/007,685 Filed: August 22, 2005 For: U.S. Patent No.: 6,689,566 B1	: : : : :	**DECISION ON PETITION**
In re Cantor et al. *Ex Parte* Reexamination Proceeding Control No. 90/007,732 Filed: September 28, 2005 For: U.S. Patent No.: 6,689,566 B1	: : : : :	

This is a decision on two petitions to Expunge Information under MPEP §724.06 and 37 CFR §1.59 dated December 12, 2007 and February 4, 2008. Each of these petitions was filed after the NIRC which was mailed January 8, 2007. Furthermore, the information which the Patent Owner seeks to expunge was cited on Information Disclosure Statements also filed after the mailing of the NIRC. Since all of the supplemental IDS's filed after the mailing of the NIRC are being returned to the Patent Owner for failing to comply with MPEP 2256, these two petitions to Expunge Information under MPEP 724.06 and 37 CFR 1.59 are not necessary, and therefore, are **dismissed**.

A copy of the letter accompanying the returned papers will be made of record in the reexamination proceeding. However, no copy of the returned papers will be retained by the Office. If the submission of the returned papers is appropriate later in the proceedings, they will be accepted by the Office at that time. See MPEP 2256.

Please note, the present proceeding is an Image File Wrapper (IFW) proceeding and the paper was entered into the IFW record. Therefore, the papers cannot be "returned" to the Patent Owner, but the papers have been (and will remain) marked "closed" and "not public." The paper will not form part of the record, and will not be available to the public.

This decision is made of record in the reexamination proceeding.

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.

Lissi Marquis
Director, Central Reexamination Unit

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MICHAEL S. DOWLER
HOWREY LLP
1111 LOUISIANA, 25TH FLOOR
HOUSTON, TX 77002

(for patent owner)

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MAY 24 2007

CENTRAL REEXAMINATION UNIT

David L. Fehrman
MORRISON & FOERSTER LLP
555 West Fifth Street
Suite 3500
Los Angeles, CA 90013

(for requestor)

In re VOGEL
Ex Parte Reexamination Proceeding
Control No. 90/007,733
Filed: September 26, 2005
Title: **Automatic Censorship of Video Programs**

In re VOGEL
Ex Parte Reexamination Proceeding
Control No. 90/008,243
Filed: September 29, 2006
Title: **Automatic Censorship of Video Programs**

SUA SPONTE
DECISION MERGING
REEXAMINATION PROCEEDINGS

The above-identified reexamination files are before the Director of Central Reexamination Unit, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 4,930,160 issued on May 29, 1990.

2. A first request for Reexamination control number 90/007,733 was made by a third party requester was made September 26, 2005 by a third party requester for reexamination of claims 1-26.

3. Reexamination was ordered in the '7733 reexamination proceeding on November 23, 2005.

4. A request for reexamination, Reexamination Control No. 90/008,243, was filed by the third party requester on September 29, 2006. This request was directed to claims 1, 3, 4, 6-8, 11, 14, 16, 17, 19-21, 24, and 27-44,

5. Reexamination was ordered in the '8,243 reexamination proceeding on March 19, 2007.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

> If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* reexamination proceeding has not been terminated, the *ex parte* reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570.

As noted above, reexamination has been ordered in both of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is appropriate.

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '7,733 and 8,243 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. 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 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. 90/7,733 and 90/008,243 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.

Patent owner is required to maintain the same claims and specification in all 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

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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,733	09/26/2005	4930160	487132800100	2180

37086 7590 04/25/2008

NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/25/2008

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

David L. Fehrman

Morrison and Foerster, LLP

555 W. Fifth St. Suite 3500

Los Angeles, CA 90013

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APR 25 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/008,243, 90/007,733

PATENT NO. 4930160.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Novak Druce & Quigg, LLP (For Patent Owner)
(NDQ Reexamination Group)
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Houston, TX 77002

Morrison & Foerster LLP (For Third-Party Requester)
555 West Fifth Street
Suite 3500
Los Angeles, CA 90013-1024

In re: Vogel	: DECISION
Reexamination Proceeding	: GRANTING-IN-PART
Control No. 90/007,733	: PETITION FOR
Request Deposited: September 14, 2006	: EXTENSTION OF TIME
For: U.S. Patent No. 4,930,160	: [37 CFR 1.550(c)]
In re: Vogel	:
Reexamination Proceeding	:
Control No. 90/008,243	:
Corrected Request Deposited: January 8, 2007	:
For: U.S. Patent No. 4,930,160	:

This is a decision on the April 21, 2008, "PATENT OWNER'S REQUEST FOR EXTENSION OF TIME TO FILE RESPONSE TO OFFICE ACTION PURSUANT TO 37 CFR 1.550(C)" requesting that the time to submit a Patent Owner response be extended an additional 35 days.

The petition is before the Director of the Central Reexamination Unit for consideration.

The petition is granted-in-part and a thirty-day extension of time is granted for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 4,930,160 (hereinafter, the '160 patent), issued to Vogel, on May 29, 1990 from application number 07/237,176, filed August 29, 1988.

2. On September 26, 2005, a third party deposited a Request for *Ex Parte* Reexamination of the '160 patent. The reexamination proceeding was assigned Control No. 90/007,733 (hereinafter, the '7733 proceeding).

3. The reexamination order was granted in the '7733 proceeding on November 23, 2005.

4. A non-final rejection was mailed on April 28, 2006 setting a two-month period for response.

5. A petition for extension of time was filed on May 31, 2006 requesting an additional 30 days for response. Said petition was granted on June 19, 2006.

6. A response was timely filed on July 28, 2006.

7. On September 29, 2006, a third party deposited a Request for *Ex Parte* Reexamination of the '160 patent. The reexamination proceeding was assigned Control No. 90/008,243 (hereinafter, the '8243 proceeding). Said request was given a filing date of September 29, 2006, which was vacated in the decision of December 8, 2006. On January 8, 2007, the third party deposited a corrected Request for *Ex Parte* Reexamination of the '160 patent.

8. The reexamination order was granted in the '8243 proceeding on March 19, 2007.

9. The '7733 and '8243 proceedings were merged on May 24, 2007.

10. A housekeeping amendment was filed on July 3, 2007.

11. A non-final office action was mailed on August 8, 2007. A subsequent non-final office action was mailed on October 1, 2007 setting a two-month period for response.

12. Patent Owner timely filed a response on December 3, 2007 (December 1st being a Saturday).

13. A final rejection was mailed on March 25, 2008 setting a one-month period for response as an order granting the joint motion to stay litigation pending reexamination proceedings was issued on January 17, 2008.

14. A request for extension of time was timely filed on April 21, 2008.

DECISION

The Patent Owner requests an extension of time in which to file a Patent Owner response to the final office action mailed March 25, 2008. The request for extension is the second request for an extension of time. The present petition for extension of time was timely filed on April 21, 2008, together with the 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 CRU 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.

Patent Owner's Showing of Sufficient Cause to Grant an Extension of Time

The request notes that "Patent Owner wishes to present declaration testimony rebutting the Office's interpretation of the priority document and the standard upon which the judgment has been made. Also for the first time, the Office has determined the declarations by Thomas Coverstone insufficient to establish the requisite nexus between the evidence of commercial success based on licensing activities of the '160 patent and the subject matter of the currently pending claims in the reexamination proceeding. Again, for rebuttal, declaration testimony is desired.

Patent Owner has initiated contact with prospective declarants, including certain foreign residents. Among other factors, the difference in time zones complicates cooperation for the preparation of the necessary declarations. Furthermore, we have just received a return contact from one of the prospective declarants and have begun the process for obtaining one of the

desired declarations. In that a substantial portion of the Response to the Final Office Action is dependent on the declarations and their content, that work must be completed for the most part after the declarations are solidified."

Reference is made to the petition for details of these and other issues.

Analysis and Findings

On balance it is considered that the petition explains the "sufficient cause" for an extension of time. It is clear Patent Owner requires some additional time to prepare a complete response. An extension of time of 30 days is considered sufficient.

It is noted that Patent Owner states that they "must respond to the Advisory Action, also due on or before April 25, 2008 in the companion case to this matter (Control Nos. 90/007,746 and 90/008,544). Given the complex nature of the reexamination proceeding and the fact that the shortest period of time allowed for response has been issued, together with the fact that a response is also due in the companion proceeding, Patent Owner and its undersigned counsel request these thirty-five additional days in order to submit the Response." However, this is incorrect as the final rejection in the merged '7746 and '8544 proceedings was mailed on February 8, 2008 and the advisory action of March 25, 2008 extended the period for response to run three months from the mailing date of the final rejection. Therefore, the response in the merged '7746 and '8544 proceedings is due on or before May 8, 2008.

Accordingly, the time for filing the response is extended for thirty days and therefor the response is due on or before May 27, 2008 (May 25th being a Sunday and May 26th being a national holiday).

Patent Owner should expect that future requests for extensions will not be granted absent strong and compelling reasons that establish the existence of an extraordinary situation necessitating the additional time.

It is also noted that the '160 patent expires on August 29, 2008.

37 CFR 1.530(j) states:

No enlargement of claim scope. No amendment may enlarge the scope of the claims of the patent or introduce new matter. No amendment may be proposed for entry in an expired patent. Moreover, no amendment, other than the cancellation of claims, will be incorporated into the patent by a certificate issued after the expiration of the patent.

MPEP 2250 (III) states, in part:

Pursuant to 37 CFR 1.530(j), "[n]o amendment may be proposed for entry in an expired patent." Thus, if a patent expires during the pendency of a reexamination proceeding for a patent, all

amendments to the patent claims and all claims added during the proceeding are withdrawn. This is carried out by placing a diagonal line across all amended and new claims (and text added to the specification) residing in the amendment papers. The patent owner should be notified of this in the next Office action. The Office action will hold the amendments to be improper, and state that all subsequent reexamination will be on the basis of the unamended patent claims. This procedure is necessary since no amendments will be incorporated into the patent by a certificate after the expiration of the patent.

Since an appeal by Patent Owner can extend the pendency of the reexamination beyond the expiration of the '160 patent (i.e. 2 months to file an appeal brief after the Notice of Appeal and 2 months to file a reply brief after the examiner's answer would prolong prosecution into at least September 2008), the Office will entertain an after-final amendment to return the claims to the original, unamended patent claims at the present time.

CONCLUSION

1. Petitioner's request is granted-in-part. The period during which Patent Owner may file a response has been extended to May 27, 2008.

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

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William R. Wright
STUM & FIX LLP
206 Sixth Avenue
Suite 1213
Des Moines, IA 50309-4076

(For Patent Owner)

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REEXAM UNIT

Donald J. Quigg
NOVAK DRUCE DELUCA & QUIGG LLP
1300 Eye Street N. W.
400 East Tower
Washington, DC 20005

(For Third Party Requester)

In re Thomas J. Campana, Jr. *et al*
Reexamination Proceeding
Control No. 90/006,493
Filed: December 26, 2002
For U.S. Patent No.5,819,172

In re Thomas J. Campana, Jr. *et al*
Reexamination Proceeding
Control No. 90/006,680
Filed: June 24, 2003
For U.S. Patent No. 5,819,172

In re Thomas J. Campana, Jr. *et al*
Reexamination Proceeding
Control No. 90/007,735
Filed: September 28, 2005
For U.S. Patent No. 5,819,172

DECISION,
SUA SPONTE,
MERGING
REEXAMINATION
PROCEEDINGS
PURSUANT TO
37 C.F.R. § 1.565(c)

The above-identified reexamination files are before the Director of the Central Reexam Unit 3999, for consideration of merger of reexamination control number 90/007,735 (the '735 proceeding) with the previously merged reexamination control numbers 90/006,493 (the '493 proceeding) and 90/006,680 (the '680 proceeding) pursuant to 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 5,819,172 issued on October 6, 1998.

2. The '493 reexamination proceeding is a Director Ordered reexamination proceeding that was ordered on December 26, 2002.

3. The '680 reexamination proceeding, filed on June 24, 2003, is a reexamination proceeding that was requested by a third party requester.

4. An order granting reexamination in the '680 reexamination proceeding was mailed on September 3, 2003.

5. The '493 and '680 proceedings were merged to provide a single consolidated proceeding on May 26, 2004.

6. A non-final Office action was mailed on June 21, 2005 in the previously merged proceedings.

7. A response to the June 21, 2005, Office action was timely filed on August 22, 2005. The response added claims 224 to 294 to the merged proceedings. However, the amendment was canceled following notification of fee deficiency in the Interview Summary mailed on November 18, 2005.

8. An amendment with proper fee was filed on November 25, 2005 in the '493 and '680 reexamination proceedings. The amendment canceled claims 224 to 294 and added claims 295 to 317.

9. A non-final Office action was mailed on December 30, 2005 in the previously merged proceedings.

10. The '735 proceeding was filed on September 28, 2005 by a third party requester.

11. The third party requester's correspondence address is the same in the '680 and '735 proceedings.

12. An order granting reexamination in the '735 reexamination proceeding was mailed on October 14, 2005.

13. There are no amendments to the '735 reexamination proceeding.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

> If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* reexamination has not been terminated, the *ex parte* reexamination proceedings will be consolidated and result in the issuance of a single certificate of a single certificate under § 1.570.

As noted , *supra*, reexamination was previously ordered in the '493 and '680 reexamination proceedings, and these proceedings have previously been merged. Reexamination has been ordered in the '735 proceeding.

As noted in the above noted facts, reexamination has been ordered in both of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is appropriate.

DECISION

In accordance with 37 C.F.R. § 1.565(c), the 90/006,493, 90/006,680 and 90/007,735 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

I. Requirements for Same Amendments in Both Proceedings

As noted above, the claims and specification have been amended in the '6,493 and '6,680 reexamination proceeding. Patent owner is required to maintain the same claims and specification in all merged files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in both files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

II. Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature, for entry in each file. All papers filed by the patent owner must be served on the requester and requester will be sent copies of all papers mailed by the Office.

CONCLUSION

Reexamination Control Nos. 90/006,493, 90/006,680 and 90/007,735 are **merged**. Patent owner has **one month** from the date of this decision to submit an appropriate "housekeeping" amendment. Upon receipt of the "housekeeping" amendment, an Office action will be issued in due course.

All correspondence regarding these proceedings should be submitted as follows:

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450

By Fax to: (571) 273-9900
Central Reexamination Unit

By Hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries with regard to this decision should be directed to Mark Reinhart, Special Program Examiner in the Central Reexamination Unit, Art Unit 3992, at (571) 272-1611

M Reinhart SPRE-CRU-3992 for
Lissi M. Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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ALEXANDRIA, VA 22313-1450
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William R. Wright
Sturm & Fix LLP
206 Sixth Avenue
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(For Patent Owner)

Novak Druce & Quigg LLP
1300 Eye Street NW
Suite 400 East Tower
Washington, DC 20005

(For Third Party Requester)

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CENTRAL REEXAMINATION UNIT

In re Campana, Jr. et al
Ex Parte Reexamination Proceeding
Control No.: 90/006,493
Filed: December 26, 2002
For: U.S. Patent No. 5,819,172

In re Campana, Jr. et al
Ex Parte Reexamination Proceeding
Control No. : 90/006,680
Filed: June 24, 2003
For: U.S. Patent No. 5,819,172

In re Campana, Jr. et al
Ex Parte Reexamination Proceeding
Control No.: 90/007,735
Filed: September 28, 2005
For: U.S. Patent No. 5,819,172

DECISION, *SUA SPONTE*, DISMISSING PETITION AND "RETURNING" IMPROPER PAPERS

This is a decision on the June 23, 2006 patent owner petition styled "Petition Pursuant to 37 CFR 1.181 or Alternatively, 37 CFR 1.182 OR Alternatively 37 CFR 1.183 to Reconsider Decision Returning Paper and Enter the Papers into the Official Record." [1]

The petition and the above-captioned reexamination proceedings are before the Office of Patent Legal Administration for consideration.

The petition is dismissed and its attachments are returned to the patent owner for the reasons discussed below.

[1] The present petition is, facially, fully treatable pursuant to the provisions of 37 CFR 1.181. Accordingly, it is manifestly unnecessary to consider the petition under either 37 CFR 1.182 or 37 CFR 1.183. No fee is required.

REVIEW OF SALIENT FACTS

1. U.S Patent number 5,819,172 ("the '172 patent") issued to Campana *et al* on October 6, 1998 from an application filed on April 23, 1997.

2. On December 26, 2002, a Director Initiated Order for Reexamination of the '172 patent mailed and assigned control number 90/006,493 ("the '493 reexamination proceeding").

3. On June 24, 2003, a request for ex *parte* reexamination of the '172 patent was filed by a third party requester, and assigned control number 90/006,680 ("the '680 reexamination proceeding").

4. On September 3, 2003, the examiner's Order Granting *Ex Parte* Reexamination for the '680 reexamination proceeding was mailed.

5. On May 26, 2004, the Technology Center Director issued a decision, *sua sponte*, by which the '493 reexamination proceeding and the '680 reexamination proceeding were merged into a single combined reexamination proceeding.

6. On September 28, 2005, a third request for *ex parte* reexamination of the '172 patent, which was assigned control number 90/007,735 ("the '735 reexamination proceeding").

7. On October 14, 2005, the examiner's Order Granting *Ex Parte* Reexamination for the '735 reexamination proceeding was mailed.

8. Following prosecution on the patentability of the '172 patent claims, a nonfinal rejection Office action was issued in the merged reexamination proceeding on December 30, 2005.

9. On January 4, 2006, a Freedom of Information Act ("FOIA") Request was made to the Office requesting the Office's communications with third parties regarding the present reexamination proceedings and pending reexamination proceedings being conducted on other of patent owner's patents.

10. The Office responded to the FOIA request through letters dated between February 8 and March 24, 2006. [2]

11. On February 28, 2006, patent owner filed a response to the nonfinal Office action of December 30, 2005.

12. On March 1, 2006 The Central Reexamination Unit (CRU) Director issued a decision, sua sponte, by which the "493 reexamination proceeding, the '680 reexamination proceeding and the '735 reexamination proceeding were merged into a single merged reexamination proceeding. [3],[4]

---

[2] An additional response to the FOIA request was mailed by the Office on June 15, 2006 and received by patent owner on June 16, 2006.

[3] Jurisdiction of the merged '493 and '680 reexamination proceedings had previously been transferred from the Technology Center to the CRU.

[4] The Image File Wrapper (IFW does not contain a copy of the February 28, 2006 response to the nonfinal Office action of December 30, 2005, notwithstanding the requirement in the March 1, 2006 decision merging the three reexamination proceedings that patent owner file a housekeeping amendment and maintain all three files identically.

13. On April 28, 2006, patent owner filed a supplemental amendment/response to the December 30, 2005 nonfinal Office action.

14. On May 17, 2006, the CRU Director mailed a decision returning the April 28, 2006 patent owner supplemental response to the nonfinal rejection noted in Fact 13 above without consideration on the merits. The return was based on the grounds that the papers filed were improper because they were not limited to consideration of prior patents and printed publications and also because portions were not in compliance with the 37 CFR 1.3 requirements for decorum and courtesy. Accordingly, the returned supplemental response was not entered into the record.

15. On May 22, 2006, patent owner filed a redacted version of the April 28, 2006 supplemental response, limited to material addressing the outstanding nonfinal rejection Office action, which has been entered into the IFW record.

16. On June 23, 2006, patent owner filed the present petition requesting reconsideration of the CRU Director's May 17, 2006 decision. Patent owner has attached to the petition the material that was refused entry and returned (by the CRU Director's May 17, 2006 decision), for entry into the record as part of patent owner's supplemental response to the February 28, 2006 nonfinal Office action.

DECISION DISMISSING THE THIRD PARTY REQUESTER PETITION AND RETURNING PAPERS FILED WITH THE PETITION

I. Relevant Statutes, Regulations and Practice

35 U.S.C. § 132 provides:

> "(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.
>
> (b) The Director shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant. The Director may establish appropriate fees for such continued examination and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under section 41(h)(1) of this title."

35 U.S.C. § 305 provides, in part:

> "After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent."

35 U.S.C. § 306 provides:

> "The patent owner involved in a reexamination proceeding under this chapter may appeal under the provisions of section 134 of this title, and may seek court review under the provisions of sections 141 to 145 of this title, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent."

37 CFR 1.3 provides:

"Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Director and will not be entered. A notice of the non-entry of the paper will be provided. **Complaints against examiners and other employees must be made in correspondence separate from other papers.**" [Emphasis added.]

37 CFR 1.4(c) provides:

"Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects."

37 CFR 1.111(b) provides:

"In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section."

37 CFR 1.181(a)(1) provides that petition may be taken to the Director:

"**From any action** or requirement of any examiner in the ex parte prosecution of an application, or **in ex parte** or inter partes prosecution **of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court.**" [Emphasis added.]

37 CFR 1.550(a) and (b) provide, in part:

"(a) All *ex parte* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office. **After issuance of the *ex parte* reexamination order and expiration of the time for submitting any responses, the examination will be conducted in accordance with §§ 1.104 through 1.116** and will result in the issuance of an *ex parte* reexamination certificate under § 1.570. [Emphasis added.]

(b) The patent owner in an *ex parte* reexamination proceeding will be given at least thirty days to respond to any Office action. **In response to any rejection,** such response may include further statements and/or proposed amendments or new claims to place the patent in a condition where all claims, if amended as proposed, would be patentable." [Emphasis added.]

MPEP § 2267 provides in part:

"The return of inappropriate submissions complies with the regulations that certain papers will not be considered and also reduces the amount of paper which would ultimately have to be scanned into the record.

I. DISPOSITION OF PAPERS
Where papers are filed during reexamination proceedings which are inappropriate because of some defect, such papers will either be returned to the sender or forwarded to one of three files, the "Reexamination File" (paper file or IFW file history), the "Patent File" (paper file or IFW file history), or the "Storage File" (paper file). Any papers returned to the sender from a Technology Center (TC) must be accompanied by a letter indicating signature and approval of the TC Director." [5]

II. Findings and Analysis

On February 28, 2006, patent owner filed a response to the nonfinal action dated December 30, 2005. On April 28, 2006, patent owner thereafter filed a supplemental response to the nonfinal action dated December 30, 2005. That paper was returned to patent owner by the decision of the CRU Director dated May 17, 2006, on the grounds that the supplemental response was an improper paper. The basis of this holding was that the supplemental response included statements and documents that were improper because they were not limited to consideration of prior patents and printed publications, and also because portions were not in compliance with 37 CFR 1.3 requirements for decorum and courtesy. Patent owner was invited, in the May 17, 2006 decision returning papers, to submit a redacted supplemental response, and patent owner has in fact filed a redacted version of that supplemental response (the redacted version has been entered into the record).

Patent owner has now attached to the present petition a set of papers to be added to the record as a part of a supplemental response to the December 30, 2005 nonfinal action, which would be available for the examiner's consideration in evaluating the patent owner's supplemental response. Patent owner requests by way of the present petition that these papers be entered into the IFW record to provide a complete administrative record. [6] It is patent owner's position that:

(1) There was no legal basis for the CRU Director's return of the April 28, 2006 supplemental response papers;

(2) The grounds for such return as expressed in the CRU Director's decision returning the papers were erroneous;

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[5] When the CRU has jurisdiction, as in the case of this merged proceeding, the CRU Director would approve and sign the letter accompanying returned papers.

[6] This would result in the commingling of the now-proffered set of papers with material that the examiner will have to consider.

(3) The patent owner is entitled to argue and provide documents to allege that the December 30, 2005 nonfinal action is an improper action based on allegations of misconduct and bias.

(4) Due process requires that the Office accept the unredacted supplemental response and related FOIA evidence. [7]

It is also noted that patent owner argues that the CRU Director's decision returning the April 28, 2006 supplemental response to the nonfinal action dated December 30, 2005 was inconsistent with a prior petition decision dated March 20, 2006 denying a patent owner petition filed on January 23, 2006. [8] This argument will be separately addressed, *infra*.

A. The April 28, 2006 Supplemental Response Was An Improper Paper, The Supplemental Response Attached To The Present Petition Is An Improper Paper, And Both Papers Lack An Entry Right In The Merged Reexamination Proceeding

Pursuant to 35 U.S.C. § 306, an issue directed to the merits of a rejection in an *ex parte* reexamination proceeding is ultimately appealable to the Patent and Trademark Office Board of Patent Appeals and Interferences. On the other hand, pursuant to 37 CFR 1.181(a), a petition to the USPTO Director is the appropriate vehicle to resolve matters not subject to appeal. It is further to be noted that, pursuant to 37 CFR 1.4(c), different matters raised in a given proceeding must be raised in separate papers. Finally, pursuant to 37 CFR 1.3, complaints against examiners and other Office employees "must be made in correspondence separate from other papers" which are not directed to complaints against examiners and other Office employees.

In the present instance, a review of the papers attached to the present petition indicates that (1) the papers are essentially the same as, if not identical to, the papers that were returned by the CRU Director's May 17, 2006 decision, and (2) these papers purport to be a supplemental response to the examiner's treatment of the pending claims in light of the prior art patents and publications applied to the claims by the examiner in the nonfinal action dated December 30, 2005. Pursuant to 37 CFR 1.550(a) (the rule that implements 35 U.S.C. § 305), *ex parte* reexamination proceeding is "conducted in accordance with [37 CFR] §§ 1.104 through 1.116." Therefore, the appropriate content of a 37 CFR 1.550(b) response to a nonfinal Office action in an *ex parte* reexamination proceeding is defined by 37 CFR 1.111. Subsection (b) of 37 CFR 1.111 does not (contrary to petitioner's argument) provide for "further statements" that are unrestricted as to content. Instead, 37 CFR 1.111(b) requires that a response to a nonfinal action address the issue of patentability of the pending claims with respect to the outstanding rejection, which, in this instance, is the examiner's treatment of the patentability of the claims in light of prior patents and printed publications. In contrast, the papers attached to the present petition include material directed to issues other than the examiner's treatment of the patentability of the claims in light of prior patents and printed publications. In fact, large portions of the remarks contained in the supplemental response to the nonfinal action [9] and documents cited in support are directed to the conduct of Office employees/officials. Thus,

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[7] Petition at pages 10 *et. seq.*

[8] The petition and decision thereon referenced by patent owner are apparently those in the file records of *ex parte* reexamination control number 90/006,495 and *inter partes* reexamination proceeding 95/000,020, which have been merged into a single reexamination proceeding.

[9] See, *e.g.*, the arguments at page 74-92 of the supplemental response. Note that even a single instance of an argument directed to matters that are not part of a proper response to a nonfinal action within the meaning of 37 CFR 1.111(b) would suffice to preclude entry of the entire supplemental response as lacking an entry right.

large portions of the papers attached to the present petition, are not directed to issues of patentability of the pending claims in light of the applied prior art patents and printed publications. Therefore, these papers clearly constitute responses to the outstanding nonfinal Office action that are not proper under 37 CFR 1.550(b) and do not fall within the jurisdiction of the examiner. Accordingly, each of these papers submitted in response to the Office action lacks an entry right in the present merged reexamination proceeding for consideration by the examiner.

Further, 37 CFR 1.3 expressly precludes "complaints against examiners and other employees" submitted as part of papers directed to other matters. Thus, the patent owner's submission of documents in support of its allegations of misconduct and bias could not properly be included with papers directed to the question of patentability in view of prior art, because the clear and unequivocal language of 37 CFR 1.3 expressly requires that "employee conduct" issues are to be raised in correspondence separate from other papers. Here, patent owner improperly raises allegations of employee misconduct incorporated within papers directed to the merits of the examiner's position on the patentability of the pending claims in light of patents and printed publications as set forth in the nonfinal Office action. Therefore, the originally filed April 28, 2006 supplemental response and the supplemental response attached to the present petition are both improper for the reason that they fail to comply with the requirements of 37 CFR 1.3. Accordingly, each paper further lacks an entry right in the present merged reexamination proceeding for consideration by the examiner.

Moreover, 37 CFR 1.4(c) requires that different matters in a given proceeding appropriate for consideration by different branches within the Office must be raised in separate papers. However, patent owner's April 28, 2006 supplemental response to the nonfinal action improperly presented, in the same paper, both:

(1) arguments and materials directed to the patentability of the claims in view of the patents and printed publications applied in the nonfinal Office action, and

(2) allegations of employee misconduct and bias.

The patentability arguments are properly considered by the examiner. In contrast, allegations of employee misconduct and bias are considered by way of a petition to the appropriate Office official for the exercise of supervisory authority pursuant to 37 CFR 1.181(a), because alleged employee misconduct and bias relate to non appealable subject matter. Thus both the originally filed April 28 2006 supplemental response as well as the supplemental response attached to the present petition are improper for the additional reason that they fail to comply with the requirements of 37 CFR 1.4(c).

Therefore, for the foregoing reasons, the April 28, 2006 patent owner supplemental response, and the June 23, 2006 supplemental response attached to the present patent owner petition are deemed improper. Therefore these papers lack an entry right in the present merged reexamination proceeding. The disposition of improper papers will be treated as discussed in Section C., *infra*.

B. Further Discussion

1. While the patent owner's April 28, 2006 supplemental response to the December 30, 2005 nonfinal action and the supplemental response to the nonfinal action attached to the present petition each lack an entry right for consideration by the examiner as explained in Section II(A),

patent owner may raise the issue of alleged employee misconduct by way of petition under 37 CFR 1.181(a). Note is taken of patent owner's statement that on March 20, 2006, the Office issued a decision in a separate proceeding, such decision denying a patent owner petition filed on January 23, 2006. [10] Patent owner correctly states that the January 23, 2006 petition was denied because it did not provide sufficient details. However, if patent owner is able to now supply those details, they must be submitted in a separate petition under 37 CFR 1.181, but cannot be submitted as part of a paper submitted for consideration by the examiner.

2. Patent owner's characterization of the May 17, 2006 decision issued by the CRU Director returning the April 28, 2006 supplemental response to the nonfinal Office action of December 30, 2005 is not wholly accurate. In actuality, the CRU Director's May 17, 2006 decision did not mean to imply that the FOIA papers would be barred from submission for any and all purposes. Rather, it properly points out that the papers were returned because they raised issues unrelated to patentability and therefore are not appropriate for consideration by the examiner. Therefore, the submitted papers did not comply with the regulations and practice regarding the submission of <u>response</u> papers. [11]

3. To the extent that patent owner disagrees with some or all of the rationale set forth in support of the CRU Director's decision, Section II(A) of the present decision amplifies the reasons in support of the conclusion reached in the CRU Director's May 17, 2006 decision to refuse entry and return the April 28, 2006 supplemental response with attached papers. Section II(A) of the present decision explains that the patent owner may indeed raise alleged employee misconduct and bias issues, but must do so via a separate petition under 37 CFR 1.181. Such a petition must conform to the governing regulations and practice, i.e., the petition regarding alleged employee misconduct must not be attached to papers directed to the substantive issue of claim patentability in light of the prior patents and printed publication. See 37 CFR 1.3 and 37 CFR 1.4(c).

4. As a final point on this matter, patent owner is not being deprived of due process by a refusal to accept papers that mingle allegations of misconduct (and documents supporting those allegations) with papers that are directed to other matters. Papers raising issues of alleged misconduct, and documents proffered in support of such allegation, are admissible in the Office only if they are provided in a manner that complies with the regulations.

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[10] See footnote 8, *supra*.

[11] Considering the fact that the papers in question were styled as a supplemental response to the nonfinal Office action, the material beginning at the last paragraph of page 2 of the May 17, 2006 CRU Director's decision and running through page 3 thereof indicates to the undersigned that the CRU Director was concerned with the mingling of prior art patent and printed publication patentability issues with the procedural issues raised by the allegations of misconduct and bias of raised in papers.

C. Disposition Of Papers

1. In this instance: (1) the April 28, 2006 presentation of the FOIA papers, (2) the April 28, 2006 declaration of Keith Anderson directed the FOIA papers, and (3) the remarks directed to the conduct of Office employees/officials that were included within the April 28, 2006 supplemental response to the nonfinal action have previously been found to be improper, and lacking an entry right in the present merged proceeding. These papers were previously returned, and a redacted form of these papers was entered into the record, as discussed above.

2. In addition, the patent owner has attached to the present petition the material that was refused entry and returned (by the CRU Director's May 17, 2006 decision), for entry into the record as part of patent owner's supplemental response to the December 30, 2005 Office action. These papers have now been found to be improper and therefore lack an entry right in the present merged proceeding to which they are directed. As these papers are determined to lack an entry right in the present merged reexamination proceeding, they will be returned in accordance with provisions of MPEP § 2267. In this instance it would be unduly burdensome to either physically return the large bulk of papers, or expend significant Office resources scanning the documents into the record and then closing them from view. [12] Therefore, the papers are being temporarily held for "pick up" in the Central Reexamination Unit (CRU). If the patent owner desires the physical return of the papers, then patent owner should promptly make arrangements to pick up the papers from the CRU **within one month** of the mailing date of this decision. Patent owner should immediately notify Norma Amador of the CRU, at telephone number (571) 272-6474, of any arrangements that have been made to pick up the papers. If the papers are **not** picked up **within one month** of the mailing date of this decision, **the CRU will dispose of the papers,** note being taken that the patent owner presumably has the originals.

3. As to the present petition, the petition contains facial allegations of employee misconduct and bias. Accordingly, though the petition itself will be retained of record in the IFW file, it is being marked as "non-public."

CONCLUSION

1. The June 23, 2006 patent owner petition is dismissed.

2. The (1) the April 28, 2006 presentation of the FOIA papers, (2) the April 28, 2006 declaration of Keith Anderson directed the FOIA papers, and (3) the remarks directed to the conduct of Office employees/officials that were included within the April 28, 2006 supplemental response to the nonfinal action have been found to be improper papers lacking an entry right in the present merged proceeding to which they are directed. These papers were proper returned to patent owner.

3. The papers attached to the present petition, which appear to be the material that was refused entry and returned by the CRU Director's May 17, 2006 decision will be held for one month in the CRU in a single storage location, and thereafter will be discarded if not picked up by patent owner.

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[12] Patent owner has filed at least six other petitions corresponding to the present petition, and provided such papers as attachments to each filed petition.

4. The present petition will be retained of record in the IFW file and is being marked as "non-public."

5. A copy of this decision is being made of record in the merged reexamination proceeding, and the decision will therefore appear in the IFW record of *ex parte* reexamination proceedings 90/006,493, 90/006,680 and 90/007,735.

6. **<u>All</u> correspondence relating to an *inter partes* reexamination proceeding should be directed to:**

By Mail to: Mail Stop *Ex Parte* Reexam
ATTN: Central Reexamination Unit
Office of Patent Legal Administration
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
Central Reexamination Unit

By hand: Customer Service Window
ATTN: Central Reexamination Unit
Randolph Building
401 Dulany St.
Alexandria, VA 22314

8. Telephone inquiries with regard to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or, in his absence, to the undersigned at (571) 272-7710.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

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August 9, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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ALEXANDRIA, VA 22313-1450
www.uspto.gov

William R. Wright
Sturm & Fix LLP
206 Sixth Avenue
Des Moines, IA 50309-4076

(For Patent Owner)

FAX RECEIVED

MAR 0 9 2007

CENTRAL REEXAMINATION UNIT

Novak Druce & Quigg LLP
1300 Eye Street NW
Suite 400 East Tower
Washington, DC 20005

(For Third Party Requester)

In re Campana, Jr. et al
Ex Parte Reexamination Proceeding
Control No.: 90/006,493
Filed: December 26, 2002
For: U.S. Patent No. 5,819,172

In re Campana, Jr. et al
Ex Parte Reexamination Proceeding
Control No.: 90/006,680
Filed: June 24, 2003
For: U.S. Patent No. 5,819,172

In re Campana, Jr. et al
Ex Parte Reexamination Proceeding
Control No.: 90/007,735 ✓
Filed: September 28, 2005
For: U.S. Patent No. 5,819,172

DECISION DENYING PETITION

This is a decision on the October 23, 2006 patent owner petition styled "Petition Pursuant to 37 CFR 1.181 or Alternatively, 37 CFR 1.182 Or Alternatively 37 CFR 1.183 to Reconsider Decision, *Sua Sponte*, 'Returning' Improper Papers and Alternatively That the Commissioner Declare His Decision A Final Agency Action." [1,2]

The petition and the above-captioned reexamination proceedings are before the Office of Patent Legal Administration for consideration.

[1] The present petition paper is fully treatable pursuant to 37 CFR 1.181, and it is thus unnecessary to consider the petition paper under either 37 CFR 1.182 or 37 CFR 1.183. A petition fee is not required.
[2] The present paper will hereinafter be referred to as "Petition for Reconsideration."

The petition is granted to the extent that (1) the "Decision, *Sua Sponte*, Dismissing Petition and 'Returning' Improper Papers" [3] dated August 23, 2006, has been reconsidered, and (2) the present decision has been designated as a final agency action under 35 U.S.C. § 704. For the reasons discussed below, the underlying relief requested by petitioner patent owner is denied.

REVIEW OF SALIENT FACTS

1. U.S Patent number 5,819,172 ("the '172 patent") issued to Campana *et al* on October 6, 1998, from an application filed on April 23, 1997.

2. On December 26, 2002, a Director Initiated Order for Reexamination of the '172 patent was mailed. The resulting *ex parte* reexamination proceeding was assigned control number 90/006,493 ("the '493 reexamination proceeding").

3. On June 24, 2003, a request for a second ex *parte* reexamination of the '172 patent was filed by a third party requester, and the resulting proceeding was assigned control number 90/006,680 ("the '680 reexamination proceeding").

4. On September 3, 2003, an examiner's Order Granting *Ex Parte* Reexamination was mailed for the '680 reexamination proceeding.

5. On May 26, 2004, the Technology Center Director issued a decision, *sua sponte*, by which the '493 reexamination proceeding and the '680 reexamination proceeding were merged into a single consolidated reexamination proceeding.

6. On September 28, 2005, a request for a third *ex parte* reexamination of the '172 patent was filed. The resulting proceeding was assigned control number 90/007,735 ("the '735 reexamination proceeding").

7. On October 14, 2005, the examiner's Order Granting *Ex Parte* Reexamination was mailed for the '735 reexamination proceeding.

8. On December 30, 2005, a nonfinal rejection Office action was issued in the merged '493 - '680 reexamination proceeding.

9. On January 4, 2006, a Freedom of Information Act ("FOIA") Request was made to the Office requesting the Office's communications with third parties regarding the present reexamination proceedings, as well as pending reexamination proceedings being conducted on other of patent owner's patents.

10. The Office responded to the FOIA request through letters dated between February 8 and March 24, 2006. [4]

11. On February 28, 2006, patent owner filed a response to the nonfinal Office action of December 30, 2005.

12. On March 1, 2006, the Central Reexamination Unit (CRU) Director issued a decision, *sua*

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[3] Hereinafter "Decision Dismissing Petition."

[4] An additional response to the FOIA request was mailed by the Office on June 15, 2006, and received by patent owner on June 16, 2006.

sponte, by which the "493 reexamination proceeding, the '680 reexamination proceeding and the '735 reexamination proceeding were merged into a single consolidated reexamination proceeding. [5]

13. On April 28, 2006, patent owner filed a supplemental amendment/response to the December 30, 2005 nonfinal Office action.

14. On May 17, 2006, the CRU Director mailed a decision returning the April 28, 2006 patent owner supplemental amendment/response to the nonfinal rejection without consideration on the merits. The return was grounded on the impropriety of the papers, because they were not limited to consideration of prior patents and printed publications, and also because portions of the submission were not in compliance with the requirements of 37 CFR 1.3. Accordingly, the returned supplemental response was not entered into the record.

15. On May 22, 2006, patent owner filed a redacted version of the April 28, 2006 supplemental amendment/response, which is limited to material addressing the outstanding nonfinal rejection Office action, and which has been entered into the IFW record for the merged proceeding.

16. On June 23, 2006, patent owner filed a petition requesting reconsideration of the CRU Director's May 17, 2006 decision. Patent owner attached to the petition the material that had been refused entry and returned (by the CRU Director's May 17, 2006 decision), and requested entry of that material into the record, as part of patent owner's supplemental response to the December 30, 2005 nonfinal Office action.

17. On August 23, 2006, the June 23, 2006 patent owner petition was dismissed, [6] and was "returned" to petitioner by permitting petitioner to schedule a time to pick up the material (together with similar material from other concurrently filed related petitions). [7]

18. On October 23, 2006, petitioner patent owner filed the present Petition for Reconsideration of the August 23, 2006 petition decision.

DECISION

I. Relevant Statutes, Regulations and Practice

35 U.S.C. § 132 provides:

> "(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.
>
> (b) The Director shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant. The Director may establish appropriate fees for such continued

[5] Jurisdiction of the merged '493 and '680 reexamination proceedings had previously been transferred from the Technology Center to the CRU.

[6] See discussion at pages 5-7, *infra*.

[7] No such pick up was scheduled, and none was made.

examination and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under section 41(h)(1) of this title."

35 U.S.C. § 301 provides in pertinent part:

"Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent."

35 U.S.C. § 302 provides in pertinent part:

"Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title."

35 U.S.C. § 303(a) provides in pertinent part:

"Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications."

35 U.S.C. § 305 provides, in pertinent part:

"After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent."

35 U.S.C. § 306 provides:

"The patent owner involved in a reexamination proceeding under this chapter may appeal under the provisions of section 134 of this title, and may seek court review under the provisions of sections 141 to 145 of this title, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent."

37 CFR 1.3 provides:

"Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Director and will not be entered. A notice of the non-entry of the paper will be provided. **Complaints against examiners and other employees must be made in correspondence separate from other papers.**" [Emphasis added.]

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"Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects."

37 CFR 1.111(b) provides:

"In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a

bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section."

37 CFR 1.181(a)(1) provides that petition may be taken to the Director:

"**From any action** or requirement of any examiner in the *ex parte* prosecution of an application, or **in** *ex parte* or *inter partes* prosecution **of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court.**" [Emphasis added.]

37 CFR 1.550(a) and (b) provide, in pertinent part:

"(a) All *ex parte* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office. **After issuance of the *ex parte* reexamination order and expiration of the time for submitting any responses, the examination will be conducted in accordance with §§ 1.104 through 1.116** and will result in the issuance of an *ex parte* reexamination certificate under § 1.570. [Emphasis added.]

(b) The patent owner in an *ex parte* reexamination proceeding will be given at least thirty days to respond to any Office action. **In response to any rejection**, such response may include further statements and/or proposed amendments or new claims to place the patent in a condition where all claims, if amended as proposed, would be patentable." [Emphasis added.]

MPEP § 2267 provides in pertinent part:

"The return of inappropriate submissions complies with the regulations that certain papers will not be considered and also reduces the amount of paper which would ultimately have to be scanned into the record.

I. DISPOSITION OF PAPERS
Where papers are filed during reexamination proceedings which are inappropriate because of some defect, such papers will either be returned to the sender or forwarded to one of three files, the "Reexamination File" (paper file or IFW file history), the "Patent File" (paper file or IFW file history), or the "Storage File" (paper file). Any papers returned to the sender from a Technology Center (TC) must be accompanied by a letter indicating signature and approval of the TC Director." [8]

II. Basis For The August 23, 2006 Decision

On April 28, 2006, patent owner filed a supplemental amendment/response to an outstanding Office action dated December 30, 2005. That paper was returned to patent owner without consideration on the merits as an inappropriate submission. [9] The paper was considered to be inappropriate by the Central Reexamination Unit Director, (1) because the paper was not limited to consideration of prior patents and printed publications, [10] and (2) because portions of that paper were not in compliance with the requirements of 37 CFR 1.3. On June 23, 2006, patent owner requested reconsideration of the return of those papers by way of a petition for reconsideration. Patent owner attached to that petition for reconsideration the material that had previously been refused entry. A decision issued August 23, 2006, setting forth in detail the basis for refusing the underlying relief requested in the June 23, 2006 request for reconsideration, and for again returning the material that was not proper for entry into the record of the present merged reexamination proceeding.

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[8] When the CRU has jurisdiction, as in the case of this merged proceeding, the CRU Director would approve and sign the letter accompanying returned papers.
[9] See MPEP § 2267.
[10] See 35 U.S.C. §§ 301-303.

It was pointed out in the August 23, 2006 decision, in explanation of why the underlying relief requested by petitioner would not be appropriate, that:

> A) Pursuant to 35 U.S.C. § 306, an issue directed to the merits of a rejection in an *ex parte* reexamination proceeding is ultimately appealable to the Patent and Trademark Office Board of Patent Appeals and Interferences (the Board). On the other hand, pursuant to 37 CFR 1.181(a), a petition to the USPTO Director is the appropriate vehicle to resolve matters not subject to appeal.
>
> B) Pursuant to 37 CFR 1.3, complaints against examiners and other Office employees "must be made in correspondence separate from other papers" which are not directed to complaints against examiners and other Office employees.
>
> C) Pursuant to 37 CFR 1.4(c), different matters raised in a given proceeding must be raised in separate papers.

These points have not been persuasively addressed in the present request for reconsideration.

A. The April 28, 2006 Papers Did Not Comply With 37 CFR 1.111

The April 28, 2006 papers purported to be a supplemental amendment/response directed to the outstanding nonfinal Office action dated December 30, 2005. Pursuant to 37 CFR 1.550(a), the present merged reexamination proceeding is to be conducted in accordance with sections 1.104 through 1.116 of Title 37 of the Code of Federal Regulations. Those regulations implement the provisions of 35 U.S.C § 132. 37 CFR 1.111(b) specifically requires that a response to a nonfinal Office action address issues of patentability of the pending claims that are subject to an outstanding rejection. The April 28, 2006 papers did contain material directed to the issue of the patentability of the claims of the patents being reexamined that are required to be resolved by appeal to the Board. However, the April 28, 2006 papers also contained comments and documents that were not directed to the merits of the outstanding rejection (*i.e.*, not directed to appealable matters). These additional comments and documents were instead directed to matters of alleged misconduct on the part of Office employees/officials, and requested relief that is only available by way of petition to the USPTO Director, and not by an appeal to the Board.[11] Accordingly, the April 28, 2006 papers failed to comply with 37 CFR 1.111.

Petitioner is also referred to MPEP § 1201 which states, in pertinent part:

> Where the differences of opinion concern the denial of patent claims because of prior art or other patentability issues, the questions thereby raised are said to relate to the merits, and appeal procedure within the Office and to the courts has long been provided by statute (35 U.S.C. 134).
> The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Director of the U.S. Patent and Trademark Office (Director) should be carefully observed. The Board will not ordinarily hear a question that should be decided by the Director on petition, and the Director will not ordinarily entertain a petition where the question presented is a matter appealable to the Board.

In this instance, the entry of the additional comments and documents directed to matters of alleged misconduct on the part of Office employees/officials would inappropriately place

[11] See, for example, the arguments at page 74-92 of the supplemental response filed April 28, 2006, that was to be disposed of if not "picked up" by the patent owner in accordance with the August 23, 2006 Decision on Petition. Note that even a single instance of an argument directed to matters that are not part of a proper response to a nonfinal action within the meaning of 37 CFR 1.111(b) would suffice to preclude entry of the entire supplemental response as lacking an entry right.

materials unrelated to the merits of patentability before the examiner. Not only would entry of these materials confuse and overburden the record, but also these materials simply are not permitted to be, and will not be, made available for consideration by the examiner in determining the patentability of the claims.

B. The April 28, 2006 Papers Did Not Comply With 37 CFR 1.3

37 CFR 1.3, last sentence, prohibits the submission of "complaints against examiners and other employees" of the Office as a part of papers directed to other matters before the Office. The "returned" April 28, 2006 papers included complaints regarding the conduct of Office employees, and these complaints were submitted as part of papers directed to other matters, *i.e.*, the issues of claim patentability in this merged proceeding. Accordingly, the April 28, 2006 papers are barred by 37 CFR 1.3.

C. The April 28, 2006 Papers Did Not Comply With 37 CFR 1.4(c)

37 CFR 1.4(c) requires that, within a given proceeding, material directed to matters that will be considered by different branches within the Office be raised in separate papers. Yet, the April 28, 2006 papers included complaints regarding conduct together with material directed to the issues of claim patentability, notwithstanding that these separate issues are decided by different branches of the Office and resolved by different appellate review tribunals: (1) decision on petition to the USPTO Director and (2) consideration by the Primary Examiner which may ultimately be reviewed by the Board. Accordingly, the April 28, 2006 papers are barred by 37 CFR 1.4(c).

III. Findings And Analysis With Respect To The Present Petition For Reconsideration

A. Patent Owner's Position Is Fundamentally Flawed

Petitioner patent owner argues that there has been improper conduct on the part of Office employees. [12] Patent owner apparently also believes that it has evidence of bias specifically on the part of one or more examiners, [13] and that this evidence, as previously submitted on April 28, 2006, should not be barred from examiner consideration because it bears on issues of patentability. Thus, petitioner patent owner urges that 37 CFR 1.3 should not preclude presentation to the examiner of the material alleging bias (even where bias alleged on the part of the examiner is alleged), because bias bears on patentability issues. Similarly, patent owner argues that 37 CFR 1.4(c) is inapplicable, because evidence of bias addresses the same patentability issues as the remainder of patent owner's substantive reply. [14]

Initially, patent owner has not shown how bias will change whether a claim is patentable over a reference or not. If the patent owner believes that there is a bias that would influence an examiner involved, or another Office employee conducting the examination of the claims for patentability, the proper avenue to address that would be via a 37 CFR 1.182 petition to remove the examiner or other Office employee, not by presenting the allegation of bias to the accused examiner for determination. Also, patent owner's position **assumes** that the evidence presented by patent owner **actually establishes bias**. However, the question of whether the material presented by patent owner in support of patent owner's allegations of bias in fact establishes

[12] See pages 3-4 of the present Petition for Reconsideration.
[13] See, for example, the headings on pages 4 and 7 of the present Petition for Reconsideration.
[14] See pages 7-9 of the present Petition for Reconsideration.

bias on the part of any Office personnel is an open question that has not yet been decided. Patent owner further assumes that the examiner is the appropriate Office employee to view alleged evidence of bias on the part of Office officials (and on the part of the examiner) in order to make a finding that bias in fact existed. However, the examiner's authority extends to making patentability determinations. The examiner does not exercise supervisory authority with respect to the alleged bias or misconduct on the part of other Office employees.

Pursuant to 35 U.S.C. § 306, an issue directed to the merits of a rejection in an *ex parte* reexamination proceeding is ultimately appealable to the Board, and then to the courts. All matters not subject to appeal to the Board under 35 U.S.C. § 306 are subject to resolution by way of petition under 37 CFR 1.181. Further, 37 CFR 1.3 prohibits complaints about employee conduct to be included within the same papers addressing the merits of patentability. Therefore, the proper avenue for obtaining review of an allegation of procedural impropriety, misconduct or bias on the part of Office personnel would be through petition to appropriate Office officials (as pointed out above). Any decision on such a petition that is adverse to patent owner would be subject to court review in the same manner as any other question of administrative procedure would be reviewed. [15] It is not reasonable to state that the evidence **alleged** to support bias on the part of Office officials, and/or on the part of the examiner, should be placed into the record of the present merged reexamination proceeding before the examiner for review and evaluation by the examiner as part of a patentability determination. Further, some of the allegations of bias are directed to the conduct of the examiner, making it far from clear that the examiner could objectively evaluate the allegations of the examiner's own bias. Yet, as noted above, patent owner appears to have raised the argument that the evidence of examiner bias should be forwarded to the examiner for consideration. Such consideration has, to date, been refused solely on the basis that patent owner has filed a single paper that conflated and intermingled these issues, rather than filing two separate papers that are each directed only to the area of the Office that would properly consider only that paper. [16]

By way of expansion on the above discussion, patent owner is reminded that patent examiners are Office personnel who are charged with evaluating evidence bearing on questions of patentability. In the present merged reexamination proceeding, the examiner's consideration of patentability is limited by 35 U.S.C. §§ 301 – 303 to a consideration of prior patents and printed publications. [17] Examiners are not charged with evaluating evidence of impropriety, misconduct or bias, by examiners or other Office personnel. Also, until the patent owner's evidence and allegations of misconduct are properly evaluated by the appropriate Office personnel, they cannot have any affect on action taken by the Office.

As a final point, patent owner is not being deprived of due process by a refusal to accept papers that co-mingle allegations of misconduct (and documents supporting those allegations) with papers that are directed to other matters. Papers raising issues of alleged misconduct, and documents proffered in support of such allegation, are admissible in the Office, and can properly be submitted for consideration by the Office, but only if they are provided in a manner that complies with the regulations.

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[15] Non-appealable subject matter reviewed by petition under 37 CFR 1.181 is subject to judicial review under the Administrative Procedures Act.

[16] Given that reexaminations are conducted with special dispatch, it is puzzling that patent owner has not seen fit to comply with the relatively straightforward and simple requirements of the 37 CFR 1.3 and 1.4(c) by filing two separate papers, since by doing so, patent owner would have immediately placed before the proper areas of the Office both the conduct issues and the substantive patentability issues for consideration by the appropriate Office personnel.

[17] Extrinsic evidence explaining the content of prior patents and printed publications may be considered as well.

B. 37 CFR 1.3 and 37 CFR 1.4(c) Each Precludes The Relief Requested By Petitioner Patent Owner

It is manifestly clear that both 37 CFR 1.3 and 37 CFR 1.4(c) each prohibit patent owner from co-mingling arguments directed to issues of the patentability of the claims with arguments and evidence in support of allegations of procedural impropriety and bias on the part of Office personnel. Those allegations are as yet unproven, and cannot be properly considered to presently establish any basis for reassignment of examining responsibilities. This is not the same as concluding that the regulations preclude **the presentation** of evidence of bias, as patent owner argues, [18] (notwithstanding that the Office has never taken such position [19]). The Office is not refusing to consider patent owner's alleged evidence, but simply is requiring that patent owner's evidence and allegations be presented in accordance with its rules which require them to be directed to the appropriate Office personnel for consideration and evaluation.

To the extent that the present petition again presents the allegation that 37 CFR 1.3 is inapplicable because patent owner has not violated decorum or been discourteous in this proceeding, [20] and also cites case law that is alleged to establish that 37 CFR 1.3 is inapplicable on the facts in this proceeding, patent owner is reminded that the August 23, 2006 Decision on Petition was in no manner based upon patent owner's conduct. Rather, 37 CFR 1.3 was applied because it requires that complaints of misconduct on the part of examiners and Office personnel "must be made in correspondence separate from other papers." [21] This language manifestly includes, as part of the class of "other papers" in which complaints of misconduct may not be raised, "papers directed to the merits of claim patentability in any proceeding in which the misconduct is alleged to have occurred."

Moreover, none of the case law cited by patent owner at page 5 of the present petition supports patent owner's position that 37 CFR 1.3 has been misapplied. Here, the Office is not prohibiting the patent owner from submitting evidence regarding its allegations; rather, the Office is simply directing material to the appropriate Office official for review of patent owner's complaint in accordance with the requirements established by 37 CFR 1.3 that employee conduct complaints "must be made in correspondence separate from other papers." None of the cases relied upon by patent owner demonstrate that the Office may not enforce the clear language of 37 CFR 1.3 by requiring papers containing complaints about the conduct of Office officials and personnel to be filed separately from other papers related to the merits of patentability.

Patent owner's argument that 37 CFR 1.4(c) should not prohibit examiner consideration of the merits of patent owner's arguments regarding the existence of bias is similarly fatally flawed. First, 37 CFR 1.4(c) does not preclude consideration of the merits of patent owner's allegations of bias, impropriety or misconduct on the part of Office officials and employees. The record does not show that the Office has taken the position that the allegations raised by patent owner cannot or will not be considered. 37 CFR 1.4(c) merely directs the orderly manner in which such allegations, and the evidence in support of such allegations, must be presented to the Office - for consideration by the proper Office officials. In this instance, 37 CFR 1.4(c) applies, because it requires that matters such as questions of bias or inappropriate conduct by Office personnel, which matters are appropriate for consideration by an Office official in one particular area of the Office, be submitted in a paper *separately* from papers containing substantive patentability issues, which are properly decided by a different Office official of

[18] See page 5 of the present petition, last sentence in the paragraph bridging pages 4 and 5.
[19] See for example, Decision Dismissing Petition dated August 23, 2006, section II(B), items 1 and 4.
[20] See the present petition, beginning at the bottom of page 4 and running through page 5.
[21] See Decision on Petition, August 23, 2006, page 7, first full paragraph.

employee in a different area of the Office. As pointed out above, the patent examiner is not the proper Office official to consider and rule on patent owner's allegations of bias, impropriety and misconduct; and thus, such allegations and materials supporting such allegations, are not proper for inclusion in the IFW record as a part of papers otherwise directed to patentability issues. The fact that the "examiner" is one of the employees that is accused of misconduct further highlights the appropriateness of the procedural safeguards provided by the rules. Clearly, the employee accused of alleged misconduct cannot be the official who will decide the issue. Moreover, the rule protects the integrity of the file history by separating employee complaints from the merits of examination.

Thus, 37 CFR 1.4(c) precludes entry of the papers submitted as a part of the June 23, 2006 petition, because the regulation properly requires that:

> matters bearing on the determination of patentability in this proceeding, and
>
> matters directed to a determination of the propriety of the allegations of misconduct, bias or impropriety on the part of Office officials and the examiner

be submitted in separate papers inasmuch as these issues are decided by different Office officials/employees in different areas of the Office.

C. 37 CFR 1.111 Precludes The Relief Requested By Patent Owner

37 CFR 1.111(b) provides that a response to a nonfinal Office action must, *inter alia*, specifically point out supposed errors in the examiner's action, and point out the specific distinctions believed to render the claims patentable over the prior art. The regulation does not provide for "further statements" that address matters other than the issues of patentability raised in the outstanding Office action. The failure of the April 28, 2006 patent owner submission to comply with 37 CFR 1.111(b) was discussed at pages 6-7 of the Decision Dismissing Petition dated August 23, 2006. It was pointed out that the April 28, 2006 patent owner submission was not confined to responding to the nonfinal Office action as required by 37 CFR 1.111(b), but instead intermingled matter directed to other issues (the issues of alleged misconduct on the part of Office personnel).

In the present petition patent owner has not directly addressed this point. To the extent that patent owner's general argument that the allegations of misconduct are in fact relevant to the issues of patentability, those arguments are wholly unpersuasive for the reasons set forth in Section III (A) above. Therefore, it is again concluded that the August 23, 2006 Decision Dismissing Petition properly refused entry of the April 28, 2006 patent owner as being non-compliant with 37 CFR 1.111(b).

CONCLUSION

1. The October 23, 2006 patent owner petition is granted to the extent that the August 23, 2006 Decision Dismissing Petition has been fully reconsidered, and that the present decision will be designated as a final agency decision.

2. The October 23, 2006 patent owner petition is denied with respect to disturbing the holding of the August 23, 2006 Decision Dismissing Petition which refused to enter the papers attached to patent owner's June 23, 2006 Petition and which "returned" those papers.

3. A copy of this decision is being made of IFW record for the merged reexamination

proceeding, and the decision will therefore appear in the IFW record of *ex parte* reexamination proceedings 90/006,493, 90/006,680 and 90/007,735.

4. Telephone inquiries with regard to this decision should be directed to Stephen Marcus, Legal Advisor, at (571) 272-7743, or, in his absence, to the undersigned at (571) 272-7710.

5. This decision is a final agency action within the meaning of 5 U.S.C. § 704.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

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February 22, 2007

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William R. Wright Sturm & Fix LLP 206 Sixth Avenue Des Moines, IA 50309-4076	:	For Patent Owner
Novak Druce & Quigg LLP 1300 Eye Street NW Suite 400 East Tower Washington, DC 2005	:	For Requester
In re Campana, Jr. et al. *Ex Parte* Reexamination Proceeding Control No. 90/006,493 Filed: December 26, 2002 For: US Patent No.5,819,172	:	DECISION GRANTING PETITION
In re Campana, Jr. et al. *Ex Parte* Reexamination Proceeding Control No. 90/006,680 Filed: June 24, 2003 For: US Patent No. 5,819,172	:	
In re Campana, Jr. et al. *Ex Parte* Reexamination Proceeding Control No. 90/007,735 Filed: September 28, 2005 For: US Patent No. 5,819,172	:	

MAILED

JUN 14 2007

CENTRAL REEXAMINATION UNIT

This is a decision on the May 25, 2007, "Petition Under 37 CFR 1.181 to Accept Previously Filed Papers" requesting that the Office accept as timely an appeal brief, evidence appendix, and information disclosure statement (IDS) submitted with the instant petition.

The petition is before the Director of the Central Reexamination Unit for consideration.

The petition is granted for the reasons set forth below.

Decision

A notice of appeal was received on October 23, 2006, so that an appeal brief was due by December 23, 2006. Patent Owner states that the required brief, evidence appendix, and also an IDS were timely filed on December 21, 2006, but were apparently lost by the Office.

Patent Owner's assertion is corroborated by a stamped postcard receipt from the USPTO, which indicates receipt of the appeal brief, evidence appendix, and IDS on December 21, 2006. Further, true and correct copies of the previously filed papers were submitted with the petition.

Accordingly, Patent Owner's petition is **GRANTED**, and the appeal brief, appendix, and IDS filed with the petition are accepted at timely.

Telephone inquiries with regard to this decision should be directed to Gregory Mills, Quality Assurance Specialist in the Central Reexamination Unit, at (571) 272-1439.

Lissi Mojica Marquis, for
Director
Central Reexamination Unit

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MEDTRONIC, INC.
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(For Patent Owner)

MAILED

JUL 17 2007

CENTRAL REEXAMINATION UNIT

Kevin W. King
Sutherland, Asbill & Brennan LLP
999 Peachtree Street, N.E.
Atlanta, Georgia 30309

(For Third Party Requester)

In re Reexamination Proceeding :
David L. Thompson :
Control No. 90/007,741 : DECISION GRANTING PETITION
Filed: September 30, 2005 :
U.S. Patent No. 6,571,125 :
Attorney Docket No. P000913.00 :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on June 20, 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 appeal fee - item 1), an authorization to charge counsel's deposit account for the $1,500.00 petition fee and for the $500.00 appeal fee (item 2), the requisite statement (item 3), a Certificate of Service on the Third Party Requester and an Amendment After Final.

The petition for entry of the late papers is granted.

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).

$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. 13-2546 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 June 20, 2007, and the Amendment After Final filed June 20, 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, Peter C. English, in CRU Art Unit 3993, 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, Senior Legal Advisor

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(For Patent Owner)

Kevin W. King
Sutherland, Asbill & Brennan LLP
999 Peachtree Street, N.E.
Atlanta, Georgia 30309

(For Third Party Requester)

In re Reexamination Proceeding :
David L. Thompson :
Control No. 90/007,741 : DECISION DISMISSING PETITION
Filed: September 30, 2005 :
U.S. Patent No. 6;571,125 :
Attorney Docket No. P000913.00 :

This is a decision on the petition under 37 CFR 1.182 filed by the patent owner on June 20, 2007, requesting that a decision be rendered recognizing that the claims in the reexamination proceeding are in condition for allowance.

The petition is before the Office of Patent Legal Administration (OPLA) for decision.

On June 20, 2007, *inter alia*, the present petition under 1.182 , an amendment after final rejection, an authorization to counsel's deposit account for the $400.00 petition fee and a Certificate of Service on the Third Party Requestor were filed. Petitioner states that the claims in the amendment filed on June 20, 2007, have been amended in accordance with the examiner's suggested changes. Petitioner requests that a decision be rendered recognizing that the claims in the reexamination proceeding are in condition for allowance.

A petition under 37 CFR 1.137(b) has been filed concurrently with this petition.

Examination of reexamination proceedings is provided for by statute, rules and is set forth in MPEP2200. A petition under 37 CFR 1.182 for a determination recognizing that the claims in the reexamination proceeding are in condition for allowance is a matter within the jurisdiction of the examiner, and as such, is not a petitionable matter.[1]

[1] Non-allowance of a claim is an appealable matter.

The petition is dismissed.

The $400.00 petition fee has been charged to counsel's deposit account no. 13-2546 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 in view of the decision on the petition under 37 CFR 1.137(b) being mailed concurrently with this decision.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Peter C. English, in CRU Art Unit 3993, 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, Senior Legal Advisor

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,742	09/30/2005	5479441	M-16197-RXUS	8342

27383 7590 02/24/2006

CLIFFORD CHANCE US LLP
31 WEST 52ND STREET
NEW YORK, NY 10019-6131

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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2/24/2006

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Edward C. Kwok

Macpherson Kwok Chen & Heid LLP

1762 Technology Drive Suite 226

San Jose CA 95121

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007742

PATENT NO. 5,479,441

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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CLIFFORD CHANCE US LLP 31 West 52nd Street. New York, NY 10019-6131	: : :	For Patent Owner
EDWARD C. KWOK Macpherson Kwok Chen & Heid LLP 1762 Technology Drive Suite 226 San Jose, CA 95121	: : : : :	For Requester
In re: LaRoy Tymes *et alia* *Ex Parte* Reexamination Proceeding Control No. 90/007,742 Filed: September 30, 2005 For: US Patent No. 5,479,441	: : : : :	
	: : : :	DECISION GRANTING PETITION FROM DENIAL OF REQUEST UNDER 37 CFR 1.515(c)

This is a decision on the timely filed Petition under 37 CFR 1.515 (c) regarding the Examiner's Determination Denying Ex Parte Reexamination. The timely filed petition was received January 13, 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 Third Party Requester has petitioned the Director of the Central Reexamination Unit, 3999 under 37 CFR 1.515 (c) to request that the USPTO decision denying the request for Reexamination should be vacated and that the Order be granted for reexamination of US Patent No. 5,479,441, reexamination proceeding control number 90/007,742.

37 CFR 1.515. Determination of the request for *ex parte* reexamination.

(c) The requester may seek review by a petition to the Director under § 1.181 within one month of the mailing date of the examiner 's determination refusing *ex parte* reexamination. Any such petition must comply with § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable.

Since the petition is granted the patent owner's statement is due according to 37 CFR 1.530.

§ 1.530 Statement by patent owner in *ex parte* reexamination

(a) Except as provided in § 1.510(e), no statement or other response by the patent owner in an ex parte reexamination proceeding shall be filed prior to the determinations made in accordance with § 1.515 or § 1.520. If a premature statement or other response is filed by the patent owner, it will not be acknowledged or considered in making the determination.
(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.

Analysis and Findings

On balance, it is considered that the petition explains the third party requester's reasoning for why a substantial new question of patentability should be raised with respect to the patent claims requested for reexamination in reexamination proceeding control number 90/007,742. The explanation for how the cited references would raise a substantial new question of patentability is considered persuasive and the Order Denying the request will be vacated and the request for reexamination Granted with this response.

The Patent Owner's statement is due 2-months from the mailing date of this response under 37 CFR 1.530.

MPEP 2248 suggests that the reexamination proceeding be reassigned. Accordingly, the reexamination proceeding will be reassigned to a different examiner.

This decision is final and nonappealable. 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

Conclusion

1. The third party requester's Petition filed under 37 CFR 1.515 (c) of January 13, 2006 for requesting withdrawal of the Order Denial and thus Granting the reexamination request in proceeding control number 90/007,742 is **granted**.

2. The Patent Owner's statement is due **2-months** from the mailing date of this response under 37 CFR 1.530.

3. Response by the Patent Owner may be submitted as follows:

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450

By Fax to: (571) 273-9900
Central Reexamination Unit

By Hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

4. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, Special Program Examiner in the Central Reexamination Unit, Art Unit 3992, at (571) 272-1611

MReinhart SPRE. CRU-3992 for
Lissi M. Marquis,
Director,
Central Reexamination Unit

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JAN 15 2008

CENTRAL REEXAMINATION UNIT

Robert E. Sokohl
Sterne, Kessler, Goldstein & Fox PLLC
1100 New York Ave., NW
Washington, DC 20005

(For Patent Owner)

Edward C. Kwok
MacPherson Kwok Chen & Heidi LLP
1762 Technology Dr., Suite 226
San Jose, CA 95110

(For Third Party Requester)

Ex parte LaRoy Tymes
Reexamination Proceeding
Control No.: 90/007,742
Filed: Sept. 30, 2005
For: U.S. Patent 5,479,441

: DECISION ON PETITION
: TO CONTINUE
: *EX PARTE*
: REEXAMINATION
: PROCEEDINGS

This is a decision on the December 19, 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 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) U.S. Patent No. 5,479,441 (the '441 patent) issued on Dec. 26, 1995.

2) The '441 patent has been the subject of four court proceedings, which are all now closed.

3) A request for *ex parte* reexamination of the '441 patent was filed by a third party requester on Sept. 30, 2005, and assigned control number 90/007,742 (the '7742 proceeding).

4) An Order granting reexamination in the '7742 proceeding was mailed on February

24, 2006. (The request was originally denied on Dec. 12, 2005, but was granted upon reconsideration after a petition was filed Jan. 13, 2006.)

5) There has been one non-final Office action in the '7742 proceeding. In addition, a final Office action was mailed September 21, 2007.

6) An examiner interview was conducted with patent owner on November 13, 2007.

7) Patent owner then responded to the final Office action on November 21, 2007.

8) On December 10, 2007, an advisory action was mailed indicating that the amendments to the claims filed after the final Office action would not be entered because they were directed to the merits of the patent and the patent owner failed to make a showing of good and sufficient reasons why the amendment was necessary and not earlier presented.

9) The present petition to request continued reexamination of the '441 patent was filed on December 19, 2007, along with a notice of appeal to allow sufficient time for a decision to made on this petition. The petition asserts that the amendment filed November 21, 2007, advances prosecution of the reexamination proceeding by amending the claims to explicitly recite the meaning of certain claim terms.

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 November 21, 2007 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 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

---

[1] Item 7 in the Review of Facts.

[2] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

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 believed prior to the final rejection that the claim language, as interpreted in view of the specification, was adequate to overcome the rejection and that an explanation to the Office of the claim interpretation would be a persuasive response. After the final rejection, patent owner realized that claim amendments would be required to overcome the rejection. In particular, in the amendment after the final Office action, the patent owner asserted that the amendments were not made previously, because the patent owner believed that the claim terms should be limited to the definitions set forth in the specification, which is asserted to be consistent with the claim construction followed in a concurrent (now closed) litigation, and thus required no amendment. 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 to support the argued claim interpretation is deemed a *bona fide* effort to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate. As such, the granting of the present petition is consistent with the requirement of 35 U.S.C. 305 to conduct reexamination proceedings "with special dispatch within the Office."

In view of the above and the fact situation presented by the present record, the petition is granted, and the prosecution in the above-noted reexamination proceeding is hereby continued. Prosecution is reopened for consideration of the November 21, 2007 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 November 21, 2007 Amendment After Final 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 '7742 *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 September 21, 2007 final Office action is withdrawn, and prosecution of the proceeding is reopened.

4) The November 21, 2007 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) 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

January 11, 2008
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[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.

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LAW OFFICE OF CHARLES E. KRUEGER
P.O. BOX 5607
WALNUT CREEK CA 94596-1607

(Patent Owner)

John C. Phillips
Fish & Richardson P.C.
12390 El Camino Real
San Diego, CA 92130

(Third Party Requester)

MAILED

JUN 01 2006

REEXAM UNIT

In re Redford et al	:	
Reexamination Proceeding	:	DECISION TERMINATING
Control No. 90/007,743	:	STAY IN
Submitted: October 3, 2005	:	REEXAMINATION PROCEEDING
For: U.S. Patent No. 5,795,156	:	

The above-captioned reexamination proceeding is before the Office of Patent Legal Administration in the United States Patent and Trademark Office (the "Office") for a decision *sua sponte* terminating the stay in the present reexamination proceeding.

BACKGROUND

1. On October 3, 2005, a third party requester submitted a request for reexamination of U.S. Patent No. 5,795,156. The request was accompanied by check # 198073 drawn on Fleet Bank, dated September 15, 2005, in payment of the *ex parte* reexamination fee set in 37 CFR 1.20(c)(1).

2. Upon presentment by the Office of check # 198073 to the payor bank on October 11, 2005, the Office was informed that the third party requester placed a stop payment on check # 198073 and, therefore, the check did not clear, and the Office did not receive the required payment of the fee for requesting reexamination.

3. Reexamination was ordered on November 15, 2005, prior to the Examiner becoming aware that the third party requester had put a stop payment on the fee check.

4. On December 28, 2005, a Decision Staying Reexamination Proceedings was mailed to the patent owner and third party requester.

5. The December 28, 2005 decision required the third party requester to re-submit the reexamination filing fee ($2,520) for the present proceeding and a returned check processing fee of $50.

6. On January 26, 2006, the third party requester's counsel paid the reexamination filing fee of $2,520 and the returned check processing fee of $50.

7. No patent owner's statement has been filed to this point.

DECISION

The December 28, 2005 decision stayed the present reexamination proceeding, "pending payment of the required fees." The decision stated:

> "When the third party requester submits the fees, the stay of the reexamination proceeding will be terminated."

Since the required fees have now been submitted, the stay of the present reexamination proceeding is hereby terminated.

The filing date of the instant reexamination proceeding is January 26, 2006, since that is the date on which the statutory requirements of 35 U.S.C. § 302 were completed by payment of the reexamination fee

The two month period for the filing of a timely patent owner's statement under 37 CFR 1.530(b) after the Order is hereby *sua sponte* extended to run TWO MONTHS from the date of mailing of the instant decision. Any extension of time is governed by 37 CFR 1.550(c). If the patent owner files a timely statement under 37 CFR 1.530(b), then a third party requester reply pursuant to 37 CFR 1.535 may be filed TWO MONTHS from the date of service of

such timely filed patent owner's Statement. This reply time is not extendable.

CONCLUSION

1. The stay of the present reexamination proceeding (Control Number 90/007,743) is hereby terminated.

2. The two month period for the filing of a timely patent owner's statement under 37 CFR 1.530(b) after the Order is hereby *sua sponte* extended to run TWO MONTHS from the date of mailing of the instant decision.

3. If patent owner files a timely statement under 37 CFR 1.530(b), a third party requester reply pursuant to 37 CFR 1.535 may be filed TWO MONTHS from the date of service of such timely filed patent owner's Statement.

4. Jurisdiction over the present reexamination proceeding is forwarded to the Central Reexamination Unit.

5. Telephone inquiries related to this decision should be directed to Mary C. Till, Legal Advisor, at 571-272-7755, or, in her absence, to the undersigned at 571-272-7710.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

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May 31, 2006

Mail

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LAW OFFICE OF CHARLES E. KRUEGER
P.O. BOX 5607
WALNUT CREEK CA 94596-1607

(Patent Owner)

John C. Phillips
Fish & Richardson P.C.
12390 El Camino Real
San Diego, CA 92130

(Third Party Requester)

MAILED
JUN 01 2006
REEXAM UNIT

In re Redford et al	:	
Reexamination Proceeding	:	DECISION TERMINATING
Control No. 90/007,744	:	STAY IN
Submitted: October 3, 2005	:	REEXAMINATION PROCEEDING
For: U.S. Patent No. 5,795,156	:	

The above-captioned reexamination proceeding is before the Office of Patent Legal Administration in the United States Patent and Trademark Office (the "Office") for a decision *sua sponte* terminating the stay in the present reexamination proceeding.

BACKGROUND

1. On October 3, 2005, a third party requester submitted a request for reexamination of U.S. Patent No. 5,795,156. The request was accompanied by check # 198073 drawn on Fleet Bank, dated September 15, 2005, in payment of the *ex parte* reexamination fee set in 37 CFR 1.20(c)(1).

2. Upon presentment by the Office of check # 198073 to the payor bank on October 11, 2005, the Office was informed that the third party requester placed a stop payment on check # 198073 and, therefore, the check did not clear, and the Office did not receive the required payment of the fee for requesting reexamination.

3. Reexamination was ordered on November 17, 2005, prior to the Examiner becoming aware that the third party requester had put a stop payment on the fee check.

4. On December 28, 2005, a Decision Staying Reexamination Proceedings was mailed to the patent owner and third party requester.

5. The December 28, 2005 decision required the third party requester to re-submit the reexamination filing fee ($2,520) for the present proceeding and a returned check processing fee of $50.

6. On January 26, 2006, the third party requester's counsel paid the reexamination filing fee of $2,520 and the returned check processing fee of $50.

7. No patent owner's statement has been filed to this point.

DECISION

The December 28, 2005 decision stayed the present reexamination proceeding, "pending payment of the required fees." The decision stated:

> "When the third party requester submits the fees, the stay of the reexamination proceeding will be terminated."

Since the required fees have now been submitted, the stay of the present reexamination proceeding is hereby terminated.

The filing date of the instant reexamination proceeding is January 26, 2006, since that is the date on which the statutory requirements of 35 U.S.C. § 302 were completed by payment of the reexamination fee

The two month period for the filing of a timely patent owner's statement under 37 CFR 1.530(b) after the Order is hereby *sua sponte* extended to run TWO MONTHS from the date of mailing of the instant decision. Any extension of time is governed by 37 CFR 1.550(c). If the patent owner files a timely statement under 37 CFR 1.530(b), then a third party requester reply pursuant to 37 CFR 1.535 may be filed TWO MONTHS from the date of service of

such timely filed patent owner's Statement. This reply time is not extendable.

CONCLUSION

1. The stay of the present reexamination proceeding (Control Number 90/007,743) is hereby terminated.

2. The two month period for the filing of a timely patent owner's statement under 37 CFR 1.530(b) after the Order is hereby *sua sponte* extended to run TWO MONTHS from the date of mailing of the instant decision.

3. If patent owner files a timely statement under 37 CFR 1.530(b), a third party requester reply pursuant to 37 CFR 1.535 may be filed TWO MONTHS from the date of service of such timely filed patent owner's Statement.

4. Jurisdiction over the present reexamination proceeding is forwarded to the Central Reexamination Unit.

5. Telephone inquiries related to this decision should be directed to Mary C. Till, Legal Advisor, at 571-272-7755, or, in her absence, to the undersigned at 571-272-7710.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

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May 31, 2006

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CENTRAL REEXAMINATION UNIT

MICHAEL S. DOWLER HOWREY, LLP 1111 LOUSIANA, 25TH FLOOR HOUSTON, TX 77002	:	(for patent owner)
David L. Fehrman MORRISON & FOERSTER LLP 555 W Fifth St. Suite 3500 Los Angeles, CA 90013	:	(for requestor)
MICHELLE CARNIAUX KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004	:	(for requestor)
In re VOGEL *Ex Parte* Reexamination Proceeding Control No. 90/007,746 Filed: October 13, 2005 US Patent No: 4,930,158 Title: **Selective Video Playing System**	:	*SUA SPONTE* DECISION MERGING REEXAMINATION PROCEEDINGS
In re VOGEL *Ex Parte* Reexamination Proceeding Control No. 90/008,544 Filed: January 31, 2007 US Patent No: 4,930,158 Title: **Selective Video Playing System**	:	

The above-identified reexamination files are before the Director of Central Reexamination Unit, for consideration of merger of the proceedings under 37 C.F.R. § 1.565(c).

BACKGROUND

1. Patent No. 4,930,158 issued on May 29, 1990.

2. A first request for Reexamination control number 90/007,746 was made by a third party requester was made October 13, 2005 by a third party requester for reexamination of claims 1-10 and 12-21.

3. Reexamination was ordered in the '7746 reexamination proceeding on December 13, 2005.

4. A request for reexamination, Reexamination Control No. 90/008,544, was filed by the third party requester on January 31, 2007. This request was directed to claims 1-10 and 12-21

5. Reexamination was ordered in the '8,544 reexamination proceeding on April 20, 2007.

DISCUSSION

Under 37 C.F.R. § 1.565(c):

> If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* reexamination proceeding has not been terminated, the *ex parte* reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570.

As noted above, reexamination has been ordered in both of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is appropriate.

DECISION

I. <u>Merger of Proceedings</u>.

In accordance with 37 C.F.R. § 1.565(c), the '7,746 and 8,544 reexamination proceedings are <u>merged</u>. 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. Since there are no amendments to the claims in either proceeding there is no requirement for a "housekeeping" amendment.

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. 90/7,746 and 90/008,544 are merged. The proceeding is returned to the Examiner in charge for response after non-final action entered.

Patent owner is required to maintain the same claims and specification in all 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

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

Lissi Mojica Marquis,
Director,
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,746	10/13/2005	4930158	487132800100	8232

37086 7590 04/25/2008

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1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/25/2008

Please find below and/or attached an Office communication concerning this application or proceeding.

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

David L. Fehrman
MORRISON & FOERSTER LLP
555 W. Fifth Street, Suite 3500
Los Angeles, CA 90013

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APR 25 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/007,746, 90/008,544

PATENT NO. 4930158.

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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Novak Druce & Quigg, LLP (For Patent Owner)
(NDQ Reexamination Group)
1000 Louisiana Street
Fifty-Third Floor
Houston, TX 77002

Morrison & Foerster LLP (For Third-Party Requester)
555 West Fifth Street
Suite 3500
Los Angeles, CA 90013-1024

In re: Vogel	: DECISION
Reexamination Proceeding	: DISMISSING
Control No. 90/007,746	: PETITION FOR
Request Deposited: October 13, 2005	: EXTENSTION OF TIME
For: U.S. Patent No. 4,930,158	: [37 CFR 1.550(c)]
In re: Vogel	:
Reexamination Proceeding	:
Control No. 90/008,544	:
Request Deposited: January 31, 2007	:
For: U.S. Patent No. 4,930,158	:

This is a decision on the April 21, 2008, "PATENT OWNER'S REQUEST FOR EXTENSION OF TIME TO FILE RESPONSE TO OFFICE ACTION PURSUANT TO 37 CFR 1.550(C)" requesting that the time to submit a Patent Owner response be extended an additional 35 days.

The petition is before the Director of the Central Reexamination Unit for consideration.

The petition is dismissed for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 4,930,158 (hereinafter, the '158 patent), issued to Vogel, on May 29, 1990 from application number 07/237,175, filed August 29, 1988.

2. On October 13, 2005, a third party deposited a Request for *Ex Parte* Reexamination of the '158 patent. The reexamination proceeding was assigned Control No. 90/007,746 (hereinafter, the '7746 proceeding).

3. The reexamination order was granted in the '7746 proceeding on December 13, 2005.

4. A non-final rejection was mailed on May 19, 2006.

5. A petition for extension of time was filed on July 17, 2006 requesting an additional nine days for response. Said petition was granted on July 24, 2006.

6. A response was timely filed on July 28, 2006.

7. On January 31, 2007, a third party deposited a Request for *Ex Parte* Reexamination of the '158 patent. The reexamination proceeding was assigned Control No. 90/008,544 (hereinafter, the '8544 proceeding).

8. The reexamination order was granted in the '8544 proceeding on April 20, 2007.

9. The '7746 and '8544 proceedings were merged on August 1, 2007.

10. A housekeeping amendment was filed on January 31, 2008.

11. A final rejection was mailed on February 8, 2008 setting a one-month period for response as an order granting the joint motion to stay litigation pending reexamination proceedings was issued on January 17, 2008.

12. An after-final amendment was timely filed on March 10, 2008 (March 8th being a Saturday).

13. An advisory action was mailed on March 25, 2008 extending the period for response to run three months from the mailing date of the final rejection (i.e. May 8, 2008).

14. A request for extension of time was timely filed on April 21, 2008.

DECISION

The Patent Owner requests an extension of time in which to file a Patent Owner response to the final office action mailed February 8, 2008 and the advisory action mailed March 25, 2008. The request for extension is the second request for an extension of time. The present petition for extension of time was timely filed on April 21, 2008, together with the 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 CRU 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.

Patent owner states:

"A response to the Advisory Action in the above-referenced reexamination is currently due on or before April 25, 2008. Patent Owner's counsel has met with Patent Owner and discussed strategy for response to the Advisory Action and determined that additional time is needed to prepare an adequate response. As the Office is familiar, Patent Owner has an identical response period ending on April 25, 2008 for a Final Office Action in another reexamination proceeding (Control Nos. 90/007,733 and 90/008,243). This other case presents several complicated and time consuming response aspects, including arguing several new issues presented for the first time in a Final Office Action and which merit declaration testimony from foreign declarants - - the coordination with which has been time consuming relative to the shortened period for response of one month from mailing."

However, the period for response is incorrect as the final rejection in the merged '7746 and '8544 proceedings was mailed on February 8, 2008 and the advisory action of March 25, 2008 extended the period for response to run three months from the mailing date of the final rejection. Therefore, the response in the merged '7746 and '8544 proceedings is due on or before May 8,

2008. Furthermore, the present petition does not explain why additional time is needed in the merged '7746 and '8544 proceedings. The showing is directed to another proceeding. Accordingly, there is no showing in the present petition that warrants extension beyond the current period for response that ends on May 8, 2008.

It is also noted that the '158 patent expires on August 29, 2008.

37 CFR 1.530(j) states:

No enlargement of claim scope. No amendment may enlarge the scope of the claims of the patent or introduce new matter. No amendment may be proposed for entry in an expired patent. Moreover, no amendment, other than the cancellation of claims, will be incorporated into the patent by a certificate issued after the expiration of the patent.

MPEP 2250 (III) states, in part:

Pursuant to 37 CFR 1.530(j), "[n]o amendment may be proposed for entry in an expired patent." Thus, if a patent expires during the pendency of a reexamination proceeding for a patent, all amendments to the patent claims and all claims added during the proceeding are withdrawn. This is carried out by placing a diagonal line across all amended and new claims (and text added to the specification) residing in the amendment papers. The patent owner should be notified of this in the next Office action. The Office action will hold the amendments to be improper, and state that all subsequent reexamination will be on the basis of the unamended patent claims. This procedure is necessary since no amendments will be incorporated into the patent by a certificate after the expiration of the patent.

Since an appeal by Patent Owner can extend the pendency of the reexamination beyond the expiration of the '158 patent (i.e. 2 months to file an appeal brief after the Notice of Appeal and 2 months to file a reply brief after the examiner's answer would prolong prosecution into at least September 2008), the Office will entertain an after-final amendment to return the claims to the original, unamended patent claims at the present time.

CONCLUSION

1. Petitioner's request is dismissed. The period during which Patent Owner may file a response ends on May 8, 2008.

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

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Edward J. Kessler
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(For Patent Owner)

MAILED

FEB 07 2008

CENTRAL REEXAMINATION UNIT

David L. Fehrman
Morrison & Foerster, LLP
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(For Third Party Requester)

In re James Barton et al.
Reexamination Proceeding
Control No.: 90/007,750
Filed: October 17, 2005
For: U.S. Patent No.: 6,233,389

DECISION ON PETITION UNDER 37 CFR 1.182

This is a decision on the December 17, 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 December 17, 2007, has not been entered for consideration by the examiner.

BACKGROUND

1. Patent number 6,233,389 issued on May 15, 2001.
2. A request for reexamination, assigned control No. 90/007,750 (the '7750 proceeding), was filed on October 17, 2005 by a third party requester.
3. On December 15, 2005 the Office issued an order granting the '7750 reexamination request.
4. The'7750 proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) issued on November 28, 2007.
5. On December 17, 2007, the instant petition was submitted with an IDS, which the patent owner requests the Office to consider. The IDS submitted two references, designated US1 and US2.
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 item (A) in regard to one of the two references submitted (US1), because there is no factual accounting to explain why the information submitted could not be submitted earlier in the reexamination proceeding. The instant petition was filed very late in the reexamination proceeding, and while an attempt to satisfy the guidance of MPEP 2256 was made, it is partially insufficient and the Office cannot enter an IDS in part. In regards to reference US1, the patent owner states they were put on actual notice of the reference in an Office action in a related case on October 19, 2007, approximately six weeks prior to the Office's issuance of a NIRC in the '7750 reexamination proceeding. The patent owner presents no factual accounting as to why the information was not submitted during the six weeks prior to issuance of the NIRC. In regards to reference US2, the patent owner states they were not put on actual notice as to the existence of the reference until December 3, 2007, approximately five days after issuance of the NIRC in the '7750 proceeding. This factual accounting is a sufficient explanation as to why the reference could not be submitted earlier. In regards to both references US1 and US2, patent owner states that the relevance of the references with respect to the claimed invention in the reexamination proceeding, namely that both references disclose all the claimed elements of independent claims 1 and 32 but without a media switch, both in general and particularly a media switch possessing the characteristics as set forth in the independent claims. As patent owner has not full satisfied the requirements of item (A) with regard to reference US1 in the IDS submitted at this late stage of reexamination the present petition does not meet the requirements necessary for consideration of an IDS after a 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 November 28, 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 of the submitted art citations, the present reexamination proceeding will <u>not</u> 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.

<u>If, however</u>, 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 December 17, 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

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Commissioner for Patents
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CENTRAL REEXAMINATION UNIT

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JOHN C. PHILLIPS, ESQ. (For Third Party Requester)
FISH & RICHARDSON
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In re Reexamination Proceeding	:
M. Hogard et al.	:
Control No. 90/007,751	: DECISION GRANTING PETITION
Filed: October 18, 2005	:
U.S. Patent No. 5,247,434	:
Attorney Docket No. 112713-1372-03	:

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on June 12, 2008, for entry of late papers based upon unintentional delay.

The petition is before the Office of Patent Legal Administration (OPLA) for decision.

37 CFR 1.137(b) states, in part:

> "*Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by: (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in § 1.17(m); (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section."

The present petition under 37 CFR 1.137(b) includes, inter alia, the requisite response (appeal brief and fee (authorization to charge counsel's deposit account for the appeal brief fee) - item 1), an authorization to charge counsel's deposit account for the $1,540.00 petition fee under 37 CFR 1.17(m) (item 2), the requisite statement (item 3) and a Certificate of Service on the Third Party Requester.

The petition for entry of the late papers is granted.

No terminal disclaimer and disclaimer fee are required for a period of termination in a reexamination proceeding.

$2,050.00 ($1,540.00 for the petition fee and $510.00 for the appeal brief fee) has been charged to counsel's deposit account no. 08-0219 in accordance with the present petition.

Jurisdiction over the reexamination proceeding is being returned to Central Reexamination Unit (CRU) Art Unit 3991 for further examination and consideration of the appeal brief filed June 12, 2008, 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, Sharon Turner, in CRU Art Unit 3991, who can be reached at 571-272-0894.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte Baxter International, Inc. and Baxter Healthcare Corp.

Appeal 2009-006493
Reexamination Control 90/007,751
Patent 5,247,434

Decided: October 9, 2009

DECISION ON PETITION

This is a decision on Patent Owner's "Petition for Remand to Examiner Under 37 C.F.R. §§ 41.3 and 41.50(a)(1) for Further Consideration" ("Petition"), filed September 15, 2009, seeking remand of this reexamination proceeding to the Examiner for further consideration of the patentability of certain claims of Patent 5,247,434 ("434 Patent").

FINDINGS OF FACT

1. In this appeal, an Appeal Brief was filed on June 12, 2008, an Examiner's Answer was entered on September 26, 2008, a Reply Brief was filed on November 25, 2008, and an Oral Hearing was held on June 17, 2009. The appeal presently is under consideration by a panel of the Board of Patent Appeals and Interferences ("Board").

2. A decision concerning, *inter alia*, the validity of certain claims of the 434 Patent was issued by the United States Court of Appeals for the Federal Circuit on September 10, 2009. *Fresenius USA, Inc. v. Baxter Int'l, Inc.*, Appeals 2008-1306, 2008-1331, 2009 WL 2881629 (Fed. Cir. Sep. 10, 2009). Specifically, the Court held that claims 26-31 of the 434 Patent were not invalid. *Id.* at 9-10.

3. The principal prior art reference considered by the Court of Appeals in *Fresenius* is the same principal reference that is before the Board in the present appeal – Fresenius CMS 08 Handbook. Further, the Court held that:

> Fresenius failed to present any evidence – let alone substantial evidence – that the structure corresponding to the means for delivering dialysate limitation, or an equivalent thereof, existed in the prior art. . . . [A] challenger who seeks to demonstrate that a means-plus-function limitation was present in the prior art must prove that the corresponding structure – or an equivalent – was present in the prior art.

Id. at 9. (Citing I*n re Donaldson Co.*, 16 F.3d 1189, 1193 (Fed. Cir. 1994) (en banc) and *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1361 (Fed. Cir. 2001) (Michel, J., dissenting)).

4. In the Petition, Patent Owner asserts that the Examiner did not apply the test articulated in *Fresenius* in rejecting the claims held not invalid in *Fresenius*. Petition, pp. 2-4.

PRINCIPLES OF LAW

With respect to the effect that a federal court decision holding patent claims not invalid has on the patentability of the same claims pending in an *ex parte* reexamination proceeding, the Federal Circuit addressed this issue in *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1428-29 (Fed. Cir. 1988):

> The two forums take different approaches in determining invalidity and on the same evidence could quite correctly come to different conclusions. . . . [I]f the district court determines that a patent is not invalid, the PTO should continue its reexamination because, of course, the two forums have different standards of proof for determining invalidity.

This principle was reaffirmed in *In re Swanson,* 540 F.3d 1368, 1377-78 (Fed. Cir. 2008), where the court observed:

> In PTO examinations and reexaminations, the standard of proof – a preponderance of evidence – is substantially lower than in a civil case, *In re Caveney*, 761 F.2d 671,674 (Fed. Cir. 1985 . . . .

On appeal in an *ex parte* reexamination, the Board has authority to "affirm or reverse the decision of the examiner in whole or in part," 37 C.F.R. § 41.50(a)(1), or, having "knowledge of any grounds not involved in the appeal," may enter a new ground of rejection. 37 C.F.R. § 41.50(b).

DISCUSSION

The issue presented by the Petition and raised by the decision in *Fresenius* is what effect the decision should have on the appeal in the reexamination proceeding.

The *Fresenius* decision articulated the test to be applied in applying prior art against a means-plus-function limitation; namely, does the prior art disclose structure corresponding to the structure of the means-plus-function limitation as disclosed in the specification or an equivalent thereof? FF 3. Whether the Examiner applied this test in rejecting the means-plus-function claims common to *Fresenius* and the reexamination proceeding, i.e., claims 26-31 of the 434 Patent, is disputed by the Patent Owner and an issue to be resolved by the Board. FF 4.

It is clear, however, that the holding in *Fresenius* that certain claims at issue in the reexamination proceeding are not invalid is not binding on the Office. *Ethicon,* 849 F.2d at 1428-29.

Further, the Board has the authority, not only to affirm or reverse the decision of the Examiner, but also to enter a new ground of rejection based on evidence and/or reasons not considered by the Examiner. 37 C.F.R. § 41.50(b).

DECISION

In view of the range of actions available to the Board, the Petition is DENIED and the panel to which this appeal has been assigned is directed to consider the decision in *Fresenius* in reviewing the Examiner's rejection of claims 26-31 of the 434 Patent.

Michael R. Fleming
Chief Administrative Patent Judge

Patent Owner:

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P.O. Box 1135
Chicago IL 60690-1135

Third Party Requester:

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Fish & Richardson PC
12390 El Camino Real
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(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

In re Reexamination Proceeding :
J. Anthony :
Control No. 90/007,752 : DECISION GRANTING PETITION UNDER 1.181
Filed: October 18, 2005 :
U.S. Patent No. 6,095,973 :
Attorney Docket No. 072674-00007 :

This is a decision on the Request To Consider Correspondence Never Received As Timely Filed In Accordance With Certificate Of Transmission And Request For Consideration Of Petition For Extension Of Time filed December 12, 2006, by facsimile transmission, which is being treated as a petition under 37 CFR 1.181 requesting that a response facsimile transmitted to the Office on October 16, 2006, but never received be treated as having been filed on October 16, 2006. The present petition under 37 CFR 1.181 included an embedded request for reconsideration of the Petition For Extension Of Time filed November 20, 2006, which was dismissed as the Office had no record of a response to the final Office action as ever being filed.

In response, on December 12, 2006, *inter alia*, the present petition was filed including an authorization to charge counsel's deposit account for any petition fee due. Petitioner argues that a response, including a declaration and the surcharge, was facsimile transmitted to the Office along with a signed certificate of transmission of October 16, 2006. In support of the petition, patent owner submitted, *inter alia*, a copy of the October 16, 2006 response including a certificate of transmission of October 16, 2006 thereon (Exhibit A), a Statement Of Emily J. Shultz Attesting To The Transmission Of Correspondence Under 37 C.F.R. § 1.8(a) (Exhibit B) (containing sub exhibits A-C (sub exhibit B is a copy of the transmission report and sub exhibit C is a copy of the Auto-Reply facsimile transmission report)) and a copy of a Petition For Extension Of Time filed November 20, 2006.

37 CFR 1.8(b) states the following:

> 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.

A review of the record reveals that on September 15, 2006, a final Office action was mailed setting a one month period for response. No response to the September 15, 2006 final Office action filed on or about October 16, 2006, has been located in the image file wrapper. However, the evidence is convincing that a response was timely filed by facsimile transmission on October 16, 2006 (October 15, 2006 being a Sunday), using the certificate of transmission procedures under 37 CFR 1.8(a).

In view of the above, the petition under 1.181 is **GRANTED**. The copy of the facsimile transmitted response (Exhibit A) is considered as being timely filed on October 16, 2006. The copy of the facsimile transmitted response, will be scanned into the image file wrapper and used for examination purposes. No petition fee is required and none has been charged to counsel's deposit account.

37 CFR 1.4(c) states the following:

> 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.

It is noted that the request for reconsideration of the decision on the petition for extension of time mailed November 27, 2006, is embedded in with the present petition under 1.181. In order to avoid any further processing delays, as to the embedding of the request for reconsideration of the decision on a petition for extension of time in with the petition, 37 CFR1.4(c) is hereby waived. The 'request for reconsideration of the decision on the petition for extension of time' embedded in with the petition will be considered in due course.

Jurisdiction over the reexamination proceeding is being returned to Central Reexamination Unit (CRU) Art Unit 3993 for consideration of the 'request for reconsideration of the decision on the petition for extension of time' in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Peter English in CRU Art Unit 3993, 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

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(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

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600 Hansen Way
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(For Requester)

In re: Anthony Joseph
Reexamination Proceeding
Control No.: 90/007,752
Filed: October 18, 2005
For: U.S. Patent No.: 6,095,973

: DECISION ON PETITION
: TO CONTINUE
: *EX PARTE*
: REEXAMINATION
: PROCEEDINGS

This is a decision on the March 9, 2007 patent owner petition, filed under 37 CFR 1.182 and denominated "PETITION SEEKING DECISION ON QUESTION NOT SPECIFICALLY PROVIDED FOR."

The petition is before the Office of Patent Legal Administration.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182 has been charged to petitioner's Deposit Account No. 20-0809 as authorized in the Fee Transmittal form accompanying the petition.

For the reasons set forth below, the petition under 37 CFR 1.182 is dismissed. Patent owner's Appeal brief is due on Monday April 16, 2007.

REVIEW OF FACTS

1) U.S. Patent No. 6,095,973 (the '973 patent) issued on August 1, 2000, with 11 claims.

2) On October 18, 2005, a third party requester filed a request for *ex-parte* reexamination of the '973 patent, and the resulting proceeding was assigned control No. 90/007,752 (the '7752 reexamination proceeding).

3) On November 28, 2005, the Office mailed an Order granting reexamination for the '7752 reexamination proceeding. The order stated that all claims of the '973 patent would be reexamined.

4) On February 10, 2006, the Office mailed a first action the merits rejecting all the pending claims and setting a 1-month period for response.

5) On March 8, 2006, an *Ex Parte* Interview Summary form was mailed to third party requester recording the substance of an interview held that day with the inventor and patent owner's representative.

6) On Monday, March 13, 2006, the patent owner filed a response [1] to the Office action of February 10 2006. Claims 1-11 were not amended, and new claims 12 was added in this submission.

7) On September 15, 2006, the Office mailed a final Office action rejecting all the pending claims. The action further notified patent owner that the patent owner's statement recording the substance of the March 8th interview failed to comply with 37 CFR 1.560(b). The action set a 1-month period for response.

8) On November 17, 2006, patent owner filed an appointment of new attorneys, a change of correspondence address, and a revocation of all prior powers of attorney.

9) On November 20, 2006, patent owner, through the newly appointed attorney, requested an extension of time to respond to the September 15th final Office action

10) On November 27, 2006, the Office mailed a decision dismissing the request for an extension of time on the grounds that it was not timely, because it was not filed before October 16, 2006 – the date a response to the Office action was due. The decision noted that Office records did not reflect any response to the September 15th Office action.

11) On December 12, 2006, patent owner filed a petition to accept a first response (Amendment After Final Action) from the patent owner to the final Office action as having been submitted on October 16th, and thus as timely filed. Patent owner further renewed the request for an extension of time.

12) On December 21, 2006, a decision accepting the first response submission as timely filed on October 16th was issued.

13) On January 12, 2007, the Examiner issued an Advisory action maintaining the rejections of record and extending the period for response to February 15, 2007.

14) On February 15, 2007, patent owner filed a second response to the September 15 final rejection. This response proposed canceling claims 1-12 and entering new claims 13-20.

15) Also on February 15, 2007, patent owner filed a Notice of Appeal with authorization to charge the requisite fee under 37 CFR 41.20(b)(1) to Deposit Account No. 20-0809.

---

[1] 30 days from February 10 was Sunday March 12, 2006. Therefore, the filing on March 13 was timely.

16) On February 22, 2007, the Examiner issued an Advisory action refusing entry of the proposed amendment filed February 15, 2007. The advisory action indicated, *inter alia*, that the claims raised issues of new matter.

17) On March 9, 2007, patent owner filed the present petition denominated "Petition Seeking Decision on Question Not Specifically Provided For," requesting relief similar to that which would be in effect if Request for Reexamination (RCR) practice would be enacted. This petition is being addressed in the present decision.

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 Amendment After Final received in the Office on February 15, 2007,[2] and resubmitted with the petition.

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending." [3] Notice was provided 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. The Notice stated:

> "[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.**"

---

[2] Item 15 in the Review of Facts.

[3] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

[Emphasis Added]

Accordingly, relief in the form of a continuation of the reexamination prosecution after a final Office action is now available via a 37 CFR 1.182 petition in appropriate circumstances. Hereinafter, this petition will be referred to as "the § 1.182 petition."

As with a Request for Continued Examination (RCE) in an application, the § 1.182 petition must be filed to further the prosecution of the reexamination proceeding, rather than to delay the proceeding. This is especially critical in the reexamination setting, where 35 USC 305 mandates 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.

Patent owner's arguments are not found to provide 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 would not be consistent with the requirement of 35 USC 305 to conduct reexamination proceedings "with special dispatch within the Office."

Petitioner asserts, as justification for allowing continued prosecution in this reexamination proceeding, [4] that the current attorney was "substituted as attorney of record ... approximately two months after the mailing of the date of the final Office action..." and therefore "lacked the opportunity to file a response earlier in the prosecution process...."

This argument does not provide persuasive justification for granting continuing prosecution in a reexamination proceeding. It is the *patent owner* who has a right to respond to Office communications, and this right can be exercised either *pro se* or through appointed representation, which may, or may not be, changed during the prosecution. *Patent owner* had a full and fair opportunity to respond to each Office communication. The dismissal of previous counsel, and appointment of new counsel, does not generate a new right for the patent owner to begin prosecution afresh.

Petitioner next argues that "patent owner now views the previously submitted prior art ... in a different light" than it viewed it based on the request for reexamination, thereby "creating a substantial new question of patentability" based on the previously submitted prior art.

This too is not a persuasive argument for reopening prosecution of the instant proceeding. Patent owner's representative appears to be arguing that, after the final Office action, patent owner first appreciated the nature of how the reference was being applied. There is no contention of what factor that could not be appreciated prior to the issuance of the final rejection, but now can be appreciated. In this instance, petitioner had a full and fair opportunity to respond. Petitioner's

[4] "Reasons Amendment was not Presented Earlier" on pages 3-4 of the petition.

assertion that patent owner's new appreciation of the art is grounds for reopening is not persuasive, since an objective standard is required, and such is only provided by a statement of what was not known, and why it led to patent owner not appreciating the nature of the reference prior to the issuance of the final rejection. (Even where such an objective showing can be made, a continuation of the reexamination is not for the purpose of re-prosecuting the case, as will be discussed below.)

Petitioner argues that granting the petition and entering the amendment will materially advance prosecution "for the reasons expressed on pages 7-13 of the remarks accompanying the petition." A review of the referenced pages reveals that they contain argument as to how the proposed new claims 13-20 *are patentable over* the art cited against claims 1-12. Such does not, however, show how the amendment proposed would address the existing prosecution to materially advance it.

In issuing the advisory Office action on February 22nd, the examiner stated that the amendment raised new issues which would require further consideration. In such a scenario, an amendment of claims coupled with the argument as to how the amended claims overcome the rejections of record may, in some instances, evidence a *bona fide* effort to advance prosecution. However, in the instant case, patent owner has not chosen merely to amend the claims to address the nature of the applied reference not comprehended prior to final Office action. Rather, while the originally issued patent claims have been unamended throughout the prosecution, patent owner now proposes to ***cancel*** all the claims which have been prosecuted to date, and to substitute an entire ***new set of claims***. This does not appear to be addressed to dealing with the nature of a reference not previously comprehended. In this instance, the relationship between the new set of claims and the previously pending claims has not been explained in detail, and the language is sufficiently different that it appears that patent owner may have focused on an entirely new inventive concept. In addition, the presentation of an entire new set of totally rewritten claims, as opposed to amending the original claims (with appropriate underlining and bracketing), shows a purpose to re-prosecute the proceeding, rather than to address the nature of the reference not comprehended. It is to be noted that the presentation of the new set would require the examiner to begin a new claim analysis "from scratch," and that is not consistent with the continuation-of-the-reexamination-prosecution practice to further the statutorily mandated requirement for special dispatch. Continuing prosecution in reexamination proceedings is for the purpose of permitting prosecution to move toward a resolution - not to start prosecution anew with totally different claims.

Based on the facts and circumstances of the present situation, it is found that the amendment after-final rejection does not provide the requisite *bona fide* effort by the patent owner to advance the prosecution.

CONCLUSION

1) The petition under 37 CFR 1.182 is dismissed.

2) The amendment after final received February 15, 2007, and re-presented with the

petition on March 9, 2007, will not be entered by the Technology Center, and will not be considered by the examiner.

3) Patent owner's Brief on Appeal is due on or before April 16, 2007.

4) The reexamination proceeding is being forwarded to the Central Reexamination Unit for further handling and examination not inconsistent with this decision.

5) Telephone inquiries related to this decision should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or in his absence, the undersigned at (571) 272-7710.

Kenneth Schor, Senior Legal Advisor
Office of Patent Legal Administration
Office of Patent Examination Policy

March 20, 2007
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(For Patent Owner)

MAILED

MAY 10 2007

CENTRAL REEXAMINATION UNIT

Marc A. Sockol, Esq.
Squire Sanders & Dempsey LLP
600 Hansen Way
Palo Alto, California 94304-1043

(For Requester)

In re: Anthony Joseph
Reexamination Proceeding
Control No.: 90/007,752
Filed: October 18, 2005
For: U.S. Patent No.: 6,095,973

: DECISION ON PETITION
: TO CONTINUE
: *EX PARTE*
: REEXAMINATION
: PROCEEDING

This is a decision on the patent owner's April 16, 2007 renewed petition under 37 CFR 1.182, requesting reconsideration of the Office's March 21, 2007 decision on patent owner's original petition.

The petition is before the Office of Patent Legal Administration for consideration.

For the reasons set forth below, the petition under 37 CFR 1.182 is dismissed without consideration on the merits.

REVIEW OF RELEVANT FACTS

1) On March 9, 2007, patent owner filed the present petition denominated "Petition Seeking Decision on Question Not Specifically Provided For," requesting relief similar to that which would be in effect if Request for Reexamination (RCR) practice would be enacted.

2) On March 21, 2007, a decision was mailed dismissing the petition of March 9, 2007.

3) On April 16, 2007, the patent owner filed the present petition requesting reconsideration of the March 21, 2007 decision. This petition is being addressed in the present decision.

DECISION ON REQUEST FOR RECONSIDERATION

As noted in the decision mailed March 21, 2007, patent owner's appeal brief was due on or

before Monday April 16, 2007. The record does not reflect the timely filing of an appeal brief, and patent owner makes no representation that such a brief has been timely filed. The present proceeding is no longer pending, as the prosecution of the reexamination proceeding was terminated after April 16, 2007 by the failure to file an appeal brief by that date. Relief to continue prosecution cannot be considered in a proceeding where the prosecution has terminated. Accordingly, the petition requesting reconsideration must be dismissed.

The record reflects that all claims stand rejected. Accordingly, a Notice of intent to issue a reexamination certificate, indicating cancellation of all claims, will be forthcoming in due course.

ADDITIONAL DISCUSSION

It is to be noted that this request for reconsideration was filed after 5:00 PM on April 16. 2007. Thus, even if the petition would have made a clear case for the granting of continued examination, it would not be reasonable for patent owner to expect the processing of the incoming paperwork, review of the petition, and issuance of a positive decision to be completed prior to the expiry of the period for filing the requisite appeal brief. The very filing at this late juncture effectively guaranteed that the reexamination proceeding would no longer be pending when brought to the attention of the deciding official, thus effectively preventing the deciding official from granting relief even if such were warranted.

The Office set forth, in its March 21 decision, as the rationale for dismissal of the March 9th petition, that patent owner's submission did not appear to be a *bona fide* effort to advance prosecution. Rather, it appeared to be attempting to start prosecution anew by providing an entirely new set of claims, instead of revising the pending claims by adding limitations to define over the cited art. A cursory review of the substance of the present petition requesting reconsideration of the March 21 decision reveals that patent owner has not addressed the guidance provided by the Office's statement of its rationale for the dismissal, as to how to make a showing that the purpose of the request for continuing prosecution is a *bona fide* effort by the patent owner to advance the prosecution. Instead, patent owner makes a conclusory statement that upon comparing the claims "one will notice that the claim structure" is generally the same with newly added limitations. This does not address why the Office should contravene the statutory requirement for "special dispatch." 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." In order to provide the requested relief, the present proceeding would need to be withdrawn from the appeal 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. Where an amendment and/or evidence to define patentability of the existing claims is denied entry after a final rejection in an ex parte reexamination proceeding, a patent owner can obtain entry of that amendment and/or evidence under 37 CFR 1.182 in appropriate circumstances. The reason for such is that the patent owners treatment **of the existing claims** would further "special dispatch" by resolving issues. Where, however, the patent owner provides a new set of claims, that requires an entirely new evaluation of the new set of claims, it

would be contrary to the public interest in providing a speedy resolution of the question of patentability raised by a request for reexamination to pull back the reexamination proceeding from the appeal process.

CONCLUSION

1) The renewed 37 CFR 1.182 petition requesting reconsideration is dismissed.

2) The Office of Patent Legal Administration will retain jurisdiction over the present reexamination proceeding for 30 days. At the expiration of the period set out above, if a petition to revive the proceeding (see 37 CFR 1.137) has not been filed, jurisdiction over the present proceeding will be forwarded to the Central Reexamination Unit for further handling not inconsistent with this decision.

3) Patent owner is advised that no further relief will be considered by the Office, absent a revival of the reexamination proceeding.

4) Telephone inquiries related to this decision should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or in his absence, the undersigned at (571) 272-7710.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

April 30, 2007
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NOTICE RE PATENT OWNER'S CORRESPONDENCE ADDRESS

Effective May 16, 2007, 37 CFR 1.33(c) has been revised to provide that:

The patent owner's correspondence address for all communications in an *ex parte* reexamination or an *inter partes* reexamination is designated as the correspondence address of the patent.

> *Revisions and Technical Corrections Affecting Requirements for Ex Parte and Inter Partes Reexamination*, 72 FR 18892 (April 16, 2007)(Final Rule)

The correspondence address for any pending reexamination proceeding not having the same correspondence address as that of the patent is, by way of this revision to 37 CFR 1.33(c), <u>automatically changed to that of the patent file</u> as of the effective date.

This change is effective for any reexamination proceeding which is pending before the Office as of May 16, 2007, <u>including the present reexamination proceeding</u>, and to any reexamination proceeding which is filed after that date.

Parties are to take this change into account when filing papers, and direct communications accordingly.

In the event the patent owner's correspondence address listed in the papers (record) for the present proceeding is different from the correspondence address of the patent, it is strongly encouraged that the patent owner affirmatively file a Notification of Change of Correspondence Address in the reexamination proceeding and/or the patent (depending on which address patent owner desires), to conform the address of the proceeding with that of the patent and to clarify the record as to which address should be used for correspondence.

Telephone Numbers for reexamination inquiries:

Reexamination and Amendment Practice	(571) 272-7703
Central Reexam Unit (CRU)	(571) 272-7705
Reexamination Facsimile Transmission No.	(571) 273-9900

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(For Patent Owner)

MAILED

MAR 21 2007

CENTRAL REEXAMINATION UNIT

Marc A. Sockol, Esq.
Squire Sanders & Dempsey LLP
600 Hansen Way
Palo Alto, California 94304-1043

(For Requester)

In re: Anthony Joseph
Reexamination Proceeding
Control No.: 90/007,753
Filed: October 19, 2005
For: U.S. Patent No.: 6,228,027

: DECISION ON PETITION
: TO CONTINUE
: *EX PARTE*
: REEXAMINATION
: PROCEEDINGS

This is a decision on the March 9, 2007 patent owner petition, filed under 37 CFR 1.182 and denominated "PETITION SEEKING DECISION ON QUESTION NOT SPECIFICALLY PROVIDED FOR."

The petition is before the Office of Patent Legal Administration.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182 has been charged to petitioner's Deposit Account No. 20-0809 as authorized in the Fee Transmittal form accompanying the petition.

For the reasons set forth below, the petition under 37 CFR 1.182 is dismissed.

REVIEW OF FACTS

1) U.S. Patent No. 6,228,027 (the '027 patent) issued on May 8, 2001, with 11 claims.

2) On October 19, 2005, a third party requester filed a request for *ex-parte* reexamination of the '973 patent, and the resulting proceeding was assigned control No. 90/007,753 (the '7753 reexamination proceeding).

3) On November 28, 2005, the Office mailed an Order granting reexamination for the '7753 reexamination proceeding. The order stated that all claims of the '027 patent would be reexamined.

4) On February 13, 2006, the Office mailed a first action the merits rejecting all the pending claims and setting a 1-month period for response.

5) On March 8, 2006, an *Ex Parte* Interview Summary form was mailed to third party requester recording the substance of an interview held that day with the inventor and patent owner's representative.

6) On Monday, March 15, 2006, the patent owner filed a response[1] to the Office action of February 10 2006. Claims 1-11 were not amended and new claims 12 was added in this submission.

7) On September 15, 2006, the Office mailed a final Office action rejecting all the pending claims. The action further notified the patent owner that the patent owner's statement recording the substance of the March 8 interview failed to comply with 37 CFR 1.560(b). The action set a 1-month period for response.

8) On Monday, October 16, 2006, a first response (Amendment After Final Action) from the patent owner to the final Office action was submitted to the Office.

9) On November 1, 2006, the Examiner issued an Advisory action maintaining the rejections of record and extending the period for response to December 15, 2006.

10) On November 17, 2006, patent owner filed an appointment of new attorneys, a change of correspondence address, and a revocation of all prior powers of attorney.

11) On November 20, 2006 patent owner, through the newly appointed attorney, requested an extension of time to respond to the September 15th final Office action

12) On November 22, 2006, the Office mailed a decision granting the request for an extension of time, and setting the period for response to expire on January 15, 2007.

13) On January 11, 2007, patent owner filed a second response to the September 15 final rejection. This response proposed canceling claims 1-12 and entering new claims 13-20.

14) On January 16, 2007, patent owner filed a Notice of Appeal[2] with authorization to charge the requisite fee under 37 CFR 41.20(b)(1) to Deposit Account No. 20-0809.

15) On February 9, 2007, the Examiner issued an Advisory action refusing entry of the proposed amendment filed January 11, 2007. The advisory action indicated, *inter alia*, that the claims raised issues of new matter.

16) On February 22, 2007, an *Ex Parte* Interview Summary form was mailed to third party requester recording the substance of an interview held that day with the patent owner's representative.

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[1] March 15 2006 was 30 days from February 13 , 2006. Therefore, the filing on March 15 was timely.

[2] Monday January 15, 2007 was a Federal Holiday. Therefore, the filing of the Notice of Appeal on the 16th was timely.

17) On March 9, 2007, patent owner filed the present petition denominated "Petition Seeking Decision on Question Not Specifically Provided For" requesting relief similar to that which would be in effect if Request for Reexamination (RCR) practice would be enacted. This petition is being addressed in the present decision.

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 Amendment After Final received in the Office on January 11, 2007[3] and resubmitted with the petition.

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."[4] Notice was provided 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. The Notice stated:

> "[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**."
> [Emphasis Added]

Accordingly, relief in the form of a continuation of the reexamination prosecution after a final Office action is now available via a 37 CFR 1.182 petition in appropriate circumstances.

---

[3] Item 13 in the Review of Facts.

[4] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

Hereinafter, this petition will be referred to as "the § 1.182 petition."

As with a Request for Continued Examination (RCE) in an application, the § 1.182 petition must be filed to further the prosecution of the reexamination proceeding, rather than to delay the proceeding. This is especially critical in the reexamination setting, where 35 USC 305 mandates 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.

Patent owner's arguments are not found to provide 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 would not be consistent with the requirement of 35 USC 305 to conduct reexamination proceedings "with special dispatch within the Office."

Petitioner asserts, as justification for allowing continued prosecution in this reexamination proceeding, [5] that the current attorney was "substituted as attorney of record ... approximately two months after the mailing of the date of the final Office action..." and therefore "lacked the opportunity to file a response earlier in the prosecution process...."

This argument does not provide persuasive justification for granting continuing prosecution in a reexamination proceeding. It is the patent owner who has a right to respond to Office communications, and this right can be exercised either *pro se* or through appointed representation, which may, or may not be, changed during the prosecution. Patent owner had a full and fair opportunity to respond to each Office communication. The dismissal of previous counsel, and appointment of new counsel, does not generate a new right for the patent owner to begin prosecution afresh.

Petitioner next argues that "patent owner now views the previously submitted prior art ... in a different light" than it viewed it based on the request for reexamination, thereby "creating a substantial new question of patentability" based on the previously submitted prior art.

This too is not a persuasive argument for reopening prosecution of the instant proceeding. Patent owner's representative appears to be arguing that, after the final Office action, patent owner first appreciated the nature of how the reference was being applied. There is no contention of what factor that could not be appreciated prior to the issuance of the final rejection, but now can be appreciated. In this instance, petitioner had a full and fair opportunity to respond. Petitioner's assertion that patent owner's new appreciation of the art is grounds for reopening is not persuasive, since an objective standard is required, and such is only provided by a statement of what was not known, and why it led to patent owner not appreciating the nature of the reference prior to the issuance of the final rejection. (Even where such an objective showing can be made,

[5] "Reasons Amendment was not Presented Earlier" on pages 3-4 of the petition.

a continuation of the reexamination is not for the purpose of re-prosecuting the case, as will be discussed below.)

Petitioner argues that granting the petition and entering the amendment will materially advance prosecution "for the reasons expressed on pages 7-13 of the remarks accompanying the petition." A review of the referenced pages reveals that they contain argument as to how the proposed new claims 13-20 are patentable over the art cited against claims 1-12. Such does not, however, show how the amendment proposed would address the existing prosecution to materially advance it.

In issuing the advisory Office action on February 9th, the examiner stated that the amendment raised new issues which would require further consideration. In such a scenario, an amendment of claims coupled with the argument as to how the amended claims overcome the rejections of record may, in some instances, evidence a *bona fide* effort to advance prosecution. However, in the instant case, patent owner has not chosen merely to amend the claims to address the nature of the applied reference not comprehended prior to final Office action. Rather, while the originally issued patent claims have been unamended throughout the prosecution, patent owner now proposes to ***cancel*** all the claims which have been prosecuted to date, and to substitute an entire ***new set of claims***. This does not appear to be addressed to dealing with the nature of a reference not previously comprehended. In this instance, the relationship between the new set of claims and the previously pending claims has not been explained in detail, and the language is sufficiently different that it appears that patent owner may have focused on an entirely new inventive concept. In addition, the presentation of an entire new set of totally rewritten claims, as opposed to amending the original claims (with appropriate underlining and bracketing), shows a purpose to re-prosecute the proceeding, rather than to address the nature of the reference not comprehended. It is to be noted that the presentation of the new set would require the examiner to begin a new claim analysis "from scratch," and that is not consistent with the continuation-of-the-reexamination-prosecution practice to further the statutorily mandated requirement for special dispatch. Continuing prosecution in reexamination proceedings is for the purpose of permitting prosecution to move toward a resolution - not to start prosecution anew with totally different claims.

Based on the facts and circumstances of the present situation, it is found that the amendment after-final rejection does not provide the requisite *bona fide* effort by the patent owner to advance the prosecution.

CONCLUSION

1) The petition under 37 CFR 1.182 is dismissed.

2) The amendment after final received January 11, 2007, and re-presented with the petition on March 9, 2007, will not be entered by the Technology Center, and will not be considered by the examiner.

3) Patent owner's Brief on Appeal due on or before March 16, 2007 has not been matched to the file. If the Brief was not timely filed, then no response to this decision

will be considered because the reexamination prosecution will have been terminated by the failure to timely file the Brief on appeal.

4) The reexamination proceeding is being forwarded to the Central Reexamination Unit for further handling and examination not inconsistent with this decision.

5) Telephone inquiries related to this decision should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or in his absence, the undersigned at (571) 272-7710.

Kenneth Schor, Senior Legal Advisor
Office of Patent Legal Administration
Office of Patent Examination Policy

March 20, 2007

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(For Patent Owner)

MAILED

MAY 10 2007

CENTRAL REEXAMINATION UNIT

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Palo Alto, California 94304-1043

(For Requester)

In re: Anthony Joseph
Reexamination Proceeding
Control No.: 90/007,753
Filed: October 19, 2005
For: U.S. Patent No.: 6,228,027

: DECISION ON PETITION
: TO CONTINUE
: *EX PARTE*
: REEXAMINATION
: PROCEEDING

This is a decision on the patent owner's April 20, 2007 renewed petition under 37 CFR 1.182, requesting reconsideration of the Office's March 21, 2007 decision on patent owner's original petition.

The petition is before the Office of Patent Legal Administration for consideration.

For the reasons set forth below, the petition under 37 CFR 1.182 is dismissed without consideration on the merits.

REVIEW OF RELEVANT FACTS

1) On March 9, 2007, patent owner filed a petition denominated "Petition Seeking Decision on Question Not Specifically Provided For", requesting relief similar to that which would be in effect if Request for Reexamination (RCR) practice would be enacted.

2) On March 21, 2007, a decision was mailed dismissing the petition of March 9, 2007.

3) On April 20, 2007, the patent owner filed the present petition requesting reconsideration of the March 21, 2007 decision. This petition is being addressed in the present decision.

DECISION ON REQUEST FOR RECONSIDERATION

Patent Owner filed a Notice of Appeal on January 16, 2007. Thus, the patent owner's Appeal brief was due no later than March 16, 2007.

The Office's March 21st decision on petition stated: [1]

> Patent owner's Brief on Appeal due on or before March 16, 2007 has not been matched to the file. If the Brief was not timely filed, then ***no response to this decision will be considered*** because the reexamination prosecution will have been terminated by the failure to timely file the Brief on appeal. [Emphasis added]

The record does not reflect the timely filing of an appeal brief, and patent owner makes no representation that a brief has been filed. Accordingly, the prosecution of the present reexamination proceeding terminated after March 16, 2007, for failure to file the appeal brief by that date. The present proceeding is no longer pending because a proper response (the appeal brief) was not timely submitted. Relief to continue prosecution cannot be considered in a proceeding where the prosecution has terminated. Accordingly, the petition requesting reconsideration must be dismissed.

The record reflects that all claims stand rejected. Accordingly, a notice of intent to issue a reexamination certificate, indicating cancellation of all claims will be forthcoming in due course.

CONCLUSION

1) The renewed 37 CFR 1.182 petition requesting reconsideration is dismissed.

2) The Office of Patent Legal Administration will retain jurisdiction over the present reexamination proceeding for 30 days. At the expiration of the period set out above, if a petition to revive the proceeding (see 37 CFR 1.137) has not been filed, jurisdiction over the present proceeding will be forwarded to the Central Reexamination Unit for further handling not inconsistent with this decision.

3) Patent owner is advised that no further relief will be considered by the Office, absent a revival of the reexamination proceeding.

4) Telephone inquiries related to this decision should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or in his absence, the undersigned at (571) 272-7710.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

April 27, 2007

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[1] Numbered item 3 under the heading "Conclusion"

NOTICE RE PATENT OWNER'S CORRESPONDENCE ADDRESS

Effective May 16, 2007, 37 CFR 1.33(c) has been revised to provide that:

The patent owner's correspondence address for all communications in an *ex parte* reexamination or an *inter partes* reexamination is designated as the correspondence address of the patent.

> *Revisions and Technical Corrections Affecting Requirements for Ex Parte and Inter Partes Reexamination*, 72 FR 18892 (April 16, 2007)(Final Rule)

The correspondence address for any pending reexamination proceeding not having the same correspondence address as that of the patent is, by way of this revision to 37 CFR 1.33(c), <u>automatically changed to that of the patent file</u> as of the effective date.

This change is effective for any reexamination proceeding which is pending before the Office as of May 16, 2007, <u>including the present reexamination proceeding</u>, and to any reexamination proceeding which is filed after that date.

Parties are to take this change into account when filing papers, and direct communications accordingly.

In the event the patent owner's correspondence address listed in the papers (record) for the present proceeding is different from the correspondence address of the patent, it is strongly encouraged that the patent owner affirmatively file a Notification of Change of Correspondence Address in the reexamination proceeding and/or the patent (depending on which address patent owner desires), to conform the address of the proceeding with that of the patent and to clarify the record as to which address should be used for correspondence.

Telephone Numbers for reexamination inquiries:

Reexamination and Amendment Practice	(571) 272-7703
Central Reexam Unit (CRU)	(571) 272-7705
Reexamination Facsimile Transmission No.	(571) 273-9900

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Alexandria, VA 22313-1450
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LAW OFFICE OF CHARLES E. KRUEGER
P.O. BOX 5607
WALNUT CREEK CA 94596-1607

(Patent Owner)

MAILED
JUN 01 2006
REEXAM UNIT

John C. Phillips
Fish & Richardson P.C.
12390 El Camino Real
San Diego, CA 92130

(Third Party Requester)

In re Redford et al	:	
Reexamination Proceeding	:	DECISION TERMINATING
Control No. 90/007,757	:	STAY IN
Submitted: October 6, 2005	:	REEXAMINATION PROCEEDING
For: U.S. Patent No. 6,249,757	:	

The above-captioned reexamination proceeding is before the Office of Patent Legal Administration in the United States Patent and Trademark Office (the "Office") for a decision *sua sponte* terminating the stay in the present reexamination proceeding.

BACKGROUND

1. On October 6, 2005, a third party requester submitted a request for reexamination of U.S. Patent No. 6,249,757. The request was accompanied by check # 198072 drawn on Fleet Bank, dated September 15, 2005, in payment of the *ex parte* reexamination fee set in 37 CFR 1.20(c)(1).

2. Upon presentment by the Office of check # 198072 to the payor bank on October 13, 2005, the Office was informed that the third party requester placed a stop payment on check # 198072 and, therefore, the check did not clear, and the Office did not receive the required payment of the fee for requesting reexamination.

3. Reexamination was ordered on November 4, 2005, prior to the Examiner becoming aware that the third party requester had put a stop payment on the fee check.

4. On December 28, 2005, a Decision Staying Reexamination Proceedings was mailed to the patent owner and third party requester.

5. The December 28, 2005 decision required the third party requester to re-submit the reexamination filing fee ($2,520) for the present proceeding and a returned check processing fee of $50.

6. On January 26, 2006, the third party requester's counsel paid the reexamination filing fee of $2,520 and the returned check processing fee of $50.

7. No patent owner's statement has been filed to this point.

DECISION

The December 28, 2005 decision stayed the present reexamination proceeding, "pending payment of the required fees." The decision stated:

> "When the third party requester submits the fees, the stay of the reexamination proceeding will be terminated."

Since the required fees have now been submitted, the stay of the present reexamination proceeding is hereby terminated.

The filing date of the instant reexamination proceeding is January 26, 2006, since that is the date on which the statutory requirements of 35 U.S.C. § 302 were completed by payment of the reexamination fee

The two month period for the filing of a timely patent owner's statement under 37 CFR 1.530(b) after the Order is hereby *sua sponte* extended to run TWO MONTHS from the date of mailing of the instant decision. Any extension of time is governed by 37 CFR 1.550(c). If the patent owner files a timely statement under 37 CFR 1.530(b), then a third party requester reply pursuant to 37 CFR 1.535 may be filed TWO MONTHS from the date of service of

such timely filed patent owner's Statement. This reply time is not extendable.

CONCLUSION

1. The stay of the present reexamination proceeding (Control Number 90/007,757) is hereby terminated.

2. The two month period for the filing of a timely patent owner's statement under 37 CFR 1.530(b) after the Order is hereby *sua sponte* extended to run TWO MONTHS from the date of mailing of the instant decision.

3. If patent owner files a timely statement under 37 CFR 1.530(b), a third party requester reply pursuant to 37 CFR 1.535 may be filed TWO MONTHS from the date of service of such timely filed patent owner's Statement.

4. Jurisdiction over the present reexamination proceeding is forwarded to the Central Reexamination Unit.

5. Telephone inquiries related to this decision should be directed to Mary C. Till, Legal Advisor, at 571-272-7755, or, in her absence, to the undersigned at 571-272-7710.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

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C:\kiva\kenpet6\7743_terminate-stay.wpd
May 31, 2006

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KNOBBE MARTENS OLSEN & BEAR LLP
2040 Main Street
Fourteenth floor
Irvine, CA 92614

(For Patent Owner)

MR. KEVIN MCMAHON
Weil, Gotshal & Manges LLP
767 Fifth Avenue
New York, NY 10153

(For Requester)

In re Herbert J. Shaw *et alia*
Ex Parte Reexamination Proceeding
Control number 90/007,759
Filed: October 10, 2005
For: US Patent No. 4,859,016

DECISION, DISMISSING, PETITION REQUESTING RECONSIDERATION FOR ORDER DENIAL UNDER 37 CFR 1.181 AND 1.515 (c)

The above *ex parte* reexamination are before the Director of the Central Reexamination Unit for consideration. The requestor petitions the director to reverse the PTO's Order Denying Request for Ex Parte Reexamination under 37 CFR 1.181 and 37 CFR 1.515 (c). The petition is dismissed as moot for the reasons which follow.

REVIEW OF FACTS

1. U. S. Patent No. 4,859,016 issued on August 22, 1989.

2. A request for *ex parte* reexamination was filed by a third party requester on October 10, 2005 under reexamination control number 90/007,759

3. The request for ex parte reexamination was denied on December 15, 2005.

4. A Petition to the Director under 37 CFR 1.181 and 37 CFR 1.515 (c) requesting reconsideration of the Order denying the reexamination request was timely filed on January 17, 2006.

DISCUSSION REGARDING PETITION FROM DENIAL OF REQUEST

MPEP 2248 Petition From Denial of Request

37 CFR 1.515. Determination of the request for *ex parte* reexamination.
(c) The requester may seek review by a petition to the Director under § 1.181 within one month of the mailing date of the examiner 's determination refusing *ex parte* reexamination. Any such petition must comply with § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable.

MPEP 2248 Further states: PROCESSING OF PETITION UNDER 37 CFR 1.515(c)
After a request for reexamination has been denied, jurisdiction over the reexamination proceeding is retained by the Technology Center (TC) for reexamination files, to await the possibility of a petition seeking review of the examiner's determination refusing reexamination. If a petition seeking review of the examiner's determination refusing reexamination is not filed within one (1) month of the examiner's determination, the TC will then process the reexamination file as a concluded reexamination file. See MPEP § 2247 and § 2294. If a petition seeking review of the examiner's determination refusing reexamination is filed, it is forwarded (together with the reexamination file) 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. Each decision by the TC Director will conclude with the paragraph: This decision is final and nonappealable. 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

37 CFR 1.515 provides for a mechanism for appealing the decision denying the request for reconsideration. As such, the requester's points raised are fully considered.

DECISION REGARDING THE PETITION DENYING THE ORDER

The thrust of the petitioner's arguments are all directed to the issues raised in the merged proceedings, control numbers 90/006,726 and 90/007,147 which are directed to the reexamination of US Patent No. 4,859,016 which is the same patent under reexamination in the merged proceedings as well as the instant proceeding. While there may be merit to the arguments raised for those proceedings, they do not raise any issues which are germane to the instant proceeding before the Office. Since the issues do not raise any issues of a substantial new question of patentability in the instant proceeding they cannot be used to argue the merits of the denial of reexamination request number 90/007,759. In any event, the argument is dismissed as moot since the NIRC has been vacated in the merged proceedings 90/006,726 and 90/007,147. The merged proceedings have been reassigned to a different examiner and the will issue an Office action in due course. Restating, the

request for reconsideration filed under 37 CFR 1.181 and 37 CFR 1.515 (c) is dismissed as moot in view of the lack of substantial new question of patentability raised in the instant application and the vacated NIRC in the merged proceedings.

This decision is final and nonappealable. 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

CONCLUSION

1. The request for reconsideration of the Order Denial under 37 CFR 1.181 and 37 CFR 1.515 (c) is **dismissed** as moot.

2. Response in reexaminations 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

M. Reinhart SPRE-CRU--3992 for.
Lissi M. Marquis,
Director,
Central Reexamination Unit

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OCT 3 2006

PATENT OWNER:

Charles A. Johnson
Mail Box 4772
P.O. Box 64942
St. Paul, MN 55164

REQUESTER:

Rider Bennett, LLP
33 South Sixth Street, Suite 4900
Minneapolis, MN 55402

Reexamination Proceeding
Control No. 90/007,761
Filed: October 11, 2005
For: U.S. Patent No. 5,738,379

PETITION TO REVIEW DENIAL OF REEXAMINATION REQUEST UNDER 37 CFR 1.515(C)

This is a decision on the petition filed by the requestor under 37 CFR 1.515(c) and 1.181(b) on January 11, 2006. Petitioner requests that the Director grant the Request for Reexamination of Patent No. 5,738,379.

The petition is GRANTED.

On October 11, 2005 requestor filed a Request for Reexamination of U.S. Patent No. 5,738,379. In the Request, three new references were cited: United States Patent No. 2,322,841 issued to Foster; European Patent Application Publication No. 0 440 592 A1 by Sers and United States Patent No. 4,940,380 issued to Ballyns. United States Patent No. 2,832,486 to Clarke, which was previously cited in the prosecution of the '379 patent, was also argued as combinable with Foster in an obvious manner. Requestor alleged that these references raised a substantial new question of patentability with respect to the '379 patent. That Request was denied on December 9, 2005 in the Order Denying Request for Ex Parte Reexamination wherein the examiner maintained that a substantial new question of patentability was not raised by these references. The examiner held that all of the cited references failed to teach certain features claimed in the '379 patent and therefore did not raise a substantial new question of patentability.

MPEP 2242 states that a substantial new question of patentability is raised where there is a substantial likelihood that a reasonable examiner would consider the prior art patent important in deciding whether or not a claim is patentable. Further, it is not necessary that a *prima facia* case of unpatentability exist as to the claim in order for a substantial new question of patentability to be present as to the claim.

Petitioner argues that Foster alone, Foster in combination with Clarke and Sers alone raise substantial questions of patentability.

All of the new references cited in the Request for Reexamination are in the same field of endeavor as the '379 patent and have many structural characteristics as the invention claimed in the '379 patent as evidenced by petitioner's extensive discussion of these references. Furthermore, these references are not seen to be cumulative of the prior art considered in the prosecution of the parent patent. Therefore, these new references would be considered important when deciding on the patentability of the claims of the '379 patent and therefore raise a substantial new question of patentability. Reexamination of the United States Patent 5,738,379 is hereby granted.

Summary: Petition and Request for Reexamination are GRANTED.

RESPONSE TIMES ARE SET TO EXPIRE AS FOLLOWS:

For Patent Owner's Statement (optional): TWO months from the mailing date of this decision. 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, either alone or in any reasonable combination. Any statements filed must be served upon the reexamination requester in accordance with section 1.248. EXTENSIONS OF TIME ARE GOVERNED BY 37CFR 1.550(c).

For Requestor's reply (optional): TWO MONTHS from the date of service of any Patent Owner's Statement. 37CFR 1.535. NO EXTENSION OF TIME IS PERMITTED. If Patent Owner does not file a timely Statement under 37 CFR 1.530(c), no reply by the Requestor is permitted.

Inquires related to thisdecision may be directed to Special Programs Examiner Kenneth Dorner at (571) 272-6587.

Lissi Marquis, Director
Central Reexamination Unit

Kjd:9/21/06

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,762	10/12/2005	5119382	2500.507	6530

20995 7590 04/16/2008

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/16/2008

Please find below and/or attached an Office communication concerning this application or proceeding.

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Matthew A. Pequignot, Esq.
Hall Vande Sande & Pequignot
10220 River Road Suite 200
Potomac, MD 20854

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/007,762*.

PATENT NO. *5119382*.

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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KNOBBE MARTENS OLSON & BEAR LLP (For Patent Owner)
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE CA 92614

MATTHEW A. PEQUIGNOT, ESQ (For Third Party Requester)
HALL VAN SANDE & PEQUIGNOT
10220 RIVER ROAD SUITE 200
POTOMAC, MD 20854

In re Reexamination Proceeding	:
C. Kennedy et al.	:
Control No. 90/007,762	: DECISION GRANTING PETITION
Filed: October 12, 2005	:
U.S. Patent No. 5,119,382	:
Attorney Docket No. 2500.507	:

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on March 26, 2008, for entry of late papers based upon unintentional delay.

The petition is before the Office of Patent Legal Administration (OPLA) for decision.

37 CFR 1.137(b) states, in part:

> "*Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by: (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in § 1.17(m); (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional ...."

The present petition under 37 CFR 1.137(b) includes, inter alia, the requisite response (Revised Response To Ex Parte Reexamination Advisory Action[1] - item 1), an authorization to charge counsel's deposit account for the $1,540.00 petition fee under 37 CFR 1.17(m) (item 2), the requisite statement (item 3) and a Certificate of Service on the Third Party Requester.

---

[1] It is noted that on March 19, 2008, a Response To Ex Parte Reexamination Advisory Action ("Response") was filed. The "Response" appears to be a duplicate of the Revised Response To Ex Parte Reexamination Advisory Action filed March 26, 2008.

The petition for entry of the late papers is granted.

$1,540.00 has been charged to counsel's deposit account no. 11-1410 in accordance with the present petition.

Jurisdiction over the reexamination proceeding is being returned to Central Reexamination Unit (CRU) Art Unit 3992 for further examination and consideration of the Revised Response To Ex Parte Reexamination Advisory Action filed March 26, 2008, 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, 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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CENTRAL REEXAMINATION UNIT

Keith E. George
McDermott, Will & Emery
600 13th St., N.W.
Washington, D.C. 20005 (For Patent Owner)

W. Scott Petty
King & Spalding LLP
191 Peachtree St., N.E.
Atlanta, GA 30303 (For Third Party Requester)

In re Kanterakis et al.	:	
Ex parte Merged Reexamination Proceedings	:	**DECISION DISMISSING REQUEST**
Control Nos: 90/007,767 & 90/008,291	:	**TO SUSPEND *EX PARTE***
Filed: Oct. 20, 2005 & Nov. 14, 2006	:	**REEXAMINATION PROCEEDINGS**
For: U.S. Patent No.: 6,574,267	:	

This is a decision on the patent owner papers filed on January 2, 2008, entitled "Petition for Suspension Under 37 C.F.R. 1.103."

The patent owner papers are before the Office of Patent Legal Administration for consideration.

For the reasons set forth below, the patent owner petition to suspend *ex parte* reexamination is dismissed. The *ex parte* merged reexamination proceeding for Control No. 90/007,767 & 90/008,291 will proceed with special dispatch.

FEES

The petition fee of $400 for the merged proceeding has been charged to patent owner's deposit account, pursuant to the authorization for same on page 2 of the Jan. 2, 2008, petition.

BACKGROUND

1. Patent number 6,574,267 (the '267 patent) issued on June 3, 2003, with claims 1-29.

2. A third party, Nokia, Inc., filed a request for *ex parte* reexamination of claims 1-29 on October 20, 2005 that was assigned control no. 90/007,767 (the '7767 proceeding.)

3. A concurrent litigation was identified in the U.S. District Court for the Eastern District of Texas, as Case No. 2:05-CV-151, styled *Golden Bridge Technology, Inc. v. Nokia, Inc. et al.*, filed May 6, 2005. The decision of the District Court that claims 13 and 23 of the '267

patent are anticipated is currently on appeal at the U.S. Court of Appeals for the Federal Circuit, Appeal No. 2007-1215 with oral arguments scheduled for Feb. 5, 2008.

4. Reexamination of claims 1-29 was ordered on Dec. 29, 2005, for the'7767 proceeding.

5. A first Office action was issued on July 25, 2006, rejecting all claims of the '267 patent, in the'7767 proceeding.

6. The third party, Nokia Inc., filed a second request for *ex parte* reexamination of claims 13 and 23-29 of the '267 patent on October 20, 2006 that was assigned control no. 90/008,291 (the '8291 proceeding.)

7. Reexamination of claims 13 and 23-29 was ordered on Feb. 2, 2007, for the'8291 proceeding.

8. The '7767 and '8291 proceedings were merged, *sua sponte*, in a decision mailed August 22, 2007.

9. A final rejection was mailed Oct. 15, 2007, in which claims 1-26 and 30-58 were finally rejected and claims 27-29 and 59-74 were indicated as being patentable.

10. A Notice of Appeal was filed in the merged proceeding on Dec. 17, 2007.

11. On Jan. 10, 2008, patent owner filed this petition to suspend reexamination proceedings until the Federal Circuit has decided the appeal with regard to claims 13 and 23 of the '267 patent.

DECISION

I. Pertinent Regulations

35 U.S.C. § 305 Conduct of reexamination proceedings.

After the times for filing the statement and reply provided for by **section 304** of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of **sections 132** and **133** of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of **section 301** of this title, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office.

37 C.F.R. 1.182 Questions not specifically provided for.

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 C.F.R. 1.565 Concurrent office proceedings which include an *ex parte* reexamination proceeding.

(a) In an *ex parte* reexamination proceeding before the Office, the patent owner must inform the Office of any prior or concurrent proceedings in which the patent is or was involved such as interferences, reissues, *ex parte* reexaminations, *inter partes* reexaminations, or litigation and the results of such proceedings. See § **1.985** for notification of prior or concurrent proceedings in an *inter partes* reexamination proceeding.

(b) 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. See § **1.987** for *inter partes* reexamination proceedings.

II. The Nature of the Petition

A suspension for cause under 37 CFR 1.103 is not available in reexamination proceedings. 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 follow 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.

Rather, the present petition should have been filed under 37 CFR 1.182 with the fee set forth in 37 CFR 1.17(f) requesting relief not otherwise provided for in the rules. As the petition appears to be a *bona fide* attempt at requesting relief, and in view of the Office's duty to conduct ex parte reexamination proceedings with special dispatch within the Office under 35 U.S.C. § 305, the petition is being taken as a petition under § 1.182.

III. Findings and Analysis

Pursuant to 37 CFR 1.565(a), patent owner has advised the Office of concurrent proceedings in the U.S. District Court for the Eastern District of Texas and the Court of Appeals for the Federal Circuit. Petitioner patent owner requests that the present "reexamination proceeding be suspended until the Federal Circuit has decided the appeal of the District Court decision."

In *Ethicon v. Quigg*[1] 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."[2]

---

[1] *Ethicon v. Quigg, 849 F.2d 1422 (Fed. Cir. 1988)*
[2] *Id. at 1425*

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.)*

Petitioner has requested an indefinite suspension in this merged proceeding, and this request will not be granted.

In addition, the issues on appeal at the Federal Circuit for which a final decision could issue are limited to only two patent claims, while the present merged reexamination proceeding involves 74 patent claims, including original patent claims and new proposed patent claims. Presently, in the reexamination proceedings, claims 1-25 and 30-58 are finally rejected, and claims 27-29 and 59-74 have been confirmed as patentable over the prior art. Patent owner has filed a Notice of Appeal pertaining to the final rejection of claims 1-25 and 30-58. Regardless of the outcome of the Federal Circuit appeal pertaining to claims 13 and 23, reexamination must continue for claims 1-12, 14-22, and 24-74. The issuance of a final decision in the related Federal Circuit case will, at most cause, reexamination of claims 13 and 23 only to be terminated, and will have no effect on the remaining 72 claims in the proceeding.

Should the Federal Circuit finally decide that claims 13 and 23 are invalid, reexamination of these claims will cease, as a final Federal Court holding of invalidity or unenforceability (after all appeals) is binding on the Office. Upon the issuance of the final holding, reexamination of the claims 13 and 23 would be terminated. However, the concurrent Federal Court case only pertains to claims 13 and 23. Therefore, reexamination of the remaining 72 claims will continue through the appeal process and ultimately to the issuance of a reexamination certificate regardless of the outcome of the litigation. Should the Federal Circuit finally decide that claims 13 and 23 are valid, termination of the reexamination as to those claims will not be mandated. Issuance of a final Federal Court

decision upholding the validity during an *ex parte* reexamination has no binding effect on the reexamination proceeding. *See Ethicon v. Quigg*, 849 F.2d 1422, 1428, 7 USPQ2d 1152, 1157 (Fed. Cir. 1988).

In view of the above, the petition is dismissed, and the reexamination proceeding will be continued with special dispatch within the Office.

CONCLUSION

1. The patent owner petition filed on Jan. 2, 2008, is dismissed.

2. The merged '7767 and '8291 *ex parte* reexamination proceeding will not be suspended and will proceed with special dispatch.

3. Jurisdiction over the proceedings is being returned to the Central Reexamination Unit, Art Unit 3992, for appropriate action in due course.

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

2-7-08
C:\Kiva\Kenpet6\8291 & 7767_ decision dismissing suspension req.doc

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AUG 0 9 2007

CENTRAL REEXAMINATION UNIT

James Y. Go
BLAKELY SOKOLOFF TAYLOR
& ZAFMAN LLP
12400 Wilshire Boulevard, 7th Floor
Los Angeles CA 90025

For Patent Owner

Richard V. Burgujian, Esq.
FINNEGAN HENDERSON FARABOW
GARRET & DUNNER LLP
901 New York Avenue NW
Washington, DC 20001-4413

For Third Party Requester

DECISION, *SUA SPONTE*
MERGING
REEXAMINATION
PROCEEDINGS

In re: Balakrishnan *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/007,771
Filed: October 21, 2005
For: US Patent No. 6,212,079

In re: Balakrishnan *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,376
Filed: December 14, 2006
For: US Patent No. 6,212,079

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. 6,212,079 issued on April 3, 2001.

2. *Ex Parte* Reexamination Proceeding, control no. 90/007,771 was requested by a third party requester on October 21, 2005.

3. The Reexamination Order was granted in proceeding, control no. 90/007,771 on December 27, 2005.

4. There are currently no amendments proceeding control number 90/007,771.

5. *Ex Parte* Reexamination Proceeding, control no. 90/008,376 was requested by a third party requester filed on December 14, 2006.

6. The Reexamination Order was granted in proceeding, control no. 90/008,376 on February 9, 2007.

7. There are currently no amendments proceeding control number 90/008,376.

8. Proceedings control numbers 90/007,771 and 90/008,376 awaits the first Office action on the merits from the assigned examiner.

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 90/007,771 and 90/008,376 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. 90/007,771 and 90/008,376 are **MERGED**.

2. The reexamination files are being forwarded to the examiner for issuing a first Office action.

3. All correspondence regarding these proceedings should be submitted as follows:

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450

By Fax to: (571) 273-9900
Central Reexamination Unit

By Hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

3. 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 M. Marquis,
Director,
Central Reexamination Unit

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CENTRAL REEXAMINATION UNIT

James Y Go
Blakely Sokoloff Taylor & Zafman LLP
7th Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025

(For Patent Owner)

Richard V. Burgujian, Esq.
Finnegan Henderson Farabow
Garret & Dunner LLP
901 New York Avenue NW
Washington, DC 20001-4413

(For Requester)

In re: Balakrishnan *et alia*
Reexamination Proceeding
Control No. 90/007,771
Request Deposited: October 21, 2005
For: U.S. Patent No. 6,121,079

In re: Balakrishnan *et alia*
Reexamination Proceeding
Control No. 90/008,376
Request Deposited: December 14, 2006
For: U.S. Patent No. 6,121,079

DECISION ON PETITION
FILED UNDER 37 CFR 1.181

The *ex parte* reexamination is before the Director of the Central Reexamination Unit for consideration of the petition filed October 12, 2007 requesting resetting the shortened statutory period (SSP) for response and requesting 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. 6,212,079 (hereinafter, the '079 patent), issued to Balakrishnan *et alia*, on April 3, 2001.

2. On October 21, 2005, a third party deposited a Request for *Ex Parte* Reexamination of the '457 patent. The reexamination proceeding was assigned Control No. 90/007,771 (hereinafter, the '7771 proceeding).

3. The reexamination order was granted in the '7771 proceeding on December 27, 2005.

4. On December 14, 2006, a third party deposited a Request for *Ex Parte* Reexamination of the '457 patent. The reexamination proceeding was assigned Control No. 90/008,376 (hereinafter, the '8376 proceeding).

5. The reexamination order was granted in the '8376 proceeding on February 9, 2007.

6. The '7771 and '8376 proceedings were merged on August 9, 2007.

7. A non-final office action was mailed on October 1, 2007 setting a shortened period for response of 1 month.

DECISION

Petitioner points out that one of the conditions set forth in MPEP 2263 that would permit a shortened statutory period of one month has not been met. Specifically, the action was not signed by the Director or Deputy Director of OPLA, the Director of the CRU, or the Director of the Technology Center in which the reexamination is being conducted. Petitioner is correct. Although the petition is silent as to the other conditions under which a SSP can be set to one month, the present proceedings are not court-ordered reexaminations and litigation is not stayed for purposes of the reexamination. It is noted that litigation is stayed pending final determination of an appeal from the International Trade Commission (ITC). However, litigation is not stayed for purposes of the present merged reexaminations. Therefore, there is no basis to set the SSP to one month. The SSP in the office action mailed October 1, 2007 should have been set to expire 2 months from the mailing date.

Petitioner also requests that the office action of October 1, 2007 be remailed. There appears to be no basis for the requested relief. A review of the record indicates that a second non-final office action was mailed on October 19, 2007. That action withdrew the office action mailed October 1, 2007 and set the SSP to 2 months. Accordingly, petitioner's requests are dismissed as moot.

CONCLUSION

1. Petitioner's requests are dismissed as moot. The non-final office action mailed October 19, 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

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.
90/007,771	10/21/2005	6212079	09578.0006	2759

7590 03/06/2009

EXAMINER

JAMES Y. GO
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
1279 OAKMEAD PARKWAY
SUNNYVALE, CA 94085-4040

ART UNIT	PAPER NUMBER

DATE MAILED: 03/06/2009

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
RICHARD V. BURGUJIAN, ESQ.
FINNEGAN HENDERSON FARABOW GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001

Date: MAILED

MAR 06 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007771
PATENT NO. : 6212079
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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United States Patent and Trademark Office
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CENTRAL REEXAMINATION UNIT

JAMES Y. GO
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
1279 OAKMEAD PARKWAY
SUNNYVALE CA 94085-4040

(For Patent Owner)

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

(For Requester)

In re: Balakrishnan *et alia* Reexamination Proceeding Control No. 90/007,771 Request Deposited: October 21, 2005 For: U.S. Patent No. 6,121,079	**DECISION ON PETITION UNDER 37 CFR 1.59**
In re: Balakrishnan *et alia* Reexamination Proceeding Control No. 90/008,376 Request Deposited: December 14, 2006 For: U.S. Patent No. 6,121,079	

DECISION

This is a decision on the petition under 37 CFR 1.59(b), filed August 31, 2006, to expunge information from the above identified proceedings.

The petition is **granted**.

Petitioner requests that documents entitled

COMPLAINANT POWER INTEGRATIONS, INC.'S POSTHEARING STATEMENT, In the Matter of CERTAIN POWER SUPPLY CONTROLLERS AND PRODUCTS CONTAINING THE SAME, United States International Trade Commission, Washington, DC 20436, Before the Honorable Paul J. Luckern, Administrative Law Judge, Inv. No. 337-TA-541, February 10, 2006;

RESPONDENT SYSTEM. GENERAL CORPORATION'S POST-HEARING BRIEF. In the Matter Of CERTAIN POWER SUPPLY CONTROLLERS AND PRODUCTS CONTAINING THE SAME. United State, International Trade Commission, Washington. DC 20436. Before the Honorable Paul J. Luckern, Administrative Law Judge, Inv. No. 337-TA-541, February 10, 2006; and

POST-HEARING BRIEF OF THE COMMISSION INVESTIGATIVE STAFF, In the Matter of CERTAIN POWER SUPPLY CONTROLLERS AND PRODUCTS CONTAINING SAME, United States International Trade Commission, Washington, DC 20436, Before the Honorable Paul J. Luckern, Administrative Law Judge, Inv. No. 337-TA-541, February 14, 2006

, filed August 28, 2006, be expunged from the record. It is noted that the documents and petition were submitted in 90/007,771 only. 90/007,771 was subsequently merged with 90/008,376. 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 proceeding.

Patent Owner is required to retain the expunged material(s) for the life of any patent which issues on the above-identified patent.

The expunged material has been removed from the official file. Since this proceeding is not a paper file, the return of the expunged material may not be possible in an Image File Wrapper (IFW) proceeding where a paper is entered into the record. Instead, such papers are marked "closed" and "not public".

CONCLUSION

1. Petitioner's request is **granted**.

2. Patent Owner is **required** to retain the expunged material(s) for the life of any patent which issues on the above-identified patent.

3. **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.

4. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929.

Eric Keasel for

Gregory Morse
Director, Central Reexamination Unit

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : October 13, 2009

TO SPE OF : ART UNIT 3992 - Lynne H. Browne

SUBJECT : Request for Certificate of Correction for Appl. No. 90/007,771 and 90/008,376 Patent No.: 6,212,079 C1

Please respond to this request for a certificate of correction within 7 days.

FOR IFW FILES:

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

FOR PAPER FILES:

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (CofC)
Randolph Square Building
2800 South Randolph Street
Arlington, VA 22206

Antonio Johnson

Should FIG. 2 be substituted?

Certificates of Correction Branch

(571)272-0483

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

- ☒ **Approved** — **All** changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

Comments: _____

approved

MARK J. REINHART
CRU SPE AU 3992

28 Oct 2009

PTOL-306 (REV. 7/03)

U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

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CENTRAL REEXAMINATION UNIT

KOBBE MARTENS OLSON & BEAR LLP (For Patent Owner)
2040 MAIN STREET
14th floor
Irvine, CA 92614

In re Robert C. Barris	:
Reexamination Proceeding	:
Control No.: 90/007,776	: **DECISION**
Filed: October 25, 2005	: **ON PETITION**
For: U.S. Patent No.: 5,434,797	: **UNDER 37 CFR 1.182**
	:

This is a decision on the April 25, 2008 patent owner petition under 37 CFR 1.182 to enter, and 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 April 25, 2008, has not been entered for consideration by the examiner.

BACKGROUND

1. Patent number 5,434,797 issued on July 18, 1995 (the '797 patent) and claims the benefit of U.S. Application number 898,827 filed June 15, 1992 which was abandoned.
2. On October 25, 2005 patent owner filed a request for the reexamination of the '797 patent. The request was assigned reexamination control No. 90/007,776 (the '7776 proceeding).
3. On December 30, 2005 the Office issued an order granting the '7776 reexamination request.
4. The '7776 proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) issued on April 10, 2008.
5. On April 25, 2008, patent owner filed a petition under 37 CFR 1.182 to enter, and have the examiner consider, an information disclosure statement (IDS)
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 states (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. (Emphasis added.)

MPEP 2256 states (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)

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 Notice of Intent to Issue a Reexamination Certificate (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 the petition does not provide a full ***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 substantive attempt is made to satisfy the guidance of MPEP 2256. The patent owner has not provided a full factual accounting to explain why the information is being submitted so late, nor has patent owner explained the relevance of the submitted information with respect to the claim limitations in the present reexamination proceeding.

In regards to providing a factual accounting (A) to explain why the information could not be submitted earlier, the petitioner/patent owner only indicates that the references were "recently" located in a file for a related matter after the NIRC was issued by the Office. This is not a full and proper factual accounting in accordance with MPEP 2256 guidance. Patent owner does not include when they became aware of the information, when they realized the other matter was "related" to the '7776 proceeding and offers only a generalized partial explanation as to why it could not submit the references any earlier, namely because it was at some undisclosed time post NIRC. However, patent owner presents no specifics as to how they went about insuring that all references that came up in the "related matter" were timely reviewed for relevancy, and if found relevant, seasonably presented in the '7776 proceeding. If the "related" nature of the other matter was not established until after NIRC in the '7776 proceeding and the time period from this point until the point the references were submitted to the Office was established then a proper showing under item (A) maybe established. However, no such showing has been proffered by patent owner. Therefore, without a detailed and meaningful factual accounting as to the delay in IDS submission, it is unclear as to why there would any delay in submitting the references pre-NIRC in addition to the fifteen day delay from NIRC issuance until receipt in regard to the IDS submission in the '7776 proceeding. Accordingly, patent owner has failed to satisfy the MPEP 2256, item (A), requirement for submission of a post-NIRC IDS.

In regard to explaining the relevance of the submitted information (B), the patent owner makes only a broad generalization about the content of the references, concluding that the documents either do not qualify as prior art by date and/or not qualifying as a printed publication, or that despite their teachings, the reasons for confirmation still stand. Such statements do not constitute an explanation of relevance with respect to the limitations of the claimed invention. Instead they amount to nothing more than a broad characterization of the references un-tethered to the limitations of the claimed invention. Therefore, patent owner has failed to satisfy the MPEP 2256, item (B), requirement for submission of a post NIRC IDS.

In summary, patent owner does not make a full factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier; nor does patent owner explain the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. Therefore, the present petition does not satisfy either of 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 January 7, 2008, 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 (factual accounting and explanation of relevance) 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 which is *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 April 1, 2008.

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

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

MAILED
MAY 01 2006
REEXAM UNIT

David S. Bradin
Womble Carlyle Sandridge & Rice LLP
1201 W. Peachtree Street
Suite 3500
Atlanta, GA 30309

(For Requester)

In re Surtec International GMBH
Reexamination Proceeding
Control No.: 90/007,777
Filed: October, 25, 2005
For: U.S. Patent No. 6,287,704 B1

: DECISION ON PETITION TO
: VACATE ORDER
: GRANTING REEXAMINATION

This is a decision on the February 14, 2006 patent owner petition entitled "PETITION UNDER 37 CFR 1.181 TO VACATE *ULTRA VIRES* REEXAMINATION ORDER." No fee is required for the petition, and a refund of the $ 400.00 petition fee tendered with the petition will be credited to Deposit Account No. 16-0820. No requester opposition to the petition to vacate has been filed. [1]

The proceeding and the patent owner petition are before the Office of Patent Legal Administration.

SUMMARY

A. The petition to vacate is dismissed for the reasons set forth below.

B. The December 21, 2005 order granting reexamination in the 90/007,777 proceeding remains intact.

REVIEW OF FACTS

1. U. S. Patent No. 6,287,704 (the '704 patent) issued on September 11, 2001.

[1] The present patent owner petition was served on third party requester on February 14, 2006. With respect to the filing of a petition in opposition to a petition to vacate a reexamination order, MPEP § 2246(I) states that "[B]ecause reexamination proceedings are conducted with special dispatch, 35 U.S.C. § 205, any such opposition by the third party requester must be filed within two weeks of the date upon which a copy of the original 37 CFR 1.181 petition was served on the third party requester to ensure consideration."

2. A first request for *ex parte* reexamination of the '704 patent was filed on January 25, 2002 and assigned control number 90/006,211 (the '211 reexamination proceeding).

3. A second request for *ex parte* reexamination of the '704 patent was filed on June 20, 2003 and assigned control number 90/006,672 (the '672 reexamination proceeding).

4. The '211 and '672 reexamination proceedings were merged into a single combined *ex parte* reexamination proceeding on March 5, 2004.

5. During the prosecution of the '211 reexamination proceeding prior to the merger, U.S. Patent 5,268,655 A to Klos (the Klos patent) and a publication entitled "Summer 1982 Transactions of the Institute of Metal Finishing, Volume 60, Part 2, "Non Chromate Passivation Treatment for Zinc", page 46 (Barnes publication) were specifically considered on the record with respect to the patentability of the claims of the '704 patent.

6. Subsequent to the merger of the '211 and '672 reexamination proceedings, the Klos patent and the Barnes publication were before the examiner in the merged proceeding.

7. *Ex Parte* Reexamination Certificate US 6,287,704 C1 issued for the merged proceeding on November 30, 2004.

8. A third request for *ex parte* reexamination of the '704 patent was filed on October 25, 2005 and assigned control number 90/007,777. This is the present proceeding, and it is hereinafter referred to as the '777 reexamination proceeding .

9. Reexamination was ordered for the 90/007,777 proceeding on December 21, 2005.

10. The order for reexamination in the '777 reexamination was based entirely upon prior art that had been considered and discussed on the record in the concluded merged reexamination proceeding, including the Klos patent and the Barnes publication, based upon viewing the previously considered prior art in a new light in view of a declaration of William Rosenberg (the Rosenberg declaration) that had not been of record in the merged proceeding.

11. On February 14, 2006, the patent owner filed the present petition under 37 CFR 1.181 to vacate the '777 proceeding.

12. A patent owner's statement under 37 CFR 1.530 has not been received in the '777 reexamination proceeding.

DECISION ON PETITION TO VACATE THE DECEMBER 21, 2005 ORDER GRANTING REEXAMINATION

35 U.S.C. 303(a) states

> "(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. On his own initiative, and any time, the Director may determine whether a substantial new question of patentability is raised by patents and publications discovered by him or cited under the provisions of section

301 of this title. 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 § 2217 states, in part:

"Affidavits or declarations which explain the contents or pertinent dates of prior art patents or printed publications in more detail may be considered in reexamination. See MPEP § 2258."

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;"

MPEP § 2258(E) states:

"Affidavits or declarations which explain the contents or pertinent dates of prior art patents or printed publications in more detail may be considered in reexamination, but any rejection must be based upon the prior art patents or printed publications as explained by the affidavits or declarations. The rejection in such circumstances cannot be based on the affidavits or declarations as such, but must be based on the prior art patents or printed publications."

MPEP § 2258.01 states, in part:

"For a reexamination that was ordered on or after November 2, 2002 (the date of enactment of Public Law 107-273; see Section 13105, of the Patent and Trademark Office Authorization Act of 2002), reliance solely on old art (as the basis for a rejection) does not necessarily preclude the existence of a substantial new question of patentability (SNQ) that is based exclusively on that old art. Determinations on whether a SNQ exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis. For example, a SNQ may be based solely on old art where the old art is being presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request."

Review of the Request for Reexamination

The present request for reexamination, filed on October 25, 2005, cited three United States patents (including the Klos patent), the Barnes publication, and the Rosenberg declaration in order to establish the existence of a substantial new question of patentability. In the request for reexamination, the third party requester asserted that the Rosenberg declaration established that certain claim limitations were inherently present in the Klos patent and in the Barnes publication. The third party requester's position was that the Klos patent and the Barnes publication each raised a substantial new question of patentability with respect for independent claims 1 and 21 of the '704 patent, because they each teach all of the limitations of these claims

when the inherent teachings of these documents (as demonstrated by the Rosenberg declaration) are considered. [2]

Review of the Order Granting Reexamination

The examiner's order granting reexamination:

1. Held that the request for reexamination raised substantial new questions of patentability with respect to claims 1-30, 32 and 36-38 of the '704 patent,

2. Found no new substantial question of patentability with respect to claims 31, 33-35 and 39-62 of the '704 patent, and

3. Determined that all claims of the '704 patent would be reexamined.

The substantial new questions of patentability that were found to exist were based upon "old art" [3], principally the Klos patent and the Barnes publication, when considered in a new light in view of the newly provided Rosenberg declaration. The examiner expressly stated that the Rosenberg declaration, which was not of record in the concluded merged *ex parte* reexamination proceeding, taught that certain of the claim limitations are inherently present in the Klos patent and in the Barnes publication. [4]

Review of Patent Owner's Argument for Vacatur

In the instant petition to vacate the reexamination order, the patent owner does not appear to contest that *ex parte* reexamination may properly be ordered based upon prior art previously considered and discussed on the record of a prior *ex parte* reexamination proceeding ("old art"), provided that the old art is presented in a new light. However, patent owner argues that the Rosenberg declaration does not merely explain the contents of the Klos patent and Barnes publication as would be permissible, but instead presents extrinsic evidence in the form of experiments conducted with the benefit of hindsight with respect to the Klos patent and the Barnes publication and that states what declarant Rosenberg "believes might have been inherent in" the Klos patent and Barnes publication. [5]

Patent owner also argues that if a rejection is made on either the Klos patent or the Barnes publication, the examiner will have to rely on declarant Rosenberg's experiments to support a conclusion that certain claim limitations are inherent in those references, and that the experiments themselves will therefore have to be raised to support the rejections. Patent owner opines that reliance on the experiments themselves would be improper because the rejection would not then be based upon prior art patents or printed publications. [6]

Patent owner also asserts that if a rejection is made in this proceeding that is supported by the Rosenberg declaration, the patent owner will not have an opportunity to challenge the veracity of declarant Rosenberg's conclusions, the integrity of his experiments, his experience in the art,

---

[2] It is noted that patent owner's position is that if independent claims 1 and 21 are patentable because no substantial new question of patentability can properly be raised against them, then no substantial new question of patentability can exist with respect to any of the '704 patent claims. See petition, page 7, third full paragraph through page 8.

[3] See *In re Hiniker*, 150 F.3d 1362, 2365-66, 47 USPQ2d 1523, 1526 (Fed. Cir. 1998) which coined the term "old art."

[4] Order granting reexamination, in particular, paragraphs 5 and 8.

[5] Petition, page, 3, penultimate paragraph through page 4, first full paragraph.

[6] *Id.*, at page 5 last paragraph.

the assumptions he has made, and his selection of parameters. While patent owner acknowledges that *In re Chambers et al,* 20 USPQ2d 1470 (Comm'r. Pat. 1991) held affidavits and declarations to be permissible in *ex parte* reexamination proceedings "to help define the scope and content of the prior art," patent owner attempts to distinguish the holding in *Chambers* by arguing that *Chambers* does not authorize consideration of a declaration to introduce extrinsic, non-publication evidence that goes beyond the teachings of a prior art reference, rather than simply explaining those teachings. [7]

Findings

I. The December 21, 2005 Order Granting The Request For Reexamination Is Appropriately Based On Prior Art Patents and Printed Publications

Although the request for reexamination cites and relies upon prior art patents which are alleged by the third party requester to raise substantial new questions of patentability as to one or more of the '704 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 the experiments underlying the Rosenberg declaration. According to patent owner, the examiner will have to rely upon the experiments conducted by declarant Rosenberg to demonstrate that the Klos patent and the Barnes publication teach the subject matter of claims 1 and 21 of the '704 patent, and that such is not permitted by the *ex parte* reexamination statute, which require the finding of a substantial new question of patentability to be based upon prior art patents and/or printed publications.

Patent owner's argument that the Rosenberg declaration does not explain the content of the Klos patent or the Barnes publication, but instead constitutes intrinsic evidence going beyond those documents and constitutes extrinsic, non-publication evidence, is not well taken. It is well settled that extrinsic evidence may be considered in *ex parte* reexamination proceedings when it is used to explain, but not expand, the meaning of a reference. See *In re Baxter Travenol Labs,* 952 F.2d 388, 390, 21 USPQ2d 1281, 1284 (Fed. Cir. 1991). Also, as stated in *In re Chambers,* 20 USPQ2d 1470, 1474 (Comm'r Pats. 1991):

> "A rejection of a claim in a reexamination proceeding must be based upon patents and/or printed publications. It would be contrary to §§ 305 and 132 to preclude consideration of other 'information' (*e.g.*, affidavits, declarations and transcripts) to define the scope and content of the prior art, or to establish that a claimed invention is not anticipated under 35 U.S.C. §102 or unpatentable under 35 U.S.C. §103 based on obviousness."

Further, the courts have addressed the question of inherent disclosure many times. Uniformly, the courts have held that when a given document is shown to contain disclosure that is not expressly set forth therein, but exists within the document as an inherent consequence of the express disclosure, **that document** is considered to teach that inherent disclosure. As one example, in *Smithkline Beecham Corporation et al v. Apotex Corporation et al,* 403 F.3d 1331, 74 USPQ2d 1396 (Fed. Cir. 2005), the court decided an issue of inherent disclosure. In resolving the issue the court stated (403 F.3d at 1344, 74 USPQ2d at 1406):

> "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.*" (Emphasis in the original.)

[7] *Id,* at page 5, first full paragraph.

The court went on to state (403 F.3d at 1345, 74 USPQ2d at 1407):

> "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 court holds that the '196 *patent* inherently anticipates claim 1 of the *'723 patent* under 35 U.S.C. 102(b)." (Emphasis in the original.)The *Smithkline Beecham* court also stated that "inherent anticipation does not require a person of ordinary skill in the art to recognize the inherent disclosure in the prior art at the time the prior art is created." *Id.*, at 1344, at 1406.

It is clear from a consideration of the *Chambers* and *Baxter Travenol* decisions that extrinsic evidence in the form of a declaration may be used to explain the teachings of a prior art patent or printed publication in *ex parte* reexamination proceedings. It is equally clear from the *Smithkline Beecham* decision that when extrinsic evidence is used to explain the inherent teachings of a prior art patent or printed publication, it is the patent or publication that is considered to be "the reference," and not the extrinsic evidence. Further, the decision in *Smithkline Beecham* makes it clear that even if the Rosenberg declaration is based upon "hindsight," it would nevertheless be proper to adduce inherent disclosure in the cited prior art patents and printed publication using extrinsic evidence in the form of the Rosenberg declaration, notwithstanding that one of ordinary skill in the art may not have initially understood these references as teaching that inherent disclosure at the time that the references were published.

Thus, the examiner's decision in the Order Granting *Ex Parte* Reexamination dated December 21, 2005 is based upon the applied prior art patents and printed publications, and the Rosenberg declaration, or the experiments underlying the statements of declarant, are employed to understand the scope and content of that prior art. Further, because the Rosenberg declaration was not of record in the prior merged reexamination proceeding, and serves to raise a significant question of patentability based upon inherent disclosure in the prior art patents (including the Klos patent) and the Barnes publication that was not considered during the prior merged reexamination proceeding, the Order Granting *Ex Parte* Reexamination is found to raise a substantial new question of patentability as required by 35 U.S.C. 303(a).

II. Patent Owner Will Be Able To Challenge The Rosenberg Declaration As To Both Form And Substance

The request for reexamination has been found by the Office to raise the issue of the inherency in the three prior art patents (including the Klos patent) cited in the request, and in the Barnes publication. 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 patents and publications based on the issue of inherent disclosure inherency discussed above. Patent owner, however, argues that if a rejection is made in this proceeding based upon the prior art as construed in light of the Rosenberg declaration, then patent owner will not have an opportunity to challenge the veracity of declarant Rosenberg's conclusions, the integrity of his experiments, his experience in the art, the assumptions he has made, and his selection of parameters. This argument is not persuasive.

In the event that the examiner holds any of the patent claims to be unpatentable over the Klos patent and/or the Barnes article (or any of the "old art" of record in the prior merged reexamination proceeding) based on a finding that the Rosenberg declaration demonstrates these references to contain inherent disclosure not appreciated in the prior merged

reexamination proceeding, then patent owner will be able to address both the formal sufficiency and the technical sufficiency of that declaration during the examination phase of the present reexamination proceeding. The various criticisms of the Rosenberg declaration expressed by patent owner in this petition, *e.g.*, the veracity of declarant Rosenberg's conclusions, the integrity of his experiments, his experience in the art, the assumptions he has made, and his selection of parameters, all are directed to patentability issues that *are not petitionable issues.* In the event that the examiner rejects claims utilizing the Rosenberg declaration to adduce inherent disclosure in the prior art patents and/or the printed publication, the patent owner may raise any or all of these issues, and such issues as are raised can be resolved in the examination process before the examiner, or possibly on appeal. During examination (and possibly appeal), patent owner would have various avenues by which the Rosenberg declaration might be rebutted; patent owner is free to provide arguments, and/or submissions of factual and evidentiary showings (including verified submissions under 37 CFR 1.132) that may reflect analysis by individuals of ordinary skill in the art to which the claims pertain. It is not the function of the petition process to determine the weight to be given to an affidavit or declaration, or to resolve the application of the prior art with respect to the ultimate claim patentablility issue. 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. In this instance, (a) the issue of interpreting the cited prior art based on the position of inherency advanced via the proffered declaration has never been determined in the prior merged reexamination proceedings, and (b) the order granting reexamination is not a final agency action. These factors weigh heavily in favor of allowing the reexamination proceedings to continue. The ultimate issue of patentability based upon the cited references can then be determined during the examination stage of this proceeding.

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 patentability raised in the October, 25, 2005 reexamination request properly raised a substantial new question of patentability.

CONCLUSION

1. The petition under 37 CFR 1.181 to vacate the reexamination order dated December 21, 2005, as being a *ultra vires* action on the part of the Office, is dismissed.

2. The reexamination proceeding is being returned to the jurisdiction of the Central Reexamination Unit (CRU) for the issuance of a first Office action under 37 CFR 1.550(a) in due course.

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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April 26, 2006

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4-28-06

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For Patent Owner

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CENTRAL REEXAMINATION UNIT

Richard V. Burgujian, Esq.
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For Third Party Requester

DECISION, *SUA SPONTE*
MERGING
REEXAMINATION
PROCEEDINGS

In re: Balakrishnan *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/007,781
Filed: October 26, 2005
For: US Patent No. 6,351,398

In re: Balakrishnan *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,364
Filed: December 16, 2006
For: US Patent No. 6,351,398

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. 6,351,398 issued on February 26, 2002.

2. *Ex Parte* Reexamination Proceeding, control no. 90/007,781 was requested by a third party requester on October 26, 2005.

3. The Reexamination Order was granted in proceeding, control no. 90/007,781 on December 27, 2005.

4. There are currently no amendments proceeding control number 90/007,781.

5. *Ex Parte* Reexamination Proceeding, control no. 90/008,364 was requested by a third party requester filed on December 6, 2006.

6. The Reexamination Order was granted in proceeding, control no. 90/008,364 on February 2, 2007.

7. There are currently no amendments proceeding control number 90/008,364.

8. Proceedings control numbers 90/007,781 and 90/008,364 awaits the first Office action on the merits from the assigned examiner.

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 90/007,781 and 90/008,364 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. 90/007,781 and 90/008,364 are **MERGED**.

2. The reexamination files are being forwarded to the examiner for issuing a first Office action.

3. All correspondence regarding these proceedings should be submitted as follows:

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450

By Fax to: (571) 273-9900
Central Reexamination Unit

By Hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

3. 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 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.
90/007,781	10/26/2005	6351398		2086

7590 03/06/2009

EXAMINER

James Y. Go
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1279 Oakmead Parkway
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ART UNIT	PAPER NUMBER

DATE MAILED: 03/06/2009

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
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Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
RICHARD V. BURGUJIAN, ESQ.
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Date:

MAILED

MAR 06 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007781
PATENT NO. : 6351398
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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United States Patent and Trademark Office
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(For Patent Owner)

MAILED

MAR 06 2009

CENTRAL REEXAMINATION UNIT

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

(For Requester)

In re: Balakrishnan *et alia*
Reexamination Proceeding
Control No. 90/007,781
Request Deposited: October 26, 2005
For: U.S. Patent No. 6,351,398

DECISION ON PETITION UNDER 37 CFR 1.59

In re: Balakrishnan *et alia*
Reexamination Proceeding
Control No. 90/008,364
Request Deposited: December 6, 2006
For: U.S. Patent No. 6,351,398

DECISION

This is a decision on the petition under 37 CFR 1.59(b), filed August 31, 2006, to expunge information from the above identified proceedings.

The petition is **granted**.

Petitioner requests that documents entitled

COMPLAINANT POWER INTEGRATIONS, INC.'S POSTHEARING STATEMENT, In the Matter of CERTAIN POWER SUPPLY CONTROLLERS AND PRODUCTS CONTAINING THE SAME, United States International Trade Commission, Washington, DC 20436, Before the Honorable Paul J. Luckern, Administrative Law Judge, Inv. No. 337-TA-541, February 10, 2006;

RESPONDENT SYSTEM. GENERAL CORPORATION'S POST-HEARING BRIEF. In the Matter Of CERTAIN POWER SUPPLY CONTROLLERS AND PRODUCTS CONTAINING THE SAME. United State, International Trade Commission, Washington. DC 20436. Before the Honorable Paul J. Luckern, Administrative Law Judge, Inv. No. 337-TA-541, February 10, 2006; and

POST-HEARING BRIEF OF THE COMMISSION INVESTIGATIVE STAFF, In the Matter of CERTAIN POWER SUPPLY CONTROLLERS AND PRODUCTS CONTAINING SAME, United States International Trade Commission, Washington, DC 20436, Before the Honorable Paul J. Luckern, Administrative Law Judge, Inv. No. 337-TA-541, February 14, 2006

, filed August 28, 2006, be expunged from the record. It is noted that the documents and petition were submitted in 90/007,781 only. 90/007,781 was subsequently merged with 90/008,364. 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 proceeding.

Patent Owner is required to retain the expunged material(s) for the life of any patent which issues on the above-identified patent.

The expunged material has been removed from the official file. Since this proceeding is not a paper file, the return of the expunged material may not be possible in an Image File Wrapper (IFW) proceeding where a paper is entered into the record. Instead, such papers are marked "closed" and "not public".

CONCLUSION

1. Petitioner's request is **granted**.

2. Patent Owner is **required** to retain the expunged material(s) for the life of any patent which issues on the above-identified patent.

3. **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.

4. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929.

Eric Keasel 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

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

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.
90/007,222 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.

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

8/3/2006

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)).

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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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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United States Patent and Trademark Office
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SEP 26 2007

CENTRAL REEXAMINATION UNIT

James Go
Blakely Sokoloff Taylor & Zafman LLP
3230 Carillon Point
Kirkland, WA 98033

(For Patent Owner)

Richard V. Burgujian, Esq.

Finnegan Henderson Farabow Garrett & Dunner LLP

901 New York, Ave., NW

Washington, DC 20001

(For Third Party Requester)

In re Patent Number 6366,481
Reexamination Control No.: 90/007,789
Filed: October 25, 2005
For: **METHOD AND APPARATUS PROVIDING A MULTI-FUNCTION TERMINAL FOR A POWER SUPPLY CONTROLLER**

RESPONSE TO PETITION UNDER 37 CFR 1.59

This is a response to the petition under 37 CFR 1.59(b), filed August 31, 2006, to expunge information from the above identified application.

The decision on the petition will be held in abeyance until mailing of a Notice of Intent to Issue *Ex Parte* Reexamination Certificate, at which time the petition will be decided.

Petitioner requests that documents entitled:

COMPLAINANT POWER INTEGRATIONS, INC.'S POSTHEARING STATEMENT, In the Matter of CERTAIN POWER SUPPLY CONTROLLERS AND PRODUCTS CONTAINING

THE SAME, United States International Trade Commission, Washington, DC 20436, Before the Honorable Paul J. Luckern, Administrative Law Judge, Inv. No. 337-TA-541, February 10, 2006;

RESPONDENT SYSTEM GENERAL CORPORATION'S POST-HEARING BRIEF. In the Matter of CERTAIN POWER SUPPLY CONTROLLERS AND PRODUCTS CONTAINING THE SAME. United State, International Trade Commission, Washington. DC 20436. Before the Honorable Paul J. Luckern, Administrative Law Judge, Inv. No. 337-TA-541, February 10, 2006; and

POST-HEARING BRIEF OF THE COMMISSION INVESTIGATIVE STAFF, In the Matter of CERTAIN POWER SUPPLY CONTROLLERS AND PRODUCTS CONTAINING SAME, United States International Trade Commission, Washington, DC 20436, Before the Honorable Paul J. Luckern, Adminstrative Law Judge, Inv. No. 337-TA-541, February 14, 2006

, filed August 31, 2006, be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

The decision on the petition is held in abeyance because prosecution on the merits is not closed. Accordingly, it is not appropriate to make a final determination of whether or not the material requested to be expunged is "material," with "materiality" being defined as any information which the examiner considers as being important to a determination of patentability of the claims. Thus, the decision on the petition to expunge must be held in abeyance at this time.

During prosecution on the merits, the examiner will determine whether or not the identified document is considered to be "material." If the information is not considered by the examiner to be material, the information will be removed from the official file.

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
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,789	10/25/2005	6366481		9807

7590 03/05/2009

EXAMINER

James Go
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
1279 Oakmead Parkway
Sunnyvale, CA 94085-4040

ART UNIT	PAPER NUMBER

DATE MAILED: 03/05/2009

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
RICHARD V. BURGUJIAN, ESQ.
FINNEGAN HENDERSON FARABOW GARRETT & DUNNER LLP
901 NEW YORK AVE., NW
WASHINGTON, DC 20001

Date:

MAILED

MAR 05 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007789
PATENT NO. : 6366481
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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United States Patent and Trademark Office
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MAR 05 2009

CENTRAL REEXAMINATION UNIT

JAMES Y. GO
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
1279 OAKMEAD PARKWAY
SUNNYVALE CA 94085-4040

(For Patent Owner)

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

(For Requester)

In re: Balakrishnan *et alia*
Reexamination Proceeding
Control No. 90/007,789
Request Deposited: October 25, 2005
For: U.S. Patent No. 6,366,481

DECISION ON PETITION UNDER 37 CFR 1.59

DECISION

This is a decision on the petition under 37 CFR 1.59(b), filed August 31, 2006, to expunge information from the above identified proceedings.

The petition is **granted**.

Petitioner requests that documents entitled

COMPLAINANT POWER INTEGRATIONS, INC.'S POSTHEARING STATEMENT, In the Matter of CERTAIN POWER SUPPLY CONTROLLERS AND PRODUCTS CONTAINING THE SAME, United States International Trade Commission, Washington, DC 20436, Before the Honorable Paul J. Luckern, Administrative Law Judge, Inv. No. 337-TA-541, February 10, 2006;

RESPONDENT SYSTEM. GENERAL CORPORATION'S POST-HEARING BRIEF. In the Matter Of CERTAIN POWER SUPPLY CONTROLLERS AND PRODUCTS CONTAINING THE SAME. United State, International Trade Commission, Washington. DC 20436. Before the Honorable Paul J. Luckern, Administrative Law Judge, Inv. No. 337-TA-541, February 10, 2006; and

POST-HEARING BRIEF OF THE COMMISSION INVESTIGATIVE STAFF, In the Matter of CERTAIN POWER SUPPLY CONTROLLERS AND PRODUCTS CONTAINING SAME, United States International Trade Commission, Washington, DC 20436, Before the Honorable Paul J. Luckern, Administrative Law Judge, Inv. No. 337-TA-541, February 14, 2006

, filed August 28, 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 proceeding.

Patent Owner is required to retain the expunged material(s) for the life of any patent which issues on the above-identified patent.

The expunged material has been removed from the official file. Since this proceeding is not a paper file, the return of the expunged material may not be possible in an Image File Wrapper (IFW) proceeding where a paper is entered into the record. Instead, such papers are marked "closed" and "not public".

CONCLUSION

1. Petitioner's request is **granted**.

2. Patent Owner is **required** to retain the expunged material(s) for the life of any patent which issues on the above-identified patent.

3. **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
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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.

4. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929.

Eric Keasel For

Gregory 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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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,790	10/25/2005	6538908	09578-0006	9396

7590 08/09/2007

Blakely Sokoloff Taylor & Zafman LLP
12400 Wilshire Blvd., Suite 700
Los Angeles, CA 90025

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/09/2007

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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AUG 0 9 2007
CENTRAL REEXAMINATION UNIT

James Y. Go
BLAKELY SOKOLOFF TAYLOR
& ZAFMAN LLP
12400 Wilshire Boulevard, 7th Floor
Los Angeles CA 90025

For Patent Owner

Richard V. Burgujian, Esq.
FINNEGAN HENDERSON FARABOW
GARRET & DUNNER LLP
901 New York Avenue NW
Washington, DC 20001-4413

For Third Party Requester

DECISION, *SUA SPONTE*
MERGING
REEXAMINATION
PROCEEDINGS

In re: Balakrishnan *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/007,790
Filed: October 25, 2005
For: US Patent No. 6,538,908

In re: Balakrishnan *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/008,363
Filed: December 6, 2006
For: US Patent No. 6,538,908

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. 6,538,908 issued on March 25, 2003.

2. *Ex Parte* Reexamination Proceeding, control no. 90/007,790 was requested by a third party requester on October 25, 2005.

3. The Reexamination Order was granted in proceeding, control no. 90/007,790 on December 27, 2005.

4. There are currently no amendments proceeding control number 90/007,790.

5. *Ex Parte* Reexamination Proceeding, control no. 90/008,363 was requested by a third party requester filed on December 6, 2006.

6. The Reexamination Order was granted in proceeding, control no. 90/008,363 on January 25, 2007.

7. There are currently no amendments proceeding control number 90/008,363.

8. Proceedings control numbers 90/007,790 and 90/008,363 awaits the first Office action on the merits from the assigned examiner.

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 90/007,790 and 90/008,363 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. 90/007,790 and 90/008,363 are **MERGED**.

2. The reexamination files are being forwarded to the examiner for issuing a first Office action.

3. All correspondence regarding these proceedings should be submitted as follows:

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450

By Fax to: (571) 273-9900
Central Reexamination Unit

By Hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

3. 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 M. Marquis,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,790	10/25/2005	6538908	09578-0006	9396

7590 03/05/2009

EXAMINER

JAMES Y. GO
Blakely Sokoloff Taylor & Zafman LLP
1279 OAKMEAD PARKWAY
SUNNYVALE, CA 94085-4040

ART UNIT	PAPER NUMBER

DATE MAILED: 03/05/2009

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
RICHARD V. BURGUJIAN, ESQ.
C/O FINNEGAN HENDERSON FARABOW GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

Date:

MAILED

MAR 05 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007790
PATENT NO. : 6538908
ART UNIT : 3900

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,363	12/06/2006	6538908		7394

7590 03/05/2009

EXAMINER

JAMES Y GO
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
1279 OAKMEAD PARKWAY
SUNNYVALE, CA 94085-4040

ART UNIT	PAPER NUMBER

DATE MAILED: 03/05/2009

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
Finnegan, Henderson, Farabow, Garrett & Dunner LL
901 New York Avenue N.W.
Washington, DC 20001-4413

Date:
MAILED
MAR 05 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008363
PATENT NO. : 6538908
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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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MAILED

MAR 05 2009

CENTRAL REEXAMINATION UNIT

JAMES Y. GO
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
1279 OAKMEAD PARKWAY
SUNNYVALE CA 94085-4040

(For Patent Owner)

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

(For Requester)

In re: Balakrishnan *et alia*
Reexamination Proceeding
Control No. 90/007,790
Request Deposited: October 25, 2005
For: U.S. Patent No. 6,538,908

In re: Balakrishnan *et alia*
Reexamination Proceeding
Control No. 90/008,363
Request Deposited: December 6, 2006
For: U.S. Patent No. 6,538,908

DECISION ON PETITION UNDER 37 CFR 1.59

DECISION

This is a decision on the petition under 37 CFR 1.59(b), filed August 31, 2006, to expunge information from the above identified proceedings.

The petition is **granted**.

Petitioner requests that documents entitled

COMPLAINANT POWER INTEGRATIONS, INC.'S POSTHEARING STATEMENT, In the Matter of CERTAIN POWER SUPPLY CONTROLLERS AND PRODUCTS CONTAINING THE SAME, United States International Trade Commission, Washington, DC 20436, Before the Honorable Paul J. Luckern, Administrative Law Judge, Inv. No. 337-TA-541, February 10, 2006;

RESPONDENT SYSTEM. GENERAL CORPORATION'S POST-HEARING BRIEF. In the Matter Of CERTAIN POWER SUPPLY CONTROLLERS AND PRODUCTS CONTAINING THE SAME. United State, International Trade Commission, Washington. DC 20436. Before the Honorable Paul J. Luckern, Administrative Law Judge, Inv. No. 337-TA-541, February 10, 2006; and

POST-HEARING BRIEF OF THE COMMISSION INVESTIGATIVE STAFF, In the Matter of CERTAIN POWER SUPPLY CONTROLLERS AND PRODUCTS CONTAINING SAME, United States International Trade Commission, Washington, DC 20436, Before the Honorable Paul J. Luckern, Administrative Law Judge, Inv. No. 337-TA-541, February 14, 2006

, filed August 28, 2006, be expunged from the record. It is noted that the documents and petition were submitted in 90/007,790 only. 90/007,790 was subsequently merged with 90/008,363. 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 proceeding.

Patent Owner is required to retain the expunged material(s) for the life of any patent which issues on the above-identified patent.

The expunged material has been removed from the official file. Since this proceeding is not a paper file, the return of the expunged material may not be possible in an Image File Wrapper (IFW) proceeding where a paper is entered into the record. Instead, such papers are marked "closed" and "not public".

CONCLUSION

1. Petitioner's request is **granted**.

2. Patent Owner is **required** to retain the expunged material(s) for the life of any patent which issues on the above-identified patent.

3. **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.

4. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929.

Eric Keasel For

Gregory Morse
Director, Central Reexamination Unit

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : October 13, 2009

TO SPE OF : ART UNIT 3992 - Lynne H. Browne

SUBJECT : Request for Certificate of Correction for Appl. No.: 90/007,790 and 90/008,363 Patent No.: 6,538,908 C1

Please respond to this request for a certificate of correction within 7 days.

FOR IFW FILES:

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

FOR PAPER FILES:

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (CofC)
Randolph Square Building
2800 South Randolph Street
Arlington, VA 22206

Antonio Johnson

Certificates of Correction Branch

(571)272-0483

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:

Note your decision on the appropriate box.

- ☒ **Approved** — All changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

Comments: _____

Eric Frahm SPE, AU 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Alexandria, VA 22313-1450
www.uspto.gov

SEIMENS WESTINGHOUSE POWER CORP
C/O Seimens Corporation
186 Wood Avenue South
Iselink NJ 08830

For Patent Owner

MAR 3 0 2006

TFS PRODUCTS CORPORATION
P.O. Box 154
277 Campbellville, Ontario
Canada, LOP 1B0

For Requester

In re: MS Briesch et al
Ex Parte Reexamination Proceeding
Control No. 90/007,793
Filed: Novenber 2, 2005
For: US Patent No. 5,845, 481

DECISION ON
PETITION OF
DENIAL OF REQUEST
UNDER 37 CFR 1.515(c)

This is a decision on the timely filed Petition under 37 CFR 1.515 (c) filed January 9, 2006 regarding the Petition Requesting Reconsideration and Grant of *Ex Parte* Request for Reexamination of US Patent No. 5,845,481.

The petition is before the Director of the Central Reexamination Unit for consideration.

The petition is **DENIED** for the reasons set forth below.

REVIEW OF FACTS

1. US Patent No. 5,845,481 was issued on December 8, 1998.

2. A Third Party request for reexamination was filed on January 3, 2005 under control no. 90/007,359. The request indicated that the Requester considered claim 1-9, 14-17 and 21-25 unpatentable over USPN 5,888,060 to Velke.

3. The Order was granted for *ex parte* reexamination in a paper mailed February 17, 2005.

4. A second Third Party request for reexamination was filed on November 2, 2005 under control no. 90/007,793. The request indicated that the Requester considered claims 1-9, 14-17, and 21-25 unpatentable over USPN 5,888,060 to Velke.

5, The Order was denied for *ex parte* reexamination in a paper mailed December 12 2005.

6. The Requester petitioned for reconsideration of the Order Denial on January 9, 2006. The Requester reasons that the request should not be denied but should have it relevancy determined under its own merrits (sic) without reference to the pending reexamination and, if the arguments presented in this request are similar to the arguments presented in the pending reexamination proceedings, the proceedings should be merged.

7. The petition was timely filed with authorization to charge any required fees.

DISCUSSION

The Requester has petitioned the Director of the Central Reexamination Unit, 3999, under 37 CFR 1.515(c) to request that the USPTO decision denying the request for reexamination should be vacated and that the Order be granted for reexamination of US Patent No. 5,845,481, reexamination control no. 90/007,793.

37 CFR 1.515. Determination of the request of *ex parte* reexamination.

(c) The requester may seek review by a petition to the Director under 1.181 within one month of the mailing date of the examiner's determination refusing ex parte reexamination. Any such petition must comply with 1.181(b). If the petition is not timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and non-appealable.

ANALYSIS AND FINDINGS

On balance, while it is considered that the petition explains the Requester's reasoning for why a substantial new question of patentability should be raised with respect to the patent claims requested for reexamination in reexamination proceeding control number 90/007,793, the fact remains that a request for reexamination under control number 90/007,359 was filed January 3, 2005 indicating the same claims, 1-9, 14-17, and 21-25, are considered unpatentable in view of the same reference, USPN 5,888,060 to Velke. A second request for reexamination filed by any party 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 proceeding. (MPEP 2240(II).) No new question of patentability has been raised in the subsequent request. The request for *ex parte* reexamination under control number 90/007,79 remains DENIED.

DECISION

The Requester's Petition filed under 37 CFR 1.515(c) of January 9, 2006 to request withdrawal of the Order Denial thus Granting the reexamination request in proceeding control number 90/007,857 is DENIED.

This decision is final and non-appealable. (37 CFR 1.515(c).) No further communication on this matter will be acknowledged or considered.

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.
90/007,795	11/04/2005	6870135	HLC-06	5152

50285 7590 01/11/2007
LAURENCE C. BONAR
917 LOGAN ST
PORT TOWNSEND, WA 98368-2337

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/11/2007

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

Laurence C. Bonar
917 Logan Street
Port Townsend, WA 98368

(For Patent Owner/Requester)

MAILED

JAN 1 1 2007

CENTRAL REEXAMINATION UNIT

In re Reexamination Proceedings :
HAMM, Andrew J. et al. : DECISION GRANTING PETITION
Control No. 90/007795 :
Filed: November 4, 2005 :
Attorney Docket No. HLC-06 :

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on December 18, 2006, 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

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 Response to Office Action in *Ex Parte* Reexamination submitted December 18, 2006. As such, Petitioner has provided the response required by 37 CFR 1.137(b) (item 1). Payment of the requisite unintentional delay fee for a small entity was made (item 2). The petition contains the proper statement for unintentional delay in filing the required response (item 3). The petition does not require a terminal disclaimer (item 4), and the present proceeding is a reexamination proceeding. 37 CFR 1.137(d)(3)

Accordingly, the present petition under 37 CFR 1.137(b) includes the requisite response (item 1), the $750.00 petition fee under 37 CFR 1.17(m) (item 2), and the requisite statement (item 3).

CONCLUSION

1. The petition for entry of late papers is **granted.**

2. Jurisdiction over the reexamination proceeding 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 Sara S. Clarke in the CRU, who can be reached at (571) 272-4873.

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

1-10-07
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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,796	11/07/2005	6208638	12566/23	9982

25693 7590 07/17/2008

KENYON & KENYON LLP
RIVERPARK TOWERS, SUITE 600
333 W. SAN CARLOS ST.
SAN JOSE, CA 95110

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/17/2008

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

KENYON & KENYON LLP
Attn: Victor J. Castellucci
RIVERPARK TOWERS, SUITE 600
333 W. SAN CARLOS ST.
SAN JOSE, CA 95110

(For Patent Owner)

MAILED

JUL 17 2008

CENTRAL REEXAMINATION UNIT

CHRISTOPHER & WEISBERG, P.A.
200 EAST LAS OLAS BOULEVARD
SUITE 2040
FORT LAUDERDALE, FL 33301

(For Third Party Requester)

DECISION GRANTING PETITION FOR EXTENSION OF TIME
37 CFR § 1.550(c)

In re: Rieley *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/007,796
Deposited on: 7 November 2005
For: US Patent No.: 6,208,638

This is a decision on the 9 July 2008, petition for "Request for Extension of Time [37 CFR § 1.550 (c)]" requesting that the time for responding to the Office action mailed 21 March 2008, 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 21 March 2008, which set a one month date for filing a response thereto. The Office action is a Final Office action. The patent owner submitted a response to the Final on 16 April 2008. The examiner in charge of the proceeding has not yet responded to the response to the Final Office action. The petition for extension of time was timely filed on 9 July 2008, together with an electronic fee transmittal for the $200.00 petition fee as is required by 37 CFR § 1.515(c) and 37 CFR § 1.17 (g).

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 the need for the examiner to have sufficient time to respond to the response after final dated 9 July 2008. It appears that the issues for appeal may be reduced with the examiner's consideration, thereby advancing prosecution. It is as such that on balance the requirement for "sufficient cause" is met by the patent owner in this request for extension for time. The petition for one month extension of time is hereby granted.

The petition request is hereby **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 9 July 2008 is hereby **granted.**

2. The Patent Owner's response is due **26 August 2008**.

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 at (571) 272-1611 or Eric Keasel, Supervisory Patent Examiner at (571) 272-4929, in the Central Reexamination Unit, Art Unit 3992.

MARK J. REINHART
CRU SPE-AU 3992

Gregory Morse,
Director,
Central Reexamination Unit
3999

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.
90/007,796	11/07/2005	6208638	12566/23	9982

25693 7590 08/29/2008

KENYON & KENYON LLP
RIVERPARK TOWERS, SUITE 600
333 W. SAN CARLOS ST.
SAN JOSE, CA 95110

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/29/2008

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

KENYON & KENYON LLP
Attn: Victor J. Castellucci
RIVERPARK TOWERS, SUITE 600
333 W. SAN CARLOS ST.
SAN JOSE, CA 95110

(For Patent Owner)

MAILED

AUG 2 9 2008

CENTRAL REEXAMINATION UNIT

CHRISTOPHER & WEISBERG, P.A.
200 EAST LAS OLAS BOULEVARD
SUITE 2040
FORT LAUDERDALE, FL 33301

(For Third Party Requester)

DECISION DISMISSING AS MOOT, PETITION FOR EXTENSION OF TIME 37 CFR § 1.550(c)

In re: Rieley *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/007,796
Deposited on: 7 November 2005
For: US Patent No.: 6,208,638

This is a decision on the 18 August 2008, petition for "Request for Extension of Time [37 CFR § 1.550 (c)]" requesting that the time for responding to the Advisory action mailed 26 June 2008, be extended by one month. This is the second request for extension of time

The petition is before the Director of the Central Reexamination Unit for consideration.

The petition is dismissed as moot for the reasons set forth below.

Decision

The Patent Owner requests a second extension of time in which to file a response to the Final Office action mailed 21 March 2008. The petition for extension of time was timely filed on 18 August 2008, together with an electronic fee transmittal for the $200.00 petition fee as is required by 37 CFR § 1.515(c) and 37 CFR § 1.17 (g).

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

The petition for extension of time is moot in light of the mailing of the Notice of Intent to Issue a Reexamination Certificate. Because a Notice of Intent to Issue a Reexamination Certificate was mailed 26 August 2008 the instant proceedings closed from further prosecution. With the mailing of the Notice of Intent to Issue a Reexamination Certificate the need for extension of time is moot.

The petition request is hereby **dismissed as moot**

Conclusion

1. The patent owner's petition for a second extension of one-month time in which to file further response to the Final Office action dated 21 March 2008 is hereby **dismissed as moot.**

2. A Notice of Intent to Issue a Reexamination Certificate was mailed 26 August 2008 thereby terminating the instant proceedings from further prosecution.

3. Any post Notice of Intent to Issue a Reexamination Certificate response deemed necessary 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 at (571) 272-1611 or Eric Keasel, Supervisory Patent Examiner at (571) 272-4929, in the Central Reexamination Unit, Art Unit 3992.

MARK J. REINHART
SPE ~~SPRE~~-AU 3992
CENTRAL REEXAMINATION UNIT

for

Gregory Morse,
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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Townsend and Townsend and Crew, LLP
Two Embarcadero Center
8th Floor
San Francisco, CA 94111-3834

(For Patent Owner)

MAILED
MAR 0 9 2006
REEXAM UNIT

Charles D. Holland
Morrison & Foerster, LLP
755 Page Mill Road
Palo Alto, CA 94304

(For Requester)

In re Align Technology, Inc.
Reexamination Proceeding
Control No. 90/007,797
Filed: November 11, 2005
For: U.S. Patent No. 6,722,880

: DECISION
: DISMISSING
: PETITION

This is a decision on the December 8, 2005 patent owner petition entitled "Petition to Withdraw Notice of Litigation." Patent owner states that the petition is filed pursuant to a request that certain papers erroneously filed by patent owner in this proceeding be withdrawn and expunged pursuant to 37 CFR 1.59.

The petition is before the Office of Patent Legal Administration for consideration of the above petition.

Petitioner has submitted a petition fee in the amount of $130.00 for the present 37 CFR 1.59 petition.[1] The petition fee required pursuant to 37 CFR 1.59 is the fee set forth in 37 CFR 1.17(g), which is currently $200.00, and thus an additional $70.00 is due for the petition fee. Petitioner's Deposit Account No. 50-2638 is being charged $70.00 to cover the unpaid portion of the petition fee, pursuant to petitioner's instructions to charge applicable fees at page 1 of the petition.

The petition is dismissed for the reasons set forth below.

[1] 37 CFR 1.59 by its terms applies to "applications;" however 35 U.S.C. § 305 provides that "reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title" and this has been interpreted to apply expungement to reexamination proceedings.

REVIEW OF FACTS

1. U.S. Patent No. 6,722,880 (the '880 patent) issued on April 20, 2004.

2. A request for reexamination was filed by a third party requester on November 4, 2005 and assigned control No. 90/007,797 (the '797 reexamination proceeding).

3. On November 30, 2005, patent owner filed a Notice of Litigation ("NOL") directed to five related reexamination proceedings.

4. On December 8, 2005, patent owner filed the present petition requesting that the NOL be withdrawn and expunged on the grounds that the NOL had been directed to the present '797 reexamination proceeding in error.

5 An Order Denying Request for *Ex Parte* Reexamination in the '797 reexamination proceeding was mailed on December 23, 2005.

6. After the present petition was matched with the present proceeding, the NOL was "closed" in the Image File Wrapper (IFW) pending a decision on the petition.

7. On January 23, 2006, the third party requester filed a petition seeking to overturn the December 23, 2005 Order and have the request for *ex parte* reexamination of the '880 patent granted. The January 23, 2006 third party requester petition was not executed.

8. In response to a telephone inquiry by the Office, a paper ratifying the January 23, 2006 third party petition by supplying a signature for that petition was filed on February 13, 2006.

DECISION

As pointed out, patent owner requests that patent owner's NOL be withdrawn and expunged from the record on the grounds that it was erroneously filed in the '797 proceeding. Patent owner states that the NOL was properly directed to five related reexamination proceedings, but not to the '797 reexamination proceeding. Patent owner filed the petition in order to ensure that the NOL was not considered by the examiner in preparation of the examiner's order, and would not be construed as a patent owner's statement under 37 CFR 1.530.

The petition is <u>dismissed as moot</u>, without prejudice to the filing of a renewed petition as discussed below.

ADDITIONAL DISCUSSION

Under 37 CFR § 1.515(c) states, in pertinent part:

> "The requester may seek review by a petition to the Director under § 1.181 within one month of the mailing date of the examiner's determination refusing *ex parte* reexamination. ... If no petition is timely filed or if the decision on petition affirms that no substantial new question has been raised, the determination shall be final and nonappealable."

Under 37 CFR § 1.530(a) states:

> "Except as provided in § 1.510(e), **no statement or other response** by the patent owner in an *ex parte* reexamination proceeding shall be filed prior to the determinations made in accordance with § 1.515 or § 1.520. If a premature statement or other response is filed by the patent owner, it will not be acknowledged or considered in making the determination." (Emphasis added.)

MPEP § 2244, "Prior Art on Which the Determination is Based," states in pertinent part:

> "The determination whether or not 'a substantial new question of patentability' is present can be based upon any prior art patents or printed publications. 35 U.S.C. § 303(a) and 37 CFR 1.515(a) provide that the determination on a request will be made 'with or without consideration of other patents or printed publications,' i.e., other than those relied upon in the request. The examiner is not limited in making the determination based on the patents and printed publications relied on in the request. The examiner can find 'a substantial new question of patentability' based upon the prior art patents or printed publications relied on in the request, a combination of the prior art relied on in the request and other prior art found elsewhere, or based entirely on different patents or printed publications."

MPEP § 2248 provides, in pertinent part:

> "If a petition seeking review of the examiner's determination refusing reexamination is filed, it is forwarded (together with the reexamination file) 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*."

Although the NOL may have been submitted in error, the record does not show that it constitutes either a patent owner's statement or any other response in this reexamination proceeding. Rather, it is simply a notice of concurrent proceedings submitted pursuant to MPEP § 2282. That the NOL was filed in error does not convert the NOL into something that it is not, *i.e.*, a patent owner's statement or a response to a paper setting forth a requirement to which a response must be addressed.

Further MPEP § 2244 makes it clear that when an examiner reviews a request for reexamination to determine whether the request has raised a substantial new question of patentability, the examiner is not restricted to a consideration of only those prior art patents and printed publications submitted with the request for reexamination. The examiner may properly consider any prior art patents or printed publications to decide whether the prior art and printed publications does, or does not, raise a substantial new question of patentability.

In the present instance, the request for reexamination has been denied, and a petition has been filed on January 23, 2006 by the third party requester seeking review of the refusal to order reexamination. After this decision is mailed, the proceeding will be remanded to the Central Reexamination Unit Director to address the January 23, 2006 requester petition. At that time, the NOL filed on November 30, 2005 that is presently "closed" in the IFW file will be reviewed. To the extent that the information in the NOL contains, or makes reference to, prior art patents and publications, such information will be available to the Central Reexamination Unit Director (who has jurisdiction to review the January 23, 2006 requester petition) when considering whether or not a substantial new question of patentability exists on the present record. Any information that is relied upon in considering the question of whether to order reexamination should be ordered, and thus would be "important to a reasonable examiner in deciding whether or not a claim is patentable," [2] would be cited in accordance with the procedure set forth in the appropriate one of MPEP §§ 2246 or 2247. Further, in the event that reexamination is ordered, then any information in the NOL that is determined to be "important to a reasonable examiner in deciding whether or not a claim is patentable" would be cited on the record *during* the reexamination proceeding. All such

[2] MPEP 724.04(c), item C.

information in the NOL that is made of record would be opened to the public, i.e., unsealed.

In the event the information of the NOL is not determined to be important to a reasonable examiner in deciding whether or not a claim is patentable, then the patent owner may renew the petition to expunge under 37 CFR 1.59, without additional fee. The time for such renewal would be:

(a) In the event that reexamination proceeding is again denied following consideration of the requester petition filed on January 23, 2006, then the petition should be renewed seasonably after the denial decision is issued.

(b) If reexamination is granted following consideration of the requester petition filed on January 23, 2006, then the petition should be renewed seasonably after the termination of the reexamination prosecution by the issue of an Notice of Intent to Issue a Reexamination Certificate, or when all of the NOL information is earlier stated not to be important to a reasonable examiner in deciding whether or not a claim is patentable.

The patent owner is cautioned that a failure to timely renew the petition to expunge could result in the sealed material being unsealed and thus becoming open to the public.

If the petition to expunge under 37 CFR 1.59 is subsequently renewed, the requirements of MPEP 724.05 should be reviewed to make certain that the petition to expunge is complete as to all requirements for same. Any such renewed petition would be reviewed by the Central Reexamination Unit Director, in accordance with MPEP §§ 724.04(c) and 724.05.

CONCLUSION

1. Patent owner's request that the NOL filed on November 30, 2005 be expunged from the record is dismissed, subject to renewal at a later point in time.

2. The reexamination proceeding is being forwarded to the Central Reexamination Unit to charge the balance of the fee for the petition under 37 CFR 1.59. Thereafter, the reexamination proceeding will be forwarded to the Central Reexamination Unit Director, *via* the CRU Special Program Examiner, for appropriate action on the third party requester petition filed on January 23, 2006.

3. 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
March 9, 2006

C:\KIVA\KENPET6\7797_expunge-NOL filed prior to order....doc

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Townsend and Townsend and Crew, LLP
Two Embarcadero Center
8th Floor
San Francisco, CA 94111-3834

(For Patent Owner)

APR - 6 2007

Charles D. Holland
Morrison & Foerster, LLP
755 Page Mill Road
Palo Alto, CA 94304

(For Requester)

In re Align Technology, Inc.
Reexamination Proceeding
Control No. 90/007,797
Filed: November 11, 2005
For: U.S. Patent No. 6,722,880

: DECISION UNDER
: ACEEPTING
: WITHDRAWAL OF
: PETITION
:

This is a decision on the October 12, 2006 requester paper entitled "Request for Withdrawal of Petition to Director under 37 CFR §§ 1.515(c) and 1.181 Seeking Review of Denial of Request for Reexamination."

The request is before the Office of Patent Legal Administration for consideration.

The request is granted for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 6,722,880 (the '880 patent) issued on April 20, 2004.

2. A request for reexamination was filed by a third party requester on November 4, 2005 and assigned control No. 90/007,797 (the '797 reexamination proceeding).

3. An Order Denying Request for *Ex Parte* Reexamination in the '797 reexamination proceeding was mailed on December 23, 2005.

4. On January 23, 2006, the third party requester filed a petition seeking Director's review of the December 23, 2005 order denying reexamination and to have the request for *ex parte* reexamination of the '880 patent granted. The petition is entitled "Petition to Director under 37 CFR §§ 1.515(c) and 1.181 Seeking Review of Denial of Request for Reexamination." The January 23, 2006 third party requester petition was not executed.

5. On February 13, 2006, in response to a telephone inquiry by the Office, a paper was filed ratifying the January 23, 2006 requester petition by supplying a signature for that petition.

6. On October 12, 2006, the third party requester filed the present request to withdraw the "Petition to Director under 37 CFR §§ 1.515(c) and 1.181 Seeking Review of Denial of Request for Reexamination."

7. The Office has not acted on the "Petition to Director under 37 CFR §§ 1.515(c) and 1.181 Seeking Review of Denial of Request for Reexamination."

DECISION

The third party requester requests withdrawal of the "Petition to Director under 37 CFR §§ 1.515(c) and 1.181 Seeking Review of Denial of Request for Reexamination," which was filed on January 23, 2006 and ratified on February 13, 2006. The Office has not issued any decision on the petition, and the requested withdrawal of the petition will conserve the resources of the Office. The request is accordingly granted.

Based upon the October 12, 2006 request paper:

1. The January 23, 2006 requester petition, as supplemented on February 13, 2006, is held to be withdrawn. No decision will be rendered on the petition.

2. A copy of this decision will be placed in the present reexamination file.

3. Jurisdiction over the reexamination proceeding is being forwarded to the Central Reexamination Unit for further processing, including processing the reexamination file to provide the partial refund set forth in 37 CFR § 1.26(c).

3. Telephone inquiries related to this decision should be directed to Jeanne Clark, at (571) 272-7714 or Andres Kashnikow, Special Program Examiner, at (571) 272-4361, or in their absence, to Legal Advisor Stephen Marcus at (571) 272-7743.

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
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,798	11/09/2005	6483580	TNCR.157US3	2963

36257 7590 04/26/2007
PARSONS HSUE & DE RUNTZ LLP
595 MARKET STREET
SUITE 1900
SAN FRANCISCO, CA 94105

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
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4/26/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Michael J. Halbert
SILICON VALLEY PATENT GROUP LLP
2350 Mission College Blvd., Ste. 360
Santa Ana, CA 95054

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007798
PATENT NO. 6,483,580
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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www.uspto.gov

PARSONS HSUE & DE RUNTZ LLP
595 Market Street
Suite 1900
San Francisco, CA 94105

For Patent Owner

MAILED

APR 26 2007

CENTRAL REEXAMINATION UNIT

Michael J. Halbert
SILICON VALLEY PATENT GROUP LLP
2350 Mission College Blvd., Ste. 360
Santa Clara, CA 95054

DECISION GRANTING
PETITION FOR EXTENSION
OF TIME
[37 CFR 1.550(c)]

In re: Xu *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/007,798
Filed: November 9, 2005
For: US Patent No. 6,483,580

This is a decision on the April 18, 2007, petition for "Ex Parte Reexamination Request for Extension of Time Pursuant to 37 CFR 1.550 (c)," requesting that the time for responding to the Office action mailed March 26, 2007, be extended by one month.

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 April 18, 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 April 18, 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 delays in receiving the action impacting the one month response time, the large number of rejections and large number of claims with which response is required.

The petition request is **granted-in-part**. While a one-month of time was requested, a **two-week** extension of time is hereby 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 March 26, 2007 is **granted-in-part**.

2. The Patent Owner's response is due **May 10, 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
3999

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,800	11/08/2005	6590656	TNCR.157US4	2737

36257 7590 04/26/2007

PARSONS HSUE & DE RUNTZ LLP
595 MARKET STREET
SUITE 1900
SAN FRANCISCO, CA 94105

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
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4/26/07

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

MICHAEL J. HULBERT

2350 MISSION COLLEGE BLVD.

STE. 360

SANTA CLARA, CA 95054

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007800

PATENT NO. 6,590,656

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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PARSONS HSUE & DE RUNTZ LLP
595 Market Street
Suite 1900
San Francisco, CA 94105

For Patent Owner

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APR 26 2007

CENTRAL REEXAMINATION UNIT

MICHAEL J. HULBERT
2350 Mission College Blvd.
STE. 360
Santa Clara, CA 95054

DECISION GRANTING
PETITION FOR EXTENSION
OF TIME
[37 CFR 1.550(c)]

In re: Xu *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/007,800
Filed: November 8, 2005
For: US Patent No. 6,590,656

This is a decision on the April 18, 2007, petition for "Ex Parte Reexamination Request for Extension of Time Pursuant to 37 CFR 1.550 (c)," requesting that the time for responding to the Office action mailed March 26, 2007, be extended by one month.

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 April 18, 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 April 18, 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 delays in receiving the action impacting the one month response time, the large number of rejections and large number of claims with which response is required.

The petition request is **granted-in-part**. While a one-month of time was requested, a **two-week** extension of time is hereby 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 March 26, 2007 is **granted-in-part**.

2. The Patent Owner's response is due **May 10, 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

MRuhre
for

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

Lissi Mojica Marquis,
Director,
Central Reexamination Unit
3999

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DERGOSITS & NOAH LLP
Four Embarcadero Center
Suite 1450
San Francisco, CA 94111

(For Patent Owner)

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MAR 12 2007

CENTRAL REEXAMINATION UNIT

Gary A. Hecker, Esq.
The Hecker Law Group
1925 Century Park East, Suite 2300
Los Angeles, CA 90067

(For Requester)

In re Brown
Reexamination Proceeding
Control No. 90/007,802
For: U.S. Patent No. 6,137,794

: DECISION ON
: PETITION UNDER
: 37 CFR § 1.181
:

On March 6, 2007, patent owner (hereinafter "petitioner") filed correspondence, entitled "Petition Under 37 C.F.R. 1.181," which included a petition and supporting documents. For the reasons set forth below, the petition is granted.

The copies of the following documents filed on February 23, 2007 by facsimile are accepted as the true and correct copies of the following documents shown to have been mailed to the Office under 37 CFR 1.8(a) on January 22, 2007:

1. Response to November 22, 2006 Office Action;
2. Declaration of Michael E. Dergosits Pursuant to 37 CFR § 1.132
3. Declaration of Paul A. Brown Pursuant to 37 CFR § 1.132; and
4. Certificate of Service.

The matter is before the Director of the Central Reexamination Unit for consideration of whether or not grant the above-mentioned petition complies with the provisions of 37 CFR 1.181.

REVIEW OF FACTS

1. U.S. Patent No. 6,137,794 (hereinafter, the '794 patent), issued to Brown, on October 24, 2000, from an application filed on November 17, 1999.

2. A third party requested *ex parte* reexamination of the '794 patent pursuant to 37 CFR 1.510, on November 9, 2005. The reexamination proceeding was assigned Control No. 90/007,802 (hereinafter, the '8802 proceeding).

3. On January 13, 2006, an order granting reexamination of claims 1-6 of the '794 patent was issued.

4. On November 22, 2006, a non-final Office action was issued.

5. On February 23, 2007, petitioner faxed copies of the response to the November 22, 2006 Office action, including the declarations of Michael E. Dergosits and Paul A. Brown, and the certification of service was mailed to the Office under 37 CFR 1.8(a) on January 22, 2007.

6. On March 6, 2007, petitioner filed a "Petition under 37 CFR § 1.181" to petition the Director to invoke his supervisory authority to accept the February 23, 2007 facsimile copies of the response to the November 22, 2006 Office action, and the declarations of Michael E. Dergosits and Paul A. Brown as true and correct copies of the same mailed on January 22, 2007 to the Office.

DECISION

The provisions of 37 CFR 1.8 apply to correspondence sent in reexamination proceedings. 37 CFR 1.8(a)(1) states that correspondence will be considered as being timely filed if such correspondence is addressed as set forth in 37 CFR 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail, and the correspondence includes a certificate stating the date of deposit or transmission. 37 CFR 1.8(a)(1)(ii) further requires that the person signing the certificate should have a reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated. The declarations of Fern Marder, Michael E. Dergosits, and Teri Nelmark, filed in support of the petition under 37 CFR 1.181, provide for a showing that the correspondence was mailed on January 22, 2007 in accordance with 37 CFR 1.8(a). Specifically, the declarations show that the correspondence was addressed as set forth in 37 CFR 1.1(a), deposited with the U.S. Postal Service with sufficient postage as first class mail, and included a certificate stating the date of deposit or transmission signed by a person, Ms. Nelmark, that should have a

reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.

37 CFR 1.8(b) describes the procedure to follow if correspondence considered timely filed by being mailed or transmitted in accordance with 37 CFR 1.8(a) is not received by the Office. In accordance with 37 CFR 1.8(b)(1), after a reasonable amount of time had elapsed from the mailing of the correspondence, petitioner promptly contacted the Office to inform the Office of the previous mailing of the correspondence. Specifically, on February 23, 2007, Ms. Marder, under the direction of patent owner's counsel, called the Central Reexamination Unit to inquire about the status of the January 22, 2007 correspondence. After confirming that the correspondence was still not present in the application file, and that it was not possible to state exactly where the correspondence was, Ms. Marder faxed the correspondence to the Central Reexamination Unit as suggested by a staff member of the Central Reexamination Unit. By faxing the copy of the correspondence, petitioner complied with the requirement of 37 CFR 1.8(b)(2). The requirement of 37 CFR 1.8(b)(3) that a statement that attests on a personal knowledge or to the satisfaction of the Director to the previous timely mailing, however, was not met in the February 23, 2007 submission. Accordingly, the paralegal in the Central Reexamination Unit determined that the February 23, 2007 submission was not timely.

The above-mentioned petition and supporting documents do provide the required statement under 37 CFR 1.8(b) that the February 23, 2007 faxed copies of the response to the November 22, 2006 Office action, and the declarations of Michael E. Dergosits and Paul A. Brown are true and correct copies of the same mailed on January 22, 2007 under 37 CFR 1.8(a). Furthermore, the petition and supporting documents show that the same is true for the certificate of service document.

Accordingly, the February 23, 2007 facsimile copies of the response to the November 22, 2006 Office action, the declarations of Michael E. Dergosits and Paul A. Brown, and the certificate of service are accepted as true and correct copies of the same mailed on January 22, 2007 to the Office.

It is noted that a number of non-patent literature documents and other documents, including court documents, were also transmitted to the Office on February 23, 2007. To the extent that such documents are the exhibits mentioned in the declarations of Michael E. Dergosits and Paul A. Brown, these documents will also be considered timely received. As the petition did not clearly mention these documents, petitioner may wish to clarify the record.

In the future, petitioner may wish to follow the requirements of 37 CFR 1.8(b) if the unfortunate circumstance of the Office not receiving correspondence happens again to avoid the need to file a petition under 37 CFR 1.181. See MPEP 512 for more information.

CONCLUSION

1. The February 23, 2007 facsimile copies of the response to the November 22, 2006 Office action, the declarations of Michael E. Dergosits and Paul A. Brown, and the certificate of service are accepted as true and correct copies of the same mailed on January 22, 2007 to the Office.

2. The petition under 37 CFR 1.181 is granted.

3. Telephone inquiries related to this decision should be directed to Jeanne Clark, at (571) 272-7714, or in her absence, to Lissi Mojica Marquis, at (571) 272-1596.

Lissi Mojica Marquis
Director
Central Reexamination Unit

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DERGOSITS & NOAH LLP : (For Patent Owner)
FOUR EMBARCADERO CENTER :
SUITE 1450 :
SAN FRANCISCO CA 94111 :

MAILED

JAN 25 2008

CENTRAL REEXAMINATION UNIT

Gary A Hecker, Esq. : (For Third Party Requester)
THE HECKER LAW GROUP :
1925 Century Park East :
Suite 2300 :
Los Angeles, CA 90067 :

: DECISION ON REQUEST
: FOR STAY OF
: PROCEEDINGS ON
: APPEAL

In re: Brown :
Ex Parte Reexamination Proceeding :
Control No. 90/007,802 :
Deposited on: 9 November 2005 :
For: US Patent No. 6,137,794 :

This is a decision on the 7 January 2008 letter for "Request For Stay Of Proceedings On Appeal Pending The Examiner's Issuance Of An Advisory Action in View Of Patent Owner's Request For Reconsideration of October 1, 2007 Final Rejection."

The Letter is before the Director of the Central Reexamination Unit for consideration.

The Stay is dismissed for the reasons set forth below.

Decision

The Patent Owner requests a stay of the proceedings on appeal in reexamination proceeding control number 90/007,802 pending the examiner's issuance of an advisory action in view of the patent owner's request for reconsideration of the Office action mailed 1 October 2007.

MPEP 2272

I. FINAL REJECTION — TIME FOR RESPONSE

The statutory period for response to a final rejection in a reexamination proceeding will normally be two (2) months. If a response to the final rejection is filed, the time period set in the final rejection continues to run. The time period is automatically extended by 1 month (in accordance with the guidelines set forth in MPEP § 2265) if the response is the first response after the final rejection >and a notice of appeal has not yet been filed<. Any advisory Office action **>using form PTOL-467, Ex Parte Reexamination Advisory Action Before the Filing of an Appeal Brief, which is< issued in reply to patent owner's response after final rejection >(and prior to the filing of the notice of appeal)< will inform the patent owner of the automatic 1 month extension of time. It should be noted that the filing of any timely first response to a final rejection (even an informal response or even a response that is not signed) will automatically result in the extension of the shortened statutory period for an additional month. 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.

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 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.

Analysis and Findings

On balance, given that the examiner has now responded to the after final with an advisory action dated 18 January 2008, the request to stay the proceeding is moot. The request is thus dismissed.

Further, the patent owner has two months from the notice of appeal dated 2 January 2008 to submit the appropriate appeal papers.

The request to stay the proceeding is dismissed.

Conclusion

1. The patent owner's letter to stay the proceeding for response from the examiner after final is hereby dismissed.

2. The Patent Owner's appeal is due two months from the filing of the notice of appeal dated 2 January 2008.

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
CRU SPE-AU 3992

for

Lissi Mojica Marquis,
Director,
Central Reexamination Unit
3999

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.
90/007,802	11/09/2005	6137794	74200.989	7171

7590 03/12/2010
DERGOSITS & NOAH LLP
FOUR EMBARCADERO CENTER
SUITE 1450
SAN FRANCISCO, CA 94111

EXAMINER
WEAVER, SCOTT LOUIS

ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
03/12/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte SP Controls, Inc.

Appeal 2009-006008
Reexamination Control 90/007,802
Patent 6,137,794
Technology Center 3900

Mailed: March 12, 2010

DECISION ON RENEWED PETITION

This is a decision on the "Renewed Petition Pursuant to 37 C.F.R. § 1.183," filed February 16, 2010 ("Renewed Petition"). The Renewed Petition seeks a waiver of the two month period for filing a request for rehearing.

FINDINGS

1. The history of this matter is set forth in the Decision on Petition of January 15, 2010.

2. Accompanying the Renewed Petition filed on February 16, 2010, was a "Declaration of Michael E. Dergosits in Support of the Patent Owner's Renewed Petition Pursuant to 35 C.F.R. § 1.183" ("Dergosits Declaration"). The Dergosits Declaration describes the attempt by Patent Owner's counsel

to electronically file a Request for Rehearing and Certificate of Service from his home computer on the evening of October 19, 2009. As described in the Declaration, due to incompatibilities of his home computing system with his office computing system, he was unable to electronically file the documents by the midnight filing deadline.

DISCUSSION

The technical difficulties encountered by Patent Owner's counsel in attempting to electronically file the Request for Rehearing and Certificate of Service on October 19, 2009 constitute an extraordinary situation for which justice requires waiver under 37 C.F.R. § 1.183 of the two month deadline for such filing. *See* 37 C.F.R. § 41.52(a).

DECISION

In view of the foregoing, the Renewed Petition is GRANTED. The Board of Patent Appeals and Interferences will accept the second Request for Rehearing and Certificate of Service filed on October 20, 2009.

Michael R. Fleming
Chief Administrative Patent Judge

Counsel for Patent Owner:
Michael E. Dergositis
Dergoits & Noah LLP
Four Embarcadero Center, Suite 1450
San Francisco, CA 94111

Counsel for Third Party Requester:
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,804	11/14/2005	6358874	81880.0127	9422

26021 7590 08/04/2008

HOGAN & HARTSON L.L.P.
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LOS ANGELES, CA 90067

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/04/2008

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UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Hogan & Hartson LLP
1999 Avenue of the Stars
Suite 1400
Los Angeles, CA 90067

(For Patent Owner)

MAILED

AUG 04 2008

CENTRAL REEXAMINATION UNIT

In re reissue application of
Yoshihiro Kobayashi, et al.
Application No. 12/139,768
Filed: June 16, 2008
For: U.S. Patent 6,358,874

In re Reexamination Proceedings
Yoshihiro Kobayashi, et al.
Control No. 90/007,804
Filed: June 16, 2008
For: U.S. Patent 6,358,874

DECISION SUSPENDING ACTION IN REISSUE

The above-captioned proceedings are before the Office of Patent Legal Administration to consider the merits of the June 18, 2008 patent owner petition filed under 37 CFR 1.182, requesting to stay the *ex parte* reexamination proceeding 90/007,804, because of the reissue application 12/139,768.

REVIEW OF THE FACTS

1. On March 19, 2002, U.S. Patent 6,358,874 (the '874 patent) issued to Kobayashi et al.

2. On November 14, 2005, a request for *ex parte* reexamination of the '874 patent was filed by the patent owner. The resulting reexamination proceeding was assigned control number 90/007,804 (the '7804 proceeding).

3. On April 4, 2006, a notice of the filing of the '7804 *ex parte* reexamination was published in the *Official Gazette*.

4. On December 21, 2005, an order granting the '7804 *ex parte* reexamination request was mailed.

5. On October 2, 2007, a final rejection Office action was issued for the '7804 proceeding.

6. On April 2, 2008, patent owner filed a notice of appeal in the '7804 proceeding.

7. On June 2, 2008, patent owner filed an appeal brief in the '7804 proceeding.

8. On June 16, 2008, patent owner filed the present reissue application for the '874 patent, which was assigned application number 12/139,768 (the '768 reissue application). No Office action has been mailed in the '768 reissue application.

9. On June 18, 2008, patent owner filed the present petition requesting to stay the '7804 reexamination proceeding.

10. On July 15, 2008, a notice of the filing of the '768 reissue application was published in the *Official Gazette* for the present reissue application.

11. A review of the prosecution history of the '7804 reexamination proceeding reveals that the patent owner has amended the specification, amended claims 1 and 2, canceled claims 3-10, and added new claims 11-15. A review of the '768 reissue application file shows that patent owner has amended claims 15 and 19, canceled claims 1-14, and added new claims 15-19. Accordingly, the claims and specifications of the two proceedings are not identical.

DECISION

Under 37 CFR 1.565(d) states (in part):

> (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.

The instant reissue application number 12/139,768 and *ex parte* reexamination proceeding control number 90/007,804 are both currently pending for the same patent. As an order has been mailed pursuant to 37 CFR 1.525 in the *ex parte* reexamination proceedings, and because both proceedings have been announced in the *Official Gazette*, a decision under 37 CFR 1.565(d) is timely, and the June 18, 2008 patent owner petition will be addressed on the merits.

MPEP 2285 states (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 reason for this policy is to permit timely resolution of both proceedings to the extent possible and to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner. Accordingly, if both a reissue application and an *ex parte* reexamination proceeding are pending concurrently on a patent, a decision will normally be made (A) to merge the two proceedings <u>or</u> (B) to stay one of the two proceedings. See *In re Onda*, 229 USPQ 235 (Comm'r Pat. 1985).

MPEP 2285 II C states (in part):

> 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. For example, if the reexamination proceeding is on appeal to the Board or to the Court of Appeals for the Federal Circuit, or a Notice of Intent to Issue a Reexamination Certificate was issued for the reexamination, that fact would be considered in making a decision whether to merge the reissue application examination and the reexamination proceeding or stay one of them.

In light of the above, it is not appropriate to conduct the examination of the reissue and reexamination proceedings separately, and at the same time as to the same patent. As pointed out above, the claims of the reissue and reexamination proceedings are currently NOT identical. Furthermore, it is untenable to guarantee that they can be made and maintained identical in two separate proceedings. As the two proceedings advance, the potential for continued and expanding inconsistencies and conflicts to develop between them will only grow. This would run contrary to the prevention of inconsistent, and possibly conflicting, amendments from being introduced into the multiple proceedings on behalf of the patent owner, as stated in MPEP 2285. The remaining alternatives are merger (consolidation) of the '768 reissue and the '7804 proceeding, or suspension of either the '768 reissue proceeding or the '7804 reexamination proceeding.

35 USC 305 states (in part) that "[a]ll reexamination proceedings under this section, including any on appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office." In this instance, the '7804 reexamination proceeding is at the appeal stage and has developed mature and focused issues of patentability. A substantial amount of prosecution has taken place in the '7804 proceeding, and the request for reexamination has been ongoing for over two years. It would be contrary to the 35 U.S.C. 305 unqualified statutory mandate of special dispatch in *ex parte* reexamination to remove the '7804 proceeding from this point in the appeal process to merge it the present reissue application. [1]

In this instance, no Office action on the merits has been issued for the present '768 reissue application. The '768 reissue application was not filed until June 16, 2008, after the appeal brief in the '7804 proceeding had been filed (June 2, 2008).

In view of the above, merger of the present '768 reissue application with the '7804 reexamination proceeding will <u>not</u> be ordered. The remaining alternatives are suspension of the reissue proceeding and suspension of the reexamination proceeding. A suspension of the '7804 reexamination proceeding, as requested by petitioner, would result in an unsubstantiated delay that is contrary to the unqualified statutory mandate of special dispatch, especially given its status on appeal. Thus, it is the present '768 reissue application that must be suspended.

In regard to the patent owner's concern about a reexamination certificate issuing without any allowed claims, in the event such takes place, the patent owner could file a petition under 37

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[1] As pointed out in MPEP § 2285, part II C, "if the reexamination proceeding is on appeal to the Board ..., that fact would be considered in making a decision whether to merge the reissue application examination and the reexamination proceeding or stay one of them."

USC 1.183 to waive 37 USC 1.570(d), explaining why the reissue application was not filed until the present late stage in the prosecution of the reexamination proceeding.

Having considered the present petition, and the proceeding records as a whole, action in the '768 reissue application is hereby **suspended** pursuant to 37 CFR 1.103(e) in favor of the '7804 reexamination proceeding. The reissue application suspension shall remain in effect until the conclusion of the *ex parte* reexamination proceeding by the issuance and publication of the reexamination certificate.

CONCLUSION

1. The June 18, 2008 patent owner petition under 37 CFR 1.182 is dismissed.

2. Action in the present 12/139,768 reissue application is **suspended** pursuant to 37 CFR 1.103(e), until conclusion of the *ex parte* reexamination proceeding control number 90/007,804.

3. After the conclusion of the *ex parte* reexamination proceeding by the issuance and publication of the reexamination certificate, patent owner may call up the reissue application for action, by notifying the Office of such conclusion.

4. Telephone inquiries relating to this decision should be directed to the undersigned at (571) 272-7710.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

August 8, 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
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,804	11/14/2005	6358874	81880.0127	9422

26021 7590 11/05/2008

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/05/2008

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Hogan & Hartson LLP
1999 Avenue of the Stars
Suite 1400
Los Angeles, CA 90067

(For Patent Owner)

MAILED

NOV 05 2008

CENTRAL REEXAMINATION UNIT

In re Reissue Application of
Yoshihiro Kobayashi *et al*
Application No. 12/139,768
Filed: June 16, 2008
For: U.S. Patent No. 6,358,874

In re Reexamination Proceeding
Yoshihiro Kobayashi et al
Control No.: 90/007,804
Filed: November 14, 2005
For: U.S. Patent No. 6,358,874

DECISION DENYING PETITION

This is a decision on the petition filed on October 4, 2008 styled "Petition for Reconsideration of Petition Under 37 CFR 1.182 to Stay Reexamination Proceeding Because of Reissue Application" ("the petition"). The petition and the above-captioned proceedings are before the Office of Patent Legal Administration for consideration.

Summary: The patent owner petition for reconsideration is granted to the extent that the "Decision Dismissing Petition" dated August 4, 2008 has been reconsidered. However, with respect to the relief requested by patent owner, the present patent owner petition is denied.

This decision is designated as a final agency action pursuant to 5 U.S.C. § 704.

FEES

A petition filed under 37 CFR 1.182 requires a petition fee of $400.00 as set by 37 CFR 1.17(f). It appears that petitioner's deposit account was debited for the petition fee, as authorized at page 4 of the petition. However, the deposit account was improperly debited in the amount of $200.00 (37 CFR 1.17(g)). The $200.00 charge will be credited to Deposit Account No. 50-1314, and then a charge in the amount of $400.00 will be made against Deposit Account No. 50-1314.

REVIEW OF THE FACTS

1. On March 19, 2002, U.S. Patent 6,358,874 (the '874 patent) issued to Kobayashi et al.

2. On November 14, 2005, a request for *ex parte* reexamination of the '874 patent was filed by the patent owner. The resulting reexamination proceeding was assigned control number 90/007,804 (the '7804 proceeding).

3. On April 4, 2006, a notice of the filing of the '7804 *ex parte* reexamination was published in the *Official Gazette*.

4. On December 21, 2005, an order granting the '7804 *ex parte* reexamination request was mailed.

5. On October 2, 2007, a final rejection Office action was issued for the '7804 proceeding.

6. The time for filing a response to the final rejection having been extended by the examiner, on April 2, 2008, patent owner filed a notice of appeal in the '7804 proceeding.

7. On June 2, 2008, patent owner filed an appeal brief in the '7804 proceeding and thereafter filed a revised appeal brief on October 27, 2008.

8. On June 15, 2008, patent owner filed the present reissue application for the '874 patent, which was assigned application number 12/139,768 (the '768 reissue application). No Office action has been mailed in the '769 reissue application.

9. On June 18, 2008, patent owner filed a petition requesting that the '7804 reexamination proceeding be stayed.

10. On July 15, 2008, a notice of the filing of the '768 reissue application was published in the *Official Gazette*.

11. A review of the prosecution history of the '7804 reexamination proceeding reveals that the patent owner has amended the specification, canceled patent claims 1-10, and added new claims 15-19 (having canceled previously added new claims 11-14). A review of the '768 reissue application file shows that patent owner has amended patent claims 1 and 2, canceled patent claims 3-10, added new claims 11-15 and amended the specification. Accordingly, the claims are not identical. The specification amendments are also not identical because the '768 reissue application has been amended to include specification amendments that were refused entry after final rejection in the '7804 reexamination proceeding.

12. A decision was mailed on August 4, 2008, dismissing the June 18, 2008 petition to stay the '7804 reexamination proceeding. Instead, the August 4, 2008 decision suspended prosecution in the '768 reissue application.

13. On October 1, 2008, the present petition was filed requesting reconsideration of the decision on petition dated August 4, 2008.

RELEVANT AUTHORITY

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 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.565(d) provides, in part:

If a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings.

37 CFR 1.570(d) provides:

If an *ex parte* reexamination certificate has been issued and published which cancels all of the claims of the patent, no further Office proceedings will be conducted with that patent or any reissue applications or any reexamination requests relating thereto.

MPEP § 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 reason for this policy is to permit timely resolution of both proceedings to the extent possible and to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner. Accordingly, if both a reissue application and an *ex parte* reexamination proceeding are pending concurrently on a patent, a decision will normally be made (A) to merge the two proceedings or (B) to stay one of the two proceedings. See *In re Onda*, 229 USPQ 235 (Comm'r Pat. 1985).

MPEP § 2285(II)(C) provides, in part:

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. For example, if the reexamination proceeding is on appeal to the Board or to the Court of Appeals for the Federal Circuit, or a Notice of Intent to Issue a Reexamination Certificate was issued for the reexamination, that fact would be considered in making a decision whether to merge the reissue application examination and the reexamination proceeding or stay one of them.

MPEP § 2285(IV) provides, in part:

If applicant/patent owner files a request for continued examination (RCE) of the reissue application under 37 CFR 1.114 (which may be filed on or after May 29, 2000 for an application filed on or after June 8, 1995), the reissue application is not considered to be expressly abandoned; rather the finality of the Office action is withdrawn, and the merged proceeding will continue. This is so, because an RCE is not an abandonment of any application, whether it be a reissue application or a non-reissue application.

DECISION

I. *The August 4, 2008 Decision*

The present '768 reissue application and the present '7804 reexamination proceeding are both currently pending for the '874 patent. As an order had been mailed pursuant to 37 CFR 1.525 in the *ex parte* reexamination proceeding, and both proceedings had been announced in the *Official Gazette*, a decision under 37 CFR 1.565(d), the mailing of the August 4, 2008 decision that addressed the June 18, 2008 patent owner petition was timely. The practice in the circumstance where a reissue application and a reexamination proceeding for the same patent are concurrently pending in the Office is to consider the alternatives of merger of the proceedings and suspension of one of the proceedings pending conclusion of the other proceeding. In the August 4, 2008 decision, it was decided that the patent owner's requested stay of the '7804 reexamination proceeding should not be granted, that merger of the two proceedings was inappropriate, and therefore, prosecution in the '768 reissue application should be suspended. This holding was based on the following determinations:

(1) The '7804 reexamination proceeding was then on appeal to the Board of Patent Appeals and Interferences (BPAI), while prosecution in the '768 reissue application had not yet commenced. It was held that to suspend the '7804 reexamination proceeding so that prosecution could be conducted separately in the '768 reissue application would be contrary to the requirement of 35 U.S.C § 305 that reexamination proceedings in the Office (including appeals to the BPAI) be conducted with special dispatch.

(2) Merger of the '768 reissue application and the '7804 reexamination proceeding would not considered to be appropriate, because there existed issues in the reissue application that would not be proper for consideration in reexamination. For example, the claims and specifications in the two proceedings were not identical, so that it was considered to be untenable to guarantee that, if the two proceedings were to be conducted separately, that the claims and specifications could be maintained identically in each separate proceeding.

The August 4, 2008 decision held that prosecution in the '768 reissue proceeding should be suspended. Patent owner's concern that if prosecution in the '768 reissue application were suspended, and a reexamination certificate that canceled all of the claims of the '874 patent were to then issue, then patent owner would be precluded by 37 CFR 1.570(d) from conducting prosecution in the '768 reissue application, was addressed by noting that patent owner could, in such circumstance, file a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.570(d).

II. The Present Petition for Reconsideration

A. Patent Owner's Position

Petitioner patent owner requests reconsideration of the August 4, 2008 decision on the following bases:

(1) The '7804 reexamination proceeding contains only product claims, whereas the reissue application contains both product and method claims.

(2) The '768 reissue application method claims are amended method claims that have never been examined by the Office.

(3) The claims in the reissue application are directed to a different invention and/or are narrower than the claims in the '7804 reexamination proceeding, so that the results in the reexamination proceeding are not likely to apply to the reissue application.

(4) If a reexamination certificate were to issue without any allowed claims, then patent owner would not be permitted to have the amended method claims and narrower product claims examined by the Office.

(5) As the '7804 reexamination proceeding is on appeal, amendments cannot be introduced into that proceeding, so it is unlikely that any inconsistent and conflicting amendments could be introduced into that proceeding. As the '7804 reexamination proceeding contains only product claims, while the '768 reissue application contains both product claims (narrower than those in the '7804 reexamination proceeding) and method claims, the likelihood of the reissue application yielding results that are either inconsistent or conflicting with those obtained in the reexamination proceeding is minimal.

(6) Patent owner states that it will take no further action in the '7804 reexamination proceeding if the Office allows the '768 reissue application to proceed, thus further ensuring that no inconsistent and/or conflicting amendments are introduced into the proceedings.

(7) Patent owner believes that the special dispatch mandate of 35 U.S.C. § 305 has prejudiced patent owner's ability to pursue claims as set forth in the '768 reissue proceeding, and that the special dispatch is "counterbalanced by 35 U.S.C. § 101" [1] so as to warrant granting of the relief requested in the present petition.

B. Patent Owner's Position is Not Persuasive

MPEP § 2285 sets forth the three options that exist when a reexamination proceeding and a reissue application for the same patent are copending before the Office. The Office may, in its discretion, merge the two proceedings into a single combined proceeding that, in accordance with the provisions of 37 CFR 1.565(d), will be conducted under the rules governing reissue applications, or stay either of the two proceedings. In general, the Office will not conduct prosecution concurrently in a reissue application and a reexamination proceeding that have been filed for the same patent. However, petitioner patent owner has requested that the Office either suspend the '7804 reexamination proceeding, or conduct that proceeding concurrently with examination of the '768 reissue application and separately therefrom.

With respect to providing a stay of the reexamination proceeding, *Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988), is the seminal case directed to the authority of the Office to stay or suspend a pending reexamination proceeding.

In *Ethicon*, 849 F.2d at 1426, 7 USPQ2d at 1154, the court considered the language of 35 U.S.C. §§ 302-305, and concluded that, with respect to the specific facts of the case which involved a stay of an *ex parte* reexamination proceeding to await the outcome of litigation involving the patent in that reexamination proceeding:

> [W]hen read together, the statutes say: "*Any* person *at any time* may request reexamination and *all* reexamination procedures *will* be conducted with *special dispatch*." The issue for us is whether "special dispatch" contemplates that a reexamination be suspended pending the outcome of a

[1] "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."

> district court case involving allegations of invalidity of the same patent. We conclude that it does not. [Emphasis by underlining added.)]

The court also discussed the general question of stay of a reexamination proceeding as follows:

> The Commissioner attacks Ethicon's statement that "there may be circumstances in which multiple concurrent proceedings within the Patent Office may well justify a stay of a particular reexamination proceeding" as a suggestion that "special dispatch has one meaning with respect to concurrent PTO proceedings, and another, stricter meaning with respect to concurrent PTO and court proceedings." Ethicon's comment came because the district court pushed it to speculate about when a stay might be appropriate. But it addresses a hypothetical situation in which there are multiple proceedings before the PTO. That is not this case. We mention it, however, only to observe that the two situations are different and that 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. [Emphasis added.]

849 F.2d at 1427-28; 7 USPQ2d at 1156.

It is clear from that the *Ethicon* court would not have approved of a stay of the reexamination proceeding on the facts presented in the present petition. Here, the record shows that the prosecution of the '768 reissue application has not yet begun. On the other hand, the reexamination proceeding is already at the appeal stage and has been briefed. It appears that when prosecution of the reissue application does begin, it will include issues, such as the patentability method claims, that do not now exist in the '7804 reexamination proceeding. This factor clearly indicates that the Office could not assure that any stay of the '7804 reexamination proceeding would be for a determinate time of relatively short duration such that the '768 reissue application and the '7804 reexamination proceeding could be examined seriatim, with the prosecution in the '768 reissue application proceeding quickly so that a stay of the '7804 reexamination proceeding would be for a relatively short period of time so as not to unduly preclude the treatment of the '7804 reexamination proceeding with special dispatch. This is particularly so because the '768 reissue application is, of course, subject to having continuation applications filed, and/or requests for continued reexamination (RCE). Further, the '7804 reexamination statute expressly and unequivocally requires that *ex parte* reexamination proceedings will be treated with special dispatch in the Office, even when the reexamination proceeding is before the BPAI. It would clearly contradict both the statutory requirement for treatment of *ex parte* reexamination proceedings with special dispatch, as well as the views of the court in *Ethicon*, to stay the present '7804 *ex parte* reexamination proceeding, while prosecution of the '768 reissue application, which has not yet begun and which may extend through multiple applications or continuing examination procedures, is first conducted.

As to the merger option (merger of the '768 reissue application and the '7804 reexamination proceeding), MPEP § 2285(II)(C) clearly points out that when a reexamination proceeding is on appeal to the Board of Patent Appeals and Interferences (the BPAI), that fact would weigh against merger of the reexamination proceeding with another copending proceeding for the same patent. In this instance, a merger of the '786 reissue application with the '7804 reexamination proceeding would impede treatment of the '7804 reexamination proceeding with special dispatch, for reasons similar to those given in the previous paragraph. A merger would pull the '7804 reexamination proceeding back from its briefed-on-appeal stage, and return the prosecution to a point in which no examination has taken place. Further, both product and

method claims would be required to be examined, while prosecution in the '7804 reexamination proceeding now includes only product claims. Also, the merged proceeding would be conducted under the broader reissue regulations, as required by 57 CFR 1.565(d). And, as pointed out in MPEP § 2285(IV), the merged proceeding would be subject to the potential filing of multiple requests for continued examination (RCE). It is simply does not appear that prosecution on the '786 reissue application, which has not yet begun, and which will involve both product claims and method claims will be concluded quickly to provide special dispatch for the reexamination proceeding. [2] There is a public interest in the outcome of the '7804 reexamination proceeding, and the public has a right to have that proceeding conducted with special dispatch, particularly when it has reached a late stage of prosecution, rather than have prosecution delayed indefinitely in favor of prosecution in a reissue application that has not yet had a first examination, and which may be subject to prosecution that may be extended by multiple follow-on filings.

Based on the above analysis, it is clear that none of the factors and arguments raised in the present patent owner petition rebut the analysis set forth in the preceding paragraphs. Factors (1) through (3) as set forth in Section II.A above demonstrate only that any prosecution of the claims of set forth in the '768 reissue application (whether as part of a merged proceeding with the '7804 reexamination proceeding or as a stand alone reissue application) is likely to be complicated and potentially of a lengthy duration, in contravention of treatment of the '7804 reexamination proceeding with special dispatch. Factors (5) and (6) do not address the issue of treatment of the '7804 reexamination proceeding with special dispatch.

Factor (4), that if a reexamination certificate were to issue without any allowed claims, then patent owner would not be permitted to have the amended method claims and narrower product claims examined by the Office, is simply untrue. As set forth in the paragraph bridging pages 3 and 4 of the August 4, 2008 petition decision, patent owner may, if, at the end of prosecution of the '7804 reexamination proceeding, no allowed claims remain in the '7804 reexamination proceeding, patent owner may file a petition to waive the provisions of 37 CFR 1.570(d), explaining why the reissue application was not filed until the present late stage in the prosecution of the reexamination proceeding.

Factor (7), patent owner's belief that the special the language of 35 U.S.C. § 101 counterbalances the requirement for special dispatch mandated by the reexamination statute is also not persuasive that the requested relief should be granted. Patent owner's "belief" does not establish the correctness of patent owner's position so as to compel a grant of the relief requested by patent owner. In fact, 35 U.S.C. § 101 simply provides that an applicant who has invented certain patent eligible subject matter may obtain a patent therefor, provided that the conditions and requirements of Title 35 are met. Patent owner <u>has</u> obtained such a patent, namely the '874 patent. Congress has also provided for subsequent examination by the Office of an original patent so obtained, and correction of that patent by reissue pursuant to 35 U.S.C. § 251 or reexamination pursuant to 35 U.S.C. § 302 *et seq*, if correction is warranted. A patent owner is entitled to ultimately obtain a corrected revised patent as a result of such subsequent examination by the Office, if the reissue application or reexamination proceeding ultimately complies with the applicable patentability standards set forth in Title 35. However, Congress *also mandated* that a reexamination proceeding conducted pursuant to 35 U.S.C. § 302 *et seq* to correct a previously obtained patent must be conducted with special dispatch in the Office. Treating such a proceeding with special dispatch does not contravene a patent owner's right to

[2] In that regard, it is to be noted that originally, both product claims and a method claim were subject to reexamination in the '7804 reexamination proceeding, but patent owner canceled the method claim, rather than conducting prosecution on the method invention.

obtain a corrected patent via reexamination, if correction is necessary and is warranted as a matter of patentability. The statutory right to *ex parte* reexamination and the requirement that such reexamination be conducted with special dispatch do not interfere with any of the rights of an inventor to obtain a patent pursuant to 35 U.S.C. § 101. Neither does the statutory right to *ex parte* reexamination and the requirement for special dispatch in a reexamination proceeding interfere with patent owner's ability to obtain a corrected patent via reissue, upon compliance with the statutory requirements for reissue, provided that patent owner has not otherwise given up that right. It is also to be noted that Congress did not mandate that a reissue application be examined in the Office with "special dispatch," so that suspension of prosecution in a reissue application is appropriate where such is deemed to be necessary by the Office.

As to permitting prosecution in the '7804 reexamination proceeding and the '768 reissue application to proceed concurrently, the prosecution of an application does not take place in a vacuum. What happens in one proceeding on a patent is available for viewing with respect to another proceeding on that patent. Patent owner cannot be permitted to circumvent the fact that the reexamination proceeding is at the briefed-on-appeal stage, and at that late point, submit arguments and amendments via the reissue application as a matter of right. This point is in addition to the fact that there cannot be separate sets of claims for a single patent, and that it is clearly more orderly to conclude the well advanced reexamination proceeding, while waiting as to the reissue proceeding that has not yet been examined, and was filed only after the reexamination proceeding was well advanced.

After full and careful consideration of the position advanced by patent owner in Section II.A, above, it is found that patent owner's position in the present petition is not persuasive that patent owner is entitled either to the requested relief of a stay in the prosecution of the '7804 reexamination proceeding, or the alternative relief of having the Office permit prosecution in the '7804 reexamination proceeding and the '768 reissue application to proceed concurrently.

CONCLUSION

1. The August 4, 2008 decision to dismiss patent owner's June 18, 2008 petition to stay the '7804 *ex parte* reexamination proceeding or to conduct that proceeding and the examination in the '768 reissue application concurrently is granted to the extent that it has been fully reconsidered. However, the October 4, 2008 petition is <u>denied with respect to the relief requested therein</u>.

2. Jurisdiction of the present 12/139,768 reissue application is being returned to Technology Center 2886, but prosecution in the '768 reissue applications remains suspended pursuant to 37 CFR 1.103(e) until conclusion of *ex parte* reexamination proceeding control number 90/007,804.

3. Jurisdiction of the '7804 *ex parte* reexamination proceeding is being returned to the Central Reexamination Unit.

4. After the conclusion of the '7804 *ex parte* reexamination proceeding by issuance and publication of the reexamination certificate, patent owner is advised to call up the reissue application for action by notifying the Office of such conclusion.

5. This decision is designated as a final agency action under 5 U.S.C. § 704.

6. Telephone inquiries related to this decision should be directed to Senior Legal Advisor Stephen Marcus at (571) 272-7743, or, in his absence to the undersigned at (571) 272-7710.

Kenneth M. Schor

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.
90/007,806	11/16/2005	5629245	740756-2887	2815

22204 7590 09/12/2006

NIXON PEABODY, LLP
401 9TH STREET, NW
SUITE 900
WASHINGTON, DC 20004-2128

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/12/2006

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CENTRAL REEXAMINATION UNIT

Jeffrey L. Costellia
NIXON PEABODY LLP
401 9th Street, N.W.
Washington , DC 20004-2128

(For Patent Owner)

In re Takashi Inushima et al.
Reexamination Proceeding
Control No.: 90/007,806
Filed: December 15, 2005
For: U.S. Patent No.: 5,629,245

DECISION ON PETITION UNDER 37 CFR 1.182

This is a decision on the August 22, 2006 patent owner petition under 37 CFR 1.182 to enter and to have the examiner consider an information disclosure statement (IDS) filed after the termination of the prosecution in this reexamination proceeding.

The petition is before the Office of Patent Legal Administration for decision.

The petition is dismissed for the reasons set forth below.

REVIEW OF SALIENT FACTS

1. Patent number 5,629,245 issued on May 13, 1997 with 11 claims.
2. A request for reexamination, assigned control No. 90/007,806 (the '806 proceeding), was filed on November 16, 2005, by the patent owner.
3. An order granting the reexamination request was mailed December 22, 2005.
4. An Information Disclosure Statement (IDS) was filed by the patent owner on June 6, 2006.
5. A Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the '806 proceeding on July 19, 2006.
5. The instant petition was filed on August 22, 2006, accompanied by a new IDS, which 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.

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 1.555. Information material to patentability in *ex parte* reexamination and *inter partes* reexamination proceedings.

(a) ... Any information disclosure statement must be filed with the items listed in § 1.98(a) as applied to individuals associated with the patent owner in a reexamination proceeding, and should be filed within two months of the date of the order for reexamination, or as soon thereafter as possible.
(b) Under this section, information is material to patentability in a reexamination proceeding when it is not cumulative to information of record or being made of record in the reexamination proceeding, and
(1) It is a patent or printed publication that establishes, by itself or in combination with other patents or printed publications, a *prima facie* case of unpatentability of a claim; or
(2) It refutes, or is inconsistent with, a position the patent owner takes in:
(i) Opposing an argument of unpatentability relied on by the Office, or
(ii) Asserting an argument of patentability.
A prima facie case of unpatentability of a claim pending in a reexamination proceeding is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability. ...

DECISION

1. The petition points out that Patent Owner's counsel received, in connection with a pending reexamination proceeding of related U.S. Patent No. 6,013,338, an unsolicited report via email on June 5, 2006, entitled "IdeaCop Second Opinion Prior Art Report for US Patent No. 6013338 by Patent Trakker." The report is stated to have listed the 58 U.S. patent documents now listed in the instant IDS. Patent Owner also admits in the petition that patent owner then prepared an IDS for the instant reexamination proceeding, which patent owner subsequently filed on June 6, 2006.

The petition fails to detail (a) why the patent owner did not submit the additional 58 documents received on June 5, 2006, with the IDS that patent owner filed on June 6, 2006, and (b) why the patent owner waited until August 22, 2006 to submit the documents it was made aware of on June 5, 2006.

2. A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on July 19, 2006, and the proceeding has now entered the publication process. The proceeding is not scheduled to come up for further action on the merits. In this instance, the present proceeding would need to be withdrawn from the publication process, thus regressing the processing of the proceeding. This would run contrary to the statutory requirement of 35 U.S.C. 305 that "[a]ll reexamination proceedings under this section...will be conducted with special dispatch within the Office."

The instant petition was filed late in the processing of the reexamination, and fails to provide a statement as to why the art submitted makes at least one claim unpatentable. To the contrary, patent owner merely states (page 1 of the instant petition) that the references were received in

connection with a pending reexamination of related U.S. patent 6,013,338 in an "an unsolicited report via email." Furthermore, patent owner has not in any way indicated how the references are material to patentability of this proceeding, except to proffer two articles about "Patent Trakker." According to one of these articles, Patent Tracker, "as a public service....has commenced publication of prior art references for ALL newly published USPTO Patent Applications...." Each of the two articles also states "...we are able and willing to provide prior art on any existing issued patents on request to e-mail protected from spam bots."

There is no statement that patent owner has reviewed the references and found them to be relevant.

In addition, patent owner has requested consideration of 58 patents, and has provided no discussion whatsoever about the substance of these references. There is no indication as to how any of these references would raise a substantial new question of patentability for at least one claim, or how any of these references refutes, or is inconsistent with, a position taken by the patent owner, as required by 37 CFR 1.555(b).

The statutory mandate of special dispatch is based upon the public interest in providing certainty and finality as to the question of patentability raised by the request for reexamination. In view of the fact that the information submitted was submitted after termination of the prosecution in this reexamination proceeding, is not asserted as raising a question of patentability of the claims, and it is not in any way discussed in detail, it is deemed that the reexamination proceeding should not be reopened at this late date to consider the proffered IDS. Accordingly the petition is dismissed as to the request for consideration of the IDS.

If, however, the patent owner in fact believes that one or more references submitted raises a substantial question of patentability as to at least one claim of the patent different than raised in this proceeding, the patent owner can always file a new request for reexamination for consideration of such references.

3. The IDS submitted by patent owner will be placed in the file, and will remain of record. However, since prosecution has been terminated in this reexamination proceeding, the IDS will not be considered by the examiner, as the proceeding will not be coming up for action on the merits.

4. In view of the above, the petition is dismissed.

CONCLUSION

1. The petition is dismissed as to the request for consideration of the IDS filed on August 22, 2006.

2. The IDS is entered into the file, but will not be considered by the examiner.

---

3. The present proceeding will continue in the publication process, toward issuance of a reexamination certificate.

4. Telephone inquiries related to this decision should be directed to Karen M. Hastings, Legal Advisor, at (571) 272-7717.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

kmh
9/06/06

9-08-06
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,806	11/16/2005	5629245	740756-2887	2815

22204 7590 11/21/2006

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/21/2006

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401 9th Street, N.W.
Washington , DC 20004-2128

(For Patent Owner)

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NOV 21 2006

CENTRAL REEXAMINATION UNIT

In re Takashi Inushima et al.
Reexamination Proceeding
Control No.: 90/007,806
Filed: November 16, 2005
For: U.S. Patent No.: 5,629,245

DECISION DENYING RELIEF SOUGHT IN REQUEST FOR RECONSIDERATION

This is a decision on the October 3, 2006 patent owner request for reconsideration of the September 12, 2006 decision dismissing the August 22, 2006 patent owner petition under 37 CFR 1.182. In the August 22, 2006 petition, patent owner sought entry and consideration of an information disclosure statement (IDS) filed after the termination of the prosecution in this reexamination proceeding.

The request for reconsideration is before the Office of Patent Legal Administration for decision.

SUMMARY

The request for reconsideration is granted to the extent that the September 12, 2006 Decision on Petition has been reconsidered, but the relief requested by patent owner is denied for the reasons set forth below.

Accordingly, the IDS filed August 22, 2006, has not been entered for consideration by the examiner. A copy of the IDS has however been placed in the electronic file. The patent owner has recourse for consideration of the IDS filed August 22, 2006 by way of filing a new request for reexamination for consideration of such references. If any of such references raises a substantial question of patentability as to at least one claim of the patent different than raised in this proceeding, that question would be resolved. If none of such references raises a substantial question of patentability as to at least one claim of the patent different than raised in this proceeding, then the Office's consideration of such references would result in a denial of reexamination.

REVIEW OF SALIENT FACTS

1. Patent number 5,629,245 issued on May 13, 1997 with 11 claims.

2. A request for reexamination, assigned control No. 90/007,806 (the '806 proceeding), was filed on November 16, 2005, by the patent owner.
3. An order granting the reexamination request was mailed December 22, 2005.
4. An Information Disclosure Statement (IDS) was filed by the patent owner on June 6, 2006.
5. A Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the '806 proceeding on July 19, 2006.
6. On August 22, 2006, a petition was filed, accompanied by a *new IDS*, which the patent owner requested the Office to consider.
7. On September 12, 2006, a decision was mailed dismissing the patent owner's petition.
8. On October 3, 2006, the instant request for reconsideration was filed by the patent owner.
9. The reexamination proceeding is in the final phase of the reexamination certificate publication process.

DECISION

A. Basis for Patent Owner's Request for Reconsideration

Patent owner alleges that the September 12, 2006 decision dismissing the original petition should be reconsidered for the following two major reasons. Patent owner asserts that:

1) The September 12, 2006 decision "characterization of untimeliness appears subjective and fails to take into account practical aspects of prosecution." It is patent owner's position that the roughly two month period for investigation of the origin of the unsolicited third party submission of prior art, docketing, review, preparation of drafts, and communications between parties residing on opposite parts of the world, should not prevent consideration of the IDS by the Office.

2) The September 12, 2006 decision appears to be based on standards that were not in effect at the time of filing the IDS on August 22, 2006. It is patent owner's position that changes to MPEP 2256 published on September 15, 2006 set forth new guidelines for consideration of an IDS after NIRC. It is the patent owner's position that it is improper and unfair to improperly enforce guidelines that were "unknowable" to the patent owner at the time the IDS was filed on August 22, 2006.

B. Analysis and Findings

1. 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 1.555. Information material to patentability in *ex parte* reexamination and *inter partes* reexamination proceedings.

(a) ... 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 so n thereafter as possible.**
(b) Under this section, information is material to patentability in a reexamination proceeding when it is not cumulative to information of record or being made of record in the reexamination proceeding, and
(1) It is a patent or printed publication that establishes, by itself or in combination with other patents or printed publications, a *prima facie* case of unpatentability of a claim; or
(2) It refutes, or is inconsistent with, a position the patent owner takes in:
(i) Opposing an argument of unpatentability relied on by the Office, or
(ii) Asserting an argument of patentability.
A prima facie case of unpatentability of a claim pending in a reexamination proceeding is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability. ... (Emphasis added.)

37 CFR 1.2 Business to be transacted in writing.

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. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

MPEP 2256 (Rev. 5, Aug. 2006)

...Once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, **and** (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC.

Once the reexamination has entered the Reexamination Certificate publication process, pulling the proceeding from that process provides an even greater measure of delay. 37 CFR 1.313 states for an application (emphasis added):

> "(c) Once the issue fee has been paid, **the application will not be withdrawn from issue upon petition by the applicant for any reason except:**
> (1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;"

The publication process for an application occurs after the payment of the issue fee (there is no issue fee in reexamination), and thus 37 CFR 1.313(c) applies during the publication cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its publication cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). **Accordingly, where a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), is made while a proceeding is in its publication cycle, the patent owner must provide an unequivocal statement as to why the art submitted makes at least one claim unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim r claims t 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)

2. Overview:

The instant IDS and the original petition filed August 22, 2006 points out that Patent Owner's counsel received, in connection with a pending reexamination proceeding of related U.S. Patent No. 6,013,338, an unsolicited report via email on June 5, 2006, entitled "IdeaCop Second Opinion Prior Art Report for US Patent No. 6013338 by Patent Trakker." The report is stated to have listed the 58 U.S. patent documents now listed in the instant IDS. Patent Owner also admits in the petition that patent owner was preparing an IDS for the instant reexamination proceeding, which patent owner subsequently filed on June 6, 2006.

The petition that was dismissed failed to detail, and failed to provide *any showing*, as to (a) why the patent owner did not submit the additional 58 documents received on June 5, 2006, with the IDS that patent owner filed on June 6, 2006, (b) why the patent owner failed to file a paper notifying the Office that a further IDS was to be filed and request a limited suspension of the prosecution to permit filing the further IDS, and (c) why the patent owner waited until August 22, 2006 to submit the documents it was made aware of on June 5, 2006.

In addition, patent owner requested consideration of 58 patents, and provided no discussion whatsoever about the substance of these references. There is no indication as to how any of these references would raise a substantial new question of patentability for at least one claim, or how any of these references refutes, or is inconsistent with, a position taken by the patent owner, as required by 37 CFR 1.555(b).

A review of the record showed that the examiner terminated prosecution on the merits by issuing a NIRC on July 19, 2006; thus, patent owner had more than a month to consider the additional 58 documents received on June 5, 2006, and to petition the Office for a one or two month suspension if extraordinary circumstances called for a delayed submission of an IDS.

In this instance the failure of patent owner to take timely action does not result in irreparable harm. On the contrary, the patent owner may have the entirety of the IDS filed August 22, 2006 considered by filing a new request for reexamination for consideration of such references. If any of such references raises a substantial question of patentability as to at least one claim of the patent different than raised in this proceeding, that question would be resolved. If none of such references raises a substantial question of patentability as to at least one claim of the patent different than raised in this proceeding, then the Office's consideration of such references would result in a denial of reexamination.

The proceeding has now entered the publishing cycle. The proceeding is not scheduled to come up for further action on the merits. In this instance, in order to consider the instant IDS, the present proceeding would need to be withdrawn from the publishing cycle, 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 petition that was dismissed, and the instant October 3, 2006 request for reconsideration, were filed late in the processing of the reexamination, and fail to provide a statement as to why the art submitted makes at least one claim unpatentable. To the contrary, patent owner merely states (page 1 of the petition that was dismissed) that the references were received in connection with a pending reexamination of related U.S. patent 6,013,338 in an "an unsolicited report via email."

3. Detailed Discussion:

A. It is patent owner's position that the roughly two month period for investigation of the origin of the unsolicited third party submission of prior art, docketing, review, preparation of drafts, review of drafts, etc. should not prevent consideration of the IDS by the Office.

The September 12, 2006 decision did not state or imply that the over two month period of time (i.e., June 5 to August 22) *per se* prevented consideration of the IDS. It was but one factor considered. It is, however, to be noted that no explanation was given in the original petition, nor in the instant request for reconsideration, as to nature of the preparation made which required the owner to wait roughly two months to submit just the bare listing of citations which was in patent owner's possession on June 5, 2006. While the patent owner alleges that the roughly two month period of time was needed for the listed activities, the actual submission on August 22, 2006 includes just what patent owner received on June 5, 2006. There were no documents that should have resulted from the "drafts" that were allegedly done, and there is not even a statement that patent owner reviewed the references and found them to be relevant. And further, as pointed out above, the patent owner could have filed a paper notifying the Office that a further IDS was to be filed and requesting a limited suspension of the prosecution to permit filing a further IDS.

The statutory mandate of special dispatch is based upon the public interest in providing certainty and finality as to the question of patentability raised by the request for reexamination. In view of the fact that the information, in this instance, (a) was submitted after termination of the prosecution in this reexamination proceeding, (b) is not asserted as raising a question of patentability of the claims, and (c) is not in any way discussed in detail, it is deemed that the reexamination proceeding should not be reopened at this late date, by pulling the proceeding from the publishing cycle, to consider the proffered IDS. If patent owner wanted the Office to withdraw the reexamination proceeding from the publication process, the patent owner needed to give the Office sufficient information to enable the Office to address the newly submitted IDS with the special dispatch required by law. The patent owner has given no such information here.

<u>If, however</u>, the patent owner in fact believes that one or more references submitted in the IDS filed August 22, 2006 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), as pointed out above.

B. The patent owner also states that since patent owner had no control over the timing of the Patent Trakker report, they consequently had no control over what point in time during prosecution it was received. This may be true, however, as pointed out above, the Office must conduct the proceeding with special dispatch. The Office properly proceeded to issue the NIRC on July 19, 2006, since no petition for limited suspension (providing an adequate showing of why more time was needed and how much more time, and paying the requisite petition fee) was filed. It is further noted that there is not even a showing providing evidence that patent owner alerted the examiner, before the NIRC was mailed, to the fact that they were preparing another IDS.

C. It is also the patent owner's position that the September 12, 2006 decision appears to be based on standards that were not in effect at the time of filing the IDS on August 22, 2006. Changes to MPEP 2256 were published on the Office's website on September 15, 2006 and set forth what are alleged to be "new guidelines" for consideration of an IDS after NIRC. It is the patent owner's position that it is improper to enforce guidelines that were "unknowable" to the

patent owner at the time the IDS was filed on August 14, 2006. The patent owner also refers to alleged oral representations made by Ms. Lissi Marquis that "no statements of relevancy are required in an IDS filed under Rule 1.555."

1) First, the request for reconsideration makes it clear that the discussion that occurred with Ms. Marquis was on April 19, 2006. There could not have been any discussion on April 19, 2006 about the listing received by the patent owner on June 5, 2006. Thus, this discussion was made in the context of the IDS filed June 6, 2006, before the NIRC was mailed on July 19, 2006. The IDS submitted June 6, 2006 was in fact entered and was considered by the examiner. There does not appear to have been any discussion directed to the Office policies for handling IDS submissions after a NIRC has been mailed.

2) Second, as pointed out in 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." It is to be noted that an oral discussion is subject to misunderstanding, misconstruing, and a lack of certainty as to what was discussed.

3) In addition, as stated in the September 12, 2006 decision, the patent owner has requested consideration of 58 patents, and has provided no discussion whatsoever about the substance of these references. There is no indication as to how any of these references would raise a substantial new question of patentability for at least one claim, or how any of these references refutes, or is inconsistent with, a position taken by the patent owner, as required by 37 CFR 1.555(b) for a showing that this information is material to patentability. This is needed before the Office will consider an IDS submission after a NIRC has been mailed - to provide the Office with guidance as to evaluation of the submitted citations, in order to counter-balance the statutory requirement for special dispatch. It is presumed that counsel was aware of the statutory requirement for special dispatch at the time the IDS was filed. As stated previously, if patent owner wants the Office to pull/withdraw the reexamination proceeding from the publication process, the patent owner needs to give the Office sufficient information to enable the Office to address the newly submitted IDS with the special dispatch required by law. The patent owner provided no such information here.

4) Furthermore, the changes made recently to MPEP 2256 (Rev. 5, August 2006) merely discussed previous standards that have been commonly applied to IDS submissions after a NIRC has been mailed in a reexamination proceeding. [1]

D. As to the present request for reconsideration, the petitioner has, for the first time, provided some discussion as to the reasons for the delay in submitting the IDS. These reasons have not been found sufficient for the reasons set forth above. Even if the reasons had been sufficient, however, petitioner would be submitting them for the first time, at a point where the proceeding is in the final stage of the printing cycle. At this stage, however, the patent owner is required to 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, based on the following:

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[1] See, for example, the decisions on petition in records of the 90/006,737, 90/007,444, 90/007,533, 90/005,969, 90/007,336, 90/006,926, 90/006,849, and 90/004,028 proceedings, which were, and are open to the public.

There is no issue fee in reexamination, and the present reexamination proceeding has, at present, entered the final phase of the publication process (the "printing cycle"). In a reexamination proceeding, there is no withdrawal under 37 CFR 1.313 of the proceeding from the publication process for consideration of an Information Disclosure Statement (IDS), because 37 CFR 1.313(a) applies to applications and not to reexamination proceedings. Accordingly, in this instance the petition for withdrawal of the proceeding from the publication process for consideration of the accompanying IDS papers has been filed under 37 C.F.R. 1.182.

While there is no regulatory provision for withdrawal of a reexamination proceeding from the publication process for consideration of an IDS, 37 CFR 1.313 provides such a mechanism for an application. Accordingly, the requirements of 37 CFR 1.313 for withdrawal of an application from the printing cycle (after the issue fee has been paid) have historically been applied analogously to the requirements for withdrawal of reexamination proceedings from the printing cycle. This policy is explicitly set forth in the latest revision of MPEP 2256 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, for the present request for reconsideration, the patent owner failed to satisfy the grounds that would be analogous to those of 37 CFR 1.313(c). The instant reconsideration petition fails to provide a statement as to why the submitted IDS items of information (art citations) make at least one claim unpatentable. Patent owner does not provide any discussion of the substance of any of the items of information, and has not applied the teachings of the same to the claim limitations in the present reexamination proceeding.

For *ex parte* reexamination, there is a statutory requirement pursuant to 35 U.S.C. 305 that all *ex parte* reexamination proceedings "will be conducted with special dispatch within the Office." It is required that the withdrawal criteria of 37 CFR 1.313(c) be complied with for an application, in which there is no statutory requirement for special dispatch, and such criteria must certainly be complied with for a reexamination proceeding where there is a statutory requirement for special dispatch. This is explicitly set forth in the latest revision of the MPEP as set forth above; patent owner admits being aware of these provisions at the time the present reconsideration petition was filed, yet, patent owner failed to comply with them when the present reconsideration petition was filed.

E. Again, a review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on July 19, 2006, and the proceeding has now entered the final stages of the publication process. The proceeding is not scheduled to come up for further action on the merits. In this instance, in order for the examiner to consider the instant IDS, the present proceeding would need to be withdrawn from the publication process, thus regressing the processing of the proceeding. This would run contrary to the statutory requirement of 35 U.S.C. 305 that "[a]ll

reexamination proceedings under this section...will be conducted with special dispatch within the Office." The statutory mandate of special dispatch is based upon the public interest in providing certainty and finality as to the question of patentability raised by the request for reexamination. In view of the fact that the information submitted was submitted after termination of the prosecution in this reexamination proceeding, is not asserted as raising a question of patentability of the claims, and it is not in any way discussed in detail, it is proper that the reexamination proceeding should not be reopened at this late date to consider the proffered IDS papers.

Accordingly, the relief requested in the October 3, 2006 request for reconsideration is denied as to the request for consideration of the IDS papers. The proceeding will not be withdrawn from the publication process.

In summary:

In view of the above discussion, the IDS consideration relief requested by the patent owner in the request for reconsideration is denied.

The IDS submitted by patent owner has, however, been placed in the file, and will remain of record. Since prosecution has been terminated in this reexamination proceeding, the IDS will not be considered by the examiner, as the proceeding will not be coming up for action on the merits.

CONCLUSION

1. The request for reconsideration is granted to the extent that the September 12, 2006 Decision on Petition has been reconsidered, but the relief requested by patent owner is otherwise denied.

2. The IDS remains entered in the file, and has not been considered by the examiner.

3. The present proceeding will continue in the publication process, toward issuance of a reexamination certificate.

4. **This decision is a final agency action within the meaning of 5 U.S.C. § 704.**

5. Telephone inquiries with regard to this decision should be directed to Kenneth M. Schor, Senior Legal Advisor, or, in his absence, to Karen M. Hastings, Legal Advisor, at (571) 272-7717.

Robert A Clarke, Deputy Director OPLA
for

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

kmh
11/09/06

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3-8-07

Patent No. : 5,808,146 C1
Ser. No. : 08/554,906
Inventor(s) : Goodman, et. al.
Issued : January 2, 2007
Title : AMINO ACID ANALOGS FOR TUMOR IMAGING
Docket No. : 64-95

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(s) 1.322.

Assignees' names and addresses (assignment data) printed in a patent, are based *solely* on information supplied in the appropriate space for identifying the assignment data, i.e., item 3 of the Issue Fee Transmittal Form PTOL-85B. Granting of a request under 37 CFR 3.81(b) is required to correct applicant's error providing ***incorrect or erroneous*** assignment data, *before* issuance of a Certificate of Correction, under 37 CFR 1.323 *(see Manual of Patent Examining Procedures (M.P.E.P) Chp.1400, sect. 1481).* This procedure is required *at any time after the issue fee is paid,* including after issuance of the patent.

In view of the foregoing, your request is hereby denied.

A request to correct the Assignee under 37 CFR 3.81(b) should include:

A. **the processing fee set forth in 37 CFR 1.117(h) (currently $130);**
B. a statement that the failure to include the correct assignee name on the PTOL-85B was inadvertent; and
C. a copy of the Notice of Recordation of Assignment Document, reflecting the reel and frame number where the assignment(s) is recorded and/or reflecting proof of *the date* the assignment was submitted for recordation.

In the Request, Applicant(s) may request that the file be forwarded to Certificates of Correction Branch, for issuance of a Certificate of Correction, if the Request is granted.

Any request under 37 CFR 3.81(b) should be directed to the following address or facsimile number:

By mail: Mail Stop PETITIONS
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

Copied from 08554906 on 05/21/2007

By hand: Customer Service Window
Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By fax: (703) 872-9306
ATTN: Office of Petitions

If a fee (currently $100) was previously submitted for consideration of a Request for Certificate of Correction, under CFR 1.323, to correct assignment data, , no additional fee is required.

Eva James
For Cecelia Newman
Decisions & Certificates
of Correction Branch
(703) **308-9390 ext. 124** or (703) 308-9390 ext. 105

Susan K. Doughty
Greenlee, Winner & Sullivan
4875 Pearl East Circle, Suite 200
Boulder, CO 80301

ej

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Stoel Rives LLP
900 SW Fifth Avenue
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Portland, OR 97204-1268

(For Patent Owner)

MAILED
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REEXAM UNIT

[Enclosure: Third Party Requester's January 31, 2006 petition.]

Thomas R. Arno
Knobbe Martens Olson & Bear LLP
2040 Main Street
Fourteenth Floor
Irvine, CA 92614

(For Third Party Requester)

In re *Electro Scientific Industries*	:
Ex Parte Reexamination Proceeding	:
Control No.: 90/007,812	: **DECISION DISMISSING**
Filed: November 23, 2005	: **PETITION AND SERVING**
For: U.S. Patent No. 5,685,995	: **PETITION ON PATENT OWNER**
	:

This is a decision on the January 31, 2006 third party requester petition under entitled "PETITION FOR SUBSTITUTION AND MERGER OR WITHDRAWAL AND DISMISSAL OF REEXAMINATION PROCEEDING."

The petition is before the Office of Patent Legal Administration for decision.

The petition does not assert a regulatory basis for the requested relief, but has authorized the payment of the $400 petition fee established by 37 CFR 1.17(f) for the petition. It is presumed that the basis for the relief requested is 37 CFR 1.182. [1]

The petition is dismissed and is being mailed to patent owner for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 5,685,995 (the '995 patent) issued on November 11, 1997 issued from application number 08/538,073 (the '073 application) filed on October 2, 1999, and is assigned to Electro Scientific Industries.

2. Application number 08/959,140 (the '140 application) was filed on October 28, 1997, as a continuation of the '073 application.

[1] Third party requester does not allege that the requested relief requires the waiver of any regulation pursuant to 37 CFR 1.183.

3. A terminal disclaimer was filed on May 5, 2005 in the '140 application, disclaiming the terminal portion of the statutory term of the '272 patent that would extend beyond the full statutory term of any patent granted on the '140 application.

3. Upon acceptance of the terminal disclaimer in the '140 application, U.S. Patent No. 5,802,272 (the '272 patent) issued on September 15, 1998. The '272 patent is also assigned to Electro Scientific Industries.

4. A third party requester filed a request for *ex parte* reexamination of the '995 patent on November 23, 2005. The request for reexamination was assigned control number 90/007,812 (the '812 reexamination proceeding) and is the present proceeding.

5. Reexamination was ordered in the '812 reexamination proceeding on January 20, 2006.

6. The same third party requester filed a request for *ex parte* reexamination of the '272 patent on February 2, 2006. That request for reexamination was assigned control number 90/007,911 (the '911 reexamination proceeding).

7. Reexamination was ordered for in the '911 reexamination proceeding on March 1, 2006.

8. No further prosecution has been conducted in either reexamination proceeding.

9. **The present petition was filed on January 31, 2006, with no indication of service on the patent owner.**

DECISION

37 CFR 1.182 provides:

> "All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f)."

37 CFR 1.535 provides as to third party requesters:

> "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 provides as to third parties in general:

> "(g) ...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)."

As noted, *supra*, the request for reexamination of the '995 patent was filed on November 23, 2005, and reexamination was ordered in the resulting '812 reexamination proceeding on January 20, 2006. The record shows that, prior to third party requester's filing of the present petition on January 31, 2006, patent owner had not filed a patent owner's statement pursuant to 37 CFR

1.530. Thus, the third party requester was not entitled to file a reply, or any other submission at the time the petition was filed. In addition, the two month period of time set in the Order Granting *Ex Parte* Reexamination in which the patent owner was permitted to file a patent owner's statement has now expired, and no patent owner statement has been filed in the '812 ex parte reexamination proceeding. Thus, pursuant to 37 CFR 1.535, no further third party requester submission will be considered. In addition, the present petition is not a request for reexamination in compliance with the requirements of 37 CFR 1.510, it is not a reply to a patent owner's statement pursuant to 37 CFR 1.535, and it does not qualify as a prior art citation under 37 CFR 1.501. Thus, pursuant to 37 CFR 1.550, the submission will not be considered as a submission by a third party in general.

Accordingly, the present petition does not have an entry right under the rules. Third party requester has not requested the waiver of any regulation precluding entry of the present petition. Therefore, the present petition would ordinarily be returned to the third party requester without consideration. However, because the record does not show that the present petition was served on patent owner as required by the regulations, the present petition will be mailed to patent owner to perfect service. The present petition *will not* be decided on the merits.

ADDITIONAL DISCUSSION

35 U.S.C. § 301 states, in pertinent part:

> "Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent."

35 U.S.C. § 302 states, in pertinent part:

> "Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title."

35 U.S.C. § 303(a) states, in pertinent part:

> "Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Director **will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request**, with or without consideration of other patents or printed publications. ... **On his own initiative, the Director may determine whether a substantial new question of patentability is raised by patents and publications discovered by him or cited under the provisions of section 301 of this title.** " (Emphasis supplied.)

35 U.S.C. § 304 states, in pertinent part:

> "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.**" (Emphasis supplied.)

35 U.S.C. § 305 states, in pertinent part:

> "After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination **will** be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. ... In any reexamination proceeding under this chapter, **the patent owner will be permitted t propose any amendment to his patent and a new claim or claims thereto**, ... (Emphasis supplied.)

35 U.S.C. §§ 302-305 provide, *inter alia,* that when a request for reexamination is filed, the Director will determine whether a substantial new question of patentability exists. [2] Thereafter, if the Director has determined that a substantial new question of patentability exists, that determination will include an order for reexamination of the patent. [3] Thereafter, reexamination will be conducted, and patent owner will be permitted to amend his patent and a new claim or claims thereto. [4]

A request to withdraw an *ex parte* reexamination request, or to apply a request to another (a different) patent would not be permitted in view of the legislation and implementing rules which require that (1) once an *ex parte* reexamination request is filed, it will be decided, and (2) once the request is determined to raise a substantial new question of patentability of a claim of the patent, the request *will* result in an order for reexamination to resolve the substantial new question, which in turn *will* be followed by reexamination in accordance with 35 U.S.C. §§ 303-305. The statutory language is based on the public interest in resolving any reexamination proceeding that is filed.

Withdrawal of a third party requested reexamination proceeding would leave both the public and the patent owner with an unresolved request for reexamination. Both the public and the patent owner have a right to such a resolution. In the event reexamination is ordered, a substantial new question of patentability will have been raised in the proceeding, and the patent owner has a statutory right to have that question resolved, including amending the patent as deemed necessary. All of this would be abrogated by "withdrawing" or otherwise "abandoning" or "terminating" a reexamination.

The substitution of patent B for patent A after reexamination has been ordered for patent A would likewise leave the issue of a substantial new question of patentability and resolution of any such question intact and unresolved. The patent owner and the public would once again be deprived of the statutory right to resolution.

It is finally to be noted that even if a reexamination request could be withdrawn, the Director is authorized under 35 U.S.C. § 303(a) to order reexamination on his own initiative, based on an existing substantial new question of patentability, and this would serve the public interest for which a Director-initiated-reexamination was enacted. As a matter of administrative convenience, the Office need not, and will not, expend the additional resources needed to terminate one reexamination proceeding only to institute another one based on the same substantial new question of patentability that presently exists in the reexamination proceeding for which withdrawal is requested.

CONCLUSION

1. The third party requester petition filed February 17, 2006 is dismissed as not having an entry right.

2. Rather than returning the filed copy of the petition papers to the third party requester, the petition papers filed February 17, 2006, are being mailed to the patent owner as an attachment to this decision.

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[2] 35 U.S.C. § 303
[3] 35 U.S.C. § 304
[4] 35 U.S.C. § 305

3. No copy of the petition papers will be maintained in the electronic Image File Wrapper, or elsewhere in the Office.

4. A copy of this decision will be made of record in the reexamination file.

5. The '812 *ex parte* reexamination proceeding is being returned to the jurisdiction of the Central Reexamination Unit for appropriate action.

6. Telephone inquiries related to the present decision should be directed to the Stephen Marcus, Legal Advisor, at 571-272-7743, or, in his absence, to the undersigned at 571-272-7710.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

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March 16, 2006

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March 16, 2006